

DRAFT LAW ON THE ENFORCEMENT OF
INTELLECTUAL PROPERTY RIGHTS INCLUDING BORDER MEASURES
FOR THE SULTANATE OF OMAN

prepared by the Secretariat of WIPO

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Part I: Infringement Proceedings

Chapter 1: Infringement

Infringement of Patents;
Remedies

1.(1) Subject to Articles 12(3), 16, 19 and 20 of Law No. .../2000 on the Protection of Patents, an infringement of a patent shall consist of the performance of any act referred to in Article 12 of Law No. .../2000 on the Protection of Patents in Oman by a person other than the owner of the patent and without the agreement of the latter.

(2) The owner of the patent, or a licensee if he has requested the owner to institute court proceedings for a specific relief and the owner has refused or failed to do so, is entitled, unless the patented product or product incorporating the patented device has been put on the market with the consent of the owner of the patent,

- (i) to an injunction to prevent infringement or an imminent infringement,
- (ii) where the infringer acted knowingly or with reasonable grounds to know, to damages, and
- (iii) to any other remedy provided for in the general law and under Chapter 5 of this Part.

(3) Requests for remedies under sub-article 2)) shall be filed with the [...] Court.

Infringement of Trademarks
and Trade Secrets;
Unlawful Acts; Remedies

2.(1) Subject to Article 16 of Law No. .../2000 on Trade Marks, Trade Secrets and Protection Against Unfair Competition, an infringement of a registered mark shall consist of the performance of any act referred to in Article 14 A of Law No. .../2000 on Trade Marks, Trade Secrets and Protection Against Unfair

Competition in Oman by a person other than the owner of the mark and without the agreement of the latter. In case of use of an identical sign for identical goods or services, a likelihood of confusion shall be presumed.

(2) Subject to Article 16 of Law No. .../2000 on the Trade Marks, Trade Secrets and Protection Against Unfair Competition, an infringement of a registered well-known mark shall consist of the use of a sign identical with or confusingly similar to the well-known mark without the agreement of the owner of the well-known mark provided that the sign is used:

- (i) in relation to goods or services identical with or similar to the goods or services for which the well-known mark has been registered, or
- (ii) in relation to goods or services which are not identical with or similar to those in respect of which the well-known mark has been registered provided that the use of the sign in relation to those goods or services would indicate a connection between those goods or services and the owner of the well-known mark and that the interests of the owner of the well-known mark are likely to be damaged by such use.

(3) An infringement of an unregistered well-known mark shall consist of the use of a sign identical with or confusingly similar to the well-known mark without the agreement of the owner of the well-known mark provided that the sign is used in relation to goods or services identical with or similar to the goods or services for which the mark is well-known.

(4) In determining whether a mark is well-known,

owner of the mark has refused or failed to do so, is entitled, unless the good bearing the mark has been put on the market with the consent of the owner of the mark,

- (i) to an injunction to prevent infringement, an imminent infringement, or an unlawful act referred to in Articles 30 *bis* and 30 *ter* of Law No. .../2000 on Trade Marks, Trade Secrets and Protection Against Unfair Competition,
- (ii) where the infringer acted knowingly or with reasonable ground to know, to damages, and
- (iii) to any other remedy provided for in the general law and under Chapter 5 of this Part.

(6) Any competent authority or any interested person, group association or syndicate, including producers, manufacturers or traders, is also entitled to the same relief where the Court is satisfied that an act of unfair competition referred to in Articles 30 *bis* and 30 *ter* of Law No. .../2000 on Trade Marks, Trade Secrets and Protection Against Unfair Competition has been committed or is imminent.

(7) Requests for remedies under sub-articles (5) and (6)) shall be filed with the [...] Court.

Infringement of Industrial Designs; Remedies

3.(1) An infringement of an industrial design registered under Law No. .../2000 on the Protection of Industrial Designs shall consist of the performance of any act referred to in Article 14 of the said Law by a person other than the owner of the industrial design and without his agreement.

(2) The owner of the industrial design, or a licensee if he has requested the owner to institute court proceedings for a specific relief and the owner has refused or failed to do so, is entitled, unless the good incorporating the design has been put on the market with the consent of the owner of the industrial design,

- (i) to an injunction to prevent infringement or an imminent infringement,
- (ii) where the infringer acted knowingly or with reasonable ground to know, to damages, and

(iii) to any other remedy provided for in the general law and under Chapter 5 of this Part.

(3) Requests for remedies under sub-article2)) shall be filed with the [...] Court.

Unlawful Use of
Geographical Indications;
Remedies

4.(1) An unlawful use of a geographical indication protected under Law No.2000/... on the Protection of Geographical Indications shall consist of the performance of any act referred to in Article3 D of the said Law or any use of a geographical indication by a person who has no right to use the geographical indication in accordance with the said Law.

(2) Any interested person or any interested group of producers or consumers is entitled, where the conditions set out in sub-article1)) are met, to an injunction to prevent the unlawful use of the geographical indication and

the owner to institute court proceedings for a specific relief and the owner has refused or failed to do so, is entitled, unless the layout-design (topography) or integrated circuit incorporating the layout-design (topography) has been put on the market with the consent of the owner of the layout-design (topography),

- (i) to an injunction to prevent infringement or an imminent infringement,
- (ii) where the infringer acted knowingly or with reasonable ground to know, to damages, and
- (iii) to any other remedy provided for in the

- (i) be fair and equitable and provide for safeguards against their abuse, and
- (ii) provide a means to identify and protect confidential information.

(3) Decisions on the merits of the case shall be

- (i) in writing and reasoned,
- (ii) made available without undue delay at least to the parties to the proceedings, and
- (iii) based only on evidence in respect of which parties were offered an opportunity of being heard.

(4) Subject to the adoption of provisional measures in accordance with Article 8 (2) without hearing the other party,

- (i) all parties to enforcement procedures shall be duly entitled to substantiate their claims, to present all relevant evidence and to be represented by independent legal counsel,
- (ii) defendants shall have the right to timely written notice containing sufficient detail including, in particular, the basis of the claims.

(5) Enforcement procedures under this Law shall not

- (i) impose overly burdensome requirements concerning mandatory appearances,
- (ii) be unnecessarily complicated or costly and
- (iii) entail unreasonable time-limits and unwarranted delays.

Chapter 3: Provisional Measures

Provisional Measures

8.(1) The [...] Court shall order prompt and effective provisional measures to pr

(6) Where the provisional measures are revoked or where the Court decides on the merits of the case in proceedings under sub-article 5)) initiated by the applicant that there has been no infringement or threat of an infringement, the Court shall order the applicant, upon the request of the defendant, to provide the defendant appropriate compensation for any injury caused by the execution of the provisional measures.

Chapter 4: Evidence; Burden of Proof

Evidence; Reversal
of Burden of Proof

9.(1) The Court may, where a party has presented reasonably available evidence sufficient to support the claims and has specified evidence relevant to substantiation of the claims which lies in the control of the opposing party, order that this evidence be produced by the opposing party, subject, in appropriate cases, to conditions which ensure the protection of confidential information.

(2) In cases in which a party to a proceeding voluntarily and without good reason refuses access to, or otherwise does not provide necessary information within a reasonable period, or significantly impedes a procedure relating to an enforcement action, the Court may make preliminary and final determinations, affirmative or negative, on the basis of the information presented to it, including the complaint or the allegation presented by the party adversely affected by the denial of access to information, subject to providing the parties an opportunity to be heard on the allegations or evidence.

(3) For the purposes of court proceedings, other than criminal proceedings, in respect of the violation of the rights of the owner of a patent referred to in Article 1 of this Law, where the subject matter of the patent is a process for obtaining a product, the burden of establishing that an identical product was not made by the protected process shall be on the alleged infringer if the product is new.

(4) In requiring the production of evidence, the Court before which the proceedings referred to in sub-article 1)) take place shall take into account the legitimate interests of the alleged infringer in not disclosing his manufacturing and business secrets.

Chapter 5: Damages, Other Remedies

- Damages
10. Where damages are awarded in accordance with Articles 1 to 6, the Court shall order the infringer to pay the right holder adequate compensation for the infringement of his intellectual property right provided that the infringer acted knowingly or with reasonable grounds to know. Where appropriate, the Court shall order the infringer to pay the right holder expenses which may include appropriate attorney's fees.
- Other Remedies
- 11.(1) Where goods have been found to be infringing, the Court shall, wherever this is considered adequate under the circumstances to create an effective deterrent to further infringement, taking due account of the need for proportionality between the seriousness of the infringement and the remedies as well as the legitimate interest of third parties, order, without compensation of any sort, that these goods be destroyed, or be disposed of outside the channels of commerce in such a manner as to avoid any harm caused to the right holder.
- (2) In respect of counterfeit trademark goods, the simple removal of the trademark unlawfully affixed shall not be sufficient, other than in exceptional cases, to permit release of the goods into the channels of commerce.
- (3) The Court shall also, wherever this is considered adequate, taking due account of the conditions set out in sub-article 1)), order that materials or implements the predominant use of which has been the creation of infringing goods be disposed of outside the channels of commerce without compensation of any sort in such a manner as to minimize the risks of further infringement.
- Information to Right Holder
12. The Court shall order the infringer to inform the right holder of the identity of third persons involved in the production and distribution of the infringing goods or rendering of services and of their channels of distribution, where this is in proportion to the seriousness of the infringement.
- Indemnification
13. The Court shall order an applicant at whose request

of Defendant

measures were taken and who has abused enforcement procedures to provide to a defendant wrongfully enjoined or restrained adequate compensation for the injury suffered by virtue of such abuse. Where this is considered adequate in view of the seriousness of the abuse, the Court shall also order the person having abused enforcement procedures to pay the other party expenses including appropriate attorney's fees.

Chapter 1: Border Measures by the Customs Department

Suspension on Own Initiative or on Request; Invitation to File Application

17.(1) The Customs Department shall, upon the request of the right holder or upon its own initiative, suspend the customs clearance procedures and release into free circulation of goods if there is sufficient *prima facie* evidence that the importation of counterfeit trademark goods or pirated copyright goods is taking place or is imminent.

(2) Where the release into free circulation was suspended on its own initiative, the Customs Department shall notify the right holder and give him

Release of Goods

Department under Article 17, the Customs Department shall inform the right holder of the names and addresses of the importer, consignor and consignee and of the quantity of the said goods provided that this is in proportion to the seriousness of the infringement.

(2) Upon request, the Customs Department shall also, without prejudice to the protection of confidential information, provide the right holder with copies of documents lodged in respect of such goods or with any information or documents relating to any previous importation of identical or similar goods [in which the same importer, consignor or consignee were involved].

(3) The owner, importer or consignee of the goods shall be entitled to their release on the posting of a security in an amount sufficient to protect the right holder, where the period set out in Article 33 has expired without the granting of provisional relief by the Court and where all other conditions for importation have been complied with.

Liability of Customs Department

21. The Customs Department shall not be liable for any action taken in good faith in respect of the release or suspension of release into free circulation of counterfeit, pirated and/or infringing goods including, in particular,

- (i) any failure to detect such goods, and
- (ii) the inadvertent release of such goods.

Assistance by Right Holder

22. The Customs Department may require the right holder to provide, without payment, any information and assistance, including technical expertise and facilities, for the purposes of determining whether goods are counterfeit or pirated goods or, where border measures have been ordered by the Court, whether the imported goods are identical with the goods referred to in the decision by the Court as being infringing goods.

Chapter 2: Border Measures by Court Order

Availability of Border Measures

23. Border measures shall, where the conditions set out in this Chapter are met, be ordered by the Court to prevent the importation of goods which

infringe intellectual property rights conferred by

- (i) patents granted in accordance with Law No.2000/... on the Protection of Patents,
- (ii) trademarks and trade names [business names] protected under the Law on Trade Marks and Data of October 5, 1987, and Law No. .../2000 on Trade Marks, Trade Secrets and Protection Against Unfair Competition,
- (iii) industrial designs protected under Law No.2000/... on the Protection of Industrial Designs and Models,
- (iv) geographical indications protected under Law No. .../2000 on the Protection of Geographical Indications,
- (v) integrated circuits incorporating unlawfully reproduced layout-designs (topographies) protected under Law No.2000/... on the Protection of Layout-Designs (Topographies) of Integrated Circuits, or articles incorporating such integrated circuits,
- (vi) copyright and related rights protected under Law No.2000/... , and
- (vii) goods unlawfully produced in violation of rights in respect of secret information protected under Article 30 *ter* of Law No.2000/... on Trade Marks, Trade Secrets and Protection Against Unfair Competition.

Application for
Suspension

24. The holder of an intellectual property right may file an application with the [...] Court requesting it to order the Customs Department to suspend customs clearance of goods suspected to infringe such right on the ground that there is a likelihood that his intellectual property right has been infringed or that such infringement is imminent.

Request; Prima Facie

25. The application shall be presented in writing and

Evidence

shall state the grounds for the request. It shall be accompanied by

- (i) *prima facie* evidence that the applicant is the holder of the intellectual property right
- (ii) *prima facie* evidence that his right has been infringed or that an infringement is imminent,
- (iii) a sufficiently detailed description of the goods alleged to be infringing in order to make them readily recognizable, and,
- (iv) the prescribed fee.

Content of Application

26. The applicant shall furnish all information available to him enabling the Court to take a decision. The information may include the following:

- (i) the name and address of the importers and/or consignees of the goods alleged to infringe his intellectual property rights,
- (ii) a sample or photograph of the goods alleged to be infringing, or other means enabling the Customs Department to recognize the said goods,
- (iii) the country or countries of origin or manufacture of the goods alleged to be infringing,
- (iv) the names and addresses of persons and/or business entities involved in the manufacture and distribution of the goods alleged to be infringing,
- (v) the manner of transportation and the names and addresses of the transporters of the goods alleged to be infringing,
- (vi) the port or ports where it is anticipated that the goods alleged to be infringing will be imported into the territory of the Sultanate and presented to the Customs Department,

- (vii) the expected date of importation and presentation to the Customs Department, and
- (viii) a sample of the genuine goods produced by or with the consent of the right holder.

Security

27.(1) The Court may require the right holder to provide security or other equivalent assurance:

- (i) to cover any liability on his part *vis-à-vis* persons affected by border measures where the said measures are discontinued by virtue of an act or omission by the right holder or where the goods in question are subsequently found not to be infringing,
- (ii) to ensure payment of the expenditure incurred in keeping the goods in suspension by the Customs Department, and
- (iii) to prevent abuse.

(2) Such security or equivalent assurance shall not unreasonably deter recourse to the procedure suspending release into free circulation of goods.

Release of Goods
and Security Therefor

28.(1) Where the period of suspension of release into free circulation of the goods referred to in Article 32 and Article 23³³) has expired without granting provisional relief by the Court in accordance with Article 29, and all other conditions for importation have been complied with, the owner, importer, or consignee of such goods shall be entitled to their release.

(2) The Court may make the release of the goods subject to the posting of a security in an amount sufficient to protect the right holder for any infringement.

Procedure

29.(1) The decision by the Court to suspend the release into free circulation of goods alleged to be infringing goods shall be taken in proceedings under Article 18⁸) and may be rendered, in accordance with Article 28⁸), without giving the other party an opportunity of being heard. In its decision, the Court shall specify the period

for which the Customs Department will have to take action.

(2) The Court shall forward its decision granting the application by the right holder without delay to the Customs Department which shall be liable to take action in respect of the goods alleged to be infringing.

Execution of Court Order

30. The Customs Department shall, upon the order of the Court, suspend the customs clearance procedures and the release into free circulation of goods [alleged][suspected] to infringe intellectual property rights referred to in Articles 1 to 6.

Compensation for Wrongful Detention

31. The Court may order the applicant to pay the importer, the consignee and the owner of the goods appropriate compensation for any injury caused to them through the wrongful detention of goods or through the detention of goods released by virtue of failure to initiate proceedings leading to a decision on the merits of the case in accordance with Article 32 .

Chapter 3: Proceedings Leading to Decisions on the Merits of the Case

Time Limit;
Release of Goods

32.(1) If, within a period of 10 working days after the applicant has been notified of the suspension of the release into free circulation, no proceedings leading to a decision on the merits of the case have been initiated by a party other than the defendant and, where the Customs Department has taken the decision to suspend the release into free circulation of the goods, the Customs Department has not been notified accordingly, the goods shall be released, provided that all other conditions for importation have been complied with.

(2) The Customs Department may, where it considers an extension of the said period to be appropriate under the circumstances, extend the period of suspension by a period not exceeding another 10 working days.

(3) The Court may extend the period by any period it considers reasonable under the circumstances.

Review of Decision

33.(1) If proceedings leading to a decision on the merits of the case have been initiated, the Court or the Customs Department, whichever authority has taken

Parallel Importation

37. Articles 16 to 35 shall not apply where the imported goods have been put on the market in another country with the consent of the right holder.

By-laws; Administrative Instructions

38. The [Minister of ...] shall issue By-laws setting out the detailed procedure for the implementation of this Law which may, in particular,

- (i) contain provisions establishing a centralized recordation system of intellectual property rights,
- (ii) provide for establishing contact points for the exchange of information on trade in goods infringing intellectual property rights, and
- (iii) provide for the publication of decisions of general interest on the application of this Law.

Appeal Against Decisions by Customs Department

39. The aggrieved party may lodge an appeal against any decision or measure taken by the Customs Department on or in connection with the suspension of release into free circulation of goods alleged to be counterfeit or pirated. The appeal shall lie to the [...] Court and shall be filed within [30] days from the notification of the decision.

Appeals Against Court Decisions

40. The aggrieved party may lodge an appeal against any decisions taken by the Court of first instance on or in connection with the suspension of release into free circulation of counterfeit, pirated or infringing goods. The appeal may be filed within [30] days from the notification of the decision with the [Court of Appeal].

[End]