



## Standing Committee on Patents

### Questionnaire on the Publication of Patent Applications

**National Group: Romania**

#### Questions

Groups are invited to answer the following questions under their national laws:

#### **I. Analysis of current law and case law**

1. Please provide a brief description of your law concerning publication of patent applications and identify the statute, rule or other authority that establishes this law.

Legal provisions concerning the publication of the patent applications are provided by the Romanian Patent Law no. 64/1991 ("Patent Law"), as republished on 19.08.2014 with renumbering the articles, and the Implementing Regulations to the Patent Law 64/1991, as republished (2007), of 18.06.2008 (the Implementing Regulations refer to the old articles of the Patent law). The specific laws in the field of Industrial Property are proposed to the Parliament of Romania by the State Office for Inventions and Trademarks ("OSIM"), which is a specialized body of the central public administration subordinated to the Government, with sole authority on the territory of Romania in the field of industrial property protection.

The Patent Law provides that "*patent applications filed by national route, for which the regular national filing has been effected, shall be published as soon as possible after the expire of a period of 18 months from the date of filing or, if priority has been recognized, as from the date of priority*". From said publication are excluded patent applications related to information in the field of national defense and State security included in an invention created on the territory of Romania and being the object of a patent application may be classified as secret of State by the competent authorities.

The Patent law also provides that "*patent applications filed under the Patent Cooperation Treaty shall be published as soon as possible after the expiry of a period of 6 months from the opening of the national phase.*"

The Implementing Regulations specify that the publication of the patent application 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 the Official Industrial Property Bulletin ("BOPI") containing the mention of the publication of the application.

2. Does publication of patent applications occur automatically in your jurisdiction? If so, when does publication take place? If not, what are the requirements to effect publication?

The publication of a patent application will occur automatically, after the fees for filing or entering the national phase and for publication have been paid. There is no need for expressly requesting publication in writing.

Consequently, the main requirement to effect the publication of the patent application for which the regular national filing has been effected, is to pay the official fee provided for this procedure. If the applicant asks for and pays the procedure for urgent examination, i.e., in 18 months from the date of filing, the publication fee is considered to be included in the examination fee.

3. If a patent application claims priority from or the benefit of an earlier application how, if at all, does this affect the timing of publication?

The Romanian Patent Law requires that all applications, for which the conditions for having a national regular filing have been met, be published immediately after the expiry of 18 months from the date of filing or from the priority date, where the priority has been recognized. Where priority has been declared inadmissible before the scheduled publication, it will be published only after a period of 18 months from the filing date.

4. Is there a specific point in time up to which the applicant can withdraw its application without it being published?

Where the applicant withdraws its application at least one month before the scheduled publication date, the patent application will not be published.

5. What parts of a pending patent application are published?

The description, claims and, where appropriate, drawings of the patent application as filed are made available to the public at OSIM headquarters. The date of publication is the date of the issuance of BOPI containing the mention of the publication of the application.

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;*
- 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."*

6. Does a published pending patent application give rise to provisional rights (or any type of interim protection) in your jurisdiction and, if so, to what extent?

Yes, the Patent Law provides that starting from the date of its publication, the patent application shall provisionally confer on the applicant protection, which is determined by the claims as published.

Any awarded damages shall be enforceable only after the patent's grant.

7. Does an unpublished pending patent application give rise to provisional rights (or any type of interim protection) in your jurisdiction and, if so, to what extent?

Provisional protection is available only for published patent applications.

Nevertheless, the patent law provides that the applicant can notify an alleged

infringer even before the publication date of the patent application, by sending him an authentic copy of the patent application as filed with OSIM.

When the activities qualified under the patent law as patent infringement acts continue to be performed by the alleged infringer after receiving the notice from the applicant, at the request of the latter, a Romanian court may order the alleged infringer to stop performing such acts until the Office will take a decision with respect to the patent application. Such measures may be ordered upon the payment by the applicant of a bail established by the Court.

8. Is 'early publication' allowed in your jurisdiction? If so, what are the conditions for such early publication? How is the request for early publication made? What is the effect of an early publication on a pending patent application?

Yes, the Patent Law provides for the possibility of an early publication of the patent application. Such early publication has to be request by the patent applicant or by its representative and an official fee equal to the double of the normal publication fee has to be paid. Furthermore, the early publication shall not be performed by OSIM earlier than four months from the date of filing of the national patent application or the date of entering the national phase of a PCT application or 16 months from priority.

9. Is non-publication possible in your jurisdiction? In other words, can a pending patent application remain confidential? If so, under what conditions is such allowed? How is the request for non-publication made?

In Romania, the non-publication of a patent application can occur in the following situation:

- the patent application is classified as secret of state by the relevant national authorities and is kept secret (until cancellation of secrecy);
- or if, at least one month before the scheduled publication date, the patent application is: refused; withdrawn by the applicant; deemed to be withdrawn;

Specific requests for non-publication are not admissible.

10. Will a lapsed, abandoned or withdrawn patent application be published? If not, is that automatic or by the request of the applicant? If it would otherwise be published, can the applicant request non-publication?

The application will not be published if, at least one month before the scheduled publication date, the patent application is: refused; withdrawn by the applicant; deemed to be withdrawn. This procedure is automatic; the applicant does not have to specifically request the non-publication of the patent application (nevertheless in case of voluntary withdrawal it is advisable to request it). The publication is automatic if the publication fee has been paid. Non-publication requests made by the applicant for a pending patent application are not admissible.

11. What is the position in your jurisdiction regarding the publication of continuation, continuation-in-part and divisional applications?

The Romanian legal framework related to patent matters does not provide for continuation or continuation-in-part applications. The Implementing Regulations to the Patent Law set forth that a divisional application is published within 3 months of its filing, but not earlier than 18 months from the date of filing or priority of the earlier application.

## **II. Policy considerations and proposals for improvements to your current system**

12. Should there be a requirement for automatic publication of pending applications by a particular deadline?

Yes. The Patent Law already provides the automatic publication of pending applications by a particular deadline.

13. Should there be a right for the patentee to request early publication? If so, on what basis and with what consequence?

Yes, on express request by the applicant. The Patent Law already provides the right of the patentee to request early publication of the patent application.

The consequence of an earlier publication for the applicant is getting provisional protection which confers him an exclusive right of exploitation of the invention. An earlier publication allows third parties to better organize future activities without violating industrial property rights.

14. If your answer to question 13 is yes, should all the applications deriving from the same priority application be subject to the early publication if one application is published early?

The correct legal provision should be that all applications deriving from the same priority application to be subject to an earlier publication at the same time. Such a legal provision should prevent problems of fulfillment of the condition of novelty for the patent applications deriving from the same priority and published later.

15. Should there be a right for the patentee to withdraw the application before publication?

Yes. The Patent Law already provides the right for the patentee to withdraw the application before publication.

16. If your answer to question 15 is yes, what should be the consequence of such withdrawal:

- a. with respect to the patentee's own subsequent patent applications; and
- b. with respect to third party patent applications?

a. the patent application is not published, there are no provisional rights conferred by the patent application for the applicant. It is not part of the state of the art. In regards to priority right, the principle of first application according to Paris Convention should be applicable.

b. if an application is not published, it should not be considered part of the state of the art.

17. If your answer to question 15 is yes, should the patent office be required to provide its initial assessment of the validity of the patent (if granted) before the applicant is required to decide whether to withdraw?

It should be up to the applicant to decide the moment of withdrawal. A simple request of the applicant should suffice. No other requirements should be necessary.

18. In light of your answers to the previous policy questions, what would be

appropriate time limits for:

- a. the patent office to provide the results of its initial assessment?;
- b. the applicant to decide whether to withdraw the application?; and
- c. the application to be published?

- a. 6 months from filing the patent application
- b. 2 weeks prior to publication
- c. 18 months from filing or earliest priority (if priority claimed)

19. Should there be any exceptions to automatic publication, and if so what on what grounds, for example:

- a. on the initiative of the patentee;
- b. on the initiative of the patent office; or
- c. on the initiative of third parties (such as other governmental agencies)?

- a. No, it is important that the public has access to the content of patent applications
- b. no
- c. governmental agencies should have the right to prevent publication of patent applications concerning the State security

20. If your answer to question 19 is yes, who should decide on whether such exception is applied?

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21. Should there be different rules for the publication of continuation, continuation-in-part and divisional applications?

Yes, the Romanian Patent Law already provides for specific rules for the publication of divisional patent applications.

22. What proposals would you make to improve your current system?

Although the Romanian Patent Law is generally harmonized with the European Patent Convention, there are things that could be improved. For instance, the online accessibility of the patent register is not available. The access to electronic

files would provide useful and rapid information related to the legal status of a patent application / granted patent, opposition proceedings, decision to refuse a patent, etc, all such information being nowadays obtainable from the Office by filing an official request and upon payment of an official fee.

### **Proposals for harmonization**

Groups are invited to put forward proposals for the adoption of harmonized rules in relation to the publication of patent applications. More specifically, the Groups are invited to answer the following questions:

23. Should patent offices be required to provide examination results or at least search results prior to publication so that applicants can make an informed decision whether to pursue obtaining a patent or to withdraw the application and protect the invention idea as a trade secret?

The patent offices should be required to provide at least search results prior to publication and an opinion regarding the patentability of the invention

24. Should there be any exception to publication of applications, for example by the applicant's opt-out?

Exception to the publication of the patent application should be for the following reasons:

- classification of the application as secret of State (until cancellation of secrecy);
- application was refused, withdrawn, deemed to be withdrawn before the scheduled publication date;

There should not be the applicant's possibility to opt-out if the patent application is still pending.

25. How should exceptional circumstances be defined, e.g., public order, morality or national security where the patent office delays or suppresses publication? To what extent should these exceptional circumstances be specifically defined?

Patent offices should be able to delay or suppress publication, in the following exceptional circumstances:

- if publication would be prejudicial to public order, morality, or national security
- if the application contains offensive or disparaging material



26. What is an appropriate period for publication after filing an application or after the priority date? Is 18 months an appropriate period?

yes

27. Please make any other comments or proposals for harmonization in relation to publication of patent applications that you consider appropriate.

An easy access to the patent file would allow an easier transfer of information and technology between applicants/owners and third parties, thus, a better transparency. The Romanian Patent Office should harmonize the law as to allow online public inspection of the files.

28. Procedure

29. It would be most helpful if the National Groups would fill out the Questionnaire and send in their answers to the General Secretariat of AIPPI ([StandingCommittees@aippi.org](mailto:StandingCommittees@aippi.org)) by 3 August 2016.

30. For inquiries, please contact either of the following members of the Standing Committee on Patents.

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