

**Council for Trade-Related Aspects
of Intellectual Property Rights**

CHECKLIST OF ISSUES ON ENFORCEMENT

Decision of the Council for TRIPS of 21 November 1995

In providing information on national enforcement law and practices in response to the checklist of issues below, as soon as possible after the time that a Member is obliged to start applying the provisions of the TRIPS Agreement on enforcement, each Member should identify the relevant provisions of national laws and regulations. Where a response differs according to the intellectual property right (IPR) in question, the response should be given on an IPR-by-IPR basis. The checklist follows the structure of Part III of the TRIPS Agreement; when considering what information would be relevant in response to the issues listed, Members may wish to consult the corresponding provision of Part III of the TRIPS Agreement on the Enforcement of Intellectual Property Rights.

The checklist will be reviewed by the Council, in the light of experience at the end of 1997, *inter alia* to identify any elements which have proven unduly burdensome in relation to the usefulness of the information provided.

Civil and Administrative Procedures and Remedies

(a) *Civil judicial procedures and remedies*

1. Specify the courts which have jurisdiction over IPR infringement cases.
2. Which persons have standing to assert IPRs? How may they be represented? Are there requirements for mandatory personal appearances before the court by the right holder?
3. What authority do the judicial authorities have to order, at the request of an opposing party, a party to a proceeding to produce evidence which lies within its control?
4. What means exist to identify and protect confidential information brought forward as evidence?
5. Describe the remedies that may be ordered by the judicial authorities and criteria, legislative or jurisprudential, for their use:

-injunctions;

- damages, including recovery of profits, and expenses, including attorney's fees;
- destruction or other disposal of infringing goods and materials/implements for their production;
- any other remedies.

6. In what circumstances, if any, do judicial authorities have the authority to order the infringer to inform the right holder of the identity of third persons involved in the production and distribution of the goods or services found to be infringing and of their channels of distribution?

7. Describe provisions relating to the indemnification of defendants wrongfully enjoined. To what extent are public authorities and/or officials liable in such a situation and what "remedial measures" are applicable to them?

8. Describe provisions governing the length and cost of proceedings. Provide any available data on the actual duration of proceedings and their cost.

(b) *Administrative procedures and remedies*

9. Reply to the above questions in relation to any administrative procedures on the merits and remedies that may result from these procedures.

Provisional Measures

(a) *Judicial measures*

10. Describe the types of provisional measures that judicial authorities may order, and the legal basis for such authority.

11. In what circumstances may such measures be ordered *inaudita altera parte*?

12. Describe the main procedures for the initiation, ordering and maintenance in force of provisional measures, in particular relevant time-limits and safeguards to protect the legitimate interests of the defendant.

13. Describe provisions governing the length and cost of proceedings. Provide any available data on the actual duration of proceedings and their cost.

(b) *Administrative measures*

14. Reply to the above questions in relation to any administrative provisional measures.

Special Requirements Related to Border Measures

15. Indicate for which goods it is possible to apply for the suspension by the customs authorities of the release into free circulation, in particular whether these procedures are available also in respect of goods which involve infringements of intellectual property rights other than counterfeit trademark or pirated copyright goods as defined in the TRIPS Agreement (footnote to Article 51). Specify, together with relevant

criteria, any imports excluded from the application of such procedures (such as goods from another member of a customs union, goods in transit or *de minimis* imports). Do the procedures apply to imports of goods put on the market in another country by or with the consent of the right holder and to goods destined for exportation?

16. Provide a description of the main elements of the procedures relating to the suspension of the release of goods by customs authorities, in particular the competent authorities (Article 51), the requirements for an application (Article 52) and various requirements related to the duration of suspension (Article 55). How have Articles 53 (security or equivalent assurance), 56 (indemnification of the importer and of the owner of the goods) and 57 (right of inspection and information) been implemented?
17. Describe provisions governing the length and cost of proceedings. Provide any available data on the actual duration of proceedings and their cost. How long is the validity of decisions by the competent authorities for the suspension of the release of goods into free circulation?
18. Are competent authorities required to act upon their own initiative and, if so, in what circumstances? Are there any special provisions applicable to *ex officio* action?
19. Describe the remedies that the competent authorities have the authority to order and any criteria regulating their use.

Criminal Procedures

20. Specify the courts which have jurisdiction over criminal acts of infringement of IPRs.
21. In respect of which infringements of which intellectual property rights are criminal procedures and penalties available?
22. Which public authorities are responsible for initiating criminal proceedings? Are they required to do this on their own initiative and/or in response to complaints?
23. Do private persons have standing to initiate criminal proceedings and, if so, who?
24. Specify, by category of IPR and type of infringement where necessary, the penalties and other remedies that may be imposed:
 - imprisonment;
 - monetary fines;
 - seizure, forfeiture and destruction of infringing goods and materials and implements for their production;
 - other.
25. Describe provisions governing the length and any cost of proceedings. Provide any available data on the actual duration of proceedings and their cost, if any.