

# PATENTS

## Romania



# Patents

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Quick reference guide enabling side-by-side comparison of local insights into patent litigation and patent office procedures, including types of enforcement proceedings; trial format and timing; standards of proof; standing to sue; inducement / contributory infringement; infringement by foreign activities / by equivalents; discovery; litigation timetable and costs; appeals; scope and ownership of patents; alternative dispute resolution; defences of absolute novelty, obviousness, inventiveness or prior use; types of remedy; voluntary and compulsory licensing; patent office proceedings, including timetabling, costs, appeals, opposition, and modification / re-examination of patents; and recent trends.

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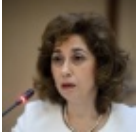
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## PATENT ENFORCEMENT PROCEEDINGS

### Lawsuits and courts

What legal or administrative proceedings are available for enforcing patent rights against an infringer? Are there specialised courts in which a patent infringement lawsuit can or must be brought?

In Romania, industrial property matters are considered to be part of civil law, not commercial. The most important types of legal actions that can be initiated against an infringer are civil patent infringement lawsuits and criminal actions against the infringer.

There is no specialised IP court in Romania. The Municipal Court of Bucharest has three sections that hear intellectual property matters. The judges of these sections are knowledgeable about patent matters.

Additionally, the Municipal Court of Bucharest is the sole court that can hear patent cancellation claims.

The choice of the court must follow the general rules with respect to competence. Territorial jurisdiction is determined by the defendant's domicile in civil proceedings and by the defendant's domicile or the place of infringement in criminal proceedings. Material competence may be conferred on the lower court or the court of law, depending on the value of the case.

Customs enforcement is also an option for patent owners to stop counterfeit products from entering Romanian territory. Customs authorities may act ex officio or based on an application for action. Customs actions usually end with a simplified procedure, which leads to the destruction of the counterfeited goods. If requested, customs' intervention may be followed by civil or criminal proceedings.

*Law stated - 11 January 2023*

### Trial format and timing

What is the format of a patent infringement trial?

There are two types of civil patent infringement lawsuit: a permanent injunction claim and an interim injunction claim. The permanent injunction claim can be lodged as a stand-alone trial. The interim injunction claim must be accompanied by the permanent injunction claim.

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

A civil patent infringement lawsuit 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 counterstatement.

Electronic court file 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. The initial hearings usually deal with the type of evidence suggested by the parties. The last hearing is when the pleadings take place. After the pleadings, in patent infringement cases the parties submit written conclusions. Usually in patent infringement cases, the judges deliver the operative part of the judgment one to four weeks after the deadline for the written conclusions. This operative part of the judgment is available on the website. The motivation of the decision is written two to four months after the ruling and is handed to the parties.

Documents are the customary type of evidence used in patent infringement proceedings. Testimonies and cross-examination of witnesses are allowed but are not very frequent. In some cases, the court orders an expert report.

Affidavits can be used but are not customary. The rule is that the parties suggest the type of evidence and the judge decides whether to accept it or not for each type of evidence.

In the absence of an expert report, the trial can take around 12 to 18 months at first instance. If an expert report is ordered by the court, the parties can challenge it, which leads to roughly an additional year.

In many cases, the defendant – that is, the infringer – lodges a request for cancellation of the patent based on which the infringement lawsuit started. In this case, the infringement is stayed until a final decision is taken in the cancellation case. The cancellation can take two to four years, including the appeal, depending on the existence of an expert report that is different from the possible expert report of the infringement lawsuit.

Expert reports in cancellation cases are more frequent than expert reports in infringement cases.

*Law stated - 11 January 2023*

## **Proof requirements**

**What are the burdens of proof for establishing infringement, invalidity and unenforceability of a patent?**

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.

Documents are the customary type of evidence used in patent infringement proceedings. Testimonies and cross-examination of witnesses are allowed but are not very frequent. In some cases, the court will order an expert report. Affidavits can be used but are not customary. The rule is that the parties suggest the type of evidence and the judge decides whether to accept it for each type of evidence.

The burden of proof for cancellation cases is on the defendant of the infringement case, who is plaintiff in this cancellation case. He or she must demonstrate that the patent does not satisfy at least one of the legal requirements: novelty, inventive step or no added matter from the application to the granted patent.

Types of evidence customary in patent cancellation proceedings: documents, testimonies and cross-examination (in most cases, the latter referring to the inventor). In some cases, the court will order an expert report. Affidavits can be used but are not customary. The rule is that the parties suggest the type of evidence and the judge decides whether to accept it for each type of evidence.

To date, there have been no cases of unenforceability of a patent.

*Law stated - 11 January 2023*

## **Standing to sue**

**Who may sue for patent infringement? Under what conditions can an accused infringer bring a lawsuit to obtain a judicial ruling or declaration on the accusation?**

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

The interest of the defendant is to convince the judge that the infringement claim is not grounded. Therefore, apart from the decision on the trial initiated by the plaintiff, the defendant has no other possibility to obtain another type of judicial ruling or declaration on the accusation. However, the defendant can sue the plaintiff accusing him or her of abuse with respect to the patent infringement case. In practice, court actions concerning a pretended abuse right are

rare, as the claimant would be expected to prove the bad faith of the plaintiff when initiating the lost trial. In this respect, the simple losing of the trial does not constitute an abuse of right of the plaintiff.

*Law stated - 11 January 2023*

### **Inducement, and contributory and multiple party infringement**

To what extent can someone be liable for inducing or contributing to patent infringement? Can multiple parties be jointly liable for infringement if each practises only some of the elements of a patent claim, but together they practise all the elements?

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

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

*Law stated - 11 January 2023*

### **Joinder of multiple defendants**

Can multiple parties be joined as defendants in the same lawsuit? If so, what are the requirements? Must all of the defendants be accused of infringing all of the same patents?

It is possible to join several defendants in the same lawsuit. In the majority of cases, in practice, several defendants are joined when they are part of the same group (eg, a foreign parent company and Romanian child company). This is common in pharmaceutical patent litigations.

Another situation is when the plaintiff is not sure which of the defendants is actually carrying out the infringing actions and sues several companies.

One lawsuit usually refers to the infringement of a single patent, unless the patents are related.

*Law stated - 11 January 2023*

### **Infringement by foreign activities**

To what extent can activities that take place outside the jurisdiction support a charge of patent infringement?

Infringing acts include the export and import of goods that infringe the patent as well as the offering for sale of these goods. Thus, if the activities that happen in a territory outside Romania are related to Romania (eg, the goods manufactured in Romania are offered for sale or exported to this territory outside Romania), they may support the charge of patent infringement.

*Law stated - 11 January 2023*

### **Infringement by equivalents**

To what extent can 'equivalents' of the claimed subject matter be shown to infringe?

Infringement can be direct or by equivalents. There is a statutory provision in the Patent Law, namely article 31 (6),



according to which, in order to determine the scope of protection conferred by the claims, any equivalent element shall be taken into account.

*Law stated - 11 January 2023*

### **Discovery of evidence**

What mechanisms are available for obtaining evidence from an opponent, from third parties or from outside the country for proving infringement, damages or invalidity?

In theory, Ordinance 100/2005 transposing Directive 2004/48/EC is applicable – see article 8 of Directive 2004/48/EC, according to which the competent judicial authorities may order that information on the origin and distribution networks of the goods or services that infringe an intellectual property right be provided by the infringer. Thus, this mechanism implies filing a court claim.

*Law stated - 11 January 2023*

### **Litigation timetable**

What is the typical timetable for a patent infringement lawsuit in the trial and appellate courts?

In the absence of an expert report, the trial can take around 12 to 18 months at first instance. If an expert report is ordered by the court, the parties can challenge it, which leads to roughly one additional year.

In many cases the defendant – that is, the infringer – lodges a request for cancellation of the patent based on which the infringement lawsuit started. In this case, the infringement is stayed until a final decision is taken in the cancellation case. The cancellation can take two to four years, including the appeal, depending on the existence of an expert report that is different from the possible expert report of the infringement lawsuit.

The trial in the appellate court takes around one year.

If the defendant is a foreign company and has no known address for service in Romania (such as the attorney of the record of the patent), 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 to that country and waits for official confirmation that the writ was served. This can take several months, or maybe a year if the address is not correct.

*Law stated - 11 January 2023*

### **Litigation costs**

What is the typical range of costs of a patent infringement lawsuit before trial, during trial and for an appeal? Are contingency fees permitted?

The costs of a patent infringement vary depending on the complexity of the case and on the lawyers or attorneys hired. The degree of variation is very high, therefore it is difficult to define a typical range.

In most patent infringement cases, contingency fees are not used, as the trial costs granted by the courts must be based on the filed evidence of their effective payment by the party. They are not prohibited by law and, theoretically, may be requested to be reimbursed through separate court claims after the infringement litigation is finally decided.

*Law stated - 11 January 2023*

## Court appeals

What avenues of appeal are available following an adverse decision in a patent infringement lawsuit? Is new evidence allowed at the appellate stage?

At the appeal stage, the parties can use both legal and factual arguments. New evidence is allowed at the appellate stage; however, only if this evidence was not available at first instance. In cases when an expert report is ordered by the court, the appellate court sometimes orders a new expert report to be carried out at the appeal stage.

*Law stated - 11 January 2023*

## Competition considerations

To what extent can enforcement of a patent expose the patent owner to liability for a competition violation, unfair competition or a business-related tort?

In principle, enforcement of a patent exposes the patent owner to competition violation, unfair competition business-related tort liability. Although rare, it is possible for the patent owner to be sued for such reasons, leading to a separate trial of a very difficult and complex nature. For example, in 2003, there was an interim injunction claim granted to the patent owner preventing the defendant from selling the products until the end of the permanent injunction proceedings; these permanent injunction proceedings ended in 2010 with the cancellation of the patent based on which the interim injunction was granted.

In 2013, the defendant of the interim injunction sued the patent owner for business-related tort because, allegedly, although the patent owner knew in 2003 that his patent was weak, he obtained the interim injunction preventing the defendant from selling his products until 2010. However, the plaintiff of the business-related tort trial failed to adduce evidence that he sold his products from 2011 when there was no obstacle and failed to explain why the patent owner 'knew' years before the date when the patent was cancelled that the patent was weak.

The trial ended in 2020 in favour of the patent owner, obliging the plaintiff of the business-related tort trial to pay court trial costs to the patent owner.

*Law stated - 11 January 2023*

## Alternative dispute resolution

To what extent are alternative dispute resolution techniques available to resolve patent disputes?

Alternative dispute resolution proceedings are also available in Romania. Usually, they refer to negotiations either before starting the trial or during the trial. If parties reach an agreement during the trial, the agreement is formally submitted with the court and included in the court decision.

*Law stated - 11 January 2023*

## SCOPE AND OWNERSHIP OF PATENTS

### Types of protectable inventions

Can a patent be obtained to cover any type of invention, including software, business methods and medical procedures?

National law is very similar to the European Patent Convention when it comes to substantive aspects. Software is not patentable as such, but it is possible to obtain computer-implemented patents involving the use of a computer, computer network or other programmable apparatus, where the invention has one or more features that are realised wholly or partly by means of a computer program.

In addition to defining a computer-implemented invention in terms of a method and a system, it is also possible to include, in the same application, claims that are directed to a computer program product, such as a computer program product including instructions for performing the method.

The basic patentability considerations in respect of claims for computer-implemented inventions are, in principle, the same as for other subject matters: being patentable only if they have technical character, are new and involve an inventive technical contribution to the prior art.

The technical character of a claim directed to computer-implemented inventions needs to provide a non-obvious technical solution to a technical problem for it to involve an inventive step; features that do not contribute to the technical character of the invention cannot support the presence of an inventive step.

For subject matter comprising a mixture of technical and non-technical features, the inventive step is assessed using the problem–solution approach, considering only features that contribute to the solution of the technical problem; this may include features that, when taken in isolation, are non-technical, if these features, in the context of the invention, contribute to producing a technical effect serving a technical purpose, contributing to the technical character of the invention, even if they are non-technical as such.

Business methods are not patentable as such; however, apparatus for these business methods may be protected if the general patentability criteria are respected.

Computer-implemented inventions are usually drafted as methods involving computers, computer networks or other conventional programmable apparatus, carrying out at least some steps of the method.

Medical procedures are not patentable as such; however, the apparatus for carrying out these medical procedures, and substances or compositions, for use in any of these methods are patentable.

In practice, many medical methods that are not patentable in a method claim format can still be patented by being converted into a purpose-limited product claim or a claim directed to the product itself.

*Law stated - 11 January 2023*

## Patent ownership

Who owns the patent on an invention made by a company employee, an independent contractor, multiple inventors or a joint venture? How is patent ownership officially recorded and transferred?

There has been an employee invention law in place since 2014. According to this law, if the invention is carried out by a company employee, the right to file the patent application belongs to the company. This is the case if the invention is created by the inventor during his or her activities on the basis of a form of contractual agreement with the employer, where the contractual agreement includes an 'inventive mission'; or if the invention is obtained during the term of employment that includes a period of up to two years after the termination thereof, using the knowledge and the experience of the employer, following the professional training of the employee who was paid and cared for by the employer.

In the case of an independent contractor, the right to file the patent application is according to the provisions of the contract between the independent contractor and the company.

The same applies to multiple inventors and joint ventures (that is, the provisions of the contract between them must be reflected in the right to file the patent application).

The patent ownership is usually officially recorded using the declaration of inventor forms between the parties, which must be signed in front of a notary public.

If the patent ownership is transferred, this transfer must take place in front of a notary public, who certifies the identity and the quality of the signatory parties.

*Law stated - 11 January 2023*

## DEFENCES

### Patent invalidity

How and on what grounds can the validity of a patent be challenged? Is there a special court or administrative tribunal in which to do this?

The Municipal Court of Bucharest is the sole court that can hear patent cancellation claims together with the Bucharest Court of Appeal.

The following invalidity (also called cancellation) grounds are stated in article 51 (1) of the Patent Law, referring to both national patents and European patents validated in Romania:

- the subject matter of the patent is not patentable: exceptions and exclusions to the patentable inventions;
- the subject matter of the patent is not patentable: there is lack of novelty, inventive step or industrial applicability;
- insufficiency of disclosure;
- the patent extends beyond the scope of the application (added matter); or
- the patent owner was not entitled to file the application.

*Law stated - 11 January 2023*

### Absolute novelty requirement

Is there an 'absolute novelty' requirement for patentability, and if so, are there any exceptions?

The exceptions to the novelty requirement are as follows:

- for substances or the compositions known, if the method of using these is not included in the prior art; and
- for all cases, if the disclosure is the result of an obvious abuse against the applicant or if the applicant exposed the invention in an international exhibition under the Paris Convention, the abuse or the exhibition taking place within a maximum period of six months before the date of filing.

*Law stated - 11 January 2023*

### Obviousness or inventiveness test

What is the legal standard for determining whether a patent is 'obvious' or 'inventive' in view of the prior art?

The invention has an inventive step if it is not obvious to a person skilled in the art.

The problem–solution approach as in the European Patent Convention is frequently used.

Prior art has at least one disadvantage that is acknowledged by the inventor. To overcome it, the inventor states a technical problem to be solved and then the claims supported by the description and drawings teach how the technical

problem is solved. If the way the technical problem is solved is not obvious to a person skilled in the art, the invention has an inventive step. The 'could-would' approach may be informally used (see the European Patent Office Guidelines for Examination, G-VII, 5.3).

*Law stated - 11 January 2023*

### **Patent unenforceability**

Are there any grounds on which an otherwise valid patent can be deemed unenforceable owing to misconduct by the inventors or the patent owner, or for some other reason?

There are no grounds on which an otherwise valid patent can be deemed unenforceable owing to misconduct by the inventors or the patent owner, or for some other reason.

*Law stated - 11 January 2023*

### **Prior user defence**

Is it a defence if an accused infringer has been privately using the accused method or device prior to the filing date or publication date of the patent? If so, does the defence cover all types of inventions? Is the defence limited to commercial uses?

An accused infringer who has been using the method or device in question privately and without any commercial purpose can continue to use this method or device privately and without any commercial purpose.

An accused infringer who has been using the accused method or device for experimental purposes and without any commercial purpose can continue to use this method or device for experimental purposes and without any commercial purpose.

An accused infringer who has been using the accused method or device as published or has taken serious measures for using this method or device independently from the patent owner before the filing date or the priority date, can continue to use the respective method or device in the same volume existing at the date of filing or the priority of the patent application.

An accused infringer who has been using the accused method or device or has taken serious measures for using this method or device during the time between the lapse of patent rights and the revalidation of the patent can continue to use the respective method or device in the same volume existing at the date of lapse.

The exemptions to the patent infringement define the acts that shall not constitute infringement of the right conferred by the patent:

- the use of the subject matter of the patented invention for exclusively non-commercial purposes; and
- prior user right, consisting in performing any acts considered as exclusive proprietor's exclusive right, by a person who applied the subject matter of the patent or that of the patent application, as published, or has taken effective steps for producing or exploiting this subject matter in good faith in the territory of Romania, independently of the patent owner, before the regular national patent filing or the recognised priority date; in that case, the invention may continue to be exploited by that person to the same extent as on the date of filing the patent application, but the right of use may not be transferred otherwise than with the assets of that person or part of those assets assigned to the exploitation of the invention.

*Law stated - 11 January 2023*

## REMEDIES

### Monetary remedies for infringement

What monetary remedies are available against a patent infringer? When do damages start to accrue? Do damage awards tend to be nominal, provide fair compensation or be punitive in nature? How are royalties calculated?

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 must submit evidence. The remedies are not awarded ex officio.

Court trial costs refer to the costs related to the lawyers, attorneys, experts and translators.

Damages can be calculated using various formulas. Usually, they refer to the lost profits of the plaintiff. Royalties, although permitted, are not customary.

Monetary remedies are available in the permanent injunction claim.

*Law stated - 11 January 2023*

### Injunctions against infringement

To what extent is it possible to obtain a temporary injunction or a final injunction against future infringement? Is an injunction effective against the infringer's suppliers or customers?

It is possible to obtain an interim injunction if the patent owner demonstrates the urgency and temporary character of the measures requested.

An interim injunction must be accompanied by a permanent injunction claim, usually lodged on the same day with the court.

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

An interim injunction may be effective against the infringer's suppliers or customers.

*Law stated - 11 January 2023*

### Banning importation of infringing products

To what extent is it possible to block the importation of infringing products into the country? Is there a specific tribunal or proceeding available to accomplish this?

It is possible to obtain an interim injunction if the patent owner demonstrates the urgency and temporary character of the measures requested.

An interim injunction must be accompanied by a permanent injunction claim, usually lodged on the same day with the court.

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

Importation of infringing products is one of the infringing acts. A block on importing the said products can be

requested and awarded in both the interim and permanent injunction claim.

The decision to ban can be then communicated to the customs authorities to enforce it.

*Law stated - 11 January 2023*

## **Attorneys' fees**

### **Under what conditions can a successful litigant recover costs and attorneys' fees?**

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 must 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 requested amount of court trial costs is considered reasonable, the judge can award it in its entirety; otherwise, the judge may award less than initially requested.

*Law stated - 11 January 2023*

## **Wilful infringement**

### **Are additional remedies available against a deliberate or wilful infringer? If so, what is the test or standard to determine whether the infringement is deliberate? Are opinions of counsel used as a defence to a charge of wilful infringement?**

Proving deliberate or wilful infringement usually increases the chances of the injunction being granted, be it an interim or a permanent injunction.

There is no special test for deliberate or wilful infringement. It should stem from the evidence, usually documents, although cross-examination and testimonies are also allowed.

Opinions of counsel are not considered differently in the deliberate or wilful infringement with respect to all the other submissions.

*Law stated - 11 January 2023*

## **Time limits for lawsuits**

### **What is the time limit for seeking a remedy for patent infringement?**

There is no time limit for seeking a remedy, namely, a permanent injunction against the infringer prohibiting him or her from carrying out the infringing acts.

However, if the claim concerns infringement acts known to the plaintiff for more than three years prior to the lodging of this claim, the court might consider that the interest of the claimant is not in the present, and this might lead to an irregularity of the claim and its further possible rejection on the ground of lack of interest.

In addition, damages must refer to infringement acts that have occurred in the three years prior to the date of lodging the court trial.

*Law stated - 11 January 2023*

### **Patent marking**

Must a patent holder mark its patented products? If so, how must the marking be made? What are the consequences of failure to mark? What are the consequences of false patent marking?

The marking of patented products is not mandatory. False patent marking falls under the false declarations category and can be punished as such by criminal or civil laws.

*Law stated - 11 January 2023*

## **LICENSING**

### **Voluntary licensing**

Are there any restrictions on the contractual terms by which a patent owner may license a patent?

There are no restrictions on the contractual terms by which a patent owner may license a patent.

*Law stated - 11 January 2023*

### **Compulsory licences**

Are any mechanisms available to obtain a compulsory licence to a patent? How are the terms of such a licence determined?

Compulsory licences to a patent are granted only by the Municipal Court of Bucharest, and they are not exclusive. Compulsory licences can be awarded in one of the following situations:

- if the patent was not used or insufficiently used on Romanian territory and the owner does not have justified reasons for that;
- in a national emergency; or
- in situations of public use for non-commercial purposes.

The Court shall determine their duration, their scope and the royalty to the patent owner.

*Law stated - 11 January 2023*

## **PATENT OFFICE PROCEEDINGS**

### **Patenting timetable and costs**

How long does it typically take, and how much does it typically cost, to obtain a patent?

National patents can be typically obtained in three to five years depending on the technological field. More time is needed for inventions in the field of electronics because of the chronic lack of patent examiners in that field.

Costs typically range from €2,000 to €5,000.

*Law stated - 11 January 2023*



## Expedited patent prosecution

### Are there any procedures to expedite patent prosecution?

Expedited examination can be requested for an extra fee.

The Patent Prosecution Highway (PPH) is available. Romania has commenced bilateral PPH programmes with the United States, Japan and Moldova.

The programmes allow patent applicants whose applications have been determined as patentable by the United States Patent and Trademark Office, Japan Patent Office or Moldavian Patent Office to use a simple procedure to request an accelerated examination of the corresponding applications in the Romanian Patent Office (RPTO).

The RPTO will still conduct its own search and examination, and will independently consider whether the application meets the requirements of patentability under the national legal provisions. The PPH request does not, therefore, guarantee allowance, and the RPTO examiner will also consider whether the claims meet the requirements of novelty, inventive step, support, clarity and enablement in accordance with RPTO practice.

*Law stated - 11 January 2023*

## Patent application contents

### What must be disclosed or described about the invention in a patent application? Are there any particular guidelines that should be followed or pitfalls to avoid in deciding what to include in the application?

The disclosure of the invention should be sufficient to allow a person skilled in the art to realise the invention. The guidelines of the European Patent Office are informally used by patent examiners and should be taken into account by applicants, because the RPTO recognises them, as the national patent law is harmonised with the European Patent Convention.

*Law stated - 11 January 2023*

## Prior art disclosure obligations

### Must an inventor disclose prior art to the patent office examiner?

Prior art must be disclosed; however, it is not mandatory to quote patent or non-patent literature. The applicant can disclose the prior art as known to him or her from his or her own observation.

*Law stated - 11 January 2023*

## Pursuit of additional claims

### May a patent applicant file one or more later applications to pursue additional claims to an invention disclosed in its earlier-filed application? If so, what are the applicable requirements or limitations?

The system of continuation applications is not used under Romanian patent law. A later application must deal with another matter. The sole exception is divisional applications, if the examiner finds that the initial application is not unitary.

## Patent office appeals

Is it possible to appeal an adverse decision by the patent office in a court of law?

An adverse decision by the RPTO in the examination – namely, the rejection of the application – is first appealed to the board of appeal of the RPTO as the court of first instance. The decision of the RPTO can be further appealed to the Municipal Court of Bucharest.

Law stated - 11 January 2023

## Oppositions or protests to patents

Does the patent office provide any mechanism for opposing the grant of a patent?

The mention of the grant of a patent is published in the official bulletin. The procedure of opposing the grant is called 'revocation of the patent', and it is heard by the board of appeal of the RPTO as the court of first instance. The decision of the RPTO can be further appealed to the Municipal Court of Bucharest.

Law stated - 11 January 2023

## Priority of invention

Does the patent office provide any mechanism for resolving priority disputes between different applicants for the same invention? What factors determine who has priority?

The date of the application determines who has priority, based on the first-to-file principle.

Should two patent applications with the same effective date be received from two different applicants, each must be allowed to proceed as if the other did not exist.

Law stated - 11 January 2023

## Modification and re-examination of patents

Does the patent office provide procedures for modifying, re-examining or revoking a patent? May a court amend the patent claims during a lawsuit?

The mention of the grant of a patent is published in the official bulletin. The procedure of opposing the grant (the revocation of the patent) is heard by the board of appeal of the RPTO as the court of first instance. The decision of the RPTO can be further appealed to the Municipal Court of Bucharest.

After the grant of the patent, in the absence of the opposition (the revocation of the patent), or if this revocation of the patent ends favourably for the patent owner, there are two types of actions possible:

- the patent owner can renounce the patent in its entirety or partially. The renunciation is an administrative procedure carried out by means of a declaration formally submitted by the patent owner to the RPTO; or
- any interested third party can request that the Municipal Court of Bucharest cancel the patent.

The Municipal Court of Bucharest is the sole court that can hear patent cancellation claims together with the Bucharest Court of Appeal.

The following invalidity (also called cancellation) grounds are stated in article 51 (1) of the Patent Law, referring to both national patents and European patents validated in Romania:

- the subject matter of the patent is not patentable: exceptions and exclusions to the patentable inventions;
- the subject matter of the patent is not patentable: there is lack of novelty, inventive step or industrial applicability;
- insufficiency of disclosure;
- the patent extends beyond the scope of the application (added matter); or
- the patent owner was not entitled to file the application.

*Law stated - 11 January 2023*

## Patent duration

### How is the duration of patent protection determined?

The duration of patent protection is 20 years from the date of deposit, if the payment of the annuities is made each year before the anniversary date of the patent. Annuities are not due before the patent is granted.

*Law stated - 11 January 2023*

## UPDATE AND TRENDS

### Key developments of the past year

#### What are the most significant developing or emerging trends in the country's patent law?

The Patent Law was last updated in 2014 when a special law regarding employees' inventions was enacted.

On substantive matters, the last update of the Law was in 2008. Fortunately, the Patent Office de facto applies many of the examination guidelines of the European Patent Office, which compensates for the lack of amendments to the Law.

*Law stated - 11 January 2023*

## Jurisdictions

|   |                    |   |
|---|--------------------|---|
|    | <b>Australia</b>   | Griffith Hack                                     |
|    | <b>Austria</b>     | Barger Piso & Partner                             |
|    | <b>Brazil</b>      | Bhering Advogados                                 |
|    | <b>Canada</b>      | Gilbert's LLP                                     |
|    | <b>Chile</b>       | SCR Abogados                                      |
|    | <b>China</b>       | Baker McKenzie                                    |
|    | <b>Colombia</b>    | OlarteMoure                                       |
|    | <b>Denmark</b>     | Accura Advokatpartnerselskab                      |
|    | <b>El Salvador</b> | Mayora & Mayora                                   |
|    | <b>France</b>      | Aramis Law Firm                                   |
|   | <b>Germany</b>     | Meissner Bolte                                    |
|  | <b>Greece</b>      | Dr Helen G Papaconstantinou and Partners Law Firm |
|  | <b>Guatemala</b>   | Mayora IP SA                                      |
|  | <b>Honduras</b>    | Mayora IP SA                                      |
|  | <b>Hungary</b>     | Germus & Partners                                 |
|  | <b>India</b>       | Anand and Anand                                   |
|  | <b>Israel</b>      | S Horowitz & Co                                   |
|  | <b>Italy</b>       | Studio Legale Jacobacci & Associati               |
|  | <b>Japan</b>       | Anderson Mōri & Tomotsune                         |
|  | <b>Kazakhstan</b>  | PETOŠEVIĆ   |
|  | <b>New Zealand</b> | Griffith Hack                                     |
|  | <b>Philippines</b> | Hechanova Group                                   |
|  | <b>Portugal</b>    | VdA   |
|  | <b>Romania</b>     | Cabinet M Oproiu Patent & Trademark Attorneys     |
|  | <b>Singapore</b>   | Drew & Napier LLC                                 |

|   |                       |  |
|---|-----------------------|--|
|  | <b>South Korea</b>    | Lee International IP & Law             |
|  | <b>Taiwan</b>         | Formosa Transnational Attorneys at Law |
|  | <b>Turkey</b>         | Moroğlu Arseven                        |
|  | <b>Ukraine</b>        | PETOŠEVIĆ                              |
|  | <b>United Kingdom</b> | AA Thornton IP LLP                     |
|  | <b>USA</b>            | Jenner & Block LLP                     |
|  | <b>Uzbekistan</b>     | PETOŠEVIĆ                              |
|  | <b>Vietnam</b>        | Pham & Associates                      |