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On the Admissibility of the Presidential Ordinance for Measures to Terminate Acts for the Infringement of Industrial Property Rights

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Abstract: Given that the special laws on industrial property (trademarks, geographical indications, patents, models and industrial designs) do not contain any special rules regarding the procedural particularities of the Presidential Ordinance for taking measures to stop acts of infringement of industrial property rights, we propose to present the special legal conditions of common law for the exercise of the presidential ordinance, provided for in art. 997, par. 1 Code of Civil Procedure, in the light of the particularities determined by the specificity of industrial property rights.

Keywords: Presidential Ordinance; industrial property rights; common law

In principle, the presidential ordinance may also be issued in the field of industrial property for the cessation of acts of infringement of industrial property rights, if the special legal requirements of common law are cumulatively fulfilled: the appearance of the law, the urgency of the measure to be taken, the temporal character of the measure and the failure to judge the fund.

The peculiarities are determined by the specificity of industrial property rights, which must be found in titles obtained in procedures governed by special laws, these being absolute real rights of industrial property, *erga omnes* opposable (Roş, 2003, pp. 633-634) (within the limits of the principles of specialty, territoriality and temporary character, established by Law for each of these rights), with the content expressly and legally regulated.

The special regulations in the matter insurance provisions in the industrial property domain expressly providing for the possibility for the plaintiff to make bail. The examination of this condition of admissibility is, however, a matter of further examination of the other conditions of admissibility of the presidential decree, which must be retained as previously agreed, given their mandatory and peremptory character (in relation to the optional initial and the dilatory nature of the bail).

The condition- premises from which the examination of the admissibility of the request made by way of the Presidential Ordinance is the appearance of the subjective right which would be prejudiced by delay and which must be retained accordingly or in connection with which an imminent loss would occur and which could not be repaired and, consequently, necessary to be prevented.

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In the doctrine¹ it was considered that the justification of the appearance of the law is a specific condition of admissibility, as any measure ordered in this way, although provisional, must be in conformity with the law" being "closely related to the condition that the fund of the law of not being put under discussion."

In the field of industrial property, the premise behind the opening of the admissibility of the presidential ordinance is the applicant's justification of the appearance of his industrial property right.

The request for a presidential order is inadmissible, if the preconditioned condition is not fulfilled, namely whether the applicant does not invoke or justify the appearance of an industrial property right in his favour as the holder of the right or the beneficiary of another form of exploitation (the license or the cession), with the consent of the holder, for the protection of which he can use the way of the Presidential Ordinance, either to preserve it or otherwise to delay it or to prevent imminent damage in connection with this right, and which could not be repaired.

Emergency

By listing the situations in which the measure may be taken by way of the Presidential Ordinance, art. 997 par. 1 the Code of Civil Procedure defines implicitly the specific condition of admissibility of emergency, in terms of its alternative content. Consequently, the condition of admissibility of the emergency will be deemed to be met whenever the temporary measure is required to be ordered to retain a right that would be prejudiced by delay, to prevent imminent and unreparable damage, such as and to remove the obstacles that arise on the occasion of execution. The latter situation has no particularities in industrial property matters and will therefore not be the subject of the analysis.

The provisions of the special laws do not contain derogatory regulations on this matter.

The emergency condition is fulfilled in this matter, with regard to the delay of the right, due to the nature of acts of infringement of industrial property rights: acts of successive execution, usually of a commercial nature, which involve a reaction of the consumer of products or services which implies such a right.

Therefore, damages in this matter are not susceptible to full reparation by the equivalent (compensation) and are, as a rule, future but certain (imminent), which implies periodic actions in law, the extent of the damage being determined over time, and the effects of violations are susceptible to amplification over time. For example, dilution of the mark by abusive use of the identical or similar sign, loss of clientele, etc.

As regards the second alternative legal condition, imminent and irreparable damage is indissolubly linked to the industrial property right, the appearance of which must be justified.

In this matter, the reasoning of the urgency is implicit and equates to the finding of the defendant's committing abusive acts or acts of infringement of the industrial property rights, the appearances of which are justified by the applicant. The abusive nature of the acts or acts committed by the defendant needs the protection of the violated industrial property right, the appearance of which acts in favour of the plaintiff, by way of the presidential ordinance, a way to obtain effective protection against the

¹ (Crisu, 1997, p. 35) and note 1 dc to the footnote of the same page in the present case, the applicant requested a presidential ordinance, ordering the marketing of a pharmaceutical product, on the basis of a non-final judgment by which the transient protection certificate for a patent of invention in favor of the defendant, also concerning a pharmaceutical product (other than the one marketed by the applicant) which was annulled until its irrevocable stay. *Law no 93/1998 on the transitional protection of patents for inventions governed by art. 1, the protection in Romania for patent holders "with priority date".*

application of common law, as long as the damage is amplified by the passage of time, due to the successive execution of the acts of violation.¹

Transitoriness

No measures may be taken by way of the Presidential Ordinance, the execution of which renders the impossibility of the subsequent restoration of the changed situation. (Tăbârcă, 2014, p. 196)

As stated in the doctrine², “the temporality depends on the essence and nature of the presidential ordinance, and the length over time depends on the causes that have generated the measures and the position of the parties”, without the temporality of the provisional measures, the transitory measure having temporary nature from the very moment of its taking.

Since the measures are required to be taken by the holder of the industrial property right, by way of the presidential ordinance, against third parties, concern the obligation of not making or terminating the abusive acts of infringement of the industrial property rights, they appear as definitive measures precisely due to the fact that their duration seems unlimited.

The doctrine³ (analysing a settled jurisprudence in this regard) is unanimous in assessing the fulfilment of the condition of admissibility of temporality when the measure consists in determining the defendant's obligation to make an end to abusive acts, the measure retains its temporal character, although its length over time may give the appearance of a definitive measure.

However, the probable duration of the measure is that which gives the appearance of its definitive character. The duration of the measure taken by way of the Presidential Ordinance depends on the attitude of the parties, respectively on their manifestation of will, on the litigation on the merits.

As regards the protection of industrial property rights in this way, the duration of the temporary measure depends on the attitude of the defendant.

The defendant is the one who is interested in bringing the case to the merits, a prejudice that calls into question the validity of the applicant's title in the presidential decree. Obviously, and under these circumstances, the measure will last indefinitely, if the court in the case of the liquidation of the fund irrevocably assesses the validity of the claimant's title (or confirms the right to exploit it).

When the complainant uses the way of the presidential ordinance, justifying the appearance of the industrial property right, after the publication of the application, temporary measures become definitive in terms of time duration if the title is ultimately issued to the plaintiff and the defendant does not contest it, or although he contested it, he did not get a favourable decision.

The measure is temporary in the mentioned cases, as it tends to end abusive acts, only the duration of which is of a definitive nature. Accordingly, it is not necessary to refer to a certain period of time in the operative part of the Presidential Order, since the duration of the measure prohibiting abusive acts determines the condition of admissibility of the term, but rather the content of the measure itself.⁴

¹ The court is obliged to state the urgency “and to show the reasons which led the judge to decide on the existence or non-existence of this condition” (Crisu, 1997, p. 45). “... self-indigence or violence creates for the injured party the right to use the procedure of the presidential decree, these acts being the proof of urgency” (Crisu, 1997, p. 46).

² (Crisu, 1997, p. 67).

³ Exceptionally, by means of a presidential ordinance, for the abolition of some abusive acts, to the defendant it has been imposed an obligation to do” (Deleanu, 2010, p. 31) with notes 4 and 5 in the footer of the same page).

⁴ “... the determination of the duration of these measures is a mistake. Such an explanation is unnecessary to the provisional nature of any presidential ordinance, as it cannot be ruled out that the next day it became illusory by the disappearance of the reasons which led to the ordering of the measures and therefore their abolition” (Crisu, 1997, p. 67).

Not Judging the Fund

In assessing the fulfilment of the condition of non-judgment of the merits, for the admissibility of the request for a presidential order, it must be taken into account what would be the judgment on the merits, which would be the claim brought to the court at the moment when the request for a presidential ordinance was made. The importance of establishing this issue lies in the need to determine the limits of the examination of the appearance of the law on the way of the Presidential Ordinance, both in the light of the claims put forward by the applicant and of the defendants, which the defendant may formulate and the acts to be proven.

The claim on the merits of the case, at the applicant's request, would have the effect of prohibiting any act likely to bring prejudice to the industrial property rights protected by the title on the basis of which the applicant justified the appearance of the right in his favour and the reparation of the damage caused by such acts. At the defendant's request, the claim brought by him under common law would have the purpose of challenging the validity of the title on the basis of which the applicant justified the appearance of industrial property rights by way of the presidential ordinance.

The assessment of the subject matter of the dispute on the merits is reported at the time of the introduction of the request for a presidential order irrespective of the subject of the petition for judicial proceedings pending before the courts and until the final settlement of the case by which the applicant requests the taking of the measure by way of the presidential ordinance.

The substance of the dispute will not be solved in the summary procedure of the presidential decree if the investigation is circumscribed to the relevant elements of the appearance of the law, without any assessment of the fund (Deleanu, 2010, p. 36), even if the defendant's defence concerns the validity of the title on the basis of which the applicant justifies the appearance of his industrial property right.

If the defendant invokes some aspects of the industrial property right, the appearance of which is invoked in the request for the Presidential Ordinance, the investigation of these issues is equivalent to the resolution of the funds. Therefore, the request for a presidential order will not be considered inadmissible as the investigation of the defence of the defendant's involves prejudicing the substance, but the defence will not be received, motivated by the limits of the investigation in the proceedings of the presidential ordinance.

As it has been shown above, the investigation into the appearance of industrial property rights excludes the investigation of the validity of the title challenged by the defendant in its defence, in terms of the substantive and formal circumstances assessed in relation to the moment of the issue of the title, the exclusive jurisdiction of the court in the matter. The court vested in the presidential decree examines only the opposability of the title (in the period of validity) to third parties.

The investigation of the fulfilment of the condition of admissibility of the Fund is not justified by the justification of the appearance of the industrial property right, the protection of which is claimed by the plaintiff in this way, and not the defence claimed by the defendant. To admit the opposite is to admit that the defendant may paralyze the request for a presidential ordinance by simply invoking certain defence whose investigations involve solving the fund.

In conclusion, these conditions being fulfilled cumulatively, the admissibility of the request for a presidential ordinance for the protection of industrial property rights by the prohibition of abusive acts is taken as a procedural means of taking rapid and effective provisional measures for the purpose of ensuring such protection, under art. 50 of the TRIPS Agreement. The investigation of each of these conditions starts from the concrete aspects of each case, retained on the basis of a minimal proof, and

it is not limited to their formal research in purely theoretical terms. The solution to the inadmissibility of the request for a presidential ordinance for the protection of industrial property rights must be based on a number of considerations, including a concrete examination of the conditions of admissibility, on the basis of the specific elements of the case, by showing and assessing the considerations contemplated in the retention of non-fulfilling each condition.

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