

GOVERNMENT OF ROMANIA

EMERGENCY ORDINANCE ON THE ENFORCEMENT OF INDUSTRIAL PROPERTY RIGHTS

The special circumstances whose settlement could not be delayed were created by the requirement of transposing "The Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights" with a view to fighting against the scourge of infringement of industrial property objects and in the interest of the holders of industrial property rights, as well as by the compliance with Art. 53 of the Treaty on the accession of Romania to the European Union - the document establishing the conditions for the accession of Republic of Bulgaria and Romania and the adoption of the treaties on which the European Union is based.

According to Art. 115 paragraph (4) of the republished Constitution of Romania,

The Government of Romania adopts this emergency ordinance:

Chapter I **General provisions**

Art. 1 - (1) This emergency ordinance provides for the measures, procedures and remedies with a view to enforcing the industrial property rights.

(2) Within the meaning of this emergency ordinance, the expression *industrial property rights* includes all industrial property rights provided for by the national and community law, as well as by the specialized international treaties and conventions to which Romania is a party.

Art. 2 - (1) Without affecting the more convenient means for the right holders provided by the community or national law, the measures, procedures and remedies provided by this emergency ordinance shall be applied in any case of infringement of an industrial property right, as provided by the community and/or national law.

(2) This emergency ordinance shall not affect the obligations under the conventions, treaties and agreements to which Romania is a party, and in particular, those under the TRIPS Agreement, including the obligations relating to criminal procedures and penalties to be applied.

(3) Neither the common law provisions, nor the provisions of the special laws relating to criminal procedures or penalties to be applied in the case of infringement of protected industrial property rights shall be affected.

Chapter II **Measures, procedures, remedies**

Art.3 - (1) Measures, procedures and remedies provided by the industrial property laws shall be applied by the competent judicial authorities.

(2) Measures, procedures and remedies should be effective, proportional to the infringed rights, dissuasive and should be applied in such a manner as to avoid the creation of barriers to legitimate trade and, at the same time, to protect against the abusive

use thereof.

Art. 4 - The following persons are entitled to request the application of measures, procedures and remedies:

- a) holders of industrial property rights, according to the provisions of the applicable law;
- b) any person which is authorized to use the industrial property rights, in particular licensees.

Chapter III

Evidence and measures for preserving the same

Art. 5 - (1) Upon request by a party having presented reasonably available and sufficient evidence elements to support his/her statements, and if said elements are under the control of the opponent, the competent judicial authority may order that such evidence be presented by the opponent, while ensuring the protection of confidential information.

(2) In the case of infringement of protected industrial property rights committed on a commercial scale, the competent judicial authority may, upon request by any party, order that banking, financial or commercial documents under the control of the opponent be communicated, while ensuring the protection of confidential information.

Art. 6 - (1) Before judging the merits of the case in respect of a protected industrial property right, the competent judicial authority may order, upon request by a party having presented reasonably available and sufficient evidence elements to support his statements that an industrial property right has been infringed or is about to be infringed, prompt and effective provisional measures for preserving the evidence elements relevant for the case, subject to ensuring the protection of confidential information.

(2) The measures provided for in the paragraph (1) may include the detailed description, with or without the taking of samples, the seizure of the infringing goods, and when appropriate, of the materials and instruments used in the production and/or distribution of said goods, as well as the documents relating thereto.

(3) The measures for preserving evidence shall be taken by the competent judicial authorities, by presidential ordinance, even without the other party having been summoned, when any delay is likely to cause an irreparable prejudice to the right holder or when there is a provable risk of destroying the evidence.

(4) When the presidential ordinance is issued without the other part having been summoned, the parties concerned shall be given notice without delay.

(5) Within 5 days from the notification of the evidence preserving measures, the parties concerned may appeal against the ordered measures. The case shall be judged in emergency procedure, while hearing the parties, the provisions of the Code of civil proceedings on special proceedings being applicable.

Art. 7 - (1) The measures for preserving the evidence shall be approved by the competent judicial authority, subject to the lodging by the plaintiff of an adequate security, established by the judicial authority intended to cover any prejudice suffered by the defendant, in the cases provided by the paragraph (3).

(2) When the plaintiff has not instituted proceedings with a view to obtaining a decision on the merits of the case, within a period which shall not exceed 20 working days or 31 calendar days, whichever is the longer, the defendant may request to the competent judicial authority to revoke the measures for preserving the evidence, including the damages caused to the defendant by the said measures.

(3) When the evidence preserving measures are revoked or they lapse due to any act or omission by the plaintiff, or when after the approval of the measure by the judicial authority there is found that no infringement of a protected industrial property right or

infringement threat has taken place, the judicial authority shall be authorized to order the plaintiff, upon request by the defendant, to provide the latter a compensation corresponding to the prejudice caused by the said measures.

(4) During the trial, the judicial authority may order witnesses' identity protection measures, according to the law.

Chapter IV

Right to information

Art. 8 - (1) During a trial concerning the infringement of an industrial property right, and upon the justified and proportionate request of the plaintiff, the competent judicial authority may order that information on the origin and distribution networks of goods and services infringing a protected industrial property right be provided by the infringer or by any other person who:

a) holds infringing goods with commercial purposes;
b) uses infringing services with commercial purposes;
c) was found to be using infringing services with commercial purposes;
d) provides, with commercial purposes, services used in infringing activities; or
e) was indicated by a person referred to in letters a), b) or c) as being involved in the production, manufacturing or distribution of the goods or the provision of the services.

(2) The information provided in the paragraph (1) shall contain, as appropriate:

a) names and addresses of producers, manufacturers, distributors, providers and other previous holders of goods or services, as well as of intended wholesalers and retailers;

b) information on the amounts produced, manufactured, , delivered, received or ordered, as well as on the price obtained for the said goods or services.

(3) The provisions of paragraphs (1) and (2) shall apply without prejudice to other legal provisions by which:

a) the right holder is entitled to receive more complete information;
b) the use in civil or criminal matters of the information communicated according to the provisions of this article is established;
c) the responsibility for abuse concerning the right of information is established;
d) the possibility of refusing to provide information supposed to force a person referred to in paragraph (1) to admit his/her own participation or the participation of his/her close relatives in an infringement of a protected industrial property right is provided, or
e) the protection of confidentiality of information sources or the processing of personal data is established.

Chapter V

Provisional and withholding measures

Art.9 - (1) The competent judicial authority may order, upon request by the plaintiff, provisional measures against the alleged infringer of a protected industrial property right with a view to preventing any imminent infringement of said right, namely:

a) forbid, on a provisional basis, the continuation of the alleged infringement ; or
b) order that a security is lodged for compensating the holder of the protected right for his/her loss.

(2) The provisional measures referred to in the paragraph (1) may also be ordered against an intermediary whose services are used by a third party for infringing a protected industrial property right.

(3) Upon request by the plaintiff, the competent judicial authorities may order the

seizure of the goods alleged to infringe a protected industrial property right for preventing their introduction into or circulation within the commercial circuits.

(4) In the case of an infringement committed within the framework of commercial activities, if the injured party proves that there are circumstances likely to make the recovery of damages impossible, the competent judicial authority may order the seizure of the movable and immovable property of the alleged infringer of a protected industrial property right, including the blocking of the bank accounts and other assets thereof. The communication of banking, financial or commercial documents or the access to information relevant to the case may be ordered with the same purpose.

(5) Within the framework of the measures provided by the paragraphs (1) - (4) the competent judicial authority may require the plaintiff to provide any available evidence to form with sufficient certainty the belief that he/she is the right holder and his/her right has been infringed or such an infringement is imminent.

Art. 10 - (1) The provisional measures referred to in Art. 9, paragraph (1) - (4) may be ordered by presidential ordinance, even without the defendant having been heard, when any delay is liable to cause an irreparable prejudice to the right holder. In this case, the ordered measures shall be communicated to the involved parties without delay.

(2) The provisions of Art. 6 paragraph (5) and Art. 7 are also applicable in the situation referred to in paragraph (1).

Art. 11 - (1) In addition to the damages that can be obtained by the holder of the infringed protected industrial property right, the competent judicial authority may order, upon request by the plaintiff, the following measures concerning the goods found to be infringing the protected industrial property right and the materials and instruments principally used in the creation or manufacturing of the goods, as the case may be:

- a) recall from the commercial circuits;
- b) definitive removal from the commercial circuits, or
- c) destruction.

(2) The competent judicial authority shall order that the measures referred to in paragraph (1) shall be carried out on the expenses of the infringer of a protected industrial property right, unless there are special reasons preventing it from ordering the same.

(3) In the examination of the request concerning the corrective measures provided by the paragraph (1), the competent judicial authority shall take into account both the proportionality between the seriousness of the infringement and the corrective measures to be ordered, and the interests of the third parties.

Chapter VI Injunctions

Art. 12 - (1) When the infringement of a protected industrial property right is ascertained by a judicial decision, the competent judicial authority may forbid the continuation of the infringement act, by means of a presidential ordinance.

(2) The failure to comply with the injunction measure provided by paragraph (1) shall be considered as a new infringement of said industrial property right, hence, one of the measures referred to in Art. 11 may be ordered against it.

Chapter VII Compensations and law costs

Art. 13 - (1) Upon request by the infringer of an industrial property right, which is liable to be subject to one of the measures or injunctions referred to in Art. 11 and 12, the judicial authority may order the payment by said person of a compensation to the injured

party, instead of the application of the above-mentioned measures.

(2) The judicial authority shall act according to the provisions of paragraph (1) if the following conditions are cumulatively complied with:

a) the person acted unintentionally and by imprudence;

b) the execution of the measures to be ordered would cause him a disproportionate prejudice in comparison with the act committed by the same;

c) the payment of the compensation referred to in paragraph (1) is considered reasonably satisfactory.

Art.14 - (1) Upon request by the injured party, the competent judicial authority shall order to the infringer which intentionally carried out an infringement act to pay the holder of the infringed right damages corresponding to the actual prejudice suffered as a consequence of the infringement.

(2) When establishing the amount of damages, the judicial authority shall take into account:

(a) all corresponding aspects, such as the negative economic consequences, especially profit loss suffered by the injured party, unfair profits made by the infringer of a protected industrial property right, and, where appropriate, other elements than economic factors, such as the moral prejudice caused to the holder of the infringed right; or

(b) as an alternative, where appropriate, the setting of a lump sum for the damages, on the basis of several elements, such as, at least the amount of royalties or value of rights which would have been due if the infringer had requested the authorization to use the said industrial property right.

(3) When the infringer of a protected industrial property right carried out intentionally an infringement activity, the competent judicial authority may order the recovery of profits or the payment of damages liable of being pre-established.

Art. 15 - The law costs reasonably and proportionally established by the judicial authority and paid by the successful party shall incur, as a general rule, to the unsuccessful party.

Chapter VII

Publicity measures

Art.16 - (1) Within legal procedures instituted for the infringement of a protected industrial property right, upon request by the plaintiff, the competent judicial authority may order, on the expense of the infringer of the protected right, appropriate measures for the dissemination of the information concerning the judicial decision, including the displaying, as well as the publishing thereof, wholly or in part.

(2) The competent judicial authority may also order additional publicity measures corresponding to special circumstances, prominent advertising included.

Chapter IX

Final provisions

Art. 17 - Without affecting the provisions of this emergency ordinance concerning measures, procedures and civil and administrative remedies, any other civil and criminal penalties provided for by the common law or special industrial property laws is also applicable.

Art. 18 - (1) With a view to supporting the actions of enforcement of industrial property rights, business and professional associations and organizations may elaborate codes of conduct at the Community level, especially proposing the use on optical disks of a code enabling the identification of the origin of their manufacture.

(2) The conduct codes elaborated according to paragraph (1), as well as the possible evaluations concerning the application thereof shall be submitted to the Commission of draft conduct codes at the national or Community level.

Art. 19 - The authorities referred to in Art.20 shall inform without delay the European Commission on the legislative or administrative measures taken, as well as on any national normative act adopted in the field and submit to the European Commission a report concerning the implementation of the measures for transposing the Directive, until 29 April 2009, at the latest.

Art. 20 - With a view to complying with the obligations under Art. 19, as well as for cooperation purposes, in particular for the exchange of information between Romania and the European Commission, the Ministry of Justice is appointed as national correspondent entrusted with all issues concerning the implementation of the Directive.

Art. 21 - This emergency ordinance transposes the Directive 2004/48/EC of the European Parliament and the Council of 29 April 2004 on the enforcement of intellectual property rights, published in the Official Journal of the European Union L 157 of 30 April 2004.

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