



# Civil Remedies Against IP Infringement

Dr. Eric GASTINEL | Zoom | 18 May 2021

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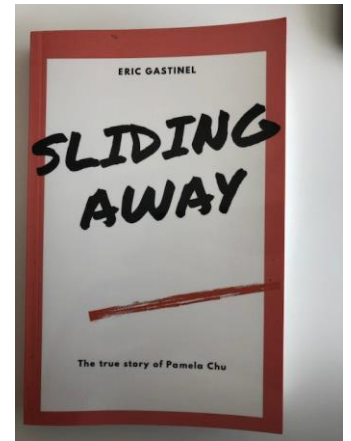


## The EUIPO judges network since 2008

A network of some 1,000 judges and prosecutors in the EU and beyond was created

3,630 judges and prosecutors were hosted over 81 events

The work was done around **the Max Case and Pamela Chu**



## An idea to start with?



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### Quoting Forrest Gump:

**‘Life is like a box of chocolates, you never know what you will get ...’**

**Unveiling a counterfeit case could compare to a huge box of chocolates. You never know what you will find beyond it.**



## The road map

**I The General Context**

**II The Procedural Aspects**

**III Wrapping up**



## The road map

# I The General Context

## II The Procedural Aspects

## III Wrapping up



## The judicial axiom



## TRIPS makes a natural road map

**TRIPS covers minimum conditions of protection of IPR at civil, customs and criminal levels**





## The starting point

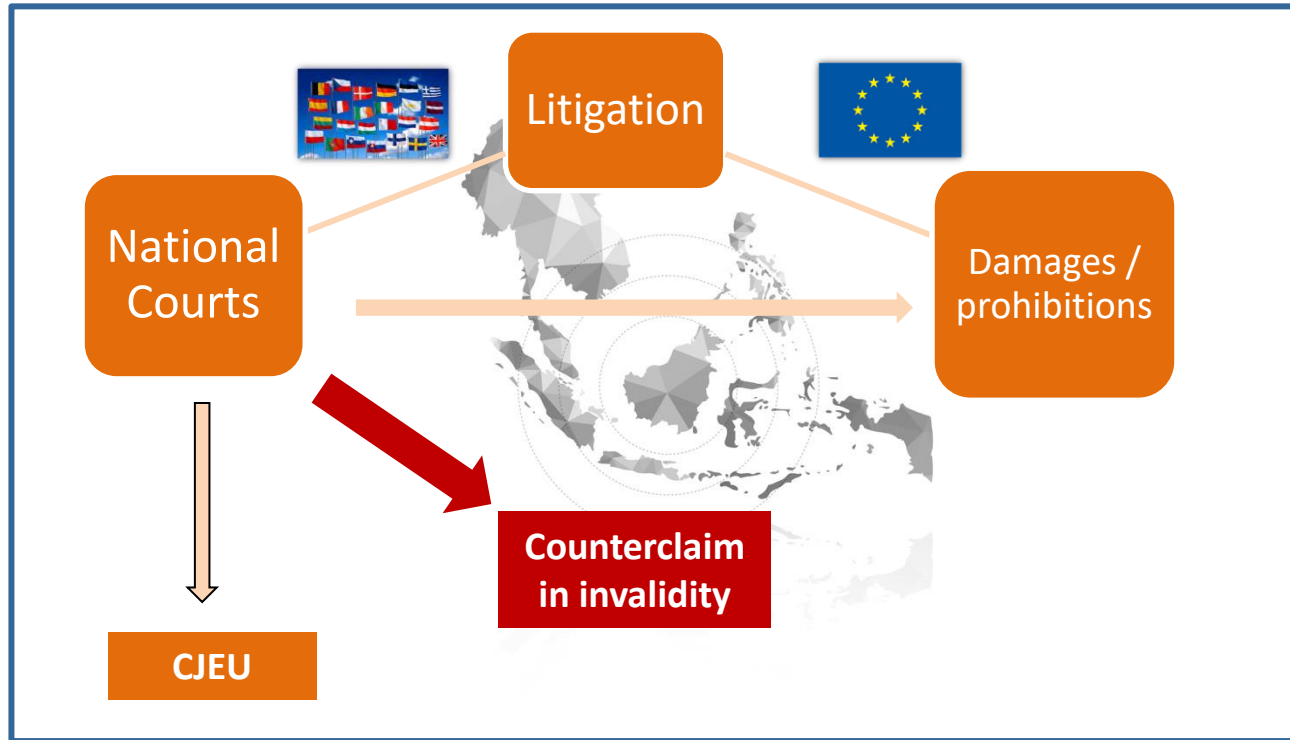
**The IPR must be validly protected in the country in which the right holder wants to initiate legal action or to claim a prejudice.**



**International exhaustion of IP rights does not exist in the EU from outside of the EEA.**



## The classic IPR litigation



## Key messages for enforcement officers

### Turn intelligence into evidence

**Counterfeiting is not a victimless crime**

**Get the right holders to be involved and supportive**

**Make your case an easy and sexy one**

**Follow the money and catch it**



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## The civil remedies: a European patchwork



## The courts having jurisdiction

**There is no harmonisation within the EU Member States  
as to the courts having jurisdiction over IPR matters**



## The geographical scope of measures

- ✓ EU-Wide based upon the domicile of the defendant
  - ✓ Nation-wide based upon the place of the infringement
- 



## How to enforce IPRs within the EU? — Civil remedies

A European Directive 2004/48/EC of 29 April 2004 set the different measures the EU Member States had to implement in their national legal systems.

However the directive didn't harmonise the procedural rules of the civil litigations that remained governed by pure national legislations.





## The set of different preliminary measures

- 
- ✓ **Collection of evidence**
  - ✓ **Interim measures to prevent imminent infringement**
  - ✓ **Injunctions for internet**



## The different types of measures on the merits

- ✓ **Order to stop the infringement and remove the goods from the channels of commerce**
  - ✓ **Publicity measures**
  - ✓ **Damages, punitive damages and licensing fee alternatives**
  - ✓ **Disposal of goods**
  - ✓ **Confiscation measures (stock of products, machinery, money, closure of the factory)**
- 



## The disposal of infringing goods

- ✓ Re-use of IPR infringing goods after de-branding
- ✓ Destruction of the infringing goods..... Who pays?



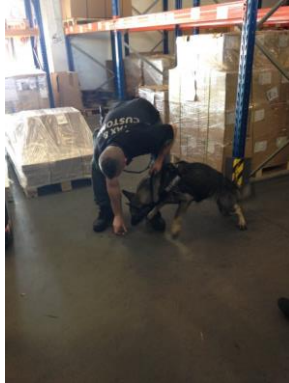
## The forfeiture issue

- ✓ **What are the rules, specific conditions and related thresholds that apply to confiscation in your country?**
- ✓ **Does confiscation apply to IPR?**
- ✓ **Is there a civil or administrative confiscation in your country?**



## How to dispose easily of IP rights? – customs measures

As for border measures, Regulation (EU) No. 608/2013 concerning customs enforcement of IPRs set a special procedure to facilitate the seizure and disposal of IP-infringing products before they enter the channels of commerce within the EU.



## EU Customs enforcement of IPR – Scope of Regulation 608/2013

- **Customs will intervene for goods under customs supervision or control within the European Union customs territory. This excludes goods in external transit.**

Exclusions : goods of non-commercial nature contained in travellers' luggage, parallel trade and overruns

- **Rights covered :**

- ✓ Trade marks
- ✓ Designs
- ✓ Copyrights or related right
- ✓ Geographical indications (except traditional specialty guaranteed)
- ✓ Patents
- ✓ Supplementary protection certificates
- ✓ Plant variety rights
- ✓ Topographies of semiconductors (new 2013)
- ✓ Utility models (new 2013)
- ✓ Trade names (new 2013)
- ✗ Know how and trade secret (not covered)
- ✗ Unfair competition and passing off (not covered)



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## The weaknesses of the civil route

- ✓ Evidencing the full profit made by the infringers
- ✓ Evidencing the loss incurred by the victims
- ✓ Giving a proper value to the moral damages
- ✓ The lump sum or fee alternative
- ✓ The fear of punitive damages





## Opening up to new perspectives

- 
- ✓ **Condemnation *in solidum***
  - ✓ **Class action against infringers**
  - ✓ **Civil confiscations**



And...

**fake smiling?**  
I'm a professional at that.

 @IPKey\_EU

