

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

Responses from the Slovak Republic

**Civil and Administrative Procedures and Remedies**

(a) *Civil judicial procedures and remedies*

As an introduction it is necessary to mention that in the Slovak Republic there is a three instance judicial system, the court of the first instance is the district court as the court with full jurisdiction, the second instance court is the regional court as the court of appeal, and the court of the third instance is the supreme court, which decides, above all, about extraordinary remedies. In several, strictly defined commercial and criminal matters, decisions are made by the regional court as the court of the first instance, the supreme court having the function of the court of appeal.

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

Court jurisdiction is provided by Section 9 of the Code of Civil Procedure, the first instance proceedings are in the jurisdiction of the appropriate district courts. In specified cases regional courts make decisions as the courts of the first instance. The regional court as the court of the first instance decides the disputes concerning patent rights, utility model and industrial design rights, as well as topographies of semiconductor products provided they are the subject matter of trade. Furthermore, it takes decisions on disputes concerning rights to trade names, trademarks and appellations of origin. Regional courts of the first instance act on disputes involving the protection of economic competition and unfair competition. In the first instance the decisions are made by the single judge, the appeals are decided by the senate of three.

**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 to industrial or intellectual property rights can be asserted without limitation by anybody who is a right holder. There are no special requirements for mandatory personal appearances before the court. A party to a proceeding can be, but need not be, represented by a legal representative. It is only applied in case of a minor, who must be represented by a legal representative (parent), and a person deprived of capacity to legal acts must have a guardian. Compulsory representation by an attorney is ordered only in the proceedings for extraordinary remedies before the supreme court.

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

**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?**

Every institution is obligated to produce evidence, or evidential measures at their disposal. Special treatment concerns evidence which is the subject matter of official or professional secrets which can be submitted to the court only on fulfilling particular, strictly defined, conditions.

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

The method of treatment of confidential information, as well as information which is the subject of a professional or official secret, is strictly and comprehensively regulated by the Law on Protection of Official and Professional Secrets No. 100/1996 Coll. Every institution which is involved with the subject matter of confidential information gives a notice in the Collection of Laws by which the range of the subject matter of professional, or official secrets is defined. The disposal of such information is amenable to strictly defined special treatment in every institution including courts. There is, above all, only a limited number of persons who have access to confidential information. In cases of judicial proceedings, or a proceeding before the Industrial Property Office, confidential information is identified on the basis of a request of a party to a proceeding, who has the right to require certain information to be considered confidential and thus the subject of a professional secret in accordance with law, and public administration workers or judges are bound by secrecy to treat confidential information and act accordingly. The liabilities in this respect are stipulated also by the Law on Protection of Economic Competition No. 188/1994 Coll., Sections 15 and 16, as well as the Commercial Code.

**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.**

In general, the court can order, on the basis of a proposal of a plaintiff, that a defendant is obligated to do something, to abstain from something, or to countenance something. In the above-mentioned cases the court can take a final decision or a provisional measure if a plaintiff requires it. The court can order the compensation of damage, or the obligation of compensation of non-property damage by adjudicating the right to satisfaction in the form of pecuniary implementation. The court also makes declaratory decisions with regard to the existence or non-existence of legal relations. Regarding the conditions of law enforcement in the Slovak legal system, the principles applied are the same as those valid in all European continental systems. Generally, a plaintiff has to prove that he is the holder of the right which he asserts, or that he has a well-founded legal interest in determining the existence or non-existence of a legal relation. It is on the plaintiff, however, that the burden of proof lies in relation to the determination and proof that the defendant is the bearer of an obligation, or is a person liable. In most frequent cases of compensation for damage it is necessary to prove the existence of illegal action, *nexus causalis* and value of damage. In the case of compensation for non-property damage, its determination is left to the discretion of the court.

If a person is held liable, then orders for the destruction or other disposal of goods, materials and implements for their production can be considered. This statement, however, remains only in the theoretical domain since there has not yet been any experience with the above-mentioned method in the Slovak Republic.

According to the Code of Civil Procedure the party, fully or prevailingly successful in the court proceedings, has the right to compensation for the expenses of the proceedings, including attorney's fees as well as legal payments and other legitimate costs related to the law enforcement.

**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 holder of a trademark has the right to require information of third persons according to Section 25.2 of Law No. 55/1997 on Trademarks. The holder can apply this right against everybody who puts, or intends to put on the market goods or services marked by the identical or misleadingly similar sign as a trademark. This right can be enforced by law.

**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?**

The liability of the public authorities, including the court, for the compensation of damage caused by wrongful administrative procedures or by breach of law, is regulated by the law of the same name from 1968 which was the first and, for more than two decades, the only legal regulation in the former socialist states. This regulation by law provides procedural conditions for the application of the liability of the public authority, while the liable person is represented by a department, or central authority of the public administration which, through its illegal action or wrongful administrative procedure caused damage, or is the superior authority to the body which caused damage. The public authorities are liable for the damage caused in the full extent. The official who caused damage directly can be held personally responsible and against whom can be drawn labour legal and, under certain circumstances, also criminal legal consequences (criminal act of abuse by a public administration official).

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

The cost of proceedings before the court is represented by the court fee paid both for the proposal and appeal. The court fee is 4% of the value of the subject matter of the proceedings, if such a value can be expressed in numbers, but at most it is Sk 100,000. In case the subject matter of the proceedings cannot be evaluated, the court fee is Sk 1,000. From the financial point of view, the court proceedings are relatively available, the court fees do not have a restrictive effect, which can be proven by the fact that 90% of disputes are solved through court proceedings and only the remaining 10% by means of arbitration, or mediation structures. The length of proceedings still presents a problem although the situation has improved. The length of regular civil proceedings is one year, including the appeal procedure. In exceptional cases, the length can be three years and more. In general, the worst situation is in commercial law which was, and still is, burdened with an enormous amount of cases caused by insolvency of enterprises, and thus the average length of proceedings can be estimated from two to three years - the exact figures can be obtained from the statistical outputs of the Ministry of Justice of the Slovak Republic. The above-mentioned statistical figures are not available for the Industrial Property Office, the exception being the provisional measures which can be ordered by the court, in accordance with law, in the period of one month from the filing of the proposal.

(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.**

All the above-mentioned procedures can be applied in any administrative procedures before institutions other than the courts. All these procedures can be applied to an appropriate extent since, unlike the courts which have general jurisdiction, other authorities of public administration can take decisions only on matters strictly defined by law in the sphere of their capacity and competence. Decisions of the public administration authorities on principle can be inspected by the courts. The procedural regulations in administrative procedures are less strict than those in judicial procedures. Authorities other than the courts cannot take decisions regarding compensation or satisfaction, as opposed to the court's jurisdiction. The powers of other authorities of public administration, as has already been mentioned, are specifically defined in a positive manner.

**Provisional Measures**

(a) *Judicial measures*

- 10. Describe the types of provisional measures that judicial authorities may order, and the legal basis for such authority.**
- 11. In what circumstances may such measures be ordered *inaudita altera parte*?**
- 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.**
- 13. Describe provisions governing the length and cost of proceedings. Provide any available data on the actual duration of proceedings and their cost.**

Provisional measures are regulated by Section 74 and the following sections of the Code of Civil Procedure. Provisional measures can be ordered by the court at the proposal of a party, before making a due petition, as well as during the regular judicial proceedings. For a provisional measure to be ordered, apart from the petition, it is necessary to prove the need for a provisional measure regarding the circumstances, or a legitimate apprehension that the execution of the judicial decision will be endangered. Provisional measures can be ordered by the same court which is appropriate for the proceedings in the matter. The decision regarding provisional measures is taken by the court without undue delay no later than 30 days from the making of the petition. Parties to the proceedings need not be heard before the court. The petition to order provisional measures is in principle given to the other party for observation. As has been mentioned above, by means of a provisional measure the court can order a party to a proceeding to do something, to abstain from something, or to tolerate something. Where a provisional measure was initiated before bringing a due sanction *in rem*, the court determines the liability of a plaintiff to bring a due action within a certain time limit: if the plaintiff fails to do so, the validity of the provisional measure will be extinct. The validity of provisional measures is limited by the court to a reasonable and appropriate time-limit, for instance a period until legal completion of the matter itself. Provisional measures are not the subject of legal fees. Whether the judge in a proceeding concerning a provisional measure will hear parties to a proceeding remains at the discretion of the judge. The decision by which a provisional measure was ordered is executable, i.e. it is the subject of execution regardless of whether it has come into force or was appealed to.

*(b) Administrative measures***14. Reply to the above questions in relation to any administrative provisional measures.**

Provisional measures may be ordered also by a public administration authority in accordance with Section 43, Law on Administrative Procedure No. 71/1997 Coll. As opposed to the court, the public administration authority can issue such a decision only during the proceedings about the matter itself. According to this method, the public administration authority can order parties to do something, to abstain from something, or to countenance something. It can also order the safeguarding of things which should be destroyed, or made dysfunctional, or which are necessary for establishing evidence. The administration authority will cancel a provisional measure when the reason for ordering it will elapse. A provisional measure is no longer in force when the decision *in rem* becomes valid. In such a case, the appeal against the decision concerning a provisional measure does not have an adjourned effect.

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

Answer to questions 15 - 19

The Industrial Property Office has no detailed knowledge and information regarding the above-mentioned questions as the special regulation does not exist at present, and the protection on the border with regard to industrial and intellectual property is governed by general customs regulations. The competent authority in this case is the Ministry of Finance, or the Central Customs Office.

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

Penal Code No. 140/1961 Coll. in the wording of subsequent amendments recognizes individual criminal acts as opposed to criminal acts against industrial rights and copyright. It is of no consequence to quote the exact definition of individual criminal acts; more important is the criminal liability of persons who unlawfully infringe the rights to trademarks, appellations of origin, trade names, inventions, utility models, industrial designs, or topographies of semiconductor products. At present, the recodification of the Penal Code is under preparation, which will include in its fourth part criminal acts against industrial rights and copyright. Criminal acts according to their significance are punished in this case by imprisonment, or monetary fines, or by forfeiture of something. The courts which have jurisdiction over criminal acts are the courts of the first instance - district courts.

**21. In respect of which infringements of which intellectual property rights are criminal procedures and penalties available?****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?****23. Do private persons have standing to initiate criminal proceedings and, if so, who?****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.**

**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.**Answer to questions 21 - 25

Criminal liability can be applied in those cases where a person puts goods into circulation, or provides services, unlawfully marked by a trademark which is the property of another person, or by a sign misleadingly similar. The same provision is applied in the case of using an appellation of origin or a trade name. In each of the above-mentioned cases, the penalty of imprisonment can be imposed for a period of up to three years, or monetary fine or forfeiture of something. In the case of causing major damages or committing a criminal act in the form of an organized crime, the punishment of imprisonment can be imposed for a period of up to five years.

A person who unlawfully infringes the right to an invention, utility model, industrial design or topography of semiconductor products can be punished by imprisonment for a period of up to three years, or by monetary fine or forfeiture. The criminal sanction of imprisonment is increased to a period of up to five years in cases of causing major damages or of committing a criminal act in the form of an organized crime. The criminal prosecution in its preparatory phase is initiated by the

prosecutor's office which leads criminal prosecution through the police authorities and brings the action to the court where the prosecutor represents the state. Private persons have standing to initiate criminal proceedings by submitting a proposal to the prosecutor's office or the police authority, but in criminal proceedings they can appear only as an injured party claiming damages. The prosecutor is obligated to initiate criminal proceedings; where he has knowledge of the criminal act he can do so on his own initiative *ex officio*, or on the basis of an initiative of a third person. The criminal proceedings can be initiated by anyone who has knowledge of the committing of a criminal act. Injured persons, or another person who initiates criminal proceedings, do not pay any fees, nor in the case where this person asserts his right for compensation in criminal proceedings, and also within the criminal proceedings the court can adjudicate the right to compensation, provided its amount is indisputable.