

Romania

Protecting utility models: a useful alternative for inventors

Since March 13 2008 it has been possible to protect ‘small inventions’ in Romania. The legal provisions lay down a framework harmonised with the international conventions, treaties and agreements to which Romania is a signatory, offering inventors a useful alternative for protecting their interests in Romania. The applicable national laws are:

- the Law on Utility Models (350/2007); and
- Decision 1457 approving the regulation for the application of the Law on Utility Models.

Scope of protection

A utility model can be used to protect any technical invention with a product as its object, provided that:

- it is new;
- it exceeds basic levels of professional ability; and
- it is capable of industrial application.

Exclusions

The following are not considered inventions and therefore are excluded from protection by utility model:

- discoveries, scientific theories and mathematical methods;
- aesthetic creations;
- schemes, rules and methods for performing mental acts, playing games or doing business;
- computer programs; and
- information presentations.

In addition, the following cannot be protected by utility models:

- inventions whose commercial exploitation is contrary to public order or morality, including inventions harmful to the health or life of persons, animals or plants, and which are likely to harm the environment, provided that such exception shall not depend merely on the fact that exploitation is prohibited by a legal provision;
- plant varieties and animal breeds;
- inventions with a biological material as their object;

- inventions with a product consisting of a chemical or pharmaceutical substance as their object; and
- inventions with a process or a method as their object.

Computer programs

In the field of computer programs, products suitable for protection as utility models are devices which can be programmed and where, at first sight, the technical characteristic of the invention is carried out by means of a computer program as well as the product itself (eg, a computer program for a data processing system expressed by the logical presentation thereof).

The corresponding specification can include graphical representations which present the operational steps of data processing (eg, logical diagrams, graphs).

Conditions for protection

Technical character

An invention has a technical character when the invention:

- is part of a technical field;
- solves a technical problem; or
- presents an essential technical characteristic which defines the object as claimed.

Regarding inventions in the field of computer programs, the technical character is confirmed when the program works on a computer and can cause a subsequent technical effect which exceeds the simple normal interaction between the program and the computer.

Novelty

An invention is new if it is not contained in the state of the art, which comprises all knowledge that has been made available to the public by means of a written or oral description, by use or in any other way before the date of filing of the application for a utility model.

The state of the art shall also be held to comprise the

content of an application for a utility model filed with the Romanian Patent and Trademark Office (ROPTO), as well as the content of applications having effect in Romania, as filed, with a filing date prior to that of the referenced application and published on or after that date.

Exceeding basic level of professional ability

The condition of exceeding the basic level of professional ability is considered to be met if the invention presents an advantage as a result of solving a technical problem when compared with the prior art. The advantage can be technical or practical, or can provide an advantage to the user, such as that obtained in the field of education or entertainment.

Capable of industrial application

If the object of the invention can be manufactured or used in any industrial field, including agriculture, it is deemed to meet the industrial applicability requirement.

Disclosure of invention

The application for a utility model must contain sufficient technical information to allow a person skilled in the art to carry out the invention as claimed and to solve the technical problem without any inventive contribution.

In addition, third parties should be able to understand what the contribution of the claimed invention is to the state of the art.

Procedures

In order to obtain protection for a utility model, one of the following must be filed:

- an application for a utility model;
- an application to transform a patent application into a utility model application with the same invention as its object; or
- an application to transform an application resulting from dividing a patent application with a product and a process as its object into a utility model application, with the transformation being requested in regard to the divisional patent application with the product as its object.

The transformation application can be filed:

- during the examination proceedings of a patent application up until completion of the technical preparations for publication of the notice of grant of a patent or of rejection of the patent application; or
- within three months of the date on which the ROPTO publishes the notice of final and irrevocable cancellation of a patent for lack of inventive step.

Under these circumstances, the application for a utility model resulting from transformation enjoys the same filing date and priority right, if any, as the original patent application. However, the transformation has no effect after a period of 10 years from the deposit date of the patent application.

The examination of the patent application which served as a basis for the transformation into an application for a utility model continues if the applicant does not expressly request withdrawal of the patent application.

A patent application can be transformed into an application for a utility model only once. Once an international patent application has entered the national phase in Romania, it can no longer be transformed into an application for a utility model.

Conversion into a patent application

A utility model application can be converted into a patent application at the request of the applicant. A conversion application can be filed up until the decision on registration of the utility model is made.

Such a patent application benefits from the same filing date and priority right, if any, as the utility model application.

A patent application resulting from the conversion is subject to the Patent Law (64/1991, as amended) and the relevant regulations approved by Decision 547/2008.

The registration proceedings for the utility model application which served as a basis for conversion into a patent application continue if the applicant does not expressly withdraw the utility model application.

Similarly, a utility model application can be converted into a patent application only once. In addition, as with a transformation, once an international utility model application has entered the Romanian national phase, it can no longer be converted into a patent application.

Only one invention

A utility model application must refer to only one invention. If the application contains two or more inventions, the applicant must divide it, either on its own initiative or at the request of the ROPTO, by filing a set of claims relating to the protection of only one invention. If the applicant does not comply with this request within the required term, the ROPTO considers the application to have been withdrawn.

Examination

The ROPTO does not examine the object of the utility model application as to whether it fulfils the conditions concerning novelty, exceeding the basic level of

professional ability and industrial applicability.

After a formal examination, the ROPTO will issue a search report within six months of the date of filing, which details the documents taken into consideration in regard to the conditions set down for protection of a utility model.

The search report, together with copies of the cited documents, is sent to the applicant along with an invitation to submit, within two months, proof of payment of the fees for publication, issuance of a certificate and maintenance in force of the utility model for the first six years of protection.

The applicant can amend the claims within the two-month term by filing a new set of claims.

Amended claims

The registration proceedings for a utility model cover only the national deposit of an application.

The ROPTO can accept amended claims only once the search report has been issued. The ROPTO does not carry out a supplementary search or modify the search report. The amended claims confer on the owner the right of exploitation and define the limits of protection conferred by the registered utility model. However, the amended claims must not exceed the object of the utility model application at the deposit date – this would lead to cancellation of the utility model.

What is made available to the public

The decision on the utility model application is published in the *Official Bulletin of Industrial Property* within one month of the date on which the term provided for filing an appeal has expired.

Once the decision to register the utility model has been published, the description, claims and amended claims (if any) and drawings are made available to the public. The search report may be published later.

Decisions concerning utility models are opposable to third parties from the date of publication in the *Official Bulletin*.

Search report

Since a utility model certificate is a title of protection granted without examination of the conditions necessary for protection, the exclusive rights are to be exercised by the owner, taking into account the search report as issued by the ROPTO. The search report provides the applicant with information regarding any prior art that is relevant to the invention set out in the application's claims.

The search report can be published at the same time as the registration decision or later, at the request of either the owner or third parties.

In the absence of such a request for publication of the search report, the ROPTO will publish it before the expiration of the six-year period after the deposit date. Third parties can request a search report relating to the amended claims by filing such a request with the ROPTO no later than six months before the end of the six-year protection period. The report is published immediately after its issuance and remittance to the owner and third parties.

Conferred rights

The registered utility model shall confer on its owner an exclusive right of exploitation for its entire duration.

Without the owner's consent, no party can manufacture, use, offer for sale, sell or import products for the purpose of using, offering for sale or selling the invention protected by the utility model.

The owner has the right to prevent a third party from providing to persons other than those entitled to exploit the invention the means of application of the invention in Romania, referring to an essential element of the invention, when the third party knows or, in the circumstances, should have known that those means are suitable and intended for the application of the invention.

The rights conferred by a registered utility model are exhausted in regard to the protected product after commercialisation of that product in an EU member state by the owner or with its consent. This exhaustion of rights does not apply when commercialisation takes place outside the European Union.

Defending utility rights

The applicant or the owner, as the case may be, can appeal the examination division's decision on the utility model application within two months of announcement of the decision.

Third parties can invoke the cancellation proceedings for registered utility models at any time if one of the following can be proven:

- The object of the utility model does not meet the legal conditions provided for its protection or falls into a category excluded from protection or which cannot be protected according to the law;
- The object of the utility model does not disclose the invention in a manner that is sufficiently clear and complete that a person skilled in the art could carry it out;
- The object of the utility model exceeds the limits of the content of the application as it was originally filed;
- The owner was not entitled to register the utility model; or

- The protection conferred by the utility model has been extended.

The utility model can be cancelled wholly or partially, depending on the reasons cited for its cancellation.

A decision of the re-examination division can be appealed before the Bucharest Court within 30 days of its issue. The decision of the Bucharest Court can be further appealed before the Bucharest Court of Appeal within 15 days.

Cancellation takes effect from the date of deposit of the utility model application.

Duration

A utility model registration is valid for six years from the filing date and can be renewed twice for a period of two years each time – the full duration cannot exceed 10 years.

Renewal of protection

The owner can apply to renew protection for a further period of two years no earlier than one year before and no later than six months after the expiration of the first period of validity.

A second and final two-year renewal period is available, for which the owner must also apply no earlier than one year before and no later than six months after

the expiration of the second period of validity.

Upon renewal, the ROPTO issues a renewal certificate and publishes a notice in the *Official Bulletin*.

The renewal proceedings include filing an application requesting the renewal of protection and payment of the corresponding fees.

Unless the owner has renounced the utility model, the renewal fees can be paid by any person. In such cases the renewal requirements are considered to be fulfilled and the ROPTO will notify the owner to this effect.

Revalidation proceedings

If protection lapses as a consequence of the failure to pay the renewal fees, the owner can request revalidation of the registered utility model by submitting well-supported reasons within two months of the expiration of the six-month grace period provided after each period of protection.

The ROPTO rules on the revalidation request and publishes the revalidation of the registered utility model in the *Official Bulletin*.

Transitional provisions

Patent applications with a deposit date earlier than the date on which the utility model law entered into force cannot be transformed into an application for a utility model.



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