

**ASEAN-ECAPII-USPTO  
WORKSHOP ON INTELLECTUAL PROPERTY  
PROTECTION AND ENFORCEMENT IN THE  
DIGITAL ENVIRONMENT  
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# TRIPS Enforcement Obligations

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# IPR Protection today

- World-wide: Principle of territoriality of IP rights seen as obstacle against efficient protection in times of international exchange:
  - Trade and communication increased since 19th century
  - Achievements protected in one country could be copied anywhere else if not protected there
  - Inventors, manufacturers, authors had to seek for protection in all countries
    - costly and time consuming
- Increasing harmonization of formal and material requirements for IPR protection (TLT, PLT)
- Centralization of registration and examination procedures (PCT, Madrid System, EPC)
- Supra-national systems of IPR granting, administration and enforcement (EU Community Trademark, EU Community Design, *EU Patent*)
- International standards for IPR protection (TRIPs)



# General principles of TRIPS

Before TRIPS, international treaties concerning IP rights were almost silent on the issue of enforcement. TRIPS recognizes:

- Need for a multilateral framework of principles, rules and disciplines dealing with international trade in counterfeit goods
- Intellectual property rights are private rights
- IPR Framework must recognize the underlying public policy objectives of national systems for the protection of intellectual property, including developmental and technological objectives
- IPR Framework must recognize the special needs of the least-developed countries
- Importance of reducing tensions by reaching strengthened commitments to resolve disputes on trade-related intellectual property issues through multilateral procedures



# Minimum standards in IPR protection – TRIPS (1994)

## Granting of IP rights

1. Copyright and Related Rights
2. Trademarks
3. Geographical Indications
4. Industrial Designs
5. Patents
6. Layout-Designs (Topographies) of Integrated Circuits
7. Protection of Undisclosed Information

## Enforcement of IP rights

1. Civil and Administrative Procedures and Remedies
2. Provisional Measures
3. Special Requirements Related to Border Measures
4. Criminal Procedures



# Enforcement Obligations under TRIPS (I): General Principles

- Expeditious remedies to prevent infringements and remedies which constitute a deterrent to further infringements
- Fair and equitable Procedures, not unnecessarily complicated or costly, or entailing unreasonable time-limits or unwarranted delays.
- Decisions in writing and reasoned.
- Opportunity for review by a judicial authority of final administrative decisions



# Enforcement Obligations under TRIPS (II): Civil and administrative procedures and remedies

- Injunctions
  - Order to desist from an infringement to prevent the entry of infringing goods into the channels of commerce
- Damages
  - Order to pay the right holder damages adequate to compensate for the injury the right holder has suffered because of an infringement including recovery of profits
  - Order to pay the right holder expenses including attorney's fees.
- Other remedies
  - Destruction of infringing goods
  - simple removal of trademark unlawfully affixed not sufficient
- Right of information
  - to order the infringer to inform the right holder of the identity of third persons involved in the production and distribution of the infringing goods or services and of their channels of distribution.



# Enforcement Obligations under TRIPS (III): Provisional measures

- Objectives:
  - to prevent an infringement of any intellectual property right from occurring, and in particular to prevent the entry into the channels of commerce in their jurisdiction of goods, including imported goods immediately after customs clearance
  - to preserve relevant evidence in regard to the alleged infringement.
- Procedure:
  - *inaudita altera parte* when any delay is likely to cause irreparable harm to the right holder, or when there is a risk of evidence being destroyed.



# Enforcement Obligations under TRIPS (IV): Border measures

- Right holder suspecting that importation of counterfeit or pirated goods may take place can lodge an application with competent authorities for
  - suspension by customs authorities of the release into free circulation of such goods,
  - suspension by the customs authorities of the release of infringing goods destined for exportation
- Right holder has to provide security or equivalent assurance to protect defendant and competent authorities and to prevent abuse.
- Alleged infringer has right to compensation in case of wrongful detention of goods.



## Enforcement Obligations under TRIPS (V): Criminal procedures

- Criminal procedures and penalties at least in cases of willful trademark counterfeiting or copyright piracy *on a commercial scale*.
- Imprisonment and/or monetary fines sufficient to provide a deterrent.
- Seizure, forfeiture and destruction of the infringing goods and of any materials and implements the predominant use of which has been in the commission of the offence.



# Today's challenges for IPR protection (I)

- International co-operation in establishing common systems for administration, legal protection and enforcement **not adequate** to globalization of trade – legal and illegal
- New ways of copying intellectual property in the digital environment
  - 1971 phonograms convention does not cover other works that are digitally available
  - Technical systems of protection (DRM) vs. Traditional legal means
- Traditional means of distribution replaced by internet order of counterfeits, piracy by download



# Today's challenges for IPR protection (II)

- Even though laws and procedures are increasingly harmonized, legal cultures are still mostly national – lacking awareness of legal developments abroad
- Enforcement agencies are administered and controlled nationally – police, customs co-operation still slow, few information exchange systems about infringing goods flow, particularly such flow by means of internet
- Uncertainty about individual rights (fair use) under private protection regimes like DRM
- TRIPS Agreement obliges member states to anti-counterfeiting controls only on imports but not on exports, transit and transshipment movements



# Future Tasks for IP Protection in the Internet Environment

- International legal framework on counterfeiting and piracy
  - Raising awareness
  - Improving cooperation and coordination
  - Building capacity
  - Promoting better legislation and enforcement
- Increased co-operation between national and international organizations – Interpol, World Customs Organization, WIPO – and initiatives from the private sector
- Development and implementation of integrated national, regional and international standards and programs – beyond minimum requirements for member states as required by TRIPS
- Amendments to TRIPS to oblige member states to anti-counterfeiting controls not only on imports but also on exports, transit and transshipment movements

