

**CHECKLIST OF ISSUES ON ENFORCEMENT<sup>1</sup>**

Replies by El Salvador

**Civil and Administrative Procedures and Remedies**

(a) Civil judicial procedures and remedies

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

IPR infringement cases fall within the jurisdiction of the commercial courts.

This is based on Article 184 of the Law on the Promotion and Protection of Intellectual Property, which establishes the jurisdiction of the commercial courts, assuming no special courts are created with jurisdiction over intellectual property matters.

It is also based subsidiarily on Article 67 of the Central American Convention for the Protection of Industrial Property and Legislative Decree No. 85 ratifying that Convention, which regulates issues relating to marks, trade names and advertizing slogans or signs as well as indications of source and appellations of origin.

Cases are brought before the following judicial bodies:

- Trade courts of first instance, which hear at first instance any court cases brought within the territory corresponding to their jurisdiction, and at second instance in cases and areas determined by the law (see Articles 16, 59 and 60 of the Organic Judicial Law).

Similarly, Article 15 of the Organic Judicial Law stipulates that the civil courts shall also have jurisdiction over trade matters in the municipalities in which there are no trade courts.

- Chambers of second instance, which have jurisdiction over:
  - Cases corresponding to the territory assigned to them, heard at first instance by the respective courts:
    - on appeal;
    - on remedy of review of leave to appeal;
    - for consultation;

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<sup>1</sup> Document IP/C/5.

- for review,
- Special complaint proceedings for delay of justice or other infringement;
- other cases as determined by the law.

The above is based on Article 57 of the Organic Judicial Law.

- Civil Division of the Supreme Court of Justice (see paragraph 1 of Article 54 of the Organic Judicial Law) which handles, *inter alia*, judicial review proceedings relating to trade matters.

**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?**

Standing

Any natural or legal person who is an IPR right holder has standing to assert his right in accordance with Article 90 of the Law on the Promotion and Protection of Intellectual Property and Articles 5 and 67 of the Central American Convention for the Protection of Industrial Property, which also confers standing upon the Government Procurator's Office in cases of infringement of rights to distinctive commercial signs, and indications of source and appellations of origin.

It should also be mentioned that Article 100 of the Law on the Promotion and Protection of Intellectual Property stipulates that collective management entities shall have standing, in accordance with their own articles of association and the contracts concluded with foreign entities, to exercise the rights they are called upon to administer and to assert them as legal representatives in any type of administrative or judicial procedure.

Representation

A right holder who is a natural person may act on his own behalf pending the signature and stamp of the Chief Attorney, in accordance with Articles 98 and 104 of the Code of Civil Procedure, or through a solicitor, who must be an attorney, in accordance with Articles 99 and 101.

A right holder that is a legal person may act through a legal representative, pending the signature and stamp of the Chief Attorney, in accordance with Article 104 of the above-mentioned Code, or through a solicitor, who must be an attorney, in conformity with Articles 99 and 100.

Mandatory personal appearance

In proceedings before the courts, personal appearance of the right holder is not mandatory with the exception of cases in which one of the parties has requested that the opposing party reply to interrogatories (deposition).

In this respect, Article 376 of the Code of Civil Procedure stipulates that as soon as a case is brought to trial at first instance, the parties may, at the other instances involved and at any stage prior to judgment, even where there is no further admission of evidence, request in the form of interrogatories, written and not oral, sworn statements on personal matters pertaining to the case at issue, known as pleadings.

On the same subject, Article 378 of the Code of Civil Procedure states that the party shall reply personally to the interrogatories when the requesting party so requires, even when represented by an attorney with special powers.

**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?**

Under Article 237 of the Code of Civil Procedure, the obligation to produce evidence lies with the claimant. However, Article 156 establishes the right of all persons to request that the other party produce, before the competent judge, the public or private documents, or moveable goods required for the preparation of an action or to defend itself against the action brought against it.

Likewise, Article 21(1) of the Law on Commercial Procedures requires, before an action can be brought, *inter alia*, the display before the court of objects constituting evidence of unfair competition. Such display is to take place in accordance with the article mentioned in the paragraph above.

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

Confidential information brought forward as evidence in the proceedings is protected under the second paragraph of Article 177 of the Law on the Promotion and Protection of Intellectual Property, which stipulates that information supplied to any authority by a person holding it as an industrial or trade secret shall not be considered as coming under the public domain or disclosed by operation of the law when it is supplied for the purposes of obtaining licences, permits, authorizations, registration or any other official documents.

Similarly, Article 1245 of the Code of Civil Procedure stipulates that the courts, judges and secretaries shall not give the parties access to the court records or communicate any document presented during the proceedings except under signed authorization by the party and subject to a court order. However, the litigating parties and their attorneys may apply to the appropriate offices for consultation of the court records and such documents as they wish to consult, and to take notes or private copies thereof, as long as in either case they are public, thus ensuring that the confidential information is safeguarded.

**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 attorneys' fees;**
- **destruction or other disposal of infringing goods and materials/implements for their production;**
- **any other remedies.**

Copyright and neighbouring rights

The remedies or decisions that may be ordered by the judicial authorities at the request of the holder in respect of copyright or neighbouring rights are the following:

- Preventive seizure of the liquid revenue obtained through the unlawful use (Article 91(a) of the Law on the Promotion and Protection of Intellectual Property);
- preventive seizure of unlawfully reproduced copies (Article 91(b)), Law on the Promotion and Protection of Intellectual Property;
- suspension of unauthorized reproduction, communication or distribution activities, as appropriate (Article 91(c) of the Law on the Promotion and Protection of Intellectual Property);
- prohibition of the import or export of unlawfully reproduced copies by order to the Directorate-General of Customs Revenue (Article 91(d) of the Law on the Promotion and Protection of Intellectual Property);
- cessation of the violation of the rights (Article 90 of the Law on the Promotion and Protection of Intellectual Property), i.e:
  - Immediate suspension of the unlawful activity;
  - prohibition of the infringer from resuming it;
  - withdrawal from the market of the unlawful copies;
  - disablement and where necessary, destruction of moulds, plates, printing blocks, negatives and other elements used predominantly for unlawful reproduction;
  - removal or keeping under lock and seal of the equipment used for unauthorized public communication.
- destruction of the unlawful copies or delivery up thereof, together with the materials used for reproduction at cost price and on account of the corresponding damages (Article 90 of the Law on the Promotion and Protection of Intellectual Property);
- compensation for damages and injury (Article 90 of the Law on the Promotion and Protection of Intellectual Property). With respect to loss of earnings, damages are calculated on the basis of one of the following criteria at the discretion of the injured party:
  - The profits that the right owner would presumably have earned if the infringement had not occurred;
  - the profits actually earned by the infringer as a result of the infringing acts;
  - the price or royalty that the infringer would have paid to the right owner if a contractual licence had been agreed upon, due regard being had to the commercial value of the subject-matter of the rights infringed and the contractual licences already granted.

#### Industrial property

The remedies or decisions that may be applied by the judicial authorities at the request of the holder in respect of industrial property rights are as follows:

Patents, utility models and industrial designs

- Claiming of the right when a patent or industrial design registration has been requested or obtained by a person who does not have a right thereto or to the detriment of another person who does have a right to obtain the patent or registration (Article 168 of the Law on the Promotion and Protection of Intellectual Property);
- cessation of the act or acts which infringe the right conferred by a patent or industrial design registration (Article 172 of the Law on the Promotion and Protection of Intellectual Property);
- compensation for damages suffered as a result of the infringement of a right conferred by a patent or industrial design registration (Article 172 of the Law on the Promotion and Protection of Intellectual Property). The calculation of damages as regards compensation for loss of earnings is based on the following criteria, at the discretion of the injured party:
  - The profits that the right owner would presumably have earned if the infringement had not occurred;
  - the profits actually earned by the infringer as a result of the infringing acts;
  - the price or royalty that the infringer would have paid to the right owner if a contractual licence had been agreed upon, due regard being had to the commercial value of the subject-matter of the rights infringed and the contractual licences already granted.
- seizure of the goods resulting from the infringement and the means used predominantly to commit the infringement of a right conferred by a patent or registration of an industrial design (Article 172 of the Law on the Promotion and Protection of Intellectual Property);
- transfer of ownership of the above-mentioned objects or means, in which case the value of the goods shall be deducted from the amount of the damages (Article 172 of the Law on the Promotion and Protection of Intellectual Property);
- measures necessary to prevent the continuation or repetition of the infringement, including destruction of the means seized under the relevant paragraph above where necessary (Article 172 of the Law on the Promotion and Protection of Intellectual Property);
- as a precautionary measure, the immediate cessation of the infringing acts may be ordered (Article 174 of the Law on the Promotion and Protection of Intellectual Property).
- as a precautionary measure, the preventive seizure, withholding or deposit of the infringing goods and the means used predominantly to commit the infringement may be ordered (Article 174 of the Law on the Promotion and Protection of Intellectual Property);

Industrial or trade secrets

- Compensation for damages through the use for commercial purposes or disclosure without justification and without the consent of the holder or authorized user of the secret (Article 180 of the Law on the Promotion and Protection of Intellectual Property);
- compensation for damages resulting from the unlawful procurement of information containing an industrial or trade secret (Article 180 of the Law on the Promotion and Protection of Intellectual Property).

Distinctive commercial signs

- Immediate cessation of the use or unlawful imitation of a mark (Article 26 of the Central American Convention for the Protection of Industrial Property);
- prohibition of the import or entry of merchandise or products as long as they continue to display a misused mark (Article 26 of the Central American Convention for the Protection of Industrial Property);
- recovery of damages caused by the misuse of a mark (Article 26 of the Central American Convention for the Protection of Industrial Property);
- cessation of the misuse or unlawful imitation of a trade name (Article 53 of the Central American Convention for the Protection of Industrial Property);
- recovery of damages caused by the misuse of a trade name (Article 53 of the Central American Convention for the Protection of Industrial Property);
- cessation of the misuse or unlawful imitation of an advertising slogan or sign (Articles 64 and 26 of the Central American Convention for the Protection of Industrial Property);
- prohibition of the import or entry of merchandise or products as long as they display a misused advertising slogan or sign (Articles 64 and 26 of the Central American Convention for the Protection of Industrial Property);
- recovery of damages caused by the misuse of an advertising slogan or sign (Articles 64 and 26 of the Central American Convention for the Protection of Industrial Property);
- in the case of acts of unfair competition, such prudential court orders as the judge may deem appropriate for the adequate protection of the rights of the complainant, of consumers and of the competitors, including the preventive seizure or confiscation of the merchandise in question (Articles 65, 66 and 68 of the Central American Convention for the Protection of Industrial Property);
- in cases of unfair competition, recovery of damages (Article 70 of the Central American Convention for the Protection of Industrial Property).

Indications of source and appellations of origin

- In the case of acts of unfair competition, such prudential court orders as the judge may deem appropriate for the adequate protection of the rights of the complainant, of consumers and of the competitors, including the preventive seizure or confiscation of the merchandise in question (Articles 77 and 68 of the Central American Convention for the Protection of Industrial Property);
- in cases of unfair competition, recovery of damages (Articles 77 and 70 of the Central American Convention for the Protection of Industrial Property).

Draft law on marks and other distinguishing signs

In accordance with the section entitled Actions and Penalties for the Violation of Rights of the draft Law on Marks and Other Distinctive Signs, the following measures may be imposed in case of infringement of rights regarding distinctive commercial signs, and geographical indications and appellations of origin:

- Seizure of the infringing goods, including packaging, wrapping, labelling, printed or advertising materials or other materials resulting from the infringement or used to commit the infringement, and the means that served principally to commit the infringement;
- prohibition of the import of the goods, materials or the means referred to in the previous indent;
- attribution of ownership of the goods, materials or means referred to in the first indent, in which case the value of the goods shall be deducted from the amount of the damages;
- such measures as are required to prevent the continuation or repetition of the infringement, including the destruction of the goods, materials or means referred to in the first indent;
- cessation of the infringing acts;
- compensation for damages, which are calculated, *inter alia*, in accordance with the following criteria:
  - loss of earnings by the right holder as a result of the infringement;
  - amount of the profits earned by the infringer as a result of the infringing acts; and
  - the price which the infringer would have paid if a contractual licence had been agreed upon, due regard being had to the commercial value of the right infringed and the contractual licences already granted;
- publication of the sentence and notification thereof to interested persons at the cost of the infringer;
- as a precautionary measure, immediate cessation of the infringing acts;

- as a precautionary measure, seizure with inventory, description or deposit of the goods, packaging, labels or other materials displaying the infringing sign and the means principally used to commit the infringement;
- as a precautionary measure, suspension of the import or export of the goods, materials or means referred to in the previous indent;
- as a precautionary measure, provision of a security or other guarantee of payment of any possible damages by the alleged infringer;
- as a precautionary measure, communication by the alleged infringer of any information he may have concerning persons who participated in the production or marketing of the infringing goods or services and the distribution channels for such goods or services.

**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 goods or services found to be infringing and of their channels of distribution?**

In accordance with the provisions in the Code of Civil Procedure concerning depositions (Article 376), the judge, as soon as the case is brought to trial at first instance, may order a party, at the request of the other party, to answer interrogatories, in which case the third parties involved in the infringement of the rights in question must be identified together with the channels of distribution used.

In this connection it should be noted that under Article 385 of the Code of Civil Procedure, the party asked to answer the interrogatories shall be considered to have confessed:

- (1) If he fails to appear on the second citation without reasonable cause;
- (2) if he refuses to give evidence or take oath;
- (3) if his replies are evasive and are not complete and final.

At the same time, the second paragraph of Article 89 of the draft Law on Marks and Other Distinctive Signs gives the judicial court the power to order the infringer to provide any information in his possession concerning persons involved in the production or marketing of the infringing goods or services and their channels of distribution.

**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?**

Indemnification of defendants wrongfully enjoined

Under Article 439 of the Code of Civil Procedure, any complainant who is unable to prove his case at first instance or who abandons his action shall be ordered to pay the costs. The same article stipulates that if the proceedings reveal that one of the parties not only failed to prove his case or substantiate his claim, but in fact acted with intent or is unfit, that party shall also be ordered to pay damages.



At the same time, Article 91 of the Law on the Promotion and Protection of Intellectual Property stipulates that persons requesting prudential measures in connection with copyright infringements must file the corresponding complaint within eight days following the date on which the measures were ordered, failing which they shall be liable for damages.

Similarly, Article 174 of the above-mentioned Law provides for the application of immediate precautionary measures in cases of infringement of industrial property rights protected thereunder, with the possibility of making such measures contingent on the provision of a sufficient security. The same article also stipulates that if the action for infringement is not brought within ten working days following the imposition of the measure, the measure shall cease to have effect and the complainant shall be liable for damages.

Article 23 of the Law on Commercial Procedure, for its part, gives the judge the authority to order the payment of a security for the potential damages resulting from the display in court of the goods proving unfair competition referred to in paragraph 1 of Article 493 of the Commercial Code, which covers the misuse of distinctive commercial signs.

According to Article 239 of the Constitution, judges and public officials alike are responsible for governmental offences committed in the exercise of their duties and shall be judged for such governmental offences as they commit by the common courts.

Similarly, Article 245 stipulates that public officials and employees shall be personally liable and the State subsidiarily liable for material or moral damages caused as a result of violation of the rights enshrined in the Constitution.

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

Article 182(5) of the Constitution stipulates that the Supreme Court of Justice shall ensure that justice is administered rapidly and completely, to which end it shall adopt such measures as it deems necessary.

In accordance with the above and with Article 184 of the Law on the Promotion and Protection of Intellectual Property as well as Article 2 of the Law on Commercial Procedure, complaints with respect to intellectual property infringements shall be dealt with by summary procedure.

In this respect, Article 59 of the Law on Commercial Procedure establishes the rules governing summary procedures, referring to the provisions of Articles 975, 976 and 977 of the Code of Civil Procedure:

Article 975: The complaint shall be transmitted for a period of three days to the opposing party, and, upon receipt of the said party's reply or by default, the evidence shall be admitted for a period of eight days together with all of the charges if necessary. Once those eight days have elapsed, a judgement shall be handed down in accordance with the law and without further formalities or procedures

Article 976: In all summary proceedings, objections shall be put forward and substantiated as indicated in Article 483.

Article 977: As a rule, in summary proceedings, provided the dispute concerns the application of the law to the matter under question and once the facts have been substantiated

by the public records that have not been refuted, or provided the parties expressly so agree evidence shall not be required.

The actual duration of commercial summary proceedings, taking account of motions filed during the course of the proceedings or appeals lodged in connection with the pleas or motions resolved therein, may be up to a year and a half.

Article 181 of the Constitution stipulates that the administration of justice shall be free of charge.

On the other hand, the right holder shall be responsible for paying the fees of the Chief Attorney or prosecutor he appoints. Since El Salvador has an outdated system of fees, these are normally determined by agreement.

It is therefore extremely difficult to establish the costs of such proceedings, since they vary from case to case.

(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.**

**9.1 Specify the courts which have jurisdiction over IPR infringement cases.**

With respect to copyright and neighbouring rights, Article 98(b) of the Law on the Promotion and Protection of Intellectual Property states that the Commercial Registry shall be responsible for serving as an arbitrator, when the interested parties so request, in disputes which arise between right holders, between collective management entities, between the latter and their partners or representatives and between the management entities and right holders or users of works, performances or productions protected under Title II of the said Law related to artistic, literary or scientific property.

It should be noted that in such cases, the interested parties retain the right to apply to the competent court where they do not agree with the decision of the Registrar.

With respect to industrial property, objections to registrations of marks, trade names and advertising slogans or signs are substantiated before the Commercial Registry in accordance with Articles 97 *et seq.* of the Central American Convention for the Protection of Industrial Property.

**9.2 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?**

Proceeding from the previous reply and in conformity with the above-mentioned Article 98 of the Law on the Promotion and Protection of Intellectual Property, the persons who have standing to assert IPRs in an arbitration before the Commercial Registry are:

- The holders of such rights;
- collective management entities;
- partners or representatives of the management entities;

- users of the works, performances or productions protected under Title II of the said Law relating to artistic, literary or scientific property.

### Industrial property

With respect to the procedure for filing an objection to the registration of marks, trade names and advertising slogans or signs, Article 97 of the Central American Convention for the Protection of Industrial Property states that any person claiming to have a legitimate interest may oppose an application for registration and object to the granting thereof.

Similarly, the above-mentioned provision states that the objecting party may appear in person with the assistance of an attorney or may be represented by an agent who must also be an attorney.

There are no provisions which provide for mandatory personal appearances by the right holder.

### **9.3 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?**

The administrative authorities have no authority to order, at the request of an opposing party, a party to a proceeding to produce evidence which lies within its control.

### **9.4 What means exist to identify and protect confidential information brought forward as evidence?**

Confidential information brought forward as evidence in the proceedings is protected under the second paragraph of Article 177 of the Law on the Promotion and Protection of Intellectual Property, which stipulates that information supplied to any authority by a person holding it as an industrial or trade secret shall not be considered as coming under the public domain or disclosed by operation of the law when it is supplied for the purposes of obtaining licences, permits, authorizations, registration or any other official documents.

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

In the area of copyright, the issue of the resolution under the arbitration procedure referred to in Article 98(b) of the Law on the Promotion and Protection of Intellectual Property.

In the industrial property area, settlement of the objection in conformity with Article 106 of the Central American Convention for the Protection of Industrial Property.

### **9.6 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?**

The administrative authorities do not have such authority.

### **9.7 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?**

Under Article 439 of the Code of Civil Procedure, any complainant who is unable to prove his case at first instance or who abandons his action shall be ordered to pay the costs. The same Article stipulates that if the proceedings reveal that one of the parties not only failed to prove his case or substantiate his claim, but in fact acted with intent or is unfit, that party shall also be ordered to pay damages.

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

Since Article 98(b) of the Law on the Promotion and Protection of Intellectual Property does not provide any details on the arbitration procedure provided for therein, the procedure is governed by the provisions on arbitration procedures in Articles 56 *et seq.* of the Code of Civil Procedure.

It should also be noted that since this type of procedure is not commonly used, it is extremely difficult to provide any data on its duration and cost.

**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 and neighbouring rights

The provisional measures that may be applied by the judicial authorities with respect to copyright and neighbouring rights are as follows:

- Preventive seizure of the liquid revenue obtained through the unlawful use (Article 91 of the Law on the Promotion and Protection of Intellectual Property);
- preventive seizure of unlawfully reproduced copies (Article 91 of the Law on the Promotion and Protection of Intellectual Property);
- suspension of the unauthorized reproduction, communication or distribution activities, as appropriate (Article 91 of the Law on the Promotion and Protection of Intellectual Property);
- prohibition of the import or export of unlawfully reproduced copies by order to the Directorate-General of Customs Revenue (Article 91 of the Law on the Promotion and Protection of Intellectual Property).

Industrial property

The provisional measures that may be applied by the judicial authorities with respect to industrial property rights are as follows:

Patents, utility models and industrial designs

- As a precautionary measure, the immediate cessation of the infringing acts may be ordered (Article 174 of the Law on the Promotion and Protection of Intellectual Property);

- as a precautionary measure, the preventive seizure, withholding or deposit of infringing goods and the means used predominantly to commit the infringement may be ordered (Article 174 of the Law on the Promotion and Protection of Intellectual Property).

#### Distinctive commercial signs

- Prohibition of the import or entry of merchandise or products as long as they continue to display a misused mark (Article 26 of the Central American Convention for the Protection of Industrial Property);
- prohibition of the import or entry of merchandise or products as long as they continue to display a misused advertising slogan or sign (Articles 64 and 26 of the Central American Convention for the Protection of Industrial Property);
- in the case of acts of unfair competition, such prudential court orders as the judge may deem appropriate for the adequate protection of the rights of the complainant, of consumers and of the competitors, including the preventive seizure or confiscation of the merchandise in question (Articles 65, 66 and 68 of the Central American Convention for the Protection of Industrial Property).

#### Indications of source and appellations of origin

- In the case of acts of unfair competition, such prudential court orders as the judge may deem appropriate for the adequate protection of the rights of the complainant, of consumers and of the competitors, including the preventive seizure or confiscation of the merchandise in question (Articles 77 and 78 of the Central American Convention for the Protection of Industrial Property).

#### Draft Law on Marks and Other Distinctive Signs

In accordance with the section entitled Actions and Penalties for the Violation of Rights of the draft Law on Marks and Other Distinctive Signs, the following measures may be imposed in case of infringement of rights regarding distinctive commercial signs, and geographical indications and appellations of origin:

- Immediate cessation of the infringing act;
- seizure with inventory, description or deposit of the goods, packaging, labels or other materials displaying the infringing sign and the means principally used to commit the infringement;
- suspension of the import or export of the goods, materials or means referred to in the previous indent;
- provision of a security or other guarantee of payment of any possible damages by the alleged infringer;
- communication by the alleged infringer of any information he may have concerning persons who have participated in the production or marketing of the infringing goods or services and the distribution channels for such goods or services.

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

With respect to copyright, Article 91 of the Law on the Promotion and Protection of Intellectual Property stipulates that the judge may order, at the request of the holder of the infringed rights and subject to the provision of a security, such prudential measures as are necessary for the urgent protection of such rights, to be imposed without notice to the infringer.

Similarly, Article 174 of the said Law stipulates that in cases of infringement of industrial property rights protected thereunder, the judge may order, with immediate effect, such precautionary measures as are necessary to ensure the effectiveness of the infringement proceedings or the recovery of damages.

In addition, Article 148 of the Code of Civil Procedure states that it is not necessary to name the person in respect of whom attachment is requested to order such measure.

**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.**

Copyright and neighbouring rights

Under Article 91 of the Law on the Promotion and Protection of Intellectual Property, any right holder, who considers that his copyright has been violated may ask the judge to order such prudential measures as are necessary to protect that right.

In such cases, the judge shall verify the violation of the right or the existence of a justified fear that such violation will occur or a violation already committed might be repeated, together with the validity of the complainant's claims, following which, and subject to the provision of a security, he shall order such prudential measures as the circumstances require.

This procedure is initiated through a written application by the complainant. The application may be submitted before or together with the main complaint. If the measures are requested prior to the complaint, the complaint must be filed within eight days following the granting of the measures, failing which the complainant shall be liable for the damages caused.

Patents, utility models and industrial designs

Article 174 of the Law on the Promotion and Protection of Intellectual Property stipulates that an industry property right holder protected thereunder may ask the judge, prior to or together with the request, to order immediate precautionary measures to ensure the effectiveness of the proceedings or the recovery of damages. Such precautionary measures may be made contingent on the provision of a sufficient security.

If the infringement action is not brought within ten working days following the imposition of a precautionary measure, the measure will cease to have effect and the complainant will be liable for the damages.

Distinctive commercial signs, indications of source and appellations of origin

Article 68 of the Central American Convention for the Protection of Industrial Property stipulates that once the action for unfair competition has been brought, the judge or authority concerned may order, subject to the provision by the complainant of a security to cover damages, such prudential measures as he deems appropriate for the adequate protection of the rights of the

complainant, of consumers and of the competitors, including the preventive seizure or confiscation of the merchandise in question, and to ensure the suspension of the acts which gave rise to the action or the return to the state of affairs prior to the commission of the acts of unfair competition.

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

As a rule, a provisional measure is ordered by the judge for a period of one to two weeks.

As regards the cost of the proceedings, the right holder must pay the fees of the Chief Attorney or prosecutor he appoints. Since El Salvador has an outdated system of fees, these are normally determined by agreement.

It is therefore extremely difficult to establish the costs of such proceedings, since they vary from case to case.

(b) Administrative measures

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

The administrative authorities do not have the authority to order provisional measures, which are handled by the judicial authorities.

**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 trade mark 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?**

The intellectual property right holder may ask the judge to prohibit the import of any products which infringe that right. Such measure will be ordered by the judge once he has established the ownership of the right by the complainant and such other circumstances as are provided for in each particular case.

**Copyright**

Article 91 of the Law on the Promotion and Protection of Intellectual Property stipulates that in the event of a violation of rights, or where there is a justified fear that such a violation might occur or a violation already committed might be repeated, the judge may, on verification of the prior circumstances and the validity of the complainant's claim, prohibit, *inter alia*, the import or export of unlawfully reproduced copies by order to the Directorate-General of Customs Revenue.

**Patents, utility models and industrial designs**

Article 174(b) of the Law on the Promotion and Protection of Intellectual Property states that the holder of an industrial property right protected thereunder may ask the judge to order, among other

precautionary measures, the preventive seizure, detention or deposit of the infringing goods and the means predominantly used to commit the infringement.

#### Distinctive commercial signs

Article 26 of the Central American Convention for the Protection of Industrial Property establishes the right of the holder of a registered mark to have the competent authorities prohibit the import or entry of the merchandise or products as long as they continue to display that mark.

Similarly Article 92 of the draft Law on Marks and Other Distinctive Signs states that the precautionary measures to be applied at customs shall be implemented by the customs authorities upon import or export of the infringing goods, materials or means.

The law also provides that products carrying unlawful distinctive signs, advertising material referring to such signs and the materials and means used to commit the infringement shall be detained or confiscated by the competent customs or police authorities pending the results of the corresponding procedure.

#### Indications of source and appellations of origin

According to Articles 77 and 68 of the Central American Convention for the Protection of Industrial Property, when an action has been brought for unfair competition, the judge may order such prudential measures as he deems appropriate to provide adequate protection for the rights of the complainant, consumers and the competitors.

#### Imports excluded from the application of border measures

With respect to imports excluded from the application of the above-mentioned procedure, it should be noted that *de minimis* imports are considered to be personal and are not liable to be detained by the customs authorities (Legislative Decree No. 647).

Similarly, Article 228 of the Central American Convention for the Protection of Industrial Property stipulates that it will not be possible to file an action for the prohibition of the entry of merchandise unlawfully displaying a mark when a customs union is established between the territories of the signatory States if the merchandise originates in one of those States. However, El Salvador does not as yet belong to any customs union with any country in Central America or outside the region, so that the said provision does not apply.

**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?**

An intellectual property right holder requesting border measures may apply directly to the judge to issue the corresponding judicial order to the Directorate-General of Customs Revenue.

In such case, the Directorate-General of Customs Revenue issues a circular for distribution to all customs posts in the country instructing them to restrict the entry of the infringing goods.



This is based on Articles 91 and 174 of the Law on the Promotion and Protection of Intellectual Property and Article 68 of the Central American Convention for the Protection of Industrial Property, which also define the content of the applications and the security to be provided.

**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?**

As already mentioned in the replies concerning precautionary or prudential measures, the border measures constitute one of the various precautionary measures that a judge may impose in response to infringements of intellectual property rights when the right holder has so requested.

In this respect, the comments made in reply to question 13 of this questionnaire are applicable.

**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?**

The customs authorities do not have the authority to act ex officio.

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

The customs authorities do not have the authority to impose border measures on their own initiative, but must act on judicial order as follows:

Copyright

Under Article 91 of the Law on the Promotion and Protection of Intellectual Property, the prohibition on the import or export of unlawfully produced copies is treated as a prudential measure, and the owner of the infringed right must apply to the judge for the imposition of such a measure, which the judge then orders subject to the provision of a security and without notifying the infringer.

Patents, utility models and industrial designs

Article 174 of the Law on the Promotion and Protection of Intellectual Property establishes, among the precautionary measures that may be requested by the holder of the infringed right, preventive seizure, detention or deposit of the infringing goods and the means predominantly used to commit the infringement.

Thus, the judge may issue the order immediately in response to the right holder's application, and may make such measure contingent on the provision of a sufficient security.

Distinctive commercial signs

With respect to distinctive commercial signs, the Central American Convention for the Protection of Industrial Property provides for the following precautionary measures:

- Prohibition of the import or entry of merchandise or products as long as they display a misused mark (Article 26 of the Central American Convention for the Protection of Industrial Property);

- prohibition of the import or entry of merchandise or products as long as they display a misused advertising slogan or sign (Articles 64 and 26 of the Central American Convention for the Protection of Industrial Property);
- in cases of unfair competition, such prudential measures shall be imposed by the judge at the request of the right holder subject to the provision of a sufficient security (Article 68 of the Central American Convention for the Protection of Industrial Property).

#### Indications of source and appellations of origin

In the case of acts of unfair competition, such prudential court orders as the judge may deem appropriate for the adequate protection of the rights of the complainant, of consumers and of the competitors, including the preventive seizure or confiscation of the merchandise in question, in accordance with the procedure described in the previous indent (Articles 77 and 68 of the Central American Convention for the Protection of Industrial Property).

#### Draft Law on Marks and Other Distinctive Signs

The section entitled Action and Penalties for the Violation of Rights of the draft Law on Marks and Other Distinctive Signs provides, in cases of infringement of rights to distinctive commercial signs and geographical indications and appellations of origin, among other prudential measures that may be ordered, for the suspension of imports or exports of the goods or materials displaying the infringing sign and of the means predominantly used to commit the infringement.

The right holder may apply to the competent authority to impose this measure before, during or after the initiation of the action. The precautionary measures may only be ordered when the competent authority is satisfied that sufficient evidence has been shown of the commission of the infringement or its imminence. The authority may, in such cases, require a sufficient security.

#### Criminal procedures

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

Under Article 48 of the Code of Penal Procedure, criminal jurisdiction is exercised by the courts and judges of the Republic and applies to nationals and foreigners.

Criminal cases are tried as follows:

- The magistrates' courts have jurisdiction in respect of the initial investigation proceedings and the initial hearing, which addresses the application by the public prosecutor to determine whether there is sufficient evidence to initiate the proceedings (Article 55 of the Code of Penal Procedure);
- the examining courts handle the formal pre-trial hearings for publicly actionable offences, in conformity with Article 54 of the Code of Penal Procedure;
- the courts of judgment handle the full court stage for all offences in accordance with Article 53 of the Code of Penal Procedure;
- the chamber of second instance, under Article 51 of the Code of Penal Procedure, handles, *inter alia*, regular appeals and appeals for review once the judgement in question has been handed down;

- the Criminal Division of the Supreme Court of Justice handles, *inter alia*, appeals to vacate a judgement when the Criminal Chamber has tried it at second instance and the appeal for review when the judgement in question has been handed down.

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

Title VIII (Offences Relating to Property), Chapter VII (Offences Relating to Intellectual Property) of the Penal Code provides as follows:

- Violation of copyright or neighbouring rights

Article 226: The reproduction, plagiarization, distribution or public communication, in part or in full, of a literary, artistic, scientific or technical work, or its artistic transformation or performance, fixed on any type of medium or communicated through any medium without the authorization of the holders of the corresponding intellectual property rights or their assignees, shall be punished by one to three years' imprisonment.

The same penalty shall apply to anyone who fails to submit to the Register of Commerce such works or productions or performances, or imports, exports or stores copies thereof without the said authorization.

- Aggravated violation of copyright and neighbouring rights

Article 227: A penalty of three to five years' imprisonment shall be applied to anyone who commits any of the acts described in Article 226 above in conjunction with any of the following circumstances:

- Usurpation of the status of author of a work or part of a work, or of the name of an artist in a performance;
- substantial modification of the integrity of the work without the authorization of the author;
- if the quantity or value of the unlawful copy is of particular economic importance.

Similarly, Title IX (Offences Relating to the Socioeconomic Order), Chapter I (Offences Relating to Industrial Property), establishes the following:

- Violation of the privileges of invention

Article 228: The manufacture, import, possession, offer or introduction into the market for industrial or trade purposes and without the consent of the owner of the patent or utility model of the subject-matter thereof shall be punished by one to three years' imprisonment.

The same penalty shall apply to anyone who for the same purposes uses an industrial process or design that is protected by registration, without the authorization of the holder or without the necessary licence, or offers or introduces into the market or uses the product obtained directly by the registered process.

- Violation of distinctive commercial signs

Article 229: The reproduction, imitation, modification or use of any kind of a mark, trade name, expression, advertising sign or any other distinctive commercial sign for industrial or commercial purposes and without the consent of the holder, in violation of the rights appertaining to the industrial property registered in conformity with the law, shall be punished by one to two years' imprisonment.

The same penalty shall apply to those who knowingly possess for the purposes of sale or placing on the market, products or services with distinctive commercial signs which, in accordance with the preceding paragraph, constitute an infringement of the exclusive rights of the holder.

- Breach of trust

Article 230: Anyone who takes possession of documents, carrier media or other items with a view to discovering or revealing an economically assessable secret belonging to an enterprise and involving economic advantages shall be punished by six-months' to two years' imprisonment.

- Exposure or disclosure of an industrial secret

Article 231: Anyone who, while legally or contractually bound to maintain confidentiality, exposes or discloses an invention for which a patent application has been filed, or an industrial or trade secret, shall be punished by six months' to two years' imprisonment.

If the secret is used to the perpetrator's own advantage, the penalty shall be increased by up to one third of the maximum.

If the perpetrator is a public official or employee and the act is perpetrated in the course of his duties, he shall, in addition, be disqualified from such duties or employment for six months to two years.

**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?**

Under Article 193 of the Constitution, responsibility for initiating criminal proceedings, ex officio or at the request of a party, lies with the Attorney-General of the Republic, and the Office of the Attorney-General of the Republic is therefore responsible for monitoring the investigation of the offence.

In this connection, Article 26 of the Code of Penal Procedure stipulates that intellectual and industrial property offences shall be prosecuted at the request of a private person, in accordance with the guidelines for criminal proceedings set forth in Article 19 of the Code concerning public right of action upon request by a private person.

The above Article also states that the Office of the Attorney-General of the Republic shall be responsible for initiating the publicly prosecutable penal action where the case is prosecuted upon prior request by a private person.

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

As mentioned in the previous replies, offences against intellectual and industrial property are offences for which there is a public right of penal action upon request by a private person.

In this respect, Article 26 of the Code of Penal Procedure stipulates that such offences shall only be prosecutable as criminal offences on application by the victim or, in case of disability, by the victim's legal representative or guardian.

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

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

In addition to the offences mentioned in the reply to question 21 in relation to intellectual property and industrial property, the following measures apply:

- Civil Liability, Articles 114 and 115 of the Penal Code

The commission of an act described by the law as an offence or misdemeanour gives rise to civil liability. The civil consequences of the offence, which shall be set forth in the judgement, include:

- Restitution of whatever was obtained as a consequence of the commission of the punishable act, failing which, payment of the value thereof;
- reparation of the damage caused;
- payment of material or moral damages to the victim or the victim's family;
- procedural costs.

Forfeiture of the product, profits and advantages deriving from the act, Article 126 of the Penal Code

This provision stipulates that, without prejudice to such repayments and compensation as are due for the damages resulting from the act, the judge or court shall order the forfeiture, on behalf of the State, of the product, the profits and the advantages obtained by the convicted party as a result of the act.

This forfeiture shall include assets, rights and goods obtained by any means for the purpose or as a result of the act, by the convicted party or any other person, natural or legal, on whose behalf the convicted party has acted.

Seizure, Article 127 of the Penal Code

This Article stipulates that, without prejudice to the rights of purchasers in good faith and for valuable consideration or to such improvements or expenditures as have been made by acquirers free of charge, the judge or the court shall order the confiscation or forfeiture on behalf of the State of the objects or instruments used by the convicted party to prepare or facilitate the act.

**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.**

Cost of the proceedings

Under Articles 172 and 181 of the Constitution, the judicial body has the exclusive authority to judge and to enforce judgments, *inter alia* in criminal cases, guaranteeing that the administration of justice remains free of charge.

Similarly, criminal proceedings in respect of intellectual property and industrial property offences are actionable publicly at the request of a private person, and the Office of the Attorney-General of the Republic is the institution responsible for conducting the proceedings, so that no cost is in fact involved.

However, Article 95 of the Code of Penal Procedure stipulates that the victim may participate in the proceedings through his representative, who, under Article 98 of the Code, must be an attorney of the Republic. In cases where the holder of the infringed intellectual property right chooses to participate in the proceedings, he must pay the fees of his representative.

Duration of the proceedings

Criminal proceedings are dealt with in Book Two of the Code of Penal Procedure.

Article 274 of the Code of Penal Procedure stipulates that the duration of the investigation stage shall not exceed a maximum of six months following the initiating order. The purpose of this stage is to prepare the public hearing by gathering together all of the elements on which to base the accusation of the prosecutor or the complainant and to prepare the defence of the accused.

However, Article 379 of the Code of Penal Procedure stipulates that during the time between the initiation of the proceedings and the preliminary hearing it is possible to request application of the accelerated procedure provided for in Book Three of the Special Procedures, Title I, when the following conditions are satisfied:

- The prosecutor requests a custodial or prison sentence of up to three years;
- the accused admits the act and agrees to the application of such procedure, without prejudice to the inclusion in his pleading of such other facts or circumstances as he may consider appropriate;
- the counsel for the defence certifies that the accused has freely given his consent;
- the victim or complainant has given his consent. If not, the judge shall examine the reasons put forward and may proceed with the accelerated procedure even without the consent of the victim or complainant.

In addition to the above, Book Two, Title II (The Trial) does not establish any maximum duration for this stage.

Finally, Book IV (Procedural Acts), Chapter VI regulates matters concerning the duration of procedural acts and deadlines for settlement.

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