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Romania

Ana-Maria Baciuc



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1 Patent Enforcement

1.1 Before what tribunals can a patent be enforced against an infringer? Is there a choice between tribunals and what would influence a claimant's choice?

The Romanian court system is hierarchically organised as follows: First Instance Courts; Tribunals; Courts of Appeal; and the High Court of Cassation and Justice.

In case of an infringement, depending on the claim value, the material competence belongs to the First Instance Courts (claims with a value lower than €45,000) or Tribunals (claims over €45,000). The owner or the licensee has a choice between the courts of the region where his own headquarters are located, the infringer's location, the place where the infringing acts occurred, or where the damages are produced.

1.2 What has to be done to commence proceedings, what court fees have to be paid and how long does it generally take for proceedings to reach trial from commencement?

The claim has to be filed together with all supporting evidence. The stamp duty is less than €100 and a first hearing is usually established within one month from the claim's registration. If the claimant is seeking damages, a stamp duty calculated based on the claim value is due.

1.3 Can a party be compelled to disclose relevant documents or materials to its adversary either before or after commencing proceedings, and if so, how?

Procedural law provides the cases for when disclosure of certain documents held by the defendant is allowed. A disclosure order is usually issued, during the trial, by the panel solving the merits of the case.

1.4 What are the steps each party must take pre-trial? Is any technical evidence produced, and if so, how?

A cease and desist letter is common practice but not mandatory. Pre-trial, the owner should collect the written evidence in support of its infringement claim. It is not mandatory, but it is advisable that the claimant produce an *ex parte* expert report on the existence and/or the extent of the infringement. The court may, upon request of

either of the parties, order an expert report to be prepared by court-appointed experts.

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

Modifications to the claim are allowed up until the first hearing. Arguments and evidence are presented in writing and in oral pleadings.

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

The ordinary course of proceedings takes one to four years before the issuance of a definitive solution. The judge should issue a reasoning of the judgment within 30 days upon the announcement of the latter.

1.7 Are judgments made available to the public? If not as a matter of course, can third parties request copies of the judgment?

The reasoning of the judgment is not publicly available, but its dispositive part is published on the court's website.

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

Patent disputes are solved by judges specialised in intellectual property matters. However, although they are not required to have a technical background, some do.

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

The interest of the claimant must be qualified as: (i) direct; (ii) born; (iii) present; or (iv) personal:

- (a) **Infringement:** The claimant must produce evidence that it is either the patent-owner or the exclusive licensee or, if it has a nonexclusive licence, that it has the consent and/or acts together with the patent-owner. Also, it must show the particulars on how the patent infringement is affecting its own rights.

- (b) Revocation: The patent law uses the expression “any person”, which implies that the claim has an objective nature. However, the procedural law requires that any claimant must show a characterised interest.
- (c) Declaratory proceedings are not available.

1.10 If declarations are available, can they address (i) non-infringement, and/or (ii) claim coverage over a technical standard or hypothetical activity?

This is not applicable in Romania.

1.11 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 law defines infringement restrictively (*direct infringement*), but provides the same sanctions and measures (such as confiscation, destruction, etc.) against an indirect infringer.

1.12 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, a party can be held liable for such.

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

The law provides for both literal infringement and infringement by equivalents. An element is deemed as equivalent to an element specified in the claims if, for a person skilled in the art, it is obvious that by using it, essentially the same result is obtained.

1.14 Can a defence of patent invalidity be raised, and if so, how? Are there restrictions on such a defence e.g. where there is a pending opposition?

Yes, it can be raised by way of a counterclaim together with the statement of defence in advance of the first hearing. No, an invalidity action can be filed irrespective of pending opposition proceedings.

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

In addition to a lack of novelty and inventive step, a patent can be invalidated where the subject matter of the patent is not considered an invention, is excluded from patentability, has no industrial application, does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art, for added subject matter, inadmissible extension or the patent-owner is not the person entitled to the grant of the patent.

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

The court may decide to stay the infringement until the invalidity claim or the opposition decision is final.

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

The grounds for defence vary depending on the factual context, and include statute of limitation, exhaustion of rights, prior use rights, existence of a licence, experimental use, etc.

1.18 Are (i) preliminary, and (ii) final injunctions available, and if so, on what basis in each case? Is there a requirement for a bond?

Preliminary injunctions are available temporarily, in urgent cases, for preventing an imminent and irremediable damage or the loss of a certain right that could be damaged by delay. If launched before the infringement claim, the court may order the main claim to be launched within a very short deadline after the PI's granting. Failure to observe the deadline results in the loss of the temporary measure. The court may also condition the issuance of the PI on the payment of a bond.

Romanian law does not recognise final injunctions.

1.19 On what basis are damages or an account of profits assessed?

The claimant must produce its own calculations and proofs of the damage; however, the courts are currently ordering accounting expertise reports to be produced by court-appointed experts. There are several methods for assessing the damage and certain legal criteria to be followed by courts and experts, such as the determination of the actual financial loss incurred by the grieving party, the unjust benefits realised by the infringer, the value of the licence rights, etc.

1.20 How are orders of the court enforced (whether they be for an injunction, an award of damages or for any other relief)?

Court decisions are enforced by recourse to a judicial bailiff. Usually, the judicial bailiff will serve the infringer a notice to comply. In the case of injunctions, upon the claimant's request, the court may order enforcement of the decision without any notice or delay. Procedural law provides that the bailiff may use several means such as an attachment of the movable assets, a garnishment of the infringers' bank accounts, etc.

1.21 What other form of relief can be obtained for patent infringement? Would the tribunal consider granting cross-border relief?

The measures against infringement include the destruction of the infringing products, their confiscation, the seizure of these and of materials and machines used for producing them, their withdrawal from the distribution channels, blocking of the accounts of the infringer, etc. Romanian law also considers infringing activity a criminal offence.

1.22 How common is settlement of infringement proceedings prior to trial?

Settlement before the launching of the infringement claim is not common, though not excluded.

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

The limitation period is normally three years starting from the moment the claimant has knowledge about the damage and the person infringing the patent. This period is interrupted by filing a civil action. However, there is no unitary jurisprudence on this topic.

1.24 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?

A decision issued by a Tribunal may be challenged before the Court of Appeal, both on the case's legal and factual aspects. The Court of Appeal's decision may be challenged before the High Court of Cassation and Justice, but only on its legal aspects.

1.25 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?

The stamp duty is fixed depending on legal criteria: i) there is a fixed fee of less than €100 for infringement and invalidity; and ii) calculated based on the value of the claim for damages claims.

The court fees, stamp duty and expert fees are recovered in full. The judges may reduce the attorney fees.

1.26 For jurisdictions within the European Union: What steps are being taken in your jurisdiction towards ratifying the Agreement on a Unified Patent Court, implementing the Unitary Patent Regulation (EU Regulation No. 1257/2012) and preparing for the unitary patent package? For jurisdictions outside of the European Union: Are there any mutual recognition of judgments arrangements relating to patents, whether formal or informal, that apply in your jurisdiction?

This is not applicable in Romania.

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

Yes. The making of amendments to national patents, known as the limitation procedure, with the view to reducing the scope of the patent, can be made before the Romanian Patent Office within three months after the grant date.

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

Yes. Romanian Patent Law allows the amendment of a patent both in revocation proceedings before the Romanian Patent Office, as well as in invalidity proceedings before the national courts.

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

Yes. The amended claims should have support in the patent's description and they cannot be broader than the initial claims.

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

No. As a general rule, the patent licence terms are subject to the general terms and conditions set out in the Civil Code. Also, there may be limitations stipulated by competition and antitrust law.

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?

The grounds for granting a compulsory licence include: insufficient exploitation of the patent; national emergency cases; other cases of extreme emergency; and cases of public use for non-commercial purposes.

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?**

As an exception, the term of a patent can be extended only for patented medicinal products or for plant protection products, for which a supplementary protection certificate (SPC) may be granted under Regulation (EC) no. 469/2009, Regulation (EC) no. 1610/96 and Regulation (EC) no. 1901/2006. It extends the term of the patent for up to a maximum of five years and an additional six months in case of paediatric medicines.

5 Patent Prosecution and Opposition**5.1 Are all types of subject matter patentable, and if not, what types are excluded?**

A patent shall be granted for virtually any invention having as its subject matter a product or process, in all technological fields. However, the following are not considered inventions:

- discoveries, scientific theories and mathematical methods;
- aesthetic creation;
- schemes, rules and methods for performing mental acts, playing games or doing business, as well as computer programs; and
- presentation of information.

Also, a patent shall not be granted for inventions:

- considered against public morals, harmful to health or life;
- which are plant varieties and animal breeds;
- having as a subject matter the human body, as well as the mere discovery of one of its elements, including the sequence or partial sequence of a gene; and
- which are methods of treatment concerning the human or animal body, by surgery or therapy and diagnostic methods.

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 such duty.

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?

Yes. Any interested person may lodge a request for the revocation of a patent within six months from 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?

Yes. The decisions of the Romanian Patent Office (of the Board of Appeal) shall be appealed before the Bucharest Tribunal within 30 days from their communication. The decisions of the Bucharest Tribunal may be challenged only before the Bucharest Court of Appeal.

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

Disputes concerning the status of an inventor, patent-owner or other rights arising from the patent, including the economic rights of the inventor under assignment or licence contracts, shall fall within the jurisdiction of the courts of law.

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

There is no such grace period.

5.7 What is the term of a patent?

The term of a patent is 20 years from the date of filing the application. The term can be extended under certain conditions – see the answer to question 4.1.

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?

EU Regulation 608/2013 of the European Parliament and of the Council concerning customs enforcement of intellectual property rights applies. A decision granting or rejecting an application is taken within 30 working days.

7 Antitrust Law and Inequitable Conduct

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

Antitrust law, as provided under EU Regulations, Directives and Article 102 TFEU is applied by national courts in accordance with the CJEU’s case-law.

Consequently, following the *Huawei Technologies Co. v. ZTE Corp.* (Case C-170/13) judgment, the Bucharest Court of Appeal, although indirectly, took into consideration the criteria set out in the latter judgment in *Vringo v. ZTE*. The case regarded ZTE’s request that the courts revoke a preliminary injunction Vringo had obtained against ZTE relating to a standard-essential patent, which remained in effect.

The national courts give thorough consideration to every reason held by the CJEU in its decisions regarding this subject and, thus, will take into account the CJEU’s case-law that the exercise of an exclusive right linked to an intellectual property right by the proprietor may, in exceptional circumstances, involve abusive conduct for the purposes of Article 102 TFEU.

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

Domestic law does not provide for any express limitation on patent licensing due to antitrust law. Nevertheless, the patent law sets out the right of a competitor to submit in front of the Bucharest Tribunal a request for a compulsory licence. Thus, the Tribunal is empowered to issue a compulsory licence in order to put an end to a practice which alters the competition on the market. In this case, other conditions provided for a regular compulsory licence such as (i) failure to agree on the conditions of the licence, or (ii) the granting of compulsory licences in cases of emergency or public utility do not apply. We may therefore say that, in an implicit manner, the right of exclusive use/exploitation is limited by antitrust good practices. Moreover, EU Regulation 316/2014 providing for the exclusion of pricing restrictions and limiting production is directly applicable in front of the national courts.

8 Current Developments

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

Romania signed the Protocol for the Provisional Application of the Unified Patent Court Agreement on September 14, 2016 and is in the process of finalising the draft law on the ratification of the Agreement on the Unified Patent Court, opened for signature and signed by Romania in Brussels on February 19, 2013, and the ratification of the Protocol on the Provisional Application of the Unified Court Agreement Patents, opened for signature on October 1, 2015 and signed by Romania in Brussels on September 14, 2016.

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

The most important subject is the possibility of the legal implementation of the Unified Patent Court with or without the United Kingdom. Depending on the evolution of the Unitary Patent system, Romania will finalise the draft law in order to ratify the Unified Patent Court Agreement.

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

At present, there is an upward trend in Romania of the submission of IT&C patent applications and we expect an increased volume of litigation in the telecommunication sector.

Also, with the awareness of the economic potential of a patent, the number of requests for assistance in the field of employees' inventions has registered a slight increase.

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- recommended individual in *IAM Patent 1000*;
- gold recommended individual in *WTR1000*;
- ranked in Band 1 as a Leading Individual in IP in *Chambers Europe*; and
- ranked in Tier 1 as a Leading Individual in IP in *The Legal 500 EMEA*.



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