



The International Enforcement of Intellectual Property

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**TEAM OF SPECIALISTS ON INTELLECTUAL PROPERTY
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Structure of Presentation

- **IPR enforcement under TRIPS**
 - Civil enforcement
 - Criminal enforcement
 - Border control

- **TRIPS enforced via specialized IP Courts**

- **IPR enforcement in Europe**
 - EC Enforcement Directive 2004
 - Proposed IP Crime Directive 2005

- **International Enforcement Agencies**

- **National Best Practice: e.g. U.K. Integrated IP Enforcement Strategy**

TRIPS: International Minimum Standards of Enforcement

- **Articles 41- 50: require WTO members to make available civil enforcement procedures and remedies.**
- **Articles 51 – 60 oblige WTO Members to introduce border control procedures to enable the application of Customs procedures to forbid the importation of counterfeit trade mark and pirate copyright goods.**
- **Article 61 provides that Members shall provide for criminal procedures and penalties ‘to be applied at least in cases of wilful trademark counterfeiting or copyright piracy on a commercial scale’.**

EC Implementation of TRIPS Enforcement: **Enforcement Directive 2004**

- **The objectives of Directive 2004/48/EC on the enforcement of intellectual property rights of 2004 are to deal with:**
 - **Disparities among member states in their laws for enforcing intellectual property rights, including measures and procedures for conducting searches, making seizures, determining proof of counterfeiting and piracy.**
 - **Differences among member states regarding minimum thresholds for sanctions and criminal proceedings.**
 - **Lack of administrative and operational co-operation between agencies concerned in enforcement action against counterfeiting and piracy.**

Enforcement Directive 2004

The Enforcement Directive (2004/48/EC) includes:

- **General provisions (Articles 3-6) - provision of proportionate measures and procedures to enforce IPRs so that infringements are punishable by penalties.**
- **Evidence (Articles 7-8) - measures to enable judicial authorities to order the communication or seizure of bank, financial or commercial documents together with supporting evidence protection measures.**
- **Right of information (Articles 9) - provisions of a right of information regarding the origin of goods or services that are thought to infringe a trade mark.**
- **Provisional and precautionary measures (Articles 10-11) - make available provisional measures, such as injunctions, to prevent the infringement of IPR based on reasonable evidence from the applicant. These to include, in appropriate cases, injunctions to freeze the assets of the alleged infringing party.**

Enforcement Directive 2004

- **Criminal law provisions (Article 20) - serious infringements of IPR should be treated at criminal offences and appropriate criminal sanctions including imprisonment should be provided.**
- **Administrative cooperation (Articles 23-24) - three years after its implementation, there shall be an assessment of the effectiveness of the Directive and national correspondents shall be designated to encourage co-operation and communication.**

Proposed IP Crime Directive

- **Proposed Council Directive on criminal measures aimed at strengthening measures against counterfeiting and piracy throughout the EU: 12/07/2005 (COM(2005)276 final)**
- **It implements TRIPS Article 61 to provide criminal procedures & criminal penalties.**
- **Penalties would range from €100,000 (\$122,000) to €300,000**
- **Serious infringements involving criminal organizations could lead to *at least* 4 years in prison.**

Enforcement Directive Criminal Measures of **12/07/2005**

- **Article 3 – *Extended powers of confiscation:***
 - provides for the full or partial confiscation of goods belonging to persons convicted in accordance with Council Framework Decision 2005/212/JHA of 24 February 2005 on Confiscation of Crime-Related Proceeds, Instrumentalities and Property.
- **More *coordination and cooperation among authorities:***
 - Article 4 - Joint investigation teams: IPOs; police; customs.
 - Article 5 - Jurisdiction and coordination of proceedings.

European Regulation: Customs & Counterfeiting

- **The regulation on Customs and Counterfeiting of 22 July 2003:**
 - **Extends the scope of the Regulation to cover more IPRs such as plant varieties and quality foodstuffs bearing geographical indications (e.g. Parma Ham).**
 - **Improves the information provided by the owner to customs.**
 - **Standardizes the form of requests for customs' intervention**
 - **Rightholders are able to make requests online.**
 - **See COUNCIL REGULATION (EC) No 1383/2003 of July 2003 concerning customs action against goods suspected of infringing certain intellectual property rights**

EC initiative to improve international enforcement via TRIPS

- **In June 2005 the EC requested the TRIPS Council to examine compliance of Members with the enforcement provisions of the TRIPS Agreement, pursuant to Article 68 of the TRIPS Agreement" (IP/C/W/448).**
- **Such examination would include:**
 - **Assessing the implementation of TRIPS provisions on enforcement in detail**
 - **Setting benchmarks to evaluate the progress made by governments towards a higher level of intellectual property enforcement**
 - **Suggesting best practices to ensure a full implementation of TRIPS obligations.**



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INTERNATIONAL BAR ASSOCIATION
INTELLECTUAL PROPERTY AND
ENTERTAINMENT COMMITTEE

International Survey of Specialised Intellectual Property
Courts and Tribunals

London, February 2005

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Specialised IP courts & tribunals

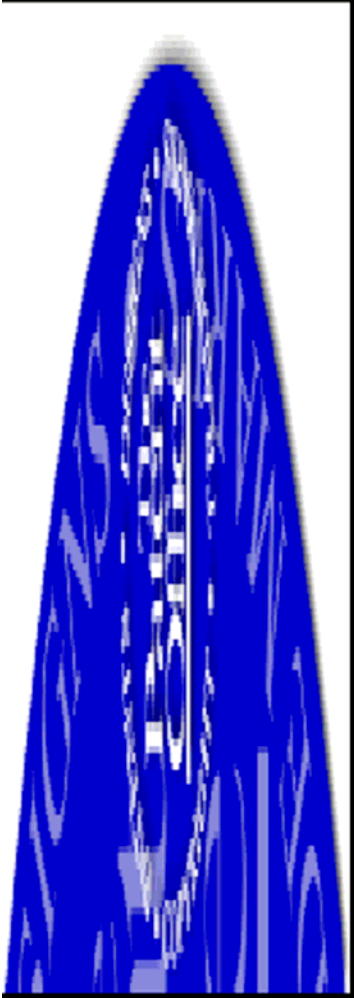
- The International Bar Association (IBA) published a Report that surveys specialised IP courts and tribunals in developing, transitioning, and small economies in 85 jurisdictions: <http://www.ibanet.org/iba/article.cfm?article=44>
- The Report examines the role of specialised IP courts in improving the quality of IP rights litigation and ensuring adequate enforcement of IP rights.
- It concludes that:
‘Judges’ expertise in IP cases can reduce hearing times and cost for litigants, increase efficiency, improve precision and predictability of adjudication.’

International Agencies Concerned With IP Enforcement

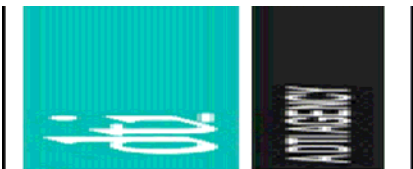


- Interpol IP Crime Action Group (IIPCAG). Membership includes: police and customs representatives from Interpol member countries, international organizations and cross-industry bodies.
- World Customs Organization: aims to combat IP crime at the border. It facilitates the exchange of information between industry and Customs administrations, and provides technical assistance.
- World Intellectual Property Organization: its website contains links to publicly and freely accessible online databases that contain court/administrative decisions in IP cases: <http://www.wipo.int/enforcement/en/>

National Best Practice in the UK



- Characterized by *coordination and cooperation among authorities*:
 - The Patent Office is a Key Member
 - The Organised Crime Task Force
 - Interpol (IP Crime Action Group)
 - Information Sources (IpCass database)
 - Chair of UN Economic Commission for intellectual property protection
 - Regional Trading Standards Groups.



A National Strategy

Work with Stakeholders began in January 2004

Government Agencies

- Patent Office
- H M Customs and Excise
- The Department of Culture
- Media and Sport
- DTI Solicitors
- DTI Europe and World Trade
- The Home Office
- Northern Ireland Office
- Department of Work and Pensions
- Immigration Service (Work Permits UK)

Enforcement Bodies

- The Assets Recovery Agency
- The National Criminal Intelligence Service
- National Crime Squad
- The Police Service of Northern Ireland
- Trading Standards
- Scottish Crime Squad
- The Metropolitan Police – Fraud Team
- Organised Crime Task Force

FAKE NATION?



A study into an everyday crime

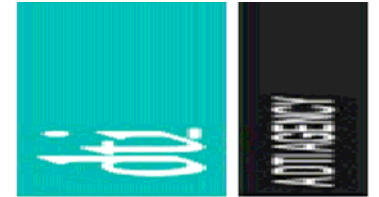
- **The Alliance Against Counterfeiting & Piracy, 'Fake Nation' at <http://www.allianceagainstiptheft.co.uk/Fake-Nation.pdf>**
- **The Anti-Counterfeiting Group**
- **The British Phonographic Industry**
- **The Entertainment, Leisure and**
- **Software Publishers Association**

Industry & Professional Groups

- **The Federation Against Copyright Theft**
- **International Federation of Phonographic Industries**
- **Lovells Solicitors**
- **The Local Authorities Coordinators of Regulatory Services**
- **The Mechanical Copyright Protection Society**
- **Anti Counterfeiting in Designs (ACID)**
- **Association des Industries de Marque (AIM)**
- **The Business Software Alliance**
- **The Motion Picture Association**
- **The Richemont Group**
- **REACT UK**
- **The Trading Standards Institute**



National intelligence Model



- **Provides a structure based on a multi-agency IP CRIME GROUP to develop plans and implement action**
- **Law enforcement & industry bodies agreeing to contribute a Co-ordination Group to target resources**
 - **Greater intelligence sharing**
 - **Change public perception**

Provides a Central Intelligence Point to: •receives, analyse, link intelligence and disseminates to

- **Trading Standards, Police, National Crime Squad, Customs, NCIS, Interpol and industry anti-piracy bodies.**

FAQs: ENFORCEMENT!

- **Who brings criminal charges?**
- **Does the plaintiff have to choose between civil & criminal?**
- **Who bears the burden of proof in a criminal proceedings?**
- **What is the standard of proof in criminal and civil proceedings?**
- **Can civil and penal liability be engaged for the same acts of counterfeiting?**
- **Does the penal court which rules on the penal liability for an act of counterfeiting have the capacity to rule on the question of the validity of the trade mark or is this only the concern of a civil jurisdiction?**
- **Are the terms of the limitation of these acts identical from the point of view of the civil liability and the point of view of the penal liability?**

THANK YOU!