

CONSIDERATIONS REGARDING PROVISIONAL MEASURES FOR THE PROTECTION OF INTELLECTUAL PROPERTY RIGHTS IN ROMANIA

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Abstract

The article takes a look at provisions in the Code of Civil Procedure dealing with the provisional measures that can be requested by the intellectual property right-holder in case of apparent infringements of his rights. Starting from the goals of such regulation, as provided by Directive 48/2004, the article examines what could be the hurdles imposed by the Romanian legislator (mostly by not providing sufficiently tailored means in respect of intellectual property rights) on the right-holder and proposes that, in light of the problems as reflected in the courts' practice, a legislative intervention be undertaken in order to better adapt the means to the purpose envisaged.

Keywords: *provisional measures, interim measures, intellectual property rights, injunction, procedure*

1. Introduction

The Civil Procedure Code having entered into force on 1 February 2013 provides, in articles 977 and 977, for provisional measures for the protection of intellectual property rights. These were formerly dealt with by a triad of legal instruments comprising provisions in special legislation concerning the measures for the protection of the specific intellectual property right concerned, the provisions of Emergency Government Ordinance 100 of 20 July 2005 ("GEO 100/2005")¹ and the provisions regarding the presidential ordinance of the Old Civil Procedure Code.

In their turn, both the special legislation concerning the measures for the protection of the specific intellectual property rights and GEO 100/2005 were amended or drafted so as to implement the provisions of Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights².

This short article aims to analyze whether the changes brought by the Civil Procedure Code bring any improvements to the situation where the provisional measures were sought without there being a specific regulatory provision for such in the Civil Procedure Code.

2. Content

The objective of Directive 24/2008 was "to approximate legislative systems so as to ensure a high, equivalent and homogeneous level of protection in the Internal Market" as provided by preamble 10 of the Directive. Therefore one of the goals of Directive 24/2008

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¹ Published in the Official Journal nr. 643/20.07.2005.

² OJ L 157, 30.04.2004, pp. 45-86.

was the provision of measures that were effective, proportionate and dissuasive while homogenous at Community level for the protection of intellectual property rights³.

The Romanian legislator has decided (in 2005) to implement the Directive by amending Law nr. 8/1996 concerning copyright and related rights ("Copyright Law"), on the one hand, and by enacting GEO 100/2005 in order to provide for the enforcement of industrial property rights, on the other⁴.

Leaving aside the fact that this artificial division makes little sense and contravenes the objectives of the Directive, as indicated in preamble 13 ("It is necessary to define the scope of this Directive as widely as possible in order to encompass all the intellectual property rights covered by Community provisions in this field and/or by the national law of the Member State concerned. Nevertheless, that requirement does not affect the possibility, on the part of those Member States which so wish, to extend, for internal purposes, the provisions of this Directive to include acts involving unfair competition, including parasitic copies, or similar activities"), the division has caused problems also in respect of the changes brought about by the enactment of the New Civil Code and New Civil Procedure Code.

Thus the Law implementing the New Civil Procedure Code, Law nr. 76/2012⁵, has amended both the Copyright Law and GEO 100/2005 in order to harmonize the level of protection granted to industrial property rights and copyright and related rights to the level provided for by Directive 48/2004.

Article 977 of the Code of Civil Procedure provides that the interim measures regulated by it and concerning interim measures for the protection of intellectual property rights apply in respect of both patrimonial and non-patrimonial rights (if concerning intellectual property) and that article 255 of the Civil Code provides interim measures for "other non-patrimonial rights".

This provision raises some issues in respect of its apparent excluding from the scope of interim measures provided by the Civil Code of the ones dealing with non-patrimonial intellectual property rights. This would not be of particular concern were the Civil Code not to expressly provide for substantive relief in respect of the infringement of such rights. This would in turn entail that while relief available for the infringement of non-patrimonial rights of authors of intellectual property would be available under article 253 of the Civil Code, interim relief in respect of such would only be available under the provisions of the Code of Civil Procedure. This would be awkward since the provisions of article 255 of the Civil Code and those of article 978 of the Code of Civil Procedure are identical, which means that the dissociation would, without any corresponding practical effect, merely require that the owner of a non-patrimonial right related to intellectual property claim for relief under the Civil Code and for interim relief under the Code of Civil Procedure while the owner of a non-patrimonial right not related to intellectual property would claim for both substantive and interim relief under the Civil Code⁶.

The interim measures especially available

The interim measures that can be requested are provided for by article 978 of the Code of Civil Procedure and generally relate to a claim that the court provisionally order the forbidding or the provisional cessation of the alleged breach of an intellectual property right

³ William Cornish, David Llewelyn, Tanya Aplin, *Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights*, 7th ed., (Sweet & Maxwell – London: 2010), 57.

⁴ Sonia Florea, *Proceduri civile în materia drepturilor de proprietate intelectuală*, (Universul Juridic: București, 2013), 136.

⁵ Published in the Official Journal nr. 365/30.05.2012.

⁶ Buta Paul-George, "Considerations Regarding the Scope of Provisional Measures for the Defense of Non-patrimonial Rights as Provided for in the Civil Code" in Mircea Duțu, Mihaela Tomiță (eds.), *The New Romanian Civil Code, two years after its entry into force*, (Medimond International Proceedings: Pianoro, 2013), 38.

(article 978, letter a)) and/or the securing of evidence (article 978, letter b)). We detail each, in turn, below.

The forbidding of the breach of the intellectual property right [paragraph (2) letter a) 1st thesis]

Although not expressly provided, as in the case of the 2nd thesis of letter a), the forbidding of an infringing act can be ordered only provisionally, for a period of time precisely determined, this being of the essence of the provisional measures and the procedure of the presidential ordinance by which such measures are to be ordered.

The possibility of provisionally forbidding the perpetration of the future act could not be requested, upon a strict interpretation of the text of law, not even in the case of the industrial property rights, when relying on GEO 100/2005, as art. 9 paragraph (1) letter a) provides the possibility of requesting the forbidding „under provisional title, that the alleged breach continues”. Subsequent to the modification of GEO 100/2005 by the Law nr. 76/2012 for the implementation of the new Code of Civil Procedure, the procedure for taking the interim measures was harmonized at the level of those specified by art. 978 of the Civil Procedure Code⁷.

This measure aims at provisionally forbidding the perpetration of the illicit action, if such action is imminent, while the forbidding for the future of the illicit action, which has already started and continues, makes the object of the measure provided by the 2nd thesis.

This raises the interesting question concerning the possibility of obtaining an order that the respondent make a declaration that he does not intend to breach the intellectual property rights of the plaintiff. Such order could be extremely useful especially in the case of generic entry where the generic company seeks regulatory approval before patent expiry (without intending to launch the product before patent expiry) but, due to the principle of parallel regulation (the pharmaceuticals regulatory bodies are not competent to assess possible infringements of intellectual property rights when assessing applications for regulatory approval) the modifications arising out of mere regulatory approval (even if not followed by actual launch of the generic) would cause damage to be incurred by the originator especially by means of the changes in the level of compensation by the public health insurance schemes.

In such cases the only remedy that the originator could have would be either an order that such changes not be operated before patent expiry (in which case the originator would have to seek injunctive relief against the authorities operating the public insurance program, which, in light of the fact that the generic normally applies for regulatory approval only a few months before patent expiry, could cause such claim to be heard only after patent expiry thereby leaving such claim without object) or, by means of the generic demanding that its regulatory approval become effective only after patent expiry (in which case the possibility of obtaining an order that the generic issue such request would be the only form of relief).

In both cases outlined above there is uncertainty as to the admissibility of a claim for interim relief to the effect sought. In the first case the issues that could be raised would pertain to the fact that the public authority is not a direct infringer itself, the fact that the authority would merely follow provisions of law in operating the changes and the fact that, in most likelihood, such interim injunction would, in fact, be a final injunction. In respect of the second case, the relief sought would not fall expressly within the scope of the provisions and the originator could be determined as lacking standing to bring such a claim since the generic would be willing to declare that it does not intend to launch before patent expiry and he would be under a legal obligation not to infringe beforehand. Moreover, in the second case the relief would be akin to a final relief rather than interim relief.

⁷ See Mihaela Tăbârcă, *Drept procesual civil*, vol. II, (Universul Juridic: 2013), 713-718.

The provisional cessation of the breach of intellectual property right [paragraph (2) letter a), 2nd thesis]

This time, the legislator provided expressly for the provisional character of this measure. The measure aims at the cessation for the future of the illicit act, if such is still ongoing.

The taking of the necessary measures to ensure the securing of evidence [paragraph (2) letter b)]

The “securing of evidence” can be realized, in the case of breach of intellectual property rights, even in the absence of this provision from the Civil Procedure Code, through the procedure of securing of evidence provided by the Civil Procedure Code by arts. 359-365. It is true that the analyzed text uses the expression “securing of evidence”, while the preservation of evidence, according to art. 235 Civil Procedure Code in force and art. 359 of the New Civil Procedure Code is made through the “collecting” of those evidence facing peril of disappearance or that would be difficult to be produced in the future, but the most used and useful manner of preserving evidence – if not the only one – is to produce such evidence prior to its alteration, destruction or disappearance.

The measures the court might consider necessary for the preservation of evidence, and which it might take, envisage for the most part, in our opinion, those measures considered by art. 359 of the Civil Procedure Code: acknowledging the confession of a party, the opinion of an expert, the status of goods, movable or immovable, the recognition of a writ, fact or right.

Although the text refers to the “preservation of evidence”, we believe that a teleological interpretation allows us to state that the court will be also able to order measures for the acknowledging of a certain situation of fact that might cease or change until the producing of evidence. But, even if the court will consider that the text of paragraph (2) letter b) of art. 255 of the new Civil Code does not allow it to do so, it would still be able to order such measure, if considered necessary, on the ground of art. 359 of the Civil Procedure Code.

The provisional measures provided by paragraph (2) letters a) and b) are those the legislator considered as being the most frequent and useful for the provisional protection of the intellectual property rights and that is why it stipulated that the courts may order them “especially”, therefore not exclusively. Consequently, the claimant may request to the court, and the judge may order, the taking of provisional measures other than those expressly provided.

The conditions necessary for taking the provisional measures

A first condition provided by paragraph (1), in order for the court to be able to take a provisional measure, is that the person considering himself harmed must make the credible proof of the fact that his intellectual property rights are the object of an illicit action. This means that the claimant has to prove both the action of breach of its intellectual property right and its illicit character⁸.

A second condition provided by the text of law is that the illicit action invoked by claimant should be actual or imminent, only in this case the urgency for the taking of the provisional measures being justified. The mere evidencing of the actual or imminent character of the act is of a nature to grant legitimacy to claimant’s enterprise, from the point of view of the urgency, because, in cases where there is an express provision concerning the taking of measures by way of presidential ordinance – as in this case – the court must no longer verify such condition, for it is presumed by the legislator.

⁸ See Mihaela Tăbârcă, *Drept procesual civil*, vol. II, (Universul Juridic: 2013), 713-718.

The third condition imposed by the text of paragraph (1), in order to be able to take the provisional measures – and which also falls under the general conditions of the presidential ordinance – is the existence of the risk that the illicit action causes a prejudice difficult to recover. It is about an imminent prejudice which has not occurred yet but will certainly occur, if the circumstances presented by the claimant do not change, so it is not about a possible prejudice. On the other hand, the request is admissible not only if the prejudice that may occur could not be repaired at all, but also if its subsequent repairing would be possible, but only with difficulty.

Paragraph (3) provides some supplementary conditions for the taking of provisional measures, in case of prejudices brought through the means of the written or audio-visual press. Thus, the court will not be able to order the cessation, under provisional title, of the prejudicial action unless: a) the prejudices caused to the claimant are severe; b) the action is not evidently justified, according to art. 75 of the Civil Code; and c) the measure which the court is to take, upon claimant's request, does not appear as disproportionate relatively to the caused prejudices.

The three supplementary conditions provided by paragraph (3) for the taking of the provisional measures in case of prejudices brought through the means of written or audio-visual media impose on the claimant a supplementary evidencing effort, while on the judge impose a deeper and more restrictive analysis in the taking of such measures, inclusively from the perspective of the international treaties and conventions Romania is a party to and to which art. 75 of the Civil Code refers, indicated by the very text of paragraph (3). From this perspective the judge is to analyze the seriousness of the prejudices, the obvious non-justified character of the action and the proportionate or disproportionate character of the provisional measure to be taken, relatively to the caused prejudice.

In the final part of paragraph (3) it is specified that the provisions of art. 253 paragraph (2) of the Civil Code remain applicable, which means that the court will be not able to order, by way of presidential ordinance, under the title of provisional measure, the forbidding of an imminent illicit deed, in case of breach of non-patrimonial rights by the exercising of the right to free speech.

If GEO 100/2005 imposed, in the matter of industrial property rights, with a view to the taking of provisional measures other than the preservation of evidence, only the first two conditions specified above (respectively the existence of an actual allegedly illicit action or with imminent effect), in case of the measure of preserving the evidence, the legislator not only imposed the satisfaction of all three conditions specified above, but in regard of the prejudice, the latter had to be „irreparable” and not only “difficult to be repaired”. Subsequent to the modification of GEO 100/2005 by Law nr. 76/2012 for the implementation of the new Code of Civil Procedure, the measures for the preservation of evidence shall be ordered according to the provisions of art. 978 of the respective Code.

The procedure for taking the provisional measures

The procedure for taking the provisional measures for the protection of intellectual property rights is provided by article 978 of the Code of Civil Procedure⁹.

Paragraph (4) provides that “*The court settles the request in line with the provisions concerning the presidential ordinance, which apply accordingly*”. Consequently, when taking the above mentioned provisional measures, the court will apply the ordinary law provisions of the special procedure concerning the presidential ordinance, respectively those of art. 996 – 1001 of the Code of Civil Procedure, although some of them have a “corresponding” application by reference to the specificity of the matter.

⁹ See Mihaela Tăbărcă, *Drept procesual civil*, vol. II, (Universul Juridic: 2013), 745-761.

Mention must be made of the fact that art. 998 of the Civil Procedure Code provides that the claim for interim relief is to be judged with the summoning of the respondent and with the providing for the respondent of the possibility to file a statement of defense. However, paragraph 2 of art. 998 provides that, upon receipt of the claim for interim relief the court may, in situations deemed as special emergencies by the court, order that the claim be ruled on without summoning the either of the parties and that the court may rule on the claim the very day the claim is filed.

Special mentions need to be made here in respect of the claims seeking interim relief for the alleged breach of intellectual property rights. A first such mention regards the claim for the securing of evidence. It is evident that on a literal reading of the provisions in art. 998 of the Civil Procedure Code the court should normally communicate the claim to the alleged infringer, allow him to file a statement of defense and only afterwards rule on the claim for the securing of evidence. Only where the court would find that there is a "special emergency" would it be allowed to rule on the claim without informing the respondent of the claim filed.

Since the claim for the securing of evidence is most obviously a claim that requires that the respondent not be aware of the intentions of the plaintiff, given that the very purpose of the provisions governing the admissibility of the claim refer expressly to the need for securing evidence that would otherwise be destroyed or lost, it appears as the provisions governing the presidential ordinance generally, need to be adapted in order to allow the fulfilling of the special role envisaged by the legislator for the provisions governing the interim relief for alleged infringements of intellectual property rights. Thus, if the plaintiff were to prove that the evidence would be destroyed or lost if not secured at that particular time, the onus of proof on the plaintiff would be quite high given that the factor that would trigger the risk of the evidence being destroyed would be precisely the informing of the respondent of the intentions of the plaintiff to file for infringement. Therefore the court should interpret "otherwise" widely so as to include situations where the evidence would be destroyed or lost only as a result of the actions (albeit legitimate) of the right-holder.

Moreover, in practice, even where the court would allow for such a claim to be ruled on without summoning the parties, in order to assign the docket to a judge in the manner provided by the provisions of the Civil Procedure Code, the court clerk would need to first register the docket in the electronic docket management system (ECRIS)¹⁰, the information contained therein being accessible to the public (i.e. also to the respondent). Therefore the respondent could in fact know of any claims filed against him by merely searching his name with the ECRIS system. Afterwards the respondent may request that he access the file and check for himself the exact relief sought (including type of evidence to be collected, the locations to be searched). Finally, using the same ECRIS system, the respondent could in fact know when the order is granted and prepare accordingly. The respondent could also file a motion of defense (even if not summoned) and file an appeal (which however would not, of its own, suspend execution of the order granted by the first-instance court).

This obvious disadvantage to the right-holder most certainly goes against the purpose of Directive 48/2004 in allowing the right-holder effective means to secure evidence of possible infringements.

Such disadvantage could be avoided if the order for the securing of evidence were to be always granted without summoning the respondent. However the avoiding of the claim being registered with ECRIS and published on-line could not be so avoided. The only way to make this information not harm the plaintiff would be to always rule on the claim the same day as filed and provide the reasons for such without delay.

¹⁰ See art. 93 of the Internal Regulation of the Courts published in the Official Journal no. 958/28.10.2005.

In practice¹¹ however the courts appear to favor the normal route for claims for provisional relief, which means that upon their being registered with the court clerk they are registered with ECRIS, assigned to a judge who includes them on the list of cases previously assigned and then sets a date for ruling upon such within approximately one month. This allows the respondent to study the file and even file a statement of defense. Moreover the fact that the terms set for issuing the grounded decision (provided by the Code of Civil Procedure not to exceed 48 hours after the ruling) are regarded by the courts as indicative and not imperative results in the grounded decision (which alone can be enforced) to be issued only after a relatively long time since the ruling thus giving the respondent plenty of time to prepare for the eventual enforcement of the order.

One can observe that this practice of the courts, in the absence of express provision to the contrary in the law, voids the claim for the securing of evidence of most of their purpose and thus explain the overall scarcity of jurisprudential activity in this domain.

This is even more of a problem when considering the above mentioned cases concerning generic entry where the declaration to be sought from the generic (in order to prevent the changes to the level of compensation to be paid to the originator by the national public insurance scheme) can only be obtained by means of an adapted form of the order for the securing of evidence and needs to be obtained very quickly in order to prevent the changes being operated by the public authority.

3. Conclusions

1. The current framework for the protection of intellectual property rights, by being dependent on procedural issues on the generic regulation concerning the presidential ordinances, fails to fulfill the purpose envisaged by the European legislator in the enactment of Directive 48/2004. Moreover such failure to provide for actual means to protect intellectual property rights is not only a potential infringement of the European law but also a potential failure by the Romanian state to fulfill its duties in respect of obligations assumed under international treaties, such as the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS)¹².

2. In view of the particular objectives and the specificity of intellectual property rights enforcement a better adapted protection framework is needed in respect of these rights and therefore, in the absence of a jurisprudential practice doing so, the Romanian legislator should provide for specific, tailored means of obtaining provisional relief for infringements of intellectual property rights. Such a tailored regulatory framework should follow the objectives of Directive 48/2004 and the implementation of this Directive in other Member States.

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¹¹ See, for example, Decision 394/31.03.2014 of the Bucharest Tribunal, 4th chamber (http://portal.just.ro/3/SitePages/Dosar.aspx?id_dosar=300000000572496&id_inst=3, accessed on 11 April 2014).

¹² Hector MacQueen, Charlotte Waelde, Graeme Laurie, Abbe Brown, *Contemporary Intellectual Property Law and Policy*, 2nd ed., (Oxford University Press: Oxford, 2010), 955-956.

- Decision 394/31.03.2014 of the Bucharest Tribunal, 4th chamber (http://portal.just.ro/3/SitePages/Dosar.aspx?id_dosar=300000000572496&id_inst=3, accessed on 11 April 2014)