

IMPLEMENTING REGULATIONS TO THE LAW NO. 350/2007 ON UTILITY MODELS

CHAPTER I - General provisions

Art. 1 - Protection of inventions by utility model

Protection of inventions by utility model shall be carried out under the provisions of the Law no. 350/2007 on utility models, published in the Official Gazette of Romania, Part I, No.851 of 12 December 2007, while meeting the provisions of the conventions, treaties and agreements to which Romania is a party.

Art. 2 - Definitions

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

- a) Law - Law no.350/2007 on utility models;
- b) Art. of the Law - article of the Law no.350/2007 on utility models;
- c) Art. - article of the Implementing Regulations;
- d) BOPI - Official Industrial Property Bulletin - Utility Models Section;

(2) Throughout the current Implementing Regulations, terms and phrases defined in the Law shall have the same meaning.

CHAPTER II - Utility model application

Art. 3 - General provisions

Utility model applications shall follow the procedures provided for by the Law and the present Implementing Regulations.

Art. 4 - Product as a subject-matter of the utility model application

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

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

(3) Products within the meaning of the provisions of paragraph (2) may be, for example:

- a) devices, installations, equipments, machine-tools, apparatuses or subassemblies thereof employed for carrying out a manufacturing or working process;
- b) electric, pneumatic or hydraulic circuits;

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

Art. 5 - Utility model application for inventions in the field of computer programs

(1) Products in the field of computer programs as a subject-matter of a utility model application can be programmable apparatuses, in which at first sight the technical characteristic of the invention is carried out by means of a computer program, as well as the computer program products for data processing systems expressed by the logical running thereof.

(2) Description in the utility model application may be accompanied by graphical representations presenting the data processing operational stages or steps such as organization charts, graphs or the like.

Art. 6 - Utility model application resulting from the conversion of a patent application

(1) The request for conversion filed under the conditions provided for in Art. 14, paragraph (1) and (3) of the Law shall contain:

- a) the express request for conversion in view of registration of the utility model for the invention which is the subject-matter of the patent application;
- b) filing number and date of the patent application having the value of regular national filing whose conversion is requested;
- c) applicant's identification data.

(2) Patent applications whose subject-matter is defined under Art. 4 or Art. 5, paragraph (1) can be converted into utility model applications.

(3) Applications resulting from the division of a patent application having a product and a process as a subject-matter can also be converted into utility model applications. In that case, the applicant shall request the conversion into utility model application for the divisional patent applications having the product as a subject-matter.

(4) If the requirements provided for in paragraph (1) are complied with, OSIM shall make copies of the description, claims and, where appropriate, drawings constituting the regular national filing of the patent application on which the conversion is based, enter the utility model application into the National Register of filed utility model applications and notify the applicant on the number of the utility model application resulting from conversion.

(5) Where the legal conversion fee was not paid at the moment of filing the request under paragraph (1), it can still be paid within a time limit of two months from the filing date.

(6) Where the legal conversion fee has not been paid as provided in paragraph (5), the utility model application shall be declared as deemed to be withdrawn, according to the provisions of Art. 19, paragraph (5), letter e) of the Law.

(7) In the situation provided in Art. 14, paragraph (1), letter b) of the Law, the owner of the cancelled patent shall file, together with the request for conversion, a copy of the final and irrevocable decision of cancellation, accompanied by the copy of the claims cancelled for lack of inventive step.

(8) A patent application can be converted into a utility model application only

once.

(9) An international application which has entered the national phase in view of the grant of a patent can no longer be converted into utility model application.

(10) For the purposes of registration as utility model, the application resulting from the conversion of a patent application shall be subjected to the procedures provided for by the Law and the present Implementing Regulations.

(11) For the application of the provisions of Art. 18, paragraph (3) of the Law, after the utility model application resulting from a patent application has been filed, OSIM shall publish the search report drawn up for the patent application, if it has not been made public up to the date of the conversion request.

(12) Claims amended as a consequence of the search report drawn up for a patent application, can be filed together with the conversion request.

(13) The filing date referred to under Art. 9, paragraph (4) of the Law is the filing date of the patent application for the case provided under letter a), and the filing date of the utility model application for the case provided under letter b), respectively.

(14) For the application of the provisions of Art. 9, paragraph (4) of the Law, the utility model shall be deemed not to have retroactive effects from the filing date, under paragraph (13), in so far as, on the date of publishing the mention of the grant of the patent, it protects the same invention and has the same owner as the patent, Where a transfer by licence occurs for the utility model application, and a patent is granted based on the patent application, the transfer effects shall cease from the filing date of the patent application.

(15) The applicant for a patent may, before a decision for the grant of the patent is made, either:

a) request the withdrawal of the patent application, or

b) renounce the right conferred by the registered utility model, if he is the owner of such a right.

(16) Where, in the patent application converted into a utility model application, a priority has been claimed and recognized, it shall be deemed to be also claimed and recognized in the utility model application.

(17) A patent application having the value of a first regular national filing, from which a utility model application has resulted by conversion, shall generate a convention priority right if, within 12 months from the filing date, it was not refused, withdrawn or deemed to be withdrawn.

(18) If the patent application was refused, withdrawn or deemed to be withdrawn within the time limit referred to under paragraph (17), the utility model application resulting from the conversion of the patent application shall generate a conventional priority right.

(19) OSIM shall notify the applicant that the patent application cannot be converted into a utility model application under paragraph (9) or where the provisions of Art. 14, paragraph (1) or (3) of the Law are not complied with.

(20) The national patent application resulting from the conversion of a European patent application can be converted into a utility model application if:

a) documentation of the converted European patent application has been received by OSIM within a time limit of 20 months from the European patent application filing date or, where a priority is claimed, from the priority date, provided that it contains the request for conversion into a national application in Romania;

b) within a time limit of two months from the receiving by OSIM of the documentation referred to under letter a), the applicant files with OSIM the

translation of the description, claims and, where appropriate, drawings contained in the documentation, for which he wants procedures to be carried on with a view to obtaining utility model protection, accompanied by the express request for conversion into a utility model application.

(21) In case the provisions under paragraph (20) are not complied with, OSIM shall notify the applicant that the national patent application resulting from the conversion of the European patent application cannot be converted into a utility model application.

Art. 7 - Conversion of a utility model application into a patent application

(1) The request for conversion filed under the provisions of Art. 15, paragraphs (1) or (3) of the Law shall contain:

a) the express request for conversion for the invention which is the subject-matter of the utility model application;

b) filing number and date of the utility model application having the value of regular national filing whose conversion is requested;

c) applicant's identification data.

(2) If the requirements provided for in paragraph (1) are complied with, OSIM shall make copies of the description, claims and, where appropriate, drawings constituting the regular national filing of the utility model application, enter the patent application into the National Register of filed patent applications and notify the applicant on the number of the patent application resulting from conversion.

(3) In respect of the patent application resulting from the utility model application, the legal conversion fee shall be paid according to current number 4 in the Annexe no. 2 of the Government Ordinance no.41/1998 on the fees in the industrial property field and the conditions for using the same, as republished, with the subsequent amendments. Where the legal conversion fee was not paid at the moment of filing the request under paragraph (1), it can still be paid within a time limit of two months from the filing date.

(4) Where, in the utility model application, the priority of a prior application was claimed and recognized, then the patent application resulting from the conversion of the utility model application shall also benefit by the claiming of said priority.

(5) A utility model application having the value of a first regular national filing, from which a patent application has resulted by conversion, shall generate a convention priority right if, within 12 months from the filing date, it has not been refused, withdrawn or deemed to be withdrawn.

(6) If the utility model application has been refused, withdrawn or deemed to be withdrawn within the time limit referred to under paragraph (5), the patent application resulting from the conversion of the utility model application shall generate a conventional priority right.

(7) The registration procedure shall be continued in respect of the utility model application from which a patent application resulted by conversion, according to the Law and the present Implementing Regulations, in the absence of an express request to withdraw the utility model application made by the applicant.

(8) A patent application can result by conversion from a utility model application only once.

(9) A patent application can no longer result from an international application which has entered the national phase with a view to obtaining utility model

protection.

(10) The patent application resulting from conversion shall be subject to the procedures provided for by the Patent Law no.64/1991 as republished¹ and the Implementing Regulations to the Patent Law no. 64/1991, approved by the Government Decision no. 547/2008.

(11) Where, in respect of the utility model application, the applicant has declared the inventors and/or proved that he is the person entitled to the registration of the utility model, the same requirements shall be deemed to be met in respect of the patent application.

(12) In case the provisions under paragraph (1) are not complied with, OSIM shall notify the applicant that no patent application resulted by conversion from the utility model application.

CHAPTER III - Utility model registration procedure

Art. 8 - Application examination

(1) The utility model registration procedure shall be carried out under the provisions of Art. 17 - 19 of the Law.

(2) The utility model application filed on paper shall be made-up in A4 format, in a computer printer or a typing machine. Otherwise, the utility model application shall be deemed not to have been filed, and the documentation shall be returned to the applicant.

(3) OSIM shall examine if:

- a) the utility model application meets the provisions of Art. 10 of the Law;
- b) the invention falls under the provisions of Art. 1, paragraph (2) of the Law and, consequently, it lacks technical character;
- c) the invention does not fall under the provisions of Art.1, paragraph (4) of the Law;
- d) the utility model application relates to a single invention, as provided by Art. 16, paragraph (1) of the Law;
- e) in the utility model application, the invention is disclosed according to the provisions of Art. 11 of the Law.

4) OSIM shall notify the applicant on the deficiencies of the application documents ascertained during the examination, according to the provisions of paragraph (3), and grant a time limit for response.

(5) Amendments made as a consequence of the notification referred to under paragraph (4) shall be indicated in a visible manner on the initial text. At the same time with the so made modifications, the applicant shall file two copies of the description, claims and drawings containing the text redrawn after modification.

(6) The documents redrawn according to the provisions of paragraph (5) shall be in A4 format, the text being made-up in a computer printer or typing machine. Otherwise the amended documents shall not be taken into consideration, the applicant being notified accordingly.

(7) One of the copies of the amended document referred to under paragraph (6) shall be signed by the applicant on each sheet.

¹See also the rectification published in the Official Gazette of Romania, Part I, No. 638 of 18 September 2007.

Art. 9 - Technical character of the invention

(1) For the application of the provisions of Art. 1, paragraph (1) of the Law, the technical character of an invention may be given by the fact that the invention belongs to a technical field, solves a technical problem or presents at least one essential technical feature to define within the claims the subject-matter for which protection is sought.

(2) The technical character of an invention in the field of computer programs is based on the fact that, when run or uploaded in a computer, the program determines or is capable to determine a subsequent technical effect exceeding the mere normal interaction between the program and the computer.

Art. 10 - Disclosure of the invention

(1) An invention shall be deemed to comply with the provisions of Art. 11 of the Law if the utility model application contains sufficient technical information to allow a person skilled in the art to carry out the invention as claimed, without any inventive step, and to solve the proposed technical problem, and if it allows third parties to understand the contribution the claimed invention brings to the state of the art.

(2) For the application of the provisions of Art. 11 of the Law, the clear and complete disclosure of the invention refers to the utility model application as a whole, including description, claims and, where appropriate, drawings.

(3) Within the meaning of the provisions of Art. 11 of the Law, the disclosure of the invention must be already made on the filing date of the utility model application.

Art. 11 - Non-prejudicial disclosure

(1) For the application of the provisions of Art. 3, paragraph (4), letter a) of the Law, the utility model application shall be filed with OSIM within a maximal time limit of 6 months from the date on which the invention was made available to the public within the meaning of Art. 3, paragraph (2) of the Law.

(2) For the application of the provisions of Art. 3, paragraph (4), letter b) of the Law, there constitutes an *obvious abuse in relation to the applicant or his predecessor in title* the disclosure by a third party who:

a) has purloined the invention from any of these persons; or
b) one of these persons communicated the invention to, on condition of not being rendered available to the public.

(3) The abuse, within the meaning of paragraph (2), is supposed to be intentional and may be invoked by the applicant, even if the abuse has not been made relative thereto, but relative to his predecessor in title.

Art. 12 - Exceeding the framework of mere professional skill

(1) Within the meaning of Art. 1, paragraph (1) of the Law, an invention is deemed to exceed the framework of the mere professional skill if, as compared with the state of the art, under the provisions of Art. 3 of the Law, it presents an advantage, as a result of solving the technical problem.

(2) The advantage referred to in paragraph (1) may be a technical advantage

or a practical one in carrying out or using a product, or an advantage for the user, such as an advantage obtained in the field of education or leisure.

(3) Utility model applications and patent applications provided under Art. 3, paragraph (3) of the Law, although forming part of the state of the art, shall not be taken into consideration when assessing the exceeding of the framework of the mere professional skill, under the provisions of paragraph (1).

Art. 13 - Drawing up the search report

(1) The search report, under the provisions of Art. 18 of the Law, shall provide the applicant with information relating to the relevant state of the art with regard to the invention contained in the application claims, in respect of which he can exercise his exclusive rights, as provided by Art. 20 of the Law.

(2) After its publication, the search report shall provide third parties with information relating to the relevant state of the art with regard to the invention contained in the application claims.

(3) OSIM shall draw up the search report based on the regular national filing constituted under the provisions of Art. 13 of the Law.

(4) The search report cannot be made in the following cases:

a) the invention which is the subject-matter of the utility model application lacks technical character, within the meaning of Art. 1 of the Law or is excluded or excepted from protection under the provisions of Art. 1, paragraph (2) or (4) of the Law or the provisions of Art. 11 of the Law on the invention disclosure are not complied with, and

b) the fees for drawing up the search report have not been paid.

(5) For the application of Art. 16, paragraphs (2) and (3) of the Law, where OSIM ascertains that the application contains two or three inventions, the applicant shall be notified accordingly and asked to file the claims corresponding to the invention for which the search report shall be drawn up.

(6) Under the provisions of Art. 18 of the Law, the search report shall be sent to the applicant which, within the granted time limit, can communicate to OSIM if he desires the publication thereof together with the publication of the mention of the registration decision.

(7) For the application of the Art. 18, paragraph (7) of the Law, where the search report has not been published together with the publication of the mention of the registration decision, it shall be published subsequently, upon request by the owner or third parties.

(8) The request for publication shall be filed with OSIM in writing, not later than 4 months before the end of the time limit of 6 years from the filing date.

(9) Where the publication of the search report has not been requested according to the provisions of paragraph (8), OSIM shall publish the report before the end of the time limit of 6 years from the filing date.

(10) For the application of Art. 19, paragraph (9) of the Law:

a) the search report may be requested, in writing, by a third party, not later than 6 months before the end of the first 6 years of protection;

b) where a third party has requested that OSIM draw up a search report based on amended claims, OSIM shall publish the original search report drawn up for the applicant, while the second search report shall be published immediately after its having been drawn up and transmitted to the owner and the third party.

Art. 14 - Amending the claims

(1) The utility model registration procedure shall be based on the regular national filing of the application, the amending of claims by the applicant, referred to under Art. 18, paragraph (5) of the Law, being admitted only as a consequence of receiving the search report drawn up by OSIM.

(2) Where the amended claims provided under Art. 18, paragraph (5) of the Law are filed subsequently to the end of the time limit referred to under Art. 18, paragraph (4) of the Law, they shall not be published and shall be returned to the applicant.

(3) For the application of Art. 19, paragraph (10) of the Law, the Board shall not examine the amended claims filed under Art. 18, paragraph (5) of the Law.

(4) The claims amended under the provisions of Art. 18, paragraph (5) of the Law shall confer on the owner the right of exploitation referred to under Art. 5 of the Law and shall determine the scope of protection conferred by the registered utility model.

(5) However, the amended claims shall not extend beyond the subject-matter of the utility model application on the filing date. The amended claims shall be assessed within the cancellation procedure according to the provisions of Art. 23, paragraph (1), letter e) of the Law.

Art. 15 - Utility model application examination report

(1) The utility model application examination report, according to the provisions of Art. 19, paragraph (1) of the Law, is the document drawn up and signed by the examiner who has instrumented the application file, on which the decision of the Examination Board is based.

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

- a) bibliographic data of the utility model application;
- b) a brief presentation of the subject-matter of the invention for which the utility model registration is requested;
- c) mention of the procedures the application has undergone subject to the payment of the fees, as well as of the analyzed documents;
- d) explanations concerning the fulfilment of the conditions provided under Art. 17, paragraph (1) and (2) of the Law;
- e) the examiner's proposal to register the utility model or to refuse the application, while specifying the legal grounds thereof.

Art. 16 - Examination Board

(1) The competence of the Examination Board shall be the following:

- a) to make the decisions to register the utility model or to refuse the application;
- b) to declare the utility model applications falling under the provisions of Art. 18, paragraph (6) and Art. 19, paragraph (5) of the Law as deemed to be withdrawn; or
- c) to take note of the utility model application withdrawal, upon the express request by the applicant.

(2) The Examination Board consists of:

- a) chairman appointed by the Director General of OSIM;

b) state examiner in the industrial property field who has drawn up the examination report;

c) a second examiner appointed by the chairman.

(3) Decisions made by the Examination Board shall be justified and a mention thereof shall be entered in the National Register of utility model applications where the mentions concerning the withdrawn utility model applications and the mentions concerning the applications declared as deemed to be withdrawn shall also be entered.

(4) Mentions of the decisions to register the utility model application shall also be entered in the National Register of registered utility models.

(5) The decisions made by the examination boards, the document concerning the withdrawal of the utility model application or the declaration that the application is deemed to be withdrawn shall be communicated to the applicant or the professional representative, as the case may be, within one month from the date of making the decision, or from the date on which the document concerning the withdrawal was issued.

(6) For the application of the provisions of Art. 19, paragraph (3) of the Law, OSIM shall defer the decision on the utility model registration if the applicant files a grounded request and pays the fee for extension of the time limit for proceeding starting from the 7th month from the filing date; otherwise, the registration procedure shall be continued by OSIM.

(7) For the application of the provisions of Art. 19, paragraph (7) of the Law, where an appeal is lodged, the mention of the decision shall be published within a time limit of one month from the date on which the appeal has been settled.

Art. 17 - Publication of the utility model registration

(1) For the application of the provisions of Art. 19, paragraph (8) of the Law, the utility model registration shall be published by making the description, claims and drawings included in the regular national filing and, where appropriate, the amended claims, available to the public, at OSIM premises, starting from the date when the mention of the registration decision has been published in BOPI; the search report shall also be published by being made available to the public at OSIM premises.

(2) Publication, under the provisions of paragraph (1), shall include a first page which shall comprise at least the following:

a) filing number and date of the patent application;

b) index of the international classification;

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

d) title of the invention;

e) owner's identification data;

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

g) inventor's identification data;

h) claimed priorities;

i) application abstract agreed and figure indicated by the applicant to be published;

j) number of the claims and figures of the utility model application;

k) mention of publication of the search report, where appropriate.

(3) Decisions on utility models shall produce effects for third parties as from

the date of the publication in BOPI of their mention.

(4) At the time of the publication referred to under paragraph (1), the changes in the legal status, filed with OSIM up to the date on which the preparations for the publication of the utility model are finalized, shall also be published.

Art. 18 - Renewal of protection

(1) OSIM shall enter in the National Register of registered utility models and publish in BOPI the notice of protection renewal immediately after the expiry of the protection duration provided for under Art. 7 (1) and (2) of the Law, if:

- a) the owner has requested the renewal of protection in writing, within the time limits provided under Art. 7, paragraph (2) or (3) of the Law and
- b) proof of payment of the renewal fee is made, according to the provisions of Art. 7, paragraph (5) or (6) of the Law.

(2) OSIM shall not enter the notice of protection renewal referred to in paragraph (1) where, before the expiry of the protection duration, a final and irrevocable decision to cancel the registration certificate has been made or the owner has waived his rights conferred by the utility model registration.

(3) As soon as the legal conditions for the renewal of utility model protection are fulfilled, OSIM shall issue the renewal certificate to the owner and shall publish the notice of protection renewal in BOPI.

(4) Where the owner has not renounced the utility model, the renewal fee can be paid by any person, provided that the identification data thereof and the owner's data, the utility model certificate number, the title of the invention which is the object of utility model protection and the period for which the fee is paid are indicated and a copy of the payment document is registered with OSIM.

(5) Where the owner or the professional representative has not paid the renewal fee before the end of the time limit provided under Art. 7, paragraph (5) of the Law, but the payment has been effected by another person, the legal conditions for the renewal of utility model protection shall be deemed to be fulfilled and OSIM shall notify the owner or professional representative, as the case may be, accordingly.

(6) Where protection lapses for failure to pay the renewal fees under the provisions of Art. 7, paragraph (5) or (6) of the Law, the owner may apply with OSIM for revalidation of registration, for justified grounds, within two months, at the most, from the expiry of the time limit referred to under Art. 7, paragraph (5) of the Law; OSIM shall decide on the application for revalidation under the condition of the payment of the legal fee provided for in Art. 1 point 22 of the Annex No. 1 to the Government Ordinance No. 41/1998, as republished with the subsequent amendments, as well as of the renewal fee.

(7) The notice of utility model registration revalidation shall be published in BOPI within 30 days from the communication of the decision under the provisions of paragraph (6).

(8) In the case referred to under Art. 14, paragraph (1), letter b) of the Law, where OSIM decides to register the utility model after the expiry of a time limit of 6 years from the utility model filing date, the owner shall also pay the renewal fees provided for under Art. 7, paragraph (5) and, where appropriate, paragraph (6) of the Law.

Art. 19 - Utility model certificate cancellation procedure

(1) Where a utility model registration is cancelled for the reason referred to under Art. 23, paragraph (1), letter d) of the Law, OSIM shall issue the certificate to the entitled person, subject to payment of a fee corresponding to the legal fee for filing modifications in the legal status of a patent.

(2) For the purpose of publication in BOPI, the person entitled to the issuance of the certificate shall submit the proof of payment of the fee referred to under paragraph (1) and the final and irrevocable decision establishing the new owner, as the case may be.

CHAPTER IV - Transitional and final decisions

Art. 20 - Mutatis mutandis application of provisions of the Implementing Regulations to the Patent Law 64/1991, approved by Government Decision No. 547/2008

In application of Art. 28 of the Law, the following provisions of the Implementing Regulations to the Patent Law 64/1991, as republished, shall apply mutatis mutandis: Art. 2 - 10, Art. 14 - 16, Art. 18, except paragraph (15), Art. 19 - 24, Art. 26 - 31, Art. 33 - 34, Art. 38, Art. 44 - 46, Art. 48, except paragraph (2), Art. 49, Art. 52 - 54, Art. 55 wherein the phrase "request for revocation" shall be replaced by the phrase "request for cancellation", Art. 56, except paragraph (1), letter b), Art. 57, except paragraph (4), and wherein the phrase "request for revocation" shall be replaced by the phrase "request for cancellation", Art. 58 wherein the phrase "request for revocation" shall be replaced by the phrase "request for cancellation", Art. 59, except paragraph (2) and wherein the phrase "request for revocation" shall be replaced by the phrase "request for cancellation", Art. 60, Art. 63, Art. 64, except paragraph (4), Art. 65, except paragraph (3), (5) and (6), Art. 80, except letter a), Art. 81, except paragraph (13), Art. 82 and Art. 84 - 91.

Art. 21

In the application of the current Implementing Regulations, the Director general of OSIM can issue instructions to be published in the Official Gazette of Romania, Part I.