International Comparative Jurisprudence 1 (2015) 55–65

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Contents lists available at ScienceDirect

International Comparative Jurisprudence

journal homepage: www.elsevier.com/locate/icj

Available Defences in Provisional measures: Between the Enforcement Directive and National law ☆, ☆☆

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ARTICLE INFO

Available online 19 October 2015

Keywords:
European Union
Intellectual property
Civil procedure
Provisional measures
Enforcement Directive
Enforcement
Defences
Balance of interests

ABSTRACT

The EU Enforcement Directive provides a set of provisional measures to be applied upon request from a right-holder of a particular object of intellectual property. Simultaneously, the EU Enforcement Directive envisages a set of defences for an alleged infringer (defendant) in order to safeguard the balance of the parties. This article discusses available defences for an alleged infringer in the provisional measures as provided by the EU Member States when the norms of the EU Enforcement Directive are transposed. Specifically, the present article not only focuses on the threshold of evidence to be presented by a plaintiff for the application of provisional measures, but also in regard to a set of available motions that could be lodged by an alleged infringer. This article argues that though the EU Enforcement Directive should provide harmonisation of national law in relation to provisional measures (in addition to other civil remedies under that Directive), the currently existing disparities among EU Member States demonstrate that such an aim is far from being achieved. Therefore, application of provisional measures throughout EU depends on the national law and, in the result, its practical outcome varies from one EU Member State to another.

1. Introduction

1.1. Topicality of the subject

Intellectual property (hereinafter IP) is usually reviewed from the point of view of right holders of the IP objects. Such an approach, which requires an ever increasing scope of IP protection is completely obvious, as the protection of IP rights is designed and developed for protection of the IP right holders, on the one hand, and the protection of other legal interests, like the interests of consumers, on the other hand. However, there is another tendency that has taken up an ever increasing role in the modern times, when the usual image of an IP infringer is changing. If a potential infringer was previously

☆ This article is the revised version of the paper the author presented at 7th Annual Conference of the EPIP Association 'IP in motion' held at the University of Leuven, Belgium, 27–28 September 2012. The author would like to thank participants of that conference for their valuable comments.

☆☆ This study was supported by the National Research Programme 5.2. "Economic Transformation, Smart Growth, Governance and Legal Framework for the State and Society for Sustainable Development – a New Approach to the Creation of a Sustainable Learning Community (EKOSOC-LV)".

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Peer review under responsibility of Mykolas Romeris University.

http://dx.doi.org/10.1016/j.icj.2015.10.001

described as a wilful criminal or a shameful imitator[1], then in modern times it is clear that even large corporations, including software corporations, may become potential infringers of IP objects. Consequently, it is no longer appropriate to review IP protection only from the point of view of IP right holders and the protection of their interests.

In order to ensure the possibility of execution of a court ruling, there is necessity for effective provisional measures which could be applicable during the time period when court proceedings take place until a final court's ruling enters into force. As stated by Professor Annette Kur in this regard, 'there is no doubt that interlocutory injunctions are of central importance in intellectual property infringement proceedings' (Kur, 2004, p. 825). These provisional measures are specific procedural instruments to be applied to civil proceedings[2] for the temporary suspension of activities of an alleged infringer during ongoing court proceedings or before the commencement of court proceedings.

Yet, the existence of defences available for defendants in IP infringement cases[3] against the application of provisional measures is of outstanding importance to ensure the justice, equality of parties and balance of the rights of both parties, i.e., a plaintiff (a particular IP right holder) and a defendant (an alleged infringer).

This article reviews provisional and precautionary measures (hereinafter provisional measures[4]) as regulated at the EU level by the Enforcement Directive (2004) (could be also referred to as interlocutory injunctions (Kur, 2004, p. 825; European Commission, 2010), simply as injunctions (Kur and Dreier, 2013, p. 445), interim injunctions (Bainbridge, 2012, p. 926), or cease and desist letters (Fei, 2014, p. 631), depending on the author or jurisdiction) from the point of view of alleged IP infringers (defendants in IP infringement cases). The topicality of this issue not only arises from the point of view of ensuring the balance of parties in civil procedure, but also from the fact that provisional measures under the Enforcement Directive are little discussed, as the main attention is related to other remedies like damages (Johnson, 2013). This article demonstrates that despite the aim of the EU Enforcement Directive to harmonise national law in relation to provisional measures (and other civil remedies), the currently existing disparities among EU Member States demonstrate that such an aim is far from being achieved.

1.2. Scope and structure of the article

The aim of this article is to study the available defences for defendants within the application of provisional measures as provided by the Enforcement Directive (the EU level) and transposed into the national laws of the EU Member states to be applied in the court practice (the national level). However, the aim of this article is not to challenge the effectiveness of the appropriate national provisional measures of the EU Member States, rather it is to explore the level of the harmonisation of those measures from the perspective of the Enforcement Directive.

In conducting this study, the article is divided into three parts. It begins with a brief review of the provisional measures provided by the Enforcement Directive; then it carries on with its transposition into laws of the EU Member states (the legislative approach); and finally, it discusses whether the availability of defences envisaged by the Enforcement Directive within the application of provisional measures is ensured in the national laws of the EU Member states (the practical approach).

While admitting that the Enforcement Directive is the main source for the regulation of provisional measures, there are still also other legal acts in the EU law providing specific provisional measures. First, as explicitly mentioned in the Enforcement Directive itself (Art. 9 (1) (a) of the Enforcement Directive supported by Points 16 and 23 of its preamble in conjunction with Art.2 (2)), it does not apply to intermediaries liable for copyright infringements which are covered by the Information Society Directive (2001), specifically, Arts. 2–6 and 8 of the Information Society Directive. Second, it is without prejudice to those provisional measures contained not only in the above mentioned provisions of the Information Society Directive, but also in Art. 7 of the Computer Programs Directive (1991). Still, these additional provisional measures will not be discussed in this article if their scope goes beyond the scope of provisional measures as provided by the Enforcement Directive. In addition and due to the scope of this article, the extent of the provisional measures contained in Art. 50 of TRIPS and its compliance with national laws of EU Member states (simultaneously being Member states of the World Trade Organisation together with the EU itself) will not be reviewed. Another reason for such limitation of the scope lies in the fact that the TRIPS was implemented in the EU law by the very adoption of the Enforcement Directive (Ubertazzi, 2009, p. 927; European Commission, 2010b) itself, including the implementation of Art. 50 of the TRIPS, which specifically provides provisional measures.

[1] One of such notable examples is the critical comment on the EU institutions' legislative initiative which is particularly covered by this article by stating that '[m]ost people abhor deliberate imitators of protected products, who can offer no justification for what they are doing, who have no intention of taking any licence and who are out for whatever profit they can get' (Cornish et al, 2003, p. 447).

[2] It shall be mentioned that provisional measures of similar nature may be applicable within criminal proceedings and also administrative proceedings. Yet, this article focuses on civil proceedings and consequently it does not review provisional measures in criminal or administrative procedures. Similarly, the Enforcement Directive discussed within this article has a similar scope of regulation (see Art. 2 (3) (b) and (c) of the Enforcement Directive (2004)). Yet, due to the scope of this article it would be sufficient in this regard, to mention that the proposal for Directive governing criminal measures for intellectual property infringements was withdrawn by the European Commission (2010a).

[3] As the provisional measures are specifically aimed to be applied within the infringement proceedings, they may not be applied within invalidation proceedings. Therefore (European Commission, 2005), in the case of provisional measures, the IP infringement cases are relevant.

[4] Within this article, provisional measures are understood as the procedural measures which are imposed by a court in IP infringement cases within civil proceedings which are not final and are in force until revoked or until the final court ruling enters into force.