

**IMPLEMENTING REGULATIONS  
TO  
THE PATENT LAW NO. 64/1991  
as republished**

**CHAPTER I  
Filing Procedure of the Patent Applications**

**SECTION 1  
General Provisions**

**ARTICLE 1  
Invention protection by patent**

The patents shall be granted according to the provisions of the Patent Law no.64/1991, as republished, by meeting the provisions of the conventions, treaties and agreements to which Romania is a party.

**ARTICLE 2  
Definitions**

(1) For the purposes of these Regulations, the terms and phrases below shall mean as follows:

- a) *law* - Patent Law no. 64/1991, as republished;
- b) *International Bureau* - the International Bureau of the World Intellectual Property Organization;
- c) *BOPI* - the Official Industrial Property Bulletin- Invention Section;
- d) *Strasbourg Agreement* - the Strasbourg Agreement concerning the International Patent Classification of 20 March 1971, amended on 28 September 1979, to which Romania adhered by the Law no. 3/1998, published in the Official Gazette of Romania, Part I, no. 10 of 14 January 1998;

e) Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure, signed on 28 April 1977 and modified on 26 September 1980, to which Romania adhered by the Law no. 75/1999;

f) *Patent Cooperation Treaty* - the Patent Cooperation Treaty adopted at the Diplomatic Conference in Washington on 19 June 1970, ratified by Romania through the decree no. 81/1979.

g) state examiner in the industrial property field - the specialist within the State Office for Inventions and Trademarks, hereinafter named OSIM, having as basic attribution to examine the applications for the grant of the protection titles.

(2) For the purposes of the present Implementing Regulations the terms and phrases defined in the law have the same meaning.

### ARTICLE 3

#### **Time limits**

(1) The time limits shall be expressed in days, months or years.

(2) The time limit expressed in days shall not contain either the day when the period started or the day when the period ended.

(3) The time limit expressed in months or years, shall expire in the relevant subsequent day of the month or year corresponding to the starting day.

(4) The time limit starting on the dates of 29, 30 or 31 of the month and expiring in a month not having a day with the same number shall be deemed to end on the last day of the month; the time limit which expires on a statutory holiday or when the office is closed for the public shall be extended until the end of the first working day that follows.

5) The time limit for the response granted in the OSIM notifications sent by mail shall be calculated starting with the eighth day of communication, considered as being the date when the notification reached the recipient.

(6) Where the interested person brings evidence that the OSIM document was received after more than 8 days of the date of communication, the time limit under paragraph (5) shall

be extended by the duration of the delay, but not more than three months.

(7) The communications sent by mail to OSIM shall be deemed to have been received in due time, provided that they were handed over to the post office before the date when the time limit has ended.

(8) The extension of a time limit granted by OSIM pursuant to Art. 27 paragraph (2) of the Law shall be accepted provided that the following conditions are fulfilled cumulatively:

a) by a written request signed by the applicant or patent owner, and transmitted, where appropriate, by the professional representative, there is justifiedly demanded, before the expiration of the time limit, the extension thereof by at least 2 months;

b) the proof of payment of the legal fee is submitted at the time of filing the application with OSIM.

(9) OSIM shall notify the applicant, patent owner or the professional representative thereof the acceptance or rejection of the request for the extension of the time limit.

(10) The request for the extension of the time limit, according to paragraph (8) cannot be rejected before having notified the applicant, patent owner or the professional representative, as the case may be, the reasons of rejection and before granting the same a maximum two-month period for sending the observations.

## SECTION 2

### **Patent Application Filing**

#### ARTICLE 4

### **Filing the patent application**

(1) Filing a patent application may be performed by any person:

a) on paper carrier directly to the General Registry of OSIM or by mail, or;

b) by electronic means, while observing the provisions of Art. 5.

(2) OSIM shall mark , on the application, the date of filing, the filing number and the name of the person who made the filing and confirm to the applicant the receipt of the application filed pursuant to paragraph (1) and the received documents; a copy of the filled

in application form shall be returned, on paper carrier, to the applicant or to the professional representative, as the case may be.

(3) The patent applications belonging to the field of the national defense and security, that have been created within the territory of Romania, shall be filed by observing the provisions of the special law and according to Art. 7.

(4) The patent application is allotted a number and a filing date, provided that the provisions of Art. 15 paragraph (1) of the Law or Art. 15 paragraph (1) or (8) of the Law are fulfilled; the number allotted successively and the filing date are entered in the National Register of the filed patent applications and both are written down on the patent application form and on each page of the description as well as of the claims and drawings, even if they are filed subsequently.

(5) The number in the National Register of Filed Patent Applications shall be used in all OSIM notifications and in the communications of the applicant or of the interested person, in connection with the procedures the patent application undergoes.

(6) The patent application filing fee is due by the applicant at the time of filing the patent application with OSIM; if the applicant has paid the filing fee before submitting the patent application, he shall specify that in the application, attaching a copy of the payment document thereto.

(7) If upon filing the patent application the applicant has not paid the filing fee, this fee may be paid within 3 months from the filing date; otherwise, the patent application shall be deemed to be withdrawn according to Art. 28 paragraph (4), letter f) of the Law.

(8) Any communication or payment document received with OSIM shall contain the identification data of the petitioner, for correspondence, as well as the number of the patent application or of the patent; in case OSIM cannot identify the patent application or the patent, the documents shall be classified as witness copy and the amount of money shall be refunded after subtracting the bank or mail service cost, only if the payer is identifiable.

## ARTICLE 5

### **Filing and processing the patent applications filed by electronic means**

(1) The requirements relating to filing and processing the patent applications filed by electronic means shall be established by the instructions issued by the Director General of OSIM, and shall be published in the Official Gazette of Romania, Part I.

(2) The instructions shall establish the conditions relating to filing the patent applications submitted by electronic means and processing the same, such as:

a) acknowledging the receipt;

b) means for authenticating the documents and the identity of the parties that communicate with OSIM;

c) material conditions concerning the presentation of the component parts of the patent application, according to the provisions of Art. 20.

(3) When the Patent Cooperation Treaty and its Implementing Regulations, the European Patent Convention or the instructions provide that documents, notifications, communications or correspondence should be transmitted to OSIM and from OSIM, to another national office or to an intergovernmental organization, in the electronic form, this means of transmission shall mutually be agreed upon by both parties.

(4) Where the application or other documents concerning the application are filed on paper carrier, OSIM may accept that a copy thereof in the electronic form be also transmitted by the applicant.

## ARTICLE 6

### **Official language**

(1) The official language of OSIM shall be Romanian.

(2) The patent application as well as the abstract shall be filed with OSIM, in the official language, which is also the language for all the procedures concerning the patent application or the patent.

(3) When OSIM is the receiving office, within the meaning of the Patent Cooperation Treaty, the provisions of Art. 29 paragraph (5) shall apply.

(4) The documents and materials generally consisting of publications, used in the proceedings before OSIM, according to the provisions of Art. 27 paragraph (4) and Art. 53 and Art. 54 of the Law, respectively, may be filed in any language, and in such cases OSIM may require the filing of the translation thereof into Romanian.

(5) When a name, denomination, address or registered office are written, in the patent application form, with other characters than the ones of the Latin alphabet, these shall have to be indicated with letters of the Latin alphabet, either by transliteration or by translation into Romanian; the applicant, patent owner or any interested person shall decide the words to be transliterated and the words to be translated.

## ARTICLE 7

### **The invention as information or as classified information**

1) The information relating to or in connection with inventions created by Romanian citizens or by natural persons having the residence on the territory of Romania, and filed with OSIM as patent applications by the national route or as international applications, based on the provisions of the Patent Cooperation Treaty, shall not be public until the date of the publication thereof in BOPI, or up to the date stipulated in the Treaty.

2) Upon filing with OSIM a patent application for inventions created by Romanian natural persons on the territory of Romania, the applicant shall declare on his own responsibility in respect of using classified information in the patent application documentation.

(3) According to Art. 40 (2) of the Law, the task of assigning the state secret character to the information contained in the documents concerning the inventions in the field of the national defense or national security, for which the Ministry of Defense, Ministry of Interior and Administration Reform, Romanian Intelligence Service manifested their interest, vests in them within 60 days from the filing date.

4) Upon the recommendation by the representatives of the Ministry of Defense, Ministry

of Interior and Administration Reform or of Romanian Intelligence Service in respect of attributing the state secret character to patent applications which do not belong to the national defense or security, OSIM shall invite the representatives of the entitled institutions to say their opinion in respect of the character of information in the patent application. In the situation when, within 30 days from sending the invitation, the representatives of the entitled institutions fail to say their opinion, this information shall be deemed not to be classified.

(5) Where the information relating to an invention is classified by the habilitated institutions, the patent application is subjected to the provisions stipulated by the Law, while observing the legal provisions concerning the classified information.

(6) The representatives of the Ministry of Defense, Ministry of Interior and Administrative Reform, Romanian Intelligence Service or of other entitled institutions have the obligation to ensure transmittal, transport and storing of the documents that contain such information, based on the agreements signed with OSIM and on the provisions in force concerning the classified information.

(7) The information relating to or in connection with patent applications filed with OSIM, and classified as state secret will be protected according to the secrecy level attributed by the issuer, this having the obligation to notify OSIM about any change of the classification level and of the time period for which they were classified.

(8) The institution that classified the information relating to or in connection with the inventions as state secrets shall pay, into the account of OSIM, the annual fee for maintaining the patent application to the secrecy level assigned, within 60 days from the date of assigning the secrecy level, and within the same period of time, it shall notify the applicant about the secrecy level assigned and the time limit for which the information was classified; the applicant may lodge an appeal to the authority that classified said information. The decision concerning the appeal shall be communicated to OSIM by the interested person within 30 days from the date of making the decision.

(9) The Ministry of Defense, Ministry of Interior and Administration Reform, the Romanian Intelligence Service and other authorized institutions may keep the copy of the description, claims and drawings of the patent application attached to the notification that

OSIM transmitted, as a consequence of classifying the information, according to paragraph (8), for the whole period for which the corresponding fee for maintaining the invention in the “state secret” level has been paid.

(10) The authorized institution that has classified the information relating to or in connection with the invention shall notify OSIM of the declassification or passing thereof to a lower secrecy level, and OSIM shall deal with the invention according to the new secrecy level, or as unclassified information as the case may be.

(11) Pursuant to the provisions of Art. 40 paragraph (2) of the Law, the Ministry of Defense, the Ministry of Interior and Administration Reform, the Romanian Intelligence Service or another authorized institution shall grant an equitable material compensation to the applicant or owner of the patent that contains information classified the patent application which has been assigned the state secret status or to the patent owner, said compensation being established by contract for the whole period of maintaining the invention in this category; any litigation concerning the contract shall be solved by the law court.

(12) In case of their own inventions, the Ministry of Defense, the Ministry of Interior and Administrative Reform, the Romanian Intelligence Service or another entitled institution, in the position of applicant, shall classify the information relating to or in connection with the invention prior to transmitting and filing the patent application with OSIM.

(13) OSIM shall ensure the required conditions for keeping records, holding, handling and multiplying the information classified as state secrets contained in an invention or of the ones referring to them, depending on the secrecy level assigned, pursuant to the provisions of the special regulations.

(14) Where a patent application in the biotechnological field contains information classified as a state secret, the related microorganism deposited with an international depository institution, in order to comply with the provisions of Art. 18 paragraph (2) of the Law, shall have the same secrecy level.

(15) In order to classify the information contained in the patent applications filed with OSIM as state secret, to declassify or to pass it to a lower classification level, the representatives of the qualified institutions shall have access to all the information concerning

the invention, and in case of an invention from the biotechnological field, also have access to the microorganism or to samples of the microorganism deposited to an international depository institution.

(16) Any person within OSIM that has knowledge about information classified according to the provisions of Art. 40 paragraph (2) of the Law or who perform works by using this information, shall be informed of the assigned secrecy level.

(17) If the applicant states, according to the provisions of Art. 27, that the disclosure of the invention that is the subject-matter of the patent application occurred in the conditions of the provisions of Art. 11 of the Law and the information relating to or in connection with the invention is classified, OSIM notifies the issuer relative to the necessity of declassifying the information.

(18) Where the information relating to the patent application classified as state secret has not been declassified by observing the provisions of Art. 25 paragraph (2) of the Law, the patent application shall be declared as deemed to be withdrawn, according to the provisions of Art. 28 paragraph (4) letter f) of the Patent Law.

(19) When the information relating to or in connection with the invention that is the subject-matter of the patent application has been classified as restricted documents, the director of the legal entity having the position of applicant shall declassify the information with a view to publishing the application, and shall request the publication in writing with OSIM.

(20) Failure to declassify the information provided for in paragraph (19), the patent application shall be declared as being withdrawn and the information will be maintained with OSIM as being classified as "restricted documents" up to their declassification by the issuer.

## ARTICLE 8

### **Filing date**

(1) With a view to granting the filing date, in application of the provisions of Art. 15 paragraph (1) of the Law, the part of the application provided for under letter c) of this paragraph is filed in Romanian, or in a foreign language, in the conditions provided for by Art.

16 paragraph (1) of the Law.

(2) The description according to Art. 15 paragraph (1) letter c) of the Law may also be a reference in Romanian language to a patent application previously filed with an office and this reference shall include:

- a) number of the previously filed application;
- b) denomination of the office where the patent application has been filed;
- c) application filing date.

(3) Where, according to the provisions of Art. 15 paragraph (1) letter b) of the Law, OSIM can contact the applicant, but the documents provided for in Art. 15 paragraph (1) letter a) and/or c) of the Law have not been filed, OSIM shall notify the applicant on the ascertained drawbacks and grant a two-month time period, from the date of filing at least one of the documents, for submitting the missing documents.

(4) In the situation under paragraph (3), the patent application filing date is the date on which the documents specified in the notification are filed with OSIM.

(5) If, within the time period granted in the notification under paragraph (3), the missing documents have not been submitted, the patent application is deemed not to have been filed and this shall be communicated to the person who filed the documents, also indicating the reasons for which the patent application was dealt with in such a way.

(6) In the situation provided for under paragraph (5), OSIM shall return the documentation keeping a copy thereof, as a witness copy, that shall not be published and may be consulted, at the OSIM headquarters, by the person who submitted the documents, following to a written request.

(7) Where, upon establishing the filing date, OSIM ascertains that a part of the description is missing, according to Art. 15 paragraph (2), it shall notify the applicant who is asked to submit the missing part within 2 months from the date of sending the notification, but not more than 4 months from the date on which at least one of the documents provided for in Art. 15 paragraph (1) of the Law has been filed with OSIM.

(8) The missing part of the description may also be filed with OSIM on the applicant's own initiative, within 4 months from the date on which OSIM has received at least one of the

documents referred to in Art. 15 paragraph (1).

(9) Where the applicant files the missing part in the Romanian within the time limit referred to in paragraph (7) or (8), OSIM shall consider that missing part as included in the description, the application filing date shall be the date on which the missing part has been filed with OSIM, and the applicant shall be notified accordingly.

(10) Where a priority of an earlier application is claimed and the missing part is contained in the earlier application whose priority is claimed, the applicant shall, for the purpose of according the filing date, submit the following:

a) the missing part in the Romanian language, within 4 months from the date when at least one of the documents provided for in Art. 15 paragraph (1) of the Law has been filed with OSIM;

b) a copy of the earlier patent application containing the missing part, with the precise indication thereof, within the time limit referred to under letter a);

c) a copy of the earlier application, certified by the office where the application has been filed and the filing date of the application whose priority is claimed, within 4 months from notification, but not more than 16 months from the date of the claimed priority;

d) a translation into Romanian of the earlier application, if this has not been filed in Romanian.

(11) When applying the provisions of paragraph (10) the following shall be observed:

a) the missing part of the description shall entirely be found in the earlier application;

b) where the earlier application has already been filed with OSIM, the applicant shall file only the missing part, within the time limit referred to in paragraph (10) letter a);

c) the documents referred to under the provisions of Art. 15 paragraph (1) shall contain explicit reference to the earlier patent application whose priority was claimed in the patent application.

(12) Where the requirements referred to in paragraph (10) are complied with, the filing date shall be the date established according to the provisions of Art. 15 paragraph (1) of the Law.

(13) Where the missing part of the description is filed within the time limits provided for

in paragraph (7) or (8), but OSIM ascertains that it does not belong to the earlier patent application whose priority was claimed, the filing date of the application will be the date of filing the missing part, and OSIM shall notify the applicant accordingly, indicating the reasons therefor.

(14) If within one month from the date of the notification concerning the according of the filing date, under the provisions of paragraph (9) or (13), the applicant communicates to OSIM the intention of withdrawing the part that initially was deemed to be missing, the patent application filing date will be the date on which the provisions of Art. 15 paragraph (1) of the Law are complied with.

(15) The copy of the earlier application referred to under the provisions of paragraph (10) letter b) shall contain: the description, claims and, where appropriate, the drawings; where the earlier patent application does not contain claims and drawings, these shall be submitted within the time limit provided for in paragraph (10) letter a).

(16) The request for filing the missing part or for withdrawing the filed missing part is deemed being filed only subject to payment of the fee for filing the missing part of the description of invention with a view to establishing the filing date or, as the case may be, of the fee for the withdrawal of the filed missing part.

(17) The filing date of a patent application resulting from dividing an original application is the same as the filing date of the original application.

(18) Where the provisions of Art. 66 paragraph (2) letter b) of the Law apply, the new patent application shall have the same filing date as the original patent application.

## ARTICLE 9

### **Regular national filing**

(1) All documents referred to in Art. 14 paragraph (1), filed with OSIM, constitute the regular national filing of the patent application.

(2) The patent application filing referred to in paragraph (1) produces the effects of a regular national filing as provided for in Art. 4 of the Paris Convention.

(3) Where the requirements referred to in Art. 15 paragraph (1) of the Law are fulfilled and there are filed the documents provided for in Art. 14 paragraph (1) letters d) and e) of the Law, OSIM shall notify the applicant that the patent application filing produces the effects of a regular national filing.

(4) The provisions of paragraphs (1) and (2) also apply to patent applications resulting from dividing a patent application which do not comply with the provisions of Art. 19 paragraph (1) of the Law.

(5) In case of foreign applicants who file, according to Art. 16 paragraph (1), the description, claims and/or drawings in a foreign language, the patent application filing produces, from the date of filing, the effects of a regular national filing, provided that the certified translation of said documents in the Romanian language is filed with OSIM in three copies, within 2 months from this date; failing to file the translation or to pay the filing fee therefor, the application shall be rejected, according to the provisions of Art. 28 paragraph (2) letter a) of the Law.

(6) In the application of the provisions of Art. 15 paragraph (7) of the Law, where the claims and, where appropriate, the drawings were not filed on the date of filing, these may be filed with OSIM within two months from the filing date, subject to payment of the legal fee, and in this case the patent application produces the effects of a regular national filing starting from the filing date.

(7) Where the claims are not filed according to the provisions of Art. 15 paragraph (7) of the Law, the patent application shall be declared to be withdrawn, according to Art. 28 paragraph (4) letter e) of the Law .

(8) Where reference to drawings is made in the description and claims, but the drawings have not been filed with OSIM on the date of filing or within the time limit referred to in paragraph (6), OSIM shall notify the applicant:

a) of the requirement that any reference to drawings in the description and claims should be considered to have been eliminated, with the proviso of filing with OSIM the description and claims, modified by eliminating the reference to drawings therefrom, within two months from the notification, but not more than 4 months from the filing date; or

b) of the fact that OSIM should carry on the examination procedure only for the parts of the description not making reference to drawings, in which case the applicant shall file the redrafted description and claims with OSIM, within the same time limits provided under letter a).

(9) The applicant failing to respond to the notification referred to under paragraph (8), within the granted time limit, the patent application shall be deemed to have been withdrawn.

## ARTICLE 10

### **Conventional priority and claiming the same**

(1) The conditions for and the effects produced by claiming a priority are the ones stipulated in the Paris Convention.

(2) By the declaration referred to in Art. 20 paragraph (4) of the Law, there is claimed the priority of one or more earlier national, regional or international patent applications filed in or for any State Party to the Paris Convention or for any Member State of the World Trade Organization.

(3) The declaration provided for under paragraph (2) shall indicate:

a) the date of filing the earlier application;

b) the number of the earlier application;

c) the denomination of the State party to the Paris Convention or of the Member State of the World Trade Organization, in which the earlier application has been filed, if the earlier application is a national application;

d) the denomination of the authority that granted the regional patent, pursuant to the provisions of the regional patent treaty, where the earlier application is a regional application;

e) the denomination of the receiving office where the application has been filed, where the earlier application is an international application.

(4) Where the earlier application, according to paragraph (2), is a regional or international application, the claiming of priority may also indicate one or more States party to the Paris Convention, for which the earlier application was filed.

(5) Where the earlier application filed on the basis of a regional patent Convention originates in a State that is neither a party to Paris Convention nor a member of the World Trade Organization, the claiming of priority shall contain at least one State party to the Paris Convention or a Member State of the World Trade Organization for which the earlier application was filed.

(6) More priorities of earlier applications originating in various States may be claimed in a patent application, with the proviso of complying with the stipulation of Art. 20 paragraph (5) of the Law.

(7) The priority claiming fee shall be paid for each priority:

a) within 4 months from the application filing date, if the priority claiming was made on that date; or

b) at the time of opening the national phase.

(8) Failure to pay the priority claiming fee in the legal amount and time limit provided for in paragraph (7) leads to the non-recognition of priority.

(9) In a patent application claiming one or more priorities of earlier applications according to the provisions of paragraph (1) or (6), the claiming of any of these priorities is also recognized in the conditions in which the application contains one or more features not contained in the application or applications whose priority is claimed, provided that, in both cases there exists a unity of the invention, according to the provisions of Art. 19 paragraph (1) of the Law.

(10) Where one or more priorities are claimed in a patent application, only that part of the subsequent application filing contained in the first application or first applications filing shall be recognized, according to the provisions of Art. (9) for the parts not contained in the application or applications whose priority is claimed, the subsequent application filing generates a priority right in the conditions of the Law.

(11) Where some features of the invention from a subsequent application wherein a priority was claimed, cannot be found in any claim drafted in the earlier application, the priority may still be recognized, if these features obviously result from the assembly of the earlier application.

(12) The applicant may avail himself of the right of priority derived from a first filing of a non-unitary patent application, no matter if the patent application was divided or not in the country of origin.

(13) Where a patent application results from dividing a patent application, the applicant benefits of the right of priority claimed in the divided application.

(14) The claiming of more cascade priorities is not recognized.

(15) The data contained in the declaration according to paragraph (2) may be corrected if:

a) a request signed by the applicant or by the professional representative thereof, explicitly requesting the correction of the data, is filed within two months from the expiry of the twelve-month time limit from the date of priority;

b) the fee for publishing the correction of the data relating to claiming of priority is paid within 4 months from the date of filing the patent application or of opening the national phase.

(16) In a patent application having the filing date within the twelve-month time limit from the date on which the priority of an earlier application could have been claimed, the priority may, according to the provisions of Art. 22 paragraph (1) of the Law, be claimed within 2 months from the expiry of the twelve-month time limit calculated from the filing date of the earliest application whose priority was claimed.

(17) The priority claimed according to paragraph (16) may be recognized only if:

a) a request signed by the applicant or by the professional representative thereof, explicitly requesting the addition of priority claiming, is filed at the latest within two months from the expiry of the twelve-month time limit;

b) the fee for claiming the priority after the date of filing the patent application is paid at the time of claiming the priority.

(18) According to the provisions of Art. 20 paragraph (7) of the Law, priority may be recognized only where :

a) there exists a request signed by the applicant or his professional representative which explicitly requests the reinstatement; when on the date of filing there was not claimed the priority of the earlier application, the request shall be attended by the priority claiming;

b) the request referred to under letter a) is filed within the two-month time limit from the expiry of the priority period;

c) the request referred to under letter a) presents the reasons for failure to file the patent application within the priority period and a statement or other proof can be attached for sustaining the reasons;

d) the fee for claiming a priority is paid at the time of filing the request under letter a).

(19) The provisions of paragraphs (17) or (18) shall be applied if the request referred to in paragraph (17) letter a) or paragraph (18) letter a) is filed before the applicant requests the publication of the application according to the provisions of Art. 23 paragraph (3) of the Law, or before OSIM complies with a request for withdrawal or takes a decision of rejection.

(20) If the provisions of paragraph (18) are not fulfilled, OSIM shall decide the non-recognition of the priority according to the provisions of Art. 22 paragraph (4) of the Law.

## ARTICLE 11

### **Internal priority**

(1) For a subsequent patent application the applicant shall file with OSIM the internal priority document within 5 months from the application filing date.

(2) The internal priority document is issued and attached by OSIM to the subsequent patent application which claims the internal priority of an earlier application at the applicant's request and subject to payment of the fee for the issuance of a priority certificate.

(3) The fee for claiming the internal priority shall be paid within 4 months from the subsequent application filing date.

(4) Failure to claim the internal priority in the subsequent application, failure to submit the priority document or to pay the internal priority claiming fee leads to the non-recognition of the claimed priority.

## SECTION 3

### **Subject-Matter of the Invention**

## ARTICLE 12

### **Product**

(1) The product referred to in Art. 7 paragraph (1) of the Law is the subject-matter of an invention in so far as it constitutes the solution to a technical problem.

(2) Product may be an object having determined properties, technically defined by its constructive or component parts, by elements connecting the same, by its constructive shape or the shape of its component parts, by materials used for making it, by the constructive, position and functional relationships between the component parts or by the functional role thereof.

(3) Products within the meaning of the provisions of paragraph (1) and (2) may be:

a) devices, installations, equipments, machine-tools, apparatuses or assemblies of apparatuses operating together or relating to working means for carrying out a manufacturing or working process;

b) electric, pneumatic or hydraulic circuits;

c) chemical substances, including intermediates defined by the component elements and their relationship, symbolized by chemical formulae, by the significance of the substituting radicals, molecular structure, steric isomerism, molecular weight or by other features which individualize or identify them;

d) means or agents, chemical substances indicating the purpose they are used for;

e) physical or physical-chemical mixtures defined by the component elements, the quantitative ratio between them, structure, physical-chemical properties or other properties individualizing them and making them applicable to solving a technical problem.

(4) Where the product cannot be defined according to the provisions of paragraph (2), it may be defined by its manufacturing process.

(5) The product referred to under Art. 7 paragraph (1) of the Law, as a subject-matter of a biotechnological invention is defined according to the provisions of Art. 68 paragraph (3) and paragraph (7).

(6) The product as a subject-matter of a computer-related invention is defined in the provisions of Art. 44 paragraph (12).

## ARTICLE 13

## **Process**

(1) The process is the subject-matter of a patentable invention, according to the provisions of Art. 7 paragraph (1) of the Law, in so far as it constitutes a solution to a technical problem.

(2) The process according to paragraph (1) represents a logical succession of stages or steps, defined by their carrying on order, by initial conditions, such as the selected raw material, parameters, technical conditions for carrying on and/or employed technical means and by final products or results.

(3) The process according to the provisions of paragraph (1) consists of:

a) a mechanical, physical, chemical technological activity with the effect of obtaining or modifying a product;

b) a working method characterized by operating steps; or

c) a new use of a known product or process.

(4) The process referred to in Art. 7 paragraph (1) of the Law as a subject-matter of a biotechnological invention is defined in Art. 68 paragraph (3).

## **SECTION 4**

### **Patent application**

#### **ARTICLE 14**

#### **The component parts of the patent application**

(1) According to Art. 14 paragraph (1) of the Law, the patent application contains a form requesting the grant of a patent, accompanied by a description of the invention, one or more claims and, where appropriate, drawings to which reference is made in the description and/or claims.

(2) The patent application shall be accompanied by other documents: abstract of the patent application, the power of attorney for appointing the professional representative, the priority document, authorization for transfer of the priority rights, document proving the deposit

of the biological material with an international depository authority, the document for designating the inventors, the document for transmitting the right to be granted the patent, exhibition certificate.

## ARTICLE 15

### **Patent application form**

(1) According to Art. 14 paragraph (1) letter a) of the Law, the request for the grant of a patent may be filed with OSIM, on a printed form comprising:

- a) explicit request for the grant of a patent for invention;
- b) title of the invention drawing up the subject-matter of the invention in a clear and concise manner;
- c) all indications necessary for establishing the applicant's or applicants' identity, as the case may be;
- d) designation of the inventor, if this is different from the applicant, indicating the place of work thereof at the moment of creating the invention.

(2) The form under paragraph (1) shall contain a list indicating:

- a) its total number of pages and the number of pages of the description, claims, drawings and abstract;
- b) the denomination of other documents appended to the form, such as: power of attorney in the original or a copy of a general power of attorney, priority documents, a list of nucleotide sequences presented in a format that can be read by means of the computer, a document relating to the payment of the fees, a document relating to the deposit of a microorganism or of other biological material, document wherethrough the applicant designates the inventors, the document wherethrough the applicant proves his entitlement to file the application and to be granted the patent, authorization concerning the assigning of the priority right, as well as the number of pages of each document;
- c) the number of the figure in the drawings indicated by the applicant to accompany the abstract upon publication; the applicant may justifiedly request the publication of two figures, and in this case he will indicate the numbers thereof.

(3) The list referred to in paragraph (2) shall be filled in by the applicant, and OSIM shall check and register the presence of the documents declared as being filed.

(4) The form in paragraph (1) shall be drawn up in Romanian and shall be filled in in three copies by printing, typing or in hand writing.

(5) The indications referred to in paragraph (1) letter c) are:

a) where the applicant is a natural person, the name, first name, domicile and State whose citizen he is;

b) where the applicant is a legal entity, the official complete denomination, the headquarters thereof, the State whose nationality he has, as well as other official data concerning the legal existence of the legal entity.

(6) If there are more applicants and these are not represented before OSIM by a professional representative, one of the applicants designated for the correspondence with OSIM shall be indicated in the application; otherwise OSIM shall have correspondence with the first applicant indicated in the form.

(7) Upon request by the applicant, OSIM shall forward the correspondence to another address indicated by the applicant.

(8) The patent application form referred to under the provisions of paragraph (1) may also include:

a) identification data of the professional representative;

b) claiming of a priority according to the provisions of Art. 10;

c) reference, in the Romanian language, to an earlier patent application filed with an Office according to the provisions of Art. 8 paragraph (2);

d) indication of the procedures that the applicant wants to be undergone by the application, of which expressly the following: the publication of the patent application according to the provisions of Art. 23 paragraph 3 of the Law, drawing up a search report according to the provisions of Art. 24 of the Law, substantive examination according to the provisions of Art. 25 of the Law;

e) indication of the number and filing date of the original application from which the application was divided.

(9) Identification by domicile or registered office according to the provisions of paragraph (5), (6) and (8) letter a) shall meet the usual requirements for the delivery by mail; in order to allow rapid communication, the telephone and facsimile number or the data necessary for other types of communication shall also be indicated.

(10) The form referred to in paragraph (1) shall be signed by the applicant or the professional representative appointed by this; in the situation of more applicants, the form shall be signed by at least one of them, with the agreement of the other applicants.

(11) If the form is not signed, according to the provisions of paragraph (10), a copy of the ones existing at OSIM shall be returned with a notification to the applicant or the professional representative, as the case may be, in order that this should return the signed form to OSIM, within two months from the filing date; otherwise, the application shall not be treated as a patent application and the provisions of Art. 8 paragraph (5) shall be applied.

## ARTICLE 16

### **Description of the invention**

(1) The description of the invention according to Art. 14 paragraph (1) letter c) of the Law shall contain the following:

a) the title of the invention as indicated in the patent application, containing a clear and concise drawing up of the claimed invention, without disclosing it and without containing fanciful denominations;

b) specification of the technical field wherein the invention may be applied;

c) presentation of the prior art considered by the applicant to be useful for understanding, performing the documentary search and examining the claimed invention, with the indication of the documents which substantiate it; at least one solution considered to be the closest to the claimed invention shall be presented; where the prior art also contains traditional knowledge, this and its source, if known, shall explicitly be indicated in the description;

d) presentation of the technical problem that the applicant proposed to solve by the

invention; the technical problem consists in formulating the objective whose solving represents a success in the technical field that the invention relates to.

e) exposition of the invention as claimed, for a person skilled in the art to be able to understand the technical problem, even if it is not explicitly presented, and the means for solving the same; where the description comprises a group of inventions which fulfil the condition of unity of the invention, each invention from the group shall be exposed distinctly;

f) presentation of the advantages of the invention in comparison with the state of the art;

g) brief presentation of each figure of the explanatory drawings, where such drawings exist;

h) detailed presentation of at least one embodiment of the claimed invention, by using examples, where appropriate, with reference to drawings, if any; in case of some carrying out versions, at least one embodiment shall be presented for each version.

i) indication of the way of industrially exploiting the invention, if this does not result as obvious from the detailed presentation according to letter h) or from the nature of the invention;

(2) In the description, according to the provisions of paragraph (1), there may be presented chemical, physical or mathematical models and formulae, algorithms, programming lines, subroutines or computer programs, tables, without supporting the presentation of the subject-matter of the invention in the embodiment exclusively on them.

(3) The description shall be presented in the manner and with the succession of the chapters referred to under paragraph (1), except where, by the nature of the invention, a different presentation would lead to a better understanding of the invention.

(4) The description of the invention according to the provisions of paragraph (1) shall contain the technical terms of the Romanian language; where no equivalent terms exist in the Romanian language, technical terms that are usual in a foreign language, particularly in the data processing field, may be used.

## ARTICLE 17

### **Description of an invention in the field of computer programs**

(1) The description of the invention in the field of computer programs shall comply with the provisions of Art. 16.

(2) For better understanding the invention, the description according to the provisions of paragraph (1) may be attended by diagrams presenting the data processing operational stages or steps such as program organization diagrams, graphs or the like.

(3) In the description there are accepted short fragments of a program for the data processing units, in a usual programming language, if they better explain the manner of carrying out the invention.

## ARTICLE 18

### **Claims**

(1) In application of the provisions of Art. 14 paragraph (1) letter d) of the Law, the claims shall define the matter for which protection is sought in terms of the technical features of the invention.

(2) According to paragraph (1), the claims shall be clear and concise both individually and wholly, and they shall be supported by the description, as stipulated in Art. 16.

(3) According to paragraph (1) the claims shall be drawn up in two portions and shall contain:

a) a preamble indicating the subject-matter of the invention and the technical features necessary for defining it and which, in combination, belong to the state of the art; and

b) a characterizing portion, preceded by the expression "characterized in that" , presenting the technical features which, in combination with the features stated in the preamble, define the claimed protection.

(4) However, the claims may also be drawn up in a single portion which contains the presentation of a technical feature or of a combination of more technical features which define the subject-matter for which protection is claimed.

(5) A patent application may contain one or more independent claims, depending on the essential technical features of the invention: an independent claim can be followed by one or more subordinated dependent claims.

(6) The independent claim, according to the provisions of paragraph (5), shall clearly state all the essential technical features necessary for the definition of the subject-matter of the invention.

(7) The dependent claim, according to the provisions of paragraph (5), shall implicitly contain all the features of the independent claim to which it is subordinated and it shall:

a) develop or explain the essential technical features of the invention already enunciated in the independent claim; or

b) relate to particular embodiments of the invention; or

c) contain other technical features than the ones in the independent claim, but which do not represent essential features for defining the subject-matter of the claimed protection.

(8) The dependent claim, according to the provisions of paragraph (5), shall contain a reference to the claim it is subordinated to, without any reference to the state of the art being made at the beginning of the claim.

(9) The dependent claims, according to the provisions of paragraph (5), may be followed by one or several dependent claims subordinated thereto and they represent multiple dependence claims.

(10) The dependent claims, according to paragraph (5) or paragraph (9), subordinated to one or more previous claims shall be grouped and located in the most suitable possible manner.

(11) The number of the claims according to paragraph (1) shall be reasonable considering the nature of the claimed invention, the claims being numbered by consecutive Arabic numerals.

(12) The patent application relating to a group of inventions forming a single general inventive concept shall contain at least one independent claim, according to paragraph (5), for each invention.

(13) Without prejudice to the provisions of Art. (19) of the Law, a patent application may contain more than one independent claim of the same category (product, process, installation, use), only if the subject-matter of the patent application relates to:

a) more interdependent products; or

b) various uses of a product or of an installation; or

c) alternative solutions for a certain problem when these cannot be contained in a single claim.

(14) For drawing up the claims, according to the provisions of paragraph (1), the following shall also be taken into account:

a) the denominations of the technical features in claims and the reference signs shall correspond to the ones in the description and drawings, respectively;

b) the drawing up shall be in a single sentence;

c) where the patent application contains drawings, the technical features mentioned in the claims shall, in so far as it facilitates the understanding of the claim, be followed by the reference signs relating to these features, put between brackets; the reference signs shall not be interpreted as a limitation of the claim;

d) the claims shall not contain drawings or graphics, program lines, subroutines or computer programs, but they may contain chemical or mathematical formulae or tables, if these are essential for the definition of the object of the claimed protection;

e) the claims shall not contain reference such as “as presented in ... in the description” or “as illustrated in figure ...”; however, when absolutely necessary, the claim may, in respect of the technical features of the invention, refer to the description and drawings.

(15) In case of computer program-related inventions the claims shall be drawn up so that:

a) the new features of the product may be achieved by means of a computer program in a system which comprises means adapted to achieve an equivalent process;

b) the process may be achieved in a system if the program determining the carrying out of the process can be run within a system.

## ARTICLE 19

### **Drawings**

(1) The drawings according to the provisions of Art. 14 paragraph (1) letter e) of the Law are necessary in so far as they contribute to understanding the invention and the technical features thereof.

(2) The drawings, according to the provisions of paragraph (1) shall contain reference consisting of signs, numbers and/or letters which indicate the component elements of the number they represent, corresponding to the presentation in the description referred to in Art. 16.

(3) A drawing sheet, according to the provisions of paragraph (1), may include more figures carried out according to the norms accepted in the technical drawing field.

(4) The drawing sheet according to the provisions of paragraph (3) shall be in A4 format or A3 format, in exceptional cases, and may be made on tracing paper, white cardboard or other carrier, provided that the drawing has the necessary contrast for its being reproduced by means of electrostatic methods; the sheets shall not have a framing or other lines to delimit the drawings; the minimum free margins of the sheets shall be of 2.5 cm on each side.

(5) The flow sheets and diagrams, except for the tables, shall be considered drawings under paragraph 1.

(6) The drawings, according to the provisions of paragraph (1), shall not contain texts, except for a word or some isolated words strictly necessary, such as: "water", "steam", "open", "closed", and for the flow sheets and diagrams illustrating the process steps, keywords absolutely necessary for understanding them.

(7) The reference signs, according to the provisions of paragraph (2) shall correspond to the ones mentioned in the description and claims and reversely.

## ARTICLE 20

### **Material conditions concerning the manner of presentation of the component parts of the patent application**

(1) The application form, the description, claims and drawings which constitute

component parts of the patent application, according to the provisions of Art. 14 paragraph (1) of the Law, shall be presented on white smooth, mat, hard, thin and lasting A4 format paper, each sheet being used so that the short sides should be positioned up and down, and shall be filed with OSIM in 3 copies, according to the provisions of Art. 4.

(2) One of the 3 copies of the description, claims and drawings filed according to the provisions of paragraph (1) shall be signed on each sheet by the applicant or by the professional representative, as the case may be, and shall represent the original copy.

(3) All the sheets of the patent application shall be written only on one face of the sheet and in such a manner as to allow them to be separated for the purpose of being reproduced in an unlimited number of copies. The sheets shall not be torn, creased or folded.

(4) The sheets of each document of the patent application shall be numbered in Arabic numerals in the increasing order, placed at the upper side, centre of the sheet.

(5) The description and claims shall be made-up or typed at 1.5 - 2 line spacing and the free margins of each sheet shall be of 2.5 cm on each side.

(6) The symbols and graphical characters, chemical or mathematic formulae in the patent application may also be written by hand or drawn.

(7) The sheets of the description and claims shall not contain drawings.

(8) The patent application sheets shall be free from erasures, corrections, overwriting or interlineations; if they still exist, the applicant shall sign on the original copy in front of the modification.

(9) Each component part of the patent application shall start on a new sheet and the sheets will be bound so as to allow them to be easily identified, turned over, separated and reunited.

(10) In the patent application there shall be used terms, signs and technical symbols accepted in application field of the invention.

(11) The units of measurement shall generally be expressed in the international system.

(12) The terminology and the reference signs shall be consistent throughout the description, claims and drawings.

(13) The following shall not be a part of the patent application filing and shall be

returned to the applicant: the product carried out according to the invention, scale models, manufacturing projects concerning the invention, other carriers except paper which contain components of the patent application and the like.

(14) The filing of a patent application based on the description, claims and drawings filed in the electronic form or by electronic means shall be constituted only after the provisions of Art. 5 paragraph (1) are applied; the documents filed before this date on other carrier except paper shall be returned to the applicant.

(15) The title and claims shall not contain commercial denominations, product marks, fanciful denominations or the like.

## ARTICLE 21

### **Patent application abstract**

(1) In the application of the provisions of Art. 14 paragraph (8) of the Law, the abstract is useful both as a means both for selecting the technical information for specialists and for making a decision concerning the need of consulting the patent application.

(2) The abstract that accompanies the patent application according to the provisions of Art. 14 paragraph (7) of the Law shall be drawn up by using about 150 words:

a) it shall indicate the title of the invention and the technical field the invention or the group of inventions belongs to;

b) it shall contain a brief presentation of the invention disclosed in the application, which should allow the understanding of the technical problem, the essence of the solution for solving the technical problem and the main use of the invention and, where appropriate, the chemical formula selected from the formulae contained in the patent application, which best characterizes the invention;

c) it shall not contain considerations relating to alleged merits or appreciations of the invention or of possible speculative applications;

d) it shall be accompanied by an indication of the figure, or exceptionally, the figures in the drawings proposed to be published.

(3) OSIM may decide the publication of another (other) figure(s) together with the

abstract under paragraph (2), if it considers that this or these better characterize(s) the invention; each of the main features mentioned in the abstract and illustrated in the drawing shall be followed by a reference sign placed between brackets.

## ARTICLE 22

### **Power of attorney**

(1) Appointment of the professional representative which stands for the applicant, owner, assignor or any other person shall be made by a special power of attorney filed with OSIM at the time of filing the patent application and it shall contain the name and signature of the represented person.

(2) Where the power of attorney, according to paragraph (1) is not filed on the filing date of the patent application or on the date of opening the national phase, it can still be filed within 2 months from the date on which the applicant is notified by OSIM with reference to filing the missing document, or within 4 months from the filing date, or from the date of opening the national phase, whichever expires later.

(3) Where the applicant does not have the domicile or registered office on the territory of Romania and the provision of paragraph (2) has not been fulfilled, the patent application shall be rejected.

(4) Where the represented person referred to has the domicile or registered office on the territory of Romania but the provision of paragraph (2) has not been fulfilled, OSIM shall not enter the professional representative in the registers.

(5) A power of attorney referring to procedures corresponding to more patent applications or patents of the same represented person, named general power of attorney, shall be entered in the register for general powers of attorney held by OSIM, provided that:

a) all the patent applications or patents are identifiable within the power of attorney, or the ones for which the representation is not made, are specified, as the case may be;

b) for each patent application and patent, a copy of the power of attorney certified by OSIM with the number in the register for general powers of attorney and the signature of the professional representative is filed with OSIM; and

c) the fee for certification and issuance of the power of attorney copy is paid.

(6) Where the power of attorney is not drawn up in Romanian language, this shall be accompanied by a translation certified to be in compliance with the original.

## ARTICLE 23

### **Priority document**

(1) In the application of the provisions of Art. 20 paragraph (4) of the Law, the applicant claiming the priority of an earlier patent application shall submit to OSIM, within 16 months from the date of the claimed priority, a copy of the earlier application together with the filing date thereof certified by the authority where the earlier application has been filed and which represents the priority document.

(2) For the international applications for which the national phase has been opened, a copy of the priority document is requested by OSIM from the International Bureau.

(3) When the priority of an earlier application is claimed in an international application, and the national phase has been opened, and the priority document has not been filed with the International Bureau within the time limit provided for by Rule 17 from the Implementing Regulations of the Patent Cooperation Treaty, the priority document may be filed with OSIM with a view to recognizing the claimed priority:

a) within 4 months from the date of opening the national phase, if the provisions of Art.30 paragraph (3) apply; or

b) within 2 months from the date of opening the national phase, if the provisions of Art. 30 paragraph (4) apply.

(4) Upon request by the applicant, OSIM may obtain the priority document in the electronic form from a digital library of a State party to the Paris Convention or of a Member State of the World Trade Organization, in the conditions provided for by Art. 5 paragraph (3).

(5) OSIM shall not recognize priority in the following situations:

a) failure to submit the priority document, failure to file an application with OSIM according to the provisions of paragraph (4) or

b) failure to pay the fee for claiming a priority.

(6) The priority document may confirm the filing of the earlier patent application or of the application for the registration of a utility model.

(7) In the application of the provisions of Art. 22 paragraph (3) of the Law, OSIM may notify the applicant to file a certified translation into Romanian of the priority document with a view to recognizing the claimed priority. Failure to submit the translation of the priority document with OSIM within the granted period of time, that may not exceed 2 months from the notification date, shall lead to the non-recognition of the claimed priority.

(8) When one or more priorities are claimed, and OSIM requests through a notification, the translation of the priority documents, the applicant or his successor in title shall also indicate the passages in the description, claims and, where appropriate, the drawing or drawings which correspond(s) to each priority document.

(9) The person who has filed a patent application or utility model application abroad and is entitled to claim in that application the priority of an earlier application filed in Romania, may request the issuance of the priority document confirming the application filing effected in Romania.

(10) OSIM shall issue the entitled person the priority document requested, according to paragraph (9), provided that a copy of the protection application filed abroad is filed with OSIM and subject to payment of the legal fee.

## ARTICLE 24

### **Authorization for transferring the priority rights**

(1) The authorization referred to in Art. 20 paragraph (8) and (9) of the Law shall be submitted to OSIM by the assignor of the priority right and shall mention the right thereof of claiming the priority of the first filing.

(2) The time period for filing the authorization with OSIM, in case of claiming the priority provided for in Art. 20 paragraph (1) or (7) of the Law is of maximum 17 months from the priority date; otherwise, [according to the provisions of Art. 22 paragraph (4) of the Law], OSIM decides the non-recognition of the claimed priority.

(3) If within the priority period successive assignments of the priority right took place,

these shall be registered with OSIM within the time period under the provisions of paragraph (2).

(4) Where the provisions of paragraph (2) or of Art. 30 paragraph (13) apply, the authorization shall be filed with OSIM within 3 months from the date of opening the national phase; otherwise, within 6 months from the date of opening the national phase, OSIM shall decide the non-recognition of the claimed priority.

## ARTICLE 25

### **Document attesting the deposition of the biological material with an international depository authority**

(1) The document stipulated in Art. 18 paragraph (2) of the Law shall be filed with OSIM within the time limit under Art. 73 paragraph (3) and shall contain:

- a) denomination of the biological material;
- b) denomination and address of the depository institution where the biological material has been deposited;
- c) order number assigned to the deposit;
- d) date of the deposit of the biological material with the depository institution.

(2) The document referred to in paragraph (1) shall prove that the biological material was deposited with the international depository institution on an earlier date than the date of the deposit or than the date of the recognized priority of the patent application.

(3) Where the invention in the patent application relates to a microorganism, in default of the certification document mentioned under paragraph (1), the application shall be refused.

## ARTICLE 26

### **Document for designation of inventors**

(1) In the application of the provisions of Art. 14 paragraph (2) of the Law, where the applicant is not the same as the inventor, or is not the only inventor, the designation of the

inventor shall be made in a separate document annexed to the patent application.

(2) The designation document according to paragraph (1) shall state the surname, first name and complete address of the inventor; these data shall be identical with the ones contained in the document proving that the applicant acquired the right to be granted the patent.

(3) OSIM shall not check the accuracy of inventor designation.

(4) If the applicant does not have the quality of inventor or is not the only inventor, OSIM shall publish the data concerning the inventor designated according to paragraph (2), together with other data provided for in Art. 35 for the publication of the patent application.

(5) The applicant and the inventor cannot invoke the omission of a notification concerning the paragraph (3), with reference to the errors contained in the document designating the inventor.

(6) In the application of the provisions of Art. 35 paragraph (3) of the Law, where the inventor gives up, in a written document, his right to be mentioned, the inventor shall file a statement with OSIM, at the latest, one month before the date of publication of the patent application.

(7) Where the interested person files a final and irrevocable decision with OSIM through which, there is established, according to the provisions of Art. 63 of the Law, the inventorship thereof, this shall file, with OSIM, the document through which the right to be granted the patent is transferred to the applicant. Otherwise, the patent application shall be refused according to the provisions of Art. 28 paragraph (2) letter g) of the Law.

(8) Where the designation provided for in paragraph (1) contains errors, the correction of the errors shall be made upon request, in a justified manner and only with the consent of the designated person.

(9) If the request for the correction of data concerning the inventor's designation is filed by a third party, the applicant's or the patent owner's consent is also necessary.

(10) Where the designation of the inventor was entered incorrectly in the National Register of the Filed Patent Applications and, where appropriate, it was published in BOPI, the correction or cancellation thereof shall also be entered in the register and shall be published in BOPI, where appropriate.

(11) Where, according to the provisions of Art. 35 paragraph (3) the inventor's name is not published, as well as in case of filing a request for correction or cancellation of the mention concerning the designation of the inventor, the applicant or patent owner, as the case may be, owes to OSIM a fee for non-publishing the inventor's name and for modification of the legal status, respectively.

(12) If the inventors have not been designated upon filing the patent application, the applicant is obliged to declare them within the time limit stipulated by Art. 28 paragraph (4) letter a) of the Law; where the patent applications comply with the provisions of Art. 40 paragraph (2) of the Law, the designation of the inventors shall be made until the declassification of the information for the purpose of the publication or until a decision in respect of the patent application is made.

(13) Where the applicant is notified by OSIM in respect of designating the inventors within the time limits stipulated above and fails to respond to the notification, the patent application shall be declared as deemed to be withdrawn, according to the provisions of Art. 28 paragraph (4) letter a) of the Law.

(14) Where the applicant or the patent owner requests for the modification of the collective of inventors with OSIM, an authenticated declaration showing the agreement of the designated inventors shall be submitted. Where some inventors are included, the declaration shall also contain their agreement with a view to transmitting the rights to the applicant.

(15) In the situations provided for in paragraph (14) the request shall be complied with only subject to payment of the legal fees for filing the modification of the collective of inventors and for transfer of rights.

(16) The declaration may be filed with OSIM according to the provisions of paragraph (14), at the latest until the decision to grant the patent is made; otherwise, OSIM shall not take into account the applicant's request for the modification of the collective of inventors.

## ARTICLE 27

### **Document for transfer of right to the grant of the patent**

(1) According to the provisions of Art. 14 paragraph (2) of the Law, if the inventor or inventors have assigned the right in the patent to a natural person of legal entity before filing the patent application, the applicant shall file the document attesting this transfer with OSIM in order to prove his entitlement to be granted the patent.

(2) The document mentioned in paragraph (1), in the original or as authenticated copy may be filed until a decision is made in respect of the patent application.

(3) Where there does not result from the patent application the applicant's entitlement to the grant of the patent, OSIM shall notify and ask the applicant to file the document mentioned in paragraph (1).

(4) If the applicant failed to file the document stipulated in paragraph (2) up to the date a decision is made in respect of the patent application, OSIM shall him grant a six-month time limit to file it; failure to file the document shall lead to the refusal of the patent application according to the provisions of Art. 28 paragraph 2, letter g) of the Law.

(5) If the right to the grant of the patent was transferred after the date of filing, the transfer document shall be filed, in the original or in an authenticated copy, and the related fee shall be paid until a decision is made by OSIM; otherwise, the patent shall be granted on the applicant's name.

## ARTICLE 28

### **Exhibition certificate**

(1) Within 4 months from the patent application filing date, the applicant shall file with OSIM the exhibition certificate which constitutes the document to which reference is made in Art. 11 paragraph (2) of the Law and which shall contain:

a) denomination and registered office of the administration responsible for the industrial property protection in the exhibition in which the invention was displayed and that issued the certificate;

b) denomination of the exhibition, the place where it was carried on and date of opening the exhibition;

c) name and address of the natural person, or the namely the denomination and

registered office of the legal entity that submitted the subject-matter of the invention to the administration of the exhibition that exhibits it;

d) ascertainment that the invention was in fact displayed in the exhibition;

e) date of the first disclosure of the invention;

f) number and date of issuance of the certificate;

g) a copy of the description of the exhibited subject-matter, drawn up in the Romanian language, certified by the administration referred to under letter a), showing that the exhibited subject-matter is identical to the described one.

(2) In the situation referred to in paragraph (1) letter e), when the first disclosure of the invention is subsequent to the date of opening the exhibition, the certificate shall mention the date of the first disclosure.

(3) The certificate may be accompanied by a document for the identification of the inventor, authenticated by the administration provided for in paragraph (1) letter a) concerning the identification of the inventor.

(4) Where the certificate provided for in paragraph (1) is not filed in Romanian language, after having been notified by OSIM, the applicant shall file a certified translation thereof.

## SECTION 5

### **International applications filed with OSIM**

#### ARTICLE 29

### **Receiving and processing the international applications**

(1) OSIM shall be the receiving office for the international applications of the Romanian

applicants, natural persons or legal entities, of the applicants who have their residence in Romania or who have real and serious industrial or commercial enterprises in Romania, as provided for in Art. 3 of the Paris Convention.

(2) If an international application is submitted by more applicants it shall suffice for one of them to fulfil the provisions of paragraph (1).

(3) OSIM as a receiving office shall receive, check and transmit the international applications to the International Bureau, according to the Patent Cooperation Treaty and the Implementing Regulations under the Patent Cooperation Treaty.

(4) The international application shall be drafted in three copies by the applicant and shall meet the conditions provided for by the Patent Cooperation Treaty and the Implementing Regulations under the Patent Cooperation Treaty, the application form being the one elaborated by the International Bureau.

(5) The description, claims and abstract shall be drafted in one of the following languages: Romanian, French, English, German or Russian, at the applicant's option.

(6) Where the description, claims and abstract are drafted in Romanian, the applicant shall use an international application printed form in one of the other languages indicated in paragraph (5).

(7) The applicant may elect one of the offices designated in compliance with the provisions of Art. 16 of the Patent Cooperation Treaty, as an international search authority.

(8) Where the description, claims and drawings have been filed in another language than one of the languages accepted by the international search authority elected by the applicant, this shall file, within one month from the date of filing the application, a translation of the documents into the accepted language.

(9) Where the provisions of paragraph (1), (2) or (4) have not been fulfilled, the international application shall be deemed to be received by OSIM on behalf of the International Bureau, as a receiving office, and the whole documentation shall be transmitted to the International Bureau, subject to the payment, by the applicant, to the benefit of OSIM, of a fee in an amount equal to the transmittal fee.

(10) The applicant shall pay the following fees to OSIM as a receiving office:

a) fee for the transmittal to the International Bureau owed to OSIM as the receiving office, referred to in Rule 14 of the Implementing Regulations under the Patent Cooperation Treaty;

b) international registration fee referred to in Rule 15 of the Implementing Regulations under the Patent Cooperation Treaty;

c) international search fee referred to in Rule 16 paragraph (1) of the Implementing Regulations under the Patent Cooperation Treaty .

(11) The fees provided for in paragraph (10) letters b) and c) shall be collected by OSIM to the benefit of the International Bureau and of the international search authority and shall be transmitted to them.

(12) If one of the fees provided for in paragraph (10) has not been paid in due time or has partially been paid until the expiry of the time limit, Rule 16 bis of the Implementing Regulations under the Patent Cooperation Treaty shall apply.

(13) The proof of payment of the fees provided for in paragraph (10) and (12) shall be filed with OSIM by the applicant immediately after the payment of the fees.

(14) Where the translation has not been submitted within the time limit stipulated in paragraph (8), this may be submitted within one month from the notification, but not later than two months from filing the international application, subject to the payment of the fee for subsequently filing the translation of the international application

(15) Where the international application fulfils the conditions stipulated by the Patent Cooperation Treaty and the Implementing Regulations under the Patent Cooperation Treaty, OSIM, as the receiving office, shall accord the international filing date.

(16) A copy of the international application filed with OSIM shall be kept as witness copy and it shall not be rendered available to the public.

(17) Where, on the date of filing, the international application contains information classified as "state secret", or information relating to or in connection with the invention is subsequently classified as "state secret", according to the provisions of Art. 41 paragraph (2) of the Law, by the institutions habilitated for the national defense and safeguarding the national security, OSIM, as a receiving office shall not deal with the application as an international application, and consequently, it shall not transmit the application to the International Bureau

and to the international search authority and shall refund the fees provided under paragraph (10) that were collected.

(18) An international application for which OSIM is the receiving office shall be declared as being deemed to be withdrawn in the conditions provided for by the Patent Cooperation Treaty.

(19) If an international application claims the priority of an application having a filing date earlier than the priority date, the applicant may file an application according to Rule 26 bis 3 of the Implementing Regulations under the Patent Cooperation Treaty, subject to payment of a fee in an amount equal to the amount of the fee of an application for reinstatement.

(20) OSIM shall take the decision to accept the application referred to in paragraph (19) where it has been ascertained that the applicant made all efforts for filing the international application within the priority time limit or that the priority term was not exceeded by intention.

## ARTICLE 30

### **Procedures undergone by the international applications in the national phase**

(1) The provisions of this Article shall apply to the international applications for which Romania is a designated State, and elected State, as the case may be, according to the Patent Cooperation Treaty.

(2) An international application that was accorded an international filing date with a receiving office shall have the same effect as a patent application filed in Romania on the same date.

(3) If the applicant desires to continue the international application in Romania, within 30 months from the international filing date, or, if a priority has been claimed, from the date of priority, he shall open the national phase in Romania.

(4) The provisions of paragraph (3) shall also apply if, for justified reasons, the applicant opens the national phase within two months from the date of the expiry of the 30-month time limit, subject to payment of a fee in an amount equal to the amount of the fee for filing an

application for reinstatement.

(5) For opening the national phase in Romania, the applicant shall pay, to OSIM, the fee for filing the patent application and, where appropriate, the fee for claiming a priority, and shall file an explicit or implicit request for opening the national phase, and three copies of the certified translation into Romanian of the description, claims, drawings and abstract of the international application.

(6) Within the meaning of paragraph (5) the explicit request for opening the national phase shall be made by filing the form for opening the national phase, published by the International Bureau in the Patent Cooperation Treaty Applicant's Guide.

(7) The international applications for which the national phase has been opened shall be entered in the National Register of Filed Patent Applications.

(8) After the national phase has been opened, the international application shall be subjected to the procedures provided for by the Law and the present implementing regulations.

(9) If the applicant has paid the fees provided for in paragraph (5) and has justified the filing of the description, claims, drawings and abstract of the international application in a foreign language, the certified translation thereof into Romanian may be filed within two months from the date of opening the national phase, subject to payment of the legal fees.

(10) OSIM shall accept, upon request by the applicant, the continuation in Romania of only a part of the international application, and in this case he shall file the translation of that part only, and shall make a statement showing the parts of the international application not included in the translation and the reason for giving them up.

(11) When the applicant requested the opening of the national phase subsequently to the time limits referred to in paragraph (3) or paragraph (4), OSIM shall decide the rejection of the patent application.

(12) If the International Search Authority subjected to the international search only a part of the international application which relates to two or more inventions forming a single general inventive concept, the applicant may continue the international application in Romania for all the inventions contained therein, or according to paragraph (10).

(13) Where the applicant failed to submit the declarations mentioned in Rule 4.17 of the Implementing Regulations under the Patent Cooperation Treaty, to the International Bureau,

within the time limit provided for in Art. 22 or Art. 39 of the Patent Cooperation Treaty, any of these declarations may be filed with OSIM under the conditions provided for in the provisions of Art. 24 and Art. 27.

(14) Filing any of the documents provided for in Art. 24 and Art. 27 shall be accompanied by the proof of payment of a fee in an amount equal to that of the fee for completing the patent application by filing the missing part of the description of the invention.

(15) If OSIM considers that copies of the documents relating to said application, filed or issued according to the provisions of the Patent Cooperation Treaty and the Implementing Regulations under the Patent Cooperation Treaty are necessary for carrying on the procedures undergone by an international application entered in the national phase, these copies may be requested from the International Bureau.

(16) The translation provided for under paragraph (5) may be the translation of the description, claims and drawings submitted by the applicant on the date of filing the international application or any certified translation of the description or claims, as modified during the procedures undergone by the application in the international phase.

(17) For the international application entered in the national phase, the applicant may transmit to OSIM any of the certified translations of the description or claims as amended during the procedures the application undergoes in the international phase; the amendments shall not go beyond the limits of the disclosure of the invention in the international application, as filed with the receiving office.

(18) Where the applicant fails to send the translation of the claims as originally filed, OSIM shall notify the same to submit the translation within 90 days; in case where the missing translation is not submitted within the time limit specified in the notification, OSIM shall carry on the procedures based on the filed translated claims.

(19) Where the applicant has opened the national phase according to the provisions of Art. 22 of the Patent Cooperation Treaty, even if Romania is also an elected state, he cannot open the national phase according to the provisions of Art. 39 of the Patent Cooperation Treaty.

(20) If the applicant, under the conditions provided for by the Patent Cooperation Treaty withdraws the request for the international preliminary examination or withdraws the election

of Romania, then Romania remains a designated State.

(21) The description, claims and drawings of the international application for which the national phase was opened in Romania, translated into Romanian, shall be published immediately after the expiry of a six-month time limit from the date of opening the national phase, according to the provisions of Art. 23 of the Law.

(22) However, the application cannot be published earlier than 20 months from the date of filing or from the date of the claimed priority, without the applicant's consent.

(23) Where a search report is requested according to the provisions of Art. 24 of the Law, this shall be drawn up based on the translation of the description, claims and drawings indicated by the applicant.

(24) The examination procedure of the international application which entered the national phase shall start after the expiry of the time limit referred to under paragraph (3) and only upon express request by the applicant, drawn up before this time limit.

(25) Where both the initial and the amended claims have been filed with OSIM, upon request by the applicant, either the initial or the amended claims shall be subjected to the examination procedure, the applicant having the possibility to amend the description, claims and drawings during the national phase, within the time limits stipulated by the Law and the present Regulations.

(26) An international application shall not have effects in Romania if the applicant has withdrawn the international application or the designation of Romania or the application is in one of the situations referred to under Art. 12 paragraph (3), Art. 4 paragraph (1) letter b), Art. 14 paragraph (3) or (4) of the Patent Cooperation Treaty, the national phase has not been opened, the regional phase has not been opened with the European Patent Office, the regional phase has been opened with the European Patent Office but Romania is not a designated State.

(27) Within 4 months from opening the national phase, the applicant may correct, subject to payment of the legal fee, the deficiencies in the priority indicated during the international phase procedure.

(28) OSIM shall recognize the priority claimed in an international application having a filing date, subsequent to the priority time limit, provided that the applicant requests within 2

months from the opening of the national phase, subject to payment of the legal fee, the reinstatement of priority right according to the provisions of Art. 20 paragraph (7) of the Law and of Art. 10 paragraph (18).

## ARTICLE 31

### **Review of international application by OSIM**

(1) The provisions of the present Article shall apply to the international applications wherein Romania is a designated State.

(2) If a receiving office refused to accord a filing date to an international application or decided that the application or the designation of Romania is deemed to be withdrawn, OSIM shall, upon request by the applicant, analyze the decision in order to establish whether it is justified, with a view to carrying out the procedures by the national route, and shall review it, where appropriate.

(3) The provisions of paragraph (2) may be applied following to any notification of the International Bureau, according to which an application is deemed to be withdrawn.

(4) A request for review shall be presented by the applicant to the International Bureau prior to the expiry of the time limit provided for by Rule 51.1 of the Implementing Regulations underent Cooperation Treaty, in order that a copy of all the documents annexed to the international application should be transmitted by the International Bureau to OSIM; OSIM shall comply with the request for review prior to the expiry of the time limit, provided that the applicant files a translation of the application with OSIM and pays a fee in an equal amount to the fee for lodging an appeal.

(5) If OSIM states that the decision of the receiving office or of the International Bureau was not justified, the application shall be subjected to the procedures provided for by the Law and the present regulations.

(6) If an international filing date has not been accorded by the receiving office, the filing date of the application shall be the date on which OSIM considers that the filing date should have been accorded.

(7) If the international application fulfils the requirements concerning the form and

substance provided for by the Patent Cooperation Treaty, the application shall have the effects of a national application in Romania from the date of filing.

## SECTION 6

### **The european patent application designating Romania and European patent with effects in Romania**

#### ARTICLE 32

#### **European patent application and European patent**

The European patent applications and the European patents with effects in Romania shall be dealt with by OSIM according to the legislation in force.

## CHAPTER II

### **Examination of patent applications**

#### SECTION 1

#### **Preliminary examination procedure**

#### ARTICLE 33

#### **Examination of the regular national filing**

(1) After receiving the patent application, OSIM checks the fulfilment of the conditions for according the filing date and at the same time indicates, together with the time limit for remedying, the possible drawbacks that have been ascertained, such as:

- a) failure to file the form according to the provisions of Art. 14;
- b) lack of applicant's or professional representative's signature on the form;
- c) lack of writing of the applicant's or professional representative's identification data, in Latin characters, according to Art. 6 paragraph (5);
- d) lack of the title of the invention on the form;
- e) lack of the translation into Romanian of the description, claims and drawings contained in the patent application;
- f) lack of the proof of payment of the legal fees concerning the subsequent translation into Romanian of the description, claims and drawings or of the claims and/or drawings, as the case may be;
- g) lack of the professional representative's power of attorney, where the applicant mentioned his representation in the application;

h) failure to indicate the legal provisions based on which the applicant is entitled to be granted the patent, including the lack of the document proving this;

i) lack of the claims and/or drawings;

j) lack of the abstract.

(2) In the situation provided for in paragraph (1) letter b), a copy of the patent application form shall be transmitted to the applicant or the professional representative, as the case may be, to assign it. Where the form does not contain the signature of all applicants, the absence of signature shall be justified, otherwise, the application shall be refused.

(3) If the provisions of Art. 14 paragraph (1) or Art. 16 paragraph (1) of the Law are complied with, OSIM shall accord the filing date, notify the applicant of the filing date and number, and the patent application shall continue the preliminary examination procedure, wherein the following are analyzed:

a) the applicant's entitlement to the patent for invention, when he is not the inventor;

b) the professional representative's right to represent the applicant before OSIM;

c) whether the inventors have been declared;

d) whether the conventional priority has correctly been claimed and sustained by the priority documents filed with OSIM;

e) whether the fees have been paid in the amount and within the time limits corresponding to the procedures requested in the patent application;

f) the fulfilment of the material conditions concerning the patent application, under Art. 20;

g) whether the invention fulfils the provisions of Art. 8 paragraph (1) or of Art. 9 letters b)- d) of the Law;

h) whether the invention fulfils the provisions of Art. 9 letter a) of the Law;

i) whether the application results by dividing an earlier application, when this fact is mentioned in the application;

j) the fulfilment of the conditions concerning the drawing up of the description, claims and drawings, so that at first sight the invention is disclosed within the patent application according to the provisions of Art. 18 of the Law;

k) the fulfilment of the conditions referred to in Art. 24 in respect of the document certifying the deposition of the biological material with an international depository institution;

l) whether the patent application containing a group of inventions fulfils, at first sight, the unity of the invention, according to the provisions of Art. 19 paragraph (1) of the Law.

(4) After the examination, according to the provisions of the paragraph (3), the applicant is notified of the results of the analysis and is granted a time period for answering.

(5) As a consequence of the notification sent according to the provisions of paragraph (4) or from his own initiative, the applicant may send the modified description, claims and drawings, where appropriate, according to the provisions of Art. 27 paragraph (5) of the Law and Art. 37.

(6) The preliminary examination board shall make decisions within the preliminary examination procedure in compliance with the provisions of Art. 28 paragraph (2), letters a), c), d), f), g) and h) of the Law.

## ARTICLE 34

### **Classification of the patent application**

(1) OSIM shall classify the patent application according to the edition in force of the international patent classification established by the Strasbourg Agreement, assigning classification indices which allow the identification of the claimed invention and of the additional information contained in the patent application.

(2) After checking the fulfilment of the provisions of Art. 14 paragraph (1) or of Art. 16 paragraph (1) of the Law, as the case may be, the patent application as filed shall be initially classified in the preliminary examination procedure, based on the claims.

(3) The classification of the patent applications failing to comply with the provisions of Art. 18 of the Law in respect of the sufficiently clear and complete disclosure, that are to be published, shall be based on what the invention seems to be, as far as it can be understood.

(4) Where it has been ascertained that the patent application does not obviously meet the condition stipulated in Art. 19 paragraph (1) of the Law, all the claimed inventions shall be classified with a view to publication.

(5) The initial classification according to paragraph (2) is confirmed, completed or modified during the patent application search and examination procedures, according to the provisions of Art. 26 of the Law.

(6) The classification may also undergo modifications as a consequence of limitation of the granted patent, according to Art. 51 paragraph (2) of the Law.

## SECTION 2

### **publication of the patent application**

## ARTICLE 35

### **Publication conditions**

(1) Where the patent application for which the fees for filing or opening the national phase and for publication have been paid according to the provisions of Art. 43 paragraph (1) of the Law fulfils the provisions of Art. 14, paragraph (1) or Art. 16 paragraph (1) of the Law and, one month before the date of publication, a decision to refuse the application has not been made, or OSIM has not taken note of the withdrawal of the patent application or the application has not been declared as deemed to be withdrawn under Art. 28 of the Law, said patent application shall be published, on condition that the time limits provided for in Art. 23 paragraphs (1) - (5) of the Law are observed.

(2) In the cases provided for in Art. 23 paragraphs (1), (2), (4) and (5) of the Law, whether the publication of the patent application has not been expressly requested in writing, but proof was made of the payment of the publication fee in the legal amount and within the legal time limits, it is considered that the applicant agreed to the publication.

(3) The publication of the application may be requested only by the applicant or professional representative who also owes the publication fee.

(4) If another person than the applicant or the professional representative thereof has requested the publication and/or paid the publication fee, OSIM shall not comply with the publication procedure; however, if the applicant or the professional representative, as the case may be, agrees with the payment of the publication fee by another person, this shall communicate his agreement to OSIM which shall comply with the publication of the application.

(5) In the absence of the agreement provided for in paragraph (4) the amount paid shall be considered to be undue and shall be refunded to the person that has paid it, in the conditions provided for in Art. 4 paragraph (9).

(6) Where the legal conditions for the publication of the patent application are fulfilled, the applicant shall be notified about the date of publication of the application and about the fact that the publication fee shall not be refunded, whatever may happen to this application subsequently.

(7) In case of failure to observe the deadlines for payment and the amount of the fee for publication, OSIM shall declare the application as deemed to be withdrawn in compliance with the provisions of Art. 28 paragraph (4) letter f) of the Law.

(8) For the patent applications that are in the situation provided for in Art. 23 paragraph (4) of the Law, the application publication fee is deemed being included in the amount of the examination fee.

(9) Where the applicant or the professional representative, as the case may be, has requested the examination of the patent application subsequently to the filing date and has

paid the application examination fee without paying the publication fee therefor, OSIM shall not comply with the substantive examination procedure and shall notify the applicant, granting the same a new two-month time limit during which the applicant shall communicate to OSIM his option concerning the selection of one of the following variants:

a) to pay the publication fee;

b) to communicate his agreement that OSIM should retain the amount of the publication fee from the paid examination fee and to prove, within the granted time limit, the payment of the difference for completing the legal amount of the examination fee.

(10) If, within the time limit granted by OSIM according to paragraph (9), the applicant or the professional representative, as the case may be, does not comply with any one of the variants referred to under letter a) or b), OSIM shall declare the application as deemed to be withdrawn, in compliance with the provisions of Art. 28 paragraph (4) letter f) of the Law and the examination fee shall be refunded in the conditions provided for in Art. 4 paragraph (9).

(11) The patent application publication in compliance with Art. 23 paragraph (3) of the Law shall be made not earlier than 4 months from the filing date or from the date of opening the national phase, or, if a conventional priority was recognized, not earlier than 4 months from the filing date or 16 months from the date of the claimed priority date.

(12) According to Art. 23 paragraph (7) of the Law, the patent application publication is made by rendering available to the public, at OSIM headquarters, the description, claims and, where appropriate, drawings of the patent application as filed, and the date of publication shall be the date of the issuance of BOPI containing the mention of application publication.

(13) The following data are rendered available to public through the publication of the patent application:

a) application number and filing date;

b) international classification index according to Art. 34;

c) standard code for the identification of various types of patent documents;

d) title of the invention;

e) applicant's identification data;

f) identification data of the professional representative appointed by the applicant;

g) inventor's identification data;

h) date, number and State of filing the earlier application whose priority has been claimed;

i) number and date of international application filing;

j) number and date of the international publication of the international application;

k) date of publication of the application;

- l) application abstract agreed upon by the applicant under signature;
- m) number of the claims and figures of the patent application;
- n) figure or figures indicated by the applicant to be published.

(14) The mention of patent application publication in BOPI, according to Art. 23 paragraph (7) of the Law shall comprise at least the indications provided for in paragraph (13) letters a) - k).

(15) If after the preliminary examination of the application, according to Art. 33 paragraph (3) letter l), OSIM ascertains that the patent application is obviously non-unitary, it shall notify the applicant accordingly, informing him about the fact that he has the possibility of dividing the application within two months at the latest before the date of publication thereof.

(16) Where the applicant, after having been notified or by his own initiative has divided the patent application within the time limit referred to in paragraph (15), OSIM shall publish the description, claims and, where appropriate, the original drawings as well as the claims of the invention or group of inventions remained by dividing this application.

(17) If the applicant has failed to divide the patent application within the time limit referred to under paragraph (15), OSIM shall publish the application in the non-unitary form.

(18) The application resulting from dividing an initial patent application shall be published within 3 months from the date of filing with OSIM, but not earlier than 18 months from the filing date of the basic application, or, if a priority has been claimed, from the date of priority thereof.

(19) In the situation provided for in paragraph (18) in the part edited by OSIM there shall be published the number and date of filing the basic application from which the new application resulted by division.

(20) OSIM shall, at the time of publishing the patent application, also publish the last modification brought to the patent application, in the following conditions:

a) it was made following to OSIM notification, according to Art. 33 paragraph (4) or following the search report, according to Art. 24 of the Law, or after the notification under Art. 43 paragraph (2) and it complies with the provisions of Art. 27 paragraph (5) of the Law and Art. 37;

b) there are fulfilled the provisions of paragraph (3) or paragraph (4);

c) the documents provided for under letter a) were filed at least two months before the date of publication; and

d) the fee for publication of the modifications has been paid.

(21) Where the publication of the patent application is made according to Art. 23

paragraph (4) of the Law, OSIM shall publish the description, claims and, where appropriate, the drawings that constitute the regular national filing as well as the amended claims that were subjected to the substantive examination, where appropriate

(22) If the claims have been filed with OSIM subsequently to the filing date of the application, this mention shall be made at the time of publication. If the claims were modified before the completion of the technical preparations related to the publication of the application, the new amended claims shall be included in the published application, together with the original claims, provided that the provisions of Art. 27 paragraph (5) of the Law are fulfilled.

(23) After the publication of the patent application, OSIM shall, by observing the legal provisions, publish all the modifications occurred in the legal status of the patent application after the date of filing, such as the modification of the person entitled to be granted the patent or the inventor, according to the provisions of Art. 66 paragraph (2) letter a) of the Law, the mention of the decision to grant or refuse the application according to Art. 28 paragraph (1) or (2) of the Law and Art. 66 paragraph (2) letter c) of the Law or the mention that the application was withdrawn or declared to be deemed being withdrawn according to Art. 28 paragraph (3) or (4) of the Law.

(24) Where a decision to refuse the application remained final and irrevocable or the patent application has been withdrawn or declared as deemed to be withdrawn, the applicant shall not benefit by the provisions of Art. 33 of the Law.

## ARTICLE 36

### **Elements not to be published**

(1) The patent application rendered available to the public shall not contain:

- a) texts and/or drawings contrary to public order or morality;
- b) allegations disparaging products, processes or assessment of the value of the patent applications or patents of third parties;
- c) elements obviously irrelevant or useless in connection with the disclosure of the invention.

(2) The mere comparison of the claimed invention with the state of the art, performed by an applicant shall not be deemed being disparaging in itself.

(3) Where the patent application contains elements as the ones provided for in

paragraph (1), OSIM shall omit them from publication, indicating their place within the submitted documentation and the number of words and/or drawings that have not been published.

(4) OSIM shall notify the applicant, or the professional representative, as the case may be, in respect of the elements omitted from publication and shall send him a copy of the application rendered available to the public.

(5) The modifications brought to the patent application by own initiative or as a consequence of an OSIM notification, which do not comply with the provisions of Art. 27 paragraph (5) of the Law shall not be rendered available to the public.

(6) The documents attached to the patent application that shall not be made available to the public on or after the date of publication of the application are the following:

a) internal documents of OSIM;

b) documents relating to the inventor who requested that his identity should not be rendered available to the public;

c) any other document not corresponding to the purpose of informing the public with regard to the patent application or patent.

## ARTICLE 37

### **Disclosure of the invention**

(1) An invention is deemed to fulfil the provisions of Art. 18 paragraph (1) of the Law, if the patent application contains sufficient technical information to allow a person skilled in the art to carry out the invention as claimed, without any inventive step, and if it allows the third parties to understand the contribution the claimed invention brings to the state of the art.

(2) According to Art. (18) paragraph (1) of the Law, the clear and complete disclosure of the invention shall have in view the patent application considered in whole, including the description, claims and drawings, as the case may be.

(3) The disclosure of the invention within the meaning of Art. 18 paragraph (1) of the Law shall be made by the applicant on the the patent application filing date.

(4) If OSIM considers the provisions of paragraphs (1)-(3) not to be fulfilled, the applicant is notified about this.

(5) As a consequence of the notification sent according to paragraph (4), the applicant or the professional representative, as the case may be, may modify the patent application, while observing the provisions of Art. 27 paragraph (5) of the Law.

(6) The changes brought by the applicant or the professional representative, as the

case may be, during the preliminary or substantive examination shall be accepted by OSIM, if they:

a) refer to features existing in the description and drawings in the regular national filing and contain specifications and explanations relating thereto;

b) refer to the content of the claims, but are based on features existing in the description and drawings in the regular national filing;

c) refer to drawings, but are based on features existing in the description, or, as the case may be, they refer to the description, but are based on features existing in the drawings;

d) are meant for a better understanding of the invention, though not contained in the regular national filing of the patent application and are not the subject-matter of new claims or do not introduce new features in the original claims.

(7) The amendments performed according to paragraph (6) shall be visibly indicated on the initial description or shall be contained in a description where they are also marked. The sheets containing these amendments shall be A4 format, and the text shall be made-up on computer or typing machine, otherwise, the correspondence shall be attached to the patent application file, but shall not be considered during the examination thereof.

(8) The description, claims and amended drawings, where appropriate, shall be filed with OSIM, either as retyped sheets or, redrawn figures, or in an entirely modified form; all the pages, including the ones containing figures, shall be signed by the applicant and shall be subjected to the procedures the patent application undergoes, provided that the provisions of Art. 27 paragraph (5) of the Law are fulfilled.

(9) Where the modifications brought cannot be accepted for failure to comply with the provisions of Art. 27 paragraph (5) of the Law, OSIM shall notify the applicant about this, showing that they shall not be subjected to the procedures the application is to undergo, granting him a time limit to respond.

(10) If after the examination of the brought modifications it has been ascertained that they meet the provisions of Art. 27 paragraph (5) of the Law, the examination procedure shall continue by analyzing the fulfilment of the patentability conditions, the accepted modifications being also considered.

(11) If the applicant, or where appropriate, the professional representative fails to respond to the notification referred to in paragraph (4) or paragraph (8) or to bring arguments in sustaining the acceptance of these modifications, the provisions of Art. 18 paragraph (1) of the Law are considered not to be fulfilled and the patent application shall be refused or accepted in part, as the case may be.

ARTICLE 38  
**State of the art**

(1) In the application of Art. 10 paragraph (2) and paragraph (3) of the Law, the patent application filing date shall be interpreted, where appropriate, as being the date of priority of the application.

(2) In the application of Art. (10) paragraph (2) of the Law, the knowledge available to the public means the information available to the public, anywhere in the world, by:

a) presentation of patent documents or other information on various carriers or on different informational channels ;

b) oral description of information that was not subject to any restriction of confidentiality concerning the use or dissemination of this information.

(3) The date on which the knowledge according to paragraph (2) have become available to the public shall be identifiable.

(4) Where the available information according to paragraph (2) contains indications concerning only the month in a certain year or only the year, this information is deemed to have become available to the public in the last day of the month, or the last day of the year, respectively

(5) Available to the public, within the meaning of paragraph (2) also means that the document comprising the information or the public oral presentation thereof is to be found in a public library with unrestricted access.

(6) Public within the meaning of Art. 10 paragraph (2) means one or more persons not bound by confidentiality and which could disseminate information; the public may be any person and not necessarily a person skilled in the art.

(7) The oral disclosure within the meaning of Art. 10 paragraph (2) of the Law may consist of a presentation in a conference, broadcasting programs, recordings on sound reproducing carriers, such as tapes, discs or the like.

(8) The information is deemed to have become available to the public by use, within the meaning of Art. 10, paragraph (2) of the Law, if, on the relevant date, any person could take possession of said information by the displaying or use thereof. If a person sells an item to a third party, without any limitations, restrictions or obligations regarding the confidentiality, the item is deemed to have been rendered available to the public.

(9) The knowledge become available to the public by oral means, by use or any other means shall be deemed to belong to the state of the art, only if it is confirmed by a document containing it and demonstrating the date on which it became available to the public and that

represents the relevant document date.

(10) The content of the patent applications within the meaning of Art. 10 paragraph (3) of the Law means the disclosure of the invention in the description, claims and drawings, the explicitly presented state of the art, included.

(11) The applications provided for by Art. 31 paragraph (6) and (7) belong to the state of the art, provided that they are available to the public according to Art. 23 of the Law.

(12) If a patent application was refused or withdrawn prior to its publication, it did not help as a basis for claiming a right of priority and did not allow the subsistence of rights, this shall not be deemed to belong to the prior art.

## ARTICLE 39

### **Unity of invention**

(1) In the application of Art. 19 paragraph (1) of the Law, the condition that the patent application should relate only to a single invention is fulfilled if the technical problem that the invention proposes to solve is unitary and all its essential technical features are necessary or at least adequate for solving this problem.

(2) Where a group of inventions is claimed in the patent application, the condition stipulated in Art. 19 paragraph (1) of the Law on the unity of invention shall be fulfilled only when there is a technical relationship among these inventions involving one or more identical or corresponding special technical features; the expression "special technical features" shall mean those technical features which define a contribution which each of the claimed inventions, considered as a whole, makes over the state of the art.

(3) The determination of the existence of a single general inventive concept in case of a group of inventions shall be made without regard to whether each invention is claimed in separate claims or as alternatives within a single claim.

(4) General inventive concept within the meaning of paragraph (3) may consist of:

a) solutions to more technical problems, if based on the technical interdependence thereof, they are subsumed to a single general unitary problem;

b) independent technical solutions, if the solved technical problem is new, or though it is not new, it is solved for the first time;

c) related technological solutions to a single technical problem;

d) unitary effect obtained by more inventions; or

e) claims of various categories, if they present a technical interdependence relationship.

(5) Within the meaning of paragraph (4), any of the following combinations of

independent claims of different categories shall be allowed in the same patent application:

a) in addition to an independent claim for a given product, an independent claim for a process specially adapted for manufacturing the product and an independent claim for the use of said product;

b) in addition to an independent claim for a given process, an independent claim for a device or a means specially conceived for the application of the said process, or

c) in addition to an independent claim for a given product, an independent claim for a process specially adapted for the fabrication of the product and an independent claim for a device or means specially conceived for the application of the process.

(6) List of combinations of independent claims under paragraph (5) shall not be exhaustive, other combinations being possible, while observing the provisions of Art. 39 paragraph (2).

(7) Within the meaning of paragraph (5) a process is specially adapted for the fabrication of the product, if said process leads directly to obtaining the claimed product; also, a device or a means is specially conceived for carrying out the process, if the device or means is suitable for carrying out the process, there existing a technical relationship, as defined under paragraph (2), between the device or means and the claimed process.

(8) If a patent application fails to fulfil the provisions of Art. 19 paragraph (1) of the Law, the patent application is deemed being non-unitary and the invention shall be divided for the protection of all the claimed inventions.

(9) In the application of Art. (19) paragraph (2) the Law where an application is found to be non-unitary, OSIM shall notify the applicant or, where appropriate, the professional representative thereof, about this, inviting his to submit a written option concerning the division of the application.

(10) The applicant or the professional representative, as the case may be, has the opportunity to divide the application by filing a divisional patent application for each invention or group of inventions fulfilling the condition of unity of the invention.

(11) In the application of the provisions Art. 19 paragraph (3) of the Law, where multiple priorities have been claimed in the original patent application, the applicant shall indicate the corresponding priority in each divisional application.

(12) If after the notification under paragraph (9) the applicant or the professional representative, as the case may be, does not express the option relating to the division of the application, OSIM shall examine the patent application considering that the subject-matter is the first invention or the first group of inventions claimed observing the condition of unity.

(13) If, until a decision is made for the original application, the applicant failed to file

patent applications for the inventions not complying with the condition of unity of the invention, these will remain in the description, but without being the subject-matter of the claims.

(14) Where the applicant or the professional representative, as the case may be, has failed to file divisional patent applications and OSIM has examined the patent application whose subject-matter is the first invention or the first group of inventions fulfilling the condition of unity of the invention, the protection by patent shall be considered not to have been claimed for the other claimed inventions contained in the original application which is the basic application.

(15) The lack of unity of a patent application cannot be invoked within the actions of revocation or cancellation of a patent, according to the provisions of Art. 52 and 54 of the Law.

## ARTICLE 40

### **Drawing up and publishing the search report**

(1) The search report according to the provisions of Art. 24 of the Law shall supply, after its publication, information relating to the relevant state of the art in respect of the invention contained in the patent application claims to the applicant and third parties.

(2) OSIM shall proceed to drawing up and publishing the search report according to the provisions of Art. 24 paragraph (1) of the Law, where the applicant submits a request and the proof of payment of the legal fee.

(3) For the drawing up of a search report for a national application by OSIM, until the expiration of a ten-month period from the date of filing, the applicant shall file the application according to the provisions of paragraph (2) within maximum 3 months from the filing date.

(4) Where the fee for drawing up and publishing the search report is included in the examination fee, by the payment thereof within the legal time period, the requirements of paragraph (2) are deemed being fulfilled.

(5) The patent application may be subjected to the procedure of drawing up and publication of the search report with or without written opinion, if the date of the written request is until the 20<sup>th</sup> month from the filing date of the application or from the opening of the national phase.

(6) The publication of the search report according to the provisions of Art. 24 paragraph (1) of the Law shall be made at the time of publication of the application, immediately after the expiration of an 18-month time period of the filing date of the application or subsequently to the publication of the application.

(7) OSIM shall draw up the search report based on the regular national filing

constituted according to Art. 16 paragraph (4) of the Law.

(8) The applicant may request the search report to be drawn up based on the description, claims and, where appropriate, drawings modified on his own initiative or as a consequence of an OSIM notification, provided that they meet the provisions of Art. 27 paragraph (5) of the Law.

(9) In the situation provided for in paragraph (7) the applicant shall also pay the fee for the publication of the modifications brought to a patent application, where the request for drawing up the search report was made before ending the preparations for the publication of the application.

(10) OSIM shall notify the applicant that the search report cannot be made in the following conditions:

a) the request for drawing up the search report has been filed after the time limit referred to under paragraph (5);

b) the legal fee has not been paid in the legal amount and time limits;

c) the invention that is the subject-matter of the patent application meets the provisions of Art. 9 or Art. 8 paragraph (1) of the Law, or it does not fulfil the provisions of Art. 18 or Art. 7 paragraph (2) of the Law;

d) OSIM has made a decision to refuse the patent application, has taken note of the withdrawal of the application or has declared the application as being deemed to be withdrawn before the date of requesting the search report;

e) the patent application meets with the provisions of Art. 40 paragraph (2) of the Law;

f) the legal conditions for the publication of the application are fulfilled according to Art. 23 paragraph (4) of the Law;

g) the patent application filing does not have the effects of a regular national filing.

(11) In the situation under paragraph (10) letters a), d), e), f) and g) the fee for drawing up the search report shall be refunded.

(12) In the situation under paragraph (10) letter c) OSIM shall publish the mention of the fact that the search report could not be drawn up.

(13) If during the procedure of drawing up the search report it has been ascertained that the patent application contains two or more inventions failing to comply with the condition of unity of invention according to the provisions of Art. 19 paragraph (1) of the Law, the applicant shall be notified about the lack of unity of invention and asked:

a) to indicate the invention or group of inventions in the filing for which the search report can be drawn up based on the paid fee, or

b) to pay the fee for also drawing up the search report for the other inventions.

(14) If, within the period of time granted by OSIM, the applicant failed to transmit the indication under paragraph (13) letter a) or to pay the fee referred to under paragraph (13) letter b), the search report shall be drawn up for the first claimed invention or unitary group of inventions.

(15) The search report according to the provisions of Art. 24 of the Law shall be transmitted to the applicant together with the copies of the relevant parts of the cited documents, on paper, magnetic carrier or in electronic form. In case of copies on paper carrier, the equivalent value of the copy shall be paid.

(16) If the search report is accompanied by a written opinion, according to Art. 41 paragraph (8), the applicant shall be notified, and OSIM shall not render the written opinion available to the public.

(17) The search report shall be published after the expiration of the time limit for the response granted in the notification referred to in paragraph (13).

(18) The publication of the search report according to Art. 24 of the Law shall be made by rendering it available to the public at the OSIM headquarters, on the date of publication of the mention of drawing up the report in BOPI.

(19) In the situation when, after the date of the search report, the applicant transmits to OSIM the amended claims complying with the provisions of Art. 27 paragraph (5) of the Law, during the substantive examination procedure, a supplement of the search report shall be drawn up for the new elements introduced into the claims.

## ARTICLE 41

### **Content of the search report**

(1) For the purpose of determining the relevant state of the art for a patent application, OSIM shall establish, based on claims, description and drawings, the relevant documents to be cited in a search report.

(2) In the search report there shall be cited the documents contained in the state of the art defined according to Art. 38, available on the date of drawing up the same, that can be considered for assessing the novelty and the inventive step, there being indicated, for each citation, the claim in the patent application referred to; there shall be indicated the degree of relevance thereof, by using the internationally assigned symbols as well as the relevant parts of the cited documents, where appropriate.

(3) The search report shall not contain any appreciation relating to the fulfilment or non-fulfilment of the patentability conditions except those under paragraph (2).

(4) The international classification indices assigned to the subject-matter of the patent application shall be written in the search report.

(5) The search report shall distinguish between the cited documents published before the date of the priority claimed, between the priority date and the date of filing and on or after the date of filing.

(6) If after the analysis of the patent application OSIM considers that it does not meet the provisions for carrying out a meaningful search in the state of the art, on the basis of all or only some claims, it shall either declare that the search is not possible, situation in which the fee shall not be refunded, or shall, in so far as applicable, draw up a partial search report; the declaration and the partial report shall be considered for the purposes of the subsequent proceedings that the patent application undergoes.

(7) The search report shall be communicated to the applicant according to Art. 24 paragraph (1) of the Law within a time limit allowing him to respond up to ending the preparations for publication.

(8) A written opinion contains observations relating to the fulfilment of the provisions of Art. 18 of the Law.

(9) The written opinion accompanying the search report according to Art. 24 paragraph (1) of the Law shall contain a concise appreciation with regard to novelty, inventive step and industrial applicability of each claim in the patent application as well as explanations in respect of the relevance of documents cited in the report relative to the corresponding claims.

(10) Until the completion of the preparations for publication, the applicant may transmit his viewpoint to the written opinion, accompanied, where appropriate, by the modification of the application, there being fulfilled the provisions of Art. 27 paragraph (5) of the Law.

## ARTICLE 42

### **Conditions for starting the substantive examination**

(1) The procedure of patent application substantive examination shall start only subject to payment of the adequate fee, in the amount and the time limits stipulated by the Law.

(2) The patent application examination fee may be paid in the legal amount, without going beyond the 3-month time limit from the written request of the examination, that may be performed up to the 30<sup>th</sup> month from the filing date.

(3) Where the fee referred to under paragraph (2) has been paid, the substantive

examination of the patent application shall be performed only subject to payment of the publication fee; otherwise the provisions of Art. 35 paragraph (9) shall apply.

(4) If the patent application has been published, any person may request the substantive examination and may pay the fee, communicating the number and date of the patent application filing as well as the name of the applicant to OSIM, and OSIM shall notify the applicant that the examination fee has been paid and shall start with the substantive examination of the application.

(5) If the examination fee for a national patent application is paid within three months from the date of filing of the application, in the amount established by the Law, the fee for drawing up and publishing a search report shall be considered to be included therein and the publication of the report shall be performed at the time of publication of the patent application.

(6) In the situation provided for in paragraph (5), if the applicant requests the drawing up and the publication of a search report and pays the legal fee- this shall be refunded to the applicant.

(7) In case there is requested a search report with a written opinion concerning the patentability and the corresponding legal fee is paid, the fee for patent application examination within 18 months from the filing date shall be paid in an amount reduced by the value of the fee for drawing up the report with written opinion.

(8) The substantive examination of the patent application shall start after:

- a) receiving the applicant's response, or
- b) the expiration of the period for response to the written opinion transmitted, and shall have in view the appreciations contained in the search report.

## ARTICLE 43

### **Substantive examination procedure**

(1) OSIM shall perform the substantive examination of the patent applications in each specialized field, in the order of the filing date, and subject to payment of the examination fee.

(2) The substantive examination procedure is deemed being started if OSIM transmitted the applicant at least one notification in compliance with the provisions of Art. 26 B letters a), b), c) of the Law.

(3) Any notification according to the provisions of paragraph (2) shall contain the reasons for the limitation or refusal of the patent and their legal grounds.

(4) In case of the notifications relating to the fulfilment of the patentability conditions within the meaning of Art. 26 B letter c) of the Law OSIM shall transmit the applicant or the

professional representative, as the case may be, together with the notification, the copy of the part of the pertinent document which the notification concretely refers to.

(5) Upon request and subject to payment of the corresponding fee, OSIM shall transmit the applicant or the professional representative, as the case may be, copies of the documentary material in extenso, according to the provisions of paragraph (4) or of the reference bibliographical material indicated thereby.

(6) The examination shall have in view the modifications transmitted as a consequence of the notification under paragraph (2) which fulfil the provisions of Art. 27 paragraph (5) of the Law.

(7) In the application of the provisions of Art. 26 paragraph (1) letter b) of the Law the substantive examination of a patent application shall follow in successive order the fulfilment of the conditions provided for in Art. 7 paragraph (1) of the Law, as follows:

- a) the existence of an invention belonging to any technological field;
- b) if the invention is susceptible of industrial application;
- c) if the invention is novel;
- d) if the invention involves an inventive step.

(8) In the application of paragraph (6) the invention shall have a technical character and shall be able to be carried out by a person skilled in the art according to Art. 18 paragraph (1) or (2) of the Law.

(9) The technical character of an invention according to paragraph (8) may be given by the fact that the invention:

- a) refers to a technical field according to the provisions of Art. 16 paragraph (1) letter b);
- b) refers to a technical problem according to Art. 16 paragraph (1) letter d);
- c) presents at least an essential technical features defining in the claims the subject-matter for which protection is requested.

(10) The subject-matter of a patent application fulfils the condition under paragraph (7) letter a) if, considered in itself, it is not excluded from patentability, within the meaning of Art. (8) paragraph (1) of the Law, and if irrespective of the form or kind of the patent claim it presents a technical character according to paragraph (9).

## ARTICLE 44

### **Exclusions and exceptions from patentability**

(1) In the application of the provisions of Art. 8 paragraph (2) of the Law the subject-matter or activities claimed in the patent application shall be patentable if they if they have a technical character, according to Art. 43 paragraph (8).

(2) In the application of Art. (8) paragraph (1) of the Law:

a) the discovery per se of a substance or of an object existing freely in the nature or the mere discovery of a new feature of a known material is not patentable;

b) a scientific theory per se, as well as a theory explaining or substantiating practices previously carried out empirically shall not be patentable;

c) the mathematical methods are considered to be particular cases of the methods for exercising mental activities, according to Art. 8 paragraph (1) letter c) of the Law.

(3) The aesthetic creation within the meaning of Art. 8 paragraph (1) letter b) of the Law refers, by definition, to a product which does not present technical features. The aesthetic effect per se is not patentable either as a product or as a process.

(4) However, the technical means, products or processes for obtaining an aesthetic effect are patentable.

(5) In the application of the provisions of Art. (8) paragraph (1) letter c) of the Law, the construction drafts, patterns for making clothes articles, methods of training for people and animals, musical scores, shorthand-typing systems, accounting and financing systems or systems for managing affairs, advertising, rules for practicing various games or the mere posology of a medicament and the like are not patentable.

(6) In the application of the provisions of Art. (8) paragraph (1) letter d) of the Law, the presentation of information per se, characterized only by the content thereof is not patentable, but the information carrier or the process for transmitting the information may be patentable.

(7) In the application of Art. 8 paragraph (1) letter c) of the Law, the computer programs per se shall not be considered inventions within the meaning of the provisions of Art. 7 paragraph (1) of the Law.

(8) However, the inventions whose carrying out involves the use of a computer, a computer network, or other programmable apparatus, in which at first sight one or more characteristics of the claimed invention is carried out wholly or in part by means of one or more computer programs are patentable.

(9) Where a computer program that is the subject-matter of the invention, runs or is loaded on a computer, it determines or is capable of determining a subsequent technical effect which is more than mere normal physical interaction between the program and the computer on which it is executed, the invention is patentable.

(10) The inventions in the field of computer programs shall be considered to belong to

a technological field and shall comply with the patentability conditions provided for in Art. 7 of the Law and Art. 47 paragraphs (11) - (13).

(11) The inventions in the field of computer programs, according to the provisions of paragraph (10) may have a product or process as a subject-matter.

(12) Within the meaning of paragraph (11), the product may be a programmed computer, a network of programmed computers or other apparatus, and the process may be achieved by means of such a computer, network of computers or other apparatus by the execution of one or more computer programs.

(13) Within the meaning of paragraphs (7) to (12), the product may be in the form of a computer program.

(14) Within the meaning of Art. 9 paragraph (2) of the Law a patent may be granted for inventions having as a subject-matter:

a) products, particularly substances or compositions used in any of the methods provided for in Art. 9 paragraph (1) letter d) of the Law;

b) surgical, therapeutical or diagnosis instruments or apparatus used in the methods provided for in Art. 9 paragraph (1) letter d) of the Law;

c) the methods provided for in Art. (9) paragraph (1) letter d) of the Law practiced on the human or animal body which is not alive.

(15) In the application of the provisions of Art. 9 paragraph (1) letter a) of the Law, with reference to the biotechnological inventions, the exceptions from patentability provided for in Art. 71 and Art. 72 shall be taken into account.

## ARTICLE 45

### **Novelty of invention**

(1) The novelty, according to Art. 10 of the Law, shall be established depending on the content of the claims, based on the essential features necessary for defining the claimed invention and on the state of the art defined in Art. 38.

(2) In the application of the provisions of paragraph (1), when establishing the novelty of an invention, the technical problem solved by the invention shall not be taken into account.

(3) In the application of paragraph (1), upon establishing the novelty of the invention, as a rule, only a single document from the state of the art, namely the one considered to be the closest to the claimed invention, shall be taken into account. To this effect, there shall not be allowed the combination of two separate elements belonging to the state of the art, or the

combination of two separate elements from two different versions described within the same document, except if this combination was explicitly suggested.

(4) However, if the document according to paragraph (3), called *primary document*, explicitly refers to another document available to the public on the date of publication of the primary document, the latter shall be deemed to be incorporated in the primary document.

(5) In case of an application fulfilling the condition of unity, the provisions of paragraphs (3) and (4) shall be applied for each invention of the group provided for in Art. 19 paragraph (1).

(6) When assessing the novelty, a previous document shall be taken into consideration depending on its relevant date that may be either its date of publication, in case of a previously published document, or the filing date or, the priority date, as the case may be, in case of the documents according to Art. 10 paragraph (3) of the Law.

(7) There shall be considered relevant documents and shall be analyzed in the examination report referred to in Art. 50 those documents existing in the state of the art whose content covers partially or wholly the subject-matter of requested protection.

(8) Examination of novelty shall be performed by comparing the features in the claims with the ones in the document according to paragraph (3), that was selected for this purpose to be cited in the examination report.

(9) The claimed invention is considered to fulfil the novelty condition, if it differs, by at least one essential features, from the technical solution in the selected document, according to paragraph (8).

(10) There are considered essential technical features, according to the provisions of paragraph (9), all those features defining the claimed invention, to the extent in which they are not implied by the generic terms employed.

(11) The claimed invention is new, if it refers to:

a) a particular case, and the document in the state of the art has in view a general disclosure which includes the particular case; or

b) a subfield selected from a field disclosed in a document in the state of the art, on condition that the subfield is narrow and it is not close to known values and has a different technical effect; or

c) an element or a limited number of elements selected from a known larger class.

(12) According to a generic claim, an invention is not new if the document in the state of the art comprises a specific example and said claim relates to a general disclosure that also includes that specific example.

(13) When examining the novelty, the technical equivalents of the features of the

claimed invention shall not be taken into account.

## ARTICLE 46

### **Non-prejudicial disclosure of the invention**

(1) In the application of the provisions of Art. 11 paragraph (1) letter a) of the Law, there constitutes an obvious abuse against the persons provided for in Art. 11 paragraph (1) letter a) of the Law the disclosure of the invention to a third party :

a) that has purloined the invention from any of these persons; or

b) who the inventor communicated the invention to, on condition of not being rendered available to the public.

(2) The abuse, within the meaning of paragraph (1), is supposed to be intentional and may be invoked by the applicant, even if the abuse has not been made relative thereto, but relative to the inventor who has assigned his rights in the invention, or relative to the first applicant who has assigned the rights.

(3) In the application of Art. 11 paragraph (1) letter b) and paragraph (2) of the Law, the patent application shall be filed within maximum 6 months from the date of displaying the invention in the exhibition, under the conditions referred to in Art. 27.

## ARTICLE 47

### **Inventive step of the invention**

(1) According to Art. 12 of the Law, the inventive step of an invention shall be assessed in connection with the technical problem it solves and with the claimed invention taken as a whole, by comparing the same with the state of the art defined in Art. 10 paragraph (2) of the Law and Art. 38. The analysis of the inventive step shall be performed only for the claims fulfilling the novelty condition.

(2) The claimed invention taken as a whole is considered to be obvious within the meaning of Art. 12 paragraph (1) of the Law if, starting from one or more characteristics of the prior art, the use of the general knowledge of the person skilled in the art had allowed that person, on the date of filing or of the application priority, to arrive to the claimed invention

(3) The person skilled in the art within the meaning of paragraph (2) represents the person considered to have access to the whole state of the art, having normal abilities and general knowledge in the technical field which the technical problem solved in the invention on the relevant date belongs to.

(4) When assessing the inventive step, there may be combined in mosaic system either more documents or parts of more documents, or different parts of the same document belonging to the state of the art and compared with the claimed invention, on condition that this combination is obvious for a person skilled in the art.

(5) The assessment of the inventive step may be performed by the problem-solution approach, considering the closest state of the art.

(6) For assessing the inventive step by the problem-solution approach, according to paragraph (5), the following steps shall be considered:

- a) determining the closest state of the art;
- b) establishing the objective technical problem to be solved;
- c) evaluating in so far as, starting from the closest state of the art and from the objective technical problem, the claimed invention would have been obvious for the person skilled in the art on the relevant date.

(7) The closest state of the art, according to the provisions of paragraph (6), is that combination of features that is disclosed in a single reference of the state of the art and constitutes the best basis for evaluating the obviousness.

(8) The objective technical problem to be solved according to the provisions of paragraph (5) letter b) represents the objective proposed for modifying or adapting the closest state of the art for obtaining the technical effects the invention has in comparison with this state of the art. It may be different from the technical problem presented by the applicant in the description of the application, according to the provisions of Art. 16 paragraph (1) letter d), if the state of the art determined by the Office during the examination procedure imposes the modification to the effect of rendering it objective.

(9) In the application of the provisions of paragraph (1), an invention is deemed to involve an inventive step if it is particularly in one of the following situations:

- a) the non-obvious use of known means for another purpose while producing novel and surprising effects;
- b) a novel use of a known device or material which obviates technical difficulties impossible to surpass in a known manner;
- c) a combination of new or known features, carried out in such a manner that they mutually intensify their effects and a new technical result is obtained;
- d) a selection, within a process, of those technical parameters contained in a known range, which produce unexpected effects on the carrying out of the process or on the properties of the product obtained;
- e) a selection within a very large group of compounds of known chemical combinations

of those that have unexpected advantages;

f) the use of technical means of the claimed invention for solving the technical problem on another way than the one resulting from the documents contained in the state of the art analyzed by the person skilled in the art.

(10) In the application of the provisions of paragraph (2), an invention is deemed not to involve a inventive step if it is especially in one of the following situations:

a) the invention represents at least one of the possible solutions that would obviously result for a person skilled in the art, for filling a gap existing in the documents in the state of the art;

b) the invention differs from the known state of the art only by the use of some well-known equivalent mechanical, electric or chemical means;

c) the invention consists only in a new use employing the known features of a known means;

d) the invention consists in replacing, within a known device, of a material with a recently discovered material whose properties make it suitable for this use, called analogous replacement;

e) the invention consists only in the use of a known technique in a rigorously similar situation, called analogous use;

f) the invention consists in juxtaposing or associating known devices or processes, each operating or being carried on in the known manner, without resulting an interdependence between them;

g) the invention consists only in selecting a solution from a certain number of suitable possibilities;

h) the invention consists in selecting certain dimensions, temperature ranges or parameters from a limited range, which could have been obtained by successive attempts or by the use of the known designing methods;

i) the invention is obtained only by a simple extrapolation resulting directly from the state of the art;

(11) For the inventions in the computer program field, the inventive step criterion is deemed being fulfilled, according to the provisions of Art. 12 of the Law if the invention involves a technical contribution, this meaning a contribution to the state of the art in a technical field.

(12) The technical contribution shall be determined by taking into account as defined in Art. 10 paragraph (2) of the Law and Art. 38 of the present regulations.

(13) In the application of the provisions of paragraph (12) the claimed invention may

comprise elements containing non-technical features besides the technical features.

## ARTICLE 48

### **Industrial applicability of the invention**

(1) According to the provisions of Art. 13 of the Law, an invention is susceptible of industrial application if it has technical utility or it can be objectively carried out.

(2) The claimed invention having as a subject-matter a device or a process whose operation, or use, is obviously contrary to the laws of physics, as it is the case of perpetuum mobile mechanisms shall not be susceptible of industrial application.

(3) In the application of paragraph (2), where the claims of the patent application having as a subject-matter such a device specify the function pretended to be fulfilled by the invention, as well as the construction thereof, the invention is not susceptible of industrial application.

(4) However, in the situation where the device provided for in paragraph (2) is claimed as a product having a certain construction, objections in respect of the insufficient disclosure of the invention, within the meaning of Art. 18 paragraph (1) of the Law may be raised.

(5) The industrial applicability of an invention is presumed, except the situations where the technical use thereof is not obvious and the explicit indication thereof is necessary.

## ARTICLE 49

### **OSIM notifications**

(1) The notifications provided for in the legal proceedings before OSIM shall be presented either as an original document signed, stamped and filed or as a copy thereof in conformity with the original. The document copies emanating from the parties shall not need such a certification.

(2) The notifications shall be transmitted by:

- a) mail;
- b) technical communication means;
- c) delivery at OSIM headquarters;
- d) public notification.

(3) The notifications according to paragraph (1) shall be made as follows:

a) in the situation when the applicant is not the same as the inventor and a professional representative has not been appointed, the notification shall be addressed exclusively to the applicant;

b) in the situation when the applicant has appointed a professional representative, the notification shall be exclusively addressed thereto.

(4) The decisions as well as the documents established by order of the Director General of OSIM shall be transmitted through registered letter with acknowledging of receipt; the other notifications shall be communicated by registered letter.

(5) The notifications transmitted by mail shall be deemed to have been delivered to the addressee within the time limit provided for in Art. 3 paragraph (5).

(6) The notification may be handed over at the headquarters of OSIM directly to the addressee, who acknowledges the receipt by signature applied to the document copy that remains with OSIM. By this means of transmitting there may be handed over to the addressee the minutes concluded with the examiner at the OSIM headquarters, validated by the signatures of the parties and filed.

(7) Where the addressee's address cannot be known or the notification cannot be delivered to the addressee after the second attempt made by OSIM, the notification may be effected by public notice. The Director General of OSIM, by the same order as in paragraph (4), may decide the manners of giving public notice as well as the moment from which there runs the one-month time limit from the expiry of which the document is deemed being notified.

(8) The notification shall produce effects even if the addressee refuses to accept the notified document or to acknowledge the receipt thereof.

(9) In the application of paragraph (3) letter b) if more professional representatives have been appointed for a single interested party, it is sufficient to address the notification to one of them and in case more interested parties have a common professional representative it is sufficient to address the notification to the common professional representative.

(10) In the notifications transmitted to the applicant or to the professional representative, as the case may be, OSIM shall indicate the time limit for response; the applicant may, for justified grounds, request the extension of the legal time limit for response, according to the conditions of Art. 3 paragraph (8).

(11) OSIM cannot take decisions before the expiration of the time limit granted for response.

(12) If, within the granted time, limit the applicant or the professional representative, as the case may be, has failed to respond and has not asked for the extension of the time limit

for response, the decision concerning the patent application shall be taken by OSIM based on the existing documents.

(13) Where after performing the substantive examination of a patent application it has been ascertained that the invention having a product as a subject-matter, according to the provisions of Art. 12, does not involve an inventive step within the meaning of the provisions of Art. 12 of the Law, OSIM cannot take a decision to reject the application before having sent the applicant a notification in respect of the possibility of transforming a patent application into a utility model application and before the time limit for the response has elapsed.

## ARTICLE 50

### **Patent application examination report**

(1) The patent application examination report according to the provisions of Art. 28 paragraph (1) of the Law is the document by which the procedure of examination of a patent application is completed, according to the provisions of Art. 26 of the Law, and it shall be drawn up and signed by the examiner who has instrumented the patent application file.

(2) The examination report according to paragraph (1) shall contain:

- a) mention of the bibliographical data of the published patent application;
- b) a brief presentation of the subject-matter or subject-matters of the application;
- c) mention of the procedures the patent application has undergone subject to the payment of the fees;
- d) analysis of the invention in respect of its being sufficiently disclosed in the patent application, of its belonging to the categories excluded or excepted from the grant of the patent, followed, where appropriate, by the analysis of the fulfilment of the patentability conditions based on the relevant documents selected from the state of the art;
- e) the examiner's proposal addressed to the Examination Board concerning the grant or the refusal of the patent application, there being invoked the legal grounds thereof.

## SECTION 4

### **Examination Board**

## ARTICLE 51

### **Competence of the examination board. Composition and decisions**

(1) In the patent application examination procedure the specialized state examiner in the industrial property field shall draw up the examination report according to Art. 50, based

on which a specialized examination board within OSIM shall make the decision to grant the patent or to refuse the application according to the provisions of Art. 28 paragraph (1) of the Law; the examination board shall take note of the patent application withdrawal where the applicant requests the withdrawal in writing or shall declare the applications that are in one of the situations provided for in Art. 28 paragraph (4) of the Law, as deemed to be withdrawn.

(2) The specialized examination boards within OSIM are constituted according to technical fields or to the examination procedure.

(3) The examination board consists of:

- a) chairman appointed by the Director General of OSIM;
- b) state examiner in the industrial property field who has performed the patent application examination and has drawn up the examination report;
- c) a second examiner appointed by the chairman.

For the inventions of special complexity, the board may be extended by two more examiners upon the chairman's proposal.

(4) After completing the patent application substantive examination procedure, OSIM shall notify the applicant or the professional representative, as the case may be, about the intention to grant the patent and to communicate the corresponding decisions, subject to payment of the fee for publication, printing and issuance of the patent, within the time limit provided for by the Law. The notification shall be accompanied by the documentation containing the description, claims and drawings based on which the board will make the decision to grant the patent.

(5) Up to making a decision, within the time limit granted by OSIM, the applicant may ask OSIM in writing to eliminate possible errors or other modifications of the documentation.

(6) Where the Examination board does not agree with the modifications or corrections referred to under paragraph (5), the applicant shall be granted a new time limit for transmitting his observations. Failure to respond within the granted time limit, the decision to grant shall be made based on the last form of the documentation transmitted to the applicant or the professional representative, as the case may be.

(7) Any modifications requested after the communication of the decision to grant shall be carried out only by appeal, according to Art. 51 of the Law and subject to payment of the legal fee.

(8) The decisions taken by the examination board shall be justified and entered in the Register of the examination boards within the specialized division as well as in the National Register of filed patent applications; the mentions concerning the patent applications withdrawn by the applicant or the mentions concerning the applications declared as deemed

to be withdrawn shall be entered in the same registers.

(9) The decisions taken by the examination boards as well as the mentions referred to under paragraph (8) shall be communicated to the applicant or the professional representative, as the case may be, within one month from the date of taking the decision, or from the date on which cognizance was taken of the withdrawal of the application or on which the application was declared to be deemed to be withdrawn.

(10) For all the patent applications for which the publication fee, printing and issuance of the patent have been paid, the mention of the decision to grant the patent shall be published in the first BOPI issue following after the expiration of the legal fee for lodging an appeal. The mentions concerning the decisions to refuse the patent application shall be published in the first BOPI issue following to the expiration of the legal fee for lodging an appeal.

(11) In case of lodging an appeal, the publication of the mention of the decision according to paragraph (10) shall be made within one month from the date when the appeal was settled.

(12) Publication of the mention of the decision to grant according to paragraph (10) shall be made within the time limit provided for in Art. 28 paragraph (6) of the Law, provided that the publication, printing and patent issuance fee has been paid, but not earlier than one month from the communication of the decision.

(13) The inventions for which the patent was granted shall be published by rendering the description, claims and drawings available to the public at OSIM headquarters starting from the date of publication in BOPI of the mentions in respect of the decisions to grant, according to paragraphs (10) and (11).

(14) In the application of Art. 28 paragraph (9) of the Law, the patent, according to Art. 32 of the Law shall produce effects from the date of publication of the decision to grant in BOPI. The time limit for the revocation of the patent, according to Art. 52 of the Law, shall start to run from the publication of the mention of the decision to grant. In the application of the same article, the decision to refuse the patent application shall produce effects from the date of publication in BOPI.

## ARTICLE 52

### **Suspension of proceedings before OSIM**

(1) In the application of the provisions of Art. 28 paragraph (11) of the Law, the applicant's successor in title or the professional representative, as the case may be, shall:

a) file a request with OSIM to expressly request the suspension of the proceedings that

the patent application undergoes;

- b) pay a fee for extension of the time limit for the proceedings; and
- c) file with OSIM certified copies of all documents justifying the request for suspension.

(2) The procedure may be resumed at the express request of the successor in title or of the professional representative, as the case may be filed with OSIM, to which the documents attesting the status of successor in title shall be appended; OSIM shall notify the date of resuming of the proceedings to the interested parties.

(3) In case of suspension caused by the death of the professional representative and appointment of a new professional representative, OSIM shall resume the proceedings only after the submission of the power of attorney for the representation of the applicant; otherwise, the patent application shall be rejected or the proceedings shall be resumed considering that the applicant is not represented by the professional representative, as the case may be.

(4) In the situation provided for in Art. 28 paragraph (12) of the Law, OSIM shall notify the interested party the date on which the proceedings is suspended.

(5) With a view to resuming the suspended proceedings, according to paragraph (4), if the provisions of Art. 66 paragraph (1) of the Law are applicable, the interested party shall:

- a) request for the resumed proceeding within 30 days from the date the decision remained final and irrevocable;
- b) pay the fee for filing the modifications in the legal status of the patent.

(6) In order to resume the suspended procedure, according to the provisions of paragraph (4), if the provisions of Art. 65 paragraph (2) of the Law apply, the interested party shall:

- a) communicate the decision of the court to OSIM within 3 months from the date on which it became final and irrevocable and endorsed with executory formula by the law court;
- b) communicate in writing to OSIM, within the same time limit, his option concerning the selection of one of the choices contained in Art. 66 paragraph (2) letters a) - c) of the Law.

(7) If, from the communication made according to paragraph (6) letter b), it results that the person whose right to the patent was recognized, desires to continue the procedure instead of the applicant, according to Art. 66 paragraph (2) letter a) of the Law and pays the fee for filing the modifications in the legal status of the patent application, OSIM shall publish in BOPI the mention of the change of the person entitled to be granted the patent.

(8) When from the communication made according to paragraph (6) letter b) it results that the person, whose right to the patent was recognized, will file a new patent application for the invention to which his right was recognized, according to Art. 66 paragraph (2) letter b) of the Law, this shall:

a) be made within the time limit provided for in paragraph (6) letter a);

b) comprise a reference in the Romanian language to the original application or contain the description, claims and drawings of the invention for which his right to the patent was recognized;

c) be accompanied by the proof of payment of the legal fee;

d) be accompanied by a copy of the final and irrevocable law court decision.

(9) The filing date of the patent application referred to in paragraph (8) shall be the same as the filing date of the original application and the new application shall benefit by the priority right claimed in the original application.

(10) The provisions of paragraph (8) having been fulfilled, OSIM shall declare the original application as deemed to be withdrawn starting on the filing date.

(11) Where from the communication made according to paragraph (6) letter b) it results that the person whose right to the patent was recognized requests the rejection of the original application, according to Art. 66 paragraph (2) letter c) of the Law, and the condition of paragraph (6) letter a) is fulfilled, OSIM shall make the decision to reject the original application and shall publish the mention thereof in BOPI and shall communicate the decision to the interested parties.

(12) Suspension of the procedure cannot occur before the publication of the patent application according to Art. 23. paragraphs (1) - (5) of the Law.

## ARTICLE 53

### **Reinstatement**

(1) When the applicant or patent owner failed to comply with a time limit for an action within a procedure before OSIM, having the effect of loss of rights in respect of the patent application or the patent, OSIM, upon request thereof, may reinstate the same in the previous situation, within 2 months from the cessation of the cause, but not more than one year from the expiration of the time limit, provided that the following requirements are fulfilled cumulatively:

a) the applicant, patent owner or the professional representative, as the case may be, expressly request the reinstatement;

b) the request is formulated within due time;

c) the application is justified; and

d) the legal fee paid at the time of filing the application is the one provided for in Art. 44 paragraph (4) of the Law.

(2) The provisions of Art. 44 paragraph (4) of the Law shall apply to the applications according to Art. 28 paragraph (4) letter b) of the Law for which the form of the description and drawings was accepted in compliance with the content of the accepted claims and the time limit referred to in Art. 28 paragraph (2) letter e) of the Law has not expired.

(3) The request submitted according to paragraph (1) letter a) cannot be refused wholly or in part, before OSIM has notified the applicant, the patent owner or the professional representative, as the case may be, about the reasons for refusal and has granted a two-month time limit for submitting the observations.

(4) OSIM decides the rejection of the request for reinstatement, if this refers to one of the situations provided for in Art. 44 paragraphs (2) and (3) of the Law, as well as in Art. 20 paragraph (7) of the Law.

(5) The decision to accept or reject the request for reinstatement shall be communicated to the applicant, patent owner or the professional representative, as the case may be.

## ARTICLE 54

### **Ex officio revocation**

(1) The decisions of the Examination Board in respect of the patent applications may be revoked ex officio, within the meaning of Art. 29 paragraph (1) of the Law, if within the revocation period, OSIM has identified documents liable to change these decisions.

(2) The ex officio revocation according to Art. 29 of the Law shall be made by the Examination Board that has made the decision.

(3) If it has been ascertained that the decisions of the Board contain material errors or omissions, particularly with regard to the inventor's, the applicant's or patent owner's identification data, the Examination Board shall decide the remedying thereof, without the revocation of the decision.

(4) The mention of ex officio revocation shall be entered in the Register of the examination boards within the division where the decision has been made.

(5) The justification of the ex officio revocation shall be written by the chairman of the examination board in an official report which is appended to the patent application file.

(6) After the revocation of the decision, according to paragraph (1), the examination

board shall make a new decision in respect of the patent application, immediately after solving the causes that determined the revocation of the decision.

## SECTION 5

### **Defense of rights concerning the inventions**

#### ARTICLE 55

#### **Preparation of the session of the board of appeal for decisions made in the substantive examination**

(1) According to Art. 53 of the Law, the appeals, including the ones aiming at limiting the patent, drawn up based on Art. 51 of the Law and the requests for revocation formulated based on Art. 52 of the Law shall be solved by the Board of Appeal consisting of:

a) chairman;

b) one or three examiners having at least 5 years of service in the examination field;

and

c) a legal adviser within the Appeal Department.

(2) The chairman of the board of appeal is the Director General of OSIM or, by delegation of competence, the head of the Appeal Department; the board secretariate is ensured by a person within this department.

(3) The chairman will designate the examiner as the rapporteur of the cause, in the boards consisting of three members, or one of the three examiners, in the boards consisting of 5 members.

(4) The members of the Boards of Appeal may not take part in judging an appeal or a request for revocation, if they have a personal interest in the debated appeal or if they took part, as examiner or members of the Examination Board, to the examination of the patent application referred to in the cause.

(5) The rapporteur, after having studied the documentation of the patent application and the file of the case, shall draw up a preliminary study of the case pointing out the arguments formulated by the parties, and shall mention the most relevant invoked proofs.

(6) The rapporteur shall also analyze the viewpoint transmitted by the examiner of the file, expressed in the situation in which other documents appeared relative to the documents considered for making the decision appealed against. The examiner's viewpoint will be requested at the time of summoning the parties.

(7) The session for settling the case shall be carried out by hearing the parties, the carrying out of the oral procedures as well as submitting evidence shall be entered by the Secretariate in a special register for sessions.

(8) For settling the case, the board of appeal shall give the possibility to the interested parties to present and sustain their viewpoint on the basis of the proofs submitted to the file of the case, either personally or through the professional representative or attorney-at-law, on the basis of the power of attorney.

(9) Where a board of appeal consisting of three members considers that the nature of the appeal or of the request for revocation requires a board consisting of three members examiners, a chairman and a legal adviser, the decision of enlarging the board shall be made at the latest at the first session date established for settling the case.

## ARTICLE 56

### **Competence of the Board of Appeal concerning the decisions taken in the preliminary examination**

(1) The appeals concerning the decisions taken in the preliminary examination relating to:

- a) patent applications;
- b) the applications for the grant of the pipeline protection;
- c) claimed priority;
- d) reinstatements;
- e) revalidation of the patents;

f) registration of the transfer of rights shall be settled by a board of appeal formed by three members of which 2 legal advisors within the Disputed Claims - International Relations Directorate and one examiner within the Preliminary Examination Divisions; the chairman of the board shall be delegated by the Director General of OSIM, and the secretariate of the Board is ensured by a person from the Disputed Claims- International Relations Directorate.

(2) During the session for settling the appeal, the board of appeal may request any explanations and documents necessary for settling the appeals.

(3) The Board of Appeal decides to accept or refuse the appeal.

## ARTICLE 57

### **Appeal and request for revocation**

(1) The appeal through which the Board of Appeal is informed shall be communicated in writing and shall contain the following elements:

a) name and domicile or denomination and registered office of the person who lodged the appeal;

- b) object of the appeal;
- c) the grounds in fact and reasons in law on which the appeal is based;
- d) presentation of proofs on which the appeal is based;
- e) signature of the person who formulated the appeal.

(2) The appeal shall relate to the reasons on which the decision appealed against is based and shall be accompanied by the proofs in upholding the same and the proof of payment of the appeal fee.

(3) When the proofs consist in documents, copies of these documents shall be submitted. If the documents are drawn up in a foreign language, there shall be submitted translations thereof into Romanian, certified by the party who submitted them.

(4) The appeal having as an object the limitation of the patent according to Art. 51 paragraph (2) of the Law shall contain the reasons for which the restriction of the granted protection is desired.

(5) The request for revocation of the patent shall be done in writing and shall contain the same elements as the appeal. The owner of the patent concerned will be able to submit an answer to the request for revocation at least 5 days before the first session date established for settling the request.

(6) The appeal as well as the documents accompanying it shall be submitted in two copies, and the request for revocation and the possible answer and the documents accompanying it shall be submitted in the number of copies corresponding to the number of parties plus two copies for the Board of Appeal and the Examination Board.

(7) At least five days before the first session date established for settling the case, the Examination Board may file the viewpoint under Art. 55 paragraph (12) to the file.

## ARTICLE 58

### **Procedure for settling the appeals and requests for revocation**

(1) The request for revocation shall be communicated by the secretary of the Board of Appeal to the owner of the patent concerned, and the owner thereof may submit an answer and possible upholding documents within the time limit granted by the Board. A copy shall also be given to the Examination Board.

(2) The answer under paragraph (1) shall be notified to the person who formulated the request for revocation by the secretary of the Board of Appeal.

(3) The appeal and the request for revocation shall be also communicated by the secretary of the Board of Appeal, to the Patent Directorate of OSIM for information and, where

appropriate, for drawing up a viewpoint.

(4) At least 14 days before the session date established for settling the case the secretary of the Board of Appeal shall summon the parties, or the representatives thereof, as the case may be, by mail with acknowledging of receipt. The session lists approved by the Director General of OSIM shall be communicated to the Patent Directorate and shall be published on the Internet, at least 3 days before the session date.

(5) Where the Board of Appeal ascertains that the settling of a case depends on the existence or non-existence of a right that is the object of a trial, and the penal pursuit has started for an infringement of the Law that could have implications on the decision of the Board, this Board can adjourn the case up to a final and irrevocable decision in the penal trial.

(6) During the deliberation on the merits of the case, the rapporteur will be the first to express his opinion, followed by the newest member of the board, the chairman being the last to express his opinion.

(7) When making the decision, the chairman shall summarize the possible options relating to the decision and put them to the vote; the votes shall be expressed in the order under paragraph (6) in the presence of all members.

(8) The decision of the board of appeal shall be made with the votes of the majority of its members; the divergent opinions will be mentioned following the enacting terms of the decision.

## ARTICLE 59

### **Decisions of the board of appeal**

(1) Regarding the appeals, the Board of appeal may decide:

a) to accept the appeal wholly or in part, by changing the decision to refuse, by cancelling the same and returning the case to the substantive examination for the continuation of the examination procedure, within the competence limits specified in the decision of the Board of Appeal;

b) to accept the appeal, to cancel the decision to grant and to send the case back to the substantive examination for the continuation of the examination procedure within the competence limits specified in the decision of the Board of Appeal;

c) to accept the appeal and the modifications requested by the appellant in the appeal procedure, to change the decision to grant and to send the patent for publication with the

modifications brought by the Board of Appeal;

d) to reject the appeal and to maintain the decision appealed against.

(2) In case of the appeal having the object of patent limitation, the Board of Appeal may decide:

a) to accept the appeal based on the claims amended by the applicant, to modify the decision to grant made by the Examination Board and to transmit the patent with the modifications accepted by the Board of Appeal for publication;

b) to reject the appeal and transmit the patent as granted by the Examination Board for publication.

(3) In case of the requests for revocation, the board of appeal may decide:

a) to accept the request wholly and to revoke the patent;

b) to accept the request for revocation in part and the claims amended by the patent owner within the revocation procedure, to maintain the patent as modified by the owner within the revocation procedure and to transmit the patent to be republished;

c) to accept in part the request, by maintaining the patent as modified after the decision made by the board of appeal and to transmit the patent for publication;

d) to reject the request for revocation and to maintain the patent as modified by the owner within the revocation procedure and to transmit the patent to be republished;

e) to reject the request for revocation and to maintain the patent as granted by the Examination Board.

(4) After the decision has been pronounced, the decision shall be drawn up and it shall be signed by the chairman and members.

(5) The decisions of the board of appeal shall be communicated to the parties as copies certified in compliance with the original; the decision, drawn up in only one original copy shall be attached, by the secretary, to the file of decisions made by the board of appeal and shall be entered in the book of the sessions.

(6) The provisions of the present Regulations relating to the procedure for settling the appeals and the requests for revocation, as well as the ones relating to the decisions made by the Board of Appeal shall be completed correspondingly with the provisions of the Civil Proceedings Code.

## SECTION 6

### **Issuance of the patent**

#### ARTICLE 60

### **Conditions for the issuance of the patent**

(1) In the application of Art. 30 paragraphs (1) and (2) of the Law, OSIM shall issue the patent to the patent owner, subject to payment of the patent publication, printing and issuance fees, according to Art. 28 paragraph (7) of the Law.

(2) The patent shall be accompanied by a notification concerning the publication of the mention concerning the decision to grant the patent according to Art. 28 paragraph (9) of the Law as well as the description, claims and drawings that the decision is based on. OSIM shall notify the owner on the elements provide for in Art. 36 paragraph (1) which shall not be published and shall send him a copy of the description and claims to be published.

(3) Where the patent is in the co-ownership status, in compliance with the provisions of Art. 84, the patent shall be issued to the designated co-owner, or in the absence thereof, to the first mentioned co-owner, while the other co-owners are issued a duplicate containing the mention "co-owner of the patent no ..."; the issuance of the duplicate is not subject to the payment of a fee.

(4) In case of loss or destruction of the original copy of a issued patent, the owner may be granted, upon request, a duplicate copy of the patent subject to payment of the legal fee and after publication in the Official Gazette of Romania, Part III of the mention of the loss or destruction thereof.

(5) In the application of Art. 35 paragraph (2) of the Law, the issuance of the duplicate copy for the inventor that is not the patent owner shall not be subject to payment of fees.

(6) However, in case of loss or destruction of the duplicate, according to paragraph (5), the inventor may be issued, upon request, a new duplicate copy, only subject to payment of the legal fee.

(7) For the patents revoked or cancelled in part according to the provisions of Art. 52 paragraph (2) and Art. 54 paragraph (2) of the Law, OSIM shall issue, subject to payment of the fee according to paragraph (1), a patent pursuant to the decision of the Board of Appeal or to the final and irrevocable decision of the law court, as the case may be, and shall publish the mention of patent issuance in BOPI.

## SECTION 7

### **Patent maintenance in force**

#### ARTICLE 61

### **Patent maintenance in force during the protection period**

(1) According to Art. 43 paragraph (2) of the Law, for the patent maintenance in force,

the fee for one year of protection shall be due in the first day of the respective year of protection, with the following exceptions:

a) for the first two years of protection, for which the owner does not owe these fees;

b) for, the period comprising the protection years following to the first two years, including the year following to the year when the mention of the grant of the patent was published, when the fee is to be paid within 12 months from the date of publication in BOPI of the mention regarding the grant of the patent.

(2) According to Art. 43 paragraph (3) of the Law, the payment in advance for a period of up to 4 years shall also include the payment for the year of protection for which this payment had to be made.

(3) When the fee is paid in advance according to paragraph (2), this payment shall be deemed to be valid, even if the amount of the fees was updated during the period for which these fees were paid.

(4) If a transfer of rights was registered according to Art. 45 of the Law during the period for which the fee was paid in advance with a reduction, simultaneously with the transfer of rights there shall be paid the difference up to the level of the legal amount for the year of protection following to the year when the mention of the registration of this transfer was published.

(5) If the payment of the difference of fee provided for in paragraph (4) was not made at the time of registration with OSIM of the document for the transfer of the right, the patent owner shall, through a notification, be granted a two-month time limit for the payment of this difference up to the amount of the fee to be paid; otherwise, the patent owner shall lose the rights conferred by the patent.

(6) As soon as the legal conditions for the patent maintenance in force are fulfilled, OSIM shall notify this to the patent owner or to the professional representative thereof, as well as the fact that the fee for the patent maintenance in force shall not be refunded irrespective of the subsequent modifications with reference to the legal status of the patent.

(7) In case when after having been notified that a decision to grant the patent is to be made, the applicant requests an extension of the time limit for making a decision, for reasons of incapacity of paying the fees for publication, printing, issuance and maintenance in force, respectively, the agreement concerning this request shall be notified; the extension of the time limit for making a decision shall not be longer than 12 months from the date of communication of the agreement and it shall only be granted once.

(8) The fee for maintenance in force of the patent for one year of protection, that was not paid according to the conditions provided for in the paragraph (1), may be paid with 50%

increase up to the end of the six-month period from the due date.

(9) In the case provided for in paragraph (1) letter b) the six-month period under paragraph (8) starts on the date when the 12-month time limit, calculated from the date of publication of the mention of the grant of the patent, ended.

(10) Failure to pay the legal fee for patent maintenance in force for one year of protection, after the expiry of the time limit provided for in paragraph (9) or (10) shall, pursuant to Art. 43 paragraph (3) of the Law, cause the patent owner's loss of rights conferred by the patent.

(11) In the application of Art. 39 paragraph (3) of the Law, the payment may be made by any person, provided that the data for the identification thereof and of the patent owner, the number of the patent, the title of the invention which is the object of protection by patent, the year or the period for which the fee is paid are indicated and provided that a copy of the payment document and of the documents proving, where necessary, that the patent owner has fulfilled the conditions for the reduction of the amount, are filed with OSIM.

(12) In case the patent owner or the professional representative failed to pay the fee for the maintenance in force up to the end of the time limit mentioned in paragraph (8) or (9) and the payment was made by another person, according to Art. 39 paragraph (3) of the Law, then the legal conditions for the patent maintenance in force are fulfilled and OSIM shall notify this in compliance with paragraph (6).

(13) In case when the patent owner that has lost the rights conferred by the patent requests the revalidation thereof, and the conditions of Art. 38 of the Law are fulfilled and there is paid the fee for maintenance in force for the period for which the payment was not made, OSIM shall decide, through a board within the Patent Directorate, on the request for revalidation.

(14) The revalidation decision shall be entered in the National Register of Patents, provided for in Art. 67 paragraph (9), shall be communicated to the patent owner and shall be published in BOPI within the time limit stipulated in Art. 37 of the Law.

(15) The patent owner may, according to Art. 51 paragraph (1) of the Law, lodge an appeal against the decision concerning the request for the patent revalidation.

## ARTICLE 62

### **Procedure with OSIM in case of cancellation of the patent when another person than the one indicated in the patent is entitled to the grant of the patent**

(1) In the application of Art. 66 paragraph (1) of the Law, in the situation in which after an action for the patent cancellation, according to Art. 54 paragraph (1) letter e) of the Law,

OSIM shall grant the patent to the entitled person:

a) the entitled person shall communicate the final and irrevocable decision to be published in BOPI;

b) the interested person shall pay the fee for the modification of the patent legal status, the fees for printing, publication and issuance thereof as well as the fee for patent maintenance in force.

(2) OSIM shall publish in BOPI the final and irrevocable court decision, the mention of patent issuance and shall enter all these data in the National Register of Patents.

## ARTICLE 63

### **Renunciation by the patent owner to his rights**

(1) Renunciation by the patent owner to the rights conferred by a patent within the validity period, according to the provisions of Art. 38 paragraph (1) of the Law, shall be made by filing a request with OSIM; OSIM shall take act of the patent owner's renunciation, if:

a) the request is express, indicates whether the renunciation is made wholly or in part and indicates the claims referred to;

b) the request is filed after the date the mention of the decision to grant the patent has been published in BOPI;

c) the request is signed by the patent owner or, where the patent has several co-owners, the request will be signed by each of them separately;

d) the owner proves that the provisions of Art. 38 paragraphs (2), (3) or (5) of the Law are fulfilled.

(2) The mention of renunciation to the patent shall be entered in the National Register of Patents and shall be published in BOPI within 60 days from the date of its registration with OSIM.

(3) At the inventor's request, the patent owner, according to the provisions of Art. 38 paragraph (2) of the Law, shall transfer wholly or in part the right in the patent to the inventor, wholly or in part, and the inventor or inventors shall file with OSIM a signed request for taking over the right in the patent, the original or authenticated copy of the document of renunciation and transfer of the right wholly or in part as well as of the proof of payment of the fee for the modification of the legal status of the patent; OSIM shall enter the transfer of rights in the National Register of Patents and shall publish the mention thereof in BOPI, according to Art. 45 paragraph (3) of the Law.

## SECTION 8

### **Extent of protection conferred by the patent**

#### ARTICLE 64

##### **Interpretation of claims**

(1) The provisions of Art. 32 shall not be considered to mean that:

a) the extent of protection conferred by the patent is determined in a strict and literal sense of the text of the claims, the description and drawings helping only for the elimination of ambiguities concerning the claims;

b) the claims help only as guidelines; and

c) the protection is also extended to what, in the opinion of a person skilled in the art that analyzed the description and claims, the patent owner wanted to protect.

(2) The provisions of Art. 32 paragraph (3) of the Law shall be interpreted as defining a position between these extremes, which should ensure at the same time an equitable protection to the patent owner and a reasonable degree of certainty to third parties.

(3) In the application of Art. 32 paragraph (3) of the Law, the characteristics used in the claims shall be considered within the meaning and scope they normally have in the relevant state of the art, except where the description provides for another meaning given to these characteristics.

(4) Where a claim defines a product as such manufacturing process, said claim shall be interpreted as defining the product in itself with the characteristics conferred by the manufacturing process.

(5) Where a claim defines a product for a specific use, the claim shall be interpreted as defining the product limited exclusively to that use.

(6) In the application of Art. 33 paragraph (6) of the Law, an element is deemed being equivalent to an element specified in the claims, if, for a person skilled in the art, it is obvious that by the use thereof there is essentially obtained the same result as the one obtained by the element specified in the claims.

(7) Upon establishing the extent of the protection, there shall be taken into account any specification made by the applicant or by patent owner during the procedures relating to the grant or to the validity thereof which limits it in respect of the content of the claims.

#### ARTICLE 65

##### **Extent of protection depending on the subject-matters of the invention**

(1) In the application of the provisions of Art. 32 paragraph (2) of the Law, the patent having a product as a subject-matter confers an absolute protection which comprises all functions, effects, uses and advantages of the product as a subject-matter of the invention, even if these have not been indicated in the patent description.

(2) The protection by the patent having a product as a subject-matter comprises the product as such, irrespective of the way or manner of manufacturing, so that the indication of a manufacturing way or process in an embodiment does not mean that the protection conferred by patent extends only to the product manufactured this way.

(3) Where the product is defined by its manufacturing process, according to Art. 12 paragraph (4), the extent of protection shall be the one for the product, according to the provisions of paragraph (1), the protection being valid only for those products defined this way.

(4) For the patent having as a subject-matter a product claimed as limited to a certain purpose, such as devices, means etc, the conferred protection shall be limited to achieving said purpose.

(5) In the application of Art. 32 paragraph (2) of the Law, the patent having a process as a subject-matter confers absolute protection relative to any use or offer for use of the patented process, comprising all purposes that can be achieved with the patented process even if they have not been indicated in the patent description.

(6) In the application of the provisions of paragraph (5), if the essence of the invention having the patented process as a subject-matter refers to a use of a product for a certain purpose, the extent of the patent protection is limited to the use for the mentioned purpose.

## SECTION 9

### **Representation by professional representative**

#### ARTICLE 66

### **Representation in the proceedings before OSIM**

(1) The applicant, patent owner, assignor or other interested person may be represented for any proceeding concerning a patent application or a patent by a professional representative exercising the profession of industrial property attorney, either independently or within an employment form provided for by the Government Ordinance no. 66/2000 on the exercise of the profession of industrial property attorney, as republished.

(2) When OSIM has ascertained that a professional representative has been designated for a patent application or a patent, it shall check if this is included in the lists published in BOPI and shall enter the mentions referring to the designation in the National Register of Patent

applications or in the National Register of Patents, as the case may be.

(3) Any mention relating to the designation of a professional representative as well as the modifications in respect of the legal status thereof or to giving up the representation mandate shall be entered in one of the registers provided for in paragraph (2), upon written request signed by the applicant, patent owner, assignor or any other interested party.

(4) A modification of the professional representative designated in a patent application or for a patent, or a modification of the address thereof shall be registered by OSIM subject to payment of the legal fee.

(5) Registration of the professional representative shall be cancelled ex officio by OSIM, if a new professional representative has been designated or when a change of the patent owner has been entered and the new patent owner has failed to designate a professional representative.

(6) When a patent application has been filed with OSIM directly by the applicant, OSIM shall notify to the applicant a list of industrial property attorneys as well as the possibility of designating a person contained in the communicated list.

(7) Where one of the proceedings provided for in Art. 39 paragraph (2) of the Law has been performed directly by the applicant, patent owner, assignor or any other interested party, OSIM shall notify to the authorized representative the acts done by said person; OSIM shall also communicate to the person who has done said acts about the notification sent to the professional representative.

## SECTION 10

### **National Registers**

#### ARTICLE 67

#### **National Register of Filed Patent Applications and the national Register of Patents**

(1) According to the provisions of Art. 69, paragraph (1) letter (c) of the Law the National Register of Filed Patent Applications and the National Register of Patents shall be established and kept with OSIM.

(2) The registers provided in paragraph (1) shall be kept on paper carrier or partially or wholly in electronic format.

(3) In the cases in which the legal provisions concerning the form or the content of a document from which data shall be entered in the registers, or the payment of the legal fees in the legal amount and at the legal time limits are not observed, or the request in the documents

is not made by the entitled person, as mentioned in the registers, the data shall not be entered in the registers and this shall be notified to the applicant or the interested person.

(4) In the application of the provisions of Art. 15 paragraph (6) of the Law, the patent applications fulfilling the provisions of Art. 15 paragraph (1) of the Law shall be entered in the National Register of Filed Patent Applications, in the increasing order of the number to which the filing date is associated.

5) For entering the data in the National Register of filed patent application, they shall only be taken from original documents or documents having the value of original documents and shall be entered as such.

(6) Upon request by any person OSIM shall, in the conditions of the Law and of the present regulations, issue any requested document, in copy, or an excerpt of a registration in the National Register of Patent Applications, as the case may be, provided that the fee for certification and issuance of a document has been paid.

(7) The data to be entered in the National Register of the Filed Patent Applications are the following:

- a) number of the patent application and filing date;
- b) in case the application is filed by the national route, the date of filing the patent application with OSIM, if this date is different from the filing date;
- c) if the patent application is an international application for which the national phase has been opened, the number and date of filing the international application and the date of opening the national phase;
- d) if the patent application resulted from reviewing an international application, according to Art. 31, the data referring to the reviewed international application;
- e) if the patent application resulted from the conversion of a European patent application into a national patent application, the number of the national patent application and the number of the European patent application, the filing date, according to the European Patent Convention and the date when the European patent application was converted into the national patent application;
- f) title of invention
- g) classification code attributed according to the international patent classification system;
- h) the applicant's identification data, according to Art. 14 paragraph (1) letter b) of the Law;
- i) the inventor's identification data and, where appropriate, other data declared by the inventor;
- j) address for correspondence indicated by the applicant;

k) data for the identification of the professional representative designated by the applicant;

l) if a priority is claimed, the date, number and State of filing the earlier application whose priority is claimed;

m) if the application resulted from division, the number and date of filing of the application from which it resulted;

n) the date of publication of the application and the legal ground according to which the publication was made;

o) number, date and kind of decisions made in respect of the application within OSIM;

p) data concerning the document certifying the deposit of the biological material with the international depositary authority, according to Art. 18 paragraph (2) of the Law;

r) registered transfers of rights, according to Art. 45 and Art. 46 paragraph (1) of the Law;

s) other modifications registered in the legal status of the patent application;

t) lodging an appeal or a request for revocation;

u) data concerning the submission of the exhibition certificate according to Art. 28 paragraph (1);

v) data concerning the discontinuing or suspending of the procedure or of extending the time limits.

(8) The data concerning the patent applications entered in the National Register of Filed Patent Applications become available to the public from the date of publication of the application, according to Art. 23 of the Law, and may be consulted by any person at OSIM headquarters.

(9) The National Register of Patents for Invention, according to paragraph (1), has a section for the patents granted by the national route and a section for the European patents with effects in Romania and a section for the patents conferring pipeline protection.

(10) In the National Register of Patents - Section for Patents granted by the national route- there shall be entered the following:

a) number of the patent, filing number and date of the patent application on whose basis the patent has been granted;

b) where the patent is granted on the basis of an application filed by the national route, the date of submitting the patent application with OSIM, if this is different from the filing date;

c) where the patent is granted on the basis of an international application for which the national phase has been opened, the filing number and date of the international application and the date of opening the national phase;

d) where the patent is granted on the basis of a European patent application converted

into a national patent application, the number of the European patent application, the filing date according to the European Patent Convention and the date on which the European patent application was converted into a national patent application;

- e) title of the invention;
- f) classification index attributed, according to the international patent classification system;
- g) data for the identification of the inventor and of the patent owner;
- h) address for correspondence indicated by the patent owner;
- i) data for the identification of the professional representative designated by the patent owner;
- j) if a priority has been claimed, the date, number and State or organization where the earlier application whose priority is claimed was filed;
- k) date of publication of the application and the legal ground according to which the publication was performed;
- l) mention of the decision to grant the patent, according to Art. 28 paragraph (1) of the Law;
- m) mention of the number of claims and figures in the patent;
- n) mention of the decision of the law court, become final and irrevocable, relating to the person entitled to the patent;
- o) date of the issuance of the patent, according to Art. 30 paragraph (2) of the Law;
- p) documents of payment of the fees for printing and maintenance in force and the amount of such fees;
- q) mention of the loss of patent owner's rights by failure to pay the fees, and the date of publication thereof;
- r) mention of the final and irrevocable decision to revalidate the patent, according to Art. 37 of the Law;
- s) mention of the renounce, wholly or in part, the right to the patent, according to Art. 38 paragraph (6) of the Law;
- ş) mention of the final and irrevocable decision to cancel wholly or in part the patent, according to Art. 54 paragraph (3) of the Law;
- t) classification of information relating to or in connection with the invention which is the subject-matter of the patent, according to Art. 40 paragraph (2) and paragraph (3) of the Law and Art. 7;
- ţ) reinstatement according to Art. 44 of the Law;
- u) transfer, wholly or in part, of the right to the patent or of rights deriving from the patent,

according to Art. 45 of the Law;

v) compulsory licences according to Art. 50 of the Law;

w) mentions of the final and irrevocable decisions, according to Art. 57 paragraph (4) of the Law;

x) modifications in a final and irrevocable decision relating to the status of inventor, patent owner or to other rights derived from the patent and the date of publication of the decision mention;

y) mention of the final and irrevocable decision relating to the fact that other person than the patent owner is entitled to the grant of the patent, according to Art. 66 paragraph (1) of the Law and the date of publication of the decision mention.

(11) In the National Register of Patents - Section for European Patents with effects in Romania, there shall be entered the data relating to the legal status thereof.

(12) On the date of receiving a copy of the decision made in respect of a patent application or a patent, the mention of this decision shall be entered in the registers, or, where appropriate, the corresponding rectification in the data entered in the registers shall be made,; the performed rectification shall be mentioned in any document issued which is the copy or the excerpt of a registration in the registers.

(13) The Registers represent the *prima facie* evidence of any data entered therein.

(14) Any interested person may request that the material errors or omissions in the entries in the National Register of Filed Patent Applications or in the National Register of Patents , as the case may be, should be remedied.

(15) After filing the request for remedying the errors and up to solving the same, OSIM shall not issue any document that is a copy or an excerpt of an entry in the National Register of Filed Patent Applications or in the National Register of Patents, as the case may be.

(16) OSIM may request any explanations or documents necessary for upholding the request under paragraph (15).

(17) In case when some errors or omissions in the entries in the National Register of Filed Patent Applications of National Register of Patents, as the case may be, have been remedied, these shall be highlighted in any issued document that represents the copy or excerpt of an entry in the Register.

### CHAPTER III

#### **Biotechnological Inventions**

#### SECTION 1

#### **General provisions**

## ARTICLE 68

### Definitions

(1) The biotechnological inventions are, according to Art. 7 paragraph (2) letter a), b) and c) of the Law, the inventions which refer to a product which consists of or contains a biological material or which relates to a process whereby the biological material is obtained, processed or used.

(2) Biological material means, according to Art. 7 paragraph (2) letter a) of the Law, any material containing genetic information and which is self-reproducible or reproducible within a biological system.

(3) Microbiological process is, according to Art. 7 paragraph (2) letter c) of the Law, any process in which there is obtained a microbiological material in which there is used a microbiological material, or which involves an intervention on a microbiological material.

(4) International depositary institution referred to in Art. 18 paragraph (2) of the Law means a depositary institution ensuring the receiving, acceptance and preservation of the microorganisms and delivering samples therefrom, and which has acquired the statute of international depositary authority according to Art. 7 of the Budapest Treaty.

(5) The plant variety represents, within the meaning of Art. 7 paragraph (2) letter b) of the Law, any group of plants belonging to a botanic taxon having the lowest known rank, which, independently of complying with the conditions for the grant of a plant variety patent, may be:

a) defined by the expression of characters resulting from a certain genotype or from a certain combination of genotypes;

b) distinct from any other group of plants, by the expression of at least one of the characters mentioned under letter a);

c) considered as an entity, with regard to its capacity of being reproduced as such; the hybrid with the parental forms is also considered a plant variety.

(6) The animal breed represents, within the meaning of Art. 7 paragraph (2) letter b) of the Law, a group of individuals within a species of animals having common, stable, hereditarily fixed biochemical, physiological and ecological characters and which are distinguished clearly from other groups of individuals within the same species.

(7) The genetically modified plants or animals shall, within the meaning of Art. 7 paragraph (2) letter b), can be defined by at least one functional gene which has been introduced into the genome thereof and/or newly acquired features, and not by the genome in its whole.

(8) Essentially biological process for obtaining the plants or animals is a process wholly based on natural phenomena, such as crossing or selection.

## SECTION 2

### **Patentability**

#### ARTICLE 69

#### **Subject-matter of biotechnological inventions**

(1) The biotechnological inventions may have a product or a process as a subject-matter, according to Art. 7 paragraph (1) of the Law.

(2) Products may be biological materials defined in Art. 68 paragraph (2) and genetically modified plants or animals, defined in Art. 68 paragraph (7).

(3) The biological materials mentioned in paragraph (2) comprise:

a) microorganisms isolated from their natural environment or obtained by processes which induce mutations, or genetically modified at the genotype level, characterized by the taxon integration as well as by, morphological and biochemical features, the term of “microorganism” comprising bacteria and other generally unicellular organisms, having microscopic dimensions, which can be handled and multiplied in the laboratory, viruses and plasmids, unicellular fungi, including yeasts, algae, protozoa, as well as human, animal and vegetal cells;

b) genes or vectors, characterized by the succession of nucleotides or with reference to the process for obtaining the same, to a figure such as a restriction map, and to a deposit number of a host cell line comprising them, respectively, or

c) proteins or monoclonal antibodies characterized by the succession of amino acids or by a combination of parameters, such as: source, molecular weight and a functional feature.

(4) The microbiological processes defined according to Art. 68 paragraph (3) are characterized by:

a) starting materials, steps and working conditions, taxon integration, and morphological and biochemical features of the resulting new microbiological material, in case of obtaining a microbiological material; or

b) starting materials, steps and working conditions, taxon integration and morphological and biochemical features of the used microbiological material in case when the biological material helps as a means for carrying out the process or as a starting material.

#### ARTICLE 70

#### **Patentable biotechnological inventions**

(1) According to Art. 7 paragraph (2) letter a) of the Law, the inventions having as a subject-matter a biological material as defined in Art. 68 paragraph (2) are patentable.

(2) The biological material mentioned in paragraph (1) may be isolated from the natural environment and used for practical purposes or may be produced by any technical process.

(3) According to Art. 7 paragraph (2) letter b) of the Law, the inventions relating to plants or animals are patentable, if the technical possibility for carrying out the invention is not confined to a certain plant variety or animal breed, as defined in Art. 68 paragraphs (5) and (6).

(4) According to Art. 7 paragraph (2) letter c) of the Law, the inventions relating to a microbiological process as defined in Art. 68 paragraph (3) or another technical process or a product obtained by such a process are patentable, the product being different from the plant variety or animal breed obtained this way.

## ARTICLE 71

### **Exceptions from patentability**

(1) In the application of Art. 9 paragraph (1) letter a) of the Law, patents shall not be granted in particular to biotechnological inventions having as a subject-matter:

- a) processes for cloning the human being;
- b) processes for modifying the genetic identity of a human being germinal line;
- c) uses of human embryos for industrial or commercial purposes; or
- d) processes for the modification of the genetic identity of animals, liable to cause suffering without any substantial medical benefit for man or animal, as well as animals resulting from such processes.

(2) The exception provided for in paragraph (1) letter c) does not relate to the inventions with therapeutic or diagnosing purpose which are applied to the human embryo, if useful for the same.

(3) According to Art. 9 letter b) of the Law patents shall not be granted for plant varieties and animal breeds as defined in Art. 68 paragraphs (5) and (6) or for essentially biological processes as defined in Art. 68 paragraph (8), for obtaining plants or animals.

(4) In the application of Art. 9 paragraph (1) letter b) of the Law, the plant varieties and animal breeds shall not be granted patents even if the plant varieties and animal breeds are obtained by means of microbiological processes.

## ARTICLE 72

## **Inventions having the human body and its elements as subject-matter**

(1) An element which is isolated from the human body or produced in another way by a technical

process, including the sequence of partial sequence of a gene, according to Art. 7 paragraph (2) letter d) of the Law, may constitute a patentable invention even if the structure of that element is identical to the structure of a natural element.

(2) The human body in various stages of its formation and development as well as the mere discovery of one of its elements including the sequence of partial sequence of a gene, according to Art. 9 paragraph (1) letter c) of the Law, cannot constitute patentable inventions.

(3) In the application of Art. 13 paragraph (2) of the Law, the industrial applicability of a sequence or of a partial sequence of a gene shall be concretely disclosed in the patent application, by indicating the specific function of the sequence or partial sequence.

### SECTION 3

#### **Biological material deposit**

#### ARTICLE 73

#### **Conditions for inventions relating to a biological material**

(1) Where an invention relates to a biological material or to the use of a biological material, which was not available to the public and cannot be described in the patent application in a way which should allow a person skilled in the art to carry out the invention, the invention may be deemed to be disclosed, according to the provisions of Art. 18 paragraph (1), only if:

a) a sample of biological material was deposited with an international depositary authority, prior to the date of filing the application or the date of the recognized priority;

b) the patent application, as filed, contains relevant information available to the applicant with regard to the features of the biological material;

c) the patent application comprises the indication of the international depositary authority and the order number of the deposited biological material .

(2) Where the biological material was deposited by another person than the applicant, the name and the address of the depositor shall be mentioned in the patent application, and a document shall be submitted to OSIM to prove that the depositor authorized the applicant to make reference in the patent application to the deposited biological material, and unreservedly and irrevocably consented to render the deposited material available to the

public, according to Art. 74.

(3) The information mentioned in paragraph (1) letter c) and paragraph (2), as the case may be, may be communicated:

a) within 16 months from the filing date or, if a priority is claimed, from the priority date, the time limit being considered to be observed if the information is communicated until the end of the technical procedures with the view of publishing the patent application;

b) up to the date of presenting the request for publication of the patent application, in compliance with Art. 23 paragraph (3) of the Law;

c) the time limit to expire first is applicable.

(4) After the communication of these information, the applicant shall be considered to consent unreservedly and irrevocably to render the deposited biological material available to the public, according to Rule 74.

## ARTICLE 74

### **Access to the biological material deposit**

(1) The biological material deposited according to Art. 73 may be accessed based on a request, by any person, starting on the date of publication of the patent application, the access being made by the delivery of a sample of deposited biological material to the interested person under the proviso of Art. 75 .

(2) Delivering the sample of deposited biological material, provided for in paragraph (1) shall be made only when the interested person makes the commitment before the applicant or patent owner not to communicate the biological material or a derived biological material to third parties and to use the biological material only for experimental purposes up to the date when the patent application is rejected, withdrawn or considered to be withdrawn, as the case may be, except where the applicant or patent owner expressly gives up such a commitment.

(3) The commitment to use the biological material only for experimental purposes shall not be applicable when the interested person makes use of this material for an exploitation which results from a compulsory license.

(4) The expression "compulsory license" mentioned in paragraph (3) includes the ex officio licenses and any right to use a patented invention for the interest of public.

(5) By derived biological material within the meaning of paragraph (2) there is meant any material having the essential features of the deposited material for carrying out the invention.

(6) The request provided for in paragraph (1) accompanied by the proof of payment of the fee for the certification of an official document shall be addressed to OSIM that certifies both the filing of a patent application referring to a biological material deposit and the fact that the interested person or the expert appointed by that person, in compliance with Art. 75 is entitled to deliver a sample of this material.

(7) The request provided for in paragraph (1) may be addressed to OSIM even after the grant of the patent.

(8) OSIM shall transmit a copy of the request referred to in paragraph (1) accompanied by the certification under paragraph (6) both to the international depository authority and to the applicant or patent owner.

## ARTICLE 75

### **Appointment of an expert**

(1) Up to the end of the technical preparations for the publication of the patent application, the applicant may communicate to OSIM that:

a) up to the publication of the mention of the decision to grant the patent, in compliance with Art. 23 paragraph (4) of the Law; or, where appropriate

b) for a 20-year period starting from the patent application filing date, if the patent application is rejected, withdrawn or considered to be withdrawn, the access provided for in Art. 74 can be allowed only by delivering a sample of biological material to an expert appointed by the interested person.

(2) The appointed expert may be:

a) any natural person, provided that the interested person, according to paragraph (1) makes the evidence that, on the date of filing the request for the delivery of the sample, the appointment of the expert was made with the agreement of the applicant;

b) any natural person that is recognized to be an expert by OSIM.

(3) The appointment mentioned in paragraph (2) is accompanied by a statement made by the expert whereby this assumes the commitment to the applicant, in compliance with Art. 74 and the fact that, either up to the date of the patent expiration or up to the date provided for in paragraph (1) letter b), the patent application may be rejected, withdrawn or deemed being withdrawn, the interested person being deemed to be a third party.

## ARTICLE 76

### **New deposit of biological material**

(1) If the biological material deposited according to Art. 73 paragraph (1) ceases to be available with the international depositary authority, there shall not be considered a discontinuity of its availability if the following conditions are fulfilled cumulatively:

- a) a new deposit is constituted in compliance with the Budapest Treaty;
- b) a copy of the document issued by the international depositary authority, confirming the receiving of the new deposit and in which the application or patent number is mentioned, is sent to OSIM within four months from the date of the new deposit.

## ARTICLE 77

### **Content of description**

The content of the description of an invention in the biotechnological field shall observe the provisions included in Art. 16 and Art. 73 paragraph (1).

## ARTICLE 78

### **Description of the invention relating to microorganisms**

(1) If the subject-matter of the invention relates to a new microorganism strain, the description of the invention shall contain, within the embodiment of the invention, at least one process for obtaining said microorganism, besides the morphological and biochemical features of the microorganism; in the description there shall also be indicated the taxon integration of the microorganism, number of order and date of depositing the microorganism with the international depositary authority where the microorganism was deposited.

(2) If the subject-matter of the invention relates to a product containing a microorganism or it is obtained by means of a process involving a microorganism, or to a process in which a microorganism is involved, the description of the invention shall contain in the embodiment the taxon integration, the morphological and biochemical features of the microorganism, denomination of the microorganism, number of order and date of depositing the microorganism with the international depositary authority as well as the denomination of the international depositary authority where the used microorganism has been deposited.

## ARTICLE 79

### **Description of invention relating to amino acid or nucleotide sequences**

(1) If the subject-matter of the invention relates to amino acid or nucleotide

sequences, the description, after the presentation of the embodiments of the invention, shall contain a list of sequences according to a standardized presentation of the amino acid or nucleotide sequences.

(2) OSIM shall request, besides the written documents of the patent application, the list containing the sequences provided for in paragraph (1), on a data carrier readable by means of a computer, said list being accompanied by a declaration showing that the information recorded on this carrier is identical to the list of sequences contained in the description.

(3) If a list of sequences was filed or corrected after the date of filing, the patent applicant shall file a declaration that the list of sequences filed or corrected does not go beyond the initial filing.

(4) A list of amino acid and nucleotide sequences submitted after the filing date may constitute the missing part of the description, in which case OSIM shall accord a new filing date according to Art. 8 paragraph (9).

## CHAPTER IV

### **Rights**

#### ARTICLE 80

#### **Exceptions concerning the infringement of rights**

(1) In the application of Art. 34 paragraph (1) letter e) of the Law, the following shall not constitute an infringement of the rights provided for in Art. 32 and 33 of the Law:

a) the carrying out of the tests and studies necessary for obtaining the authorization for placing a medicament on the market, as well as the practical requirements resulting therefrom;

b) use for education purposes of the information contained in the patent;

c) the acts concerning the research and development of information contained in the patent, on condition that they are destined exclusively to experiments or studies which intend to evaluate the technical data from the patents.

#### SECTION 1

#### **Transfer of rights**

## ARTICLE 81

### **Assignment and license**

(1) In the application of Art. 45 paragraph (1) of the Law, the assignment is total, if it relates to the whole patented invention, to all of the exploitation rights conferred by the patent. The assignment is partial, if it is limited only to some rights conferred by the patent or only to a certain part of the invention protected by patent.

(2) The priority right may be transferred by assignment only with the agreement of the parties.

(3) The assignment may be limited in time.

(4) The partial assignment leads to the co-ownership of the patent.

(5) The license is exclusive when the licensor has committed himself not to transfer the rights of exploitation of the invention to other persons.

(6) In the case of an exclusive license, if not otherwise provided for, the licensor maintains the right of exploitation of the invention.

(7) The license is non-exclusive if the licensor reserves the possibility of granting the right to exploit the invention to other persons.

(8) In the application of Art. 45 paragraph (1) of the Law, the licence is total if it relates to all rights of exploitation, to the whole patented invention and to the whole territory; the license may be limited to a shorter period of time than the duration of protection period of the patent.

(9) The licensee may grant sub-licences only with the licensor's consent.

(10) The licensee cannot start an infringement action in the court without the patent owner's consent, unless otherwise provided by the license agreement.

(11) By exception to the provisions of paragraph (10), the beneficiary of an exclusive license may start an infringement action in the court if, after having notified the infringement acts he took knowledge of to the patent owner, this did not act within the time limit requested by the licensee.

(12) If the patent owner does not exploit the invention or if the exploitation is not sufficient on the territory of Romania, the importation of the subject-matter of the patent by the patent owner shall be considered to be an exploitation of the patent in Romania.

(13) In case of the transfers of rights registered by a foreign applicant or patent owner, OSIM may, where appropriate, request a translation into Romanian language of the original document of the certified copy of the right transfer contract.

## ARTICLE 82

### **Compulsory licences**

(1) The Law Court of Bucharest may grant a compulsory license in the conditions provided for in Art. 46 of the Law.

(2) In national emergency situations or in other extremely urgent situations, a compulsory license may be granted by the Law Court of Bucharest without being necessary that the interested person requesting the compulsory license prove the attempt to obtain a contractual license.

(3) An interested person may request the grant of a compulsory license only if on the date of the request there exists a published patent application for which OSIM has not made a decision to reject, or that was not withdrawn or deemed to be withdrawn or there exists a patent in force on the territory of Romania.

(4) The beneficiary of the compulsory license has no right to start an infringement action.

(5) The Law Court of Bucharest shall decide with regard to the withdrawal, extent, duration of a compulsory licence as well as with regard to the remuneration due to the patent owner.

(6) Where the invention in the patent application or patent, for which a compulsory license was granted, contains classified information according to Art. 40 of the Law, these will continue to keep the attributed character.

(7) The object of a compulsory license is only the information contained in the patent application or in the patent.

(8) In case when the patent owner fails to pay the annual fees for the maintenance in force of the patent, the beneficiary of the compulsory license shall pay the fees.

(9) The registration of a change of patent owner resulting from the absorption, merging, dividing or dissolution of a legal entity is assimilable to a transfer of rights.

## ARTICLE 83

### **Compulsory licences granted in case of dependent patents**

(1) In case of a compulsory license authorized in the conditions of Art. 46 paragraph (7) of the Law, the owner of the earlier patent is entitled to a licence for the exploitation of the patent granted on the basis of the subsequent application.

(2) Where a patent cannot be exploited without prejudicing the rights conferred by

another patent granted for a patent application whose filing date is earlier, the reference in Art. 46 paragraph (7) letter c) of the Law relates to the fact that the authorized use in respect of the earlier patent is uninterrupted, except when the right in the subsequent patent has been assigned.

(3) A compulsory license for a patent may be exploited without prejudicing the rights conferred by another patent granted for an application whose filing date is earlier than the date of the application for which there was granted the patent which is the object of the license; a compulsory licence may be requested while observing the conditions provided for in Art. 46 paragraph (1) of the Law, in this case the provisions of Art. 82 paragraph (9) being also applicable.

(4) For the purpose of entering the compulsory license in the National Register of Patents and of publication in BOPI, the interested person shall communicate the decision of the Law Court of Bucharest relating thereto.

#### ARTICLE 84

##### **Patent application or patent co-ownership**

(1) Where a patent jointly belongs to more owners, each of them is a co-owner and in this situation the exploitation of the invention may be performed according to a written agreement of the co-owners concerning the manner of exploitation.

(2) In default of a written agreement of the co-owners concerning the manner of exploitation of the invention, each of the co-owners may exploit the invention to his own benefit, with the obligation to pay equitable indemnification to the other co-owners who do not exploit the invention personally, or who have not granted exploitation licences; in default of an agreement, the indemnification shall be established in the law court according to the civil law.

(3) Each of the co-owners may bring an infringement action to his own benefit; the co-owner bringing an infringement action shall notify this action to the other co-owners.

(4) Each of the co-owners may, to his own benefit, grant a non-exclusive exploitation license to a third party, on condition that an equitable indemnification should be paid to the other co-owners who do not exploit the invention personally or who have not granted an exploitation license; in default of an agreement, this indemnification shall be established by the law court according to the civil law.

(5) An exclusive exploitation license can be granted only with the agreement of all co-owners or according to a final and irrevocable decision of the law court.

(6) Each co-owner may, any moment, assign his share of ownership to the patent.

(7) The co-owners dispose of a preference right which shall be exercised within 3 months, starting from the notification of the intention to assign the patent; in the absence of an agreement concerning the price of the assigned quota, the price shall be established by the law court, according to the civil law.

(8) The co-owner of a patent may notify the other co-owners that he renounces his quota to the benefit of the others; starting from the date of entering the renunciation in the National Register of Patents for Invention, said co-owner has no other obligation to the other co-owners; after the renunciation, the other co-owners shall redistribute the renounced quota, except where it has otherwise been provided for.

(9) The dispositions of paragraphs (1) - (8) shall apply *mutatis mutandis* in case of co-ownership of a patent application.

## SECTION 2

### **Registration of rights**

#### ARTICLE 85

#### **Registration of the change of the applicant or patent owner in the National Register of Patents**

(1) The change of the applicant or patent owner is entered in the National Register of Patents based on a written request filed with OSIM by the previous owner, the new owner or by the professional representative, as the case may be.

(2) When the change of the owner results from a contract, the request may be accompanied by a copy of the contract or of an excerpt from the contract, certified by a notary public for compliance with the original.

(3) When the change of the owner results from absorbing, merging, dividing or dissolving a legal entity, the request shall be accompanied by a copy of the document which proves the same, and this shall be certified by a notary public for compliance with the original.

(4) In the situations provided for in paragraphs (2) and (3), if the change refers to one or a part of the co-owners and not to all co-owners, the request may be accompanied by a document signed by the other co-owners, which should contain the express agreement thereof with regard to the new co-owner.

(5) When the change of the patent owner occurred by the effect of the law or according to a decision of the court, the request shall indicate this and shall be accompanied by documents proving this change.

(6) The request shall be considered to have been filed only after the payment of the

fee provided for by the law.

(7) A single request is enough, even if the change relates to more applications or patents belonging to the same persons, if:

- a) the change of applicant or patent owner is the same for all applications and all patents;
- b) numbers of the applications and patents are indicated in the application;
- c) legal fees have been paid for each indicated patent application or for the granted patents.

(8) OSIM may require additional evidence when doubts exist with regard to the truthfulness of the indications in the application or in any document concerning the registration of the owner or the correctness of any translation necessary for the registration.

(9) OSIM shall examine, based on the filed documents, the fulfilment of the legal conditions concerning the request for registration and shall decide the acceptance or the rejection thereof, as the case may be, within 30 days from the filing of the application with OSIM; the 30-day time limit may be extended correspondingly by OSIM, when the necessity of filing other documents or information is ascertained.

(10) The registration of the applicant or owner change shall be entered in the National Register of Filed Patent Applications or in the National Register of Patents, as the case may be, and shall be published in BOPI in the month immediately following to the month when the registration was made.

(11) The provisions of the present article shall also be applied *mutatis mutandis* in the case of a change of the applicant.

## ARTICLE 86

### **Registration of licences or guarantees**

(1) The request for registration of a license shall be made in writing and signed by the owner or the beneficiary of a licence and shall contain the following elements:

- a) express request for the registration of the license;
- b) number of the patent or patents referred to in the license;
- c) name and address of the owner;
- d) name and address of the beneficiary of the license;
- e) indication of the exclusive or non-exclusive character of the license or other indications relating to the kind of license;
- f) denomination of the State in which the beneficiary of the license has a real and

effective industrial or a commercial enterprise as provided for in Art. 3 of the Paris Convention;

g) date of granting and duration of the licence.

(2) The request is considered to be filed only after the payment of the legal fee.

(3) The provisions of paragraphs (1) and (2) shall apply *mutatis mutandis* to:

a) requests for registration of the setting up of a guarantee referring to a patent application or patent;

b) the request for canceling the registration of a licence or of the setting up of a guarantee concerning a patent application or a patent.

(4) The request for registration of the license shall be accompanied by the copy of the license contract or the copy of an excerpt thereof, certified by a notary public for compliance with the original.

(5) When the license is granted on the basis of a decision of the court or it results by the effect of the law, the request for registration of the license shall be accompanied by the final and irrevocable decision mentioned above.

(6) When a guarantee is set up, the request for registration shall be accompanied by the legalized copy of the act for setting up the guarantee.

(7) The fee for the registration of a guarantee is the same in respect of the amount and time limit as the fee to be paid for registration of licenses.

(8) The request for compulsory license, formulated according to Art. 46 paragraphs (1) and (2) of the Law shall be accompanied by the justification of the fact that the person requesting license could not obtain an exploitation license from the patent owner and that he is capable of exploiting the invention seriously and effectively.

(9) The provisions of paragraphs (8) - (10) of Art. 85 shall also apply *mutatis mutandis* in the case of registration of the licenses and of setting up the guarantees.

(10) Upon request by one of the parties, the licenses, sub-licenses, the setting up of a guarantee as well as the measures for compulsory execution, as the case may be, shall be entered in the National Register of Filed Patent Applications or in the National Register of Patents and shall be published in BOPI in the month immediately following to the month when the registration was made.

(11) The provisions of the present article are also applicable to the registration of the licenses and setting up of a guarantee concerning patents.

## ARTICLE 87

### **Cancellation of the registration from the National Registers of OSIM**

(1) The registration of an assignment, license, sub-license or the registration of the setting up of a guarantee may be canceled from the National Register of Filed Patent Applications or from the National Register of Patents, as the case may be, upon the written request by one of the interested persons.

(2) The request for cancellation of the registration shall contain:

- a) name and address of the person requesting the cancellation of registration;
- b) elements for the identification of the patent application or of the patent to which the request for cancellation of registration of a right according to Art. 85 and Art 86 relate;
- c) specification relating to the right whose registration is requested to be cancelled.

(3) The request shall be accompanied by documents proving the cessation of the registered right or by a declaration wherefrom there shall result that the beneficiary of the registered right and the owner of the right agree to the cancellation of registration.

(4) The request shall be deemed to be filed only subject to payment of a fee whose amount is equal to the one provided for the registration of a modification relating to the transfer of rights.

## CHAPTER V

### **Inventions made by employees**

#### ARTICLE 88

#### **Right of the employee to the patent**

(1) According to Art. 3 of the Law, the right to the patent belongs to the inventor or to his successor in title.

(2) Where the inventor is an employee, according to Art. 5 of the Law, the right to the patent belongs to the inventor in the following conditions:

a) the invention has been created in the conditions of Art. 5 paragraph (1) letter a) of the Law and there exists a contract clause through which the right to the patent belongs to the employee;

b) the invention has been created in the conditions of Art. 5 paragraph (1) letter b) of the Law and there does not exist a contrary clause in a contract concerning the inventions made by the employee;

c) the invention made by the employee within the individual employment contract is not in connection with the activity of the employer, was not created in the course of his duty, nor by knowing or using the specific technique or means or data existing in the enterprise and it has not

been created with the material support of the employer;

d) the invention has been created in the conditions of Art. 5 paragraph (2) of the Law and there exists a clause by which the right to the patent belongs to the inventor;

e) the invention can be included in one of the situations provided for in Art. 5 paragraph (5) of the Law and the employee has informed the employer in writing, according to the provisions of Art. 91, but the employer has not filed the patent application with OSIM within 60 days from the date the information was made and there is no other convention between parties.

## ARTICLE 89

### **Right of the employer to the patent for invention**

Where the inventor is an employee, according to Art. 5 of the Law, the right to the patent shall belong to the employer, in the following situations:

a) the invention has been created in the conditions of Art. 5 paragraph (1) letter a) of the Law within a contract with inventive mission and there does not exist a contract provision giving the inventor the right to the patent, the contract with inventive mission being an individual employment contract concluded upon employment, a renewed employment contract which provides for an inventive mission or an additional act to the individual employment contract, if an inventive mission occurs; the inventive mission shall be the object of a distinct clause of the contract, whereby there are explicitly established the technical field, the technical problem or problems which the employee commits himself to solve by involving a creative contribution corresponding to his position;

b) the invention has been created in compliance with the provisions of Art. 5 paragraph (2) of the Law and there does not exist a contrary contract clause by which the inventor is entitled to the grant of the patent within a research contract, this having the possibility to provide a clause through which the right to the grant of the patent belongs either to the employer that commissioned the research or to the research institutions, or to them both; if the research contract does not provide such a clause, the right to the patent belongs to the employer that commissioned the research;

c) the invention has been created in the conditions of Art. 5 paragraph (1) letter b) of the Law and there exists a clause in a contract concluded with the employee by which the right to the patent belongs to the employer.

## ARTICLE 90

### **Relations of the employees - inventors with the employer**

(1) The employee who is the author of an invention shall inform the leadership of the enterprise in writing about the invention created in the conditions provided for in Art. 5 paragraph (3) of the Law.

(2) In case the invention was created by more inventors, the informing shall be made in common by all inventors or by the professional representative thereof.

(3) The informing shall contain sufficient data to allow the employer to evaluate the integration of the invention in one of the categories provided for in Art.5 of the Law and in this article.

(4) The informing shall contain:

- a) the subject-matter of the invention and the application field;
- b) the conditions in which the invention was created;
- c) integration of the invention in the provisions of Art. 5 of the Law, made by the employee-inventor.

(5) The informing shall be accompanied by a description of the invention, when the enterprise has the right to the patent; the description will expose the claimed invention, taking into account the prior art, the proposed solution and an embodiment.

(6) The informing with regard to the invention shall be made personally, with the number of filing with the enterprise, by registered letter, so as to be used as a means of proving the informing of the employer, while observing the provisions of the special law.

(7) The 60-day time limit provided for in Art. 5 paragraph (5) of the Law shall start from the date of filing the informing accompanied by the description.

(8) If the employer and the employee have not come to an agreement concerning the right to the patent, the litigation shall be the competence of the law courts, according to Art. 63 paragraph (1) of the Law; in this case, in order to ensure the protection of the invention, the patent application shall be filed with OSIM by the inventor prior to or after informing the law courts, with the obligation to inform the employer.

(9) Failure to observe the obligation of mutually informing in any case shall bring the responsibility according to the civil law for the prejudices caused, according to Art. 5 paragraph (4) of the Law.

(10) The employer and the employee shall refrain from any disclosure of the invention during the procedure up to the publication of the patent application.

(11) In the case of an invention created in the conditions of Art. 5 paragraph (1) letter b) of the Law, for which the right to the patent belongs to the employee, this has the obligation to make, according to Art. 5 paragraph (6) of the Law, the first offer for a license or assignment to

the employer whose employee he is.

(12) The employer shall, as a result of the offer, express the interest for taking over the rights, within 3 months from the offer, within a contract concluded with its employee.

(13) If within this interval of time the employer did not express the interest, the inventor, in the position of patent owner, has the right to exploit his invention on the basis of a contract with any third party.

(14) If the employer expressed the interest, but an agreement concerning the contract price has not been arrived at, the litigation shall be settled by the law courts, according to Art. 5 paragraph (6) of the Law.

(15) The Ministry of Defense, Ministry of Interior and Administration Reform, Romanian Intelligence Service shall issue internal instructions concerning procedures for applying the Law and these Regulations.

## ARTICLE 91

### **Pecuniary rights of the inventors-employees**

(1) In case of the inventions for which the right to the patent belongs to the employer, according to Art. 5 paragraph (1) letter a) of the Law the inventor-employee is entitled to receive an additional remuneration independent of the basic pay, said remuneration being established by the contract with inventive mission or in an additional act to the individual labour contract.

(2) Where the invention has been created within a research contract, the additional remuneration to be paid to the inventor-employee will be negotiated with the employer whose employee he is, by additional act to the individual labour contract, according to Art. 5 paragraph (2) of the Law.

(3) The patrimony rights of the inventor-employee, according to Art. 36 of the Law shall be established based on a contract and shall be granted depending on the economic and/or social effects resulting during the period of validity of the patent from the exploitation of the patent, or depending on the economic contribution of the invention and only for the period of exploitation thereof.

(4) When negotiating the contract clauses provided for in Art. 36 of the Law, the following shall particularly be taken into account:

a) the pecuniary rights corresponding to the economic effects, including the ones deriving from the social effects during the period of calculation of the profit, cannot be lower than the values from the following table:

\*T\*

Economic/social effects (E) ROL	Pecuniary rights (ROL)
$E \leq 40,000$	$E \times 15\%$ , but not less than 2,00
$40,000 < E \leq 200,000$	$6,000 + E \times 10\%$
$200,000 < E \leq 400,000$	$2,200 + E \times 8\%$
$400,000 < E \leq 800,000$	$38,000 + E \times 6\%$
$E > 800,000$	$62,000 + E \times 4\%$

\*ST\*

b) reimbursement of the expenses directly to the inventor for all technical or economical documentation, projects, studies, researches with prototypes, if these have been carried out by the inventor for the application of the invention;

c) adjusting the pecuniary rights with the official inflation index between the date of performing the payment and the date of ending the negotiation.

(5) When establishing the economic effects there shall be taken into account the difference in costs, elimination or reduction of the imports, reduction of the investment costs.

(6) When evaluating the social advantages there shall be taken into account the reduction of toxicity within the working environment, the reduction of pollution of the environment, the reduction of the physical effort of the personnel working in exploitation, disposal of important equipments for other purposes and the like, such as the difference of costs, elimination or reducing of imports.

(7) The pecuniary rights shall be established for each patented invention and shall be distributed to the inventors according to the authenticated agreement between them.

(8) If the parties do not reach an agreement after the negotiations, the litigation shall be the competence of the law courts.

## ARTICLE 92

### **Storing documents in non-public status**

(1) In compliance with the provisions of Art. 69 letter f) of the Law, OSIM shall perform services of storing, in non-public status, documents that represent intellectual creations. The

document may contain information concerning in particular creations that may be included in Art. 8 paragraph (1) of the Law.

(2) The document referred to in paragraph (1) shall be filed with OSIM in a closed envelope and may represent a way of proving the date on which the author of the intellectual creation deposited the document comprising the description of his creation.

(3) No industrial property shall be granted based on the document contained in the envelope.

(4) The manner of submitting the envelope to OSIM, entering in the Register for non-public documents and keeping the deposit is made based on the instructions issued by the Director General and published in the Official Gazette of Romania, Part I..

## ARTICLE 93

### **Transitional and final provisions**

(1) In the application of the present regulations, the Director General of OSIM shall issue instructions to be published in the Official Gazette of Romania, Part I.

(2) The patent applications filed with OSIM in the conditions of the republished Patent Law no. 64/1991, for which no decision to grant or to reject was made, shall be solved according to the provisions of the new regulations.

