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# The Legal 500 Country Comparative Guides

## Romania

# PATENT LITIGATION

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This country-specific Q&A provides an overview of patent litigation laws and regulations applicable in Romania.

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# ROMANIA

## PATENT LITIGATION



### 1. What is the forum for the conduct of patent litigation?

The court of first instance for patent infringement litigation is the Tribunal (District court). For applications seeking to secure means of evidence, the county court (in Ro. Judecatorie) will have jurisdiction. In this case, the territorial jurisdiction will be determined by reference to the respondent's domicile or headquarter.

Invalidity proceedings must be brought before the Tribunal of Bucharest, which has exclusive jurisdiction.

In Bucharest, the Tribunal, the Court of Appeal and the High Court of Cassation and Justice all have specialised general IP judge panels. However, there are no specific patent specialist judges and judges do not have a technical background, but only a legal one.

### 2. What is the typical timeline and form of first instance patent litigation proceedings?

The form of the patent litigation proceedings is no different than other litigation proceedings, as they are also governed by the provisions of Civil Procedure Code (herein CPC). Thus, after the court states that it has jurisdiction and after deciding upon procedural exceptions to be heard, the submission of evidence (in Ro. cercetare judecătorească) phase of the proceedings will begin.

During this phase, the evidence that sustains the claims and defences of the parties is brought before the court. All matters that must be proved or clarified, such as the existence of the acts of infringement, or the meaning of the patent claims, have to be clarified during the discovery phase.

In Romanian law, claim construction is not a distinct phase of patent litigation proceedings and issues related to the interpretation of the claims are heard together with those concerning infringement and/or validity. Infringement and invalidity claims can be heard in the

same court file which is usually the case.

After there is no more evidence to be presented and the court considers the facts of the case to be clear, the submission of evidence phase is followed by the debates. Thus, both the claimant and the respondent are required, if present, to orally present their claims or defences.

As regards the length of the trial, it depends on the complexity of the matters brought before the court and the amount of evidence that needs to be presented, most notably the expert report. The more complex the evidence and the claims, the longer the proceedings will last. It usually takes more than 1 year for a first instance court judgement to be issued in infringement proceedings, while invalidity first instance decisions can be issued following 1-2 years.

Regarding determination of the damages, it may be ordered in both separate proceedings and as a part of the main patent infringement proceedings. In practice, damages are usually claimed in separate proceedings.

If the claim for damages is filed separately, the competent court shall be determined based on the amount of the claim, in accordance with the general provisions of the CPC.

### 3. Can interim and final decisions in patent cases be appealed?

An overview of the ways to appeal/review decisions in patent cases in Romania is included in the EPO's *Patent enforcement in Europe A country-by-country overview*<sup>1</sup>.

As a rule, interim decisions (in Ro. incheieri de sedinta), by which the judge decides on the evidence to be submitted or on any other procedural issue, can only be appealed together with the final decision.

Both preliminary injunctions<sup>2</sup> (in Ro. ordonanță președințială) and final decisions on merits can be appealed, but under different conditions. In both cases,

no permission to appeal is required.

Regarding final decisions of first instance courts on merits, CPC states that they can be subject to appeal. As a general rule, the appellant must file a request within 30 days after the date of the service of the judgment to be appealed.

As for preliminary injunctions, the CPC provides that the injunction is subject to appeal within five days of service of the grounds for the decision (if it was granted *ex parte*) or within five days of pronouncement of the judgment (if the parties were summoned).

The appeal shall be filed with the court whose decision is appealed and this court will forward the file together with the appeal to the relevant appellate court which has jurisdiction to decide the appeal.

Under Romanian law, the appeal is not restricted to issues of law, but, on the contrary, it implies a *de novo* consideration of issues of both fact and law. However, the grounds of appeal are limited to the issues that were brought before the first instance court. This means that no new request can be lodged after the first instance court delivered its decision.

Generally, the decision on the appeal may further be challenged by an appeal on points of law (in Ro. *recurs*) within 30 days after the date of service of the judgment. The appeal on points of law cannot challenge the facts of the case, as they have been established by the previous courts.

An appeal on points of law cannot be submitted in case of preliminary injunctions.

As for enforcing the decision of the first instance court while the appeal is being heard, the applicable legal provisions are different for preliminary injunctions and decisions on the merits.

As a rule, first court decisions on merits in patent litigation are not enforceable until the period for lodging an appeal expires without them being challenged.

On the other hand, a preliminary injunction is immediately enforceable but, if requested, the court can stay the enforcement. If the enforcement is stayed, the party that had to fulfil the obligations provided for in the decision must lodge a security in the amount set by the court.

Footnotes:

<sup>1</sup>[https://documents.epo.org/projects/babylon/eponet.nsf/0/EAA84D9341629828C12585220059FFEE/\\$File/patent\\_enforcement\\_in\\_europe\\_2020\\_en.pdf](https://documents.epo.org/projects/babylon/eponet.nsf/0/EAA84D9341629828C12585220059FFEE/$File/patent_enforcement_in_europe_2020_en.pdf)

[enforcement\\_in\\_europe\\_2020\\_en.pdf](https://documents.epo.org/projects/babylon/eponet.nsf/0/EAA84D9341629828C12585220059FFEE/$File/patent_enforcement_in_europe_2020_en.pdf)

<sup>2</sup> We will refer further on to *interim injunctions as preliminary injunctions*.

#### 4. Which acts constitute direct patent infringement?

Art. 31 Para. 2 of Law no. 64/1991 on patents lists the actions that are prohibited to those who do not have the consent of the patent holder, and, in this way, determines which acts constitute direct patent infringement.

Thus, the following constitute acts of direct patent infringement:

- manufacture, use, offer for sale, sale or import for use, offer for sale or sale, where the subject-matter of the patent is a product;
- the use of the process, as well as the use, offering for sale, sale or import for these purposes of the product obtained directly by the patented process, where the subject-matter of the patent is a process.

However, Art. 33 of Law no. 64/1991 on patents limits the scope of Art. 31 Para. 2 by listing a number of cases when those above are not considered acts of infringement, namely:

- The use of inventions in the construction and operation of land, air vehicles, and on board ships or devices for their operation, belonging to the Member States of international treaties and conventions on inventions to which Romania is a party, when these vehicles or ships enter the territory of Romania, temporarily or accidentally, provided that such use is made exclusively for the needs of vehicles or ships;
- The performance of any of the acts referred to in Art. 31 Para. 2 by a person who has applied the subject-matter of the patent or that of the patent application, as published, or has taken effective and serious measures to produce or use it in good faith on the territory of Romania, independently of its holder, and before the establishment of a national regulatory deposit on the invention or before the date from which the term of priority recognized flows; in this case, the invention may continue to be used by that person, in the volume existing at the date of deposit or priority recognized, and the right to use may be transferred only with the person's

- patrimony or with a fraction of the patrimony affected by the exploitation of the invention;
- The performance of any of the acts referred to in Art. 31 Para. 2 exclusively in private and for non-commercial purposes; producing or, where appropriate, using the invention exclusively in private and for non-commercial purposes;
  - The marketing or offering for sale in the territory of the European Union of those copies of the product, the object of the invention, which were previously sold by the patent holder or with his express consent;
  - Use for experimental purposes, exclusively of a non-commercial nature, of the object of the patented invention;
  - Use in good faith or take effective and serious measures of use of the invention by third parties in the period between the revocation of the patent holder and the revalidation of the patent. In this case, the invention may continue to be used by that person, in the volume existing at the time of publication of the mention of the revalidation, and the right to use may be transmitted only with the patrimony of the person using the invention or with a fraction of the patrimony that is affected by the exploitation of the invention;
  - The exploitation of the invention or part of it if the protection has been waived, even in part.

### 5. Do the concepts of indirect patent infringement or contributory infringement exist? If, so what are the elements of such forms of infringement?

The infringement acts are expressly provided for in Art. 31 of Law no. 64/1991, as stated above. Romanian legislation does not contain any provisions on indirect patent infringement or contributory infringement.

### 6. How is the scope of protection of patent claims construed?

The Romanian Patent Law no. 64/1991 provides a scope of protection in terms similar to article 69 of the European Patent Convention (herein EPC) and the Protocol on the Interpretation of Article 69 EPC. In this respect, according to Art. 31 Para. 3 of Law no. 64/1991, the extent of protection shall be determined by the claims, while the description and drawings shall be used to interpret the claims. The relationship between the claims and the description and drawings should be considered as a middle ground between the strict, literal

meaning of the words used in the claims, on the one hand, and to what, from a consideration of the description and drawings by a person skilled in the art, the patent proprietor has contemplated.

Art. 31 Para. 6 of Law no. 64/1991 states that in determining the extent of the protection, account shall be taken of any element equivalent to an element specified in the claims. Thus, the *doctrine of equivalents* applies under Romanian law. Art. 64 Para. 6 of Implementing Regulation of Law no. 64/1991 explains the term *equivalent* and states that an element is considered equivalent to an element specified in the claims, if it is obvious to a specialist in the field that its use essentially achieves the same result that is obtained by the element specified in the claims.

Many legal systems provide for a form of prosecution history estoppel, also known as file-wrapper estoppel. The term generally refers to the situation where a person who has filed a patent application, and then makes narrowing amendments to the application to accommodate the patent law, may be precluded from invoking the doctrine of equivalents to broaden the scope of their claims to cover subject matter ceded by the amendments.

A form of prosecution history estoppel is not expressly provided for under Romanian law, but Art. 33 Para. 1 letter g of Law no. 64/1991 has a somewhat similar effect. It states that the exploitation of the invention or part of it is not an infringement if the protection was waived for the invention or that part of the invention.

### 7. What are the key defences to patent infringement?

The respondents in patent infringement litigations can defend themselves by denying the infringement itself and proving that the action that the claimant relies on did not exist or does not constitute an act of infringement. Another strategy for the defence may be to prove that the patent was not valid at the time when the supposed act of infringement took place. This requires submission of a patent annulment counterclaim by the respondent.

Another possible defence is based on compulsory licences. Should the conditions for granting a compulsory licence be met, the respondent may submit such a counterclaim and use it in his defence.

### 8. What are the key grounds of patent invalidity?

Patent invalidity can be discussed either as a defensive counterclaim brought by the party that is accused of infringement, or as a separate, independent claim which, under Romanian law, is an application for annulment.

Art. 51 Para. 1 of Law no. 64/1991 provides for the grounds of invalidity, as follows:

- *the subject-matter of the patent is not patentable, according to articles 6 to 9, 11 and 12.* This means that the patent can be voided if the subject matter does not meet the requirements for the valid grant of a patent, namely:

- the subject-matter of the patent is not an invention.

Art. 7 Para. 1 of Law no. 64/1991 states that *'The following shall not be regarded as inventions within the meaning of Art. 6, in particular:*

*(a) discoveries, scientific theories and mathematical methods;*

*(b) aesthetic creations;*

*(c) plans, principles and methods in the exercise of mental activities, in matters of games or in the field of economic activities, nor in computer programs;*

*(d) presentations of information.'*

- the subject-matter of the patent is not new. The novelty is defined by Art. 9 Para. 1 of Law no. 64/1991 which provides that *'An invention is new if it is not included in the state of art.'*

- the subject-matter of the patent does not involve an inventive activity. This requirement is provided for in Art. 11 Para. 1 of Law no. 64/1991. According to this Art. *'An invention shall be considered to involve an inventive activity if, for a specialist person, it is not evident from the knowledge contained in the state of the art.'*

- the subject matter of the patent is expressly excluded from patenting by Art. 8 Para. 1 of Law no. 64/1991. According to this Art. *'No patent is granted, according to this law, for:*

*(a) inventions the commercial exploitation of which is contrary to public policy or morality, including those harmful to the health and life of humans, animals or plants, and which are liable to cause serious harm to the environment, provided that such exclusion does not depend solely on the fact that exploitation is prohibited by a legal provision;*

*(b) plant varieties and animal breeds, nor for essentially biological processes for the production of plants or animals. The provision shall not apply to microbiological*

*processes and products obtained by these processes;*

*(c) inventions having as their object the human body at the various stages of its formation and development, nor for the simple discovery of one of its elements, including the sequence or partial sequence of a gene;*

*(d) the methods of treatment of the human or animal body, by surgery or therapy, and the methods of diagnosis practiced on the human or animal body.'*

- the subject-matter of the patent does not reveal the invention sufficiently clearly and completely so that a person specialized in the field can remake it;

- the subject-matter of the patent exceeds the content of the application, as it was filed;

- the protection granted by the patent has been extended;

- the patent holder was not entitled to the patent.

## 9. How is prior art considered in the context of an invalidity action?

Art. 9 Para. 2 of Law no. 64/1991 provides that state of art comprises all knowledge which has become accessible to the public by written or oral description, use or otherwise, until the date of filing of the patent application. Essentially, the approach is similar to that of the EPO.

It is considered that knowledge is made accessible to the public by presentation on different media or on different information channels, as well as by oral description of information that has not been subject to any confidentiality restriction regarding the use or dissemination of this information (Art. 38 Para. 2 of Implementing Regulation of Law no. 64/1991).

The content of patent applications submitted to OSIM and of the international applications for which the national phase has been opened in Romania or of European applications designating Romania, as they have been submitted, if they have a filing date prior to that of the application analysed, and which have been published, even if the publication occurred later, is considered prior art (Art. 9 Para. 3 of Law no. 64/1991).

Determining the state of art is relevant for assessing novelty and obviousness (inventive step). For assessing novelty, prior art references cannot be combined (Art. 45 Para. 3 of Implementing Regulation of Law no. 64/1991), but for assessing obviousness, a combination of the references is permitted. In this respect, Art. 47 Para. 4 of

Implementing Regulation of Law no. 64/1991 provides that to assess inventive activity, either several documents, parts of several documents, or different parts of the same document belonging to the state of the art, may be combined in a mosaic system and compared with the claimed invention, **provided that this combination is obvious to a specialist.**

### 10. Can a patentee seek to amend a patent that is in the midst of patent litigation?

Generally, the patentee can amend the patent application, at the request of OSIM or on their own initiative, but only until a decision regarding the application is given. (Art. 26 Para. 5 of Law no. 64/1991). After the patent is granted, the patentee does not have the right to amend the patent.

However, the patent holder can waive the protection granted, in whole or in part. We believe that such a narrowing amendment can occur even during patent litigation, as there are no prohibitive provisions in this regard.

### 11. Is some form of patent term extension available?

According to Art. 30 of Law no. 64/1991 the patent protection lasts 20 years, starting from the date of filing. There are no legal provisions that enable any form of patent term extension.

In the pharmaceutical field, Council Regulation (EC) No 469/2009 of the European Parliament and of the Council of 6 May 2009 concerning the supplementary protection certificate for medicinal products (SPCs) is directly applicable in Romania. SPCs aim to offset the loss of patent protection for pharmaceutical and plant protection products that occurs due to the compulsory lengthy testing and clinical trials these products require prior to obtaining regulatory marketing approval. An SPC can extend a patent right for a maximum of five years.

### 12. How are technical matters considered in patent litigation proceedings?

Not only in patent litigation, but in all kinds of Romanian judicial proceedings, the clarification of technical matters can be done by way of independent experts.

It is important to note that an expertise is not mandatory, as the court has the right to decide if it is necessary and useful for the case. If an expert report is ordered, the court will appoint an expert, by arbitrarily

choosing from the list of authorized judicial experts with the required specialisation.

The parties have the right to appoint their own experts on the case and each expert will draw up his own expertise report. However, the most important opinion will be that of the court appointed expert.

As a rule, the expert will give written answers, but, if needed, he can be held to give oral statements for clarifications, in case the court orders such measure.

The parties have the right to file oppositions to the expert report, but the court will decide which oppositions will be allowed, if any. The expert is required to provide an answer, usually in writing, to the oppositions that the court allowed. Moreover, the expert has the obligation to provide an impartially and complete point of view.

In special circumstances, the parties may ask the court to order a new expert report on the same problems.

### 13. Is some form of discovery/disclosure and/or court-mandated evidence seizure/protection (e.g. saisie-contrefaçon) available, either before the commencement of or during patent litigation proceedings?

The Romanian law provides an intricate legal framework for requesting information from the opposing party, as well as for preserving evidence and seizure, both based on the provisions of the applicable EU Directive, but with overlaps from the generally applicable procedure law.

In the European legislation, patent litigation matters are regulated by the European Directive 2004/48/EC (herein ED) which was transposed (mostly translated as such) into Romanian legislation by GEO No. 100/2005 on Enforcement of Industrial Property Rights.

On February 15th 2013, the new CPC entered into force. The Law No. 76/2012 on the application of the CPC expressly repealed some of the provisions of the Government Emergency Ordinance (herein GEO) no. 100/2005 while leaving other provisions untouched. In addition, according to Art. 83 of the Romanian Law No. 76/2012 for the implementation of the CPC, on the date of entry into force of the new CPC, any contrary provisions, even if included in special laws, are to be considered repealed.

Therefore, many legal provisions in the GEO are inconsistent or incompatible with the general rules of civil procedure, but it is difficult to assess whether they

are contrary to those general rules within the meaning of Art. 83 the Romanian Law No. 76/2012 for the implementation of the CPC. This has resulted in the GEO being inconsistent with the terminology of the new CPC and explains why the provisions of GEO have not been applied in judicial practice.

In addition, regarding patent litigation, Art. 978 and Art. 979 CPC also provide for provisional measures that can be ordered in urgent cases, by a preliminary injunction. According to 978 Para. 2 CPC, the court may order taking the necessary measures to ensure the preservation of evidence. The overall legal context hasn't changed since our first warning sign in the EPO's *Patent enforcement in Europe A country-by-country overview*<sup>3</sup>.

Regarding **requesting information**, Art. 5 of GEO no. 100/2005 (a translation of Art. 6 of the ED) provides that, on application by a party which has presented reasonably available and sufficient evidence to support its claims, and provided that the evidence requested lies in the control of the opposing party, the court may order that such evidence be presented by the opposing party, subject to the protection of confidential information.

The aforementioned provision also states that in the case of infringement on a commercial scale, the competent court may, at the request of one of the parties, order the communication of banking, financial or commercial documents under the control of the opposing party, subject to the protection of confidential information. However, GEO no. 100/2005 does not provide supplementary details e.g. as to what happens if the court order is not executed, what the exact procedural framework is within which this right can be enforced, etc.

These legal provisions may be supplemented by the common rules laid out in CPC. According to Art. 293 Para. 1 CPC, if a party claims that the opposing party has an evidentiary document in its possession which is relevant to the matter at stake, the court may order that this document be presented. Para. 2 of the same Art. states that the application will be admitted if the document is common to the parties, if the opposing party itself has referred to this document or if, according to the law, the party is obliged to exhibit the document. This procedure is called "the obligation of the opposing party to present the document" (in Ro. *obligația părții adverse de a prezenta înscrisul*).

According to Art. 294 CPC, the judge shall reject the request for submission of the document, in whole or in part, where:

1. the content of the document solely refers to personal matters concerning the dignity or

- private life of a person;
2. the submission of the document would violate a legal obligation of secrecy;
3. the submission of the document would expose the party, their spouse, or a relative to prosecution.

Unless otherwise provided by the law, the incidence of any of the above circumstances shall be verified by the judge examining the content of the document. Mention will be made in any minute of the public hearing.

According to Art. 295 CPC, if a party refuses to respond to questioning aimed at proving the possession or existence of the document, or if it appears from the evidence that the party has hidden or destroyed the document, or if after it was proven that the party has the document, the party does not comply with the order issued by the court to present it, the court will be able to consider as proven the allegations made on the content of that document by the applicant Party.

Nevertheless, Art. 293 Para. 1 CPC only refers to evidentiary documents which lie in the control of the opposing party. Therefore, in Romanian procedural legislation, there is currently no procedure for requesting anything other than evidentiary documents.

As for **preserving evidence**, there is Art. 6 Para. 1 GEO no. 100/2005 (translation of Art. 7 of the ED), stating that, before the proceedings on the merits, the competent court may, at the request of a party who has provided evidence (see the provisions of Art. 5 Para. 1 GEO no. 100/2005) in support of its claims that an infringement has occurred or is imminent, order provisional, expeditious and effective measures to preserve the evidence relevant to the case, subject to the protection of confidential information.

According to Art. 6 Para. 1 GEO and Art. 979 CPC, the order is issued in a separate proceeding from the one on the merits of the case.

According to Art. 6 Para. 2 GEO, provisional measures may include the detailed description, with or without taking samples of the goods in issue and, where appropriate, of the materials and instruments used to produce and/or distribute the goods and documents related thereto.

Para. 3 of the same Art. states that the measures for the preservation of evidence are ordered by the competent courts in accordance with the provisions of the CPC concerning provisional measures in the field of intellectual property rights. Art. 979 Para. 4 CPC establishes that the court will decide according to the provisions relating to a preliminary injunction.

Art. 364 Para. 1 CPC states that at the request of any person who has an interest in urgently finding certain facts which may cease or change until the evidence is handed over, the bailiff in whose territorial jurisdiction the request is made will be able to ascertain the relevant facts.

Besides the rules mentioned in the previous sections, the CPC also provides for the possibility of a judicial seizure. Art. 972 provides that the judicial seizure consists in the sequestration of goods that form the object of the dispute or other assets, by entrusting their custody to a seizure administrator. The seizure administrator is not a state official and is appointed by the court as a result of the parties agreement. The seizure administrator can be the person who possesses the goods.

As already mentioned in the EPO's *Patent enforcement in Europe A country-by-country overview*<sup>4</sup>, these special provisions are not harmonised with the general ones in the CPC, and in some cases overlap, for instance, measures for preserving evidence (Art. 359 CPC) and a procedure for a preliminary injunction (Art. 979 CPC). The procedure for preserving evidence (Art. 359 CPC) is meant to apply in urgent cases independently of the specific provisions applying in the case of a preliminary injunction. Therefore, the procedure for a preliminary injunction complicates the procedure and the conditions that are required for such a measure to be granted.

Moreover, in the Romanian legal tradition it has long been held that a judicial seizure will be ordered following a special procedure which is not compatible with the procedure of an interim order. Despite this, the GEO no. 100/2005 specifically provides that the physical seizure of the goods (a judicial seizure) will be decided according to the provisions relating to preliminary injunction.

Footnotes:

<sup>3</sup>[https://documents.epo.org/projects/babylon/eponet.nsf/0/EAA84D9341629828C12585220059FFEE/\\$File/patent\\_enforcement\\_in\\_europe\\_2020\\_en.pdf](https://documents.epo.org/projects/babylon/eponet.nsf/0/EAA84D9341629828C12585220059FFEE/$File/patent_enforcement_in_europe_2020_en.pdf)

<sup>4</sup>[https://documents.epo.org/projects/babylon/eponet.nsf/0/EAA84D9341629828C12585220059FFEE/\\$File/patent\\_enforcement\\_in\\_europe\\_2020\\_en.pdf](https://documents.epo.org/projects/babylon/eponet.nsf/0/EAA84D9341629828C12585220059FFEE/$File/patent_enforcement_in_europe_2020_en.pdf)

#### **14. Are there procedures available which would assist a patentee to determine infringement of a process patent?**

The Romanian legislation does not provide a direct system of assistance for the patent holder to determine

the infringement, but there are provisions that have a positive effect in this respect.

First, according to Art. 6 of GEO no. 100/2005, if the patentee presented reasonably available and sufficient evidence to support its claims, he may ask the court to order measures of preservation that include, among others, a detailed description, with or without taking samples.

Second, Art. 58 of Law no. 64/1991, for the benefit of the holder of a process patent, provides a set of presumptions in assessing the infringement. Para. 2 provides that any identical product which has been produced without the consent of the patent holder shall be deemed, until proven otherwise, to have been obtained by the patented process in at least one of the following circumstances:

- whether the product obtained by the patented process is new;
- if there is a substantial likelihood that the identical product was obtained by the process in question and the proprietor of the patent has not been able, despite reasonable efforts, to determine which process was actually used.

#### **15. Are there established mechanisms to protect confidential information required to be disclosed/exchanged in the course of patent litigation (e.g. confidentiality clubs)?**

There are no specific legal provisions concerning the protection of confidential information in patent proceedings. However, there are analogous procedures.

The first is that the hearing may be held in camera in order to protect confidentiality. Art. 263 Para. 2 CPC states that in cases where a public hearing would undermine morality, public order, the interests of minors, the private life of the parties or the interests of justice, as the case may be, the court, on request or ex officio, may order it to take place in whole or in part without the presence of the public.

The second is that according to judicial practice and depending on the particularities of the case, the judge may order that certain documents in the case file be unavailable to the opposite party.

#### **16. Is there a system of post-grant**



### **opposition proceedings? If so, how does this system interact with the patent litigation system?**

According to Art. 49 Para. 1 of Law no. 64/1991, anyone has the right to submit a written and reasoned request to OSIM for revocation of the patent within 6 months of the publication of its granting. This means that, even after the patent was granted, there is a non-judicial procedure that enables the interested person to challenge the validity of the patent.

As a general rule, this procedure cannot interfere with a typical application for annulment because the application for annulment can be filed only after 6 months from granting the patent have elapsed. (Art. 52 Para. 1 of Law no. 64/1991).

### **17. To what extent are decisions from other fora/jurisdictions relevant or influential, and if so, are there any particularly influential fora/jurisdictions?**

In the Romanian legal system, the judicial precedent is not considered source of law, except for some decisions issued by the High Court for Cassation and Justice in procedures aimed at unifying the case-law. Therefore, a court decision on a similar matter will not be binding on another court, regardless of whether it is given in Romania or in another jurisdiction.

However, in practice, Romanian courts will often follow decisions issued by prestigious patent courts (i.e. the Federal Patent Court of Germany, UK Courts). In recent PI case-law it has been established that consistent foreign decisions on the invalidity of a European patent are to be seen as having the evidentiary value of an expert report.

### **18. How does a court determine whether it has jurisdiction to hear a patent action?**

In order to determine its jurisdiction to hear a patent action, a Romanian court shall apply the provisions of Regulation (EU) No 1215/2012 of the European Parliament and of the Council on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters (herein Regulation).

As a rule, according to Art. 4 of the Regulation, the jurisdiction is determined based on the place where the respondent is domiciled. As a result, Romanian Court will be competent to hear a Romanian patent infringement action if the respondent is domiciled in Romania.

Art. 7 para. 2 of the Regulation provides for special jurisdiction on matters relating to tort, delict, or quasi-delict. Therefore, a Romanian court will be competent if the harmful event occurred or may occur in Romania. In this respect, a Romanian court will have jurisdiction to decide on the infringement of a Romanian patent by a foreign entity if the alleged infringement act took place in Romania.

As for invalidity proceedings, Art. 24 Para. 4 of the Regulation state that in proceeding registration or validity of registered intellectual property rights, including patents, the courts in the state of registration have exclusive jurisdiction.

The Art. mentioned adds that, without prejudice to the jurisdiction of the European Patent Office under the convention on the Grant of European Patents, signed at Munich on 5 October 1973, the courts of each Member state shall have exclusive jurisdiction in proceedings concerned with the registration or validity of any European patent granted for that Member State.

As for anti-suit injunction, there are no legal provisions related to this matter.

With reference to foreign patents, there is no case law concerning Romanian courts ruling on infringement or validity of foreign patents. Moreover, it is unclear whether Art. 7 para. 2 of the Regulation could lead a Romanian court to consider itself competent to rule on infringement of a foreign patent.

### **19. What are the options for alternative dispute resolution (ADR) in patent cases? Are they commonly used? Are there any mandatory ADR provisions in patent cases?**

There are no mandatory alternative dispute resolution provisions, but the parties are free to choose which form of dispute resolution suits their interest better.

Apart from commencing judicial proceedings, the parties can also mediate their conflict, as well as proceed with arbitration, although these procedures cannot lead to patent annulment.

### **20. What are the key procedural steps that must be satisfied before a patent action can be commenced? Are there any limitation periods for commencing an action?**

There are no mandatory procedures to be followed

before the action is brought. As for the limitation period for commencing an action, it depends on the specific of the claim. For invalidity claims, Art. 52 Para. 1 of Law no. 64/1991 provides that it can be brought any time while the patent is still within its validity period, but only after 6 months from granting date have elapsed.

Infringement claims shall be brought with the general limitation period applicable, namely 3 years from the date the claimant knew, or should have known, about the infringement and the person liable for the infringement.

## **21. Which parties have standing to bring a patent infringement action? Under which circumstances will a patent licensee have standing to bring an action?**

Generally, the patent holder is the one to bring a patent infringement action, but as stated in Art. 81 Para. 11 of Implementing Regulation of Law no. 64/1991, the holder of an exclusive license could bring such an action if he informed the patent holder about the acts of infringement which he acknowledged and the patent holder did not act.

In addition, the holder of a license can bring an infringement action if the license agreement grants him this right.

## **22. Who has standing to bring an invalidity action against a patent? Is any particular connection to the patentee or patent required?**

There are no restrictive conditions regarding the person that has standing to bring an invalidity action against a patent. As it appears from articles 50 to 52 of Law no. 64/1991, any person can file for the revocation of the patent, in the first 6 months from granting, or for the annulment of the patent after that period elapsed.

However, as stated in Art. 32 of CPC, for bringing any kind of action before the court, the claimant must act on a personal and legitimate interest. Thus, even though there are no explicit conditions regarding a connection to the patentee or patent for bringing an invalidity claim, the claimant still must be able to prove that he has an interest.

## **23. Are interim injunctions available in patent litigation proceedings?**

Regarding patent litigation, Art. 978 and Art. 979 CPC provide for provisional measures that can be ordered in urgent cases, by a preliminary injunction. According to 978 Para. 2 CPC, the court may order:

- prohibition of the infringement or its provisional termination
- taking the necessary measures to ensure the preservation of evidence

After establishing that the claimant is entitled to file the claim, the court may order one of those provisional measures above, to enforce a right that would otherwise be delayed, to prevent imminent and irreparable damage, as well as removing obstacles that may arise in the course of enforcement.

According to Art. 979 Para. 1 CPC, precautionary measures may be ordered when the claimant demonstrates that the patent is infringed or the likelihood that it will be infringed, and that there is a risk of irreparable damage.

The competent court is determined in accordance with the general provisions of the CPC.

These measures may be issued in separate proceedings before proceedings on the merits have been initiated.

According to Art. 978 Para. 6 CPC, provisional measures instituted before proceedings on the merits have been initiated cease to have effect if the claimant has not brought the matter before the court within the time limit set by the court, but no later than 30 days after their enactment.

The conditions (Art. 997 Para. 1 CPC) for the admissibility of a request for preliminary injunctions are that: the proceedings are commenced as a matter of urgency (in practice, this condition is presumed to be satisfied in IP cases), the temporary nature of the order, the non-judgment of the merits and the existence of an appearance of a right to be protected.

The preliminary injunction is a preliminary procedure and does not decide the merits of the case.

A preliminary injunction may be granted ex parte (Art. 999 Para. 2 CPC). The Romanian procedure does not define "appropriate cases" in which the interim order may be issued ex parte. However, in practice, injunctions are very rarely granted without all parties being heard.

According to Art. 979 Para. 5 CPC, if the provisional measures are likely to cause prejudice to the respondent, the court may oblige the claimant to lodge a security in the amount set by the court, subject to the

sanction of discontinuance of the measure if the security is not lodged.

Unless otherwise provided, the security will not represent more than 20% of the value of the claim, and in the case of applications where the claim is not valued financially, it may not exceed RON 10.000 (Art. 1057 Para. 2 CPC).

According to Art. 1058 Para. 2 CPC, subject to the claimant's consent, the security may also consist of financial instruments that serve as payment instruments, i.e. cheques, promissory notes. However, the claimant's consent is not necessary where the security is issued by the state or administrative-territorial departments. In addition, according to Art. 1059 CPC, subject to the respondent's consent, security may also constitute a mortgage over movable or real estate assets.

According to Art. 979 Para. 7 CPC the claimant is required to compensate the respondent for any damage caused by the provisional measures if the main proceedings are dismissed as groundless. However, if the claimant was not or only minimally at fault the court may, depending on the circumstances, refuse to indemnify the respondent.

Therefore, the Romanian procedure only covers the situation in which the main proceedings are dismissed as groundless.

#### **24. What final remedies, both monetary and non-monetary, are available for patent infringement? Of these, which are most commonly sought and which are typically ordered?**

As stated in Art. 11 GEO no. 100/2005 (a translation of Art. 10 of the ED), apart from the damages (the monetary remedy for the patent holder), the court, at the claimant's request, may order one of the following measures concerning the counterfeited products and the items used for producing them:

- recall from the channels of commerce
- removal from the channels of commerce
- destruction

The abovementioned measures are referred to as "Corrective measures"

The aforementioned provision does not specifically prohibit the possibility for claimants to request multiple

measures in parallel. Nevertheless, in practice the claimant is usually only interested in obtaining recall of the goods from the channels of commerce and their definitive removal.

In examining the request for corrective measures, the court shall consider proportionality between the seriousness of the infringement and the corrective measures to be ordered, as well as the interests of third parties (Art. 11 Para. 3 GEO no. 100/2005).

Romanian legislation does not define how "proportionality" as referred to in Art. 10.3 ED This issue remains at the discretion of the court, which will judge according to the circumstances of the case. The court will generally consider inter alia the good or bad faith of the respondent. However, to do so, a defence of non-proportionality must be raised by the respondent (the judge does not assess proportionality ex officio).

At the request of the respondent who has infringed an IP right and who is liable to be bound to one of the measures or prohibitions provided for in Arts. 11 and 12 GEO no. 100/2005, the court may order that person to pay the claimant a pecuniary compensation instead of applying the measures (Art. 13 Para. 1 GEO no. 100/2005). The court having heard the case on the merits is the competent authority to issue this order.

There is no case law in Romanian judicial practice concerning provisions corresponding to Art. 12 ED (Art. 13 of the GEO no. 100/2005). The alternative measure of pecuniary compensation is not frequently ordered.

The court will proceed according to the provisions of Art. 13 Para. 1 GEO no. 100/2005 if the following conditions are cumulatively met:

- the person acted unintentionally and with negligence; and
- the execution of the measures requested would cause the respondent disproportionate damage in relation to the scale of infringement; and
- payment of the pecuniary compensation as provided for in Para. 1 is reasonably satisfactory.

Moreover, in infringement proceedings the competent court may order at the request of the claimant and at the expense of the respondent, appropriate measures for dissemination of the judgment, including its full or partial publication (Art. 16 Para. 1 GEO no. 100/2005) in a national newspaper, in a local one or in audio-visual media.

The court may also order additional publicity measures

for any special circumstances of the case, including widespread publicity (Art. 16 Para. 2 GEO no. 100/2005)

## 25. On what basis are damages for patent infringement calculated? Is it possible to obtain additional or exemplary damages?

According to Art. 14 Para. 2 GEO no. 100/2005, when determining damages, the court will consider:

- a. all relevant aspects, such as adverse economic consequences, in particular loss of profit suffered by the claimant, unfair profits obtained by the infringer and, where appropriate, other factors such as the moral damage caused to the claimant; or
- b. alternatively, where appropriate, the court may award a lump sum for damages on the basis of the total amount of royalties that would have been due had the respondent requested a licence to use the right in question.

Romanian legislation does not provide for the possibility for a claimant to choose between the different calculation methods, nor does it expressly allow the judicial authorities to mix and match different calculation methods.

The methods listed in Art. 14 GEO no. 100/2005 are alternative, not cumulative, and cannot be combined.

In Romania, most frequently damages are awarded in accordance with the lost profits method.

As provided for in Art. 14 GEO no. 100/2005, determination of the damages may be ordered in both separate proceedings and as a part of the main patent infringement proceedings.

If the claim for damages is filed separately, the competent court shall be determined based on the amount of the claim, in accordance with the general provisions of the CPC.

Romanian legislation does not provide for the possibility for a claimant to obtain exemplary damages for patent infringement.

## 26. How readily are final injunctions granted in patent litigation proceedings?

Generally, final injunctions are granted when the patent holder proves the act of infringement or the imminence of such act.

Art. 13 of GEO no. 100/2005 (translation of Art. 12 of the ED) allows the courts to order the respondent to pay pecuniary compensation instead of ordering the final injunctions if the respondent acted unintentionally and without negligence, if execution of the measures in question would cause him disproportionate harm and if pecuniary compensation to the injured party appears reasonably satisfactory. However, this provision was not applied in practice; one can consider that the injunction has an automatic character in the Romanian Law.

## 27. Are there provisions for obtaining declaratory relief, and if so, what are the legal and procedural requirements for obtaining such relief?

Romanian legislation does not contain any provisions on protective letters. There is no law governing such a procedure and there is no case-law on attempts to obtain such rulings using any available interim measure procedures.

However, a similar effect could be obtained by filing for a declaratory relief, provided for in the common (general) rules laid out in the new CPC, but there is no case-law on this matter.

## 28. What are the costs typically incurred by each party to patent litigation proceedings at first instance? What are the typical costs of an appeal at each appellate level?

According to according to Art. 451 Para. 1 CPC, legal costs consist of:

- judicial stamp duties: the amount of the judicial stamp depends on the value of the claim brought before the court. As a general rule, the amount of the judicial stamp due for lodging an appeal is half of the value of the claim.
- lawyers' fees;
- fees for experts and other specialists appointed under Art. 330 Para. 3 CPC;
- amounts due to compensate for witnesses' travel and other costs, accommodation as well as costs (e.g. loss of wages) caused by the necessity of attending the trial
- any other expenses necessary for the smooth running of the trial

The actual amount the parties have to pay for the proceedings varies drastically depending on the

complexity of the case. Therefore, no in abstracto estimation of total costs can be provided.

### 29. Can the successful party to a patent litigation action recover its costs?

As a rule, the successful party can recover, in whole or in part, its legal cost, as described above. However, according to Art. 451 Para. 2 CPC, the court may, even ex officio, reduce the level of lawyer's fees to be reimbursed by the unsuccessful party where it is manifestly disproportionate to the value or complexity of the case or to the work done by the lawyer. Any reduction made by the court will have no effect on the fees to be paid to the lawyer by his client.

Generally, these costs are decided in the infringement action. According to Art. 452 CPC, the party claiming legal costs must substantiate the amount of costs no later than the date of the closure of arguments on the merits.

The successful party may nevertheless seek the recovery of costs in a separate procedure. Legal costs are established according to the will of the contracting parties.

There is no regulation that requires lodging security for legal costs. It should be mentioned that a judicial decision is an enforceable title, which means that if the losing party does not comply with its obligation of paying the legal costs in the amount specified by the court, then he can be faced with enforcement proceedings.

### 30. What are the biggest patent litigation growth areas in your jurisdiction in terms of industry sector?

It is common knowledge that the pharmaceutical field is the most active in patent litigation in Romania. We believe that it has the potential to grow further, as patent expiration dates approach and generics become eager to enter the market. On the contrary, there are few to none IT-telecom patent litigations.

### 31. How has or will the Unified Patent Court impact patent litigation in your jurisdiction?

Although Romania hasn't yet ratified the Agreement on the Unified Patent Court, once the jurisdiction will become effective in Romania its characteristics will surely impact the patent litigation scene in Romania, as the single judgement enforceable throughout the

member states' feature will likely lead to a decrease in internal patent litigation on both validity and infringement.

### 32. What do you predict will be the most contentious patent litigation issues in your jurisdiction over the next twelve months?

As most litigations concerning European patents have a multijurisdictional dimension, a long-debated issue concerns the value of decisions issued in prestigious IP jurisdictions.

### 33. Which aspects of patent litigation, either substantive or procedural, are most in need of reform in your jurisdiction?

One of the most needed reforms is establishing an unitary and coherent regulation for the procedural aspects of patent litigation. Directive 2004/48/EC was transposed into Romanian legislation by GEO No. 100/2005 on Enforcement of Industrial Property Rights. The general provisions of the ED were taken tale quale and passed in the form of national legislation. The Romanian legislator considered there was no need for additional provisions or other measures to ensure coherence and compatibility with the existing national procedural framework, in particular the Romanian CPC.

On February 15, 2013, the new CPC entered into force. The Law No. 76/2012 on the application of the civil procedure code expressly repealed some of the provisions of the GEO while leaving other provisions untouched. In addition, according to Art. 83 of the Romanian Law No. 76/2012 for the implementation of the CPC, on the date of entry into force of the new CPC, any contrary provisions, even if included in special laws, are to be considered repealed.

Therefore, many legal provisions in the GEO are inconsistent or incompatible with the general rules of civil procedure, but it is difficult to assess whether they are contrary to those general rules within the meaning of Art. 83 of the Romanian Law No. 76/2012 for the implementation of the CPC. This has resulted in the GEO being inconsistent with the terminology of the new CPC and explains why the provisions of GEO have not been applied in judicial practice.

In addition to those above, Romanian legislation lacks regulation of matters like protective letters or declarations of non-infringement. As mentioned earlier, Romanian legislation also does not contain any provisions on indirect patent infringement or

contributory infringement.

We believe that such a reform is not only welcomed, but actually needed in Romania, as is the ratification of the UPC Agreement.

### 34. What are the biggest challenges and opportunities confronting the international patent system?

The biggest opportunity is without a doubt the commencement of the UPC Agreement. As the Unified Patent Court will have exclusive competence in respect of European patents and European patents with unitary effect, it will drastically change the way European patent litigation is currently conducted.

A challenge for the international patent system which has been pointed out following the Covid pandemic will be to strike a balance between patent protection and the need to protect public health in times when quick reaction to onsetting diseases is needed.

Another challenge is posed by the different approaches to patent protection in Europe vs. other states (Russia, China).

Finally, another interesting challenge will be as to whether an artificial intelligence (AI) system can be considered an inventor, in other words whether AI inventions are patentable or not, following several previous national decisions which denied the possibility; however, the issue is far from over.

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