

HARMONIZATION OF NATIONAL PROCEDURAL PROVISIONS CONCERNING THE ENFORCEMENT OF INTELLECTUAL PROPERTY RIGHTS

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Abstract

This short paper looks at provisions concerning very specific aspects provided for at international, regional and national level and analyzes the level of harmonization between such. Given the importance of provisional measures (and especially of preliminary injunctions) for the protection of intellectual property rights, the provisions concerning this subject were the main focus of our analysis. Found in TRIPS, the EU IP Enforcement Directive and national Romanian statutory provisions, we've concluded that these are not directly applicable in disputes in Romanian courts and were therefore, as a result of multiple international obligations, supposed to be harmonized. We've looked at different aspects in parallel with the development of implementation mechanisms and found that, despite the aforementioned obligations, not even the Directive is fully TRIPS compliant, let alone the Romanian national statutory provisions. We've therefore concluded that, even if common sense would dictate that protection at more levels would equal more protection this is not necessarily true, given the fact that multiple harmonization requirements create more opportunity for divergent implementation results – influenced by either benign factors (different national legal traditions, different interpretations) or malign (lack of perspective and/or understanding, rush to implementation).

Keywords: *harmonization, intellectual property rights, provisional measures, preliminary injunctions, TRIPS, IP Enforcement Directive, procedures.*

1. Introduction

It is generally accepted that intellectual property is only protectable by legal means which makes the legal protection of intellectual property to be regarded as more valuable than its physical embodiment¹.

Without going into the details of it, we could shorthand legal protection in this case to mean the possibility of asserting a claim related to intellectual property rights against someone with a correlative duty to act (or abstain from certain acts)². Therefore enforcement of intellectual property rights goes to the core of their value and is intrinsically linked with the very existence of such value.

There is no surprise therefore that provisions concerning the enforcement of intellectual property rights were inserted in acts existing at national, regional and international level.

Such provisions deal with both material and procedural aspects of the enforcement of intellectual property rights. Since for the purposes of comparison aspects of material law require a more comprehensive analysis (as they require, among other factors, that particularities of given legal systems be taken into account), for present purposes we will limit ourselves to provisions dealing with procedural aspects.

Of the procedural aspects dealt with at all levels, the ones dealing with provisional measures³ (and

especially preliminary injunctions) would appear to us as being the most salient in terms of the need of harmonization. We base this mainly (but not exclusively) on the following assumptions: (1) preliminary injunctions are the most effective tool for right-holders to maintain exclusivity, which in turn is the essence of intellectual property rights; and (2) preliminary injunctions are the first enforcement mechanism of choice since they provide relief on an urgent basis which in turn requires that foreign right-holders should be able to obtain such relief without engaging significant costs and time for researching local legal particularities in order to obtain such relief (which would no longer be reasonably fast and efficient, let alone effective).

For present purposes therefore we will focus on the procedural provisions dealing with preliminary injunctions.

The present article looks at the influences that such provisions have one on another in a unidirectional perspective, downwards from the international level in order to verify whether there is an obligation for harmonization and whether the provisions are indeed harmonized (and if so, to what extent).

We will first set out the provisions as found at the three relevant levels, analyze whether an obligation for harmonization exists in respect of the instruments where such provisions were found and, finally, check

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¹ Jeremy Phillips and Alison Firth, *Introduction to Intellectual Property Law*, 4th ed. (Oxford: Oxford University Press, 2006), 12-13

² „legal right”, Bryan A Garner (ed.) *Black's Law Dictionary*, 8th ed. (St. Paul: Thompson West, 2004), 1348

³ Defined by the Court of Justice of the European Union in CJUE, *Mario Reichert, Hans-Heinz Reichert and Ingeborg Kockler v. Dresdner Bank AG* (C-261/90), decision of 26 March 1992 in ECR I-2149, par. 34 as “measures which, in matters within the scope of the Convention, are intended to preserve a factual or legal situation so as to safeguard rights the recognition of which is sought elsewhere from the court having jurisdiction as to the substance of the matter”

whether the provisions are harmonized (and, if so, to what extent) or not.

2. The provisions at the international level

At the international level we can note the reluctance to include procedural provisions in the WIPO-administered treaties though we can find general obligations imposed to this effect in article 2 par. (1) of the Paris Convention for the Protection of Industrial Property and in art. 15 of the Berne Convention for the Protection of Literary and Artistic Works.

More specific reference is to be found in articles 14 and 23 of the WIPO Copyright Treaty and the WIPO Performances and Phonograms Treaty, respectively. Paragraph (2) of each of those articles indicates that „Contracting Parties shall ensure that enforcement procedures are available under their law so as to permit effective action against any act of infringement of rights covered by this Treaty, including expeditious remedies to prevent infringements and remedies which constitute a deterrent to further infringements”.

The most detailed and complex provisions concerning preliminary injunctions for infringement of intellectual property rights are to be found however in TRIPS.

Section 3 of the third part of the treaty deals solely with provisional measures. Although the section only comprises one single article (art. 50), it is both comprehensive and self-sufficient. A proper analysis however would require that attention be also paid to the provisions in Section 1 of the same part, entitled „General Obligations”.

In that sense, provisions under paragraphs 1 and 2 of art. 41 would also apply in respect of preliminary injunctions. These require that members of WTO ensure that enforcement procedures as specified in TRIPS: (1) are available; (2) to permit effective action against infringement rights covered by TRIPS; (3) are to include: (a) „expeditious remedies to prevent infringements” and (b) „remedies which constitute a deterrent to further infringements”; (4) are not applied so as to create barriers to legitimate trade; (5) provide for safeguards against their abuse; (6) are fair and equitable; (7) are not unnecessarily complicated or costly, or entail unreasonable time-limits or unwarranted delays.

Art. 50, however, contains the provisions most relevant to the scope of this article.

Paragraph (1) demands that judicial authorities have the power to „order prompt and effective provisional measures: (a) to prevent an infringement of any intellectual property right from occurring, and in

particular to prevent the entry into the channels of commerce in their jurisdiction of goods, including imported goods immediately after customs clearance; (b) to preserve relevant evidence in regard to the alleged infringement”.

The second and fourth paragraphs deal with *ex parte* procedures and allow enforcement provisional measures to be taken *ex parte* „where appropriate, in particular where any delay is likely to cause irreparable harm to the right holder, or where there is a demonstrable risk of evidence being destroyed” but with the express requirement that „the parties affected shall be given notice, without delay after the execution of the measures at the latest” and that „a review, including a right to be heard, shall take place upon request of the defendant” to decide, in a reasonable period of time, whether the provisional measures are to be modified, revoked or confirmed.

Paragraphs 3 and 5 deal with the standard of proof in such claims (judicial authorities are to be able to demand that the applicant provide „any reasonably available evidence in order to satisfy [...] with a sufficient degree of certainty that the applicant is the right holder and that the applicant’s right is being infringed or that such infringement is imminent, and to order the applicant to provide a security or equivalent assurance sufficient to protect the defendant and to prevent abuse” as well as “information necessary for the identification of the goods concerned by the authority that will execute the provisional measures”.

As further safeguards against abuse par. (6) provides that provisional measures are to cease or be revoked if a claim on the merits is not filed within “a reasonable period [...] not to exceed 20 working days or 31 calendar days, whichever is the longer”.

Moreover paragraph (7) indicates that upon revocation, lapse or a finding of non-infringement or inexistence of a threat of infringement “the judicial authorities shall have the authority to order the applicant, upon request of the defendant, to provide the defendant appropriate compensation for any injury caused by these measures”.

In respect of the provisions of art. 50 TRIPS it has been stated that these are to be analyzed as implementations of art. 41 par. (1) TRIPS’ call for expeditious procedures⁴ and therefore any “delays and other domestic mechanisms endangering the effectiveness of provisional legal protection will thus cause concern to the extent that they cannot be justified by art. 41.5”⁵.

Commentary of the provisions generally indicates that, as an effect of the provisional nature of the relief sought, such would only be justifiable where delay in imposing the measure would result in irreparable damage to the right-holder, where the

⁴ Sascha Vander „Article 50” in Peter-Tobias Stoll, Jan Busche, Katrin Arend (ed.) *WTO – Trade-Related Aspects of Intellectual Property Rights*, (Leiden: Martinus Nijhoff Publishers, 2009): 740

⁵ Daniel Gervais, *The TRIPS Agreement, Drafting History and Analysis*, 2nd ed., (London: Sweet & Maxwell, 2003), par. 2.422 cit. in Sascha Vander „Article 50” in Peter-Tobias Stoll, Jan Busche, Katrin Arend (ed.) *WTO – Trade-Related Aspects of Intellectual Property Rights*, (Leiden: Martinus Nijhoff Publishers, 2009): 740, note 4

measure would be warranted under a balance of convenience test and where there is considerable likelihood of a *de facto* infringement⁶.

Also interestingly it has been argued that art. 50 TRIPS only applies “to the period after release by the customs authorities”⁷ which would make the customs authorities’ practice of allowing the continuing detention of seized goods subject to the mere lodging of a claim for interim relief questionable (the filing of a main claim for infringement of the right based on which the customs intervention was accepted being necessary). However, given that the provision of art. 50 par. (1) letter a) is merely exemplary, a wider interpretation could be allowed.

When read in conjunction with art. 50 par. (3) it is clear that the provision covers both actual and imminent infringements⁸.

In order for measures to be taken *ex parte* there would need to be “special reasons” such as delay that would cause irreparable harm or a “demonstrable risk of evidence being destroyed” but „the presence of a special reason may in general be assumed to the extent that informing the defendant runs the danger of seriously impeding or excluding the enforcement of the claimant’s IPRs”⁹.

3. The provisions at EU level

At EU level the relevant provisions are included in Directive 2004/48 of 29 April 2004 on the enforcement of intellectual property rights.

The directive’s preamble (par. (3)) indicates that “the means of enforcing intellectual property rights are of paramount importance for the success of the Internal Market” so as to underline the importance of these provisions.

Paragraphs (4) and (5) of the preamble mention the relationship with TRIPS provisions reminding that “all Member States, as well as the Community itself as regards matters within its competence, are bound by the Agreement on Trade-Related Aspects of Intellectual Property (the “TRIPS Agreement”)” which “contains, in particular, provisions on the means of enforcing intellectual property rights, which are common standards applicable at international level and implemented in all Member States”.

The preamble also indicates however that the “directive should not affect Member States’ international obligations, including those under the TRIPS Agreement” and that the directive “does not aim to establish harmonized rules for judicial cooperation, jurisdiction, the recognition and enforcement of decisions in civil and commercial matters, or deal with applicable law”.

The need for the directive has arisen, as par. (7) of the preamble indicates, since “despite the TRIPS Agreement, there are still major disparities as regards the means of enforcing intellectual property rights. For instance, the arrangements for applying provisional measures, which are used in particular to preserve evidence, the calculation of damages, or the arrangements for applying injunctions, vary widely from one Member State to another. In some Member States, there are no measures, procedures and remedies such as the right of information and the recall, at the infringer’s expense, of the infringing goods placed on the market”.

Paragraph 22 underlines the necessity for provisions dealing with provisional measures in order to secure “provisional measures for the immediate termination of infringements, without awaiting a decision on the substance of the case”, such measures being “particularly justified where any delay would cause irreparable harm to the holder of an intellectual property right”. These would need however to be applied only in respect of act carried out on a commercial scale¹⁰ (without prejudice to the possibility of Member States applying such measures also in respect of other acts).

Moreover the preamble indicates that such provisions are to observe the rights of the defense, to ensure “the proportionality of the provisional measures as appropriate to the characteristics of the case in question” and to provide “the guarantees needed to cover the costs and the injury caused to the defendant by an unjustified request”.

The general obligation under art. 3 imposes that such measures are (1) available (“Member States shall provide”), (2,3) that they include measures, procedures and remedies necessary to ensure the enforcement of the intellectual property rights that are effective, proportionate and dissuasive, (4) are applied so as to avoid the creation of barriers to legitimate trade, (5) provide for safeguards against their abuse, (6) are fair and equitable and are not (7) unnecessarily complicated or costly, or entail unreasonable time-limits or unwarranted delays.

As mentioned in par. (7) of the preamble, one of the issues the EU legislator had taken with TRIPS related to the measures for the preserving of evidence.

Art. 7 of the directive therefore creates a uniform mechanism to address this.

Such measures may be requested even before the commencement of proceedings on the merits of the case by a party who has presented “reasonably available evidence to support his claims that his intellectual property right has been infringed or is about to be infringed”. The court may order “prompt

⁶ Sascha Vander „Article 50”: 741

⁷ *Idem*

⁸ *Idem*: 742

⁹ *Idem*: 744

¹⁰ Defined as acts “carried out for direct or indirect economic or commercial advantage; this would normally exclude acts carried out by end-consumers acting in good faith” – par. (14) of the preamble.

and effective provisional measures to preserve relevant evidence in respect of the alleged infringement, subject to the protection of confidential information". Art. 7 (1) exemplifies such measures as the detailed description of the allegedly infringing products/services (with or without the taking of samples) and the physical seizure of the allegedly infringing goods (and also, where appropriate, of the materials and implements used in the production and/or distribution of these goods and the documents relating thereto).

Article 9 deals with provisional and precautionary measures and requires that courts in Member States may either (a) issue an interlocutory injunction intended to prevent any imminent infringement, (b) forbid, on a provisional basis and subject, where appropriate, to a recurring penalty payment where provided for by national law, the continuation of the alleged infringement and/or (c) order the seizure or delivery up of the goods suspected of infringing an intellectual property right so as to prevent their entry into or movement within the channels of commerce.

An injunction as under (a) or (b) above can be entered also against an intermediary whose services are being used by a third party to infringe an intellectual property right (however the directive indicates that "injunctions against intermediaries whose services are used by a third party to infringe a copyright or a related right are covered by Directive 2001/29/EC").

In addition to the above, where the alleged infringement is committed on a commercial scale, Member States must ensure that courts can, where the "injured party demonstrates circumstances likely to endanger the recovery of damages", order the precautionary seizure of the movable and immovable property of the alleged infringer, including the blocking of his bank accounts and other assets (to which end "competent authorities" can order the communication of bank, financial or commercial documents, or appropriate access to any such relevant information).

Just as in the case of claims for the securing of evidence, in claims for provisional measures provided by art. 9 the court may ask that the right-holder provide any reasonably available evidence as to the alleged infringement or such imminent infringement. In addition to this, in claims for provisional measures the directive specifically allows courts to demand that the right-holder furnish reasonably available evidence so as to satisfy the court with a sufficient degree of certainty that the applicant is the right-holder.

The directive provides that any of the measures mentioned above could be taken *ex parte*, "in particular where any delay is likely to cause irreparable

harm to the right-holder" or, in the case of measures to secure the preservation of evidence, "where there is a demonstrable risk of evidence being destroyed". In such cases the "affected parties" shall be given notice of the measures taken at the latest immediately after execution of the measures. Moreover such parties are entitled to an *inter partes* judicial review "within a reasonable period after the notification of the measures" so as to determine whether the measures are to be modified, revoked or confirmed.

Moreover, in respect of any of the measures indicated, the directive provides that any such measure taken is to be revoked or ceases to have effect, upon request of the defendant, where the applicant does not institute court proceedings leading to a decision on the merits within a period to be determined by the court instituting the measures but not longer than the longest of either 20 working days or 31 calendar days.

Also in respect of any of the measures mentioned above, the directive allows (but does not require) the courts to make the measures subject to the right-holder lodging "equivalent security or an equivalent assurance" in order to compensate the defendant for any prejudice suffered should the provisional measures be revoked, lapse due to any act or omission by the right-holder or where it is subsequently found that there has been no infringement or threat of infringement of an intellectual property right.

In such cases moreover the courts must have the authority to "order the applicant, upon request of the defendant, to provide the defendant appropriate compensation for any injury caused by those measures".

When comparing the provisions of the directive with those of TRIPS we can observe some differences, such as: the types of measures such as those enumerated by art. 7 par. (2-4) of the directive are not indicated in art. 50 TRIPS¹¹, the possibility to forbid the continuation of the alleged infringement by lodging of guarantees¹², the possibility of freezing assets¹³.

4. The provisions at the national level

Article 978 of the Romanian Code of Civil Procedure provides that the interim measures provided therein 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 Romanian Civil Code provides interim measures for "other non-patrimonial rights".

The interim measures that can be requested of the court are provided for by article 979 of the Code of Civil Procedure and generally relate to a claim that the

¹¹ Although they are considered to be of the kind had in mind when enacting the provisions - Sascha Vander „Article 50”: 742

¹² Danny Friedmann, "The Effects of the Enforcement Directive on Dutch patent law. Much Ado About Nothing?", <http://ssrn.com/abstract=1706070>: 22

¹³ Idem: 23

court provisionally order the forbidding or the provisional cessation of the alleged breach of an intellectual property right (article 979, letter a)) and/or the securing of evidence (article 979, letter b)).

Although not expressly provided, as in the case of the 2nd thesis of letter a), pursuant to the first thesis, 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.

This measure thus 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.

With respect to the provisional measures for the securing of evidence, provided by art. 979 paragraph (2) letters a) and b), these are those that 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, and the judge may order, the taking of provisional measures other than those expressly provided for in the statutory provision.

With respect to the conditions that need to be met in order for such interim relief to be granted, three such conditions are normally identified within the provisions of art. 979 par. (1) of the Civil Procedure Code: (1) that the claimant make 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 act of breach of his intellectual property right and its illicit character¹⁴; (2) that the illicit action be either 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 enough to show urgency since, where there is an express legal provision allowing such measures by way of presidential ordinance – as in this case – the court must no longer verify such condition, such being presumed by effect of law; and (3) the existence of a risk that the illicit action causes a prejudice difficult to recover. There needs to be a show of imminent harm (i.e. even one that has not yet occurred yet but will certainly occur, if the circumstances presented by the claimant do not change) but such damage does not include damage that is only possible. In respect of the possibility to repair such harm, the law does not

require that such damage be impossible to repair but only that it be repaired with difficulty.

Par. (3) of art. 979 provides some supplementary conditions for the taking of provisional measures where damage is caused by means of the written or audio-visual press. In such cases the court can't order the provisional cessation of the prejudicial act unless: a) the damage caused to the claimant is severe; b) the act is not a clearly justified act in accordance with the provisions of art. 75 of the Civil Code; and c) the envisaged measure is not disproportionate as to the damage it causes.

The procedure for taking the provisional measures for the protection of intellectual property rights is provided by article 979 of the Code of Civil Procedure¹⁵ where par. (4) provides that “*The court settles the request in line with the provisions concerning the presidential ordinance, which apply accordingly*”.

Consequently, for taking such provisional measures, the court will apply the provisions regarding the special procedure of the presidential ordinance (art. 997 – 1002 of the Code of Civil Procedure), although these are to be applied only where they do not contradict (or as long as they “correspond”) to those of art. 978-979.

Mention must be made of the fact that art. 999 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. 999 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 upon without summoning either of the parties and that the court may rule on the claim in chambers, relying solely on the claim as filed, on the very day the claim is filed.

5. Harmonization with TRIPS at EU level

Although the harmonization of national legislations of EU Member States in order to match the level of protection provided by TRIPS was indicated as one of the goals of the IP Enforcement Directive¹⁶, there were eminent voices that indicated that the EU Member States were already bound to respect those rules¹⁷ and that, prior to proposing the directive, the EU Commission did not undertake any study to suggest the EU Member States did not¹⁸.

The issue of the effect of TRIPS on EU law was analyzed by the Court of Justice in its Opinion of 15 November 1994 regarding the competence of the Community to conclude international agreements

¹⁴ Mihaela Tăbărcă, *Drept procesual civil*, vol. II, (București: Universul Juridic, 2013), 713-718

¹⁵ Mihaela Tăbărcă, *Drept procesual civil*, vol. II, (București: Universul Juridic, 2013), 745-761

¹⁶ Par. (7) of the preamble of the Directive

¹⁷ As a result not only of their own WTO membership but also as a matter of Community law since the EU was itself a member of the WTO

¹⁸ William R. Cornish, Josef Drexler, Reto Hilty and Annette Kur, “Procedures and Remedies for Enforcing IPRs: the European Commission's Proposed Directive”, *E.I.P.R.* 25 (2003): 447

concerning services and the protection of intellectual property - Article 228 (6) of the EC Treaty¹⁹.

There the Court has indicated that: "Some of the Governments which have submitted observations have argued that the provisions of TRIPs relating to the measures to be adopted to secure the effective protection of intellectual property rights, such as those ensuring a fair and just procedure, the rules regarding the submission of evidence, the right to be heard, the giving of reasons for decisions, the right of appeal, interim measures and the award of damages, fall within the competence of the Member States. If that argument is to be understood as meaning that all those matters are within some sort of domain reserved to the Member States, it cannot be accepted. The Community is certainly competent to harmonize national rules on those matters, in so far as, in the words of Article 100 of the Treaty, they 'directly affect the establishment or functioning of the common market'. But the fact remains that the Community institutions have not hitherto exercised their powers in the field of the 'enforcement of intellectual property rights', except in Regulation No 3842/86 [citation omitted] laying down measures to prohibit the release for free circulation of counterfeit goods. It follows that the Community and its Member States are jointly competent to conclude TRIPs".

Later, in *Dior*²⁰ and *Merck Genéricos*²¹, the Court has decided that it itself can, despite the separation of competences mentioned in Opinion 1/94, decide on the interpretation of art. 50 TRIPS even for rights not having been the subject of harmonization.

Moreover the Court has held that, in principle, "the provisions of TRIPs, an annex to the WTO Agreement, are not such as to create rights upon which individuals may rely directly before the courts by virtue of Community law", however, inasmuch as art. 50 of TRIPS contains procedural provisions, which are „intended to be applied by Community and national courts in accordance with obligations assumed both by the Community and by the Member States", in the case of „a field to which TRIPs applies and in respect of which the Community has already legislated, as is the case with the field of trade marks, it follows from the judgment in *Hermès*, in particular paragraph 28 thereof, that the judicial authorities of the Member States are required by virtue of Community law, when called upon to apply national rules with a view to ordering provisional measures for the protection of

rights falling within such a field, to do so as far as possible in the light of the wording and purpose of Article 50 of TRIPs. On the other hand, in a field in respect of which the Community has not yet legislated and which consequently falls within the competence of the Member States, the protection of intellectual property rights, and measures adopted for that purpose by the judicial authorities, do not fall within the scope of Community law. Accordingly, Community law neither requires nor forbids that the legal order of a Member State should accord to individuals the right to rely directly on the rule laid down by Article 50(6) of TRIPs or that it should oblige the courts to apply that rule of their own motion"²².

In what procedural provisions related to the interim protection of intellectual property rights there was, at first sight, a distinction to be made, when analyzing the utility of a directive, between the fields where there was prior harmonization and those where there was none. This means that the directive would have been useful in its harmonization aim, for those fields where there was an uncertainty as to the level of direct effect of TRIPs (were there no national provision to enable direct effect of the provisions in national law). In such cases, harmonization by means of the directive would have achieved the same result on account of the Member States' obligation to transpose the directive into their national law.

Objections raised by Cornish in that there was no prior analysis to this effect would still be valid nonetheless.

Despite the above the directive set out to secure a "TRIPs-plus" harmonization²³, an example of such being the mandatory right of information (which was optional under art. 47²⁴ or 50 par. (5) of TRIPs)²⁵.

Massa and Strowel have argued that this TRIPs-plus harmonization was diluted by the TRIPs-minus scope (making the remedies available just for infringements on a commercial scale)²⁶ even though the directive leaves Member States free to extend those remedies to other situations as well.

It is this last aspect that for Massa and Strowel the national legislator was to overcome by its approach in implementation. The authors have suggested that a commutative approach (which would mean enacting an umbrella law on procedures and remedies for all IPRs) was preferable to a distributive approach (which

¹⁹ Opinion, 1/94, EU:C:1994:384, paragraph 102-103

²⁰ CJEU, *Parfums Christian Dior SA v TUK Consultancy BV and Assco Gerüste GmbH and Rob van Dijk v Wilhelm Layher GmbH & Co. KG and Layher BV* (joined cases C-300/98 and C-392/98), decision of 14 December 2000 in ECR 2000-I, p. 11307

²¹ CJEU, *Merck Genéricos - Produtos Farmacêuticos Ld^a v Merck & Co. Inc. and Merck Sharp & Dohme Ld^a* (C-431/05), decision of 11 September 2007 in ECR 2007-I, p. 7001

²² CJEU, *Parfums Christian Dior SA*, par. 44-48

²³ European Commission Press Release IP/03/144 and Explanatory Memorandum at p. 12 et seq. cit. in Charles-Henry Massa and Alain Strowel, "The Scope of the Proposed IP Enforcement Directive: Torn between the Desire to Harmonise Remedies and the Need to Combat Piracy" in *European Intellectual Property Review*, 26 (2004): 246, note 23

²⁴ Cornish, Drexler, Hilty and Kur, "Procedures and Remedies": 449, note 4

²⁵ See also Violeta Vişean, "The Implementation of Directive 2004/48/EC in Romania" in *Revista Română de Dreptul Proprietății Intellectuale*, 4 (2009): 147

²⁶ Massa and Strowel, "The Scope of the Proposed IP Enforcement Directive": 246

would mean interspersing amendments in each IPR law)²⁷.

6. Harmonization at national level

In Romania there has been little research on the compatibility of the national provisions with TRIPS²⁸ but significant effort has gone into analyzing the implementation of the EU IP Enforcement Directive²⁹.

It has been argued³⁰ that the national provisions, before implementation of the Directive, being already aligned with the provisions of the European act, were more favorable than the provisions of TRIPS in that they made the payment of security for the covering of the eventual liability of the respondent optional at the behest of the court, rather than mandatory as under TRIPS³¹.

Körösi has also shown that the provisions of art. 50 par. (4) and (6) TRIPS were not transposed in Romanian law³² thereby making the Romanian provisions even more favorable to the right-holder³³.

She has however argued that this disadvantage (which is also at odds with the provisions of art. 9 par. (5) of the Directive) is mitigated by the direct effect of TRIPS provisions in Romania³⁴.

Nonetheless, the Romanian legislator has finally opted for an apparently “commutative” approach to implementation of the Directive by adopting a stand-alone Emergency Government Ordinance (no. 100/2005) which is, as some commentators have suggested, a translation of the Directive³⁵. The same author declared that, contrary to Massa and Strowel, a distributive approach would have been preferable.

The scope of the implementation act is however different than that of the Directive since the EGO applies only to industrial property rights while the Directive applies to intellectual property rights. The fact that the Romanian legislator has excluded copyright and related rights from the scope of the

Directive implementation act would have been, however, appreciated by Massa and Strowel³⁶. Implementation in respect of copyright has however occurred by a distributive approach implemented by means of Emergency Government Ordinance no. 123/2005³⁷.

Ciocea argues³⁸ that the imposition, by means of art. 7 of EGO 100/2005 of the lodging of security for the compensation of the defendant the Romanian legislator has gone beyond the scope of the Directive (though, as seen above, such an approach had been recommended by Spineanu-Matei in order to secure compliance with TRIPS).

The implementation act is further criticized as being too broad and not providing express procedures that would properly implement the provisions of the Directive³⁹.

Ionescu argues that the provisions of EGO 100/2005 do not contravene TRIPS but do go further than TRIPS in providing for the right-holder (thus being seen as TRIPS-plus) in that they allow for the measures to be taken against not just the alleged infringer but also intermediaries, that they provide for a right of information, that the measures can be taken before a claim for infringement is filed and that they provide for the possibility of asset freezing⁴⁰.

Ionescu importantly points out that the implementation act provides for the annulment of the measures where there is no claim on the merits filed within 20 working days or 31 calendar days, whichever is the longest, thus filling a gap in harmonization with both TRIPS and the Directive⁴¹.

Another fault identified with the implementation act was the lack of clarity in respect of the court having jurisdiction to instate such measures, which made the procedures provided for even more reliant on the common procedures provided for by the Code of Civil Procedure⁴².

²⁷ Idem: 252

²⁸ Liliana-Zoleta Körösi, „Admisibilitatea ordonanței președințiale în materia proprietății industriale” in *Revista Română de Dreptul Proprietății Intellectuale*, 3 (2005): 81-113; Vișean, „The Implementation of Directive 2004/48/EC in Romania”: 155-156

²⁹ Octavia Spineanu-Matei, “Apărarea drepturilor de proprietate intelectuală. Compatibilitatea legislației românești cu directiva 2004/48/EC a Parlamentului European și a Consiliului din 29 aprilie 2004” in *Revista Română de Dreptul Proprietății Intellectuale*, 2 (2005): 43-57; Bucura Ionescu, „Ordonanța de urgență nr. 100/2005 privind asigurarea respectării drepturilor de proprietate industrială. Nou instrument juridic de combatere a fenomenului de contrafacere în România” in *Revista Română de Dreptul Proprietății Intellectuale*, 4 (2005): 73-81; Mihaela Ciocea, „Considerații privind transpunerea prevederilor Directivei nr. 2004/48 în legislația românească” in *Revista Română de Dreptul Proprietății Intellectuale*, 4 (2006): 59-66; Alina Iuliana Țuca, „Instanța competentă să dispună măsuri de conservare a probelor, măsuri provizorii și de asigurare în materia drepturilor de proprietate industrială” in *Revista Română de Dreptul Proprietății Intellectuale*, 1 (2008): 47-65; Vișean, „The Implementation of Directive 2004/48/EC in Romania”: 140-186

³⁰ Körösi, „Admisibilitatea ordonanței președințiale în materia proprietății industriale”: 91

³¹ Spineanu-Matei argues that the provisions of the Directive would require the court to order the lodging of a security before ordering a measure to secure evidence - Spineanu-Matei, “Apărarea drepturilor de proprietate intelectuală”: 50; We disagree with this interpretation.

³² Körösi, „Admisibilitatea ordonanței președințiale în materia proprietății industriale”: 106-107

³³ Spineanu-Matei, “Apărarea drepturilor de proprietate intelectuală”: 50-51, 54-55, 56

³⁴ Idem: 108

³⁵ Ciocea, „Considerații privind transpunerea prevederilor Directivei”: 60

³⁶ Massa and Strowel, “The Scope of the Proposed IP Enforcement Directive”: 249-250

³⁷ Vișean, „The Implementation of Directive 2004/48/EC in Romania”: 153-154

³⁸ As does Ionescu, „Ordonanța de urgență nr. 100/2005”: 77

³⁹ Ciocea, „Considerații privind transpunerea prevederilor Directivei”: 63

⁴⁰ Ionescu, „Ordonanța de urgență nr. 100/2005”: 75-76

⁴¹ Idem: 78-79

⁴² Țuca, „Instanța competentă să dispună măsuri”: 59-60

Finally, with the new Code of Civil Procedure, the provisional measures were harmonized across the intellectual property right spectrum by reducing all special provisions to a reference to the procedures provided by the Code of Civil Procedure⁴³.

With this new development some of the aspects previously objected to were corrected – e.g. the lodging of security was again made optional, to be left to the discretion of the court.

However, since the ‘special’ provisions in the Code of Civil Procedure still reference the common provisions regarding the procedure for the presidential ordinance (still in the same Code of Civil Procedure but under a different heading) while only mentioning that the common provisions are to apply “accordingly”, there is even more uncertainty as to the conditions to be met by a claim for such measures, the court having jurisdiction and the application of other ‘common provisions’ in the Code of Civil Procedure such as the 20% cap on the security to be lodged (which is generally provided for by the Code for all the

cases where the law does not specifically provide an amount).

7. Conclusions

The present short article underlines a paradox in the enforcement of intellectual property rights: although providing for protection of these rights (which is paramount for their existence, which in turn is essential for the current state of the world economy and life in general) at multiple levels is meant to insure better enforcement, in fact the multiple obligations to harmonize, the uncertainty of direct effect (or direct horizontal effect) and the differences in existing national legislation and legal traditions transform even genuine harmonization efforts into opportunities to uneven the scales even more, creating significant differences in the level and efficiency of enforcement of intellectual property rights.

References

- „legal right”. Garner, Bryan A (ed.). Black’s Law Dictionary. 8th ed.. St. Paul: Thompson West, 2004: 1348
- Cătuna, Ligia. “Procedura măsurilor provizorii în materia drepturilor de proprietate intelectuală din noul Cod de procedură civilă. Prezentare generală”. *Revista Română de Dreptul Proprietății Intelectuale*. 4 (2012): 63-72
- Ciocea, Mihaela. „Considerații privind transpunerea prevederilor Directivei nr. 2004/48 în legislația românească”. *Revista Română de Dreptul Proprietății Intelectuale*. 4 (2006): 59-66
- Cornish, William R., Josef Drexl, Reto Hilty and Annette Kur. “Procedures and Remedies for Enforcing IPRs: the European Commission’s Proposed Directive”. *E.I.P.R.* 25 (2003): 447-449
- Friedmann, Danny. “The Effects of the Enforcement Directive on Dutch patent law. Much Ado About Nothing?”. <http://ssrn.com/abstract=1706070>
- Ionescu, Bucura. „Ordonanța de urgență nr. 100/2005 privind asigurarea respectării drepturilor de proprietate industrială. Nou instrument juridic de combatere a fenomenului de contrafacere în România”. *Revista Română de Dreptul Proprietății Intelectuale*. 4 (2005): 73-81
- Körösi, Liliana-Zoleta. „Admisibilitatea ordonanței președințiale în materia proprietății industriale”. *Revista Română de Dreptul Proprietății Intelectuale*. 3 (2005): 81-113
- Massa, Charles-Henry and Alain Strowel. “The Scope of the Proposed IP Enforcement Directive : Torn between the Desire to Harmonise Remedies and the Need to Combat Piracy”. *European Intellectual Property Review*. 26 (2004): 244-253
- Phillips, Jeremy and Alison Firth. *Introduction to Intellectual Property Law*. 4th ed.. Oxford: Oxford University Press, 2006.
- Spineanu-Matei, Octavia. “Apărarea drepturilor de proprietate intelectuală. Compatibilitatea legislației românești cu directiva 2004/48/EC a Parlamentului European și a Consiliului din 29 aprilie 2004”. *Revista Română de Dreptul Proprietății Intelectuale*. 2 (2005): 43-57
- Tăbărcă, Mihaela. *Drept procesual civil*. vol. II. București: Universul Juridic, 2013
- Țuca, Alina Iuliana. „Instanța competentă să dispună măsuri de conservare a probelor, măsuri provizorii și de asigurare în materia drepturilor de proprietate industrială”. *Revista Română de Dreptul Proprietății Intelectuale*. 1 (2008): 47-65
- Vander, Sascha. „Article 50”. Stoll, Peter-Tobias, Jan Busche, Katrin Arend (ed.) *WTO – Trade-Related Aspects of Intellectual Property Rights*. Leiden: Martinus Nijhoff Publishers, 2009: 738-750
- Vișean, Violeta. „The Implementation of Directive 2004/48/EC in Romania”. *Revista Română de Dreptul Proprietății Intelectuale*. 4 (2009): 140-186;

⁴³ For a general analysis see Ligia Cătuna, “Procedura măsurilor provizorii în materia drepturilor de proprietate intelectuală din noul Cod de procedură civilă. Prezentare generală” in *Revista Română de Dreptul Proprietății Intelectuale*, 4 (2012): 63-72