

THE INTELLECTUAL
PROPERTY
REVIEW

TWELFTH EDITION

Editor
Dominick A Conde

THE LAWREVIEWS

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PREFACE

The reopening of borders, economic activity and many aspects of daily life over the past year brings a sense of a return to normalcy following the coronavirus pandemic shutdowns. At the same time, some of the changes made or accelerated in response to the pandemic, such as the increased prevalence of remote work and video proceedings in legal practice, seem likely to remain at least for the near future. While it will take time for all the ramifications to become clearer, the momentousness of the past few years' events is already evident. Those experiences have highlighted the world's interconnectedness and reliance on international trade, including both benefits and challenges.

Intellectual property laws and policy are often closely related to and affected by international trade and relations, in addition to domestic policy, meaning that practitioners have much to keep abreast of as those things continually evolve. The ongoing issue of trade relations between the United States and China, including as related to intellectual property protection, is just one example. Another is the way countries view intellectual property protection of new medicines and other medical advances in relation to the issues of medical innovation, healthcare costs and access. Intellectual property law and practice also must keep up with abounding technological advances. As just a few examples, courts are beginning to hear cases about trademarks in the metaverse, and practitioners are considering questions about intellectual property as related to generative artificial intelligence. Against this backdrop, practitioners must navigate a variety of legal systems and intellectual property laws in which many differences remain, despite some movements toward harmonisation.

To aid practitioners in the ever-changing environment of global intellectual property, we present the 12th edition of *The Intellectual Property Review*. In this edition, we present 18 chapters that provide an overview of the forms of intellectual property coverage available in each particular jurisdiction, along with an update on its most recent developments. Each chapter is written and assembled by leading practitioners in that jurisdiction. While all involved have striven to make this review both accurate and comprehensive, it is necessarily a summary and overview, and we strongly recommend that the reader seek the advice of experienced advisers for any specific intellectual property matter. Contact information for the authors of each chapter is provided at the end of this *Review*.

Dominick A Conde

Venable LLP

New York

April 2023

ROMANIA

*Raluca Vasilescu*¹

I FORMS OF INTELLECTUAL PROPERTY PROTECTION

Romania is a Member State of the European Union, thus all EU legislation is applicable directly.

The most important forms of intellectual property protection are patents, utility models – also known also as design patents – trademarks, designs, copyright, and regulatory exclusivity in some fields, such as pharmaceuticals, known as data exclusivity. They are dealt with briefly below, with reference to the national laws and international treaties.

i Patents

There are two types of patents depending on the way of filing the application: European patents and national patents.

Romania is a member of the European Patent Convention (EPC) but not yet a member of the European unitary patent.² European patents must be validated in Romania, and a full translation is required.

National patents can be filed either directly with the State Office of Patents and Trademarks (OSIM), or as a national phase of international applications filed with the International Bureau of the World Intellectual Property Organization under the Patent Cooperation Treaty (PCT).

Patent Law No. 64/1991, last amended in 2014, is harmonised in most of its aspects with the EPC.

Patent protection is granted for any inventions, in all fields of technology, provided that they are new, involve an inventive step and are susceptible to industrial application.³

Romania is a signatory to the Patent Prosecution Highway agreements.

There is a special law governing employee inventions, namely Law No. 83/2014 regarding employee inventions, last amended in 2014.

Full information regarding patents is given in Section III.

ii Utility models (design patents)

Utility models have a particular type of protection that has some resemblance to the protection of patents. Specifically, the format of the utility model is identical with the format of the patent: description, claims and drawings.

1 Raluca Vasilescu is a partner at Cabinet M Oproiu.

2 At the time of writing (January 2023).

3 Text of Article 52 (1) EPC.

The differences are as follows:

Two of the three basic conditions to obtain patent protection are applicable for utility models: novelty and industrial application. The third – inventive step of the patent protection – has been replaced with the criterion that the invention must exceed the framework of mere professional skill.

The examination is different. OSIM carries out a patent search with an opinion that is delivered to the applicant. The applicant can choose to amend the application, but he or she is not obliged to do so.

The object of protection is restricted to products, including systems in the case of computer-implemented inventions. Processes are excluded from protection as utility models.

The term of protection of utility models is shorter – a maximum of 10 years from the filing date.

PCT applications can be entered into in a national phase as utility models. However, an international application entered into in a national phase as a patent application can no longer be converted into a utility model application.⁴

Regular patent applications can be converted into utility model applications under certain conditions:⁵

- a* during the examination procedure of the patent application prior to the finalisation of the technical preparation for publishing a mention of the decision to grant the patent or of the decision to reject the patent application; and
- b* within a time limit of three months from the date on which OSIM publishes the mention of a final and irrevocable decision to reject the patent application as a consequence of lack of inventive step.

A utility model application can be converted into a patent application⁶ if the request is submitted before a decision is taken in respect to the utility model application. However, the conversion of a utility model application into a patent application shall not be permitted if the utility model application resulted from the conversion of a patent application.⁷

Conversion between the two types of protection – patent and, respectively, utility model – preserves the priority rights and the filing date.

iii Trademarks

The primary legislation governing trademarks in Romania is Law No. 84/1998 on Trademarks and Geographical Indications, last amended in 2022.

Being an EU Member State, Romania is part of the European trademark system. Romania is also a member of the Madrid Agreement and Protocol.

Law No. 84/1998 on Trademarks and Geographical Indications is fully harmonized with the European Trademark Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark, as a result of the transposing into national law of Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trademarks.

4 Article 6 (9) of the Implementing Regulation of Law No. 851/2007 of Utility Models.

5 Article 14 (1) of Law No. 851/2007 of Utility Models.

6 Article 15 (1) of Law No. 851/2007 of Utility Models.

7 Article 15 (3) of Law No. 851/2007 of Utility Models.

iv Designs

The primary legislation governing designs in Romania is Law No. 192/1992 regarding designs, last amended in 2014.

Being an EU Member State, Romania is part of Council Regulation (EC) No. 6/2002 of 12 December 2001 on Community designs, last amended in 2006, better known as the Community Design Regulation.

Law No. 192/1992 regarding designs is harmonised with the Community Design Regulation.

Basically, both laws confer protection to a design to the extent that it is new and has individual character.

v Copyright

Romania is a signatory to the Berne Convention for the Protection of Literary and Artistic Works.

There is a national law, namely Law No. 8/1996 regarding copyright and related rights, last amended in April 2022. Said national Law is harmonised with the Berne Convention.

vi Data exclusivity for pharmaceuticals

Being an EU Member State, all data exclusivity legislation is directly applicable according to Regulation (EC) No. 726/2004 of the European Parliament and of the Council of 31 March 2004, last amended in December 2006. Said Regulation deals with the time during which the marketing authorisation holder benefits from the exclusive rights to the results of preclinical tests and clinical trials on a medicine.⁸

II RECENT DEVELOPMENTS

Law No. 84/1998 on Trademarks and Geographical Indications was last amended in December 2022, the amendments entering in force on 15 January 2023. The main amendments are the following:

The application for renewal is to be submitted within a period of six months prior to the expiry of the renewal date, as compared with three months under the old Law.

Requests for the exhaustion of the owner from the rights conferred by a trademark and the requests for trademark cancellations may be heard in administrative proceedings before OSIM. This procedure is now an alternative option to the judicial procedure before the Municipal Court of Bucharest. Said requests submitted with OSIM shall be dealt by a specialised commission whose members shall hear only the exhaustion and, respectively, cancellation claims, without being involved in any other OSIM trademark proceedings.

In cases where a trademark is cancelled in administrative proceedings, the specialised commission shall not decide on the legality of the contracts that concern the cancelled trademark, it being necessary to lodge a separate lawsuit with the competent court of law in respect to said legality.

⁸ Source: <https://www.ema.europa.eu/en/glossary/data-exclusivity>.

III OBTAINING PROTECTION

i Types of claims

Patent claims generally fall into two categories: product claims and process claims, the latter alternatively called method claims.

A patent can have one or more one independent claims, the general rule being one independent claim in each category.⁹

ii Nature of protection and subject matter that can be protected

The provisions of Patent Law No. 64/1991, last amended in 2014 are identical to the ones written either in the EPC or in the Implementing Regulations of the EPC.

In the absence of published guidelines for examination of national applications, some examiners use the European Patent Office (EPO) guidelines.

The exceptions to protection are basically the ones provided in Articles 52 and 53 EPC.

Business methods

Business methods as such are not patentable, as the first hurdle of the technical character of the invention is not overcome. However, the technical means used for carrying out business methods may be patentable if they have technical character, and then all the patentability requirements are fulfilled.

Computer software

Computer software is not patentable as such if the computer program does not produce a 'further technical effect' when run on a computer, said further technical effect being defined by the Romanian Patent Office as a technical effect going beyond the 'normal' physical interactions between the program (software) and the computer (hardware) on which it is run.¹⁰

OSIM accepts the format already accepted by the EPO, namely patent applications referring to a method, apparatus, and computer software running on the apparatus.

Methods for treating patients, both with drugs and medical procedures

Methods of treating patients are specifically excluded from protection.¹¹

Swiss-type claims – 'Use of substance or composition S/C for the treatment of disease D . . .' – are not allowed.

Further medical use claims are accepted, provided that said further medical use is novel and inventive.

The Romanian Patent Office accepts the guidance of the EPO that the wording 'Product X for use as a medicament' [X known as, e.g., a herbicide] or, alternatively, 'Product according to claim 1 for use in the treatment of asthma',¹² is acceptable.

9 Rule 43 (2) Implementing Regulations to the EPC.

10 See EPO Guidelines part G Chapter II.3.6.

11 See Article 53 (c) EPC corresponding to Article 8 (1) (d) Romanian Patent Law No. 64/1991.

12 See EPO Guidelines Part G Chapter VI. 7.1.

Biotechnological inventions

Plant or animal varieties or essentially biological processes for the production of plants or animals are not patentable.¹³

The human body, at the various stages of its formation and development, and the simple discovery of one of its elements, including the sequence or partial sequence of a gene, cannot constitute patentable inventions, and is not patentable.¹⁴

However, biotechnological inventions are patentable, under certain conditions.¹⁵

iii Grant procedure

The grant procedure of national applications is very similar to the one of the EPO in terms of both formal requirements (content of the application, standard publication at 18 months) and substantive requirements (disclosure, examination procedure, search report, rules regarding prior art).

The main difference is that, in the case of national applications, OSIM verifies very strictly the documents showing the relationship of the inventors with the applicant when the applicant is other than the inventors.

Annuities in national procedure are also payable after grant, with the difference that the first two annuities are not zero, as the ones for European patent (EP) applications.

One good point to note is that OSIM does not require translation of any document (prior art or assignments) if said document is in English, French or German, being the result of a practice rather than of a legal provision.

IV ENFORCEMENT OF RIGHTS

i Possible venues for enforcement or revocation

In Romania, industrial property matters are considered to be part of the civil law, not commercial. The most important types of legal actions related to intellectual property rights are nullification (cancellation) claims and infringement claims. Under Romanian patent law, the term revocation designates a proceeding similar to the opposition under the EPC. Specifically, within six months from the date of publication of the decision to grant a patent, any interested party can submit with OSIM a request to revoke said decision to grant. Revocation is decided as an administrative procedure. The term nullification, alternatively called cancellation, refers herein to a request to nullify an IP right – patent – including a supplementary protection certificate, utility model, trademark or design.

Liability for inducing or contributing to patent infringement, if demonstrated by the plaintiff, is considered to be patent infringement.

Multiple parties can be jointly liable for infringement in theory. In practice, the infringing acts of each party must be individualised.

13 See Article 53 (1) (b) EPC corresponding to Article 8 (1) (b) Romanian Patent Law No. 64/1991.

14 See Article 52 and 53 EPC, Rule 29 Implementing Regulations to EPC, corresponding to Article 8 (1) (c) Romanian Patent Law No. 64/1991.

15 See Article 52 EPC, Rule 26, Rule 27 Implementing Regulations to EPC, corresponding to Article 6 (2) Romanian Patent Law No. 64/1991.

Venue for nullification claims

With the exception of trademarks, all nullification claims (patents, including supplementary protection certificates, utility models, designs) are heard by the Municipal Court of Bucharest as the court of first instance.

Trademark cancellations can be heard in first instance either by OSIM in administrative procedures, or by the Municipal Court of Bucharest in judicial procedures, the choice being made by the plaintiff. At the date of writing, preparations are being made for an administrative procedure at OSIM, this type of procedure being possible only as of 14 January 2023.¹⁶ Administrative proceedings may be cheaper than judicial proceedings and may be recommendable for simple cases. However, in cases where the cancelling of trademarks leads to judicial effects of contracts concluded based on said trademarks, it is better to choose cancellation by judicial proceedings, because OSIM has no competence regarding contractual matters.

Venue for infringement claims

The choice of court must follow the general rules with respect to competence. The general rule is that territorial jurisdiction is determined by the defendant's domicile or the place of infringement.

There is one notable exception: infringement of European trademarks is heard only by the Municipal Court of Bucharest.

ii Requirements for jurisdiction and venue

Plaintiffs choose whenever possible the Municipal Court of Bucharest for infringement claims, because this Court has three specialised IP divisions (the 3rd, the 4th and the 5th) hearing IP cases.

Yet another argument for choosing the Municipal Court of Bucharest as the venue is that, if the plaintiff submits a cancellation claim of the right based on which the infringement is lodged, said cancellation claim is mandatorily heard by the Municipal Court of Bucharest. Managing two different claims in two different courts is cumbersome.

In practice, if the plaintiff submits a cancellation claim in reply to the infringement claim, said infringement claim is usually stayed until a final decision is reached in the cancellation claim. There is no obligation to stay the proceedings; however, in most of the cases they are stayed.

The rule is that any interested party can sue. The interest is defined in the Code of Civil Procedure as being 'determinate, personal, legitimate, real and actual'.¹⁷ If the interest is not real and actual, that is, it refers to a probability that something will happen that can harm the plaintiff, said plaintiff is allowed to take action to prevent such harm.

iii Obtaining relevant evidence of infringement and discovery

The burden of proof for infringement cases is on the plaintiff. He or she must demonstrate the infringement using any type of evidence accepted by the judge.

16 See Section II.

17 Article 33 of the Code of Civil Procedure.

Documents are by far the most common type of evidence customary in patent infringement proceedings. Testimonies and cross-examination of witnesses are allowed but not very frequent.

The burden of proof for cancellation cases is on the plaintiff.

The types of evidence customary in patent cancellation proceedings are documents, testimonies and cross-examinations, in most cases the latter referring either to the inventor or to the employer, or both. Cross-examination is quite frequent if the inventor and the employer are Romanian.

The rule in both infringement and cancellation cases is that the parties suggest the types of evidence and the judge then decides whether to accept each type of evidence.

The US-type format of discovery is not applicable in Romania.

In cases of infringements lodged as a consequence of a customs action, the notifications and products seized by Customs may be used as evidence in court.

Details regarding technical expert reports¹⁸

In some cases, the court orders an expert report on technical matters. This applies to both infringement and cancellation cases.

Usually for this purpose, the court appoints an official court expert from a list maintained by the Bureau of Technical Experts. If no such expert exists, the court can appoint a specialist or a team of specialists from outside, for example, from universities.

The technical expert report is expected to shed light on particular technical aspects that are difficult to be understood by the judge.

iv Preliminary injunctions

There are two types of patent infringement civil lawsuit: permanent injunction claims and interim injunction claims. A permanent injunction claim can be lodged as a stand-alone trial, that is, without an interim injunction claim. An interim injunction claim must always be accompanied by a permanent injunction claim. Damages can be obtained only in permanent injunction claims.

An interim injunction is usually requested to prevent the defendant putting on the market products that are considered to infringe the patent of the plaintiff, including its supplementary protection certificate (SPC), if the validity of the patent has expired and the SPC is still valid.

An interim injunction can be obtained if the patent owner demonstrates urgency, the temporary character of the measures requested, and the appearance of a right, patent or SPC.

Urgency means that in the absence of granting an interim injunction, there is a great probability that the interests of the plaintiff will be harmed.

A temporary character, if granted, means that it is in force until a final decision is taken in the permanent injunction claim.

An appearance of right is demonstrated with a letter patent, certificate or SPC and with an excerpt of status from OSIM.

18 See Section V regarding trends.

An interim injunction can be granted within two to three months from its submission. Theoretically, it can be obtained in *ex parte* proceedings; however, most judges choose *inter partes* proceedings. The defendant can appeal the interim injunction and can suspend the interim injunction order.

An interim injunction still can be granted during a parallel cancellation proceeding against the patent or SPC on which the injunction is sought if the judge considers that the odds of success of the cancellation are low.

v Trial decision-maker

All matters are heard by one judge or, in some cases, by a panel of judges. Jury trials do not exist in Romania.

In some cases, the court orders an expert report on technical or account matters, or both, but the court is not bound by the result of the expert report.

vi Structure of the trial

A patent lawsuit – either infringement or cancellation – is submitted by the plaintiff to the competent court together with the evidence. Once the formal aspects are cleared, the writ is transmitted to the defendant, who has 25 days to submit a counter statement. Said counter statement is sent to the plaintiff, who can submit a reply.

Electronic court filing is available in some courts, such as the Municipal Court of Bucharest and the Bucharest Court of Appeal.

Once the exchange of documents is done, the court sets hearings, usually once every month. The initial hearings usually deal with the types of evidence suggested by the parties. At the last hearing, the pleadings take place. After the pleadings, in patent infringement cases the parties submit written conclusions. Usually, in patent infringement cases, judges deliver the operative part of the judgment within one to four weeks after the deadline of the written conclusions. Said operative part of the judgment is available online. The motivation of the decision is written two to four months after the ruling and handed to the parties by special courier.

If the defendant is a foreign company and has no known address for service in Romania, the plaintiff must submit a translation of the infringement writ in the language of the country where the defendant is domiciled. The court clerk sends the writ and the annexes in that country and waits for the official confirmation that the writ was served. This can take several months, and maybe even one year if the address provided is not correct.

vii Infringement

Patent infringement can be direct or by equivalence. There is a statutory provision in Patent Law No. 64/1991¹⁹ according to which, in order to determine the scope of protection conferred by the claims, any equivalent element shall be taken into account.

In practice, it is preferable to demonstrate direct infringement whenever possible. Infringement by equivalence is still difficult for judges to understand. The Protocol to Article 69 EPC is known to Romanian judges, but the practical way of assessing equivalence is still little known.

19 Article 31 (6) Patent Law No. 64/1991, last amended in 2014.

viii Defences

The most frequent defence of an alleged infringer defendant in a patent infringement case is to lodge a nullification claim against the patent or the SPC of the infringement claim.

Said nullification claim can be filed either as a counterclaim at the same court having the same deadline as the counter-statement, or as a separate claim.²⁰

Usually, all possible arguments for nullification are invoked. The alleged infringer must demonstrate that the patent does not satisfy at least one of the legal requirements: novelty, inventive step, industrial applicability or that the patent has added matter in respect to the application as filed. If the infringement concerns an SPC, the alleged infringer must demonstrate that the requirements to grant an SPC²¹ are not met.

Estoppel does not exist under Romanian law.

Laches are rarely invoked. One quite recent case is discussed below.²²

The legal ground of the claim was civil liability in tort. In 2003, the defendants Smithkline Beecham Limited (formerly Smithkline Beecham Limited) and GlaxoSmithKline LLC (formerly Smithkline Beecham Corporation) (GSK) requested and obtained an interim injunction order against LEK obliging LEK to stop the commercialisation of the Amokslav product until a decision was reached in the permanent injunction file relating to infringement of Romanian Patent 116343, obtained in 1995. LEK stopped at once the commercialisation of the product. Patent 116343, covering Augmentin for paediatric use, was cancelled following a cancellation request submitted by LEK, said cancellation remaining final and definitive in 2010 with retroactive effect from the date of deposit (1995). The main allegation in support of the civil liability in tort was that the defendants Smithkline Beecham Limited and GSK would have been aware that their patent would be vulnerable to cancellation due to the fact that the US application and the EP application deriving from the same international application would be 'equivalents' to the Romanian Patent, and the final fate of both the US application and the EP application was for them not to be valid patents.

The final decision in favour of the defendants was ruled on 13 November 2019 and in October 2020. According to the decision, civil liability was not demonstrated. LEK reimbursed the trial costs to GSK in 2021.

ix Time to first-level decision

In patent infringement cases and permanent injunction claims, the time to the decision of the court of first instance is between one year – in the absence of an expert report and in the absence of a patent cancellation claim by the defendant – and at least three years, most likely four to five, with an expert report and patent cancellation claim by the defendant. Remember that patent infringement is usually stayed during the trial in the patent cancellation claim.

In patent cancellation cases, the time to the decision of the court of first instance is between one year, in the absence of expert report, and between two and three years if a patent cancellation claim is lodged by the defendant.

20 See Section IV.ii regarding venue.

21 See Article 3 Regulation No. 469/2009 of the European Parliament and of the Council of 6 May 2009 concerning the supplementary protection certificate for medicinal products.

22 Prosecuted by Cabinet M Oproiu.

x Remedies

There are two types of monetary remedies: court trial costs and damages.

The general rule is that the parties must ask for the monetary remedies and submit evidence: the remedies are not awarded *ex officio*.

Court trial costs refer to the costs related to the lawyers, attorneys, experts and translators. If requested by the parties, they are included in the decision in the sense that the losing party is obliged to pay the winning party the amounts decided by the judge.

If the amount of court trial costs requested is considered to be reasonable, the judge can award this in its entirety, otherwise the judge may award less than initially requested.

Damages must refer to infringement acts that have occurred in the past three years from the date of lodging the court trial.

The value of damages sought must be demonstrated by the plaintiff. Usually, the method of lost profit is used, but other methods of calculation may be accepted. If the value requested is consistent and the infringer objects strongly, an expert report may be ordered by the court to a court expert in accounts matters to determine the value of the damages to be awarded.

In cases where the damages or trial costs (or both) awarded are not voluntarily paid by the losing party, a separate lawsuit must be filed to obtain them.

xi Appellate review

All decisions of the first instance courts are subject to appellate review. If the first instance court is the Municipal Court of Bucharest, the appellate court is the Bucharest Court of Appeal.

The appeal stage takes at least another year, in the absence of expert report, whereas around six months pass between the two phases. In some cases, a second expert report, drafted by another expert, is ordered by the judge of the appellate court.

A second appeal is possible in a reduced number of situations, and can concern only matters of law. The second appeal court is the Bucharest High Court of Cassation and Justice, in a system similar to the French system. In most cases, the High Court of Cassation and Justice quashes the decision of the appellate court and sends the case back either to the first instance court or to the appellate court.

xii Alternatives to litigation

Alternative dispute resolution methods are available, but rarely used.

The most frequently used alternative method is the settlement of the parties in the case of a pending lawsuit. In this case, the settlement must be filed with the court and its content is copied in the court decision.

V TRENDS AND OUTLOOK

A curious trend is developing in respect of expert reports for patent litigation.

As mentioned in Section IV.iii, in some cases, the court orders that an expert report is carried out on technical matters.

The trend is that the court is more and more inclined to shift to court-appointed experts matters of law that normally are in the competence of the court exclusively. This tendency is complementary to the tendency of many court-appointed experts, fuelled by the behaviour of some parties, to behave as judges.

To understand the tendency and its impact, we shall detail first the old practice before the arising said trend.

There are rules for drafting a technical expert, such as that the expert must set at least one meeting with all the parties where the parties must respond to the questions of the expert. Meeting by video-conference is accepted. Each of the parties (plaintiff, defendant) can appoint their own expert.

After the expert report is submitted, the parties can file objections to it. If the judge deems necessary, the expert is invited to amend the expert report, or another expert is appointed.

Under the old practice, all questions were answered during the meeting with all the parties and the court-appointed expert submitted his or her expert opinion directly to the court.

Under the new practice, either the court-appointed expert asks the parties to submit points of view after the meeting, or the parties submit them on their own motion. The result is the same: the court-appointed expert receives large documents from the parties containing the same kinds of reasons as the usual submissions to the court: in some cases, the documents from one party are communicated to the other party, who responds. Practically, the court-appointed expert is transformed in an unofficial judge. The expert opinions themselves contain assertions that exceed the competence of the expert, such as assessing whether the patent is novel or has an inventive step.

After the unhappy party submits objections to the expert report, in some cases, the court sends the list of objections to the court-appointed expert without having passed them through a filter and asks the court-appointed expert to respond to them. This puts the court-appointed expert in a moral dilemma: some of the objections of the parties contain wrong statements regarding the interpretation of the law. If the expert responds to them clarifying that the party erred in the interpretation of the law, the expert exceeds his or her competences, in our opinion. If the expert does not clarify that the party erred in the interpretation of the law, then maybe the judge will not see the error. Patent matters are extremely complex, and it is not rare to see judges fail to notice some errors in the interpretation of the law.

The practical consequence of the above is that, in some extreme cases, the court-appointed expert is the one who actually takes the decision, as the judge relies fully on his or her opinion and includes the expert's reasoning into the decision.

In our view, this trend is worrying.

First of all, laws and rules have to be respected. Matters of law are and must remain to be decided by the judge, while the role of the expert must be confined to shedding light on particular technical matters.

Secondly, it distorts the functioning of the profession. Some patent attorneys are enlisted with the Bureau of Technical Experts. They can acquire artificial value within the profession, which is not healthy.

In our view, this tendency could be reversed if judges take a strong stance on limiting the technical expert report to its original role. This can be done by revising carefully the questions suggested by the parties: currently, the questions are not revised at all; they are simply passed to the expert, with the objections of the parties being revised before being handed to the court-appointed expert.

