

PARLIAMENT OF ROMANIA

CHAMBER OF DEPUTIES

SENATE

Law on Employees' Inventions

The Parliament of Romania has adopted this law.

CHAPTER I

Field of Application and Definitions

Art.1 - (1) The present Law shall be applicable to inventions created by an individual inventor or by a group of inventors, where the individual inventor or at least one member of the group of inventors is an employee of:

- a) a private law legal entity;
- b) a public law legal entity

(2) The present Law shall be applicable to the inventions referred to under paragraph (1), which can be protected by patents or registered utility models.

Art. 2 - (1) Within the meaning of this Law, the terms and phrases below are defined as follows:

a) *employee* - any natural person who carries out a paid activity, based on an individual employment contract, for and under the authority of a person referred to in Art. 1 (1);

b) *the employer's industrial property attorney* - the natural person, qualified and paid, who acts under the provisions of the Government Ordinance No 66/2000 on organizing and practicing the profession of industrial property attorney, as republished.

(2) The meaning of the phrase *research&development* is defined according to Art. 2(1) of Government Ordinance No 57/2002 on the scientific research and technological development, approved with amendments and additions by the Law No 324/2003, as subsequently amended and completed;

CHAPTER II

Employees' Inventions

Art. 3 - (1) The employees' inventions are the inventions referred under Art. 1, which meet the following conditions:

a) resulted from the carrying out of inventor's duties, either specifically assigned to him within the employment contract and the job description, or set out by other legally binding documents providing for an inventive mission;

b) were made during the individual employment contract, or during a period of 2 years, at the most, following the termination of this contract, as the case may be, having knowledge of and using the employer's expertise, using the employer's means, as a consequence of the professional training acquired by the employee-inventor due to the employer's care and on the employer's expenses or using information resulting from the employer's activity or made available by him.

(2) The inventive mission referred to under paragraph (1) a) above shall set out the technology field of the technical problem(s) for the solving of which the employee-inventor is bound, under the contract or other legally binding documents, to bring a creative

contribution according to his employment duties.

Art. 4 - (1) The employer shall be competent to decide whether an invention made by an employee falls or not in the category of employee's inventions and also upon the type of employee's invention, in accordance with the situations provided under Art. 3(1).

(2) The employee who creates an invention shall have the obligation to communicate to his employer, without delay, a presentation describing the solution to the problem solved by the invention in a sufficiently clear manner for it to define the invention and the conditions of its creation.

(3) In the absence of a longer time limit stipulated in the employer's internal regulations, within a time limit of 4 months of the receipt of the communication referred to under paragraph (2), the employer shall inform the employee-inventor about the invention's falling in the category of employees' inventions and about his claiming the right in the said invention.

(4) The above-mentioned classification of an invention by the employer may be appealed against by the employee before the competent law court, under the civil law, within a time limit of 4 months.

Art. 5 - (1) The right in the inventions referred to under Art. 3(1)a) shall belong to the employer.

(2) The right in the inventions referred to under Art. 3(1)a) shall belong to the employer in the absence of an otherwise stipulating contractual provision, where said employer is a public law legal entity having research&development among its objects of activity.

(3) The right in the inventions referred to under Art. 3(1)b) shall belong to the employee-inventor if the private-law or public-law employer does not claim the invention under the conditions set out in Art. 4(3).

(4) The right in the inventions created by employees and not falling under any of the situations provided under Art. 3(1) shall belong to the employee-inventor, under the conditions set out by the Patent Law 64/1991 as republished with the subsequent amendments.

Art. 6 - In respect of the employees' inventions referred to under Art. 3(1)b), which have been claimed by the employer, the employee-inventor is entitled to a remuneration to be established by the employer, under the conditions set out under Art. 7.

Art. 7 - The employer shall specially provide within its internal regulations the criteria for establishing the said remuneration. In the absence of such special provisions, the employer shall take into account, depending on each case, one or several of the following criteria:

- a) the economic, commercial and/or social effects arising from the exploitation of the invention by the employer or by third parties, with the employer's consent;
- b) the extent to which the employer is involved in carrying out the employee's invention, the employer's resources made available therefor included;
- c) the creative contribution of the employee-inventor, where the invention is created by a plurality of inventors.

Art. 8 - (1) In case that the right in the employees' invention belongs to the employer, he shall be entitled to file a patent application or a utility model registration application, in Romania and/or in other States, while claiming the priority right from Romania.

(2) For the purposes of applying paragraph (1), the patent application or the utility model registration application shall be accompanied by the document stating the right in the invention.

(3) In the case referred to under Art. 5(4), the employee-inventor shall be entitled to apply for protection in Romania and/or in other States, while claiming the priority right from Romania.

(4) In the cases referred to under paragraphs (1) and (3), the employee-inventor and the employer shall have the obligation to mutually inform each other in writing about the filing of a patent application or a utility model registration application.

Art.9 - (1) After having filed the application for the protection of the employee's invention, the employer shall inform the employee-inventor of the progress of the proceedings for achieving protection.

(2) Upon request by the employer, the employee-inventor shall lend him technical assistance for acquiring protection and exploiting the invention.

(3) In case the employer does not want to continue the proceedings subsequent to the filing of the application for the protection of the employee's invention or in case he is not interested in the protection of the invention in certain States, other than Romania, the employer shall assign the right to protection to the employee, subject to a non-exclusive license to be granted by the employee to the employer, in respect of the patented invention. The conditions for granting the above-mentioned non-exclusive license shall be specially stipulated in the employer's internal regulations concerning this matter. In the absence of such special provisions, the conditions for granting the license shall be agreed upon by the parties. The employer shall also transmit in due time the documents needed for resuming the procedure.

(4) Upon request by the employee, in respect of the States for which the employer declared his lack of interest in acquiring industrial property rights, the employer shall assign the right to apply for the protection of the employee's invention to the employee, within a time limit sufficient for him to enjoy the priority periods provided for by the international industrial property conventions and treaties to which Romania is a party.

Art. 10 - (1) The inventions referred to under Art. 3(1) may be subject to a trade secret.

(2) The employee-inventor is bound not to disclose or publish the invention referred to under Art. 3(1) without the employer's written agreement. The same interdiction of disclosure or publishing applies to the employer, as well as to the persons, other than the inventor, who, by the nature of their service duties, have knowledge of the existence of the invention.

(3) In case of disclosure of the employee's invention by the persons referred to under paragraph (2), they can be liable for it by virtue of the individual employment contract concluded between the employee and the employer, where a confidentiality clause is provided therein.

(4) Where the individual employment contract does not contain a confidentiality clause and a prejudice results from the disclosure of the employee's invention by the persons referred to under paragraph (2), it may entail civil liability, as provided by Art. 1349 (1) and (2) corroborated with Art. 1357 of the Civil Law Code.

Art. 11 - (1) In respect of the employees' inventions made by employees whose employers are public law legal entities having research&development among their objects of activity and claimed by the employer, according to the provisions of this Law or according to a contract concluded between the parties, and exploited by the employer, the inventor-employee is entitled to a percentage of the income made by the employer based on the said inventions.

(2) The percentage referred to under paragraph (1) cannot be lower than 30%.

Art. 12 - (1) For the inventions resulting from research&development or didactic activities carried out in a university-level institution which owns the protection right, this

institution shall grant to the inventor, upon request and free of charge, a right to exploit the invention in the respective field of didactic and research activity, based on a non-exclusive license contract, even if the inventor is not an employee.

(2) The term of the contract referred to under paragraph (1) shall be equal to the period of time during which the inventor carries out the said didactic and research activities.

Art. 13 - The employer's industrial property attorney carrying on his activity in the field of inventions shall lend assistance, upon request, to the employee-inventor, with the purpose of drawing up the communication referred to under Art. 4(2).

Art. 14 - (1) Litigation between employers and employees, regarding the application of this law, shall be within the jurisdiction of the law courts.

(2) Failure to comply with the obligations arising from this Law may entail tort civil liability and/or criminal liability for the person liable for infringing the respective legal provisions.

Chapter III Transitional and Final Provisions

Art. 15 - The employer shall elaborate and promote policies and programmes aiming at increasing the innovative capacity for higher competitiveness and job creation purposes.

Art. 16 - Patent Law 64/1991, as republished in the Official Gazette of Romania, Part I, No 541 of 8 August 2007 with the subsequent amendments, shall be amended as follows:

1. Art. 5 and Art. 36 shall be deleted

2. Art. 38(2) shall be amended and shall read as follows:

“(2) In case of employees' inventions, the patent owner shall be bound to notify the inventor of his intention to renounce the patent; upon the inventor's request, the owner shall be bound to transfer him the right in the patent, as well as the documents related thereto, provided that the employee grants a non-exclusive licence to his employer, in respect of the patented invention. The conditions for the granting of the non-exclusive licence shall be set out by special provisions of the employer's internal regulations. In the absence of the said special provisions, the conditions for granting the licence shall be agreed upon by the parties.”

3. Art. 42 shall be deleted.

4. In Art. 63 paragraph (1) shall be amended and shall read as follows:

“Art. 63 - (1) Litigations concerning the status of inventor, patent owner or other rights arising from the patent, including the economic rights of the inventor under assignment or license contracts shall be within the jurisdiction of the law courts.”

5. Art. 73 shall be deleted.

Art. 17 - (1) Patent applications filed under Art. 5 of the Patent Law 64/1991, as republished with the subsequent amendments, as well as the utility model applications of employee-inventors filed with OSIM before the date of entering into force of this Law, in respect of which no decision has been taken, shall be ruled according to the legal regime provided for by the legal norms in force on the date of filing the application for the protection title, as sought.

(2) The provisions of the Patent Law 64/1991, as republished with the subsequent amendments, of the Law No 350/2007 on utility models, of the Government Decision No 547/2008 for the approval of the Implementing Regulations to the Patent Law 64/1991, as

republished, as well as of the Government Decision 1457/2008 for the approval of the Implementing Regulations to the Law No 350/2007 on utility models, shall be applied mutatis mutandis to the inventions regulated by this Law.

(3) Within a time limit of 60 days of the publication of this Law in the Official Gazette of Romania, Part I, the Government Decision No 547/2008 for the approval of the Implementing Regulations to the Patent Law 64/1991 shall be amended accordingly by the Government.

Art. 18 - Law 64/1991 as republished in the Official Gazette of Romania, Part I, No 541 of 8 August 2007, with the subsequent amendments as well as with the amendments set out by this Law, shall be republished in the Official Gazette of Romania, Part I, the texts being given a new numbering.

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

PRESIDENT OF
THE CHAMBER OF DEPUTIES

VALERIU-ȘTEFAN ZGONEA

PRESIDENT OF
THE SENATE

CĂLIN-CONSTANTIN-ANTON POPESCU-TĂRICEANU

Bucharest, 24 June 2014
No. 83