

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

Responses from Uruguay

**Civil and Administrative Procedures and Remedies**

(a) *Civil judicial procedures and remedies*

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

The courts and tribunals with jurisdiction over civil matters.

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

It is the right holder that has standing. As regards appearances, the procedural rules generally require personal appearance by the right holder, although provision is made for representation through a proxy or through collective entities where justification has been provided. To be represented for the purposes of litigation, the right holder must provide a lawyer with a notarized power of attorney. In the case of copyright and related rights, representation of collective management entities is regulated by their own articles of association, but they must certify in writing that the holders of the rights they are seeking to assert have entrusted them with the administration of those rights.

Legal texts: Article 88 of Law No. 17.011; Article 99 of Law No. 17.164; Law No. 9.739 as reworded by Law No. 17.616; and Articles 11 and 38, 44 and 340.1 of the General Code of Procedure (CGP).

**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?**

CGP Article 168 - The party may ask the court to require the submission of evidence that is within the control of the opposing party within a time-frame decided by the court. Failure to provide such evidence shall be interpreted as a presumption against the party in question.

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

In civil proceedings, there are no specific rules.

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

**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.**

The ordinary courts are authorized to order infringers of industrial property rights to pay damages where there is fault or fraud. The payment of costs and charges may be ordered only in cases of bad faith or culpable negligence. These measures are provided for under Articles 84 and 87 of Law No. 17.011 and Articles 99, 100 and 102 of Law No. 17.164 as well as Articles 1.319, 1.323 and 1.324 of the Civil Code, which generally provides for liability and damages where there is fault or fraud.

In the case of copyright, Articles 16, 17 and 18 of Law No. 17.616 provide for judicial inspection at the request of a party; the authority of the court to order a search of the property in question without any counter-security; and without notifying the other party and precautionary measures.

**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?**

This is not provided for under Uruguayan 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 provisions relating to civil liability that may be incurred are the general provisions on the liability of public officials, including judges, contained in Articles 23 to 25 of the Constitution and, according to the majority of case law, in Article 1.319 of the Civil Code, which states that for there to be liability, there must at least be a culpable act. The conduct of the official may also lead to administrative and/or criminal liability, according to the circumstances of the case.

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

The duration of the proceedings is governed by articles 62 *et seq.* of the General Code of Procedure. The cost will differ 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.**

## Provisional Measures

### (a) *Judicial measures*

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

Generally speaking, provisional measures are designed to ensure that people's rights can be safeguarded, and in the intellectual property area, the most frequent measures are those that seek to put an end to the illegal activity, which may include the seizure of the infringing goods. The basis for providing this authority is precisely to avoid situations where at the end of the process, which must be conducted under the threat of expiry of the measure, it is still possible to protect the right, or to avoid continued violation of the right during the process. The relevant legal provisions are contained in the General Code of Procedure under Title II, "Precautionary Proceedings", Articles 311 to 317, and Article 103 of Law No. 17.164.

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

The rule is that the measures are ordered without the knowledge or intervention of the opposing party, although the affected party retains the right to appeal them, to offer alternative guarantees, or to file a motion for their modification, substitution, or cessation (CGP Articles 313 and 315).

**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.**

To request the adoption of a provisional measure, the requesting party must briefly establish the existence of the right and the danger of injury if that right is denied, and offer sufficient counter-security to guarantee any damage that may be suffered by the respondent. When the court deems that those requirements have been met (only exceptionally can exemption from the counter-security be granted) it orders the measure, and once it has done so, it must notify the affected party. On the other hand, if the measure was requested prior to the proceedings as a preliminary measure, it shall expire *de jure* if the complaint is not submitted within 30 days (CGP Article 311 to 315).

**13. Describe provisions governing the length and cost of proceedings?**

### (b) *Administrative procedures*

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

## Special Requirements Related to Border Measures

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

Only in the case of copyright and related rights, for which it is provided that the National Customs Directorate or the right holder may apply for special inspection measures, preventive seizure or precautionary suspension of customs clearance to the competent court which shall have 24 hours to rule, without need for a counter-security. Where the measure has been requested by the National Customs Directorate, the interested parties must be notified, and if no civil or criminal suit is filed, the measure shall be null and void (Article 63 of Law No. 9.739 as reworded by Article 25 of Law No. 17.616).

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?**

Only in criminal cases.

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

#### **Criminal Procedures**

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

The courts and tribunals with jurisdiction over criminal matters.

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

Those set out in Chapter XIV, Articles 81 to 89 of Law No. 17.011; Articles 106 and 107 of Law No. 17.164; and Articles 46 to 52 of Law No. 9.739 as reworded in Law No. 17.616.

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?**

Criminal proceedings can be initiated by the Public Prosecutor's Office. The Police and the Customs Authorities can file a complaint with the competent judicial authority.

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

The crimes cited in the aforementioned laws may be prosecuted at the request of a party, which must file a complaint with the competent judicial authority.

**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.**

All of the above-mentioned remedies are provided for in Articles 81 to 88 of Law No. 17.011; Articles 99 to 107 of Law No. 17.164; and Articles 46 to 52 of Law No. 9.739 as reworded in Law No. 17.616.

**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.**

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