



Hogan
Lovells

Global Anti-counterfeiting and Asset Tracing

Europe, Middle East, Asia and Americas

2016

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Our approach

Exploiting the global reach of our specialized team

Counterfeiting is an international challenge: Counterfeit products are manufactured where the production costs are low (often in Asia), shipped for further distribution to transport hubs (such as the Middle East) and finally sold where profits are high (particularly in the United States and Europe).

Therefore successful anti-counterfeiting must take an equally international approach. Hogan Lovells is exceptional in its ability to provide the international network and local expertise required for developing, implementing and applying a successful anti-counterfeiting strategy.

We support many multinational corporations, including Original Equipment Manufacturers (OEMs), in their fight against counterfeit products with:

- a **market-leading, integrated IP practice** with almost 400 professionals across Europe, the United States, Mexico, the Middle East and Asia, working beyond our own presence with a network of local agents to provide a global reach
- the only IP practice worldwide to be **ranked tier 1 by Chambers Guide 2016** on a Global, European and Asia Pacific level
- an award winning practice with **significant presence in China**, which enables us to stop counterfeits at the source
- a **market-leading Investigations, White Collar Crime and Fraud group**, which brings to the fore our strength in asset tracing, providing a truly integrated response.



Step 1: Being ahead of counterfeiters

Maintaining an up-to-date portfolio of Intellectual Property Rights

An up-to-date portfolio of Intellectual Property (IP) rights, in particular trademarks, designs and patents, is the very foundation of successful anti-counterfeiting action. The portfolio should protect all key assets of your business and be abreast of your business so that it also protects new products being launched and new markets being entered. Where IP right protection has been acquired, the IP right owner enjoys exclusivity on the protected item and can enforce its exclusivity by a set of rights, including the right to request others to cease and desist from using the IP right and to destroy products which infringe it.

Hogan Lovells knows how to manage an IP right portfolio strategically. We advise many multinational corporations on the strategic development and daily management of their global IP right portfolio, which include some of the most famous global brands. Therefore, we have the insight, business knowledge and expertise to assist you in making sure that the key assets of your business are protected in the relevant markets. In our integrated IP practice, prosecution and enforcement specialists work hand in hand. The benefits for our clients include:

- **high awareness of legal developments at home and abroad** regarding the IP right protection available in individual jurisdictions and the means to enforce such protection
- **know-how on developing and implementing** regional and global IP right portfolios and enforcement strategies
- **easy communication of relevant information** about new rights registered, products to be launched, protection gaps spotted across prosecution and enforcement teams and jurisdictions.

Step 2: Starting-off defence smartly

Intelligent investigations and information management

Successful anti-counterfeiting starts with intelligent investigation and information management. Hogan Lovells has developed and makes available to its clients a system to enable easy gathering and sharing of information on IP infringement among team members, allowing our clients to take efficient action against counterfeiters. This system comprises features to:

- **regularly review markets**, POS, trade fairs, the internet and other sources of information for (possible) infringements
- **maintain a database with key information** on infringements such as the identity of the infringer and specific features of the infringing products
- **secure evidence on infringements in a meaningful way**, such as the infringing products, copies of invoices and delivery notes
- **regularly review the information** and maintain a generic or specific list of targets sorted by priority so that cases are handled according to their importance and with a reasonable and predictable investment of resources
- **define clear reporting lines and contents of reports** with a high degree of standardization (e.g. by using standard forms).

Step 3: Preventing market infiltration

Customs monitoring across the globe

Ideally, counterfeits are removed before they enter the market so that they cannot affect the market (prices) negatively, cannot trigger unjustified customer complaints or harm the reputation of the OEM manufacturer. In many countries of the world, right holders can initiate customs checks in order to prevent counterfeits from entering the market.

Hogan Lovells regularly supports rights holders in drafting, filing and maintaining customs monitoring applications to prevent counterfeits from distorting the market and coordinates action across jurisdictions. Each year, we handle thousands of retention cases carried out on this basis and assist our clients in updating customs, not only by means of suitable documentation, but also on the spot training and online tools. Through leveraging our close links to the national authorities and our international network, our clients can take full advantage of the benefits of regional customs monitoring applications, which prevent counterfeits from entering common markets such as the single European market, and national customs monitoring applications, which permit actions against counterfeits on national markets. Our multi-lingual and multi-qualified lawyers provide for uniform client reporting and short reporting lines when it comes to process retention cases from all over the globe and in particular the key regions of the European Union, Russia / CIS, the Middle East, Asia (with particular focus on China and Hong Kong) and America (notably the US and Mexico).



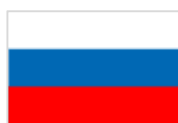
The European Union

We provide for a comprehensive coverage of the European Union with straightforward reporting lines between Hogan Lovells and your organization. Together with standardized actions we ensure maximum impact on the counterfeit business with minimum involvement of your resources. In 13 Offices across the European continent, Hogan Lovells hosts an integrated team of over 200 specialized IP lawyers with extensive experience in enforcing our clients' IP rights in the individual member states as well as handling cross-border cases. In the European Union, we provide:

- **one application covering all 28 EU member states:** the customs authorities of all designated member states look out for infringing shipments and conduct customs seizures, including the officers stationed at hotspots of international trade such as the ports of Rotterdam and Hamburg, and Heathrow and Frankfurt Airports

- **one contact with European reach:** the national authority chosen for filing the community wide application will serve as a single point of contact for the application and automatically pass on all relevant information to other national authorities designated in the application. Accordingly, Hogan Lovells offers its clients a single point of contact who makes the link between local representatives on the ground and the in-house anti-counterfeiting team, monitors all cases and deadlines from across the EU and reports about the progress made
- **a straightforward procedure that enables the destruction of infringing products** in the majority of seizure cases based on simple communication of the infringing nature of the shipment to customs alongside a request for destruction without employing the courts.

Hogan Lovells ensures that cases can be handled locally in the local language irrespective of where in the EU retentions are issued. Well established links within our network and multi-lingual lawyers allow for swift communication of information. Where court proceedings are necessary to achieve destruction, we will ascertain that proper action is taken within the tight legal deadlines.



Russia and CIS

In Moscow, our experienced IP team offers the full range of IP prosecution in Russia and other CIS countries. Our lawyers on the ground have extensive experience in representing our clients in IP matters including strategic counselling and anti-counterfeiting.

In Russia, our experience includes:

- **recording our client's trademarks/copyright with the Customs Registers** of Russia, Belarus, Kazakhstan and other CIS countries to monitor / terminate the distribution of counterfeit products and to achieve destruction of counterfeit goods
- **handling the administrative actions** initiated by the Russian Customs Authorities (including import/export related issues and in-market checks)
- **handling the criminal actions** initiated by the Russian police (including import, manufacturing, repackaging related issues and in-market checks)
- **employing the Russian Customs Code** and legislation of the Customs Union of Russia, Belarus and Kazakhstan alongside Russian courts to successfully take civil actions against parallel imports to Russia
- **organising training for Customs Authorities** to spread information on counterfeit features of suspicious shipments features such as packaging, importers, manufacturers, etc.

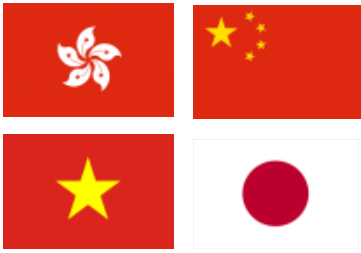


Middle East

Hogan Lovells operates its own offices in Dubai and Saudi Arabia with the Dubai Office hosting our Middle-East IP team with more than 20 years of experience in enforcing IP rights in almost every country in the Middle East. Beyond our own capabilities on the ground, we have set up in the region a network of firms with whom we work closely on a regular basis.

Our typical recommendations regarding the Middle East include:

- **regular market surveys** and test purchases to monitor the level of counterfeit products in the wholesale and retail markets
- **customs trademark recordal** in those countries where this is available such as in Dubai or the neighbouring Emirate of Sharjah
- **administrative procedures** or actions by the local "Economic Departments" can be a cost effective means of enforcement when available. For example, such actions may be useful in Dubai and Saudi Arabia
- **raids conducted by police** continue to be a valuable means of enforcement where there are reliable procedures in place
- **court-supervised seizures** are available and effective in many countries and may be preferred for certain kinds of cases.



Asia

In Asia, we provide our clients with local support across the region through nine well-established offices (3 alone in China including Hong Kong) and the Sino-Global Legal Alliance (SGLA). SGLA is a highly integrated network comprising Hogan Lovells and prominent Chinese law firms in more than 15 Chinese cities.

The anti-counterfeiting capabilities of our IP practice in Asia particularly include:

- **devising and implementing regular customs monitoring programs** (including recordation with customs and working with customs in preparing prosecution cases initiated by customs authorities) in Greater China since more than 15 years
- the **ability to handle all aspects of IP enforcement work with our domestic intellectual property agency** in Shanghai. Our liaison office in Beijing enables us to provide cost-effective services with the high standards of a top-tier international law firm. In addition, our team of IP specialists in our Tokyo office boasts combined qualifications covering Japan, Europe, the United States and further parts of the Asia-Pacific region.



United States

In the United States, we have successfully run anti-counterfeiting actions for many of the world's leading brand owners and stand out for our closely coordinated approach, allowing us to stop counterfeits where most appropriate (at source, in transit, or at destination). These strategies employ multi-faceted approaches working with the appropriate customs and law enforcement authorities as well as pursuing private causes of action and strengthening contractual rights.

As part of this strategy, we provide in the US the following services:

- **investigating and identifying the key operators** behind the flow of counterfeit goods and parallel products
- **analysing and controlling your manufacture/distribution channels**. It is important to actively monitor these channels and to have proper agreements in place with all parties requiring active monitoring of employees and sub-distributors
- **regular audits of your intellectual property**, including identifying and confirming your rights upon which enforcement action can be taken, and addressing any gaps in your portfolio
- **recording your trademark registrations with U.S. Customs and Border Protection** and preparing and presenting presentations and materials to assist Customs officials in identifying and seizing counterfeit goods
- representing and counselling clients in connection with **counterfeiting enforcement activities**, including federal and ITC litigation, cease-and-desist communications, and lodging complaints under various online IP policies.



Mexico

Our Mexican IPMT team has ample experience with administrative, customs, judicial and criminal authorities for the inception, preservation, enforcement and defense of industrial and intellectual property rights and in particular anti-counterfeiting.

For more than 35 years the firm has advised clients in their IP and anti-counterfeiting strategies, from various industries including sport related products, stationery, printer cartridges, batteries, clothing, shoes, and shaving razors. We have the experience to develop and implement efficient tailor-made strategies in Mexico depending on the specific rights involved – copyrights, trademarks, trade names, trade secrets – and always orientated on and in view of business needs of clients.

As part of anti-counterfeiting activities our Mexican IP team has trained experts from the Attorney General's Office on how to identify counterfeit goods, providing them with key information (non-confidential) to ease their task. We work constantly and closely with customs' authorities to investigate and take action against suspects trying to import counterfeit goods into Mexico through different ports of entry, as well as coordinating training programs for our clients.

For some of our clients, including major IT and consumer products companies, we handle their trademark portfolio and have been advising in the design and implementation of their anti-counterfeiting program, involving several administrative, customs (border measures) and criminal raids. These actions have proven to be very effective and successful, ongoing for more than 15 years.

During the last years, customs has been working jointly with the Mexican Institute of Industrial Property ("MIIP") in the implementation of a program for creating a database comprising information about Mexican trademark registrations ("Trademark Registry") available for Customs with the purpose of:

- allowing the latter to have information about trademark owners, licensees and attorneys of record;
- allowing the identification of counterfeited merchandise intended to be introduced in the country;
- expedite Customs clearance related to registered trademarks in Mexico; and
- allowing Customs inspectors carrying out an improved merchandise revision, giving the opportunity for informing trademark owners in the event of doubts with respect to the originality of merchandise intended to be introduced into the country.

In Mexico, trademark and copyrights anti-counterfeiting actions could be prosecuted through administrative or criminal lawsuits, depending on the likeness of the product. In the case of patents, the legal course of action is administrative.

"Renowned international firm with acclaimed IP teams across Europe and the Asia-Pacific region and a notable US presence."

Chambers Global, 2015

Step 4: Clearing the net

Employing Information Technology for fighting counterfeits on the internet

The internet is the global market for counterfeits. Here, manufacturers of counterfeit products and distributors meet and it is through online marketplaces, auction platforms and web shops that counterfeits are distributed on a global scale. In order to effectively fight counterfeiting in the net, we do not only employ the combined competence of our global team but also state of the art information technology.

We are in charge and hence have comprehensive experience on how to effectively run online enforcement programs across borders for some of the most famous brands of the world. Whether infringements are committed by offering counterfeit products in the Internet or using trademarks or other IP rights for the promotion of non-authorized products through rogue websites or apps, we employ up-to date technology as well as proprietary software and database solutions to detect and take down infringing online offers. Due to our cooperation with specialized service providers, our clients enjoy at the same time

- the advantages of an automated processing of online infringements; and
- sound legal supervision – where necessary by an integrated global team.

As a result of our practical experience in the field, we know the current state and ongoing trends of infringements in the Internet and can assess the actual benefits of the technical tools on display for facilitating enforcement of IP rights in the Internet. We know how technology and computer programs can help detecting online infringements efficiently and comprehensively. We follow closely the advancement of technology as regards detecting suspicious use of protected signs such as words and images and automated clearing of online infringements.

As a result, we wipe-off huge numbers of infringing online offers every day and spread in the market that our clients do not tolerate online infringement of their rights and are apt to take swift action across borders. Beyond the mere reduction of infringements in the internet this also results in the protection of our clients' trademarks against dilution.



Step 5: Using legal options clever across the board

Stopping counterfeiting

Civil action

We know from ample experience how to employ and enforce the civil law remedies available – preliminary proceedings and main action alike – so that the counterfeit business is eradicated, the people behind the counterfeiting are tracked down and financial losses are compensated. We do this with a view to the jurisdictions that offer the best leverage for our action.

Preliminary proceedings enable OEMs and other IP rights owners to obtain an enforceable court title quickly and cost-effectively which:

- **typically results in a preliminary injunction** ordering the infringer to cease and desist from infringing the IP rights immediately. In the case of clear infringement the preliminary injunction may also contain an order to disclose information. In cases of patent infringement, the infringer may be ordered to allow inspection of his property to obtain evidence
- **may also result in the seizure of the infringer's property** for the later satisfaction of the rights holder's claims for damages
- **are decided ex parte in several countries** and hence involve a surprise element which is key to achieving an effective seizure of infringing products or assets.

Main proceedings provide a wide array of legal means which can hit the counterfeiter hard, in particular:

- **claims for destruction** of infringing items covering not only counterfeits but also related items such as tools and promotional material
- comprehensive **claims for information disclosure** against the infringer and third parties, such as transport companies, allowing the follow-up of the counterfeit supply-chain and the ability to obtain evidence against the infringer's suppliers
- **claims for damages** against infringers to recuperate losses suffered by counterfeiting
- **claims for recall of infringing products** from the infringer's commercial customers
- claims for publication of judgment in severe cases, i.e. rights owners may obtain the permission to **publish the judgment** against the infringer in the media
- in cases of infringement of European Community trademarks and designs: (National) Community trademark or design courts can issue **cease and desist orders with effect in the entire European Union.**

The effects of the above remedies primarily affect the infringer but often send a daunting message to other possible infringers as a side effect.

Step 5: Using legal options clever across the board

Deterring counterfeiters

Criminal action

Counterfeiting is a criminal offence in many jurisdictions. To benefit from the deterring effect of public prosecution, we regularly file on behalf of our clients criminal complaints with the prosecuting authorities, police and customs investigations units, in order to trigger a criminal investigation. We do not stop there but closely follow the authorities' handling of the case, using our personal links with the law enforcement officers developed over years of cooperation. Where possible, we represent our clients in the criminal trial against the infringer to make sure that the injury suffered by the IP right owner is taken into account properly by the court and commercial infringements adequately sanctioned.

As a result, our clients benefit from the singularities of criminal proceedings such as:

- **raid of the infringer's premises** or – during trade shows – stand by the police, possibly including the private homes of the individuals responsible for the infringements
- **seizure by the police of all infringing items** including promotional materials and tools as well as the infringer's bookkeeping records and other business papers
- **collection of evidence** from the prosecutor's files for use in civil proceedings and actions against the infringer's suppliers and customers
- **punishment of the infringer**, ideally as a result of a criminal trial with high publicity
- **pressure on the infringer to reach a settlement** with the rights holder to ameliorate his position in the criminal proceedings and avoid the negative publicity of a criminal trial
- **asset recovery** of the proceeds of the criminal enterprise.

"It is one of the most joined-up firms internationally; it really has the same ethos and connectedness the world over."

Chambers Global, 2016

Step 6: Asset recovery

Tackling counterfeiting at its source

Beyond the classical means of IP rights enforcement, we make available our expertise in the commercial fraud arena for our clients' anti-counterfeiting schemes. Hence we can pursue the individuals organizing counterfeiting behind the apparent network of manufacturers, distributors and sellers. These principal players have the means to re-establish the counterfeiting enterprise in a new guise even after the front-end of their illicit operations have been shut down. In order to deprive them of these means, we reach out for their assets by applying civil asset recovery techniques.

The key to asset recovery is to secure evidence linking the illicit gains to the principal player. In a multitude of cases, we have secured that evidence by obtaining creative ancillary orders such as third party disclosure orders and freezing orders from courts in several different jurisdictions.

Such orders can allow the IP rights owners to:

- **gain access to bank accounts** without the account holder's knowledge and to prevent the bank from alerting the account holder afterwards
- **trace assets to their final destination** by gaining access to phone records and data stored on computers and servers; and
- **seize assets** which represent the proceeds of counterfeiting.



Last but not least: Managing costs

Innovative fee arrangements

We are happy to discuss innovative fee arrangements with our clients to make the costs of running an efficient anti-counterfeiting program transparent and predictable. Such arrangements may combine fixed fee arrangements and other flexible forms of fee and billing arrangements, for instance, agreement upon a monthly flat fee for certain services or flat fees for specific work.

Value added services

When working with clients we also offer a range of free value added services including tailored training on specific topics of interest and online know how resources. Clients continue to place a greater focus on driving business growth by protecting and leveraging their ideas, innovations, brands and creative works.

LimeGreen IP

The innovative and now market leading global IP know-how site limegreenip.com was launched in March 2014. Feedback from clients has been extremely positive, with many clients actively promoting it internally across their entire in-house legal teams. LimeGreenIP is a free online resource, and jurisdictional comparator, providing our clients with the answers to frequently asked IP questions from around the globe. Current content includes:

- The Trademark Application Process
- Trademark Litigation
- Patent Litigation
- Copyright Protection
- Law on Employee Invention.
- Designs

www.hoganlovells.com/limegreenip



Our anti counterfeiting credentials

Multijurisdictional anti-counterfeiting strategies

We have successfully run anti-counterfeiting actions for many of the world's leading IP rights owners and stand out for our closely coordinated international approach allowing us to stop counterfeits where most appropriate (source, transit or destination).

Recent examples include:

- After investigation, we stopped and seized a very substantial consignment of a counterfeit blockbuster pharmaceutical on the way from China via Dubai to Europe. In a coordinated enforcement action, we managed to put the Chinese manufacturer, the Tunisian middleman and the French distributor of the counterfeits in jail and to obtain significant damage payments for our client
- We unveiled and shut down a counterfeiting facility for the production of fake printer cartridges of practically all major OEMs in Germany and seized thousands of infringing items. Through our close links with the Public Prosecution and Police, we quickly obtained information on the Chinese suppliers and Dubai-based financiers of the counterfeit business for further action abroad. Against the individuals involved, jail sentences for commercial criminal trademark infringement and fraud were rendered.
- We run an online enforcement program for one of the best-known brands worldwide, allowing us to track down and take action against all infringements of a specific trademark. In close cooperation with an Internet Service Agency, we constantly screen the Internet for infringements and provide for the immediate take down of all infringing offers in a highly automatized and standardized process
- Representing IBM in Lanham Act palming-off cases in the US involving counterfeit product packaging, manuals, supplies, mainframe microcode, mainframe memory chips and memory cards, PC memory, and software
- Representing Sun Microsystems in an anti-counterfeiting case in the US resulting in a favourable settlement for Sun
- Advising a furniture manufacturer on strategies for enforcement against counterfeit products manufactured in China and imported and sold in the United States
- During the end of 2014 and beginning of 2015, we filed more than 20 proceedings for the implementation of border measures and their corresponding infringement lawsuits in Mexico where several containers were detained resulting in more than 5 million products seized by the Mexican Institute of Industrial Property with the assistance of customs.

"One of the top international players."

"Huge international presence and top-notch lawyers."

Chambers Global, 2015

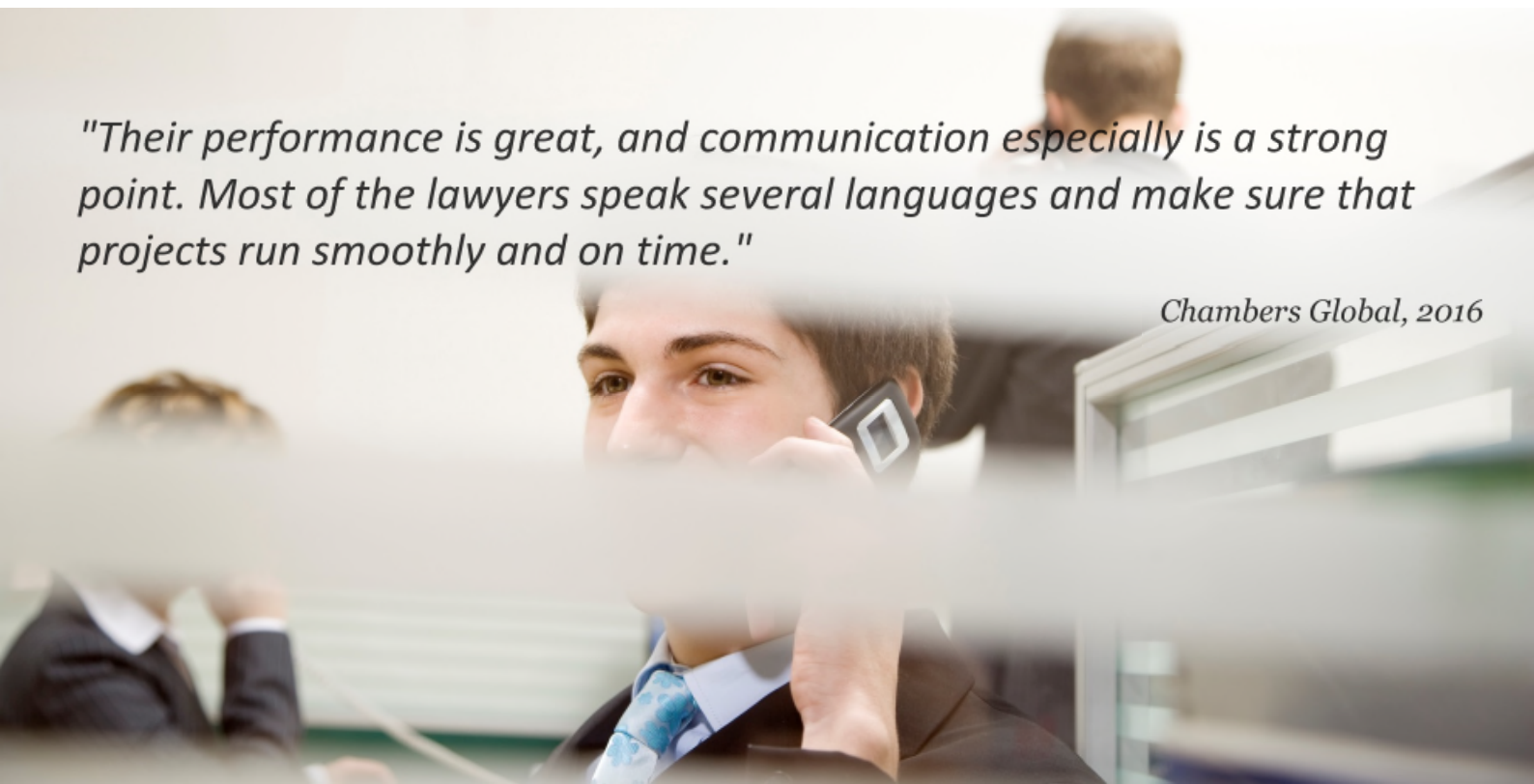
Asset recovery

Our asset recovery team has comprehensive experience in coordinating the recovery of assets worldwide including directing proceedings in a variety of jurisdictions. Recent examples are:

- Acting for **Libya's National Transitional Council (NTC)** in relation to the operation of UN sanctions, and the recovery of Libyan assets. Most notably, we have recently advised the NTC in recovering approximately £1 billion in Libyan Dinar notes frozen in the UK by UN sanctions. This is the most significant recovery of Libyan assets since the imposition of UN sanctions
- Acting for **BTA Bank**, the largest bank in Kazakhstan, in asset recovery litigation concerning fraudulent transactions of more than US\$5 billion allegedly entered into by the Bank's former management. This case is one of the largest in the UK and involves related litigation in jurisdictions such as Cyprus, the British Virgin Islands and Russia
- Advising ING Barings following the collapse of Barings Bank in relation to investigations carried out by the Bank of England, the Singaporean authorities and other regulatory bodies and prosecuting authorities into the collapse in 1995
- Acting for the **Liquidators of BCCI** including in relation to the worldwide recovery of misappropriated funds. This involved proceedings in England, France, Lichtenstein, BVI, Cayman, Bahamas, Panama, Argentina, Chile, Bahrain and Pakistan. This has resulted in the recovery of funds amounting to many millions of dollars. The dividend paid to creditors currently stands at 84%.

"Their performance is great, and communication especially is a strong point. Most of the lawyers speak several languages and make sure that projects run smoothly and on time."

Chambers Global, 2016



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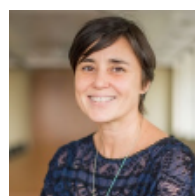
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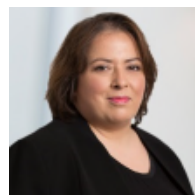
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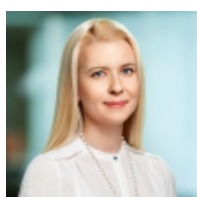
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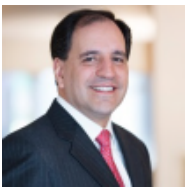
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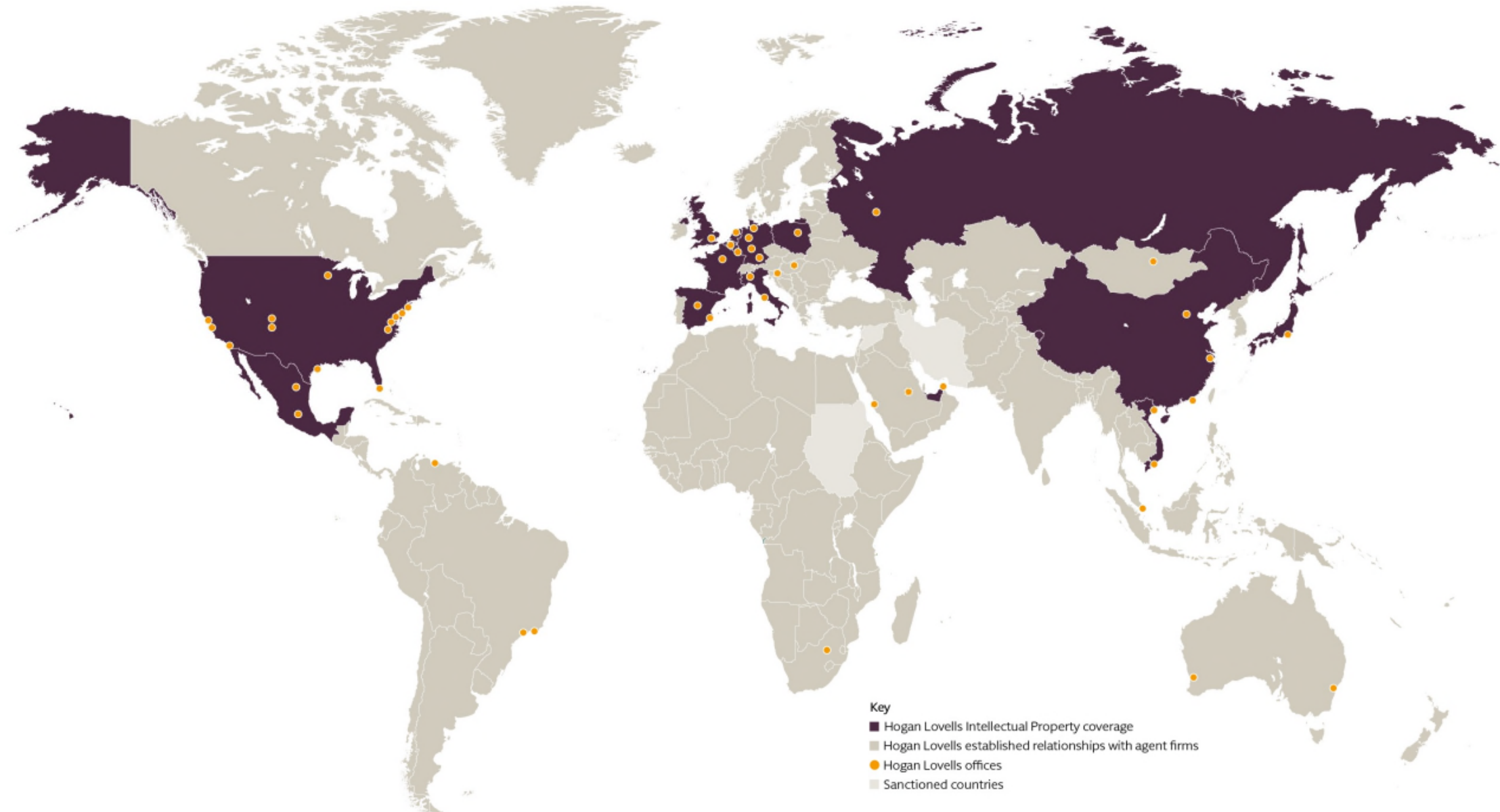
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