

Section Seven⁵

Special Aspects of Legal Proceedings of Cases Relating to the Infringement of Exclusive Rights in an Object of Intellectual Property

Law of Georgia No 1919 of 23 December 2017 – website, 11.1.2018

Chapter XLIV¹² – Measures of Providing Evidence for Cases on the Infringement of Exclusive Rights in an Object of Intellectual Property, Rights to Obtain Information and Measures to Secure a Claim

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Article 363²⁵ – Definition of terms used in this chapter

The terms used in this chapter, for the purposes of this chapter, shall have the following meanings:

a) an object of intellectual property – a trademark, service mark, or a collective mark, registered design, invention or a useful model protected by patent, and an object protected by copyright or related rights protected in accordance with the legislation of Georgia;

b) the goods produced by violation of exclusive rights and/or put in the civil circulation:

b.a) with respect to a protected trademark, service mark and/or a collective mark (the trademark) – the goods and/or services, which contain marks identical or similar to a trademark or on which the mark identical or similar to a trademark is affixed, or which have the form identical or similar to a three-dimensional trademark, and the production, delivery, and the import and storage of which in the territory of Georgia, also the putting of which in the civil circulation, or the storage/ stocking of which for the purpose of putting in the civil circulation (placement for temporary storage), and/or any other use of which causes the violation of exclusive rights of a holder in the registered trademark, despite the place where the mark is affixed;

b.b) with respect to a registered design – product, in which design is included or for which it is used, and the production and delivery, and the import and storage of which in the territory of Georgia, also the putting of which in the civil circulation, or the storage/ stocking of which for the purpose of putting in the civil circulation (placement for temporary storage), and/or any other use of which causes the violation of exclusive rights of a holder of exclusive rights in the registered design;

b.c) with respect to an invention or a useful model protected by patent – any device or substance produced by violation of exclusive rights related to patent, the production, and the import and storage of which in the territory of Georgia, also the putting of which in the civil circulation, or the storage/ stocking of which for the purpose of putting in the civil circulation (placement for temporary storage), and/or any other use of which causes the violation of exclusive rights of a holder of patent; any equipment or substance produced using a method protected by patent, the production, and the import and storage of which in the territory of Georgia, also the putting of which in the civil circulation, or the storage/ stocking of which for the purpose of putting in the civil circulation (placement for temporary storage), and/or any other use of which causes the violation of exclusive rights of a holder of patent;

b.d) with respect to an object protected by copyright or related rights – pirated copies defined by the Law of Georgia on Copyright and Related Rights.

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Article 363²⁶ – Scope of regulation

The procedures defined by this Code shall apply to cases related to the infringement of exclusive rights in an object of intellectual property, in view of special aspects determined by this chapter.

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Article 363²⁷ – Measures of providing evidence for cases relating to the infringement of exclusive rights on an object of intellectual property

1. A court shall be entitled to deliver a ruling on the use of measures of providing evidence on the basis of the motion filed by a holder of exclusive rights in an object of intellectual property for the purposes of retaining the evidence, if there is threat that such evidence may be destroyed.

2. Measures of providing evidence may involve detailed description of devices/material, equipment or a component of the equipment for production/reproduction of goods or of devices/material for the evasion of the use of technological means in production of the goods with regard to which exclusive rights in an object of intellectual property has been allegedly infringed, and/or of the documentation related to eligible violation of law, with or without sampling. Meanwhile, if evidence cannot be provided using the mentioned measures, seizure may also be applied.

3. A court shall be entitled to use several measures referred to in paragraph 2 of this article simultaneously.

4. A court shall be entitled to use the measures provided for by this article without having heard the person against whom there is reasonable presumption that he/she has infringed exclusive rights in an object of intellectual property, if there is reasonable presumption that disproportional damage may be incurred to a holder of such rights, and/or where there is clear threat that such evidence may be destroyed.

5. A court shall immediately inform the person against whom the measures under this article shall be applied, on the measures to be applied against him/her no later than 48 hours from the application of such measures.

6. A holder of exclusive rights in an object of intellectual property shall be entitled to request the use of measures to provide evidence under this article, if he/she justifies the necessity of using the said measures for identifying the fact of infringement or eligible infringement of his/her exclusive rights.

7. Procedures for the compensation of expenses related to the provision of evidence shall be determined, and the delivered ruling on the provision of evidence shall be appealed in accordance with Articles 118 and 119 of this Code.

8. A ruling on the motion with regard to the provision of evidence shall be delivered by a judge within five working days.

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Article 363²⁸ – Right to obtain information

1. During the legal proceedings relating to cases on the infringement of exclusive rights in an object of intellectual property, and on the basis of proportionate and reasonable claim of a holder of exclusive rights in the object of intellectual property, a court shall be entitled to:

a) request a person, against whom there is reasonable presumption that he/she has infringed exclusive rights, to provide information, which may include information on the origin and/or sales

network of the goods produced by infringement of exclusive rights and/or put in the civil circulation. The obligation to provide information may also include the obligation to submit financial documents related to the violation of law;

b) request the provision of information referred to in sub-paragraph (a) of this paragraph to a person against whom there is reasonable presumption that he/she has offered, taken, held and/or used the goods produced by infringement of exclusive rights and/or put in the civil circulation. The obligation to provide mentioned information shall also apply to other persons who have offered, taken, held and/or used the goods produced by infringement of exclusive rights and/or put in the civil circulation, except for the case where such action(s) were carried out for the own benefit.

2. Information referred to in paragraph 1(a) of this article shall include a full name and address of the manufacturer, producer, distributor, supplier and/or a full name and address of the previous holder of the goods, wholesale and/or retail seller (whom such goods belong and by which exclusive rights are eligible infringed), as well as information on the quantity and price of the goods produced, manufactured, delivered, received or ordered.

3. Information obtained as a result of the use of measures under this article shall be confidential and it shall be impermissible to disclose such information.

4. Expenses related to the provision of information under this article shall be compensated by a person who has applied to a court with a motion to provide such information. The opposing party shall be authorised to claim the compensation of expenses incurred by him/her for the provision of information. Such expenses shall be finally distributed upon the delivery of the judgment on the merits of a case by a court.

5. It shall not be permitted to appeal against the ruling on the provision of information. A separate claim may be lodged against the ruling on the refusal to provide information.

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Article 363²⁹– Measures to secure a claim in cases relating to the infringement of exclusive rights in an object of intellectual property

1. On the basis of the application of a holder of exclusive rights in an object of intellectual property, a court shall have the right:

a) to deliver a ruling on the seizure of movable and/or immovable property (including bank accounts and other assets) of the person, against whom there is reasonable presumption that he/she has infringed exclusive rights at commercial scale, if there is threat that the claim on the compensation of damage for the holder of exclusive rights may not be granted. For this purpose a court, on the basis of the motion of a holder of exclusive rights, shall request from a person who has allegedly infringed exclusive rights, the banking, or financial and/or commercial documents/information. Such documents/information may be introduced only to a court. A court shall be authorised to forward documents /information received for the purposes of the identification of the subject of seizure to an independent expert appointed by the court. Information obtained as a result of the application of measures defined by this sub-paragraph shall be confidential and it shall be impermissible to disclose such information;

b) not to allow the person against whom there is reasonable presumption that he/she has infringed exclusive rights, to carry out the action by which exclusive rights are infringed;

c) to require from the person against whom there is reasonable presumption that he/she has infringed exclusive rights, instead of not allowing him/her to carry out the action under sub-paragraph (b) of this paragraph, to present appropriate security of a claim.

2. A court shall be authorised to use several measures defined by paragraph 1 of this article simultaneously.

3. The measures defined by paragraph 1 of this article may also be used against those persons whose services are or were used for the infringement of exclusive rights at commercial scale.

4. If a court considers that by applying measures to secure a claim, a person, against whom there is reasonable presumption that he/she has infringed exclusive rights, the court shall be authorised to apply measures to secure a claim and meanwhile to require from a holder of exclusive rights to ensure the compensation of possible damages in favour of the opposing party. The court may also be authorised to require the submission of a guarantee to secure a claim on the basis of the application by the opposing party.

5. The requirements provided for by Chapter XXIII of this Code shall apply to cases related to the infringement of exclusive rights in an object of intellectual property.

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