



IP Enforcement: International and EU Standards

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on the Enforcement
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1. The Various Levels

- Multilateral:
 - See Paris Convention, Art. 9-10
 - See Berne Convention, Art. 16
 - See WCT, Art. 14; WPPT, Art. 23; Beijing Treaty, Art. 20
 - **TRIPS Agreement**

- Plurilateral → ACTA?
- Bi-lateral → Free Trade Agreements
- Regional (EU, OAPI, etc.)

2. The TRIPS Agreement

- Main features:
 - Sets out minimum standards of IP protection (Part II) ;
 - **Requires effective enforcement measures (Part III) ;**
 - Provides an effective dispute settlement mechanism (Part V) ;
 - Transitional arrangements (now for LDC) (Part VI).

3. TRIPS, Part III : IPR Enforcement

Part III = a framework

⇒ Balance of interests (Art. 41):

- *Minimum* standards of protection
- Ensuring effective action, including expeditious remedies to prevent infringements

But also:

- Avoiding the creation of barriers to legitimate trade (Art. 41.1);
- Providing safeguards against the abuse of procedures (Art. 41.1; Art. 48) ;
- Ensuring fair and equitable procedures: rights of defendants (Art. 42; Art. 50.4-7; etc.).

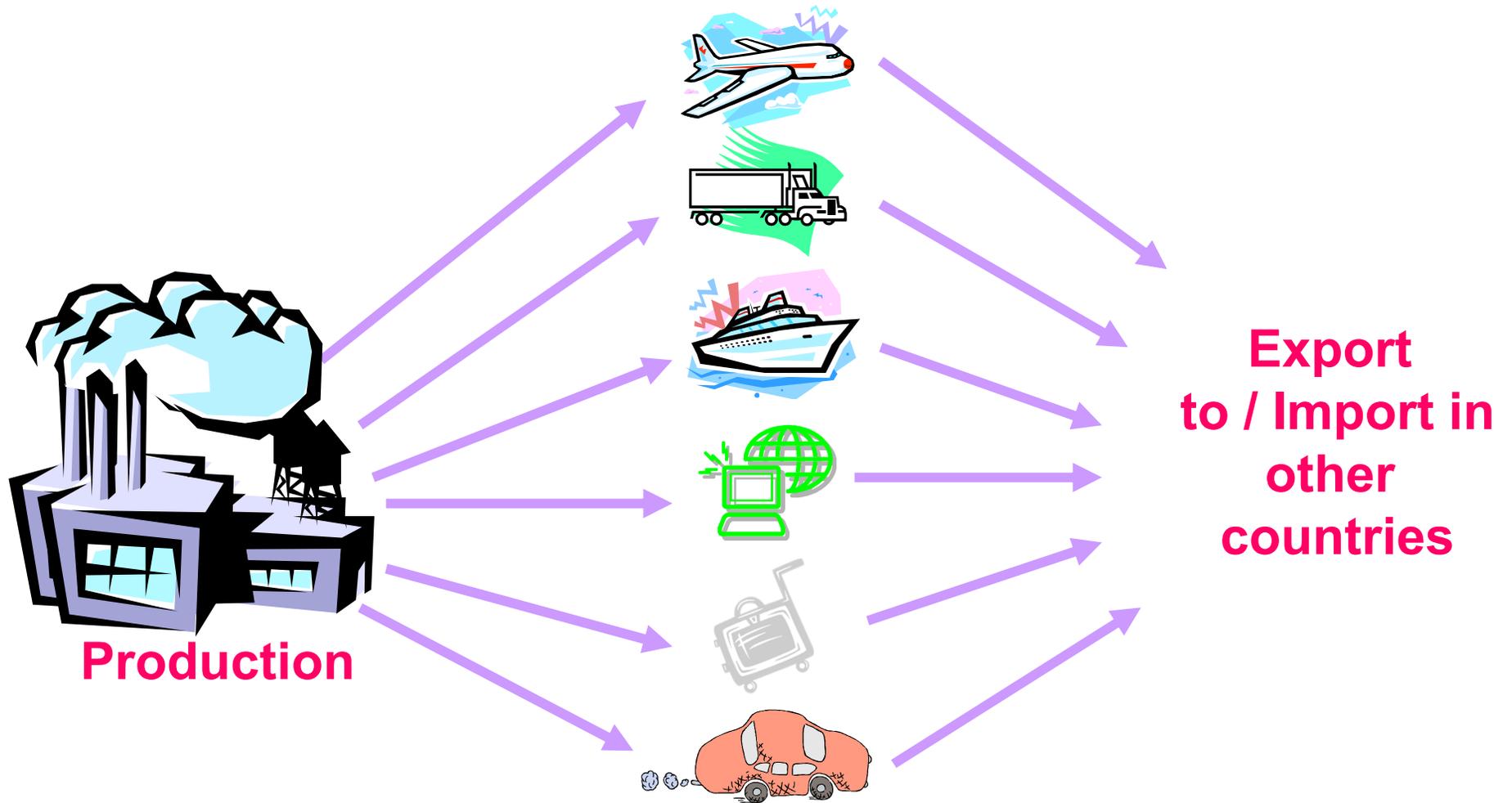
3. TRIPS, Part III : IPR Enforcement

- Structure: various sets of measures according to the nature of the infringement:
 - The infringement **of any IPR whatsoever** within the scope of TRIPS: civil & administrative procedures and remedies, including provisional measures (Art. 42-50).
 - + other measures for, **at least, trademark counterfeiting & copyright piracy** : border measures (Art. 51-60) + criminal sanctions (Art. 61).

3. TRIPS, Part III : IPR Enforcement

- No obligation for Member States to put in place a specific judicial system or allocate special funds for IP enforcement (Art. 41.5).

Means of conveyance



3.1. Border Measures (Art. 51-60)

Art. 51

- Subject: Suspension of release of alleged infringing goods.
- Only against the **importation** of goods suspected to be infringing trademarks (**counterfeit goods**) or copyrights (**pirated goods**)...
- ... but Member States may go further :
 - goods involving infringement of other IPRs (e.g., see EU Customs Reg.: **New Regulation No. 608/2013**)
 - goods to be exported.

3.1. Border Measures (Art. 51-60)

- Working?
 - Application to Customs Authorities by the right holder providing sufficient evidence of a *prima facie* infringement in the country of importation (Art. 52) ;
 - Customs Authorities (CA) decide to accept the application or not, and inform the applicant accordingly (Art. 52) ;
 - CA may require a security or equivalent assurance to the applicant : protection against abuse of right (Art. 53.1) ;

3.1. Border Measures (Art. 51-60)

- Effective suspension of release of goods => notification to the applicant AND the importer (Art. 54);
- Effective suspension of release of goods = for a determined period of time: 10 working days (+ add. 10 working days) within which period the applicant must have initiated a procedure on the merits OR provisional measures must have been taken by the judicial authorities (Art. 55) ;
- *Specificity: EU New Customs Regulation, Art. 23* (Art. 11 Reg. 1383/2003) - *Simplified Procedure* (+ Art. 26 re. goods in small consignments)
- If not => release of the goods.

3.1. Border Measures (Art. 51-60)

- If a procedure on the merits is started in due time => right of review of the suspension belongs to the importer (Art. 55) ;
- Right of inspection (to substantiate his/her claim) and information for the right holder by authorisation given by the competent authorities (Art. 57) // Provisional measures to get evidence ;
- Indemnification of the importer, the owner and the consignee of the goods for injury caused by wrongful detention of goods (Art. 56).

3.1. Border Measures (Art. 51-60)

■ Specificities:

- *Ex Officio* Action by CA, without application from the right holder (Art. 58) – *EU: New Customs Reg. 608/2013, Art. 18*
- *De Minimis* Imports (Art. 60) - *EU: New Customs Reg. 608/2013, Art. 1(4)* re. goods of a non-commercial nature contained in traveller's personal luggage

3.2. Provisional Measures (Art. 50)

- Competence of the Judicial Authorities, but possibility of same measures by administrative authorities under same conditions (Art. 50.8) ;
- Two purposes:
 - preventing an infringement of any IPR to occur (incl. entry into the channels of commerce) ;
 - **preserving relevant evidence.**
- *Prima facie* case + security (Art. 50.3) // avoiding abuse.

3.2. Provisional Measures (Art. 50)

- Unilateral procedure if need be // effectiveness of gathering evidence (Art. 50.2)...
- ... but right of review in a contradictory procedure for the defendant after the execution of the measures (Art. 50.4).
- Applicant bears the risk of having to provide the defendant with appropriate compensation (Art. 50.7).
- *See IPRED 2004/48/EC: Art. 7 (“Measures for preserving evidence”); Art. 9 (“Provisional and precautionary measures”)*

3.3. Civil procedure on the merits (Art. 42-48)

- Civil judicial procedures (Art. 42), but possibility of same measures by administrative authorities under same conditions (Art. 49) ;
- Fair and Equitable Procedures (Art. 42):
 - Right to timely and detailed written notices to Defendants
 - Right to representation
 - Personal appearances not overly burdensome
 - Right of parties to substantiate their claims and to present all relevant evidence
 - Protection of confidential information.

3.3. Civil procedure on the merits

- Evidence (Art. 42)
 - Judicial authorities may order that relevant evidence be produced by opposing party under specific conditions (Art. 43.1) ;
 - Judicial authorities can make preliminary and final determinations on the basis of the information presented to them without being stopped by the absence of co-operation of one of the parties (Art. 43.2).

- *IPRED 2004/48/EC, Art. 6*

3.3. Civil procedure on the merits

- Injunctions (Art. 44)
 - Judicial Authorities shall have the authority to order a party to desist from an infringement, *i.a.*, to prevent the commercialization of imported infringing goods
 - exception allowed for goods acquired in good faith.
- *See IPRED, Art. 11: Injunctions also against intermediaries whose services are used for infringing IPRs*

3.3. Civil procedure on the merits

- Damages (Art. 45)
 - Adequate compensation for the injury suffered by the right holder because of the infringer **who knew, or should have known**, that he was engaged in an infringing activity
 - **Option** “*in appropriate cases*”: Recovery of profits and/or payment of pre-established, **even if the infringer was acting in “good faith”**
 - *See IPRED, Art. 13*
 - Judicial expenses, which may include attorney’s fees (*see also IPRED, Art. 14*)

3.3. Civil procedure on the merits

- Other remedies (Art. 46)

- Judicial Authorities shall have the authority to order:

- that infringing goods be disposed of outside the channels of commerce or – unless against the constitutional principles - destroyed, without any compensation ;

- that materials and implements the predominant use of which has been in the creation of the infringing goods be disposed of outside the channels of commerce, without any compensation.

- *See IPRED, Art. 10 (“Corrective measures”) - includes recall from the channels of commerce; definitive removal from the channels of commerce; destruction*

- *See IPRED, Art. 15 : Publication of judgments*

3.3. Civil procedure on the merits

- Right of information (Art. 47):
 - Ordering the infringer to inform the right holder of the identity of third persons involved in the production/distribution of infringing goods + channels of distribution ...
 - ... if not out of proportion to the seriousness of the infringement.
 - *See IPRED, Art. 8: More detailed and broader (covering third parties)*

- Indemnification of the Defendant (Art. 48):
 - Adequate compensation in case of abuse (Art. 48.1) ;
 - Exemption from liability of public authorities and officials if remedial measures were taken or intended in good faith (Art. 48.2).

3.4. Criminal Procedures (Art. 61)

- Criminal procedures and penalties mandatory **at least** in cases of **wilful TM counterfeiting or copyright piracy** on a **commercial scale**.

- Remedies should include:
 - Imprisonment and/or monetary fines
 - sufficient to provide a deterrent;
 - consistently with the level of penalties for crimes of a corresponding gravity.
 - In appropriate cases, seizure, forfeiture and destruction of the infringing goods / any materials and implements used for the commission of the offence.

4. Conclusion: And now?

- TRIPS agreement, Part III : a framework.
- “TRIPS Plus”? Tackling on-line infringements?

Thank you for your attention!



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