



European IPR Helpdesk

Fact Sheet

IP enforcement: asserting your rights

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Introduction

Intellectual property (IP) can be protected by, among others, IP rights or titles, such as trade marks or patents. Such titles are usually thought to confer negative rights, which means, the right to exclude others from using or commercialising, for example, an invention protected under a patent.

This process of not allowing others to use or commercialise protected IP is known as enforcement of rights, which can be done through civil, administrative and penal measures aimed at preventing the unauthorised use of intellectual property, sanctioning such use and providing remedies to right holders for the damage caused by such unauthorised use.

The unauthorised use of IP rights, that is, infringement acts, creates important losses to the industry. Therefore, enforcement measures are essential to ensure that right holders derive their fair benefit from their intellectual efforts and investments.

It is essential for companies and IP owners in general to be well-acquainted with the array of IP enforcement actions at their disposal in order to draw up an IP enforcement plan ready to provide solutions and alternatives if an infringement happens.

This Fact Sheet illustrates the importance of IP enforcement for businesses and research organisations while providing an overview of the main enforcement actions, together with the latest developments and initiatives of the European Commission in the field.



The development of IP enforcement strategies and undertaking the relevant IP enforcement actions require a high level of legal expertise. Therefore, it is strongly advised to seek professional assistance when planning and carrying out these actions in order to achieve efficient results in accordance with applicable laws¹.

1. Understanding IP enforcement

The term IP enforcement refers to **all the existing mechanisms available to IP owners to avoid and restore the effects of infringing acts** by compelling others to act in accordance with their proprietary rights.

The protection of intellectual property rests on the conception that the IP owner has a legitimate right to the profits derived from the exploitation of such IP. Without effective IP enforcement, the system for protection of intellectual property

¹ For further information on how to find an IP professional, consult the European IPR Helpdesk Guide on "[10 steps to find a suitable IP professional](#)"

would be incomplete, as right holders would not have any mechanisms to prevent infringements and to recover the losses incurred from any actual infringement.

IP enforcement concerns the right holders. This means that it is primarily for them to take any necessary actions to avoid and fight the infringement of their IP rights, by means of IP enforcement mechanisms.





IP owners must act as their own police force and monitor the marketplace and initiate any necessary actions to assert their exclusive rights. They should not expect anyone else, such as IP offices, to take these actions on their behalf, and these actions remain a private issue, that is, generally between two private parties.

1.1. Rights conferred by different types of intellectual property

In order to enforce IP rights, holders should be aware of the intangibles which they own², treat them as their business assets and take the necessary steps to safeguard and manage their rights. Having IP as an underlying business asset will make right holders less susceptible to IP abuses.



The table below summarises the rights associated with some of the most relevant IP rights for businesses:

	Rights conferred
Trade marks³ 	<ul style="list-style-type: none"> A trade mark is an exclusive right over the use of a sign in relation to the goods and services for which it is registered. This exclusive right generally allows its owner to prevent others from using the same or similar signs for identical or related goods and/or services as those protected by the trade mark in the course of trade, without the owner's prior permission. Trade marks are territorial rights, which means that they only produce effects in the territory where they are registered.
Patents⁴ 	<ul style="list-style-type: none"> A patent is an exclusive right granted for the protection of an invention (a product or a process). The patent holder generally enjoys the exclusive right to prevent third parties from commercially exploiting their invention, that is, manufacturing, selling or using it. This does not automatically include the right to exploit the patented invention, which may be subject to restrictions for reasons such as security or public health. Patents are territorial rights, which means that they only produce effects in the territory where they are registered.

² For further information on how to identify IP assets, consult the European IPR Helpdesk Fact Sheets "[IP due diligence: assessing value and risks of intangibles](#)" and "[IP audit: uncovering the potential of your business](#)".

³ For further information on trade marks, consult the European IPR Helpdesk IPR Charts on "[EU trade mark](#)" and "[International trade mark \(Madrid System\)](#)".

⁴ For further information on patents, consult the European IPR Helpdesk IPR Charts on "[European patent](#)" and "[International patent application](#)".

<p>Industrial designs⁵</p> 	<ul style="list-style-type: none"> An industrial design is an exclusive right granted for the protection of the outward appearance of the whole or part of a product resulting from the features and/or ornamentation of the product. The holder of a registered design generally has the exclusive right to use it and to prevent third parties from using it commercially without the owner's prior consent. <p>In the EU a special regime for unregistered designs confers their owners protection only against deliberate copying, that is, the right to prevent third parties from making a commercial use of their design if it has been copied but not if the third parties have created a similar or identical design independently. Industrial designs are territorial rights, which means that they only produce effects in the territory where they are registered.</p>
<p>Copyright⁶</p> 	<ul style="list-style-type: none"> Copyright is the term used to describe the rights that creators have over their literary, scientific and artistic works. The rights arising under copyright can be classified into two categories: economic rights and moral rights. Economic rights generally confer copyright holders the right to authorise or prohibit the making and distribution of copies as well as communication to the public. Moral rights generally confer authors a right to claim authorship, as well as a right to object to a distortion or mutilation of their work, which would negatively affect their honour or reputation. Copyrights are territorial rights, which means that they only produce effects in the territory where they are registered.

1.2. IP enforcement rules

As a general rule, IP rights are subject to national regulations, particularly insofar as their enforcement is concerned. However, there are certain supranational rules, particularly at European Union (EU) level, where a lot of effort is being put into harmonising national IP laws.

1.2.1. International rules

On the international level, the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement⁷) sets out general principles, which provide for necessary remedies while also ensuring there are no obstacles to legitimate trade and providing safeguards against misuse of enforcement measures. Such general set of principles include those of fairness, transparency, due process and balance, and apply to all civil and administrative enforcement procedures for IP rights covered by the TRIPS Agreement.

TRIPS aims at allowing right holders to take effective actions against infringement of their IP rights and obtain remedies. In particular, judicial authorities must be able to award three types of remedies:

- injunctions to order a party to stop its infringing action,
- damages to compensate for the injury caused by the infringement,
- as well as other remedies, such as the removal of infringing goods from channels of commerce or their destruction, subject to certain conditions.

⁵ For further information on designs, consult the European IPR Helpdesk IPR Charts on "[Community design](#)" and "[International Design \(Hague System\)](#)".

⁶ For further information on copyright, consult the European IPR Helpdesk Fact Sheet on "[Copyright essentials](#)".

⁷ [Agreement on Trade-Related Aspects of Intellectual Property Rights](#).

Also at international level, the Paris Convention for the Protection of Industrial Property⁸, the Berne Convention for the Protection of Literary and Artistic Works⁹, and the Rome Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organisations¹⁰ contain some general provisions on IP enforcement, mainly aiming at ensuring that the legislations of the contracting parties provide for enforcement procedures so as to permit effective actions and remedies against acts of infringement of IP rights.

1.2.2. European Union rules

At EU level, the Directive on the enforcement of intellectual property rights ("**Enforcement Directive**" or "IPRED")¹¹ requires all Member States to apply effective, dissuasive, and proportionate remedies and penalties against those engaged in counterfeiting and piracy, and aims to create a level playing field for right holders in the EU. This means that **all EU countries have a minimum similar set of measures** available for right holders to defend their IP rights before civil courts – the Enforcement Directive is only concerned with civil enforcement.



The **Enforcement Directive**, adopted in 2004, is the result of the efforts of the European Commission to harmonise enforcement laws at EU level and to minimise disparities between Member States, which would be prejudicial to the proper functioning of the Internal Market and competition. Such disparities included the arrangements for applying provisional measures, which are used in particular to preserve evidence, the calculation of damages, or the arrangements for applying injunctions.

However, the Directive is not implemented and applied in a uniform manner in all Member States and there are differences regarding, for example, injunctions, damages and legal costs.

As a result, the European Commission has released some **guidance¹² on certain aspects of the Directive** to clarify certain points of the Directive, allowing for a more consistent and effective interpretation and application, and paying particular attention to the means, which are especially important to SMEs (e.g. rules on calculating damages and awarding legal costs).

This Directive should not affect Member States' international obligations, including those derived from the international texts above referred.

⁸ [Paris Convention for the Protection of Industrial Property.](#)

⁹ [Berne Convention for the Protection of Literary and Artistic Works.](#)

¹⁰ [Rome Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations.](#)

¹¹ [Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights.](#)

¹² [Guidance on certain aspects of Directive 2004/48/EC of the European Parliament and of the Council on the enforcement of intellectual property rights.](#)

In addition to the Enforcement Directive, the EU legislature has provided for other specific enforcement provisions in the domain of copyright and related rights¹³.

The provisions contained in the Enforcement Directive are applicable without prejudice to other EU or national laws, to any infringement of intellectual property rights as provided for by EU laws and/or the national law of the Member States concerned. This means that IP holders, who decide to apply an enforcement measure contained in the Directive, can do so in addition to other enforcement measures contained in other EU laws and/or in national laws, and that such measure will be applied against infringements of IP rights as defined in EU and/or national laws.

2. IP infringement

2.1. Acts of infringement

As explained above, enforcement measures are taken against acts of infringement, which can be divided into **piracy** and **counterfeiting**.

Piracy is usually associated with the act of engaging in the unauthorised **reproduction – that is, making copies - of copyrighted works** such as films, books, music, etc. For example, making a recording of a film at the cinema and distributing it, or making a recording of a copyrighted song and selling it to others without the copyright owner's authorisation, constitute acts of piracy and are, therefore, illegal.

On the other hand, **counterfeiting means making fake goods**. In other words, a counterfeit product is an unauthorised replica – also known as a knock-off - of an original product, which bears a trade mark which is essentially identical to the one of the original product. They can range from replicas of designer bags and telephones, to even pharmaceutical products.

Thus, as explained, piracy and counterfeiting can be differentiated within the broad category of IP-infringing acts, the main difference being that **counterfeiting, contrary to piracy, involves the application of trade marks to the fake copies to complete the deception**.

¹³ Such provisions are contained notably in [Council Directive 91/250/EEC of 14 May 1991 on the legal protection of computer programs](#) or in [Directive 2001/29/EC of the European Parliament and of the Council of 22 May 2001 on the harmonisation of certain aspects of copyright and related rights in the information society](#).

Examples of infringement acts

- Manufacturing of a patented technology without prior authorisation from its owner;
- Marketing of goods bearing a third party's trade mark without the consent of the trade mark owner (counterfeit product);
- Distribution of a music album CD without the copyright owner's consent (pirated good).

2.2. Impact of infringing acts

Counterfeiting and piracy create a direct economic harm to IP owners, who suffer a loss in revenues as a consequence of the fakes sold by infringers. Furthermore, IP infringement acts have a broader negative effect on economic growth and social welfare, causing job losses and undermining innovation.

Counterfeiting in the EU affects many sectors, from cosmetics and clothing to tyres and batteries. The results of a study published by the the Organisation for Economic Co-operation and Development (OECD) and the European Union Intellectual Property Office (EUIPO) show that **trade in counterfeit and pirated goods amounted to up to 2.5% of world trade in 2013**, which was even higher in the EU context where counterfeit and pirated goods amounted to up to 5% of imports¹⁴.

Furthermore, as mentioned above, IP infringing acts have an effect on employment. According to a study, published by the International Trademark Association (INTA), net job losses in 2013 were globally between 2 and 2.6 million, and projects net job losses of 4.2 to 5.4 million by 2022¹⁵.

It is worth mentioning that counterfeiting and piracy not only have negative consequences at the economic level, but also put the health and safety of consumers at risk, as many of these imports concern products subject to safety and health regulations, such as pharmaceuticals or household products.

2.3. How to avoid infringing the rights of others

Infringement acts are not always necessarily intentional. The use of a word or a symbol by a company to promote or advertise its goods and services or the use of a technology may very well be acts of IP infringement, without the infringers being even aware of it.

This is something that must and can be avoided. By conducting **prior searches** of the IP rights involved, one can learn about the trade marks, designs or patents

¹⁴ [Trade in Counterfeit and Pirated Goods, Mapping the economic impact, OECD and EUIPO \(2016\).](#)

¹⁵ [The economic impacts of counterfeiting and piracy, Frontier Economics \(2017\).](#)

that are already registered by a third party and that, therefore, cannot be used without their owners' prior authorisation.

These searches can be conducted on different **free-of-charge online databases**, such as TMView, for trade marks, or Espacenet, for patents¹⁶. While these databases are freely accessible, conducting a prior search requires knowledge not only about the functioning of the database, but most importantly about legal and technical matters – especially in the area of patents. Therefore, for a complete prior search, it is highly recommended to consult with the relevant professional.

Additionally, in relation to patents, performing a **freedom to operate (FTO)** analysis also helps to identify technologies that may preclude IP owners from exploiting their inventions without infringing the rights of another party. An FTO analysis should be carried out by professionals, as this study requires vast expertise in the related field of technology, together with a deep knowledge about the state of the art and about IP.

2.4. How to react if accused of infringement

As explained in the following section, usually the first step when there is an IP infringement consists of sending a communication to the alleged infringer asking them, among other things, to cease in the infringement.

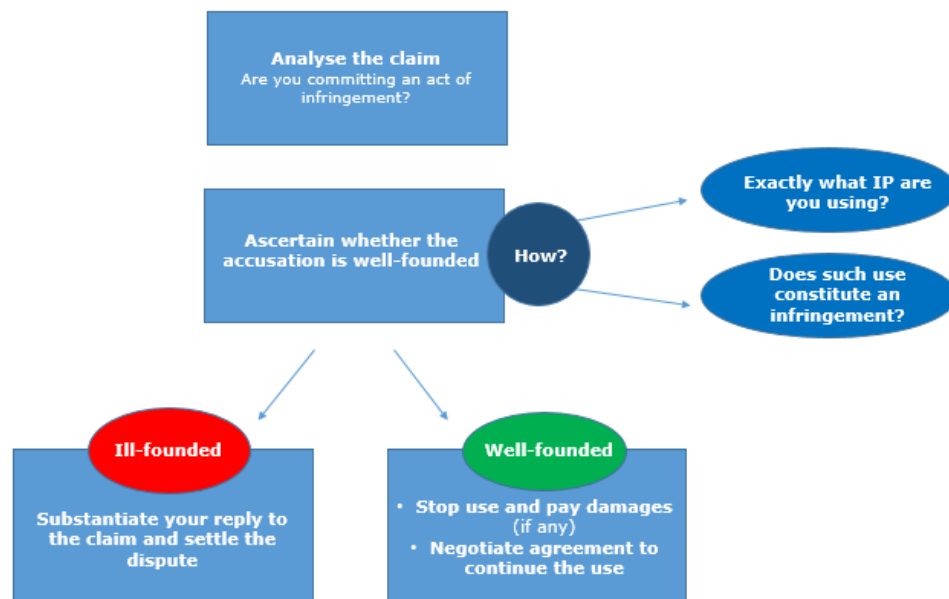
In the case of receiving such a communication, different actions are recommended:

- **Analyse the claim** and understand the object of the accusation – what exactly you have done or are still doing that constitutes an act of infringement. For example, it could be the use of someone else's trade mark to sell your products without the owner's permission.
- **Ascertain whether the accusation is well-founded.** Following the previous example, you need to:
 - (i) Determine whether you are using the trade mark as claimed in the owner's communication, or whether it is a different sign you are using.
 - (ii) Determine whether there is infringement: not every non-authorized use would be an infringement. For instance, you may be using the trade mark without the owner's consent in a way permitted by law (e.g. in connection with a product or a service for which the trade mark at issue is not registered or in a territory where such trade mark is not registered).
- **If the accusation is ill-founded**, you may want to explain this to the accuser and persuade them to withdraw their claim. Legal advice to prepare this communication may be crucial to achieve an early settlement.
- **If the accusation is well-founded**, you may:

¹⁶ For further information on prior searches, consult the European IPR Helpdesk Fact Sheets "[How to search for trade marks](#)", "[How to search for patent information](#)" and "[Design searching](#)".

- (i) **Stop** using the IP at issue, and pay any damages claimed by the owner, in order to settle the dispute.
- (ii) **Negotiate** with the owner to find a formula that allows you to continue using the IP such as, for example, entering into a licence agreement.

The above are just some possible scenarios for illustrative purposes and, therefore, the solutions may vary depending on the circumstances of the case. Thus, legal advice is highly recommended.



3. Enforcement actions

Enforcement actions are those taken by IP owners against the unauthorised use of their IP by infringing third parties. These actions, which must follow a strategic enforcement plan, aim at putting an end to concrete infringing acts as well as to repair the damage suffered. Furthermore, they may have a dissuasive effect as it shows certain proactivity by IP owners in protecting their proprietary rights which may discourage potential infringers.

There are different types of IP enforcement actions, which can mainly be classified into the following categories: **initial enforcement measures, online enforcement, civil enforcement, criminal enforcement and customs enforcement.**

While these actions are independent from each other, enforcement strategies often combine them, applying them in succession or, often, simultaneously.

3.1. Initial enforcement measures

Cease and desist letters, also known as warning letters, often prove themselves a very effective and yet simple measure against infringers. They are often used at

an initial stage, as a **preliminary measure** before it becomes necessary to adopt further actions.

Essentially, a cease and desist letter is a communication sent to the alleged infringer, asking them to put an end to a given infringing action. While this is quite a straightforward and apparently simple measure, not all cease and desist letters look the same. In this respect, particularly aggressive letters are not necessarily more effective. One must be very mindful of the language used, which should be adapted to the particular circumstances of the case.

Cease and desist letters have the advantage of providing for an **affordable, fast and amicable solution**. As a downside, they may produce no effects, and therefore taking additional measures may eventually be unavoidable. Still, they are always proven useful as evidence in subsequent proceedings that the IP owner tried to put an end to a given infringement and to reach an amicable solution on a given date.

3.2. Alternative dispute resolution

Alternative Dispute Resolution (ADR) mechanisms include several procedures, such as **mediation or arbitration**, that allow parties to resolve their disputes out of court in a private forum, with the assistance of a qualified neutral intermediary of their choice.

Typically, ADR procedures concerning IP rights are used whenever the dispute in question arises between the parties to a contract, where ADR is foreseen as the dispute resolution procedure. For example, a disagreement between the parties to a trade mark licence agreement regarding the royalties due by the licensee to the licensor. Nevertheless, **non-contractual infringement disputes may also be submitted to ADR procedures** if the parties agree to it.

ADR procedures have multiple advantages, including the dispute being submitted to a single forum, under a single law (which appears particularly interesting to avoid the expense and complexity of multi-jurisdictional litigation), their confidential character or the expertise of the mediators and arbitrators¹⁷.

3.3. Civil enforcement

Civil enforcement measures are usually taken once the inefficacy of cease and desist letters becomes apparent. Undertaking civil enforcement measures usually requires legal assistance as, depending on the applicable law and the type of case, self-representation is not allowed. In any event, these are complex and very technical issues, and therefore legal assistance is always recommended.

¹⁷ For further information on ADR procedures, consult the European IPR Helpdesk Fact Sheet on "[Alternative Dispute Resolution \(ADR\) mechanisms](#)".

Civil litigation offers multiple ways of action and often in several venues. The **choice of action and venue** must be taken at the earliest stage in a strategic way, aiming at achieving quick and efficient enforcement results.

Civil courts in the EU usually offer, based on their respective national laws, different actions which must be applied taking into account the circumstances of the case as well as the short- and long-term effects sought. These are the typical civil actions, which are taken in the following order:

- **Provisional measures** (e.g. interlocutory injunctions and seizures): to be taken at the earliest stage, and intended to avoid potential infringements and to preserve relevant evidence.
- **Damages recovery measures**: to be applied once the infringement has taken place, and intended to compensate for the damages suffered by the right holder, including lawyers' fees.
- **Post-trial enforcement proceedings**: to be initiated once litigation on IP infringement and damage recovery has come to an end, and intended to make effective the decision rendered by the court. In other words, this is usually an additional procedure before a court where, if a court has determined the infringement, the right holder essentially requests the court to order the infringer to pay the damages as determined in the court decision regarding the IP infringement.

Some aspects of civil enforcement are harmonised at EU level; however, the concrete aspects of civil litigation procedures, that is, those contained in procedural rules (e.g. rules regulating the process, timing, costs, etc.) are governed by national laws.

Apart from the aspects introduced by the Enforcement Directive, two main aspects of IP civil enforcement are harmonised at EU level: applicable law and venue.

- **Applicable law**
EU law has an impact on the applicable law to certain IP disputes, in particular to non-contractual obligations arising from an infringement of IP rights, for instance the obligations arising out of tort/delict, that one person or company – the infringer – has against the owner of the IP infringed. The EU Regulation on the law applicable to non-contractual obligations establishes, as a general rule, that **the law applicable to a non-contractual obligation arising from an infringement of an IP right shall be the law of the country for which protection is sought**. The Regulation furthermore sets up a specific rule for non-contractual obligations arising from an infringement of a **unitary EU IP right**, where the applicable law will be **the law of the country in which the act of infringement was committed**. These are two imperative rules that the parties cannot derogate from.
- **Applicable venue**

EU Regulation on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters has harmonised the rules on choice of venue at EU level. These rules cannot be avoided but they offer a certain level of flexibility, allowing enforcers to select the most appropriate venue, being usually in IP infringement cases:

- (i) the domicile of the alleged infringer;
- (ii) the place where the alleged infringing act took place, and;
- (iii) the place where the alleged infringing act produced its effects.

Several aspects are to be considered when making the decision on choice of venue, namely, the expertise of the relevant court on the matter at issue, the costs of litigation in such a venue or the average speed of the proceedings, including the subsequent post-trial enforcement proceedings – that is, how long it will take for the enforcer to be effectively compensated and close the case.

3.4. Criminal enforcement

Criminal sanctions related to IP infringement mainly concern **counterfeiting and piracy**, other types of IP infringement being only enforceable by means of civil sanctions.

Crime is a matter of public interest, therefore **criminal cases are prosecuted by a public prosecutor and investigated by the police**. This may have the positive effect of expediting the proceedings, thus allowing for effective enforcement in a relatively short term.

Criminal enforcement measures are said to have a more dissuasive effect, firstly because they often enjoy a significant degree of publicity, and secondly because the infringers not only face monetary sanctions, but sometimes prison sentences.

These proceedings constitute a particular challenge whenever the infringement has taken place in several countries. It is essential that prosecution authorities and police departments are well coordinated and informed about all the global elements of the case in order for local actions to work correctly and efficiently.

Unlike civil enforcement, **criminal enforcement procedures are not harmonised at EU level**, therefore, the available actions and procedures vary from one country to another according to the respective national provisions. Nevertheless, the EU provides for several mechanisms aiming to enhance police and judicial cooperation in criminal matters. These cooperation takes place, in particular, between national police forces, between national administrations (in particular, customs services), and between national judicial authorities – mainly through the mutual recognition of judgments and judicial decisions. EU agencies such as the European Union's Judicial Cooperation Unit (Eurojust), the European Union Agency for Law Enforcement Cooperation (Europol) and the European Judicial Network (EJN) make this cooperation possible.

3.5. Customs actions

Customs play an important role in identifying, and detaining at the border, shipments of goods suspected of infringing IP rights¹⁸. Statistics from the European Commission show a continuation in the high number of articles suspected of violating IP rights. In 2016, more than 41 million articles were detained, whose corresponding equivalent genuine products have an estimated value of just over 672 million Euro¹⁹.

Under EU laws²⁰, which have achieved a considerable degree of harmonisation in terms of customs actions thanks to the **EU Customs Union**²¹, customs have the power to detain goods at the border upon request of the right holder who believes such goods infringe their IP rights or *ex officio*, that is, by the customs' own initiative, where there is a suspicion of infringement. While the goods remain under customs control, the right holder is given the opportunity to initiate court proceedings in order to determine the infringement. Furthermore, EU laws provide for expedited proceedings, where the detained goods shall be destroyed automatically without the need to establish the infringement by means of court proceedings provided that the alleged infringer consents expressly or tacitly to such destruction.

Furthermore, in order to support the functioning and modernisation of the EU Customs Union, **the multiannual action programme Customs 2020** has been established. The programme sets a number of specific and operational objectives, as well as the means to achieve them. For instance, one of the specific objectives is to "support customs authorities in protecting the financial and economic interests of the Union and of the Member States, including the fight against fraud and the protection of intellectual property rights", and the particular means to achieve this are: "(a) computerisation; (b) ensuring modern and harmonised approaches to customs procedures and controls; (c) facilitating legitimate trade; (d) reducing compliance costs and administrative burden; and (e) enhancing the functioning of the customs authorities"²².

Customs actions under EU laws are only available to products protected under EU IP rights. This does not mean that national IP rights cannot benefit from border protection, which can be applied for under national customs actions, regulated by national laws.

¹⁸ [Customs enforcement of intellectual property rights – Frequently Asked Questions \(MEMO/11/327\), European Commission, \(2011\).](#)

¹⁹ [IPR Infringements: Facts and figures, European Commission, \(2017\).](#)

²⁰ [Commission Regulation No. 608/2013 concerning customs enforcement of intellectual property rights and repealing Council Regulation \(EC\) No 1383/2003.](#)

²¹ The EU Customs Union is a unique example of an area where a number of countries apply a uniform system for handling the import, export and transit of goods and implement a common set of rules called *the Union Customs Code* (UCC). For further information, click [here](#).

²² [Essentials on Customs 2020, European Commission.](#)

3.6. Online enforcement

The internet has created plenty of opportunities for small and medium-sized enterprises (SMEs), as it has revolutionised the dynamics of international commerce and led to facilitating the process of internationalisation. While the advantages that the internet offers are remarkable, one should also be aware of its downsides. In this sense, the internet is an ideal platform for infringers to sell counterfeit products and commit fraud, because apart from offering wide reach, infringers can act in a more anonymous way. Thus, it is essential for companies, big and small, to be well advised about the tools that can be used to stop and prevent online infringement.

First of all, **right holders need to identify the online infringement**. The internet offers a vast and everchanging landscape for different types of infringements (e.g. trade mark counterfeiting, piracy, domain name infringement, ad hi-jacking, screen scraping, etc.), which makes it very difficult for right holders to detect such infringements. Nevertheless, there are tools and services offered by specialised companies as well as law firms, to monitor online infringements and subsequently gather the necessary information to effectively tackle such infringements by IP enforcement measures.

Once the necessary information has been gathered, **right holders should develop an online enforcement strategy** aiming to decrease the number of infringements as much as possible in an economically effective way, meaning that the budget for this purpose should be managed in line with such a strategy.

The most well-known, affordable and simplest online enforcement tools are **notice and take-down systems**, by means of which right holders can file a complaint directly on the website where the infringement has been detected so the concerned product is literally “taken down” from the website. The most successful e-commerce websites often offer this service; however, less popular and/or illegal websites may not, so right holders may need to resort to other means to enforce their rights, namely approaching internet service providers and payment providers in order to identify the infringers behind these sites.

However, with counterfeiting and piracy becoming more sophisticated due to the quick evolution of technology, notice and take-down systems are considered insufficient as an online enforcement measure. To complement these systems, the European Commission recommends intermediaries, namely hosting service providers, to take **proactive measures** to tackle illegal content²³. These measures can involve the use of automated means to detect such illegal content, and are proving very effective²⁴.

²³ [Commission Recommendation on measures to effectively tackle illegal content online \(C\(2018\) 1177 final\)](#), European Commission, (2018).

²⁴ [Overview of the functioning of the Memorandum of Understanding on the sale of counterfeit goods via the internet \(COM\(2017\) 707 final\)](#), European Commission, (2017).

Enforcement actions

- **Initial enforcement actions:** cease and desist / warning letters.
- **Civil actions:** provisional measures, damage recovery measures and enforcement procedures.
- **Criminal actions:** private and public prosecution.
- **Customs actions:** EU and national customs actions.
- **Online actions:** Notice and take-down procedures, and information request from internet service providers and payment providers.

4. Enforcement Database

The Enforcement Database (EDB)²⁵, managed by the EUIPO, **contains information on products that have been granted an intellectual property right**, such as a registered trade mark or design. Police and customs officials from the Member States can access this tool to view information and product details, making it easier for them to identify counterfeits and take action.

The EDB is free of charge and is available in 23 EU languages. Any IP right holder can be part of it; you just have to enter information about your products into the database and connect it to your IP rights. Companies from all the different sectors of industry doing business in the European Union are already using the database — from small businesses to multinational corporations.

5. Conclusion

The value of IP lies in the fact that it turns intangible assets into exclusive property rights which companies can exploit, thus generating a return from their investments in research and development, as well as marketing activities. Nowadays, **IP assets are often the most valuable assets of a company.**

The efficient and coherent operation of any IP system very much depends on strong enforcement mechanisms through which IP owners can effectively protect their intellectual assets and recover any losses resulting from any actual infringement. This, in turn, helps to build a confident IP infrastructure necessary

²⁵ [Enforcement Database](#), EUIPO.

to ensure the stimulation of investment in innovation and, eventually, of economic growth and social welfare. Moreover, a solid system of IP enforcement works as a dissuasive force, discouraging IP infringements, and therefore avoiding the economic harm caused by them. Consequently, **it is essential for IP owners to optimise the value of their IP assets by defending and enforcing their rights properly and in a strategic way**, for which they need to be familiar with all the enforcement measures available.

Finally, it is worth recalling how the digital era has revolutionised commerce and the threats to legitimate traders that the internet poses. Even so, the speed with which commerce evolves should be seen as a door opened for new opportunities and a constant reminder for IP owners to be alert and up-to-date with all the mechanisms at their disposal to tackle and prevent such threats.

Useful Resources

For further information, also see:

- Fact Sheet on "[Domain names and cybersquatting](#)"
- Fact Sheet on "[Defending and enforcing IP](#)"
- Fact Sheet on "[IP due diligence: assessing value and risks of intangibles](#)"
- Fact Sheet on "[IP audit: uncovering the potential of your business](#)"
- Fact Sheet on "[Copyright essentials](#)"
- Fact Sheet on "[How to search for trade marks](#)"
- Fact Sheet on "[How to search for patent information](#)"
- Fact Sheet on "[Design searching](#)"
- Fact Sheet on "[Alternative Dispute Resolution \(ADR\) mechanisms](#)"
- IPR Chart on "[EU trade mark](#)"
- IPR Chart on "[International trade mark \(Madrid System\)](#)"
- IPR Chart on "[European patent](#)"
- IPR Chart on "[International patent application](#)"
- IPR Chart on "[Community design](#)"
- IPR Chart on "[International Design \(Hague System\)](#)"
- [Trade in Counterfeit and Pirated Goods, Mapping the economic impact](#), OECD and EUIPO (2016).
- [Customs enforcement of intellectual property rights – Frequently Asked Questions \(MEMO/11/327\)](#), European Commission, (2011).
- [IPR Infringements: Facts and figures](#), European Commission, (2017).
- [Enforcement of intellectual property rights](#), European Commission
- [Enforcement Database](#), EUIPO.
- [The economic impacts of counterfeiting and piracy](#), Frontier Economics (2017).

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ABOUT THE EUROPEAN IPR HELPDESK

The European IPR Helpdesk aims at raising awareness of Intellectual Property (IP) and Intellectual Property Rights (IPR) by providing information, direct advice and training on IP and IPR matters to current and potential participants of EU funded projects. In addition, the European IPR Helpdesk provides IP support to EU SMEs negotiating or concluding transnational partnership agreements, especially through the Enterprise Europe Network. All services provided are free of charge.

Helpline: The Helpline service answers your IP queries within three working days. Please contact us via registration on our website – www.iprhelppdesk.eu – phone or fax.

Website: On our website you can find extensive information and helpful documents on different aspects of IPR and IP management, especially with regard to specific IP questions in the context of EU funded programmes.

Newsletter and Bulletin: Keep track of the latest news on IP and read expert articles and case studies by subscribing to our email newsletter and Bulletin.

Training: We have designed a training catalogue consisting of nine different modules. If you are interested in planning a session with us, simply send us an email at training@iprhelppdesk.eu.

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