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By **Nicoleta Tarchila**, Cabinet Enpora IP

What options are open to a patent owner seeking to enforce its rights in your jurisdiction?

In Romania, patent owners may enforce their rights through civil and criminal litigation. For infringement matters, the Patent Law does not provide for specialised IP courts. Thus, the choice of court must follow the general rules with respect to competence. Territorial jurisdiction is determined by the defendant's domicile in civil proceedings and by the defendant's domicile or the place of infringement in criminal proceedings. Material competence may be conferred on the lower court or the court of law, depending on the value of the case.

Customs enforcement is also an option for patent owners to stop counterfeit products from entering the Romanian territory. Customs authorities may act *ex officio* or based on an application for action. Customs actions usually end with a simplified procedure, which leads to the destruction of the counterfeited goods. If requested, Customs' intervention may be followed by civil or criminal proceedings.

Alternative dispute resolution (ADR) proceedings are also available in Romania.

Are parties obliged to undertake mediation/arbitration prior to bringing a case before the courts? Is this a realistic alternative to litigation?

Mediation or arbitration is not compulsory before bringing a case before the Romanian courts. These ADR proceedings are optional before or during the trial. For a limited period – between 2012 and 2014 – new provisions of

the Mediation Law obliged parties to attend a session to inform them of the advantages of mediation. Any case brought before court without evidence of attending such a session was rejected. However, in May 2014 the Constitutional Court declared that this provision was unconstitutional.

Because of the limited background in this matter, ADR proceedings may not be considered a realistic alternative to litigation.

Are there specialist patent or IP courts in your jurisdiction? If not, what level of expertise can litigants expect from the courts?

There is no specialised IP court in Romania. However, IP panels, which function as part of the civil courts, are available and the level of expertise is high. For specific technical matters, the judges often seek help from technical and IP experts. The parties also have the possibility of appointing their own experts.

Are validity and infringement dealt with together, or does your country have a bifurcated system?

Validity and infringement actions are part of a bifurcated system, mainly because of the competence of the courts entitled to judge such cases. Under the Patent Law, the Bucharest Court of Law has jurisdiction in validity cases. Infringement actions are governed by the general rules on jurisdiction. Where the Bucharest Court of Law has jurisdiction over both, there is no impediment for validity and infringement issues to be dealt with together

as counterclaims in the same trial. Where a different court has jurisdiction in an infringement case, validity and infringement are judged separately. Depending on the circumstances of the particular case, a validity action may be sufficient grounds to defer an infringement action until a final decision is issued in the validity case.

Who may represent parties engaged in a dispute?

Because both infringement and validity cases are within the competence of the courts, the parties must be represented by attorneys at law or legal counsel.

To what extent is pre-trial discovery permitted in cases?

The Civil Procedure Code contains no provisions with respect to pre-trial discovery. All evidence must be submitted during the proceedings. Moreover, any information that one party wishes to obtain from its opponent (eg, information with respect to the place that the infringing goods were produced, the distribution network, the number of products or sales figures) can be procured only during the court proceedings.

Is cross-examination of witnesses allowed during court proceedings? If so, what form does this take?

Cross-examination of witnesses is allowed during court proceedings, as patent cases are governed by general civil procedure rules. Witnesses being examined in oral proceedings must first respond to questions addressed to them by the judge. After this, and with the judge's authorisation, witnesses must answer questions put to them by the parties.

What use of expert witnesses is permitted?

Parties may use expert witnesses in various fields, depending on the subject matter of the case. In patent cases technical experts with specialist knowledge in the particular field of the invention are engaged in order to explain the technical aspects. Sometimes IP expert witnesses are also appointed if the questions to be answered by them do not overlap with

the judge's role. The court may also appoint accountant witnesses in order to analyse the infringing party's sales revenues and allow the judge to establish the amount of damages due to the rightful owner.

Is the doctrine of equivalents applied by courts in your jurisdiction? If so, what form does it take?

The doctrine of equivalents is applicable in Romania. In order to determine the extent of protection of a patent, account should be taken of any equivalent element to an element specified in the claims. Consequently, the interpretation of the patent claims in a court action exceeds the literal meaning of the claims.

Are there problems in enforcing certain types of patent relating to, for example, biotechnology, business methods and software?

The object of protection should not affect the possibility of enforcing the patent. However, practice shows that there can be difficulties in enforcing certain kinds of patents, especially because of the limited number of experts in those fields. Business methods and computer software are not patentable in Romania.

To what extent are courts obliged to consider previous cases that have covered issues similar to those pertaining to a dispute?

Romanian courts are not bound by prior case law. However, earlier court decisions covering similar issues may be taken into consideration and constitute important guidelines in the interpretation and application of national legal provisions.

To what extent are courts willing to consider the way in which the same or similar cases have been dealt with in other jurisdictions? Are decisions from some jurisdictions more persuasive than those from others?

Similar to national case law, previous decisions dealing with similar cases in other jurisdictions may be taken into consideration as guidelines for the Romanian courts in issuing decisions. In particular, decisions

issued by the European courts are frequently invoked and followed by Romanian courts.

What realistic options are available to defendants seeking to delay a case? How might a plaintiff counter these?

The administration of evidence could be a realistic option for defendants to delay a trial. The drafting of expert reports is time consuming and may sometimes be controlled by the defendant, which may delay the discovery of all aspects and documents needed from a technical or accounting expert. The plaintiff may contest various adjournments and require that the trial be expedited and the defendant penalised. However, until bad faith is proven, the defendant may gain time in the proceedings.

Filing a counterclaim – usually one contesting the validity of the patent – is also a means of delaying a case. While the courts have been sceptical about staying infringement proceedings until a pending validity action is finalised, significant delays may nonetheless be obtained on a case-by-case basis.

Under what circumstances, if any, will a court consider granting a preliminary injunction? How often does this happen?

Preliminary injunctions are provided by the Civil Procedure Code and are frequently granted in infringement proceedings. Such injunctions will be granted where:

- it appears strongly that the plaintiff is in the right;
- the matter is urgent; and
- the injunction is designed to prevent a right from being infringed by any undue delay, imminent prejudice that could not be remedied later or obstacles to the enforcement of a decision on merits.

How much should a litigant budget for in order to take a case through to a decision at first instance?

It is difficult to determine an exact amount beforehand, as most cases depend on the particular circumstances. As an estimate, it should cost between €10,000 and €15,000 to obtain a decision at first instance.

How long should parties expect to wait for a decision to be handed down at first instance?

It should take between 12 and 18 months to obtain a decision at first instance, although this may take longer depending on the circumstances of the case. Following recent updates to the Civil Procedure Code, the written phase of the proceedings is dealt with before the first hearing. Depending on the court's schedule, the written phase may be started within about three months and a first hearing scheduled within six months of filing the action. Thereafter, hearings are established every month. Another two to three months are needed for the court to draft and communicate its decision.

To what extent are the winning party's costs recoverable from the losing party?

Judicial costs may be recovered on the express request of the winning party.

Contributing profiles



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Nicoleta Tarchila is a partner at Cabinet Enpora IP. She graduated from law school in 2004 and has been a specialised IP counsel since 2006. Ms Tarchila coordinates Cabinet Enpora's litigation department and has eight years' experience in IP prosecution and litigation. As part of the Cabinet Enpora IP team, Ms Tarchila advises clients from various fields of activity.

The court will approve the recovery of expenses based on the evidence submitted by the winning party. Recoverable costs consist of legal fees, translation fees, expert fees and attorney fees. Attorney fees may be reduced if the court feels that the amount paid was not justified by the complexity of the case.

What remedies are available to a successful plaintiff?

In civil proceedings a common remedy for a successful plaintiff is a permanent injunction. The defendant must cease all infringing actions and remove the infringing goods from the market and destroy them. Damages are granted when requested, as well as the reimbursement of legal fees, also upon request. The plaintiff may additionally request publication of the court's decision in a popular newsletter with the aim of informing consumers about the action's success.

In criminal proceedings the payment of a fine and sometimes imprisonment are common remedies. If the plaintiff opts for a civil damages action alongside the criminal proceedings, the above remedies are also applicable.

How are damages awards calculated?

Is it possible to obtain punitive damages?

The usual criteria taken into consideration when calculating damages are the unfair profits obtained by the defendant and the loss of profits suffered by the rights holder. Damages are usually established based on testimony given by accounting experts during the trial. Another criterion for determining damages is the applicable royalty fees. Punitive damages may not be obtained.

Under what circumstances might a court grant a permanent injunction? How often does this happen? Does the losing party at first instance have an automatic right of appeal? If not, under what circumstances might leave to appeal be granted?

A permanent injunction is a common claim in an infringement action and is usually granted if the case is successfully sustained and proven. The losing party automatically has the right to appeal the decision.

How long does it typically take for the appellate decision to be handed down?

Appeal proceedings take between six months and one year. Since an appeal implies the re-examination of all facts and evidence and new evidence may be submitted under certain circumstances, the proceedings can take even longer. A timeframe of up to three months is also necessary for the appeal decision to be drafted and communicated.

Is it possible to take cases beyond the second instance?

Infringement cases may be taken to the second instance. However, a final appeal is allowed only for the review of the application and interpretation of legal provisions.

To what extent do the courts in your jurisdiction have a reputation for being pro-patentee?

Reviewing the latest case law, it is possible to discern a pro-patentee approach among the Romanian courts.

Is your jurisdiction a signatory to the London Agreement on Translations?

Romania is not a signatory to the London Agreement on Translations.

Has your jurisdiction signed the Agreement on the Unified Patent Court? If so, when do you expect it to be ratified?

Romania is a signatory to the Agreement on the Unified Patent Court. A conservative estimate would put the ratification date at 2015. **iam**



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