WORLD TRADE ORGANIZATION

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Council for Trade-Related Aspects of Intellectual Property Rights

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CHECKLIST OF ISSUES ON ENFORCEMENT[1]

Responses from Slovenia

Civil and Administrative Procedures and Remedies

(a) Civil judicial procedures and remedies

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

- The Circuit Court of Ljubljana has the exclusive jurisdiction over all IPR infringement cases (*Law on Courts, Official Gazette Nos. 19/1994, 45/1995, Article 103(2)*). Appeals against its decisions are examined by the Higher Court in Ljubljana (*Law on Courts, Article 104, p.1*).

- Exception: the Labour and Social Courts decide in disputes between employers and employees with regard to inventions, shapes of products, pictures, drawings and technical improvements (*Law on Courts, Article 103(2); Law on Labour and Social Courts, Official Gazette No. 19/1994, Article 4, p.3*).

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 rightholder?

- Any rightholder of an IPR, who or which is a natural or legal person, has standing to assert his/its rights (*Code of Civil Procedure, Official Gazette Nos. 4/1977-27/1990, 1/1991-I, 55/1992, 19/1994, Article 77(1); Industrial Property Act, Articles 95(1), 96; Copyright and Related Rights Act, Official Gazette No. 21/95, Articles 72, 142, 164*). In addition and subject to special conditions, this stands also for other forms of associations, which do not have the legal status of a natural or legal person (*Code of Civil Procedure, Article 77(3)*) and for Collecting Societies, when collectively administering copyright and related rights (*Copyright and Related Rights Act, Article 157*).

- IPR rightholders may be represented by any natural person with full legal capacity (*Code of Civil Procedure, Article 90 (1); Copyright and Related Rights Act, Articles 142, 144(1)*), by an attorney (*Code of Civil Procedure, Article 95*) or by an authors' agency (*Copyright and Related Rights Act, Article 144(2)*).

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- There are no requirements for mandatory personal appearances before the court of the rightholder (*Code of Civil Procedure, Article 295, 269*).

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?

At the request of the opposing party the judicial authorities may order provisional measures or preservation of evidence (see below):

- At the request of one party the judicial authorities may order the opposing party to produce evidence which lies within its control (*Code of Civil Procedure, Article 233*).

- If the opposing party does not produce evidence which lies within its control, the court judges at its own discretion and due to all circumstances, what importance is to be given to the fact of the denial of access of information (*Code of Civil Procedure, Article 233(5)*).

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

- In order to ensure protection of confidential information, brought forward as evidence, the court may decide to exclude the public from the court hearings. The judge is obliged to warn all parties that they have to respect the confidential nature of any relevant information, which they receive in such hearings (*Code of Civil Procedure, Articles 307-310*). In case of patent infringement litigations concerning patented processes for new chemical compounds, the legitimate interests of the producer to protect business secrets must be taken into account (*Law on Industrial Property, Article 93(3)*).

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

- Injunctions: the Court may order the infringer to desist from a preparatory act for an infringement and the infringement itself (*Copyright and Related Rights Act, Article 167(1), p.1*) and from further infringements (*Copyright and Related Rights Act, Article 167(1), p.1; Industrial Property Act, Articles 93(1), 96(1); Law on Protection of Competition, Official Gazette No. 18/93, Article 26(1)*). The criterion is (i) an infringement of rights, and in case of preparatory acts for copyright infringements, (ii) the apparent danger that an infringement will occur.

- Damages, including recovery of profits, and expenses, including attorney's fees: the Court may order damages to be paid in favour of the rightholder (*Copyright and Related Rights Act, Article 164(1); Industrial Property Act, Articles 93(1), 96(1); Law on Protection of Competition, Article 27*). Damages include recovery of profits and expenses (*Code on Obligations, Articles 185, 189, 190*). The winning party is entitled to recover from the opposing party all expenses due to the procedure, including attorney's fees (*Code of Civil Procedure, Articles 154(1), 151*). The criterion for this is the actual existence of damage or expenses.

- Destruction or other disposal of infringing goods and materials/implements for their production: the Court may order that the infringing copies, their packaging, stencils, negatives, plates, melds or other means, which were instrumental to the infringement, be destroyed or altered (*Copyright and Related Rights Act, Article 167(1), p.3, 4;*

Law on Protection of Competition, Article 26(1)). The same stands for devices, the sole or prevalent purpose of which is to make infringements and which are owned by the infringer (*Copyright and Related Rights Act, Article 167(1), p.5*). The criterion is that an infringement has occurred.

- Other remedies - publication of the judgement: the Court may order that the judgement be published at the infringer's expense (*Copyright and Related Rights Act, Article 167(1), p.6; Industrial Property Act, Articles 96(1), 104; Law on Protection of Competition, Article 26(2)*). The criterion is that an infringement has occurred.

- Other remedies - moral damage: the Court may order that the infringer pays to the rightholder monetary satisfaction for non-material damages (*Copyright and Related Rights Act, Article 169; Industrial Property Act, Article 104*). The criteria are: (i) that an infringement of moral rights has occurred, (ii) that it has caused mental anguish and suffering to the author; and (iii) that the degree and duration of the suffering entitle the monetary compensation (*Copyright and Related Rights Act, Article 169; Code of Obligations, Article 200*).

- Other remedies - punitive damages: in case of infringement of copyrights and subject to special conditions, the Court may order that the infringer pays to the rightholder a royalty increased by up to 200% (*Copyright and Related Rights Act, Article 168*). The criteria are: (i) that an infringement has occurred intentionally or by gross negligence, (ii) the degree of culpability, (iii) the amount of royalties, (iv) the achievement of a general preventive purpose (*Copyright and Related Rights Act, Article 168(2)*).

6. In what circumstances, if any, do judicial authorities have the authority to order the infringer to inform the rightholder 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?

- A rightholder may demand that persons, who are in any way connected with the infringement of rights recognized by the Copyright and Related Rights Act (manufacturers, printers, importers, suppliers, or possessors of copies or means with which the right was infringed), provide information and produce documents in connection with the infringement, immediately upon demand. If the persons mentioned fail to give the required information or produce the documents in their possession, they are liable for damages that may be caused by their failure to comply (*Copyright and Related Rights Act, Article 172*).

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

- In case of abuse of enforcement procedures, general rules on damages (*Code on Obligations, Articles 16, 154-209*) will apply for the indemnification of the defendant (*Code of Execution Procedure, Article 274*).

- Public authorities are liable for damages, caused by their officials to third parties in the administration or in connection with the administration of their duties, under the general rules on damages (*Code on Obligations, Article 172).*

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

- The courts shall endeavour that the procedures shall not entail delays and shall run under the lowest costs possible (*Code of Civil Procedure, Article 10*). The proceedings are summary (*Industrial Property Act, Article 98*).

- The actual duration of proceedings and their cost depends on the complexity of each individual case (e.g. attorney's fees and Court taxes are proportional to the extent of the sums claimed).

(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.

- Administrative procedures are not foreseen.

<u>Provisional Measures</u>

(a) Judicial Measures

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

- In case of industrial property rights: prohibition of selling or other transfer of moveable objects, prohibition of any activity that might cause damage to the rightholder (*Code of Execution Procedure, Article 268, p.1,3*), preservation of evidence (*Code of Civil Procedure, Articles 272-276*).

- In case of copyright and related rights: seizure, exclusion from circulation, and taking into custody of copies, means, equipment, and relevant documents; interdiction of imminent infringements or of infringements already commenced; other similar measures (*Copyright and Related Rights Act, Article 170, 186*) preservation of evidence, including the inspection (of places, business records, inventory, databases, computer memory units, or other things etc.), examination and seizure of documents, examination of witnesses, and the appointment and examination of experts (*Copyright and Related Rights Act, Article 171*).

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

- In case of industrial property rights: in urgent cases (for preservation of evidence) (*Code of Civil Procedure, Articles 275(5)*).

- In case of copyright and related rights: if there is a demonstrable risk that the provisional measures mentioned above may not be effective at a later time, the court may order and execute such measures without prior notification and hearing of the other party (*Copyright and Related Rights Act, Article 170(2)*). If the rightholder shows probable grounds for belief that his exclusive right under the Act is being infringed, and that there is a demonstrable risk that evidence of such infringement will be destroyed

or that it will be impossible to obtain such evidence at a later time, the court may, on application of the rightholder, take such evidence without prior notification and hearing of the other party (*Copyright and Related Rights Act, Article 171(3)*).

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.

- Initiation: the procedures for provisional measures start on written application by the rightholder (*Code of Civil Procedure, Article 274; Code of Execution Procedure, Article 267(1); Copyright and Related Rights Act, Articles 170(1), 171(1)*).

- Ordering and maintenance in force: the court requires the applicant to show probable grounds for belief, that his claim is existing and that without the provisional measure the realisation of his claim would be impossible or rather difficult or that the measure is necessary to prevent the use of force or the event of irreparable harm (*Code of Execution Procedure, Article 267(1), (2)*).

- Time-limits: in its decision, the court is free define the duration of the provisional measure and, in cases in which the measure was ordered before the making of a law-suit or before the beginning of another proceeding, the deadline for such a beginning (*Code of Execution Procedure, Article 272(1)*).

- Defendant's safeguards: the defendant has the right of appeal against the decision on provisional measures (*Code of Execution Procedure, Article 48*). The Court may order the applicant to provide security for the defendant's damages which might occur due to the provisional measure (*Code of Execution Procedure, Article 270(2)*). The defendant himself may provide security for the rightholder's claims; in such case the provisional measure is revoked (*Code of Execution Procedure, Article 269(2) and (3)*). The defendant has the right to claim damages, caused with the provisional measure, if the measure had no legal ground (*Code of Execution Procedure, Article 274*).

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

- The courts shall endeavour that the procedures shall not entail delays and shall run under the lowest costs possible (*Code of Civil Procedure, Article 10; Code of Execution Procedure, Article 10(1)*). The proceedings are summary (*Copyright and Related Rights Act, Articles 170(3), 171(4)*).

- The actual duration of proceedings and their cost depends on the complexity of each individual case (e.g. attorney's fees and Court taxes are proportional to the extent of the sums claimed).

(b) Administrative procedures

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

- Administrative procedures are not foreseen.

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 minimus* imports). Do the procedures apply to imports of goods put on the market in another country by or with the consent of the rightholder and to goods destined for exportation?

- Border measures are defined for pirated copyright goods in the sense of Article 51, footnote 14 of the TRIPS Agreement.

- For counterfeit trademark goods the TRIPS Agreement is directly applicable on the basis of constitutional provisions (*Constitution, Article 8*).

- The procedures do not apply to imports of goods put on the market in another country by or with the consent of the rightholder 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 goods) and 57 (right of inspection and information) been implemented?

- The procedures are defined solely for pirated copyright goods (*Copyright and Related Rights Act, Article 173*). Otherwise the TRIPS Agreement applies directly.

- Competent authorities: the competent Customs-house, which takes decisions under the general administrative procedure (*Law on Customs Services, Official Gazette Nos. 1/91-I, 58/93, 65/93, Article 11; Customs Act, Official Gazette No. 1/95, Article 6*).

- Application: the rightholder shall be required to provide detailed description of the goods, as well as adequate evidence of his exclusive rights and their probable infringement. Customs authorities must promptly notify the importer and the recipient of the goods on the adopted measures (*Copyright and Related Rights Act, Article 173(1), (2), (3)*).

- Duration: the customs authorities shall revoke the adopted measures if the rightholder does not file a suit or initiate some other proceedings, leading to a decision on the merits of the case, within seven days (*Copyright and Related Rights Act, Article 173(3)*).

- Security: the customs authorities may require the rightholder to post a security to protect the defendant against possible damage that may be caused by such measures (*Copyright and Related Rights Act, Article 173(2); Code of General Administrative Procedure, Article 217(2), 292(2)*).

- Indemnification: the customs authority may order the applicant to pay damages, caused with the provisional measure, if the measure had no legal ground (*Code of General Administrative Procedure, Article 293(1), (2)*).

- Inspection: the custom authorities may, on application of the rightholder, order that the rightholder or his agent may inspect such goods (*Copyright and Related Rights Act, Article 173(1)*).

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

- The proceedings shall be guided in a fast way, under the lowest cost possible and shall not entail delays (*Code of General Administrative Procedure, Article 13*). If not prolonged, the suspension of the release of goods into free circulation shall be valid for seven days (*Copyright and Related Rights Act, Article 173(3)*).

- The actual duration of proceedings and their cost depends on the complexity of each individual case.

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 have no powers to act upon their own initiative.

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

- The customs authorities may order that such goods be seized, their release into free circulation be suspended, and the goods be detained awaiting final decision by the competent authority (*Copyright and Related Rights Act, Article 173(1)*).

Criminal Procedures

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

- The jurisdiction over criminal acts of infringement of IPRs lies with the district Courts (*Law on Courts, Official Gazette Nos. 19/1994, 45/1995, Article 99 I.1*).

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

- Trademarks: counterfeiting (*Penal Code, Article 238(1)*).

- Industrial designs: counterfeiting (*Penal Code, Article 238(2)*).

- Patents: unauthorized use of inventions (*Penal Code, Article 239*).

- Copyright (moral rights): infringement of the right of paternity (*Penal Code, Article 158(1)*).

- Copyright (moral rights): infringement of the right of respect (*Penal Code, Article 158(2)*).

- Copyright (economic rights): whoever, with the intent to obtain for himself or for another a substantial unlawful material gain, reproduces, distributes, rents copies, publicly performs, publicly transmits, publicly presents, broadcasts or transforms a copyright work without the permission of the author or another copyright holder, when such permission is required by law (*Penal Code, Article 159(1)*).

- Copyright (economic rights): whoever, with the intent to obtain for himself or for another a substantial unlawful material gain, puts into circulation, or with the intent of putting into circulation offers to the public copies of a copyright work, knowing that such copies were reproduced without authorization (*Penal Code, Article 159(2)*).

- Copyright (economic rights): if, by the act described in the foregoing paragraph, very large material gain was obtained and it was in the perpetrator' s intention to obtain such material gain (*Penal Code, Article 159(3)*).

- Copyright: whoever makes, acquires, sells or lets another use implements, intended for breaking into a computer system (*Penal Code, Article 309(3)*).

- Related rights (rights of performers): whoever, without permission of a performer, when such permission is required by law, broadcasts, reproduces, puts into circulation or communicates to the public a performance or a fixation of a performance, and thereby obtains substantial material gain (*Penal Code, Article 160*).

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?

- The authorities, responsible for initiating criminal procedures, are the Police and the District State Prosecutors. Depending on the type of infringement they act *ex officio* or on a complaint.

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

- Private persons, i.e. rightholders, have standing to initiate criminal proceedings only in cases of criminal acts under Articles 158 and 160 of the Penal Code.

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

- Trademarks: counterfeiting - imprisonment for up to three years. The infringing goods shall be confiscated on an obligatory basis (*Penal Code, Article 238(1), (3)*).

- Industrial designs: counterfeiting - imprisonment for up to three years. The infringing goods shall be confiscated on an obligatory basis (*Penal Code, Article 238(2), (3)*).

- Patents: unauthorized use of inventions - imprisonment for up to three years (*Penal Code, Article 239*).

- Copyright (moral rights): infringement of the right of paternity - fine or imprisonment for up to one year (*Penal Code, Article 158(1)*).

- Copyright (moral rights): infringement of the right of respect - fine or imprisonment for up to six months (*Penal Code, Article 158(2)*).

- Copyright (economic rights): whoever, with the intent to obtain for himself or for another a substantial unlawful material gain, reproduces, distributes, rents copies, publicly performs, publicly transmits, publicly presents, broadcasts or transforms, a copyright work without the permission of the author or another copyright holder, when such permission is required by law - fine or imprisonment for up to three months. The infringing goods and devices for their reproduction shall be confiscated on an obligatory basis (*Penal Code, Article 159(1), (4)*).

- Copyright (economic rights): whoever, with the intent to obtain for himself or for another a substantial unlawful material gain, puts into circulation, or with the intent of putting into circulation offers to the public copies of a copyright work, knowing that such copies were reproduced without authorization - imprisonment for up to two years. The infringing goods and devices for their reproduction shall be confiscated on an obligatory basis (*Penal Code, Article 159(2), (4)*).

- Copyright (economic rights): if, by the act described in the foregoing paragraph, very large material gain was obtained and it was in the perpetrator' s intention to obtain such material gain - imprisonment for up to three years. The infringing goods and devices for their reproduction shall be confiscated on an obligatory basis (*Penal Code, Article 159(3), (4)*).

- Copyright: whoever makes, acquires, sells or lets another to use implements, intended for breaking into a computer system - imprisonment for up to one year (*Penal Code, Article 309(3)*).

- Related rights (rights of performers): whoever, without permission of a performer, when such permission is required by law, broadcasts, reproduces, puts into circulation or communicates to the public a performance or a fixation of a performance, and thereby obtains substantial material gain - fine or imprisonment for up to six months (*Penal Code, Article 160*).

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.

- The courts shall endeavour that the procedures shall not entail delays (*Code of Criminal Procedure, Official Gazette 63/94, Article 15*).

- The actual duration of proceedings and their costs depends on the complexity of each individual case.

- The public prosecutor may file a summary charge sheet on the basis of a crime report alone (CCP, Article 430/2).

- The acts of investigation shall be carried out as quickly and efficiently as possible (CCP, Article 431/1).

- If the crime report is filed by the injured person (rightholder) and within a period of one month from the receipt of the request by the public prosecutor the latter fails to prefer the summary charge sheet and notify the defendant that he has dismissed the

charge or adjourned criminal proceedings, the injured party (rightholder) shall be entitled to assume prosecution subject to file the summary charge sheet with the court (CCP, Article 443).

- The judge shall order that the charge sheet or private charge be served on the defendant and shall schedule the main hearing immediately (within a month) (CCP, Article 435/2).

- Once opened, the main hearing shall proceed and end without interruption whenever possible (CCP, Article 443/1).

- An appeal against the judgement may be lodged within eight days of receipt of a copy thereof (CCP, Article 443/3).