

CHECK-LIST OF ISSUES ON ENFORCEMENT¹

Replies by the Dominican Republic

Civil and administrative procedures and remedies

- (a) Civil judicial procedures and remedies

1. Specify the courts which have jurisdiction over IPR infringement cases.

In civil proceedings and remedies, the court competent to try claims for damages arising from infringements of Laws 65-00 on Copyright and 20-00 on Industrial Property is, in the first instance, one of the civil chambers of the Court of First Instance of the place of domicile of the defendant, according to ordinary rules of procedure. Appeals against the rulings of these courts are heard by the Civil Chamber of the Court of Appeal of the corresponding judicial area, and the findings of this appeal court may be brought before the Supreme Court of Justice in an application for annulment.

Civil suits may take place concurrently with criminal proceedings pursuant to Article 3 of our Code of Criminal Procedure, which reads as follows:

Article 3. Civil proceedings may take place concurrently with public proceedings and before the same judges. The civil suit may also proceed separately, in which case it shall be suspended until a definitive decision is taken regarding any public action brought prior to or during the civil suit.

2. Which persons have standing to assert IPRs? How may they be represented? Are there requirements for mandatory personal appearances before the court by the right holder?

- The right holder, all registered licensees and registered beneficiaries of any right or claim with respect to the infringed right.
- they may be represented by an authorized lawyer or by a legal representative empowered to file actions;
- the right holder's personal appearance is not mandatory in either civil or criminal proceedings;

All holders of an intellectual property right or of a related or neighbouring right, their successors or assigns or their contractual representatives have standing to enforce their statutory rights by the means they consider most appropriate, that is, through civil, criminal or administrative channels.

¹ Document IP/C/5.

Article 61 of the Code of Civil Procedure of the Dominican Republic provides that in order to initiate civil proceedings before the Court of First Instance, the plaintiff must cite the defendant to appear by means of a document drawn up by a bailiff, stating, *inter alia*, on pain of nullity, the name and credentials of the lawyer who will act on his behalf, and the lawyer's professional address, where the plaintiff will be deemed to have elected domicile.

The aforementioned obligation is also prescribed in Article 75 of the Code of Civil Procedure for the plaintiff, who, having received the summons, must appoint a lawyer and elect domicile in the city in which the trial court is located, such appointment being made by written notification from lawyer to lawyer.

The parties may appear in person at the hearings accompanied by their lawyers, or may be represented by them; nevertheless, Article 60 of Law 834 of 1978 (which repealed and modified the Code of Civil Procedure) provides that the court may require either or both parties to appear in person in any connection.

3. What authority do the judicial authorities have to order, at the request of an opposing party, a party to a proceeding to produce evidence which lies within its control?

Pursuant to the rules governing ordinary civil procedure, if documents have not been communicated amicably between lawyers or by deposit with the court office, the judge may simply order that this be done, if requested by any of the parties.

Articles 55 to 59 of Law 834 of 1978 provide that if in the course of a civil proceeding a party makes use of a public or private instrument to which it has not been a party or of a document that is in the possession of a third party, it may request the trial court to order that a certified copy be handed over or the instrument or document produced, without the need for any particular formality. Should the court deem the request to be well-founded, it will order that the instrument or document be handed over or produced in the original, or as a copy or extract thereof, depending on the circumstances, under the conditions and with such guarantees as it may determine, and if necessary, on pain of a fine. Similarly, any of the parties may apply to the court, which may itself order, even on pain of a fine, that any item of proof in the possession of the other party be deposited.

Article 55: If in the course of an action a party makes use of a public or private instrument to which it has not been a party, or of a document that is in the possession of a third party, it may request the trial court to order that a certified copy be handed over or the instrument or document produced.

Article 56: The request shall be made without formality. Should the court deem the request to be well-founded, it shall order that the instrument or document be handed over or produced, in the original, or as a copy or extract thereof, depending on the circumstances, under the conditions and with such guarantees as it may specify, if necessary on pain of a fine.

Article 57: The court's decision shall be provisionally enforceable, summarily if necessary.

Article 58: Should difficulties arise, or should any lawful claim be raised, the court that ordered the handing over or production of the documents may, upon a request made to it without formality, retract or change its decision. Third parties may file an appeal against the new decision within 15 days of its being handed down.

Article 59: The production of evidence in the possession of one of the parties shall be requested and the evidence produced in accordance with the provisions of Articles 55 and 56.

4. What means exist to identify and protect confidential information brought forward as evidence?

Copyright

Article 189 of Law 65-00 requires the National Copyright Office and its staff to treat as confidential the source of any reports they receive of infringements of the law, with the result that they may not inform the company or its representative, or any other person, that they are carrying out an inspection or a seizure operation on the basis of the information received.

The situation is different before the courts of law, as any documentation or piece of evidence pertaining to the case submitted as proof must be disclosed to both parties, whether amicably between lawyers or by deposit with the court office, so that the other party may take cognizance thereof. To safeguard due process, the court may not rule on the basis of proof that has not been communicated or submitted in good time.

Industrial property

Law 20-00 classifies as an infringement the disclosure of business secrets obtained by any dishonest means, pursuant to Article 180.

Articles 168 and 173 set forth the actions and remedies enforceable for violation of business secrets and Article 175 describes the method of calculating indemnification for damages.

The Director-General of the National Industrial Property Office may take any precaution in order to protect information or data which by their nature should remain confidential, so as to prevent unauthorized disclosure (Article 143.2, subparagraph H). This same obligation is binding on judges who receive confidential information.

5. Describe the remedies that may be ordered by the judicial authorities and criteria, legislative or jurisprudential, for their use:

- **Injunctions;**
- **damages, including recovery of profits, and expenses, including attorney's fees;**
- **destruction or other disposal of infringing goods and materials/implements for their production;**
- **any other remedies.**

Injunctions – copyright

In the first place, under Article 179 of Law 65-00, a holder of rights granted under that Law who may have valid reason to fear infringement of his rights or the disappearance of some or all of the materials/implements used to commit the infringement is entitled to request from the trial court, without prior notification of the other party, authorization for the attachment or sequestration, in his own custody or in that of a third party, of:

- Copies of any work, interpretation or performance, production or broadcast reproduced without the permission of the owner and of the equipment or implements used to commit the infringement, as well as any information or business documents pertaining to the case;

- the proceeds from the sale, rental or any other form of distribution of unlawful copies;
- the income earned from unauthorized acts of communication to the public;
- devices for circumventing systems designed to prevent the making of unlawful copies or installed to prevent reception of unauthorized broadcasts.

The right holder may also request the immediate suspension of the unlawful activity.

Furthermore, in accordance with Article 180 of the same Law, before initiating the main action, a right holder who fears infringement of his rights may request the court of first instance to issue a warrant for the judicial inspection of the place where the acts are presumed to be taking place in violation of Law 65-00 or its implementing Regulation No. 362-01.

Such inspection may also be ordered for infringing goods and equipment passing through customs, and the inspection warrant may also stipulate that, if the law is found to have been broken, the unlawful material or equipment used to commit the infringement may be attached or sequestered and the unlawful activity immediately terminated.

Should the right holder fail to bring an action within a period of 30 working days from the execution of the warrant issued by the court, the latter may order the lifting of the measure, at the request of the other party (Article 182).

Injunctions – industrial property

The civil injunctions prescribed by Law 20-00 on Industrial Property are set forth in Article 173 which specifies the measures enforceable in actions for infringement, namely: (a) cessation of the infringing acts; (b) indemnification for damage suffered; (c) seizure of the products of the infringement, of any advertising material referring to those products and of means used exclusively to commit the infringement; (d) the transfer of ownership of the products and means referred to in subparagraph (c), in which case the value of goods will be deducted from the amount of the damages; (e) the measures necessary to prevent the continuation or repetition of the infringement, including the destruction of the means seized under subparagraph (c), if indispensable.

Article 174 further provides for provisional measures to prevent or avoid the infringement and sets forth the prerequisites for seizure, such as security, the accreditation of the right holder and evidence that the court may deem sufficient in order to consider the infringement.

Damages – copyright

Article 177 provides that anyone who, without the permission of the right holder, acts in violation of the moral or economic rights recognized under the law shall be liable to the said right holder for injury caused by the infringement, regardless of whether or not he was aware of the infringement. The owner, partner, manager, director or person in charge of the place where the unlawful activities are being carried out will be jointly and severally liable for the rights infringements occurring in that place. In no case may the damages be less than the minimum fine prescribed as the criminal penalty for the corresponding infringement, with respect to each offence.

Similarly, Article 102 of Regulation No. 362-01 implementing Law 65-00 provides that, without prejudice to the appropriate sanction for economic injury, moral damages shall be payable, without the need to prove the existence of economic injury, such moral damages being determined on the basis of the circumstances of the infringement, the seriousness of the injury and the degree of unlawful dissemination of the work.

Article 103 of the Regulation provides that in assessing the economic damages, specific account shall be taken of the profits that would presumably have accrued to the right holder had the infringement not occurred, the remuneration he might have received had he authorized the exploitation of the work, and the total direct or indirect profits accruing to the infringer from the unlawful activity.

Damages – industrial property

The provisions on damages for industrial property right infringements are very specific and are complemented by Article 1382 of the Civil Code, as envisaged in Article 175 on the calculation of damages, which reads as follows:

To calculate damages, the portion corresponding to loss of income that must be compensated for shall be computed on the basis of any of the following criteria:

- The profits that would presumably have accrued to the right holder in the absence of competition from the infringer;
- the profits earned by the infringer as a result of the infringing acts;
- the price that the infringer would have paid the right holder for a contractual licence, with due regard for the commercial value of the subject-matter of the right infringed and the contractual licences already granted.

PARAGRAPH: Anyone filing suit for infringement of rights will be liable for any injury caused to the alleged infringer in the event of malicious or reckless actions or complaints.

Destruction or other disposal of infringing goods and materials/implements for their production

- Copyright

Pursuant to Article 183 of Law 65-00, in the final ruling determining the existence of an infringement, the court may order that the copies reproduced or used illegally, as well as the instruments used for their reproduction be destroyed or handed over to the plaintiff and, at the request of a party, that the ruling be published in one or more newspapers to be indicated in the ruling, at the expense of the unsuccessful party.

This measure does not impair the right of the National Copyright Office (ONDA), under Article 108(11) of Implementing Regulation No. 362-01 of Law, to order, by means of a reasoned decision, the destruction of the copies constituting the infringement, after a detailed record has been made of the items to be destroyed.

- Industrial property

Article 173, subparagraphs (c) and (e) of Industrial Property Law No. 20-00 provides for this amongst the enforceable measures.

Article 173: Enforceable measures in actions for infringement.

- (c) The seizure of the objects resulting from the infringement, of advertising material referring to those objects and of the means used exclusively to commit the infringement.

- (e) The measures necessary to prevent the continuation or repetition of the infringement, including the destruction of the material seized under subparagraph (c), should this be indispensable.

6. In what circumstances, if any, do judicial authorities have the authority to order the infringer to inform the right holder of the identity of third persons involved in the production and distribution of the goods or services found to be infringing and of their channels of distribution?

In criminal proceedings, the representatives of the Office of the Public Prosecutor are empowered to carry out all appropriate investigations to determine any infringement of the copyright and industrial property law, and to interrogate the infringer in order to determine liability on the part of any other person who may have taken part in the offence, bearing in mind that the liability for infringements of the law extends to all those persons who may order or arrange for such infringement, legal representatives of legal persons and anyone who, aware of the illegal nature of the act, takes part in, facilitates or conceals it.

Once the criminal proceeding has started, the trial judge is empowered to interrogate the suspect on any aspect of the case, in keeping with the ordinary rules of criminal procedure.

In civil proceedings, the trial judge may, at the request of a party or ex officio, order the defendant to appear in person, for the purposes of gathering any information that may be relevant to establishing the infringement and assessing damages, in accordance with the ordinary rules of civil procedure.

The paragraph to Article 166 of Law 20-00 provides as follows:

PARAGRAPH: Liability for the acts described above extends to all those persons who may order or arrange for them to be carried out, the legal representatives of legal persons and to anyone who, aware of the unlawfulness of the act, takes part in, facilitates or conceals it.

7. Describe provisions relating to the indemnification of defendants wrongfully enjoined. To what extent are public authorities and/or officials liable in such a situation and what "remedial measures" are applicable to them?

Copyright

Law 65-00 includes no specific provisions on the indemnification of defendants wrongfully enjoined, nor does it provide for remedial measures applicable to public authorities or officials in such cases. The general rules of our legal system must therefore apply.

Civil procedure provides remedies for protecting the defendant from being wrongfully sued or enjoined. One example of this is where the defendant seeks damages by filing a counter-claim against the plaintiff.

Article 1382 et seq. of the Civil Code envisage liability in tort or for negligence by providing, in general terms, that any act by one person that harms another obliges the person responsible for that act to make reparations.

The Dominican State may also be sued in cases where its officials or employees have caused damage through their actions, and public servants who have acted improperly in the discharge of their duties may incur penalties imposed by the State, including dismissal.

Industrial property

Under Article 174(6) of Law 20-00, the court ordering provisional measures is required to demand security to indemnify the defendant should the plaintiff lose the case. Besides, the paragraph to Article 175 provides that should the complaint be malicious or reckless, the plaintiff will be liable for damages.

8. Describe provisions governing the length and cost of proceedings. Provide any available data on the actual duration of proceedings and their cost.

Article 109 of the Constitution of the Dominican Republic prescribes that justice shall be administered free of cost throughout the national territory. Nevertheless, the pursuit of any judicial action entails judicial expenditure and costs.

Article 130 of the Code of Civil Procedure provides, in reference to the cost of proceedings, that the losing party shall bear the costs. Expenses or costs relating to proceedings include registration fees and domestic stamp duties, payments to bailiffs and experts, transcription costs and fiscal charges for the issue of writs, amongst others.

It is not possible to determine the length and cost of procedures with certainty as the conclusion of the case depends on the levels of jurisdiction involved and the various investigative measures requested and granted, as well as the pleas entered.

In practice, civil proceedings are faster and less costly, for both parties, than criminal proceedings.

(b) Administrative procedures and remedies

9. Reply to the above questions in relation to any administrative procedures on the merits and remedies that may result from these procedures.

Copyright

As regards administrative procedures, the National Copyright Office (ONDA) is the competent national authority responsible for preventive and protective administrative action with regard to copyright and related rights, and decides in first instance, at its administrative headquarters, the cases submitted to its jurisdiction, whether at the instigation of a party or ex officio (Article 106 of Regulation No. 362-01).

Pursuant to Article 187(3) of Law 65-00 and Article 107(4) of Regulation 362-01, the powers of ONDA include intervening by way of conciliation, even ex officio, and through arbitration, if the parties so request, in disputes over the enjoyment or exercise of statutory rights.

These conciliation and arbitration proceedings are ordered by reasoned decision and conducted by the Director of ONDA, except where the parties have decided by common agreement to turn to another arbitrator. The parties may attend scheduled hearings in person or through their legal representatives.

As regards the authority to order a party to produce evidence which lies within his control, Article 107(5) of the Regulation stipulates that the National Copyright Office may, ex officio or at the request of a party, carry out oversight and inspection functions with regard to activities that could give rise to the enforcement of copyright or neighbouring rights, with result that users are obliged to provide all the necessary facilities for the purposes of inspection, and to furnish any information and documentation that may be requested of them. For its part, Article 188(2)(c) of Law 65-00 authorizes

ONDA officials to request the submission of relevant registrations, licences, authorizations or documents pertaining to the marketing of illegally reproduced goods.

Furthermore, ONDA may, pursuant to Article 107(9) of the Regulation, order and carry out inspections and preventive and/or precautionary measures for the collection of evidence, and may act at the express request of the right holder, his duly authorized representatives or successors in title or the appropriate collective management society, or even ex officio.

As for the confidential nature of information brought forward as evidence, the paragraph to Article 189 of the Law stipulates that ONDA officials and employees must treat as confidential the source of any allegations of infringement and therefore may not inform the company or its representatives or any other person that they are making an inspection as a result of information received.

As regards administrative measures, ONDA, pursuant to the Law and the Regulation, is empowered to order, in its administrative capacity, whether ex officio or at the request of any of the statutory right holders or their representatives, the measures hereunder:

- The immediate cessation or suspension of any unlawful activity.
- Expeditious and effective preventive or precautionary measures to prevent the infringement of any of the rights recognized by law and, in particular, to prevent the introduction of the allegedly infringing goods into the channels of commerce, including measures to prevent the entry of imports and to preserve relevant evidence in regard to the alleged infringement.
- The seizure or confiscation and withdrawal, without prior notice, of the copies improperly produced or used and of the material and equipment employed to commit the infringement, as well as relevant documentary evidence.
- The prohibition of the use of a work, service, production or broadcast, in the event of a complaint by the right holder or the management society representing him that a work has been communicated to the public by an empresario or organizer without due authorization, in which case the alleged infringer must be notified immediately of such prohibition.

ONDA is also authorized to issue a non-binding technical report in civil or criminal proceedings concerning the enjoyment or exercise of copyright or related rights when so required by the court, ex officio or at the request of a party, and to file a criminal complaint with the Office of the Public Prosecutor if it is aware of an act that constitutes a suspected infringement.

It may also order and conduct inspections and implement preventive or precautionary measures, including for the purposes of collecting evidence, acting at the express request of the right holder, his duly authorized representatives or successors in title or the collective management society concerned, as well as ex officio.

Without prejudice to the relevant civil or criminal action, in its administrative capacity ONDA is empowered to impose, whether ex officio or at the request of a party, the administrative sanctions falling within its competence pursuant to Regulation 362-01. These are warnings, fines ranging from 5 to 200 minimum wages, compensation for omissions, temporary closure for up to 30 days of the establishment where the infringement took place, definitive closure, seizure or confiscation of the unlawful copies or the apparatus or equipment used to commit the infringement, the destruction of the unlawfully reproduced copies and, if necessary, the moulds, plates, printing blocks, negatives and other materials intended for the production of such copies. It is also free to

order the publication of the decision at the expense of the infringer, as well as to decide on the temporary or definitive closure of the infringing establishments.

ONDA may have its decisions enforced and may request the intervention of the competent authorities or the help of the police to ensure their execution.

Industrial property

Under Article 154 of Law 20-00, complaints to the National Industrial Property Office are processed as follows:

A complaint is made to the head of the department concerned, who processes it within the statutory time-frames, and the rebuttal is similarly handled. After the head of department has received all the documentation, he will issue the corresponding decision. That decision may be appealed to the Director-General of the National Intellectual Property Office within the stipulated time-frames, and the latter's decisions may also be challenged in the Court of Appeal.

The following persons may assert their rights by means of such administrative actions: (a) the right holder, any registered licensee and any registered beneficiary of any right or credit pertaining to the infringed right; (b) they may be represented by an authorized lawyer or a legal representative competent to initiate proceedings; (c) the personal appearance of the right holder is not mandatory.

The National Industrial Property Office notifies the other party of the claims made by the first party in the action brought before the Office.

It is incumbent on the head of department to protect confidential information pursuant to Article 143(h). (Please see the reply to question 4.)

The National Industrial Property Office may not order judicial measures as this is the prerogative of the judicial authorities.

The administrative authorities are not empowered to undertake coercive measures with regard to the identity of third parties implicated in the infringement as this falls within the competence of the judicial authorities. This is envisaged in the paragraph to Article 166. (Please see the reply to question 6.)

Indemnification is a matter for the competent courts, as prescribed in Articles 174(6) and 175 (please see the reply to question 7). In the case of the administrative authorities, a court will issue a similar ruling only if they are found guilty of serious misconduct in the discharge of their duties.

Administrative procedures last for 150 days and their cost varies in accordance with the rates set by the National Industrial Property Office.

Provisional measures

(a) Judicial measures

10. Describe the types of provisional measures that judicial authorities may order, and the legal basis for such authority.

Copyright

The provisional measures that may be ordered by a court competent to try civil cases copyright infringement were duly explained in connection with injunctions (Civil and Administrative Procedures and Remedies, paragraph (a)(5)).

We have already explained that when a holder of rights recognized under Law 65-00 fears that his rights may be infringed or that some or all of the materials used to commit the unlawful act could disappear, Article 179 of Law 65-00 allows him to request the court, without prior notification of the other party, to authorize the attachment or sequestration, in his own custody or in that of a third party, of:

- The copies reproduced without the right holder's permission, the equipment or implements used to commit the unlawful act and information or business documents pertaining to the act;
- the proceeds from the sale, rental or other form of distribution of the illegal copies;
- the income earned from unauthorized acts of communication to the public;
- devices used to circumvent systems designed to prevent the making of unlawful copies or to prevent or monitor unauthorized reception or broadcasting.

In addition to the aforementioned measures, the right holder may request the court to suspend the unlawful activity.

Article 180 enables the right holder who fears infringement of his rights to request the court, before initiating the main action, to issue a warrant for the judicial inspection of the place where the acts are presumed to be taking place in violation of Law 65-00 or its implementing Regulation No. 362-01. A similar warrant may be requested for the purpose of suspending the clearance of infringing goods and equipment still in customs.

The intention of the lawmaker, or more precisely, the legal basis of these measures is to provide the legitimate right holder with a rapid and effective means of preventing an infringement and economic injury to the right holder, as well as of preventing irreparable damage, and to enable him to act rapidly to prevent the disappearance of the unlawful goods, amongst other things.

Article 173 of the Law describes the provisional measures that may be ordered by the competent criminal court. Thus, all copies reproduced, transformed, communicated or distributed to the public in violation of copyright or related rights recognized under the Law and all the materials and equipment used to commit the illegal acts, as well as information or business documents pertaining to the infringement, may be seized at the request of the aggrieved right holder without notifying or hearing the other party, at any stage in the proceedings, even before the start of the criminal action and in whosoever's possession they may be, by the Office of the Fiscal Attorney in the judicial district where the said goods are located.

The Fiscal Attorney may at any time, even before the start of the criminal action, without the presence of the other party, carry out such investigations or expert studies as he may deem necessary to ascertain the existence of the infringing material, wherever it may be.

Article 174 of the Law provides that the procedures laid down in the Code of Criminal Procedure shall be observed in both the preliminary proceedings and the trial, so that all the judicial investigatory measures within the competence of the criminal courts may be ordered in actions for infringement of Law 65-00 brought before criminal jurisdictions.

Industrial property

Article 173 of Law 20-00 on Industrial Property lays down the provisional measures that may be enforced by right holders who feel their rights to have been infringed.

The enforceable measures are ordinary law measures and are ordered by the competent court. These measures include: (a) cessation of the infringing acts; (b) seizure of the objects resulting from the infringement; (c) destruction of those objects; (d) transfer of ownership of the seized objects; and (e) award of damages.

11. In what circumstances may such measures be ordered *inaudita altera parte*?

The judicial measures that may be taken without the need to notify or hear the other party have been extensively explained above. To sum up, they may be taken whenever the holder of any of the rights recognized under the Law has valid grounds for fearing the infringement of his right or the possible disappearance of any or all of the materials involved in the unlawful act.

12. Describe the main procedures for the initiation, ordering and maintenance in force of provisional measures, in particular relevant time-limits and safeguards to protect the legitimate interests of the defendant.

The right holder or his representative must submit a reasoned request for the issue of a warrant ordering the measure and must furnish any available proof of the allegations made. The judge will consider the request and, if it is deemed to be serious and well-founded, will issue the warrant ordering the measure in question. It may also be requested at a hearing during the course of the trial.

This warrant must be executed summarily, despite any action for referral or any appeal against it, and its implementation or execution may not be opposed by the owner, tenant, occupant or person in charge of the place, premises or commercial enterprise where the measure is to be effected.

When seizure or sequestration is ordered, the same judge will order the annulment of the measure at the request of the party against whom it has been taken, if at the end of 30 working days as from its execution, the main action for the violation of the right has not been initiated.

In the area of industrial property, the time-frame for bringing the action is ten (10) days, pursuant to Article 174(3) of Law 20-00.

13. Describe provisions governing the length and cost of proceedings. Provide any available data on the actual duration of proceedings and their cost.

As pertains to the length and cost of proceedings, we have already stated in the reply to question 8 that Article 109 of the Constitution of the Dominican Republic provides that justice shall be free of cost throughout the national territory, though all judicial proceedings engender expenses and costs that must then be borne by the losing party.

With reference to duration, our laws do not establish time-frames in which the judge must consider the measures requested and issue the warrant ordering such measures. In practice, this time-frame varies considerably, depending on the diligence of the requesting party and the court's case-load, amongst other factors.

Once the warrant has been issued, the right holder must advance the costs of the bailiff who implements the measure and any other expenses thereby incurred.

(b) Administrative measures

14. Reply to the above questions in relation to any administrative provisional measures.

Copyright

We have already described the provisional measures that may be taken by the National Copyright Office in subparagraph 9(b).

As stated, under Article 111 of Regulation 362-01, the measures ordered by the National Copyright Office (ONDA) are preventive or precautionary in nature and intended to:

- Prevent an infringement of any of the rights recognized under Law 65-00 and prevent the entry of the allegedly infringing goods into the channels of commerce, including measures to prevent the entry of imported goods;
- preserve relevant evidence in regard to the alleged infringement.

As also explained, these measures may be taken *at the request of a party* or *ex officio*. If taken *at the request of a party*, the application must be filed in writing with the Secretariat of the National Copyright Office, which will consider it and adopt the measure by means of a reasoned decision. If the measure is taken *ex officio*, it may be based on a prior inspection carried out by ONDA under its statutory powers to monitor and oversee observance of copyright and related rights, or it may be based on a complaint filed without any specific formalities with ONDA by anyone who suspects that an act has been committed in breach of the Law. In these cases, a record shall be made at the place where the act is committed and shall remain valid until proved unfounded.

ONDA inspectors may request the help of the police force during inspections or other operations and, if deemed necessary, may request the presence of the Office of the Public Prosecutor or the assistance of the Dominican Telecommunications Institute (INDOTEL) if the inspection or operation concerns a telecommunications enterprise.

There is no statutory time-frame in which ONDA must process the complaints it receives or order the provisional measures requested, though in practice they are dealt with within a maximum of three (3) working days, except in remote parts of the country.

The party against whom a provisional measure has been ordered is always entitled to submit to ONDA his arguments and proof of due authorization to use the work. Should the legality of the act be substantiated, ONDA may revoke the measure by reasoned decision, and return the material and equipment seized.

ONDA collects no fees for its actions, which means that no expenses are incurred for the provisional measures it may order.

Industrial property

The laws on industrial property do not provide for provisional administrative measures.

Special requirements related to border measures

15. Indicate for which goods it is possible to apply for the suspension by the customs authorities of the release into free circulation, in particular whether these procedures are available also in respect of goods which involve infringements of intellectual property rights other than counterfeit trademark or pirated copyright goods as defined in the TRIPS Agreement (footnote to Article 51). Specify, together with relevant criteria, any imports excluded from the application of such procedures (such as goods from another member of a customs union, goods in transit or *de minimis* imports). Do the procedures apply to imports of goods put on the market in another country by or with the consent of the right holder and to goods destined for exportation?

Copyright

As regards border measures, where there is good reason to suspect the imminent importation or exportation of goods that infringe copyright or related rights, Article 185 of the Law 65-00 allows the holder of the copyright or related right, his successors in title, their contractual representative or the collective rights management society concerned to request the General Customs Directorate or the competent Office of the Fiscal Attorney to suspend the release of such goods into free circulation. These authorities may also suspend ex officio the clearance of suspected illicit goods.

The General Customs Directorate ordering the suspension of release of the goods must notify the requesting party and the importer, within a period not exceeding five days, of the length of time for which suspension was granted, so that the requesting party may file his action on the merits or request new measures and so that the owner, importer or consignee of the goods may apply to the court of first instance in civil or criminal matters, depending on the circumstances, for the modification or annulment of the measures taken.

ONDA is also empowered to order preventive or precautionary measures to prevent the introduction of imported goods, pursuant to Article 111(1) of the Regulation.

Industrial property

Law 20-00 on industrial property establishes border measures against counterfeit trademarks, though the court may order any measure deemed necessary to prevent the infringement of industrial property rights under Articles 173(a) and 174(4).

Our legislation provides for no exceptions, though the goods concerned must be destined for the country.

Goods marketed in another country by the right holder are not subject to border measures, by virtue of Article 88 of Law 20-00 which reads as follows:

Article 88: Limitation of Rights by Exhaustion

- (1) The registration of a mark does not confer upon its owner the right to prohibit third parties from using the mark in relation to lawfully marked products that the owner or some person with his consent or with economic ties to him has introduced into trade, in the country or abroad, provided that those products and the containers or packaging that are in direct contact with them have not undergone any modification, alteration or deterioration.
- (2) Two persons shall be considered to have economic ties when one of the persons is able to exercise a decisive influence over the other, either directly or indirectly, with

respect to the use of the trademark or when a third party is able to exert that influence over both persons.

16. Provide a description of the main elements of the procedures relating to the suspension of the release of goods by customs authorities, in particular the competent authorities (Article 51), the requirements for an application (Article 52) and various requirements related to the duration of suspension (Article 55). How have Articles 53 (security or equivalent assurance), 56 (indemnification of the importer and of the owner of the goods) and 57 (right of inspection and information) been implemented?

Copyright

Law 65-00 provided the statutory right holder with an efficacious means of quickly averting damage that could prove irreparable, while making appropriate provisions to prevent the misuse of that power. Consequently, the request for the suspension of release by the customs authorities must be made either to the General Customs Directorate or to the competent Fiscal Attorney's Office, though it is the General Customs Directorate that is competent to order suspension of the release of the allegedly illicit goods, whether as a result of said request or ex officio.

We have previously stated that as regards the duration of suspension, paragraph I of Article 185 of Law 65-00 prescribes that after suspending the release of the goods, the General Customs Directorate must notify the requesting party and the importer or owner of goods of the period for which the suspension was granted, so as to allow the requesting party to file an action on the merits or to request other measures, and to allow the owner, importer or consignee of the goods to request a court of first instance in civil or criminal matters to revoke or modify the measures.

Pursuant to paragraph II of Article 185, the party who has successfully requested the measure through the courts must file an action on the merits of the case within not more than thirty (30) working days. If the suspension has been ordered through administrative channels, the time-limit for filing the action on the merits will be ten (10) working days, which may be extended by a further ten (10) days.

Border measures may be ordered by the competent courts at the request of a party. In such cases, the courts may require that the provisional measure to be implemented with regard to the goods in customs be subject to the posting of security or a guarantee.

Industrial property

Under Article 174 of Law 20-00 the courts are the authorities competent to order border measures, at the request of a right holder who shows that an infringement is imminent and provides a detailed description of the goods. The plaintiff must bring the main action within ten (10) days of the date of the order.

Subparagraph (6) of the same Article 174 provides for the security and indemnity to be set by the court handling the case. This must be not less than three times the value of the goods so as to cover the damages that could result if the alleged infringer were acquitted.

17. Describe provisions governing the length and cost of proceedings. Provide any available data on the actual duration of proceedings and their cost. How long is the validity of decisions by the competent authorities for the suspension of the release of goods into free circulation?

Copyright

Law 65-00 does not establish a time-frame within which the competent authorities must order suspension of the release of the goods, but once such suspension has been ordered, the General Customs Directorate must notify the right holder and the importer within a period not exceeding five (5) days of the length of time for which the suspension has been ordered. The party requesting the measure has thirty (30) days in which to file an action on the merits if the measure is obtained through judicial channels and ten (10) days, which may be extended by a further ten (10) days, if the measure has been ordered by the administrative authorities.

Industrial property

The duration of these measures is determined in a trial or ordered by the court. Law 20-00 merely establishes a time-frame of ten (10) days in which to bring the main action.

The cost of such proceedings may exceed that of ordinary proceedings because of the need to post the security or deposit determined by the court.

18. Are competent authorities required to act upon their own initiative and, if so, in what circumstances? Are there any special provisions applicable to ex officio action?

Copyright

Under Article 185, both the competent Office of the Fiscal Attorney and the General Customs Directorate may suspend, ex officio or at the request of the right holder, the release from customs of goods presumed to be illicit, provided that there are valid reasons for suspecting that the imported merchandise or goods for export are infringing copyright or related rights.

Article 111 of Regulation 362-01 empowers the National Copyright Office (ONDA), as the administrative authority, to take expeditious and efficacious preventive or provisional measures to prevent the infringement of any statutory rights and, in particular, to prevent the introduction into trade channels of suspected infringing goods, including steps to prevent the entry of imported goods. These measures may be applied ex officio or at the request of a party.

Industrial property

Pursuant to Articles 167 and 168 of Law 20-00, the administrative authorities are not empowered to act on their own initiative, instead it is the right holder who must initiate the action.

19. Describe the remedies that the competent authorities have the authority to order and any criteria regulating their use.

Copyright

As regards border measures, Law 65-00 merely mentions the power of the competent authorities (General Customs Directorate, the competent Office of the Fiscal Attorney and the National Copyright Office) to suspend the release from customs of illicit goods.

Industrial property

As for industrial property rights, the customs authorities may only enforce the orders of the court, that is, seize goods or release goods that have been seized.

Criminal procedures

20. Specify the courts which have jurisdiction over criminal acts of infringement of IPRs.

In committals to trial and criminal actions arising from infringements of Laws 65-00 on Copyright (Article 174) and 20-00 on Industrial Property (Article 166), the court of first instance is one of the correctional chambers of the Court of First Instance of the domicile of the defendant, in keeping with ordinary rules of procedure. Appeals against the findings of these courts are heard by the Civil Chamber of the Court of Appeal of the corresponding judicial district, whose sentences may be appealed in judicial review proceedings before the Supreme Court of Justice.

Civil actions may be conducted simultaneously with criminal ones, under the terms of Article 3 of our Code of Criminal Procedure, which reads as follows:

Article 3: Civil proceedings may be brought concurrently with public proceedings and before the same judges. The civil suit may also be brought separately, in which case it is suspended until a definitive decision is taken regarding any public action brought prior to or during the civil proceeding.

21. In respect of which infringements of which intellectual property rights are criminal procedures and penalties available?

Copyright

Article 169 of Law 65-00 sets out at length the cases in which a person's acts constitute an infringement of the law.

In brief, persons who in any way use (distribute, modify, reproduce, communicate, etc.), without the permission of the author or his authorized representative, a literary, artistic or scientific work, an artistic performance, a phonographic production or a radio broadcast will be liable to prison sentences ranging from three (3) months to three (3) years and a fine of 50 to 1,000 minimum wages. Article 169 of the Law contains a long list of offences that carry these penalties.

Furthermore, Article 170 of the Law provides for fines of 10 to 50 minimum wages for those who, being authorized to publish a work, do so without meeting the requirements of the law or who, in publishing the work, engage in acts that go beyond those expressly authorized.

In cases of repeat infringements, the maximum prescribed penalties are applied and if the illegal act has seriously jeopardized the livelihood of the aggrieved party, the fines are increased to up to three times the amount of the material damage caused. The court may not impose fines lower than the permitted minimum, even when there are attenuating circumstances.

The court may order that the equipment used to commit the unlawful act be destroyed or handed over to the plaintiff.

Industrial property

Article 166 of the Law prescribes prison sentences ranging from three months to two years, characterizing the offences as follows:

- The use of an identical sign, direct copy or fraudulent imitation, without the consent of the owner;

- the use of an identical name for an identical or related business, without the consent of the owner;
- the use of a distinctive or similar sign liable to cause confusion;
- a false geographical indication that could mislead the public;
- the use of a false designation of origin;
- the continued use or marketing of the trademark in spite of an administrative sanction (cancellation);
- the offering for sale of patented products without consent of the patent holder;
- the use of patented processes without the consent of the patent holder;
- the reproduction or imitation of industrial designs without the consent of the owner;
- the use of designations that are likely to mislead the public;
- the concealment of information or the furnishing of false information to a National Industrial Property Office.

22. Which public authorities are responsible for initiating criminal proceedings? Are they required to do this on their own initiative and/or in response to complaints?

Copyright

In keeping with Article 175 of Law 65-00, criminal proceedings arising from infringements of the Law may be initiated by anyone and in all cases may be initiated ex officio, even in the absence of a criminal complaint or allegation.

Article 173 (paragraphs I and II) of the Law mentions the power granted to the competent Fiscal Attorney's Office to seize illicit goods and/or the equipment used to carry out unlawful acts, without notifying or hearing the other party and at any stage of the proceedings, even before the start of the criminal trial, at the request of a party. It is also empowered to carry out any investigations and expert examinations deemed necessary to determine the existence of the infringing materials, wherever they may be.

Article 118 of Regulation 362-01 implementing Law 65-00 provides that when the facts forming the subject of the administrative procedure constitute a suspected offence, ONDA may file a criminal complaint with the Office of the Attorney General.

To sum up, civil proceedings must be initiated by the interested party, while criminal proceedings may be initiated by the interested party or by the representative of the Office of the Attorney General, whether as a result of its own findings or by virtue of a complaint filed by ONDA.

Industrial property

Actions must be initiated by the right holder pursuant to Article 167 of Law 20-00.

In the event of a flagrant offence, the Fiscal Attorney of the Judicial District may initiate public proceedings under the rules of ordinary law.

23. Do private persons have standing to initiate criminal proceedings and, if so, who?

Copyright

Pursuant to Article 175 of Law 65-00, actions arising as a result of infringements of the Law may be brought by the holder of the copyright or a related right, his successors in title, or their contractual representative, in all cases in which such rights are infringed.

Industrial property

Under the terms of Article 167, only right holders or their representatives or licensees have standing to initiate proceedings.

24. Specify, by category of IPR and type of infringement where necessary, the penalties and other remedies that may be imposed:

- **Imprisonment;**
- **monetary fines;**
- **seizure, forfeiture and destruction of infringing goods and materials and implements for their production;**
- **other.**

Copyright

Prison sentences ranging from three months to three years and fines of 50 to 1,000 minimum wages are imposed on anyone who:

- In connection with a work protected by copyright or related rights, registers or broadcasts it by any means as his own, in whole or in part, verbatim or while attempting to conceal it by modifications, deletions, attributing to himself or to some other party another's authorship or ownership.
- In relation to a work subject to copyright or related rights and without express permission, modifies, reproduces, distributes, communicates to the public or broadcasts it, or having obtained permission, reproduces, communicates to the public or distributes it in greater numbers than expressly authorized or after the expiry of the term of assignment or licence granted.
- Publishes or discloses an unpublished work without due authorization.
- Falsely attributes to himself the status of holder, whether original or derived, of any of the rights recognized under the law, and by virtue of that false attribution causes the competent authority to suspend the communication, reproduction or distribution of the work, performance or production.
- Communicates, reproduces or distributes by any means a work protected by copyright or related rights, removing or changing the name or pseudonym of the author or right holder.
- Communicates, reproduces or distributes by any means a work subject to copyright or related rights, making alterations or deletions that could prejudice the integrity of the work or the reputation of its owner.

- Makes false statements concerning the certification of income, public attendance, the repertoire used, the identity of the author or right holder, or the number of copies reproduced or distributed or adulterates particulars in any other way liable to prejudice the holder of the rights recognized under the law.
- Manufactures, assembles, imports, modifies, sells or in any way places in circulation devices or systems designed to deactivate other security systems intended to prevent the violation of the law.
- Alters, removes or circumvents devices put in place to prevent the reproduction or communication to the public of works protected by law.
- Removes or alters without authorization any electronic information concerning the collective management of rights, or markets works knowing that this information has been removed or altered without authorization.
- Uses in any other way a work protected by copyright or related rights so as to infringe one of the proprietary rights recognized under the law.

Fines of 10 to 50 minimum wages shall be imposed on anyone who:

- Being authorized to publish a work, does so without mentioning the name of the author or right holder, or does so with deletions or additions that adversely affect his reputation; publishes the work with abridgements, additions or deletions; or publishes several works separately, when authorization has been given for their joint publication, or vice versa.
- Abuses the right of quotation (fair use).
- Uses, modifies or changes the title of a work.
- Is responsible for refusal to pay the right holder for authorized communication to the public.
- Includes on the cover or sleeve of the phonogram legends that mislead the public with regard to the edition of the phonogram in question.
- Fails to comply with the specifications set forth in the law for copies of an edition or production of a phonogram.
- Omits the mandatory announcements under the terms of a performance contract.
- Fails to fulfil the obligations to prepare and submit performance schedules for communicating musical works to the public.

In cases of repeat infringements, the maximum penalty must be imposed, and the courts may not reduce the penalties below the legal minimum, even in the presence of attenuating circumstances.

All unlawful reproductions will be confiscated and awarded in the guilty verdict to the right holder unless it is ordered that they be destroyed. The materials and equipment used will also be confiscated and destroyed or handed over to the injured party, all of this without prejudice to any civil suit for damages which the latter may bring against the infringer under Article 173 of the Law.

In previous replies we have mentioned the power of both the National Copyright Office and the competent Fiscal Attorney's Office to attach, confiscate and destroy the infringing goods, as well as the materials and equipment used to produce them.

Industrial property

Article 166 sets forth the following penalties:

Article 166: Penalties

Prison sentences of three months to two years or fines of ten to fifty minimum wages or both shall be imposed on anyone who wilfully:

- (a) Without the consent of the owner of a distinctive sign, makes commercial use of an identical sign or a registered trademark or a direct copy or fraudulent imitation thereof, in relation to products or services that it distinguishes, or to related products or services;
- (b) without the consent of the owner of a distinctive sign, commits the following acts in relation to a trade name, title or emblem:
 - (i) makes commercial use of an identical distinctive sign for an identical or related business;
 - (ii) makes commercial use of a similar distinctive sign when it is likely to create confusion;
- (c) makes commercial use in relation to the product or service of a geographical indication that is false or likely to mislead the public as to the origin of that product or service or as to the identity of the producer, manufacturer or supplier of the product or service;
- (d) makes commercial use in relation to a product of a false or misleading appellation of origin, even where the true origin of the product is indicated, or the appellation is used in translation or accompanied by expressions such as "type", "kind", "style", "imitation" or the like;
- (e) continues to use an unregistered trademark confusingly similar to another registered trademark or after the administrative penalty imposed for this reason has become definitive;
- (f) offers products for sale or introduces them into circulation or provides services with the trademarks referred to in connection with the previous infringement;
- (g) manufactures or develops products protected by a patent or a utility model, without the consent of their owner or without the appropriate licence;
- (h) offers for sale or introduces into circulation products covered by a patent or a utility model, knowing them to have been manufactured or prepared without the consent of the holder of the patent or registration or without the appropriate licence;
- (i) uses patented processes without the permission of the patent holder or without the appropriate licence;

- (j) offers for sale, sells or uses, imports or stocks goods that are the direct result of the use of patented processes, knowing them to have been used without the consent of the owner of the patent or of the licensee;
- (k) reproduces or imitates industrial designs protected by registration, without the consent of the owner or without the appropriate licence;
- (l) without being the owner of a patent or utility model or enjoying the rights conferred thereby, makes use in his products or his advertising of appellations that could mislead the public as to the existence thereof;
- (m) conceals information from the National Industrial Property Office or furnishes it with false information in order to obtain a patent that does not meet the requirements of patentability.

PARAGRAPH: Liability for the acts described above extends to persons who order them or arrange for them to be carried out, the legal representatives of juridical persons and all those who, knowing the act to be illegal, take part in, facilitate or conceal it.

Other measures

Penalties are prescribed in Article 173(d) and (e) of Law 20-00, which provides for the appropriation of the objects seized and for their destruction.

25. Describe provisions governing the length and any cost of proceedings. Provide any available data on the actual duration of proceedings and their cost, if any.

Laws 20-00 on Industrial Property and 65-00 on Copyright do not stipulate any length of time for the duration of criminal proceedings and the Constitution of the Republic establishes that justice shall be free of cost.

In practice, criminal proceedings last longer than civil proceedings, although this will always depend on the diligence of the lawyers handling the case, and the real costs are lower than those of civil proceedings as the summonses are served at the request of the Office of the Public Prosecutor and the proceedings are oral and subject to fewer formalities.

Lawyers' fees are regulated by the provisions of the Lawyers' Fees Act. However, the overall cost will always depend on the nature of the suit and any interlocutory matters arising during the proceedings.
