

INJUNCTIONS IN CASES ARISING FROM AUTHOR'S LEGAL  
RELATIONS: A COMPARATIVE LEGAL ANALYSIS

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The procedure of proving of copyright and/or related rights violations is one of the most complicated procedural actions in the mechanism of their protection. It is connected with an anonymous, in general, character of illegal use, first of all with a reproduction of objects of copyright and (or) related rights. Anyone who is engaged in this does not sign their name on pirated copies. Therefore, a rights holder who is a victim of violation does not have instruments for the identification of the offender and proofs of an infringement. Moreover, it is quite easy to destroy the evidence and prevent the consolidation of evidence of illegal actions. It concerns the objects that are easily transported on the one hand, such as books, engravings, CDs and other items, and on the other hand, the volume of infringements increases and new ways of copyright and (or) related rights infringement appear thanks to modern technological development and use of the Internet. This problem is important at the global level because, in fact, the borders mean nothing now when it refers to copyright and (or) related rights infringement.

For the purpose of the application of measures to prevent and eliminate the illegal use of objects of copyright and related rights at the international level as well as in national legislations of world's many countries there is an opportunity to use interim injunctions. The use of injunctions is one of the most important procedural problems that concerns equally authors,

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performers, producers and in general anyone who is authorized to use works and products that are the results of intellectual activity.

The evidence of the importance of injunctions in the sphere of copyright is the fact of their recognition under the Berne Convention<sup>1</sup>. As early as the First Act of 1886 (Article 12) provided an opportunity to require seizure of any counterfeit product in accordance with the legislation of each country.

The Universal Copyright Convention<sup>2</sup> does not contain strictly formulated provisions concerning the use of injunctions but they follow from the meaning of the paragraph 1 of Article 1 according to which Contracting States undertake to “provide for adequate and effective protection of rights...” and apply the norms of national treatment.

Giving the characteristics of international legal regulation of grounds and conditions of the use of injunction for copyright and/or related rights infringement one cannot ignore the provisions of the TRIPS Agreement<sup>3</sup>, a member of which Ukraine is. Thus, Article 50 of the TRIPS Agreement provides that provisional measures shall be applied by the judicial authorities to protect intellectual property rights. The abovementioned article directly includes provisions that judicial authorities shall have the authority to order effective measures to prevent an infringement of any intellectual property right. In this regard, they have the authority to adopt provisional measures in cases when it is necessary to obtain and preserve evidence and where any delay is likely to cause irreparable harm to the right holder, or where there is a demonstrable risk of evidence being destroyed. The judicial authorities decide on provisional measures *ex parte* (unilaterally) and *inaudita altera parte* (without hearing the other part).

Carrying out the unification of the international law norms in the copyright relations field the Ukrainian lawmaker in Part 1 of Article 52 of the Law of Ukraine on Copyright and Related Rights<sup>4</sup> granted to the subjects

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<sup>1</sup> Berne Convention for the Protection of Literary and Artistic Works (as amended on September 28, 1979).

<sup>2</sup> Universal Copyright Convention as revised on 24 July 1971, UNESCO.

<sup>3</sup> Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement), (1994), World Trade Organization (WTO).

<sup>4</sup> On Copyright and Related Rights : Law of Ukraine N 3793-XII from 23 December 1993. Vidomosti Verkhovnoyi Rady Ukrayiny (VVR), 1994, No. 13, p. 64, with amendments, available at: [http://www.wipo.int/wipolex/en/text.jsp?file\\_id=142655](http://www.wipo.int/wipolex/en/text.jsp?file_id=142655).

of copyright and related rights the right not only to require the recognition and renewal of their rights, the reimbursement of moral (non-proprietary) and material damages resulting from an infringement but also to require the termination of preparations for an infringement of copyright and (or) related rights, to participate in the inspection of the production premises, storage facilities, technological processes and business operations relating to the production of specimens of works, phonograms and videograms with respect to which there are grounds to suspect violation or threat of violation of copyright and (or) related rights; to require the provision, by the persons infringing the claimant's copyright and (or) related rights, of information about third parties involved in the manufacture and distribution of counterfeit specimens of works and objects of related rights or means of circumvention, and the relevant distribution channels.

The forecited opportunities of subjects of copyright and (or) related rights regarding to protection of their rights meet modern needs. But in spite of progressiveness of the norms of the special Law the problem is with mechanisms of their realization.

#### INJUNCTIONS IN A CIVIL PROCEDURE OF UKRAINE ON HEARING THE CASES ARISING FROM THE AUTHOR'S LEGAL RELATIONS

The Ukrainian lawmaker connects protection of copyright and (or) related rights mostly with an action proceedings in civil procedure. The effective Civil Procedure Code of Ukraine<sup>5</sup> (hereinafter CPC Ukraine) contains two variants of interim injunctions that can be applied by the court of general jurisdiction in civil procedure in cases arising from the author's legal relations – securing of evidence (Articles 133–135 of CPC Ukraine) and securing a claim (Articles 151–155 of CPC Ukraine).

However, neither securing evidence nor securing a claim can fully promote the realization of provisions set out in Part 1 of Article 52 of the Law of Ukraine on Copyright and Related Rights. This is so because the

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<sup>5</sup> Civil Procedure Code of Ukraine N 1618-IV from 18 March 2004. Vidomosti Verkhovnoyi Rady Ukrayiny (VVR), 2004, № 40-41, 42, p.492, with amendments, available at: [http://www.wipo.int/wipolex/en/text.jsp?file\\_id=187648](http://www.wipo.int/wipolex/en/text.jsp?file_id=187648)

procedure of submission of evidence is complicated and long-lasting; the statement of evidence securing shall include: the evidence that is necessary to secure; the circumstances indicating that the submission of required evidence may be impossible or complicated; the statement of evidence securing shall be considered within five days from its filing with notification of the parties and others involved in the case.

Concerning securing a claim the lawmaker paid a special attention to preventing of intellectual property rights violations. Hence according to Part 4 of Article 151 of CPC Ukraine “upon the statement of the person concerned the court may secure a claim before filing a statement of claim in order to prevent piracy of intellectual property. The documents and other evidence confirming that this person is subject to the relevant intellectual property rights and that his/her rights may be violated in the case of failure to apply measures to secure the claim shall be enclosed to the statement of claim securing”. That means that person concerned must present evidence that their rights may be infringed in the case of failure to secure the claim, herewith “...grounds to suspect violation or threat of violation of copyright and (or) related rights...” cannot be qualified as evidence, for this is only subjective-emotional evaluation that is why the provisions of Part 1 of Article 52 of the Law of Ukraine on Copyright and Related Rights cannot be realized in the judicial procedure of securing a claim. This point of view is confirmed by a court practice. For example Paragraph 3 of the Resolution of the Superior Economic Court of Ukraine on Some Matters of Practice of Application of Claim Securing Measures<sup>6</sup> (SEC Res. No16, 26 November 2011) indicated that “confirmed with evidences existence of factual circumstances with which is connected the use of certain type of claim securing is relevant enough for the claim securing. Such circumstances may be confirmed by the defendant actions aimed at deviating the obligations execution after raising a demand or submitting a claim (property realization or preparatory actions to it, spending money not for payment to plaintiff, entering into contracts of a bail or a pledge having unenforced disputed liability, etc.). Sole reference to a potential possibility

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<sup>6</sup> On Some Matters of Practice of Application of Claim Securing Measures: Resolution of the Superior Economic Court of Ukraine, No16, 26 November 2011, available at <http://spravedlivist.in.ua/zakon.php?law=12-02-02/21>.

of a respondent to dodge a judgement without giving proper arguments is not enough bases for satisfaction of the certain statement”.

Besides, according to Part 5 of Article 151 of CPC Ukraine in the case of filing a statement for claim securing before submitting the statement of claim the applicant shall submit the appropriate petition within three days after the enactment of decree on claim securing, herewith taking into account the specifics of copyright and (or) related rights and legal relations connected with these rights realization it seems to be very doubtful to have time to make actions on realization of one or another type of securing a claim.

Ordinarily decrees on claim securing are executed immediately. Analyzing current legislation on enforcement proceeding one can distinguish some basic features of execution of judgements that are immediately enforceable:

- should the judgement be immediately enforceable, a state enforcement officer opens an enforcement proceeding not later than the next working day after the enforcement document received and immediately begins its enforcement (Paragraph 1 of Part 1 of Article 22 of the Law of Ukraine on Enforcement Proceeding<sup>7</sup>);

- should an enforcement proceeding be opened under executive document that is issued on a judgement ground that must be immediately executed, the term for its voluntary fulfilment is not provided (Part 4 of Article 25 of the Law of Ukraine on Enforcement Proceeding);

- should the judgement according to which the debtor is obligated to perform a certain acts personally or refrain such actions performance, be immediately executed, its enforcement is checked no longer than by the next working day after the enforcement proceeding has been opened (Part 1 of the Article 75 of the Law of Ukraine on Enforcement Proceeding).

Therefore, we can conclude that in practice only a collector can count on a rapid execution by the decision according to which the debtor is obligated to perform certain acts personally or refrain such actions performance, provided, of course, that the decision had been to immediate execution. In all other cases, practically, immediate execution was and still is a fiction<sup>8</sup>.

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<sup>7</sup> On Enforcement Proceeding: Law of Ukraine N 606-XIV from 21.04.1999. Vidomosti Verkhovnoyi Rady Ukrayiny (VVR), 1999, N 24, p. 207.

<sup>8</sup> A. M. Avtorgov, *A profanity of immediate execution*, <http://blog.ubr.ua/pravo/profanacia-negainogo-vikonannia-2648>.

The above given opinion is in some way confirmed by the Ministry of Justice officials who point that immediate execution lies in that the state enforcement officer orders an enforcement proceeding not later than the day after reception of an executive document, and further enforcement actions will be carried out in the manner prescribed by law<sup>9</sup>. In turn, Part 2 of Article 30 of the Law of Ukraine on Enforcement Proceeding provides that executive actions on the decision are to be carried out within six months from the date of delivery of a decision on enforcement proceeding opening, and on non-property execution – within 2 months. In practice this may signify that a plaintiff can already get a court decision that came into force, and a state enforcement officer cannot execute the decision on a claim securing in the same case yet.

The situation over immediate execution of judgement and decisions deteriorates by the fact that effective legislation of Ukraine does not contain this term. In addition Parts 3 and 4 of Article 30 of the Law of Ukraine on Enforcement Proceeding use simultaneously two terms – “immediately” and “urgent” and their legal definitions are also absent. At the same time Ukrainian legislation contains the definition of the term “time”. According to Part 1 of Article 251, and Part 2 of Article 252 of the Civil Code of Ukraine<sup>10</sup> (hereinafter CC Ukraine) “time” is a certain period with the expiry of which a legally significant action or event is connected, and it is determined with years, months, weeks, days or hours, and not with references to a future event. With an indication of an event that must inevitably come, “date” is defined as a certain moment in time with the beginning of which a certain legally significant action or event is connected (Part 2 of Article 251, Part 2 of Article 252 of CC Ukraine).<sup>11</sup>

On the contrary, the definition of the term “immediately” can be found in European judicial practice. Thus, the European Court on Human Rights in the case *Brogan and others v. the United Kingdom* mentioned that “immediately” did not mean that it must happen quick as a thought but

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<sup>9</sup> See <http://minjust.gov.ua/0/10643>.

<sup>10</sup> Civil Code of Ukraine from 16.01.2003 № 435-IV. Vidomosti Verkhovnoyi Rady Ukrayiny (VVR), 2003, No 40-44, p. 356.

<sup>11</sup> The Resolution of the Supreme Court of Ukraine, 21 May 2012, Case No. 6–68c11 available at [www.scourt.gov.ua/clients/vs.nsf/0/.../\\$FILE/6-68ц11.doc](http://www.scourt.gov.ua/clients/vs.nsf/0/.../$FILE/6-68ц11.doc)

meant that it should take place as soon as possible, taking into account the location, time and circumstances of each case.<sup>12</sup>

Therefore, in order to enhance the protection of copyright and (or) related rights instead of the terms “immediately” and “urgent” the law prescription of clearly established time for court decisions enforcement that are immediately enforceable would be logical and to the point.

This way was chosen by the lawmaker of the Russian Federation. In accordance with Part 6 of Article 36 of the Federal Law of the Russian Federation on Enforcement Proceeding<sup>13</sup> requirements contained in an enforcement order issued on court decisions on the claim must be executed on the day of order receipt of the officers department, and if that is not possible because of the circumstances beyond the officer’s control, no longer than the next day. Should an executive document provide immediate compliance, their performance must be started no longer than the first working day after the document receipt of the executive officer department (Part 4 of Article 36 of the Federal Law on Enforcement Proceedings).

On the assumption of the above given provisions of the law attention is drawn to the fact that the Russian legislator connects timing with the time of receipt of an executive document to the officers department, and not to a definite officer as it is established in Ukrainian legislation and as a result it is spent much time for the “journey” of a document from a registry to a head of a department, from the head – to a state officer.

There is also a problem with realization of their rights by subjects of copyright and (or) related rights concerning the participation in the inspection of the production premises, storage facilities, technological processes and business operations relating to the production of specimens of works, phonograms and videograms with respect to which there are grounds to suspect violation or a threat of violation of copyright and (or) related rights. Such actions of subjects of copyright and (or) related rights does not engross either by securing of evidence or by securing a claim.

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<sup>12</sup> Brogan and others v. the United Kingdom, (November 29, 1988) Series A, N 145-B, p. 33-34, para. 62 available at: <http://umdpdpl.info/index.php?id=1225890025>.

<sup>13</sup> Federal Law of the Russian Federation on Enforcement Proceeding, 02.10.2007, № 229-FZ, available at: [http://lawsrf.ru/fz/02\\_10\\_2007\\_N\\_229/](http://lawsrf.ru/fz/02_10_2007_N_229/).

At the same time there are intellectual property state inspectors (hereinafter – an inspector) in Ukraine who are the officials of the State Intellectual Property Service. Their activity is regulated by the Decree of the Cabinet of Ministers of Ukraine on the Approval of Regulations of the State Inspector of the Intellectual Property of the State Intellectual Property Service (hereinafter Regulations)<sup>14</sup>.

According to Paragraph 7 of Regulations the inspector's main functions are: to execute control over business entities regarding their observance of the requirements of the Laws of Ukraine: On Copyright and Related Rights; On Distribution of Copies of Audiovisual Works, Phonograms, Videograms, Computer Programs, Databases; On the Specifics of State Regulation of Activities of Business Entities related to Production, Export, and Import of Disks for Laser Reading Systems, Matrices and other legislative acts in the field of intellectual property.

In accordance with Paragraph 9 of Regulations in a case of finding the violations of legislation on intellectual property the state inspector is liable to inform the appropriate authority of the pre-trial investigation, and in a case of detection of features of administrative offence under Articles 51-2, 164-9, 164-13 of the Code of Ukraine on Administrative Offences they shall draw up an administrative offence report and transfer it to the court.

In a case of inspection and seizure of products containing intellectual property rights, in particular, copies of audiovisual works, phonograms, videograms, computer programs, databases that are manufactured, distributed, offered for rent, stored, used or transported in infringement of law, and suppression of relevant documents, a state inspector must draw up an offence report or make a record in the administrative offence report, and in a case of purchase (including counterfeit goods) in the act of purchasing.

Attention is drawn to the fact that a state inspector being an official of the state institution must request from the State Intellectual Property Service permission to conduct scheduled and unscheduled inspections of business entities (Paragraph 7 of Regulations). Planned inspections shall

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<sup>14</sup> On the Approval of Regulations of the State Inspector of the Intellectual Property of the State Intellectual Property Service: Decree of the Cabinet of Ministers of Ukraine, 17 May 2002, № 674.



be approved by the State Intellectual Property Service (paragraph 11 of Regulations). At the same time, holders of copyright and (or) related rights, may initiate unscheduled inspections of business entities with regard to their compliance of intellectual property rights via submitting an application to a state inspector (Paragraph 12 of Regulation). However, there is no guarantee that unscheduled inspection will be carried out because the State Intellectual Property Service may not give permission for the following actions of a state inspector.

On demand of a subject of intellectual property right a state inspector makes a decision on involving such a subject or their representative to conduct inspections (Paragraph 20 of Regulations). To participate in an inspection a business entity may involve consultants, experts and other professionals with the purpose of clarification and protection of their rights and legitimate interests (Paragraph 21 of Regulations). Herewith a participation of a subject of copyright and (or) related rights depends completely on the decision of a state inspector of intellectual property. The Regulation does not provide either forms of refusal of inspection participation of these subjects or responsibility of a state inspector in a case of non-response on demand concerning a personal participation of subjects to intellectual property rights in an inspection. An appeal to a state inspector's decision on non-involvement of a subject of intellectual property proceeds in a general procedure by a reference with an application to the State Intellectual Property Service or to a court. Such a general procedure takes a considerable period of time. In a case when the State Intellectual Property Service refused in unscheduled inspection, subjects of intellectual property right may also appeal this decision in a court under administrative proceedings that also takes time. That is the requirement of efficient response on detection, termination of infringements and renewal of their copyright and related rights still remains unsolved both on legislative level and in practice.

#### PREVENTIVE MEASURES AS INTERIM INJUNCTIONS BY THE CPC OF UKRAINE 1963 AND IN MODERN ECONOMIC PROCESS IN UKRAINE

The effective CPC of Ukraine from March 18, 2004 entered into force on 1<sup>st</sup> September, 2005 and by that time the CPC of Ukraine 1963 with

amendments and additions had been acted. The CPC of Ukraine 1963 as an injunction provided a possibility of use of preventive measures besides securing of evidence and securing the claim. The CPC of Ukraine 1963 was amended with Chapter 4-A “Preventive Measures” under the Law of Ukraine № 850-IV from 22<sup>nd</sup> May, 2003 that was directly related to the fact that on 11<sup>th</sup> July, 2001 the Law of Ukraine on Copyright and Related Rights was recast. The introduction of Chapter 4-A “Preventive Measures” to the CPC of Ukraine 1963 on the one hand was progressive, and on the other hand caused violation of integrity of the Code and many collisions appeared after. The civil procedure understood preventive measures as a court activity connected with passing of decision aimed at giving additional means of protecting the rights and interests to the interested person who had reasons to think that their rights had been infringed or there was a real danger of their violation or litigation by complaint to a court with the application before filing a suit.

Without going into historical details one should point out that the preventive measures embodied in Section V-1 of the current Economic Procedural Code of Ukraine (hereinafter ECP Ukraine) and the norms of Section V-1 almost completely repeat the norms of Chapter 4-A of the CPC of Ukraine 1963, and, therefore, the problems concerning the enforcement of preventive measures in commercial procedure are similar to those present when the CPC of Ukraine 1963 was effective. Therefore, it seems to be appropriate to focus on the most significant drawbacks in Section V-1 of the effective ECP Ukraine.

First of all, Article 43-1 of ECP Ukraine as well as Article 62-1 CPC Ukraine establishes neither a special person of complaint to a court on the use of preventive measures nor distinguishes a subject of disputed relations. That is why there are the general rules of the court jurisdiction concerning the claimant for the enforcement of preventive measures.

This fact was pointed out in the Resolution of the Plenum of the Superior Economic Court of Ukraine on Some Matters of Practice of Disputes Resolution Connected with the Protection of Intellectual Property Rights from 17<sup>th</sup> October, 2012, № 12 (hereinafter - the Resolution of SEC Ukraine). Thus, pursuant to the Resolution of SEC Ukraine, taking into account the principles of jurisdiction of legal cases to different courts, as

well as the content of Article 1 of EPC Ukraine, subjects of complaint to a commercial court on the use of preventive measures were defined. Such subjects are:

- enterprises, institutions, organizations and other legal entities (including foreign);
- citizens engaged in entrepreneurial activities without forming a legal entity and according to established rules acquired the status of a business entity;
- in cases stipulated by legislative acts of Ukraine, state and other bodies, individuals who are not entrepreneurs.

So, in case of application to a commercial court to enforce preventive measures (Section V-I of EPC Ukraine) by a person who does not belong to the persons mentioned in Article 1 of EPC Ukraine, it may be refused in acceptance of such a complaint on the grounds of the abovementioned norm of procedural law. At the same time interested persons have the right to appeal to the economic court to enforce preventive measures not only on cases arising from the relations of intellectual property but also on other legal disputes. This conclusion is confirmed by a court practice – the absence of any restrictions concerning a possibility of preventive measures enforcement exclusively in legal relations that are connected with protection of intellectual property rights in Section V-I of EPC Ukraine makes such enforcement possible in other legal relations that are under economic courts authorities as well (Paragraph 7 of Resolution of SEC Ukraine).

At the time when the norms of Chapter 4-A the CPC of Ukraine 1963 were effective, interested persons filed a statement about enforcement of preventive measures on any disputable civil relations. In practice, this led to numerous abuses, since the bulk of applications for enforcement of preventive measures were submitted to controversial debt obligations. A similar trend exists in commercial procedure. The particularity of kinds of preventive measures that may be applied by a court can lead to a complete stop of business activity and a trade secret disclosure.

Secondly, if to compare Article 43-2 of EPC Ukraine with the provisions of Articles 52 and 53 of the Law of Ukraine on Copyright and Related rights we may note that law drafters thrashed out the preventive measures more carefully especially their content. For example Paragraph 43-2 of

EPC Ukraine provides such preventive measure as a survey of premises in which actions related to the violation of rights can take place. Paragraph “e” of Article 52 of the Law of Ukraine on Copyright and Related Rights describes this preventive measure more thoroughly – inspection of the production premises, storage facilities, technological processes and business operations relating to the production of specimens of works, phonograms and videograms with respect to which there are grounds to suspect violation or threat of violation of copyright and (or) related rights. At the same time evaluating the quality of legal regulation of preventive measures enforcement in Ukrainian legislation one may conclude that they practically do not contain provisions allowing interested person to gather necessary evidence for substantiation of their civil complaints in cases of infringement of intellectual property rights.

Thirdly, almost all provisions of the Law of Ukraine on Copyright and Related Rights with regard to a type of coercive measures as if initially presume a proof of copyright law violation, while the application of the measures is aimed mostly at gathering evidence confirming such violation. Probably that is why Paragraph 5 of Article 43-3 of EPC Ukraine provides filing of documents and evidence.

Based on the provisions of Article 43-1 of EPC Ukraine visibility of a right and the existence of violations or their direct threats belong to essential conditions that are necessary for usage of coercive means.

In deciding the question whether to take preventive measures, commercial court shall make an assessment of the reasonableness of the arguments of an applicant’s need for their use, taking into account the following:

- rationality, reasonableness and adequacy of the applicant’s requirements;
- maintenance of a balance of interests of the applicant and the person against whom preventive measures are being asked;
- presence of a connection between a certain type of preventive measures and the possible subject of the claim the applicant must submit within the period prescribed by Part 3 of Article 43-3 EPC Ukraine;
- probability of occurrence of circumstances specified in Article 43-1 ECP Ukraine;

– preventing violations in connection with such measures the rights and legal interests of third parties<sup>15</sup>.

Taking into account the above given, we can conclude that the decision to use or refuse the application of preventive measures is a subjective evaluation decision of a judge who may be wrong.

Fourthly, in accordance with Paragraph 4 of Part 1 of Article 43-3 of EPC Ukraine a complaint on the use of preventive measures shall include information about the circumstances justifying the need for such measures. These circumstances shall be conformed to the provisions of Article 43-1 of EPC Ukraine, and for the purposes of Paragraph 5 of Part 1 of Article 43-3 and Part 3 of Article 43-4 of EPC Ukraine shall be also confirmed by relevant evidence with the general requirements under Article 33 of EPC Ukraine. Reclamation and evaluation of relevant evidence, as well as the evidence of the applicant's claim right (information about the rights registration, a contract or other appropriate legal deal, etc.) are carried out by a commercial court as a general rule of evidence of EPC Ukraine.<sup>16</sup> Taking into account that such kind of preventive measures as a survey of the premises with respect to which there is a ground to suspect violation of law is aimed primarily at detecting such violations, their volumes, as well as at receiving evidence that can confirm violation of the right, the question arises: what evidence shall be given by an applicant? EPC Ukraine implies that the applicant must already have evidence proving a violation of his rights before applying to the court for taking preventive measures. On the basis of the specifics of the most common modern infringements in copyright law – illegal use of computer programs, databases or illegal reproduction of copies of works, phonograms and videograms, taking of evidence on such violations, first of all, may be by a survey of all premises in which action connected with the violation of rights takes place. Therefore, if the claimant does not have evidence confirming the fact that there are definite actions related to the illegal use in a particular manner of copyright and (or) related rights in the certain premise, a formal reason for non-consideration of it in a court appears. In accordance with Part 2 of Article 43-5 of EPC Ukraine if the

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<sup>15</sup> Paragraph 15 of Resolution of SEC Ukraine.

<sup>16</sup> Paragraph 12 of Resolution of SEC Ukraine.

applicant in coherence with the instructions of the judge fails to correct defects of a complaint (does not fulfil the requirements of Article 43-3 of EPC Ukraine, fails to pay the court fee), the application is considered to be unfiled and shall be returned to the applicant, on what the judge makes a reasoned judgement.

Fifthly, there are some internal contradictions in the norms of the economic procedural law devoted to a court enforcement of preventive measures. The Article 43-7 and the Part 2 of the Article 43-8 of EPC Ukraine note that filing an appeal against the ruling on taking preventive measures does not stop the execution of the ruling. At the same time, filing appeal against a ruling about cancellation of preventive measures or their replace stops the execution of the ruling. Unfavourable consequences become in a case of court enforcement of preventive measures to a person against whom a decision on taking preventive measures was made. Legal consequences of preventive measures enforcement may be the following: evidence reclamation, survey of premises where the actions connected with the violation of rights take place, seizure of property belonging to the person against whom preventive measures are used, and that is being held by him/her or others<sup>17</sup>, i.e. unfavourable circumstances for a person against whom a decision on taking preventive measures has been made directly connected with one or another kind of preventive measure that will be used by a court therefore they precisely will be appealed. Furthermore, whether the execution of a judgement will or will not stop, the lawmaker connects directly with the title of an appeal whether it will be “the appeal on a judgement on preventive measures enforcement”, i.e. in general, or “the appeal on a judgement on cancellation of preventive measures”, i.e. more specific. This approach of the lawmaker is considered to be rather formalized and not completely harmonised with the content of the appeal.

At the same time, the existence of the institute of preventive measures in the economic procedure has its positive features. Thus, in accordance with Part 1 of Article 43-4 of EPC Ukraine a statement of taking preventive measures is considered by an economic court within two days of its

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<sup>17</sup> Article 43-2 EPC Ukraine.

submission. So a consideration of claims for taking preventive measures is an example of an efficiency of trial.

A significant positive moment is that a statement of preventive measures enforcement can be considered without notifying the person against whom preventive measures are being asked but on condition that the applicant grounds an appropriate request in a statement.<sup>18</sup> In other cases there is a general rule – all interested persons shall be informed by an economic court of the examination of a statement of the enforcement of preventive measures. On the one hand such unequal procedural conditions of the applicant and the person against whom preventive measures are being asked cannot be recognized as positive, on the other hand, that prevents the destruction of evidence of illegal use of copyright and (or) related rights, or items that are planned to be used to violate these rights.

The positive moment is also that a decree of a court on the enforcement of preventive measures is liable to an immediate execution in order established to all court judgements.<sup>19</sup>

The provisions of Article 43-9 of EPC Ukraine also draw attention. This procedural law norm defines the grounds for termination of preventive measures. Meanwhile, the mentioned Code does not establish that an economic court shall deliver a decision on discontinuation of preventive measures. In summa they are terminated only by virtue of the existence of relevant grounds without compulsory registration of such termination by any procedural document.

At the same time in practice the situations are possible when circumstances mentioned in Article 43-9 of EPC Ukraine has come but the decrees, delivered by economic courts and concerning the reclamation of evidences, seizure of the property, depriving interested person (persons) the right to dispose of their property or restricts them in this law, continue to maintain force and remain obligatory. Meanwhile, in similar cases, taking into account certain circumstances, an economic court has the right and opportunity to deliver a decree on termination of one or another preventive measure in compliance with general requirements of Article 86 of EPC Ukraine on the content of the decision.

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<sup>18</sup> Part 2 of Article 43-4 of EPC Ukraine.

<sup>19</sup> Part 1 of Article 43-4 of EPC Ukraine.

## LAW ORDER AS AN INTERIM INJUNCTION

The judicial authority shall have the right to order a party to desist from an infringement of intellectual property right.<sup>20</sup>

Usually a court order in any procedural legislation of any country that provides such a procedural remedy as a court order writ proceeding is a fast and prompt interim court reaction to termination of causing damage to a claimant in comparison with action proceedings.

A somewhat different approach has the Ukrainian lawmaker. Thus, pursuant to the provisions of Section II of CPC Ukraine a mandatory proceedings is a simplified examination of those cases in which an actual dispute about the right is absent but there is a civil case, i.e. when the parties of civil procedure do not actually entered a dispute with each other but obligation execution is possible only via a court judgement. The court order is a special form of judicial decree issued by the court after hearing of the requirements.<sup>21</sup> A list of requirements under which the court order may be issued is established in Article 96 of CPC Ukraine, and is exhaustive and shall not be interpreted widely and concerns undisputable debt obligations. The Civil Procedure Law of Ukraine does not provide direct cases arising from intellectual property rights.

The legislation of the Russian Federation in the sphere of intellectual property is governed by Section 4 of the Civil Code of the Russian Federation<sup>22</sup>. Part 1 of Article 1248, corresponding to Part 1 of Article 11 of the cited Code, provides that disputes relating to the protection of the violated or disputed rights shall be examined and resolved by a court, and Part 2 of Article 1248 of the Civil Code of the Russian Federation provides a possibility to protect some disputable intellectual rights by administrative means. A court protection of the violated or disputed intellectual rights is carried out in conformity with the liability of the cases to these bodies' jurisdiction established by the procedural legislation – by the court of justice, the arbitration court or the arbitration court. Courts of general jurisdiction protect intellectual rights in civil, administrative and criminal trials. In its turn in civil trials the cases arising from the disputable relations of intel-

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<sup>20</sup> Article 44 of the TRIPS Agreement.

<sup>21</sup> Part 1 of Article 95 CPC Ukraine.

<sup>22</sup> Civil Code of the Russian Federation of December 18, 2006, № 230-Fz.



lectual property are examined mostly in action proceedings and sometimes in separate proceedings – ascertainment of legally significant facts.

Despite the fact that lawmaker of the Russian Federation established in Article 122 of the Civil Procedural Code of the Russian Federation<sup>23</sup> (hereinafter CPC RF) an exhaustive list of requirements on which a court order is issued, protection of intellectual property may be provided by mandatory proceedings within the civil trial. This possibility is pointed out by professionals of Russian civil procedure law too. So the cases in the sphere of intellectual property may be examined by mandatory proceedings in following occasions: in cases arising from writing contracts, e.g. authors' contracts, because one of the parties can be a citizen; in cases of recovering of accrued but not paid amount of employee wages, e.g. rights to a course-of-duty work.<sup>24</sup> It should be noted that an exhaustive list of requirements by which a court order may be issued that is contained in Article 96 of CPC Ukraine is slightly different from similar list established in Article 122 of CPC RF. At the same time, in accordance with paragraph 1 of the Part 1 of Article 96 of CPC Ukraine a court order may be issued in cases arising in the field of intellectual property on only one category - on claims on recovering of accrued but not paid amount of employee wages – cases arising from the creation and use of course-of-duty works.

However, one should take into account that under Paragraph 4 of Part 1 of Article 125 of CPC RF and Paragraph 2 of Part 3 of Article 100 of CPC Ukraine the judge shall refuse to accept the application for a court order issuance if the dispute on the law is seen from the application and the papers submitted is considered, i.e. only on undisputed cases arising from the creation and use of objects of copyright and (or) related right a court order may be issued.

Speaking about the court order one cannot neglect the judicial practice of Great Britain in the sphere of protection of copyright and (or) related rights and intellectual property rights in general.

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<sup>23</sup> The Civil Procedural Code of the Russian Federation, No. 138-Fz, 14 November 2002.

<sup>24</sup> O. Sukhov, *Problems of court protection of intellectual property*, [http://portal-law.ru/articles/sudzashita/problemy\\_sudebnojj\\_zashity\\_intellektualnojj\\_sobstvennosti/](http://portal-law.ru/articles/sudzashita/problemy_sudebnojj_zashity_intellektualnojj_sobstvennosti/).

By the nature of duty lying to a respondent, court orders-injunctions can be divided into prohibitory (restrictive, negative) and compensatory; and depending on the stage of issuance of court order-injunction and on the period of its action – into interlocutory and final (perpetual).

English judges developed a number of court orders-injunctions that may be used for protection of copyright and (or) related rights, among them a Mareva injunction<sup>25</sup>, an Anton Piller order<sup>26</sup>, *quia timet action*.

The Mareva injunction is also known as a “freezing order”. In order to be granted it is necessary: 1) to adduct convincing proofs to a court confirming the existence of the plaintiff’s claims against the defendant and to disclose all essential facts on the case, 2) the case should be under jurisdiction of a court to which the plaintiff applied, 3) to give evidence proving that the property against which the plaintiff applies for this injunction belongs to a defendant, 4) the defendant’s property is under court jurisdiction, 5) the plaintiff must show that there is a reasonable risk that the defendant is likely to move assets out of reach and the defendant will not satisfy the requirements of the claim, 6) the plaintiff is obligated to compensate the defendant or the third parties for all the damages that this injunction may cause in a case of plaintiff’s defeat. Another specificity of the Mareva injunction is that English courts can issue it against any defendant regardless their citizenship or country of residence.<sup>27</sup> On the basis of the Mareva injunction and legal circumstances of its realization the conclusion can be made that it is similar with such procedural action as securing the claim known in countries with code-based law system.

The Anton Piller order turned out to be the most effective in cases of an infringement of copyright, patents, trademarks, disclosure of confidential information, at the same time English courts uses it in other cases too. The Anton Piller order is also called “a search order” according to which

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<sup>25</sup> Mareva Compania SA v International Bulkcarriers SA [1975], 1 All ER 213, available at: <http://www.uniset.ca/other/cs4/19801AER213.html>.

<sup>26</sup> Anton Piller KG v Manufacturing Processes Ltd [1976] EWCA Civ 12 (08 December 1975), available at: <http://www.bailii.org/ew/cases/EWCA/Civ/1975/12.html>.

<sup>27</sup> A. Mikhailov, *Court orders-prohibitions in English right*, <http://blog.pravo.ru/blog/5599.html>.

the defendant is obliged to allow a plaintiff's lawyer to enter premises and inspect the documents and objects that, to the plaintiff's mind, infringing the intellectual property rights.

It should be kept in mind that a plaintiff's lawyer does not have the right to enter their premises without a permission of a defendant but such refusal is considered to be an offense against the court (contempt of court and attack on the interests of justice) for what a liability is stipulated.

To obtain the Anton Piller order an applicant has to: 1) adduct proofs to a court confirming the necessity of this order issuance, 2) give evidence proving that a direct or potential damage of a plaintiff will be substantial in a case of nongranteeing of an order, 3) show that a defendant has all materials that may testify the plaintiff's copyright infringement as well as to corroborate the fact that a defendant can destroy such materials in a case of action or other proceedings, 4) guarantee to a court that in a case of defeat they will compensate damages to a defendant and the third parties caused by the use of the Anton Piller order, 5) disclose all essential facts of a case.

A benefit of the Anton Piller order in comparison with other injunctions is its issuing by a court without reference to a defendant. The order can also contain a requirement to a defendant to disclose information about the third parties infringing the relevant defendant's rights and a prohibition to a defendant to inform the third parties of a plaintiff's actions.<sup>28</sup>

Functionally, a *quia timet action* (*quia timet* – because he is afraid) is giving a possibility to a plaintiff to stop the threat of causing damages and prevent from violation in future. A plaintiff must prove their concerns about possible infringements of their rights giving to the court the evidence of: 1) existence of direct nature of the threat of an infringement of their rights from the defendant, 2) the risk of future damage, 3) the fact that in a case of damage a monetary reimbursement is an adequate remedy, 4) the fact that a threat or other defendant's actions making possible to assume the future damage are intentional, 5) the urgency of the threat eliminating actions.

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<sup>28</sup> *Ibid.*

In cases where the plaintiff is unable to get *quia timet action* from a court, there is still a possibility to apply to the court for obtaining an interim or permanent injunction<sup>29</sup>.

On the basis of the abovementioned court order-injunctions it should be pointed out that some provisions were prescribed and developed in the Copyright, Designs and Patent Act 1988 of the United Kingdom.<sup>30</sup> The aforesaid court injunction orders are the adequate reaction on infringements of protected rights and interests of persons in copyright relations, and the mechanism of their realization at the same time takes into account the interests of the third parties that may be recognized as violators of copyright in future. Such a balanced approach of the English judicial system in the process of detection and fixation of copyright as well as an effective and fast response to copyright infringement with the purpose of their termination and prevention may be an example of safeguarding and protection of copyright.

#### SUMMARY

The article is devoted to topical issues of the measures that impede and prevent the illegal use of copyrighted works. The urgency of the suggested topic of the paper confirms that on the international level as well as in domestic laws of many countries the possibility of applying of an interim injunction is provided.

The article exposes the essence of interim injunctions by means of analyzing the legislation and the practice of two different legal systems: Roman-Germanic (Ukraine, the Russian Federation) and Anglo-Saxon (the United Kingdom).

The applicability of interim injunctions in the process of copyright protection in Ukraine is granted by the Law of Ukraine “On Copyright and Related Rights”.

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<sup>29</sup> *Ibid*

<sup>30</sup> [http://www.MEDIALAW.ru/laws/other\\_laws/british/copyright.htm](http://www.MEDIALAW.ru/laws/other_laws/british/copyright.htm)

According to the TRIPS Agreement, the judicial authorities shall have the right to order a party to desist from actions that involve the infringement of the intellectual property rights.

The article draws attention to the fact that usually in any procedural legislation of any country that provides such a procedural remedy as a court order, the mandatory proceeding is a fast and prompt interim response of a court to termination of causing damage to a claimant in comparison with the action proceeding.

On the basis of the analysis of the legislation of Ukraine and the Russian Federation the conclusion is proved that the civil procedural legislations of Ukraine and the Russian Federation do not explicitly provide the possibility of a court order issued either on the claims of intellectual property rights in general or on the cases arising directly from author's legal relations. The protection of copyright and (or) related rights a legislator connects mostly with the action proceeding in civil trial.

In the article attention is drawn to the fact that the civil procedural legislation of Ukraine (the Civil Procedure Code of Ukraine) provides that as interim injunctions that can be applied by the court in civil proceedings in cases arising from author's legal relations may be used – securing of evidence and securing a claim. However, these measures cannot fully meet the requirements of the Law of Ukraine “On Copyright and Related Rights”.

The author notes that the interim injunction in the legislation of Ukraine is explicitly provided by the economic procedural legislation (Section V-1 of the Economic Procedural Code of Ukraine has the title “Preventive measures”). On the one hand, that is a procedural implementation of protection of rights fixed by material law by the subjects of copyright, and on the other hand, it does not fully guarantee the fast detection of infringements and immediate receiving and preservation of evidences in cases when any delay can cause irreparable damage to the subjects of copyright or when a risk of possible destroying of the evidence is obvious.

Defects in Ukrainian legislation concerning the prevention, detection and termination of violations of copyright prompted the author of this article to apply within this problem to the legislative practice of Great Britain. The paper analyzes such court orders-injunctions as a Mareva in-

junction, an Anton Piller order, *quia timet* action that got their prescription and development in the “Copyright, Designs and Patents Act 1988” of the United Kingdom.

The research of legal regulation of copyright protection worded in this article put the question about the necessity of introduction of changes to the legislation of Ukraine aimed not only at more detailed testing of interim injunctions types but also at the elaboration of more precise procedures of their use. The necessity of the existence of interim injunctions in civil procedural legislation aimed at the prevention and detection of copyrights infringements is confirmed by the modern development of technologies and the specifics of up-to-date violations in the sphere of copyright.