

IPR ENFORCEMENT

Training of Trainers Program on Intellectual Property Asset Management
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IPR Enforcement

■ What is IPR?

- Copyright
- Trademark, Geographical Indications
- Patents, Utilities Models & Design
- Domain Names, Trade Names
- Plant varieties
- Trade Secrets, Unfair Competition etc

■ What is enforcement?

...compelling observance of Your IPR

IPR Enforcement

- **Monitor** the use of your IPR
- **Defend** the unauthorized use of your IPR
- Run **Educational & Public Awareness** Campaigns





Monitoring IPR use. Defend IPR

Internally:

- IPR management system:
 - identify applicable IPR
 - register/ conserve IPR, as applicable
- IPR policy & the employees



Monitoring IPR use. Defend IPR

Externally:

WHAT: the *unauthorized* use of IPR

WHOM: the licensees & third parties

WHERE: online medium & offline

WHY:

- to prevent/stop IPR infringement
- to prevent others from acquiring rights that might harm/dilute your IPR

HOW: ...

Monitoring IPR use. Defend IPR

- To prevent the acquiring of rights that might affect your IPR
 - OSIM, OHIM, WIPO online databases

- To detect and follow up with the unauthorized use of your IPR
 - Check domain names & trade name registries
 - Search engines, websites, forums, key-words (including sponsored keyword advertising) etc.
 - File customs application for action





Monitoring IPR use. Defend IPR

- To prevent the acquiring of rights that might affect your IPR
(exempli gratia)
 - OSIM database:
 - <http://www.osim.ro/publicatii/marci/bopi11m.htm>
 - <http://bd.osim.ro/marci/index.jsp>
 - OHIM database:
 - <http://www.oami.europa.eu/ows/rw/pages/QPLUS/databases/searchCTM.en.do>
 - WIPO database:
 - <http://www.wipo.int/romarin>

Monitoring IPR use. Defend IPR

- To detect and follow up with unauthorized use of your IPR
 - Check domain names & trade name registries
 - <http://www.rotld.ro/>
 - <http://www.eurid.eu/en/content/whois-result>
 - <http://www.whois.net/>
 - Lodging application for customs action
 - Customs retain goods likely to infringe IPR or suspend customs procedure related to such goods
 - Obligation on right holder to further pursue civil or criminal action in relation to such alleged infringement
(Law no 344 of 2005 amended)





Monitoring IPR use. Defend IPR

POTENTIAL CONFLICT FOUND => **what next?**

=> **PRESERVING** relevant **EVIDENCE**

- minimum available evidence should be preserved by the right holder

=> **EVALUATE** available **EVIDENCE** to decide the step forward

- Cease & Desist letter to the infringer
- Notification to the relevant Internet Service Provider
- Provisional measures to preserve evidence related to the alleged infringement
- Request for interlocutory injunction
- Civil action
- Criminal action



Monitor IPR use. Defending IPR

Notification to the relevant Internet Service Provider:

- ISPs are not liable for the information sent, stored or to which they facilitate the access (under the conditions under Law 365 of 2002 updated)
- ISPs are liable for the information transmitted (hosting + web-linking) if they are aware of the illegal character* of the information/activity and they do not act promptly to eliminate or to block the access to such information

* Illegal character found by decision of a public authority



Monitor IPR use. Defending IPR

Action for provisional measures to preserve evidence:

- There is risk of evidence being destroyed or difficult to be administered in the future
- IPRs infringed or likely to be infringed
- Lodgment of adequate security, in specific cases

Legal provisions:

- Common civil procedural rules (Art. 235 and following)
- Law no 8 of 1998 on copyright and neighboring rights (Art. 139, para 6 and following)
- Emergency Ordinance no 100 of 2005 (Art. 5 and following)



Monitor IPR use. Defending IPR

Request for Interlocutory Injunction:

- To prevent imminent IPR infringement or to provisionally forbid the continuation of alleged infringement or to make such continuation subject to lodging guarantee intended to secure compensation of right holder
- May be ordered by the court also against intermediaries whose services are used by third parties to infringe IPR
- The court may order:
 - Seizure of goods suspected to infringe IPR (to prevent them entering on the market/ their circulation)
 - Precautionary seizure of movable/immovable property/ blocking of bank accounts/ communication of bank, financial or commercial information (in case of alleged infringement on commercial scale)

Legal provisions:

- Common civil procedural rules (Art. 581 and the following)
- Law no 8 of 1998 on copyright and neighboring rights (Art. 139, para 3 and the following)
- Emergency Ordinance no 100 of 2005 (Art. 9 and the following)



Monitor IPR use. Defending IPR

Civil vs. Criminal enforcement

Civil action:

- potential for faster and more efficient enforcement

Criminal action:

- preferable when IPR infringement is concurrent with other serious offences (etc. tax fraud, pornography, organized crime)
- the infringer is more likely to settle to avoid criminal record; most cases dismissed after infringer paid claimed damages
- deterrent sentences under law (however not always applied by courts)
- but IPR cases likely to be closed by the public prosecutor for lack of social harm unless substantive damages are proven by right holders or concurrence with other serious offences is in place



Monitor IPR use. Defending IPR

Brief focus on:

- means of calculating damages
 - Law no 8 of 1996 amended (copyright)
 - Emergency Ordinance no 100 of 2005 amended (industrial rights)
- means of evidence:
 - Romanian Copyright Office technical report
- courts competent to hear IPR infringements cases (venue)
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Questions?

Thank You!

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