

ENCROACHMENT OF A RIGHT AND THREAT OF INFRINGEMENT OF A RIGHT AS GROUNDS FOR THE RIGHT TO ENFORCEMENT OF INTELLECTUAL PROPERTY RIGHTS

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Annotation. The article discusses the general methods of civil rights enforcement that may be applied by a court, in particular, when protecting intellectual property rights, as set out in Article 16 of the Civil Code of Ukraine. The authors also discuss special methods of enforcement of intellectual property rights provided for in part 2 of Article 432 of the Civil Code of Ukraine, according to which the court may make a decision in cases and in the manner prescribed by law.

The remedies are directly related to the nature of the violation of a subjective civil right or interest, in particular: the definition of the violated right or interest; the fact of the violation itself (non-recognition, contestation) or the threat of such violation; the possibility (or expediency) of restoring the right, removing obstacles to its exercise, or compensation for the consequences of the violation; as well as the need to apply a comprehensive approach to enforcement, etc.

It is determined that infringement is only an attempt, preparation, or attempt to commit a civil offence. As for the threat of infringement as a way of protecting intellectual property rights, it is characteristic of copyright and is a separate type of unlawful behaviour that is culpable, real, purposeful, and public. It is determined that, depending on whether the rights have already been violated or there is only a threat of their violation, the remedies can be divided into those aimed at terminating the violation and eliminating its consequences and those aimed at preventing the violation of rights.

Key words: intellectual property, enforcement of rights, infringement of intellectual property rights, encroachment of intellectual property rights.

1. Introduction.

An essential legal guarantee of intellectual property rights as a subjective civil right is their provision with judicial enforcement in case of infringement, non-recognition, or challenge. In the event of a dispute, the court's enforcement of intellectual property rights confirms the subject's ownership, stops the violation, and eliminates the negative consequences caused by it. The enforcement of intellectual property rights is of great importance, as it ensures the recognition of authorship or invention rights for the person who created the relevant intellectual property. The grounds for enforcement of intellectual property rights are their violation, non-recognition, or contestation. Preventive enforcement in the field of intellectual property is also possible when there is no infringement yet, but there is a real threat of violation of the relevant subjective rights.

As a general rule, a person who owns the intellectual property right, i.e., the subject of the relevant right, may file a claim for enforcement of the intellectual property right with the court. In cases stipulated by contract and law, other entities have the right to file a claim for enforcement. Judicial enforcement of intellectual property rights is carried out using remedies by the court, i.e. substantive legal measures aimed at recognising the right, stopping its violation, restoring the situation that existed before the violation, and compensating for the property and non-property losses caused by the violation.

Liability for infringement of intellectual property rights may be administrative, criminal, or civil. The enforcement of intellectual property rights is a separate category of cases that has its specific features.

2. Analysis of recent research and publications.

Many scientific and practical works are devoted to the issues of legal content and the enforcement of intellectual property rights. Such researchers as I.V. Venediktova, V.S. Drobiazko, R.V. Drobiazko, I.F. Koval, O.V. Kokhanovska, N.S. Kuznetsova, V.V. Luts, R.A. Maidanyk, O.P. Orliuk, R.O. Stefanchuk, O.I. Kharytonova, R.B. Shyshka, Y.M. Shevchenko, etc.

3. The purpose of the article is to analyse the legal content of encroachment of a right and the threat of infringement of a right as the basis for the right to enforcement of intellectual property rights.

4. Summary of the main material.

Implementation of the constitutional provisions related to various types of intellectual activity depends on the availability of appropriate national legislation regulating social relations in the field of intellectual property, including its enforcement. The growing role and importance of intellectual activity and intellectual property requires an increase in the effectiveness of their legal protection and enforcement. The enforcement of the rights and legitimate interests of intellectual property rights holders is carried out through a special mechanism, which is a system of forms, methods, and means of activity of the relevant jurisdictional authorities and stakeholders aimed at ensuring the enforcement of the rights and interests of these entities.

According to Article 15 of the Civil Code of Ukraine, every person has the right to protect his or her civil rights in the event of their violation, non-recognition, or challenge. The peculiarities of intellectual property rights require the establishment of special measures aimed at their enforcement. Part 2 of Article 432 of the Civil Code of Ukraine defines the powers of the court to protect intellectual property rights, including the application of immediate measures to prevent infringement of intellectual property rights and preserve relevant evidence [1].

Depending on whether the rights have already been infringed or there is only a threat of infringement, remedies can be divided into those aimed at stopping the infringement and eliminating its consequences (e.g., prohibition of publication or distribution of a plagiarized work; publication of information about the infringement in the media; withdrawal of copies of works created in violation of copyright) and those aimed at preventing infringement (e.g., prohibition of publication of a work in a scientific journal). According to Article 53 of the Law of Ukraine "On Copyright and Related Rights", actions that create a threat of copyright infringement are considered to be an infringement of copyright and (or) related rights, which is the basis for judicial enforcement. For example, actions that pose a threat to the violation of personal non-property and property copyright and related rights include, in particular:

- 1) distribution, importation into the customs territory of Ukraine of technical devices, equipment, including computer software computer programs and providing users with access to copyrighted works and/or related rights objects without the permission of the relevant copyright holders or related rights holders (including when computer programs, applications and add-ons, technologies or technical devices use signals from other Internet resources);
- 2) configuring computer programs, applications, add-ons to them, technologies, technical devices that provide access to copyrighted works and/or related rights objects without the permission of the relevant copyright holders or related rights holders of such objects (including when the computer program, applications and add-ons to it, technologies, or technical devices use signals from other Internet resources);
- 3) providing instructions on how to configure computer programs, applications, and add-ons, technologies, technical devices for accessing copyrighted works and/or related rights objects

without the permission of the relevant copyright holders or related rights holders of such objects in any form to obtain remuneration from the provision of such instructions.

As stated in the Resolution of the Supreme Economic Court of Ukraine No. 12 “On Certain Issues of Dispute Resolution Practice Related to the Enforcement of Intellectual Property Rights” dated 17.10.2012, based on this law, the absence of damage does not relieve the infringer of the obligation to cease infringement of such rights [2].

Unlike copyright law, patent law does not contain a specific list of ways to protect infringed rights. Thus, Art. 35 of the Law of Ukraine “On Protection of Rights to Inventions and Utility Models” and Art. 27 of the Law of Ukraine “On Protection of Rights to Industrial Designs”, despite their titles “Methods of Enforcement of Rights” [3,4], define only the categories of disputes that courts may consider in accordance with their competence. These include disputes over the authorship of an invention, utility model, or industrial design, the establishment of the use of these objects, compensation, etc. In addition to the traditional remedies common in the field of copyright (such as compensation for damages or prohibition of misuse of an intellectual property object), industrial property often uses such a remedy as invalidation of a security document.

For example, according to provisions of the Article 83-1 and the Article 110 of the Commercial Procedure Code of Ukraine upon a reasoned request of a party to the case, the court may secure evidence if there are grounds to believe that the means of proof may be lost, or that the collection or submission of relevant evidence will subsequently become impossible or difficult. The means of securing evidence by the court include the examination of witnesses, the appointment of experts, the request and/or inspection of evidence, including at its location, the prohibition of certain actions concerning evidence, and the obligation to take certain actions with regard to evidence. Where necessary, the court may apply other means of securing evidence as determined by the court like issue a ruling to request evidence in the form of information about the origin and distribution network of goods or services that infringe intellectual property rights or for which there are sufficient grounds to believe that the distribution of such goods or the provision of such services infringes intellectual property rights:

- 1) from a person in respect of whom there are sufficient grounds to believe that such person infringes intellectual property rights; and/or
- 2) from any other person in respect of whom there are sufficient grounds to believe that such person offered, received, possessed, and/or used goods or provided services that infringe intellectual property rights for commercial purposes; or
- 3) from any other person who has been identified by the person referred to in paragraph 2 of this part as being involved in the production, manufacture, or distribution of goods or the provision of services that infringe intellectual property rights.

A request for the disclosure of evidence shall relate exclusively to information necessary to establish the origin and distribution network of goods or services that infringe intellectual property rights or in respect of which there are sufficient grounds to believe that the distribution of such goods or the provision of such services infringes intellectual property rights.

Furthermore, upon the request of a party to the case, the court has the right to take Interim Relief. Interim Relief may be secured by:

- imposing an arrest on property and/or funds belonging to or subject to transfer or payment to the defendant and located with the defendant or other persons;
- prohibiting the defendant from performing certain actions;
- prohibiting other persons from performing actions related to the subject matter of the dispute or making payments, or transferring property to the defendant, or performing other obligations in relation to him;
- suspension of the sale of property if a claim has been filed for recognition of ownership of such property, or for its exclusion from the inventory and removal of the seizure;
- suspension of customs clearance of goods or items containing intellectual property;

- other measures in cases provided for by law, as well as international treaties, the binding nature of which has been approved by the Verkhovna Rada of Ukraine.

The court may apply several Interim Reliefs [5]

At the same time, a special provision (Article 431 of the Civil Code of Ukraine) clarifies the provisions of Article 15 of the same code, stating that encroachment of intellectual property rights, including non-recognition or infringement, entails liability determined by law or contract. However, other legislative acts do not offer a complete definition of the concept of infringement of subjective civil law, which would be suitable for the enforcement of intellectual property rights in all possible cases and cover all intellectual property objects [1].

One of the conditions for the protection of intellectual property rights is to define the content of its components, in particular, infringement of subjective intellectual property rights. Considering the interpretation of civil law provisions regulating the rights to intellectual property, we can define the concept of infringement. The Law of Ukraine "On Protection of Rights to Inventions and Utility Models" (part 1 of Article 34) [3] defines infringement as "any infringement of the right of a patent owner". A similar definition is contained in the Law of Ukraine "On Protection of Rights to Trademarks for Goods and Services" [6] and the Law of Ukraine "On Protection of Rights to Semiconductor Product Layouts" [7]. In the Law of Ukraine "On Protection of Rights to Plant Varieties" [8], the term "infringement" is associated with the presence or, more precisely, the absence of a person's permission to use and perform other actions in relation to a plant variety (Article 53). The most complete definition of "infringement" of intellectual property rights is provided in the Law of Ukraine "On Copyright and Related Rights", where, however, this concept is disclosed through a list of unlawful actions of a person [9].

Termination of actions that infringe or threaten to infringe the right and prohibition of such actions are preventive and restraining measures to protect copyright and related rights, but they are not identical. Unlike the termination of actions that infringe or threaten to infringe the right, the prohibition of actions, firstly, may cover not only actions that are already taking place, but also those that have not yet been performed. If the right holder becomes aware of the intention of a certain person to commit acts that will infringe his copyright or related rights or create a threat of such infringement, he may demand a prohibition of these acts. Secondly, a claim for prohibition of actions may be considered only in court, and the court may prohibit the distribution of works or other actions if the fact of copyright or related rights infringement or the existence of actions that create a threat of such infringement is proved in the course of the proceedings. Thus, it can be generally concluded that the legislator considers infringement of intellectual property rights as any infringement of these rights. However, this definition leaves certain questions unanswered. For example, how do the concepts of "infringement" and "encroachment" relate? The Civil Code of Ukraine considers infringement to be one of the types of violation of law, while patent laws treat it as a general concept of violation.

The UBA Committee on Medical and Pharmaceutical Law addressed the Ukrainian National Office of Intellectual Property and Innovations with proposals for amendments to the Draft Law of Ukraine "On Amendments to the Law of Ukraine "On Enforcement of Rights to Inventions and Utility Models". The Ukrainian National Office of Intellectual Property and Innovation (UIPI) has published on its official website for public discussion proposals to the Law of Ukraine "On Enforcement of Rights to Inventions and Utility Models". The purpose of these Proposals is to supplement the law with the "Bolar Rule", according to which actions aimed at registration of generic medicines under patent enforcement are not considered to be an infringement of patent rights.

The experts of the UBA Committee express their respect and generally support the need to improve the legislation by introducing provisions that allow the launch of affordable generic medicines on the market immediately after the expiration of the legal enforcement of the inventions on which they are based. However, the version of the rule proposed by the Ukrainian National Agency of Intellectual Property provides for additional inclusion in the list of exceptions that are not considered to be an infringement of patent rights of actions related to the actual filing of an application for registration of a medicinal product based on a valid third-party patent, its registration, and the issuance of a registration certificate to the applicant. According to the UBA Committee, such amendments do not take into account the requirements of the relevant legislation governing the process of creation, registration, production, and sale of medicines, and therefore their introduction may lead to the

actual legalization of the introduction of generic medicines to the Ukrainian market in violation of the valid patents of the right holders for the active pharmaceutical ingredients used in them.

Based on the analysis of the court practice in the field of patent law, according to the consistent position of the Supreme Court in resolutions 910/17860/21 and 910/9215/21 [10,11] and the Law of Ukraine "On Protection of Rights to Inventions and Utility Models" [3], it is not possible to file an application for registration of a medicinal product and obtain a state registration certificate before the expiration of the patent. Not only the actual use of the invention without the patent holder's consent, but also any infringement of these rights is considered a violation of the patent holder's rights. Since state registration is a prerequisite for placing a medicinal product on the market in Ukraine, filing an application for registration of a medicinal product that uses an invention to which the rights belong to another person and remains valid is actually a preparation for placing such a product on the market and thus an infringement of the patent holder's rights.

However, this statement contradicts certain positions of the European legislation, in particular, according to the joint statement of the European Council and the European Commission in the Joint Position of the Council of the EU No. 61/2003 of September 29, 2003: "The Council and the Commission consider that the submission and subsequent examination of an application for marketing authorization (of a medicinal product), as well as the granting of the authorization, are considered administrative actions and as such do not infringe patent enforcement" [12]. In the legal literature, an encroachment is an intentional act aimed directly at committing a crime when the crime was not completed due to circumstances beyond the control of the perpetrator [13, 507].

An analysis of the provisions of the Civil Code of Ukraine leads to the conclusion that infringement is only an attempt, preparation, or attempt to commit a civil offence. However, if such an encroachment, preparation, attempt, or other similar actions did not cause moral and/or property damage, they should not be considered a violation of civil law and intellectual property rights.

V.V. Luts notes that actions that fall under the signs of infringement of intellectual property rights are culpable, real, and purposeful, i.e., those that will inevitably lead to infringement of intellectual property rights provided for by law. Such actions may also be of a public nature, especially when it comes to infringement of personal non-property intellectual property rights. We consider this opinion to be more reasonable, since the threat of copyright infringement is a separate type of unlawful behaviour - culpable, real, purposeful, and public, which is characteristic exclusively of civil liability for copyright infringement [14, 163].

In order to determine the infringement of intellectual property rights, one should first take into account the existence of damage as one of the conditions for infringement. However, it is worth noting that infringement of intellectual property rights has its own peculiarities due to the specifics of the right itself. As in the case of a violation of property rights, infringement of intellectual property rights is usually associated with causing damage or loss to its owner. However, the peculiarity lies in the actions that cause this damage or loss. Therefore, it is necessary to identify specific illegal actions that cause damage (losses) to the subject of intellectual property rights.

A clear definition in the legislation of actions recognised as infringement of intellectual property rights will eliminate the possibility of ambiguous interpretation of such infringements. However, the list of these actions in the law cannot be exhaustive. Such a list will help to specify the grounds for liability for infringement of intellectual property rights and determine their scope. At the same time, the definition of specific actions that will be considered an infringement will contribute to a clearer regulation of the system of enforcement of this right. The list of illegal actions should be harmonised into a single and unambiguous system.

Pursuant to Article 53 of the Law of Ukraine "On Copyright and Related Rights", copyright holders may apply to courts and other authorities in accordance with their competence to protect their infringed rights. In particular, they have the right to demand recognition and restoration of their rights, to file claims for compensation for damages (pecuniary damage), including lost profits, or recovery of income received by the infringer as a result of copyright infringement, as well as compensation for moral (non-pecuniary) damage. They may also demand termination of preparatory actions that may lead to copyright infringement [9].

Copyright holders have the right to participate in the inspection of production facilities, warehouses, technological processes, and business operations related to the manufacture of copies of works, phonograms, and videograms in respect of which there is a suspicion of infringement or threat of infringement of copyright. They may also demand from infringers to provide information about third parties involved in the production and distribution of counterfeit copies of works, as well as about the means of circumventing technical means of enforcement and channels of their distribution (as an example, see the decision of the Commercial Court of Ivano-Frankivsk region of 18.08.2021 in case No. 909/511/2).

In addition, the Law defines as infringement of copyright and/or related rights any actions aimed at deliberately circumventing technical means of protecting these rights, including the manufacture, distribution, importation for distribution and use of means for such circumvention. Falsification, alteration, or removal of information, in particular in electronic form, on the management of rights without the permission of copyright and/or related rights holders or the person performing such management shall also be recognised as infringement of these rights. The distribution, importation into the customs territory of Ukraine for distribution or public announcement of copyright and/or related rights objects from which information on rights management, in particular in electronic form, has been removed or replaced without the permission of the subjects of these rights, is also considered a violation [9]. Without going into a detailed analysis of the completeness and content of the above list, it is worth noting that it quite clearly organises the system of enforcement of intellectual property rights, at least copyright and/or related rights.

The Law of Ukraine “On Protection of Rights to Plant Varieties” also defines actions that are considered infringements of rights to a variety. Thus, part 1 of Article 53 of this Law states that the appropriation of authorship of a variety is a violation of the personal non-property right of authorship of a variety [8]. However, the question remains: why is only misappropriation of authorship recognised as an infringement, while other personal non-property rights remain outside the legal regulation?

The Law of Ukraine “On Copyright and Related Rights” is the first regulatory act to define actions that pose a threat to infringement of copyright and/or related rights. The concept of “threat of infringement of copyright and/or related rights” requires a separate study, as it is close to such concepts as “infringement”, “attempt”, etc. In particular, Art. 53 of the Law describes in detail the actions that pose a threat of infringement of personal non-property and property copyright and related rights. Thus, it can be concluded that infringement is one of the types of violation of intellectual property rights.

Other laws of Ukraine regulating intellectual property do not contain clear and specific lists of actions that should be recognised as infringements of intellectual property rights. This is a significant gap in Ukrainian legislation in this area. The absence of clear definitions of infringement of intellectual property rights significantly reduces the effectiveness of the system of their enforcement and creates opportunities for ambiguous interpretation of certain actions that violate these rights. Therefore, it is important to establish a list of actions that are recognised by law as infringements of intellectual property rights in order to ensure a clear definition and regulation of this concept.

Thus, the dispute is based on the question of whether there are legal grounds to protect the plaintiff's rights in the manner chosen by the plaintiff. Under Article 431 of the Civil Code of Ukraine, infringement of intellectual property rights, including failure to recognise such rights or infringement thereof, entails liability established by this Code, another law or agreement. Under Article 432 of the Civil Code of Ukraine, every person has the right to apply to the court for enforcement of his or her intellectual property rights following Article 16 of this Code. Thus, the right to choose the method of enforcement of the violated or disputed right belongs to the plaintiff, and it is the responsibility of the court to verify that this method is appropriate for the violation and the purpose of the trial. The court must decide on the case within the scope of the claims, considering both the possibility of protecting the violated right through the chosen method (if there are grounds for this) and the need for further enforcement of the decision.

5. Conclusions.

The remedies are directly related to the nature of the violation of a subjective civil right or interest, in particular: the definition of the violated right or interest; the fact of the violation itself (non-recognition, contestation) or the threat of such violation; the possibility (or expediency) of restoring

the right, removing obstacles to its exercise, or compensation for the consequences of the violation; as well as the need to apply a comprehensive approach to enforcement, etc. In some cases, there are no remedies, for example, when an item is destroyed, it becomes impossible to restore the right. The subject's freedom to choose the type and method of defense is due to the general permissive orientation of civil law, which gives a person the right to determine his or her own behavior, i.e. to choose a method of defense, taking into account the nature of civil legal relations (characteristics or status of the subjective right and interest as an object of defense) and the nature of the offense. Thus, an encroachment is only an attempt, preparation, or attempt to commit a civil offence. However, if such an encroachment, preparation, attempt, or other similar actions did not cause moral or property damage, they should not be considered a violation of civil law, including intellectual property rights.

The threat of copyright infringement is a separate type of unlawful behaviour that is culpable, real, purposeful, and public, which is characteristic of civil liability for copyright infringement.

A clear definition in the legislation of actions that are recognised as infringement of intellectual property rights may eliminate the possibility of ambiguous interpretation of such infringements. However, even so, the list of such actions in the law cannot be exhaustive. Such a list will specify the grounds for liability for infringement of intellectual property rights, which, in turn, will allow determining the scope of liability. At the same time, specifying the actions that will be considered an infringement of intellectual property rights will ensure a clearer regulation of the system of its enforcement.

References:

1. Civil Code of Ukraine of January 16, 2003, No. 435-IV. *Bulletin of the Verkhovna Rada of Ukraine*. 2003. № 40-44. Article 356. URL: <http://zakon2.rada.gov.ua/laws/show/435-15>.
2. On some issues of dispute resolution practice related to the enforcement of intellectual property rights: Resolution of the Plenum of the Supreme Economic Court of Ukraine of 17.10.2012 No. 12. URL: <https://zakon.rada.gov.ua/laws/show/v0012600-12#Text>.
3. On the Protection of Rights to Inventions and Utility Models: Law of Ukraine of December 15, 1993. URL: <https://zakon.rada.gov.ua/laws/show/3687-12#Text>.
4. On the Protection of Rights to Industrial Designs: Law of Ukraine of December 15, 1993. URL: <https://zakon.rada.gov.ua/laws/show/3688-12#Text>.
5. Commercial and Procedural Code of Ukraine: Law of Ukraine November 6, 1991 № 1798-XII URL: <https://zakon.rada.gov.ua/laws/show/1798-12?lang=en#Text>.
6. On the enforcement of Rights to Trademarks and Service Marks: Law of Ukraine of December 15, 1993. URL: <https://zakon.rada.gov.ua/laws/show/3689-12#Text>.
7. On protection of rights to integrated circuit designs: Law of Ukraine of November 5, 1997 № 621/97-BP. URL: <https://zakon.rada.gov.ua/laws/show/621/97-%D0%B2%D1%80#Text>.
8. On the Protection of Rights to Plant Varieties: Law of Ukraine of 21.04.1993. URL: <https://zakon.rada.gov.ua/laws/show/3116-12#Text>.
9. On Copyright and Related Rights: Law of Ukraine of 01.12.2022. URL: <https://zakon.rada.gov.ua/laws/show/2811-20#Text>.
10. Resolution of 08.12.2022 No. 910/17860/21 of the Supreme Court. Commercial Court of Cassation. URL: https://verdictum.ligazakon.net/document/107746533?utm_source=jurliga.ligazakon.net&utm_medium=news&utm_content=jl01.
11. Resolution of 27.04.2023 No. 910/9215/21 of the Supreme Court. Commercial Court of Cassation. URL: <https://verdictum.ligazakon.net/document/110536260>.
12. Official Journal of the European Union 2003, C 297 E/66, footnote 1. <https://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:C:2003:297E:0041:0071:EN:PDF>.

13. Legal Encyclopedia: in 6 volumes / ed. by S. Shemshuchenko (chairman of the editorial board) and others. K.: Ukr. Encyclopedia, 1999. Vol. 2. 744 p.
14. Personal non-property rights of intellectual property of creators: a monograph / edited by V.V. Luts. Ternopil: Textbooks and manuals, 2007. 256 p.

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