

CHECKLIST OF ISSUES ON ENFORCEMENT¹

Responses from Slovenia

Revision

Civil and Administrative Procedures and Remedies

(a) Civil judicial procedures and remedies

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

In deciding in disputes on intellectual property rights, the District Court of Ljubljana has the exclusive territorial jurisdiction at the first instance, except for disputes between employers and employees in connection with inventions, shapes of products, pictures, drawings and technical improvements (Courts Act, Official Gazette RS, No 100/2005 - official consolidated text and Official Gazette No 127/2006, Article 103(2)). Appeal against its decision is examined by the Higher Court in Ljubljana (Courts Act, Article 104, p.1).

The Labour and Social Court in Ljubljana has the exclusive jurisdiction in disputes on rights and obligations relating to industrial property rights from the contract between employer and employee (Labour and Social Courts Act, Official Gazette RS, No 2/2004, Article 5(1)(d), Article 8(2)). Appeal against its decision is examined by the Higher Labour and Social Court in Ljubljana. Before initiating procedures at the court parties should try to solve the case in the obligatory conciliation procedure.

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?

Any right holder 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 RS, No 26/99, 43/2006, Article 76(1); Industrial Property Act (Official Gazette RS, No 51/2006 - official consolidated text), Article 120a; Copyright and Related Rights Act (Official Gazette RS, No 44/2006 - official consolidated text) Articles 72, 142, 164. In addition and subject to special conditions, this stands also for other forms of associations, which do not have legal status of a natural or legal person (Code of Civil Procedure, Article 76(3) and for Collecting Societies, when collectively administering copyright and related rights (Copyright and Related Rights Act, Article 146 (1, point 8)).

In the proceedings conducted by District and High Courts and by the Supreme Court only a practicing lawyer or other person who has passed the State judicial exam may act as an attorney (Code of Civil Procedure, Article 87(2); Copyright and Related Rights Act, Articles 142, 144(1), by an

¹ Document IP/C/5.

attorney (Code of Civil Procedure, Article 95), by an agent (Copyright and Related Rights Act, Article 144(2)).

There are no requirements for mandatory personal appearances before the court of the right holder (Code of Civil Procedure, Articles 262, 282).

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 that lies within its control?

At the request of the opposing party 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 control (Code of Civil Procedure, Article 227(1)).
- If the opposing party does not produce evidence which lies within 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 227(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 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, Article 294(1), and Article 295(4)). In case of patent infringement litigations concerning patented process for new chemical compounds, the legitimate interests of the producer to protect business must be taken into account (Industrial Property Act, Article 122(1)).

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

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

Injunctions

In case of industrial property rights the Court may order the infringer to desist from a preparatory act for an infringement and the infringement itself (Industrial Property Act, Article 121(1)(a)).

In case of copyright and related rights: 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)).

Damages, including recovery of profits, and expenses, including attorney's fees

In case of industrial property rights: damages including recovery of the profits, and expenses, including attorney's fees. The infringer shall pay to the owner of the right damages in the amount to be defined under general rules on compensation for damage, or the amount which is equal to agreed or customary license fee (Industrial Property Act, Article 121). Damages include recovery of profits and expenses (Obligations Code, Official Gazette RS, No 81/2001, 32/2004, 28/2006, Act, Articles 164, 168, 169). 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 151, 154(1)). The criterion for this is the actual existence of damage expenses.

In case of copyright and related rights: damages including recovery of the profits, and expenses, including attorneys fees. The infringer shall pay to the owner of the right damages in the amount to be defined under general rules on compensation for damage, or the amount which is equal to agreed or customary royalty or remuneration for legitimate use of such kind (Copyright and Related Rights Act, Article 168(1),(2)). Damages include recovery of profits and expenses (Obligations Code, Articles 164, 168, 169). 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 151, 154(1)). The criterion for this is the actual existence of damage expenses.

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

In case of industrial property rights: the court may order that the: a) objects of infringement be recalled from the channels of commerce taking into account the interests of *bona fide* third parties, b) objects of infringement or the means of infringement that are owned by the infringer and intended or used exclusively or principally for infringement be destroyed (Industrial Property Act, Article 121(1)(b)(d)(e)).

In the case of copyright and related rights: the court may order that the: a) objects of infringement be irrevocably recalled from the channels of commerce, taking into account the interests of *bona fide* third parties, b) objects of infringement or the means of infringement that are owned by the infringer and intended or used exclusively or principally for infringement be destroyed (Copyright and Related Rights Act, Article 167(2), 167(4)(d), 167(5)).

Any other remedies

Publication of the judgement: Industrial Property Act, Article 121(1)(g); Copyright and Related Rights Act, Article 167(1)(1)).

Moral damage

In case of industrial property rights - the inventor or designer may file an action for recognition of the right to be named (Industrial Property Act, Article 118).

In case of copyright and related rights: The Court may award the author or performer equitable monetary satisfaction for non material damage (Copyright and Related Rights Act, Article 169).

Punitive damages

In case of infringement of copyrights and subject to special conditions, the Court may order that the infringer pays to the right holder a royalty increased by up to 200%. The criteria are: (i) that

an infringement has occurred intentionally or by gross negligence, (ii) the degree of culpability, (iii) the amount of agreed or customary remuneration, (iv) the achievement of a general preventive purpose sought by award of punitive damages (Copyright and Related Rights Act, Article 168(3), 168(4)).

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 of services found to be infringing and of their channels of distribution?

In case of industrial property rights: the Court may upon a justified request of the party order that the information on the origin and distribution networks of the goods or services which infringe a right under the law be provided by the alleged infringer (Industrial Property Act, Article 124(b)).

In case of copyright and related rights: the Court may upon a justified request of the party order that the information on the origin and distribution networks of the goods or services which infringe a right under the law be provided by the alleged infringer (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 a situation and what "remedial measures" are applicable to them?

In case of abuse of enforcement procedures, general rules on damages (Obligations Code, Articles 10, 131-189) will apply for the indemnification of the defendant (Enforcement and Securing of Civil Claims Act, Official Claims Act, Official Gazette No 2/2007, official consolidated text).

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 general rules on damages (Obligations Code, Article 148).

8. 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 lowest costs possible (Code of Civil Procedure, Article 11).

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

Provisional Measures

(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 the Court may order provisional measures to secure non-monetary damages: interdiction to the alleged infringer the continuation of infringement already commenced and future infringements; seizure, exclusion from circulation and taking into custody the objects of infringement and means of infringement that are intended or used exclusively or principally for infringement (Industrial Property Act, Article 123(5)(a)(b)).

In case of copyright and related rights the Court may order provisional measures to secure non-monetary damages: interdiction to the alleged infringer of the continuation of infringement already commenced and future infringements; seizure exclusion from circulation and taking into custody the objects of infringement and means of infringement that are intended or used exclusively or principally for infringement (Copyright and Related Rights Act, Article 170(1), 170(2), 170(5)).

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

In case of industrial property rights: if there are probable grounds for belief that the provisional measures above may not be effective at a later time, the court may order and execute such measures without prior notification and hearing of the opposite party (Industrial Property Act, Article 123(3)).

In case of copyright and related rights: if there are probable grounds for belief that the provisional measures above may not be effective at a later time, the court may order and execute such measures without prior notification and hearing of the opposite party (Copyright and Related Rights Act, Article 170(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 a right holder. Enforcement and Securing of Civil Claims Act, Article 266(1); Industrial Property Act, Articles 123(1), 123a, 124(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 a danger exists that the enforcement of claims will be made impossible or rather difficult, the adoption of a provisional measure is necessary to avoid damage difficult to repair or that a measure does not have more detrimental consequences for the alleged infringer than would have the non-adoption of such measure for the owner of the right: Industrial Property Act, Article 123(2); Copyright and Related Rights Act, Article 170(2).

Time limits

In its decision, the court is free to define the duration of the provisional measure and, in cases in which the measure was ordered before the beginning of another proceeding, the deadline from such a beginning (Enforcement and Securing of Civil Claims Act, Article 277(1)).

Defendant's safeguards

The defendant may file an opposition against a decision of adoption of a provisional measure. The court shall decide on opposition in 30 days: Industrial Property Act, Article 123(6); Copyright and Related Rights Act, Article 170(6). The Court may order the applicant to provide security for the defendant's damages which might occur due to the provisional measure (Enforcement and Securing of Civil Claims Act, Article 270(2)). The defendant himself may provide security for the right holders claims; in such a case the provisional measure is revoked (Enforcement and Securing of Civil Claims Act, Article 274(2) and (3)).

The defendant has the right to claim damages, caused with the provisional measure, if the measure had no legal ground (Enforcement and Securing of Civil Claims Act, Article 279).

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 cost possible (Code of Civil Procedure, Article 11; Enforcement and Securing of Civil Claims Act, Article 11(1)). The proceedings are summary (Industrial Property Act, Article 123(7); Copyright and Related Rights Act, Article 170(7)).

The actual duration of proceedings and their cost depend 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 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?

Special requirements related to border measures are defined by the Council Regulation (EC) No 1383/2003 of 22 July 2003 concerning customs action against goods suspected of infringing certain intellectual property rights and the measures taken against goods found to have infringed such rights (OJ L/196, 2.8.2003) and by the Act Implementing the Customs Regulations of the European Community, Official Gazette RS, No 25/2004, 28/2006, Articles 68-76.

Article 2 of Council Regulation EC No 1383/2003 covers besides counterfeit trademarks goods and pirated copyright goods also goods which infringe patent, supplementary protection certificate, national plant variety right under the law of that Member State or Community plant variety right and geographical indication of designation of origin.

The procedures do not apply to goods:

- bearing a trademark with the consent of the holder of that trademark, or to goods bearing a protected designation of origin or a protected geographical indication or which are protected by a patent or a supplementary protection certificate, by copyright or related right or by design right or a plant variety right and which have been manufactured with the consent of the right holder (Council Regulation EC No 1383/2003, Article 3(1));
- of a non-commercial nature within the limits of the duty-free allowance and there are no material indications to suggest the goods are part of commercial traffic (Council Regulation EC No 1383/2003, Article 3(2)).

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?

The main elements of the conditions governing action by the customs authority are the following:

- An application for the action is filed with the Customs Administration of the Republic of Slovenia, General Customs Directorate, Ljubljana (Act on Implementation of the EU Customs Regulations, Article 68(1)).
- The application must contain all information needed to enable the goods in question to be readily recognised by the customs authorities and in particular (i) an accurate and detailed technical description of the goods; (ii) any specific information the right holder may have concerning the type or pattern of fraud; (iii) the name and the address of the contact person appointed by the right-holder. The application for action must also contain the declaration accepting liability in the event that a procedure by the Customs Authorities is discontinued owing to an act or omission by the right holder or in the event that the goods in question are subsequently found not to infringe IPRs (Council Regulation EC No 1383/2003, Article 4(5) and Article 6).
- When granting an application the Customs Administration of the Republic of Slovenia shall specify the period during which the customs authorities are to take the action. The period shall not exceed one year (Council Regulation EC No 1383/2003, Article 8(1)).
- The customs office shall give the applicant and persons involved the opportunity to inspect goods whose release has been suspended or which have been detained (Council Regulation EC No 1383/2003, Article 9(3)).

- The decision granting the right holder's application for action shall immediately be forwarded to those customs offices of the Member States (in case of Slovenia the Customs Administration of the Republic of Slovenia) or States likely to be concerned by the goods alleged in the application to infringe an intellectual property right (Council Regulation EC No 1383/2003, Article 8(2)). There shall be no appeal against a decision issued by the Customs Administration of the Republic of Slovenia; however, an action in the administrative proceedings may be filed with the Administrative Court of the Republic of Slovenia in Ljubljana. The court shall decide on the case at its seat in Ljubljana (Act Implementing the Customs Regulations of the European Community, Article 70(1)).
- Security: the customs authority may order the right holder to post appropriate security for the expenses of transport and damages (Act on Implementation of the European Community Customs Regulations, Article 68(3)).
- The customs office may take the samples (Council Regulation EC No 1383/2003, Article 9(3)).

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?

The proceeding shall be guided in a fast way, under the lowest cost possible and shall not entail delays (General Administrative Procedure Act, Official Gazette RS, No 24/2006 - official consolidated text, Article 14).

The actual duration of proceedings and their cost depend 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.

Suspension or detention of the release of goods (Council Regulation (EC) No 1383/2003, Article 9(1)).

Destruction of goods because of silence of the supposed infringer (Act Implementing the Customs Regulations of the European Community, Article 71(1)(2)).

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 (Courts Act, Official Gazette RS, No 100/2005 - official consolidated text, Article 99).

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

Trademarks: unauthorized use of trademark or geographical indication (Penal Code, Official Gazette RS, No 95/2004 - consolidated text, Article 238(1)).

Industrial designs: unauthorized use (Penal Code, Article 238(2)).

Patents: unauthorized use of inventions and topographies (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(1)).

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 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: whoever makes, acquires, sells or lets another use implements, intended for breaking material gain was obtained and it was in the perpetrator's intention to obtain such material gain (Penal Code, Article 159(3)).

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

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

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. right holders, have standing to initiate criminal proceedings only in case of criminal acts under Articles 158 and 160 of the Penal Code.

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.**

Trademarks/geographical indication - unauthorized use: imprisonment for up to three years. The infringing goods and devices shall be confiscated on an obligatory basis (Penal Code, Article 238(1), 238(3)).

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

Patents: unauthorized use of inventions and topographies - imprisonment for up to three years. The infringing goods shall be confiscated on an obligatory basis (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 one year (Penal Code, Article 158(2)).

Copyright (economic rights): imprisonment for up to eight years. The infringing goods and devices for their reproduction shall be confiscated on an obligatory basis (Penal Code, Article 159).

Related rights (rights of performers): imprisonment for up to eight years (Penal Code, Article 160).

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

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 and their costs depend on the complexity of each individual case (Code of Criminal Procedure, Official Gazette RS, 63/94, Article 15).

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

The public prosecutor may file a summary charge sheet on the basis of a crime report alone (Code of Criminal Procedure, Article 430(2)).

The acts of investigation shall be carried out as quickly and efficiently as possible (Code of Criminal Procedure, Article 431(1)).

If the crime report is filed by the injured person (right holder) 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 (right holder) shall be entitled to assume prosecution subject to file the summary charge sheet with the court (Code of Criminal Procedure, 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) (Code of Criminal Procedure, Article 435(2)).

Once opened the main hearing shall proceed and end without interruption whenever possible (Code of Criminal Procedure, Article 443(1)).

An appeal against the judgement may be lodged within eight days of receipt of a copy thereof (Code of Criminal Procedure, Article 443(3)).
