

INTELLECTUAL PROPERTY ENFORCEMENT

FOR GENERALIST LAWYERS IN THE EU



Intellectual property (IP) is a category of “property” that **protects the creations of the human intellect**. It can belong to an individual or a company. There is no all-in-one IP protection measure that protects everything everywhere; **each IP right or other IP protection measure serves a specific purpose in a specific country or regional area**. The same object may be protected simultaneously by different measures.

> **Why is IP enforcement important for my client?** How can I best protect my client? What will their company get out of effective IP enforcement?

Protection

Exclusive right over a creation of the human intellect and the ability to act against infringers.

Market identity

IP strengthens the company's reputation, market position, and customer loyalty.

Financial attractiveness

A business with well-protected IP assets will attract investors more easily.

Monetising

Companies can sell, license and franchise their IP to obtain revenue.

IP INFRINGEMENT, COUNTERFEITING AND PIRACY

IP OWNERS CAN:

- **use, exploit, distribute, and/or reproduce** their rights;
- **sell, license and franchise their IP to others** to use them under *agreed conditions*;
- **take actions to prevent** others from using their IP without authorisation.

Use of IP without the authorisation of the rights holder may constitute an IP infringement. In general, **IP infringement** breaches civil IP law. If the infringing conduct is serious enough, it may also breach administrative or criminal laws. The “ultima ratio” principle should apply.

Counterfeiting and **piracy** are forms of infringement, where the infringer tries to steal the success of the rightful owner and unduly benefit from their investment.

The impact of counterfeiting and piracy goes well beyond the violation of IP rights or other IP protection measures. It undermines the development of businesses and competition in all economic sectors and encourages illicit activities, such as breaches of labour laws or product manufacturing standards, which directly threaten the health and safety of consumers as well as the environment.

What does your client need to protect?	How can they protect it?	Validity	Geographical scope	Registration
Name or logo (e.g. a new brand).	Trade mark Protects the commercial origin of goods and/or services.	Indefinitely, if renewed every 10 years.	In the country or regional area where registered.	Intellectual Property Office (e.g. national IP office or EUIPO)
Invention (e.g. a new machine or a manufacturing technique).	Patent Protects products or processes that offer a new technical solution.	Generally 20 years if renewed annually.	In the country or regional area where registered.	Intellectual Property Office (e.g. national IP office or EPO)
Appearance of a product (e.g. a new shirt or a tea set).	Design Protects the appearance of a product or a part of it.	25 years if renewed every 5 years.	In the country or regional area where registered.	Intellectual Property Office (e.g. national IP office or EUIPO)
Confidential information (e.g. know-how, a recipe or a client list).	Trade secret Protects confidential business information.	Indefinitely, as long as it remains secret.	Territorial limits do not apply.	No registration process. Non-disclosure agreement can be signed.
Product from a specific geographical area (e.g. a cheese, wine).	Geographical indication Protects products, whose qualities are linked to the area of production.	Indefinitely (subject to different legislations).	Territory defined by international conventions.	Competent national authority or the European Commission.
Creative work (e.g. a new song, movie or photograph).	Copyright Protects original expressions of creative activity, (e.g. artistic, literary, and scientific works).	Author's life +70 years.	In the EU + non-EU countries with signed agreement.	Formalities not required. *Voluntary registration systems in some MS.
A website's Internet Protocol (IP) Address (e.g. yourtrademark.eu)	Domain name Identifies a particular webpage.	Indefinitely, as long as there is a valid contract with a registrar.	Worldwide (internet)	An accredited registrar *Depending on the top-level domain needed.
Technical invention (e.g. the shape of a handle).	Utility model Protects inventions with less stringent requirements than patents.	Generally 10 years if renewed annually.	In the country or regional area where registered.	Intellectual Property Office *If available in the relevant MS.
New plant variety (e.g. a new species of flower, fruit tree or vegetable).	Plant variety Protects new or improved varieties of plants.	25 years (or 30 for specific varieties), if renewed annually.	In the country or regional area where registered.	National authority or CPVO

/Scenario 1

Your client has evidence or a suspicion that someone has infringed their IP.

Example: your client is aware that products identical to theirs are sold on the internet without authorisation, or they suspect that an employee has revealed confidential information to a competitor.

/Scenario 2

Your client believes a third party intends to register or has registered an IPR conflicting with their IP.

Example: someone intends to use or register a trade mark or a design that is very similar to your client's.

/Scenario 3

Your client considers that there is a high risk that their IP will be infringed.

Example: your client plans to sell their new clothing collection on online marketplaces or social media, or has developed an innovative technology, or will unveil new products at a fair.

— **Six main questions to pose to your client:**

- What are the infringing actions (or attempts) and how did you find out about them?
- Is the infringement (or attempt) taking place online or offline?
- Do you have proof that can be used in legal proceedings (e.g. material proof), or an affidavit from a recognised person (e.g. a bailiff)?
- Do you own or license any registered IPRs?
- Do you use or have trade secrets and domain names?
- Have you taken any steps to enforce your rights and/or stop the infringers?

Possible next steps for your client as a CLAIMANT**1 Advise your client to take action against the infringer (or in some cases third parties) and to consider hiring a lawyer specialised in IP who could assist with:**

- sending a cease and desist letter or starting notice and takedown actions;
- negotiating a settlement using, inter alia, mediation and arbitration;
- initiating administrative proceedings before IP Offices (oppositions, cancellations, etc);
- assessing the situation from an international perspective.

Advise your client to consider using monitoring services to detect online infringements.

2 If the above steps do not prove sufficient, advise your client to consult a lawyer specialised in IP about starting civil proceedings.**3 If counterfeiting and piracy activities are involved, advise your client to consult a lawyer specialised in IP about starting civil, criminal and/or administrative proceedings.** This could be done through the relevant law enforcement authorities (customs/police). Your client could request customs to take action with respect to goods suspected of infringing their IPRs, by filing an Application for Action (AFA) through IPEP (the IP Enforcement Portal), the free, multilingual and secure EU platform that deals with IPR enforcement matters.**TIPS TO ADVISE CLIENTS DEALING WITH NEW TECHNOLOGIES**

Social media: Your client's social media content is IP and as such it needs to be protected, but it should also not infringe the IP of others. Your client should be aware of the usefulness of IP monitoring services to detect IP infringement online and subsequently initiate notice and takedown actions.

E-commerce platforms: When infringement is detected your client should first get the listings removed by using the systems that the e-commerce platforms have in place, such as notification systems and IP protection programmes.

Mobile apps: Your client might create apps, or might hire creators to develop apps for them. Apps are complex multimedia products combining different types of IP (trade marks, copyright, patents, designs) that should be protected (e.g. with an NDA with the software developer) and maintained.

Generative AI: Publishing content generated by auto-generative chat programmes, such as ChatGPT, may infringe the copyright of others if based closely on existing works and will not be considered protected as your client's copyright.

/Scenario 1

Your client was accused of infringing the IP of another person or company.

Example: your client received a letter from a lawyer or a court stating that they are in conflict with another company's trade mark, patent, copyright, etc.

/Scenario 2

A person or a company filed an opposition, cancellation, or similar administrative procedure against your client's IPR application.

Example: your client received an opposition against their trade mark application from a company claiming to own a similar earlier sign.

/Scenario 3

Your client considers that there is a risk of infringing the IP of another person or company.

Example: your client was inspired by products already on the market or wants to use publicly available content in their marketing on social media.

— **Six main questions to pose to your client:**

- In your opinion are the allegations received reasonable? Were proper grounds stated?
- Are the IPRs you are potentially infringing actually protected? How are these rights used in the market?
- Do you own or licence IP on the subject matter, and do you openly claim and use them for your business? Since when?
- What actions have you taken until now to avoid infringing others, including the IP in question?
- Do you use or have trade secrets and domain names covering the subject matter?
- Are the IPRs or other measures (e.g. trade secrets or domain names) older than the IP of the applicant?

Possible next steps for your client as a DEFENDANT**1 Advise your client to immediately stop the allegedly infringing activities and analyse the situation.****2 Advise your client to consider hiring a lawyer specialised in IP who could assist with:**

- responding to cease and desist letters or other infringement allegations by third parties;
- negotiating a settlement using, inter alia, mediation and arbitration;
- administrative proceedings before IP Offices (oppositions, cancellations, etc);
- civil, administrative or criminal law proceedings (before courts, customs or police).

Advise your client to make searches in IP databases to avoid infringing the rights of others.

USEFUL LINKS

- **European Union Intellectual Property Office (EUIPO)**
euiipo.europa.eu
- **Council of Bars and Law Societies of Europe (CCBE)**
ccbe.eu
- **Intellectual Property Enforcement Portal (IPEP)**
euiipo.europa.eu/en/enforce-ip/ip-enforcement-portal
- **EUIPO's Anti-Counterfeiting Technology Guide**
op.europa.eu/s/yTF4
- **FAQs on Copyright**
euiipo.europa.eu/en/observatory/awareness/faqs-on-copyright
- **EUIPO Mediation Centre**
euiipo.europa.eu/en/manage-ip/mediation-centre
- **Application for Action (AFA)**
euiipo.europa.eu/en/the-office/help-centre/websites/faq-application-for-action-eafa
- **European Patent Office (EPO)**
epo.org
- **World Intellectual Property Organization (WIPO)**
wipo.int
- **European Registry for Internet Domains (EURid)**
eurid.eu
- **Community Plant Variety Office (CPVO)**
cpvo.europa.eu
- **Your national or regional IP office**
tmdn.org/#/members