

PARLIAMENT OF ROMANIA

CHAMBER OF DEPUTIES

SENATE

LAW

ON UTILITY MODELS

The Parliament of Romania has adopted this law.

CHAPTER I - General Provisions

Art. 1 - (1) The utility model shall protect, under this law, any technical invention, provided that it is new, it exceeds the framework of mere professional skill and it is susceptible of industrial application.

(2) The following, in particular, shall not be deemed to be inventions under paragraph (1):

- a) discoveries, scientific theories and mathematical methods;
- b) aesthetic creations;
- c) schemes, rules and methods for performing mental activities, playing games or doing business, as well as computer programs;
- d) presentations of information.

(3) The provisions of paragraph (2) shall exclude the protection of the above mentioned activities or subject matters only to the extent to which the utility model application or utility model relates to such activities or subject-matters as such.

(4) The following shall not be protected as utility models:

a) inventions the commercial exploitation of which would be contrary to public order or morality, including inventions harmful to the health or life of persons, animals or plants or which are likely to seriously harm the environment, provided that said exception shall not depend merely on the fact that exploitation thereof is prohibited by a legal provision;

- b) plant varieties and animal breeds;
- c) inventions having as a subject-matter biological material;
- d) inventions having as a subject-matter a product consisting of a chemical or pharmaceutical substance;
- e) inventions having as a subject-matter a process or a method.

Art. 2 - The right to the utility model shall belong to the inventor or his successor in title.

Art. 3 - (1) An invention shall be considered to be new if it does not form part of the state of the art.

(2) The state of the art shall be held to comprise all knowledge that has been made available to the public by means of an oral or written description, by use or in any other way, prior to the date of filing of the utility model application.

(3) The state of the art shall be also held to comprise the content of the utility model and patent applications filed with the State Office for Inventions and Trademarks (hereinafter referred to as OSIM), as well as the content of the applications with effects in Romania, as filed, provided that they have the date of filing prior to the date referred to in paragraph (2) and they were duly published on or after that date.

(4) When applying the provisions of paragraphs (2) and (3), the disclosure of the invention shall not be taken into consideration if it occurred within the six months preceding the filing date of the utility model application and if it was made, directly or indirectly:

- a) by the applicant or his predecessor in title; or
- b) as a consequence of an obvious abuse in relation to the applicant or his predecessor in title.

Art. 4. - An invention shall be considered as susceptible of industrial application if it can be made or used in any kind of industry, including agriculture.

Art. 5. - (1) The registered utility model shall confer on its owner an exclusive right of exploitation of the invention throughout its duration and the right to prohibit the following acts performed without his consent: manufacturing, using, offering for sale, selling or importing the invention protected by utility model with a view to using, offering for sale or selling the same.

(2) The owner shall also have the right to prohibit any third party from supplying or offering to supply, without his consent, other persons than the persons who are entitled to exploit the invention protected by utility model with means for applying the invention on the territory of Romania, provided that those means relate to an essential element of the invention and that third party knows or, under the given circumstances, should have known that those means are suitable and meant for the application of the invention.

(3) Provisions of paragraph (2) shall not apply to staple commercial products, unless the third party attempts to induce the commitment of acts which are likely to infringe the exclusive right referred to in paragraph (1).

(4) Where the essential elements of a utility model were taken from the description, drawings, experimental models, devices or equipments belonging to other person than the owner, without his consent, the granted protection shall not be used against said person.

Art. 6. - (1) The rights conferred by a registered utility model shall not extend to the acts referred to in Art. 5 paragraph (1) concerning the protected product, performed after the product has been marketed in a Member State of the European Union by the owner or with his consent.

(2) Nevertheless, the rights conferred by a utility model shall extend to the acts referred to in Art. 5 paragraph (1) concerning the protected product, performed after the product has been marketed outside a Member State of the European Union by the

owner or with his consent.

Art. 7. - (1) The duration of a utility model shall be 6 years from the filing date.

(2) The owner of the right may obtain, based on a written request filed with OSIM, the renewal of the utility model protection for a further two year-period, but not earlier than one year and not later than six months before the expiry of the duration referred to in paragraph (1).

(3) The owner of the right may obtain, based on a written request filed with OSIM, the renewal of the utility model protection for a second and last two year-period, but not earlier than one year and not later than six months before the expiry of the duration referred to in paragraph (2).

(4) The duration of the utility model shall not exceed a time limit of ten years from the filing date.

(5) The renewal fee may be paid up to the date of expiry of the duration referred to in paragraph (1) or (2), as the case may be, or in a time limit of six months from any of said dates, with a surcharge of 50% of the amount of the due fee.

(6) The owner of the utility model may cumulatively pay the maintaining fees and the renewal fees for the entire period of protection.

(7) The notice of renewal of protection under paragraphs (2) and (3) shall be published in the Official Industrial Property Bulletin (hereinafter referred to as BOPI).

Art. 8. - (1) The right in the utility model, the right to the registration of the utility model and the rights arising from said registration shall be transferable, either wholly or in part.

(2) The utility model may be the object of a guarantee or of compulsory execution measures.

Art. 9. - (1) The utility model protection shall lapse:

a) on the expiry of its duration;

b) for failure to pay the renewal fees;

c) by renunciation by the owner of the registered utility model.

(2) The termination of protection under paragraph (1) shall become effective on the day following :

a) the date of expiry of the utility model duration, in the case referred to in paragraph (1) a) and b);

b) the date of communication of renunciation by the owner, in the case referred to in paragraph (1) c).

(3) Where the renunciation under paragraph (1) c) only relates to certain parts of the utility model, it shall remain in force for the other parts. OSIM shall take note of the renunciation without examining whether the remaining parts of the utility model still comply with the requirements of this Law and whether the limitation is acceptable.

4) The utility model shall be deemed not to have a retroactive effect from the filing date, if a patent is granted for an application:

a) claiming the priority of the utility model application; or

b) which has been converted into a utility model application, and the applicant has not expressly requested the withdrawal of the patent application.

CHAPTER II - Registration Procedure. Publication and Granting of the Certificate

Art. 10. - (1) The utility model application shall be drawn up in Romanian and shall be filed with OSIM on paper or, at the applicant's choice, in other form and by means of transmittal provided by the Implementing Regulations to this Law.

(2) The application shall contain:

a) the applicant's identification data;
b) the request for protection through utility model, accompanied by the title of the invention;

c) a description of the invention;

d) one or several claims;

e) drawings to which reference is made within the description or claims.

(3) The utility model application shall contain indications meant to allow the applicant's identity to be established.

(4) Where the applicant is not the same person as the inventor, he must declare the inventor and prove, by a document filed with OSIM before a decision is made, that he is the person entitled to the registration of the utility model.

(5) In all the procedures before OSIM, the applicant shall be deemed to be the person entitled to the registration of the utility model.

(6) A utility model application shall be filed for each invention.

(7) The claims shall clearly define the matter for which protection is sought, they shall be concise and completely supported by the description of the invention.

(8) The application shall be accompanied by an abstract of the invention. The abstract shall contain a brief presentation of the invention which is intended exclusively for technical information and cannot be taken into consideration for other purposes, in particular for determining the scope of protection.

(9) Amendments to the application shall be allowed prior to the date on which a decision to register the utility model is taken, provided that they do not extend beyond the subject-matter of the application. No rights can arise from amendments extending beyond the subject-matter of the application.

Art. 11. - The invention shall be presented in the utility model application in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

Art. 12. - (1) The filing date of the utility model application is the date on which the following have been filed with OSIM:

a) an express or implicit indication to the effect that a utility model is requested;
b) indications allowing the identity of the applicant to be established or allowing the applicant to be contacted by OSIM;

c) a part which, at the first sight, appears to be a description of the invention.

(2) Claims and drawings relating to the invention may also be filed within a time limit of two months from the filing date.

(3) Where the requirements referred to in paragraph (1) a) and/or c) are not complied with, OSIM shall notify the applicant indicating the deficiencies ascertained

and requiring the correction thereof within a time limit of two months from the date on which at least the condition referred to in paragraph (1) b) was complied with.

(4) The filing date of the utility model application is the date on which the documents remedying the deficiencies ascertained in the notification under paragraph (3) are filed with OSIM.

(5) If the mentioned deficiencies have not been remedied within the granted time limit or if they relate to the condition referred to in paragraph (1) b), the filing date shall not be granted and the utility model application shall be deemed to not having been filed.

Art. 13. - The filing of the utility model application shall have the value of a regular national filing as from the filing date, granted under Art. 12, if the provisions of Art. 10, paragraph (2) have been complied with.

Art. 14. - (1) A utility model application can also result from a patent application having as a subject-matter the same invention, provided that the applicant files a request for conversion:

a) during the patent application examination procedure, prior to the finalization of technical preparation for publishing the mention of the decision to grant the patent or to reject the patent application;

b) within a time limit of three months from the date on which OSIM publishes the mention of a final and irrevocable decision to cancel the patent as a consequence of lack of inventive step.

(2) If the requirements under paragraph (1) are met, the utility model application resulting from the conversion shall benefit by the same filing date, as well as by the priority right arising from the patent application.

(3) The conversion referred to in paragraph (2) shall have no effect after the expiry of a ten year-period counting from the filing date of the patent application.

(4) For a patent application converted into a utility model application, the examination procedure shall be continued if the applicant does not expressly request the withdrawal of the patent application.

(5) European patent applications under Art. 135 of the Convention for the grant of European patents ((European Patent Convention) adopted in Munich on 5 October 1973, to which Romania accessed by the Law 611/2002 with the subsequent revisions, can also be converted into utility model applications, under the conditions provided for by the implementing regulations to this Law.

Art. 15. - (1) The applicant for a utility model may request, before a decision on registration is made , the conversion of said utility model into a patent application, under the conditions provided for by the implementing regulation to this Law.

(2) A patent application resulting from the conversion under paragraph (1) shall benefit by the same filing date and by the priority right arising from the utility model application.

(3) The conversion of a utility model application into a patent application shall not be permitted if the utility model application resulted from the conversion of a patent application, under the provisions of Art. 14.

Art. 16. - (1) A utility model application shall relate to a single invention.

(2) The utility model application containing two or several inventions shall be divided by the applicant on his own accord or upon request by OSIM, before a decision concerning that application is made.

(3) Where the applicant fails to divide the application before a decision concerning the original application is made, by filing claims to define the protection of a single invention, as the subject-matter of the original application, OSIM shall declare the application as deemed to be withdrawn.

Art. 17. - (1) OSIM shall examine whether the utility model application complies with:

- a) the provisions of Art. 10, paragraph (3) concerning the inventor's identity;
- b) the provisions of Art. 10, paragraph (4) concerning the right to the registration of the utility model;
- c) the provisions of Art. 10, paragraph (2) concerning the contents of the utility model application;
- d) the conditions concerning the filing, provided for in Art. 12 and 13;
- e) conditions concerning the recognition of priority;
- f) conditions that the application contains a single invention, provided for in Art. 16, paragraph (1).

(2) OSIM shall examine whether the invention which is the subject-matter of the application:

- a) is not excluded from protection by utility model under Art. 1, paragraph (2) or (4);
- (b) is disclosed according to the provisions of Art. 11.

(3) OSIM shall not examine the subject-matter of the utility model application to assess if the conditions of being new, exceeding the framework of mere professional skill or being industrially applicable are met.

Art. 18. - (1) For all the utility model applications complying with the requirements under Art. 17, paragraph (1) and (2) concerning the utility model registration, OSIM shall draw up, within a time limit of six months from the filing date, a search report mentioning the documents taken into consideration as regards the conditions under Art. 1.

(2) For the search report, the applicant shall file with OSIM the proof of payment of the legal fee within a time limit of two months from the date on which the application was filed or from the filing date, as the case may be.

(3) No search report shall be drawn up for the applications resulting from the conversion of a patent application for which a search report has already been drawn up and published by OSIM.

(4) The search report together with copies of the cited documents shall be sent to the applicant, accompanied by the OSIM notification requesting the applicant to file the proof of payment of the publication fee, the fee for issuing the certificate and the maintenance fee for the first six years of protection, within a time limit of two months. At the substantiated request of the applicant, said time limit may be extended only once by other two months.

(5) The applicant may amend the claims within the time limit referred to in

paragraph (4) by filing a new set of claims. In such cases, OSIM shall not conduct an additional search and shall not modify the search report.

(6) Where, within the time limit referred to in paragraph (4), the proof of payment of the legal fee has not been filed with OSIM, the application shall be declared as deemed to be withdrawn.

(7) Where the search report has not been made available to the public on the date of publishing the documentation referred to in Art. 19, paragraph (8), it shall subsequently be published, under the conditions provided for by the implementing regulations to this Law.

Art. 19. - (1) Decisions concerning the utility model application shall be made by a specialized examination board within the Patent Directorate of OSIM, based on the examination report.

(2) If the conditions under Art. 17, paragraphs (1) and (2) are complied with and the publication fee, the fee for issuing the certificate and the fee for maintaining the utility model in force for the first six years of protection are paid, OSIM shall decide the registration of the utility model.

(3) Upon request by the applicant, the decision concerning the registration of the utility model may be deferred, without exceeding a time limit of 18 months from the filing date or from the date on which the application was filed, under the conditions provided for by the implementing regulations to this Law.

(4) OSIM shall decide to refuse registration of the utility model in the following cases:

a) the invention which is the subject-matter of the application is excluded from utility model protection under Art. 1, paragraph (2) or (4);

b) the utility model application does not comply with the provisions of Art. 10, paragraph (1) and/or (2) or paragraph (7), or the provisions of Art. 11 or 12;

c) the applicant has opened the national phase after the expiry of the time limit referred to in Art. 26, paragraphs (1) and (2), as the case may be;

d) the applicant, which is not the same person as the inventor, has not proved, within the time limit prescribed by Art. 10, paragraph (4), that he is entitled to the registration of the utility model.

(5) The utility model application shall be declared as deemed to be withdrawn in the following cases:

a) the inventors were not declared according to the provisions of Art. 10, paragraphs (3) and (4);

b) the application represented the basis of the priority claim in a subsequent application filed by the national route or for which the national phase has been opened in Romania;

c) the applicant failed to file the claims and/or drawings within a time limit of two months from the filing date of the utility model application;

d) the utility model application resulting from the conversion of a patent application in respect of which a decision to grant the patent was made after the conversion;

e) one of the legal fees has not been paid in the amount and within the time limits specified in this Law and in the Government Ordinance No. 41/1998 concerning the

fees in the industrial property field and the conditions for using the same, as republished with the subsequent amendments;

f) the applicant failed to divide the non-unitary utility model application, according to Art. 16, paragraph (2).

(6) The invention which is the subject-matter of the utility model application has the character imparted by the special law and may not be disclosed without the applicant's consent, up to publication. OSIM shall maintain the secrecy level established by the competent authorities to the filed documents. Where the secrecy of documents is not lifted prior to the publication of utility model registration, OSIM shall publish the registration within a time limit of one month from the communication of information secrecy lifting.

(7) The mention of the decision to register the utility model or to refuse registration shall be published in BOPI, within one month from the expiry of the time limit provided for by the law for lodging an appeal, under the conditions set in the implementing regulation to this Law.

(8) At the time of publishing the mention of the decision to register the utility model, the description, claims or, where appropriate, amended claims and drawings shall be made public, as well as the search report, unless this shall be published later.

(9) Any person may apply with OSIM for the drawing up of a search report based on amended claims.

(10) OSIM shall not publish amendments made after the filing date if they extend beyond the subject-matter of the application.

Art. 20. - (1) OSIM shall issue the utility model certificate together with the description, the claims and, where appropriate, the drawings of the utility model to its owner, according to the decision of registration made by the specialized examination board.

(2) The date of issuance of the certificate shall be the date on which the mention of the registration decision is published.

(3) The utility model certificate is a protection title granted without examining the conditions referred to in Art. 1, paragraph (1), the exclusive rights being exercised on the owner's responsibility, taking into account the search report drawn up by OSIM.

Art. 21. - (1) OSIM is the depository of the National Register of Filed Utility Model Applications and of the National Register of Registered Utility Models.

(2) The conditions concerning the recordal in the National Registers referred to in paragraph (1), the issuance of copies or excerpts of data entered in said Registers, as well as the public inspection of recorded data shall be established by the implementing regulation to this Law.

CHAPTER III - Defense of Rights

Art. 22. - (1) Decisions made according to the provisions of Art. 19, paragraphs (2) and (4) may be appealed against with OSIM, in writing and on valid grounds, by the applicant or the owner of the utility model, within two months of communication.

(2) The appeal shall be settled by a reexamination board within the Appeals

Department of OSIM.

(3) The reexamination board shall decide upon the acceptance or rejection of the appeal and shall communicate the decision to the appellant.

Art. 23. - (1) A utility model registered with OSIM may be cancelled upon request throughout its duration if there is ascertained that:

a) the subject-matter of the utility model does not meet the conditions provided for in Art. 1, paragraph (1) or belongs to the categories under Art. 1, paragraph (2) or (4), as the case may be;

b) the subject-matter of the utility model does not present the invention in a manner sufficiently clear and complete for a person skilled in the art to be able to make it, as provided for in Art. 11;

c) the subject-matter of the utility model extends beyond the content of the application, as filed;

d) the owner is not the person entitled to the registration of the utility model;

e) the scope of protection granted to the utility model has been extended.

(2) Where the grounds for cancellation only relate to a part of the utility model, it will be cancelled in part.

(3) Cancellation shall be settled by a reexamination board within the Appeals Department of OSIM.

(4) The substantiated decision of the reexamination board shall be communicated to the parties within a time limit of 15 days since pronouncement and may be appealed against by an appeal lodged with the Law Court of Bucharest within 30 days of communication.

(5) Decisions of the Law Court of Bucharest may be appealed against by recourse lodged to the Court of Appeal of Bucharest within 15 days of communication.

(6) Cancellation shall be effective as from the filing date of the utility model application.

Art. 24. - (1) Any person who affixes on his products or the packaging thereof a sign capable of creating the impression that those products are protected as utility models under this Law, or any person who uses such a sign as a heading for his official correspondence, his firm, his business cards or announcements shall be bound to give, upon request by any interested person, information relating to the utility model on which the use of that sign is based.

(2) At the request of the law court, OSIM shall submit the papers, documents and information necessary for judging the cause entrusted to the law court, those documents being finally retrieved, Summoning to the court shall be made only for this purpose.

(3) Petitions to the law court in the industrial property field shall be exempted from judicial fees.

CHAPTER IV - International Applications for Protection by Utility Model

Art. 25. - (1) An international application which has been accorded an international filing date in a receiving Office and which has Romania as a designated

State, shall have the same effects as a utility model application filed with OSIM on the same date.

(2) An international application shall not have effects in Romania in the cases referred to in Art. 24, paragraph (1) (I) and (ii) in the Patent Cooperation Treaty adopted by the Diplomatic Conference in Washington on 19th of June 1970, ratified by Romania through the Decree no. 81/1979 of the Council of State.

Art. 26. - (1) Where the applicant intends the continuation of his international application in Romania, he shall open the national phase for a utility model in Romania, within a time limit of 30 months as from the international filing date, or, if a priority has been recognized, from the priority date.

(2) The provisions of paragraph (1) shall also apply if, for justified grounds, the applicant opens the national phase within two months from the expiry of the 30-month time limit, subject to the payment of the fee for late opening of the national phase.

(3) For entering the national phase in Romania, the applicant shall file an application containing an explicit or implicit request for the opening of the national phase for a utility model, the certified translation into Romanian of the description, claims and drawings of the international application and he shall pay the filing fee.

(4) After entering the national phase the international application shall be subject to the procedures provided for by this Law and by the implementing regulations thereof.

(5) Where the applicant failed to comply with the requirements referred to in paragraphs (1) or (2), as the case may be, the international application shall be deemed to have never had the effects of a utility model application in Romania.

Art. 27. - An applicant which is a Romanian natural person or legal entity or a natural person or legal entity having the residence in Romania or having a real and effective industrial or commercial establishment in Romania, within the meaning of Art. 3 of Paris Convention for the Protection of Industrial Property of 1883 to which Romania adhered through the Decree no. 1177/1968 of the Council of State, may file an international application with OSIM, as a receiving office. The priority may be claimed either on the basis of a utility model application, or on the basis of a patent application.

CHAPTER V - Transitional and Final Provisions

Art. 28. - The provisions of the Patent Law no. 64/1991, as republished, concerning:

- a) definitions;
- b) the right to the patent;
- c) filing of a patent application and examination of patent applications, priorities and withdrawal of application included;
- d) rights conferred by the patent and corresponding obligations, as well as rights of prior use;
- e) transfer of rights;
- f) defense of rights;

shall be applied *mutatis mutandis* to the utility models according to the provisions of the implementing regulations to this law.

Art. 29. - Patent applications whose filing date is earlier than the date of the entering into force of this law, shall not be converted into utility model applications, under Art. 14.

Art. 30. - (1) This law shall enter into force within 90 days as from the date of its publication in the Official Gazette of Romania, Part I.

(2) Within the time limit referred to in paragraph (1), the Government shall approve by Decision, the Implementing Regulations to this Law.

Art. 31. - On the date of entering into force of this Law, the Government Ordinance No. 41/1998 on the fees in the industrial property field and the conditions for using the same, as republished in the Official Gazette of Romania, Part I, No. 959 of 29 November 2006, with the subsequent amendments, shall be amended as follows:

1. Art. 15 shall be amended and shall have the following content:

“Art. 15. - The provisions of Article 2 shall not apply to the procedures provided for in points 5 and 6 letters a) and b) in the Annexe no. 2.”

2. Art. 16 shall be amended and shall have the following content:

“Art. 16. - The fees for the renewal of utility model protection shall be paid concomitantly with the fee for the maintenance in force or for year groups, according to Annexe 2.”

3. Annexe 2 shall be amended and shall have the following content:

ANNEXE 2

**AMOUNT AND TIME LIMITS
CONCERNING THE PAYMENT OF FEES FOR THE UTILITY MODEL APPLICATIONS AND
REGISTRATION CERTIFICATES**

| Crt. No. | Object of payment | Payment time limit | Amount (lei) | Amount (EUR) |
|----------|---|--|--------------|--------------|
| 1 | Submitting the utility model application a) on paper b) by electronic means | 2 months of the date of filing | 108 72 | 30 20 |
| 2 | Late opening of national phase | 2 months from the expiry of the 30-month time limit of the date of priority claimed in the international application | 324 | 90 |

| | | | | |
|---|---|---|-------|-----|
| 3 | Drawing up and publishing a search report | 2 months of the filing date or on the date of the request by a third party | 360 | 100 |
| 4 | Conversion of a utility model application into a patent application | 2 months from the date of submitting the conversion request | 36 | 10 |
| 5 | Publishing the utility model (description, claims and drawings accompanied by the search report, not exceeding 20 pages) and issue of the utility model registration certificate and utility model maintenance in force for the first 6 years of protection | 2 months of the date of communication of the search report to the applicant | 1440 | 400 |
| | - for each additional page | | 18 | 5 |
| 6 | a) Renewal of protection for the seventh-eighth years of protection | by the beginning of the protection period | 720 | 200 |
| | b) Renewal of protection for the ninth-tenth years of protection | by the beginning of the protection period | 1,080 | 300 |
| | | | | |
| | | | | |

This Law was adopted by the Parliament of Romania in accordance with the provisions of Art. 75 and Art. 76, paragraph (2) of the Constitution of Romania, as republished.

PRESIDENT OF
THE CHAMBER OF DEPUTIES

BOGDAN OLTEANU

PRESIDENT OF
THE SENATE

NICOLAE VĂCĂROIU

Bucharest, 3 December 2007
No. 350