

ACT REGULATING CUSTOMS MEASURES RELATING TO INFRINGEMENTS OF INTELLECTUAL PROPERTY RIGHTS¹

CHAPTER I General provisions

SI 023

Article 1 Scope of the Act

- (1) This Act defines the measures relating to infringement of intellectual property rights upon entry of goods into the Republic of Slovenia or their export from the Republic of Slovenia.
- (2) The procedures for the implementation of measures relating to infringement of intellectual property rights under this Act shall be initiated upon request of the right holder or *ex officio*.
- (3) The implementation of this Act shall fall within the competence of customs authorities.

Article 2 Prohibition

- (1) Where it is established, on completion of a procedure under this Act, that goods infringe intellectual property rights, the entry into a customs territory, release for free circulation, export and re-export, initiation of any suspensive procedure or entry in a free zone of such goods shall be prohibited.
- (2) This Act shall not apply to goods which are subject to customs handling without the consent of the right holder, where such goods bear a trade mark with the consent of the right holder, or where the goods protected by a patent, supplementary protection certificate, industrial design or by a copyright or related right are manufactured with the consent of the right holder.
- (3) This Act shall not apply to goods of a non-commercial nature contained in travellers' personal luggage, provided that the quantity or value of goods is within the limits of quantity or value which, under customs regulations, shall be free of customs duties.

Article 3 Definitions

- (1) »Counterfeit goods« means:
 - (a) goods, including the packaging thereof, bearing without authorisation a sign which is identical to the trade mark valid in respect of the same type of goods, or a sign which can not

¹ Unofficial translation of the Act Regulating Customs Measures Relating to Infringements of Intellectual Property Rights of April 10, 2001, published in the Official Gazette RS No 30/2001, entry into force on May 11, 2001, applicable as from November 11, 2001.

be distinguished in its essential aspects from such trade mark, and which thereby infringes the rights of the holder of the trade mark in question valid in the Republic of Slovenia;

(b) any trade mark symbol, such as logo, label, sticker, brochure, instructions for use, guarantee document, whether presented separately or not, in the same circumstances as the goods referred to in item (a);

(c) packaging materials bearing the marks of counterfeit goods, presented separately, in the same circumstances as the goods referred to in item (a);

(d) goods bearing unduly a valid geographical indication, or a sign which can not be distinguished in its essential aspects from such geographical indication, and which thereby infringes the rights of the person entitled to use the geographical indication in question valid in the Republic of Slovenia;

(e) goods infringing a patent or supplementary protection certificate valid in the Republic of Slovenia.

(2) Pirated goods shall also be considered as counterfeit goods under paragraph (1). »Pirated goods« means goods which are or embody copies or imitations made without the consent of the holder of the copyright or related right, or of the holder of a design right, where the making of those copies or imitations infringes the right in question in the Republic of Slovenia.

(3) Any mould or matrix which is specifically designed or adapted for the manufacture of a counterfeit trade mark or geographical indication or of goods bearing such a trade mark or geographical indication, for the manufacture of goods infringing a patent or supplementary protection certificate or for the manufacture of pirated goods shall be considered as counterfeit goods referred to in paragraph (1), provided that the use of such moulds or matrices infringes the rights of the holder of the right in question in the Republic of Slovenia.

(4) »Right holder« means any person who, under the law, is deemed to be holder of a trade mark, patent, supplementary protection certificate, industrial design, copyright or related right, or any person entitled to use a geographical indication.

(5) »Working day« shall be construed as a working day of the General Customs Directorate.

Article 4 **Decision taking**

(1) Customs authorities shall take decisions pursuant to this Act and the act governing procedures by customs authorities relating to the assignment of customs-approved treatment or use of goods.

(2) There shall be no appeal under this Act against a decision taken by customs authorities. However, an action in the administrative litigation proceeding may be filed with the Administrative Court in Ljubljana. The court shall decide in the proceeding on its seat in Ljubljana.

Chapter II

Procedure on request

Article 5

Requests

(1) Requests shall be filed with the General Customs Directorate. Upon filing the request, a fee prescribed by the act regulating administrative fees shall be paid.

(2) The request shall contain in particular:

(a) data on the person filing the request and, where the right holder is not the person filing the request, on the right holder (family name and secondary name and address, or firm and seat);

(b) a sufficiently detailed description of the goods to enable the customs authorities to recognize them;

(c) proof that the person filing the request is the holder of the right for, or relating to, the goods in question, or that he is filing the request with the latter's authorisation;

(d) proofs indicating that his rights are likely to be infringed;

(e) other available information important for the decision on the request, such as particulars identifying the consignment, the place where the goods are situated or the intended destination, the scheduled date of arrival or departure of the consignment, the means of transport used, the identity of the importer, exporter, recipient or possessor of the goods;

(f) the proposed duration of the measures adopted by customs authorities, which shall not exceed the period of two years following the filing of the request.

Article 6

Decisions relating to requests; insurance

(1) If the person filing the request shows probable grounds for belief that the right of the right holder is likely to be infringed by certain goods, the General Customs Directorate shall grant the request and notify customs offices accordingly.

(2) Where the General Customs Directorate grants the request, it may require the person filing the request to provide an instrument to ensure payment of costs or possible damage that may be caused by the measures subsequently found not to be justified.

(3) Bank guarantee issued by a bank with the seat in the Republic of Slovenia shall be deemed to be the instrument to ensure payment of costs or possible damage referred to in paragraph (2).

(4) Executive regulation issued by the Minister who is competent for finance shall define, in greater detail, the mode of provision of the instrument referred to in paragraph (2), criteria for defining the amount, and procedures relating to the release and realization thereof.

Article 7 Records

(1) The General Customs Directorate shall keep records of requests and decisions taken by customs authorities. Beside data, the keeping of which is, for the purposes of implementation of customs regulations, laid down by the act governing customs service, the records shall contain in particular:

- (a) data on the person filing the request and, where the right holder is not the person filing the request, on the right holder;
- (b) data on the importer, exporter, recipient or possessor of the goods, if available;
- (c) indication of the kind of goods for which protection is sought under this Act;
- (d) indication of the kind and duration of the measures adopted by customs authorities.

(2) The provisions of acts governing protection of personal data or commercial secrecy shall apply to the collection, processing, storage, giving in use and archival keeping of data contained in the records referred to in paragraph (1), unless otherwise provided by this Act, the act governing customs service, or other regulation.

Article 8 Procedure relating to temporary suspension of release of goods

(1) Where, in the course of work, a customs authority finds the goods which correspond to the description of the goods mentioned in the decision by the General Customs Directorate granting the request for the protection of rights under this Act, that customs authority shall suspend release of the goods for a period of three working days, and promptly notify, in writing, the General Customs Directorate and the right holder, if known, or the person filing the request, accordingly.

(2) Notwithstanding other regulations, the right holder may, during the temporary suspension of release and on the basis of the notification in writing by the General Customs Directorate or customs authority and conditions laid down by either of them, examine the available documentation on the entry of the goods into the Republic of Slovenia or their export from the Republic of Slovenia to the extent which makes possible the right holder's eventual enforcement of judicial protection of rights.

(3) Goods whose release has been temporarily suspended shall be stored in accordance with customs regulations governing customs warehousing.

Article 9

Actions for infringement of rights

- (1) Where the right holder, during the temporary suspension of release of goods in accordance with Article 8(1), informs the General Customs Directorate in writing that he intends to file an action with the court for infringement of intellectual property rights concerning the suspended release, the competent customs authority shall prolong the temporary suspension of release for another 10 working days.
- (2) The right holder shall file the action within the time limit referred to in paragraph (1), and submit the evidence to the General Customs Directorate proving the filing thereof.
- (3) The General Customs Directorate may, in justifiable cases and at the request of the right holder, provide for an additional time limit for filing of an action referred to in paragraph (1), which shall not exceed 10 working days, and shall notify, in writing, the competent customs authority accordingly.
- (4) Where the right holder acts in accordance with this Article, the release of goods shall be suspended until the issuance of the decision on the detention by the competent customs office.
- (5) Where the right holder does not act in accordance with this Article, the competent customs authority shall immediately release the temporarily suspended goods into the chosen customs-approved treatment or use, provided that other conditions for the release of the goods under the act governing the proceedings of customs authorities concerning the assignment of customs-approved treatment or use of goods have been complied with.
- (6) Decisions by the court on the actions under this Article shall be accorded priority treatment.
- (7) The court shall inform of its final decisions the General Customs Directorate which shall communicate them to the competent customs office.

Article 10 Security replacing suspension of release of goods

- (1) In the case of goods suspected of infringing patents, supplementary protection certificates or design rights, the owner, importer or recipient of the goods may request the release of such goods and cancellation of the decision on temporary suspension of release against payment of a security, provided that:
 - (a) the General Customs Directorate has been informed in due time of the filing of the action referred to in Article 9;
 - (b) until expiry of the time limit referred to in Article 11(1), a decision on the detention of the goods has not been issued; and
 - (c) conditions for the release of the goods under the act governing the proceedings of customs authorities concerning the assignment of customs-approved treatment or use of goods have been complied with.

(2) The General Customs Directorate shall provide that the security referred to in paragraph (1) shall be sufficient to protect the interests of the right holder.

(3) Bank guarantee issued by a bank with the seat in the Republic of Slovenia shall be used as the security.

(4) Executive regulation issued by the Minister who is competent for finance shall define, in greater detail, the mode of provision of the security referred to in this Article, criteria for defining the amount, and procedures relating to the release and realization thereof.

Article 11 **Procedure relating to detention of goods**

(1) Where the right holder files an action in accordance with Article 9, the General Customs Directorate shall notify, in writing, the competent customs office accordingly. The customs office shall immediately, in the period not exceeding five working days from the date on which the General Customs Directorate received the information of the action filed, issue the decision that the goods shall be detained until the final decision by the court.

(2) The detained goods referred to in paragraph (1) shall be stored in accordance with customs regulations applicable to customs warehousing of goods.

Article 12 **Seizure of goods**

Where the court takes a final decision that goods infringe intellectual property rights and the right holder did not request the seizure of such goods, the competent customs office shall decide on such seizure.

Article 13 **Release of goods**

Where the court rejects the action or refuses the claim referred to in Article 9, the General Customs Directorate shall promptly notify, in writing, the competent customs authority accordingly. The latter shall immediately release the goods into the chosen customs-approved treatment or use of goods, provided that other conditions for the release of the goods under the act governing the proceedings of customs authorities concerning the assignment of customs-approved treatment or use of goods have been complied with.

Chapter III ***Ex officio* procedure**

Article 14 **Initiation of *ex officio* procedure**

Where, in the course of procedures relating to the entry into a customs territory, release for free circulation, export and re-export, initiation of any suspensive procedure, or entry in a free zone of the goods, it appears evident to the customs authority that the goods are counterfeit, it may detain such goods for a period of three working days.

Article 15

Filing of requests

(1) Where the customs authority detains the goods in accordance with Article 14, it shall promptly notify, in writing, the General Customs Directorate of the suspended release of goods. The latter shall notify, in writing, the right holder of the suspended release, alleged infringement of his rights and the possibility to file a request under Article 5 within three working days from the date of the suspension of release.

(2) Where the right holder files a request under paragraph (1), the release of goods shall be suspended until the issuance of the decision by the General Customs Directorate. Where the General Customs Directorate grants the request in accordance with Article 6, the release of goods shall be temporarily suspended for a period of another 10 working days, during which the right holder shall perform acts referred to in Article 9.

Article 16

Procedure

Provisions of Articles 8 to 13 shall apply *mutatis mutandis* for the *ex officio* procedure.

Chapter IV

Costs incurred in respect of goods and treatment of seized goods

Article 17

Costs incurred in respect of goods

(1) Costs of storage and keeping incurred during temporary suspension of release or detention of goods shall be borne, until final decision on seizure of goods under this Act, by the person against whom the right holder instituted the proceeding for the protection of rights.

(2) Notwithstanding paragraph (1), the costs referred to in that paragraph shall be borne by the right holder:

(a) if he does not act in accordance with Article 9;

(b) in the cases referred to in Article 13;

(c) if customs authorities fail to collect the costs from the person against whom the right holder instituted the proceeding for the protection of rights.

Article 18
Treatment of seized goods

(1) The competent customs authority shall, as a general rule, destroy goods seized in accordance with this Act. The destruction shall be carried out in accordance with customs regulations governing destruction of customs goods under customs supervision. Any waste or scrap resulting from the destruction of goods shall be deemed customs goods, and shall be treated in accordance with customs regulations.

(2) Notwithstanding paragraph (1), the competent customs authority may, in exceptional cases and at the request of an interested party, approve a different use of the goods referred to in paragraph (1), provided that such use does not infringe the rights of the right holder and the costs of its implementation are not to the charge of the state budget. The customs authority shall in no case allow the re-export of the seized goods.

(3) Costs incurred by the destruction of goods under paragraph (1) shall be borne by the customs declarant or the importer of goods seized in accordance with this Act.

Chapter V
Transitional and final provisions

Article 19
Executive regulations

Executive regulations referred to in Articles 6 and 10 of this Act shall be issued by the Minister who is competent for finance within three months following the entry into force of this Act.

Article 20
Termination of validity

(1) On the date this Act begins to apply, Article 173 of the Copyright and Related Rights Act (Official Gazette RS No 21/95 and 9/01), hereinafter referred to as “CRRA”, shall cease to apply.

(2) Provisions of Article 173 of the CRRA shall continue to apply for proceedings instituted pursuant to this Article.

Article 21
Entry into force and applicability

This Act shall enter into force on the fifteenth day following its publication in the Official Gazette of the Republic of Slovenia, and shall be applicable after the expiry of six-month period following its entry into force.