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The International Comparative Legal Guide to:

Patents 2016

6th Edition

A practical cross-border insight into patents law

Published by Global Legal Group, in association with CDR, with contributions from:

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Email: info@glgroup.co.uk
URL: www.glgroup.co.uk

GLG Cover Design

F&F Studio Design

GLG Cover Image Source

iStockphoto

Printed by

Ashford Colour Press Ltd.
August 2015

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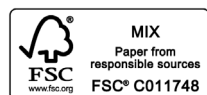
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ISBN 978-1-910083-60-4

ISSN 2044-3129

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This publication is intended to give an indication of legal issues upon which you may need advice. Full legal advice should be taken from a qualified professional when dealing with specific situations.

Romania

Nicoleta Tarchila



Pop Calin Radu



Cabinet Enpora Intellectual Property

1 Patent Enforcement

1.1 How and before what tribunals can a patent be enforced against an infringer?

In Romania patent owners may enforce their rights by initiating civil and criminal litigations. For infringement matters Romanian patent law does not provide the competence of specialised IP courts. Thus the court must be chosen based on the general rules with respect to competence: territorial jurisdiction is determined by the domicile of the defendant for civil proceedings and the domicile of the defendant or the place of infringement in criminal proceedings, material competence is conferred to the court of law because of the special nature of the conflict. Civil infringement litigation will be initiated directly by the patent owner or by the exclusive licensee. Criminal litigation must be preceded by a criminal complaint.

1.2 What are the pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

For civil proceedings depending on the court's schedule the written procedure may be started in about three months and a first hearing is established in a time frame of six months after the filing of the action. The pre-trial stage comprises: the completion of the action with all the necessary documentation; payment of the judicial fees; filing of the proof of representation; the communication of the action to the defendant; the filing of a defence within 25 days as of the date of communication of the action; and the filing of a reply to the defence within 10 days as of communication of the defence to the plaintiff.

For criminal actions the pre-trial procedural stage may take up to two years and consists of a police investigation and a resolution of the public prosecutor to start the criminal trial.

1.3 Can a defence of patent invalidity be raised and if so how?

The Romanian patent law provides special competence in validity cases to the Bucharest Court of Law. Infringement actions are governed by the general competence rules. In case the Bucharest Court of Law has competence for both actions then there is no impediment for validity and infringement to be dealt with together as counterclaims of the same trial. In case the competence in an infringement case belongs to a different court validity and infringement are judged separately. Depending on the circumstances

of the particular case a validity action may be grounds deferment of the infringement action until a final decision will be issued in the validity case.

1.4 How is the case on each side set out pre-trial? Is any technical evidence produced and if so how?

There is no pre-trial discovery in Romania. Evidences may be submitted together with the court action and/or during the court proceedings. Technical evidences may be produced through documents and expert opinions.

1.5 How are arguments and evidence presented at the trial? Can a party change its pleaded arguments before and/or at trial?

Arguments and evidences must be included in the initial court action. Both arguments and evidences may be completed during the trial depending on the course of the proceedings. The pleaded arguments may be changed before or during the trial depending on the evidences and defence of the other party but also due to a change in the strategy of the trial.

1.6 How long does the trial generally last and how long is it before a judgment is made available?

Because of the pre-trial written phase and the prior hearings where the procedural exceptions and administration of evidences are discussed the trial may last for up to two hours depending on the complexity of the case. The court's judgment must be given on the day of the trial or may be delayed for a maximum of 15 days. Another two to three months are needed by the court to draft and communicate the grounded decision.

1.7 Are there specialist judges or hearing officers and if so do they have a technical background?

There are no specialist judges or hearing officers. The judges are to rely on the technical expertise for technical information.

1.8 What interest must a party have to bring (i) infringement (ii) revocation and (iii) declaratory proceedings?

(i) A patent owner or in certain conditions the exclusive licensee may initiate infringement if there are evidences to prove the patent rights

are being infringed, (ii) any person may request the revocation of a patent, and (iii) declaratory proceedings are not available in Romania.

1.9 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

The disclosure of documents is usually made if an expertise was admitted. In such case parties are required to disclose all relevant documents to the expert in order to allow the drafting of the expertise. Moreover in case a document proven important for solving the trial by the plaintiff is in the possession of the defendant the court may order the provision of such document.

1.10 Can a party be liable for infringement as a secondary (as opposed to primary) infringer? Can a party infringe by supplying part of but not all of the infringing product or process?

The Romanian patent legislation does not contain any provisions related to secondary infringement acts. However according to the general rules taking part in an infringement action makes one liable.

1.11 Can a party be liable for infringement of a process patent by importing the product when the process is carried on outside the jurisdiction?

Yes, importing the product which is directly obtained through a protected process makes one liable for infringement.

1.12 Does the scope of protection of a patent claim extend to non-literal equivalents?

Yes non-literal equivalents apply in our jurisdiction. In order to determine the extent of protection of a patent account should be taken of any equivalent element to an element specified in the claims. Consequently the interpretation of the patent claims in a court action exceeds the literal meaning of the claims.

1.13 Other than lack of novelty and inventive step, what are the grounds for invalidity of a patent?

Other grounds for invalidity are: lack of industrial applicability; insufficient disclosure of the invention; the subject-matter of the patent exceeds the content of the patent application; the protection conferred by the patent has been extended; and the patent owner is not the person entitled to the grant of the patent.

1.14 Are infringement proceedings stayed pending resolution of validity in another court or the Patent Office?

Having in view that the resolution in a validity action influences the resolution in the infringement action the infringement proceedings are usually stayed pending resolution of validity. However depending on the specific circumstances of the case the court may decide otherwise.

1.15 What other grounds of defence can be raised in addition to non-infringement or invalidity?

Prior use rights, exhaustion of rights or statutory use may be raised as additional defence.

1.16 Are (i) preliminary and (ii) final injunctions available and if so on what basis in each case?

- (i) Preliminary injunctions are provided by the Romanian Civil Procedure Code and are frequently used and granted in infringement proceedings. The circumstances that must be cumulated in order to have a preliminary injunction granted are the existence of an appearance of right on behalf of the plaintiff, the matter must be urgent and the action is meant to prevent either the risk that the right may be harmed by any delay or an imminent prejudice that could not be repaired in a later stage or obstacles in the enforcement of the decision on merits.
- (ii) Final injunctions are granted at the end of the trial based on the claims of the plaintiff.

1.17 On what basis are damages or an account of profits estimated?

The usual criteria taken into consideration while calculating the damages are the unfair revenues obtained by the defendant and the loss of revenues supported by the patent owner. Damages are usually established based on an accounting expertise performed during the trial. Other criteria are determining damages based on royalty fees. Punitive damages may not be obtained.

1.18 What other form of relief can be obtained for patent infringement?

The plaintiff may also obtain the seizure and destruction of the infringing products and of the devices and instruments used to produce the infringing products. The plaintiff may also obtain the publication of the decision in a local newspaper.

1.19 Are declarations available and if so can they address (i) non-infringement and/or (ii) claim coverage over a technical standard or hypothetical activity?

There are no specific provisions related to non-infringement declarations. According to the general rules a declaration of non-infringement may be made however not in respect of a technical standard or a hypothetical activity.

1.20 After what period is a claim for patent infringement time-barred?

According to the general civil rules of prescription a claim for infringement is barred within three years as of the date the plaintiff was aware or should have been aware of the infringement and of the person or entity who committed the infringement.

1.21 Is there a right of appeal from a first instance judgment and if so is it a right to contest all aspects of the judgment?

The first instance judgment may be subject to appeal before the Court of Appeal with respect to all aspects of the judgment. New evidences may be produced. The appeal decision may be subject to a last appeal which is an exceptional way of appeal restricted to the incorrect application or interpretation of the law.

1.22 What are the typical costs of proceedings to first instance judgment on (i) infringement and (ii) validity; how much of such costs are recoverable from the losing party?

Depending on the value of the case for the first instance of proceedings costs may reach Euro 10,000 for both infringement and validity cases. The losing party bears the burden of paying the entire costs of the proceedings the payment of which is proven by the winning party. However if the attorney costs are considered too high by the court these may be reduced.

1.23 For countries within the European Union: What steps are being taken in your country towards ratification, implementation and participation in the Unitary Patent Regulation (EU Regulation No. 1257/2012) and the Agreement on a Unified Patent Court? For countries outside of the European Union: Are there any mutual recognition of judgments arrangements relating to patents, whether formal or informal, that apply in your country?

As a member of the EU Romania is bound by Regulation 1257/2012 and is participating in the enhanced cooperation in respect of patents. Currently Romania is in the process of deciding about the opportunity of ratifying the United Patent Court Agreement. Proposals of conducting a feasibility study were made.

2 Patent Amendment

2.1 Can a patent be amended *ex parte* after grant and if so how?

A patent application may be amended only before a decision is taken provided that the disclosure of the invention does not extend beyond the content of the patent application on the filing date. After a grant the patent may not be amended. However, at any point during the life of a patent the patent owner may waive partly or completely the patent by means of a written declaration filed before the Patent Office. In case the patent is an employee created invention the patent owner is required to transmit the rights on the patent to the inventor in exchange of a non-exclusive licence. If the patent is the object of a licence the waiver is possible only upon the agreement of the licensee.

2.2 Can a patent be amended in *inter partes* revocation proceedings?

In *inter partes* revocation proceedings the patent may be amended in so far as such protection is not thereby extended.

2.3 Are there any constraints upon the amendments that may be made?

The main constraints upon the amendments are to maintain the disclosure of the invention inside the content of the patent application on the filing date.

3 Licensing

3.1 Are there any laws which limit the terms upon which parties may agree a patent licence?

There are no specific provisions which limit the terms the parties may agree in a patent licence. However account must be taken of the antitrust and unfair competition legislation.

3.2 Can a patent be the subject of a compulsory licence and if so how are the terms settled and how common is this type of licence?

A patent can be subject to a compulsory licence authorised by the Court of Bucharest if four years have elapsed from the patent application filing date or after three years have elapsed from the grant of the patent, whichever period expires later and the invention has not been exploited or has been insufficiently exploited on the territory of Romania, and the patent owner cannot justify his inaction, and where no agreement has been reached with him regarding the conditions and commercial methods for applying the invention. Other reasons for authorising a compulsory licence are: national emergency cases; and other cases of extreme emergency and public use for non-commercial purposes. Another case of authorisation of a compulsory licence is where a patent cannot be exploited without infringing the rights conferred by another patent granted for an application having a prior regular national filing date, if the following additional conditions are cumulatively fulfilled:

- the invention claimed in the subsequent patent involves an important technical advance of considerable economic significance as compared with the invention in the earlier patent;
- the owner of the earlier patent is entitled to a cross-licence on reasonable terms for using the invention claimed in the subsequent patent; and
- the use authorised in respect of the earlier patent shall be non-transferable, except for the transfer with the subsequent patent.

We are not aware of a compulsory licence being authorised in Romania.

4 Patent Term Extension

4.1 Can the term of a patent be extended and if so (i) on what grounds and (ii) for how long?

The term of a patent may not be extended as such. Since 2007 the Supplementary Certificate of Protection (SPC) has been available in Romania for pharmaceutical and plant protection products and adds a five-year protection to these patents. For paediatric products another six-month extension of the SPC is possible.

5 Patent Prosecution and Opposition

5.1 Are all types of subject matter patentable and if not what types are excluded?

Not all types of subject matter are patentable and the following in particular shall not be granted a patent:

- discoveries, scientific theories and mathematic methods;
- aesthetic creations;
- schemes, rules and methods for performing mental acts, playing games or doing business, as well as computer programs;
- presentations of information;
- inventions, the exploitation of which would be contrary to public order or morality, including inventions harmful to the health or life of persons, animals or plants, and which are likely to seriously harm the environment, provided that such exception from patentability shall not depend merely on the fact that exploitation is prohibited by a legal provision;
- plant varieties and animal breeds, as well as the essentially biological processes for the production of plants or animals;
- the inventions having as a subject-matter the human body in its various stages of formation and development, as well as the mere discovery of one of its elements, including the sequence or partial sequence of a gene; and
- methods of treatment concerning the human or animal body, by surgery or therapy and methods of diagnosis applied to the human or animal body.

5.2 Is there a duty to the Patent Office to disclose prejudicial prior disclosures or documents? If so, what are the consequences of failure to comply with the duty?

No, there is no duty to disclose prejudicial prior art.

5.3 May the grant of a patent by the Patent Office be opposed by a third party and if so when can this be done?

The grant of a patent may be opposed by third parties by means of a revocation action to be filed within six months as of the publication of the mention of granting the patent.

5.4 Is there a right of appeal from a decision of the Patent Office and if so to whom?

The decisions of the Patent Office may be contested before the Bucharest Court of Law.

5.5 How are disputes over entitlement to priority and ownership of the invention resolved?

Disputes over entitlement to priority and ownership of the invention are resolved by the law courts.

5.6 Is there a “grace period” in your country and if so how long is it?

A six-month “grace period” is available and the disclosure of the invention shall not be taken into consideration if it occurred due to an evident abuse in relation to the applicant or his legal predecessor or due to the fact that the applicant or his legal predecessor has displayed the invention at an official or officially recognised international exhibition upon proving such participation.

5.7 What is the term of a patent?

The term of a patent is 20 years from the date of filing of the patent application.

6 Border Control Measures

6.1 Is there any mechanism for seizing or preventing the importation of infringing products and if so how quickly are such measures resolved?

Customs may act *ex officio* or based on an application for a customs action which may be filed free of charge by the patent owner. A notification concerning the seizure of infringing goods is sent to the right holder shortly after the seizure. The patent owner is allowed 10 business days to confirm if the goods are infringing its patent rights and to either request the destruction of the goods or file an infringement action with the local courts. The simplified procedure consisting in the destruction of the infringing goods is available if the infringer does not contest the seizure or explicitly agrees with the destruction.

7 Antitrust Law and Inequitable Conduct

7.1 Can antitrust law be deployed to prevent relief for patent infringement being granted?

Exhaustion of rights may be invoked to prevent patent infringement claims.

7.2 What limitations are put on patent licensing due to antitrust law?

No specific limitations are included in the Romanian legislation however the EU regulations are to be applied.

8 Current Developments

8.1 What have been the significant developments in relation to patents in the last year?

The most important development in Romania was the entering into force of the Law no. 83/2014 on employee created inventions. The swift provisions included in the patent law are now presented in depth in the new law which includes detailed provisions regarding definitions of terms and deadlines related to the inventions created by the employees.

8.2 Are there any significant developments expected in the next year?

No concrete developments are expected in the next year.

8.3 Are there any general practice or enforcement trends that have become apparent in Romania over the last year or so?

No, there are no such trends.

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Cabinet Enpora is a full service industrial property boutique based in Romania. We offer representation and assistance before the Romanian Patent and Trademark Office, European Patent Office, Office for Harmonisation in the Internal Market and World Intellectual Property Organisation. With 25 years of experience in the IP domain Enpora is one of the oldest firms in Romania specialised in this area. Our main focus over the years was providing high quality services on the Romanian market for our international clients from all over the world. Nowadays we also assist Romanian small and medium-sized companies to protect their IP rights abroad. Our constant collaboration with companies all over the world has helped us establish a solid network of interconnected firms allowing us to ensure international representation for our domestic clients.

Our team of professionals includes Romanian and European patent, trademark and design attorneys having as primary specialisations engineering and law as well as technical specialists with a background allowing a broad area of technical coverage. We have a dynamic team which combines the experience of our senior patent and trademark attorneys with the enthusiasm of our newer employees.

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