



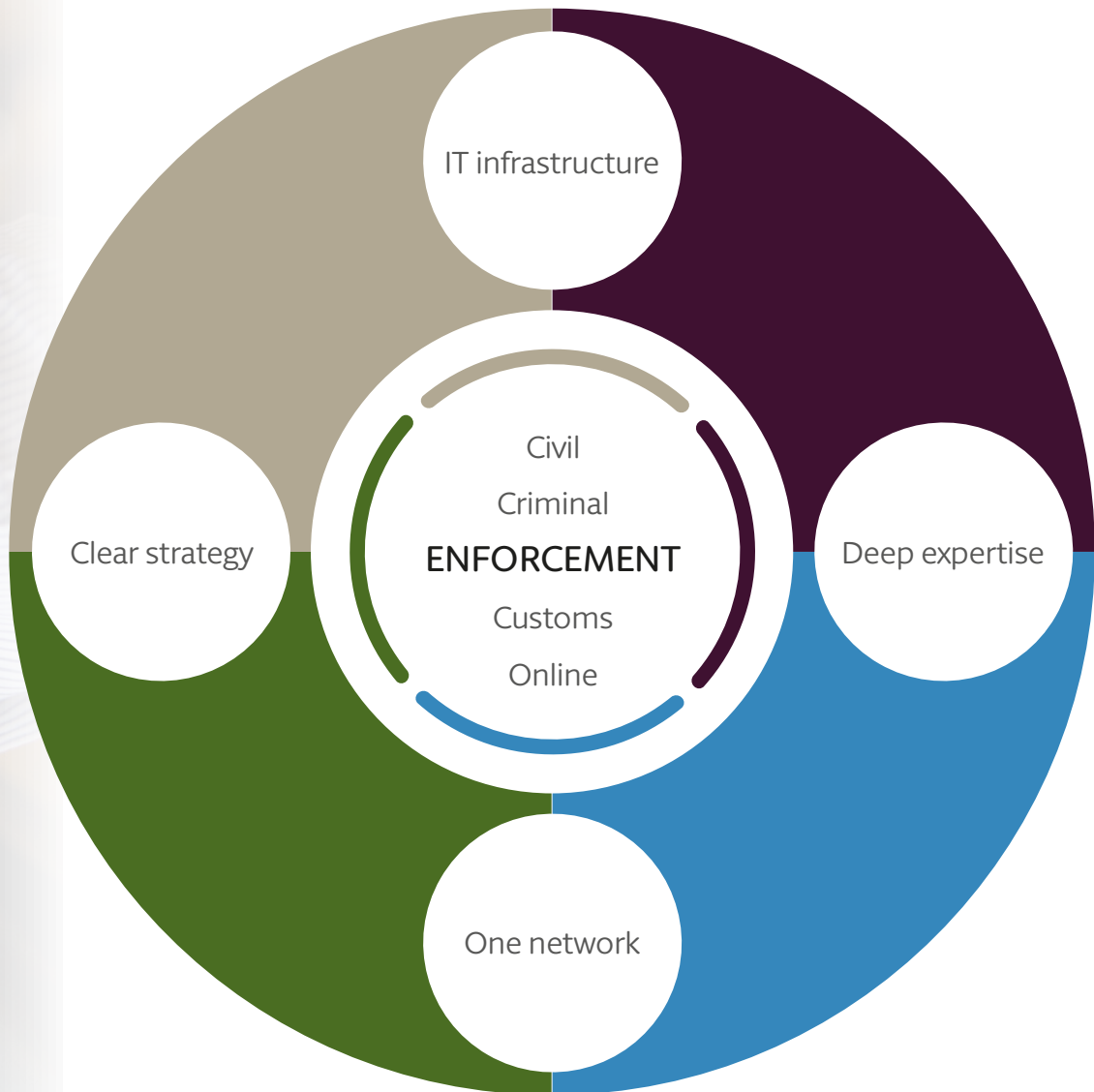
Integrated IP Enforcement

A practical toolkit for Europe

Hogan
Lovells



Integrated IP enforcement





Clear strategy

Our *Integrated IP Enforcement* strategy ensures clearly defined infringement tolerance levels. It pins down the specific IP right(s) at issue, gathers and processes infringement information comprehensively. The resulting action plan is tuned to the IP owner's budget and evaluates all available venues and procedures.



Civil enforcement

Today's global trade environment complicates efficient action in one jurisdiction. Our *Integrated IP Enforcement* strategy develops the harmonized European approach to civil action with a focus on planning pre-action correspondence, choice of venue, conducting proceedings and enforcement of judgments.



IT infrastructure

Our *Integrated IP Enforcement* strategy makes use of the most advanced information technology. Technology plays a role in practically every aspect of IP enforcement, but we focus strongly on data and evidence collection, processing workflows and transparency for IP owners.



Criminal enforcement

Criminal laws provide a number of unique tools to track down and punish IP infringers. Our *Integrated IP Enforcement* strategy implements these tools with emphasis on good relations with prosecutors, making the most of evidence reviews, tracing assets, organizing affected parties and connecting with authorities across borders.



One expert network

Our *Integrated IP Enforcement* strategy assesses the pros and cons of each procedure in each country in a transparent and comparable way. This comes about through our advice, our approach and our action being 100 percent aligned and consistent with one-another. Our teams know each other well and have deep experience of working together.



Customs enforcement

EU common procedure means efficient customs action against counterfeits crossing its outer borders and regular disclosure of information. Consequently, customs enforcement is a key element of our *Integrated IP Enforcement* strategy. We take an active role in cooperating with customs authorities in the EU as well as employing state of the art technology to map infringement hotspots and trends.



Online enforcement

Our *Integrated IP Enforcement* strategy leverages the Internet's full potential to fight the spectrum of violations on this global marketplace. We work to create a balance between pushing infringement below a defined threshold, managing budgets efficiently and avoiding the negative effects of an overly aggressive stance.



National enforcement

Our *Integrated IP Enforcement* team is at home in all major jurisdictions. We know the legal intricacies of each country inside out. We know what it means to evaluate the risks and chances of success in each jurisdiction in a consistent and cohesive manner. On the back of many years of experience working as a team, we can tell IP owners where and how to proceed in any given case.

What's the challenge?

Owners of well-known brands and products are confronted with many different types of infringements.

Trademarks are affected just as trade dress, designs and copyrights – and sometimes even patents. Infringements are not confined to any specific industry either. Typical examples include:

- Fake or gray market pharmaceuticals – offered on countless illegal websites or the backrooms of small pharmacies.
- Unauthorized compatibles for consumer electronics, such as batteries for smartphones or notebooks – for sale on electronic markets as well as through wholesale.
- Misuse of brands for financial, Internet or other business services – exploited via comparative advertising and other forms of unauthorized promotions.

Whatever the infringement scenario, EFFICIENCY and EFFECTIVENESS are the key elements behind any meaningful enforcement activity.

How the best possible results can be achieved with the least possible investment of corporate time and money is predetermined by a few vital decisions:

- Which infringements are worth pursuing?
- Where is the best place to take action?
- What is the best enforcement procedure: out-of-court, civil, criminal, customs or online enforcement?
- Is the information up-to-date or is further evidence required?
- Are multiple procedures aligned and do they fit into the overall strategy?

Integrated IP Enforcement responds to these questions: It provides a system to take the most appropriate action at the most attractive venue, offering the best outcome with the least risk and effort. That sounds easier than it actually is. Taking the right action at the right venue only works if the pros and cons of each procedure in each country can be assessed in a transparent and comparable way. Such an assessment comes about through our advice, our approach and our action being 100% aligned and consistent with one-another. Our teams in all relevant places and for all relevant procedures know each other well and share long standing experience of joint action and work for the benefit of IP owners. Our Integrated IP Enforcement approach is that safe pair of hands developed to steer IP owners through the many pitfalls, intricacies and hurdles to efficiency that exist in the landscape of IP enforcement in Europe.

Team spotlight



Leopold von Gerlach

Hamburg and Frankfurt
leopold.vongerlach@hoganlovells.com

With more than 20 years' experience in IP litigation, Leo leads the enforcement and anti-counterfeiting strategy for major pharmaceuticals, technology and consumer goods companies. His clients benefit greatly from his Integrated IP Enforcement work.



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The right strategy

The necessary starting point for efficient and effective enforcement work is a well-considered strategy:

Any action that is not fully aligned with the strategic priorities of the IP owner will be a waste of time and resources. Any action that does not follow the guidelines for the protection of a given trademark, trade dress or design is not worth the effort.

A strong enforcement strategy must address the following points:

- **The specific IP right at issue.** The trademark, the design, the copyright, must be clearly defined and enforceable. For instance, what if a relevant trademark is not in use for the relevant goods or services of its specification? In such a case, we might consider granting licenses for its use to suitable third parties. Likewise, a trademark or design protection may be extended to certain deviations to cover a bigger scope of protection.
- **Clear information about infringements.** As groundwork, IP owners must have a good understanding of the overall landscape of infringements, including any recurring patterns, the companies and persons involved and the typical channels of distribution, before considering a specific action plan. In many cases, it will make sense to divide infringing activities into three or more categories of descending priorities.
- **Comprehensive information gathering.** IP owners must unlock and utilize all sources for obtaining information on- and offline. These sources must be clearly defined. Reliable, comprehensive and up-to-date information is the foundation of any successful enforcement program.
- **Guidelines for identifying infringing forms of use.** Do we have clearly defined boundaries for our enforcement efforts? While it is not easy to provide answers to every potential form of infringement in advance, we need some idea of what we can and cannot tolerate. This means

agreeing on a set of guidelines by which we can identify infringing forms of use and single out any acceptable uses, such as descriptive references to a trademark. IP owners may find it useful to publish a version of these guidelines in the rights related section of their own websites or on any other public site dedicated to the protection of corporate IP rights.

- **The available budget.** The budget will need to be aligned with the specific Integrated IP Enforcement action plan. This requires a good understanding of the cost of each different type of infringement action and their value for the overall strategy. Clearly, one of the most important aspects of the strategy is to make the most out of the budget that an IP owner allocates to the protection of its rights.
- **The action plan.** All available procedures at all venues should be taken into account before devising a budget-aligned action plan for enforcement. Integrated IP Enforcement is – in essence – a toolkit that helps determine the best action at the most suitable venue. The action plan implementing the enforcement strategy is the game board for all our Integrated IP Enforcement work.

Team spotlight



Marie-Aimée de Dampierre

Paris

marieaimée.dedampierre@hoganlovells.com

Marie-Aimée has advised various international organizations, principally in the field of trademark law, copyright law, design law and unfair competition. She has represented a broad range of organizations, including furniture designers, fashion houses, motion picture producers and many more.

IT solutions

No enforcement strategy would be fully functional if it did not make use of the most advanced information technology. While technology practically plays a role in every aspect of enforcement work, the main focus should be on the following areas:

- **Collecting data and evidence about infringements.**

The key to efficient data collection is to determine a set of search algorithms that combine specific keywords and allow us to utilize the full potential of search engines – general Internet search engines as well as search engines on individual platforms and sites.

Searching techniques are less of a dark art than many professional search institutes and organizations want us to believe. The essence of any successful search program is to have the right keywords in place and to improve keyword combinations as our knowledge of the available data and data sources broadens.

- **Data processing.** As a second step, all infringement-relevant information should be entered into a database and classified according to certain categories of infringement types, infringers, infringing patterns and/or locations.

It is not so relevant to pick and choose a very specific database program but to have a good concept of how to analyze and categorize the information obtained. Essentially, this requires a sound understanding of each

IP owner's individual enforcement priorities and should closely follow the established guidelines for identifying infringements and the action plan we have built on those guidelines.

- **The workflows.** All enforcement procedures – whether customs, civil, criminal or cyber enforcement procedures – should follow a specific workflow. Deadlines must be notified reliably and communication must be triggered in response to certain events or occurrences. Any software that determines these workflows must be customized to encompass all steps that need to be observed in a given procedure. To manage these procedures as efficiently and effectively as possible, our Integrated IP Enforcement work relies on Inprotech® software that has been uniquely customized for this purpose. Based on our experience with a variety of workflows tailored to the needs of each individual IP owner in turn, we are also in a position to advise IP owners on customizing their own systems if needed.

Team spotlight



Natalia Gulyaeva

Moscow

natalia.gulyaeva@hoganlovells.com

Natalia is recognized as a leading IP specialist in Russia. She works on all aspects of contentious and non-contentious work including IP dispute resolution, portfolio management and strategic counseling. Natalia won the Europe Women in Business Law Award 2015 – Best in trade mark (LMG Euromoney) and IP – Patents award for Russia 2016 Client Choice Awards (ILO and Lexology).

- **Client interface.** Upon request from our clients, we provide IP owners with the option to access their own data and our data held on our system – via our proprietary Mercuriam® software interface. Such a client interface will typically be established in the context of a more comprehensive cooperation in enforcement matters.

On the basis of the right strategy and a sound IT infrastructure, Integrated IP Enforcement gives IP owners a toolkit for choosing the most appropriate action in every case. The following chapters provide an overview of the different types of actions and venues – and how they should be combined:

1. Online enforcement
2. Civil enforcement
3. Criminal enforcement
4. Customs enforcement
5. National enforcement peculiarities.

Team spotlight



Constanze Schulte

Madrid

constanze.schulte@hoganlovells.com

Constanze has vast experience with handling international trademark and geographical indications (GI) law, having advised a range of major international corporations in trademark and GI matters in Spain and abroad.

Online enforcement

Brand bidding, hi-jacking of advertisements, domain grabbing, infringing apps as well as all sorts of illegal offerings are typical phenomena of the Internet as a global marketplace. IP owners who want to leverage the Internet's full potential must find a way to keep those violations under control. As it will never be possible to completely eliminate every single IP misuse on the Internet, the real challenge of online enforcement is to reconcile the following three, sometimes conflicting aims:

1. to push the level of infringements below a certain, acceptable threshold;
2. to manage the enforcement budget efficiently; and
3. to avoid creating negative repercussions among retailers or customers as a result of overly aggressive enforcement measures.

Online intelligence

The reconciliation of these three aims requires comprehensive, up-to-date and well-considered information about all infringing activities – to what extent, on which sites, by whom and in what way are one's IP rights infringed online? Online intelligence for IP enforcement work is at least as important as it is for any targeted advertising online. We are experts in such intelligent data retrieval. We cover every step of the way, making the most of the information that is out there. Our services comprise:

- **Algorithm based searches on streaming, auction or vending platforms.** On the basis of well selected keyword combinations and automated search patterns, we screen a huge number of websites to track down infringing listings. Depending on the IP right at issue, this process may produce large amounts of “hits”. All tracked hits are entered into a database and categorized in accordance with predefined priorities.
- **App store reviews.** We regularly review all relevant app stores to determine which apps may have an infringing name, logo or content. Typically, this screening process reveals only occasional infringements. Reporting should therefore be on an individual case-by-case basis.
- **Search engine monitoring.** The use of other companies' brand names as keywords (“brand bidding”) has become a widespread phenomenon. Due to the extensive case law of the Court of Justice of the European Union, it is not always easy to figure out whether a specific keyword-triggered advertisement is infringing or not. Any meaningful monitoring of search engines must therefore proceed on a case-by-case basis – and be handled by someone with a sound knowledge of the legal framework for keyword advertising.
- **Ad hi-jacking and screen scraping.** We review competitors' websites – and also those of cooperation partners – to find out whether they employ technologies to misappropriate IP owners' website content. Again, since the scraping of third party website content is not necessarily unlawful, a good knowledge of the case law in each jurisdiction is key to identifying and addressing infringements.
- **Domain name monitoring.** Whether existing or new top level domains or second level domains are affected, we conduct automated searches for domain name misappropriation. We catalogue and categorize all hits – and their numbers may be vast – in our infringement database and prepare concise reports for easy reference.

Team spotlight



David Taylor

Paris
david.taylor@hoganlovells.com

David provides strategic advice to over 50 clients (from the U.S., Japan, China, Germany, UK, Ireland and France) on their global online strategy, portfolio management, domain name enforcement and applications in ICANN's new gTLD program.

Online tools

DMCA enabled take-downs and domain recovery proceedings are just two examples of enforcement procedures that exist only in the online world.

We make comprehensive use of these standardized procedures and combine them with traditional civil and criminal actions in a highly integrated manner. Intelligent online enforcement can easily make or break the efficiency of an IP enforcement strategy.

A few typical examples may illustrate how this works in practice in favor of IP owners:

- **Notice & Take-down procedures.** Most of the established streaming, hosting, auction and vending platforms provide for an automated notice and take-down procedure allowing IP owners to report infringements and request the removal of the infringing content. The attraction of this uncomplicated process is further enhanced by the consolidation of online markets: the most successful platforms in each country will attract an increasing number of offers while the traffic on all other websites may typically decrease. IP owners can therefore easily focus their enforcement efforts on those websites that are most relevant.

Given the streamlined electronic communication process with platform operators, take-down requests can be executed from a single point of control for multiple countries. Enforcement for large parts of Europe or even for all European countries can be efficiently managed by a few members of our team.

Internet Service Providers and/or Payment Providers.

There is a reason why some offers shy away from the established vending platforms and instead appear on obscure websites. Frequently, they are highly illegal, e.g. offers for counterfeit pharmaceuticals or fake foodstuffs. In these cases, notice and take-down procedures will not be available or make much sense. Civil or criminal action may sometimes be difficult to fight due to a lack of proper venue or the perpetrators' identity being masked.

In order to make progress in such cases, the best option may be to cooperate closely with Internet Service Providers and Payment Providers. A good working relationship with the major providers will often be the key to obtaining crucial information about individuals operating an illegal website or receiving funds from fraudulent transactions. Such a high level of trust and cooperation with service providers needs to be built up over time and well maintained. For the benefit of IP owners, we have forged these relationships over a long time.

Team spotlight



Anthonia Ghalamkarizadeh

Hamburg
anthonia.ghalamkarizadeh@hoganlovells.com

A passionate IP litigator, Anthonia manages Mozilla's global trademark enforcement. She has particular expertise in international online enforcement cases.

Domain name recovery procedures. With many new top level domains and a vast number of country and subject domains, the landscape of domain names has become extremely fragmented. To the same extent, the potential for domain name infringements such as cybersquatting, domaining and fraudulent landing pages is continuously on the rise. Any enforcement program seeking to stay on top of these global developments requires a profound understanding of domain name mechanisms and case-law. A long-standing experience with the relevant national and international remedies, such as UDRP proceedings, US ACPA lawsuits or German DENIC dispute proceedings is also beneficial.

With our award-winning Anchovy® Global Online Brand Protection Service, we take care of IP owners' domains through: Availability and registrant searches, our Name Tracker infringement monitoring, customized backorders through our Snapper Service, and all national and uniform domain name recovery proceedings. We can also manage an IP owner's global portfolio for them and give them access to our Anchovy® interface.

Team spotlight



Charlie Winckworth

London

charlie.winckworth@hoganlovells.com

Charlie is widely recognized as a leader in the online sphere. Chambers notes that 'clients appreciate his extensive knowledge of trademark law and the role of IP in an online environment'.

Civil enforcement

In our times of global trade and possibilities, it is much harder to strike efficiently in one jurisdiction only.

While civil enforcement in Europe is harmonized to a certain extent, the timing, process and cost of civil actions still vary from country to country. Yet in any country, the typical sequence of civil enforcement steps can be condensed into three steps: (1) Pre-action correspondence, (2) choice of venue and type of proceedings, and (3) Enforcing judgments and other court decisions once they have been obtained. Strategically planning the sequence of these three steps across borders is the core of any successful civil enforcement strategy.



Pre-trial correspondence:

Send a warning letter or take them unawares?

Cease and desist letters make a lot of sense in many cases. The types of infringers and infringements that can effectively be contained with a letter come from a broad spectrum:

- **The sophisticated opponent:** If the infringer is a sophisticated market player, perhaps even a direct competitor, from whom one can expect a sensible response, chances are that we will be able to reach an amicable solution. An overly forceful approach might even harm an IP owner's PR under such circumstances – word spreads quickly in industry circles if an IP owner is seen as being unduly aggressive and overbearing in its enforcement.
- **The small scale infringer:** If the infringement is one of many that occur typically and frequently, a cease and desist letter will also make a lot of sense, for entirely different reasons. Consider a toy manufacturer whose iconic trademarked products are frequently resold as loose parts, or in customized versions. Or think of the successful Internet company that is particularly vulnerable to domain name abuse. We can typically address these types of small scale infringements efficiently through standardized letters. And we can collect cease and desist undertakings that will lend additional force to future enforcement measures in comparable cases.

- **The elusive online fraudster:** We often achieve good results with aggressive cease and desist letters where the infringement is committed online and on a small scale, the infringer is of unknown identity and location, but where we have at least an email address to work with. These infringers will often be prepared to drop the infringement and move elsewhere. We won't get a cease and desist undertaking from them, but we will often get fast results. We may also have to chase the same infringer several times across changing websites, but such insistence typically pays off. The online community learns fast and once the right owner has established a reputation as a relentless IP enforcer, infringers quite often move to different targets.

There will be other situations, however, where it is not advisable to send a letter. If we are dealing with an aggressive opponent, typically a competitor, we might prefer immediate court action to avoid counter-measures. This will be particularly advisable if we are reckoning with a torpedo declaratory action that an opponent might file in a slow jurisdiction, or if we don't want to leave them time to consider a counter-strike. Depending on the overall circumstances it may also not be a good idea to send out cease and desist letters if the IP owner is not prepared to follow up. Half-hearted enforcement tends to backfire and dilute any good enforcement strategy.



Venue and motions

The cease and desist letter hasn't had the desired response, and we are now considering litigation.

Where to go, and which motions to file, should be aligned to one overarching rule: the most efficient route to effective enforcement. Sounds obvious? Let's take a look at some considerations we will typically want to include in our litigation strategy:

- **Which countries are possible venues?** Consider all jurisdictions that are affected by the infringement and where we may have a forum for civil claims. The most important points of contact will be where the defendant is domiciled (jurisdiction under Art. 4 of the Brussels I Regulation (EU) 1215/2012), from where an infringing act was committed and where the infringement had its damaging effects (jurisdiction under Art. 7 (2) Brussels I).
- **Which venue is most attractive?** The attraction of a venue is strongly influenced by the experience and the efficiency of the courts as well as by the ease of post-trial enforcement. There is a big incentive to go to court in the country where the defendant is domiciled, or where its assets are located. Even under Brussels I with its general EU-wide recognition and enforcement rules, it will generally be easier if litigation and subsequent enforcement measures stay within the same jurisdiction. That said, there can be exceptions to the enforcement-efficiency rule of thumb. Imagine, for instance, seeking an EU-wide trademark injunction against an infringer based outside the EU. In such a case we may choose to go to court in the EU market where we expect to achieve the most favorable ruling on the scope of a well-known brand under Art. 97 (2) of the EU Trade Mark Regulation. Where the enforcement jurisdiction is known to be particularly slow, we may also want to seek out another venue. Another exceptional scenario may be where the enforcement jurisdiction is known to be a particularly costly litigation venue.

- **How many proceedings?** Whether we bundle all of an IP owner's claims in one action or bring multiple proceedings in different jurisdictions will depend on the above venue considerations. It will also depend on the number of defendants, on the IP owner's budget, and on specific strategic considerations. For instance, exerting maximum pressure and generating big PR may be more important goals than cost efficiency. Bear in mind that multiple defendants can be sued jointly at any one of their domiciles if the claims are sufficiently closely connected. Also bear in mind not to jeopardize the litigation by bringing parallel proceedings about the same cause of action or related actions that will lead to a stay of proceedings or declining of jurisdiction under Art. 29 ff Brussels I.

Team spotlight



Burkhardt Goebel

Madrid and Hamburg
burkhart.goebel@hoganlovells.com

Burkhardt's work covers many complex and high profile trademark matters. He is currently representing one of the world's biggest financial institutions in a major trademark dispute concerning color marks, before the Court of Justice of the European Union.

- **Which type of proceedings?** The answer depends on the specific enforcement goals. The following overview illustrates the typical lines of attack under civil law. We may combine any of the below with criminal, online and customs enforcement options which are additional components of our Integrated IP Enforcement approach.
- **Injunctive relief:** We have been able to obtain all information relevant for identifying the infringers as well as the essential facts establishing the infringement. Now we can serve a preliminary injunction order or a main action statement of claims. If the location of the infringers is still uncertain, check whether there is access to a jurisdiction that allows public service of court documents in such cases.
- **Preliminary injunctions:** These proceedings have many advantages. They are fast and cost efficient and sometimes even ex-parte. They can also be a very useful testing ground. In some jurisdictions, we can withdraw a PI application if the decision should not go our way. One caveat to bear in mind: how much, or little, time we have for filing a preliminary injunction application varies between the EU jurisdictions.
- **Damages:** We have stopped the infringement, and now seek to recover damages. At this stage, choosing the right forum is key. If the infringement spans several jurisdictions, bear in mind that under the Brussels I Regulation, IP owners can generally recover collective damages only at the place where the defendant is domiciled, or from where the infringement originated (Art. 4 and Art. 7 para 2 Brussels I). The alternative forum for tortious acts, where the damages occurred, will only provide jurisdiction for damages occurred within that member state.
- **Obtaining information:** From the infringer, we will typically want to know how much money was made by the misuse of the contested IP right, where infringing goods came from and to whom they were distributed. Where a third party is holding information, we will often get far with friendly correspondence. Should that fail, harmonized IP laws in the EU member states grant information rights over a party that possessed an infringing item, over a telecoms company to disclose an IP address, and in other typical scenarios involving non-infringing third parties.

Team spotlight



Luigi Mansani

Milan

luigi.mansani@hoganlovells.com

Branded as 'simply excellent' by World Trademark Review, Luigi successfully assisted his long standing client, PepsiCo in a dispute regarding their well-known chips brand in Italy.

Squaring accounts:

Enforcement of damages and other titles

Once we hold a title in our hand, the enforcement chase begins:

- **Asset tracing:** We provide guidance on asset tracing in our chapter on criminal enforcement. Beyond targeting the infringer, we look at their immediate environment. Assets may have been moved to family, friends or other legal entities. If ownership has passed, we may have to challenge these transactions.
- **Effective asset recovery:** Once we know what is available, we need to act swiftly. When an infringer is busted, there will often be other injured parties trying to get their hands on the money. In this context, it is vital that we file claims with as high a rank as possible in the list of creditors. The most valuable assets will typically be bank accounts and real estate, so it makes sense to prioritize these.
- **EU-wide enforcement:** Under Art. 36 ff. Brussels I, we can have a title recognized and enforced in any EU member state. The reasons for which a member state can refuse to do so are very limited. The most important obstacle an IP owner needs to bear in mind in this context is Art. 45 (1) (a): An opponent must have had due process and a fair hearing.

Team spotlight



Andreas Bothe

Hamburg
andreas.bothe@hoganlovells.com

Andreas has been heavily involved with the “Trial of the century” between the corresponding pharmaceutical companies over the use of the name “Merck”.

Criminal enforcement



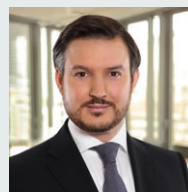
The benefits of criminal enforcement

Many IP infringements are committed on purpose and with the intention to generate a profit. In these cases, the infringement may also be subject to criminal charges – just as any ordinary fraud or theft would be.

Compared to other enforcement measures, the criminal laws of most countries provide for a number of unique tools to track down and punish IP infringers. These tools include:

- **Finding facts and gathering evidence:** It is not unusual to be aware of an infringement but to not know the perpetrator or those who pull the strings in the background. The same applies if private individuals are being used as “human vehicles” for trafficking counterfeit goods. The advantages of relying on the assistance of the police and public prosecutors for the investigations are obvious. They can take action – **examining suspects and witnesses, performing raids and seizures** – which would not be readily available through other means of enforcement.
- **Cost-effectiveness:** To initiate criminal proceedings, we simply need to file a criminal complaint. Public prosecutors and the police will investigate the case on our behalf – always depending on how determined they are and how strongly we encourage them. This will keep costs down for the IP owner and provides access to enforcement measures that would otherwise not be available.
- **Fast and aggressive interventions required:** There are situations of imminent danger for an IP owner’s corporate assets or the safety of its customers. For example, counterfeit spare parts such as car brakes are offered at a trade fair and we need to find the actual productions site. In such cases, criminal enforcement will be part of a strategy that may deliver immediate results – **raids and seizures often can be carried out within hours after filing the initial criminal complaint.**
- **Deterring effect:** Sanctions offered by criminal law go beyond the scope accessible in civil proceedings. That applies in particular to the possibility of imprisonment or any type of asset freezing. In general, the deterring effect of a criminal judgment, and the pressure this exerts on infringers, should not be underestimated. As a consequence, well communicated and consistently employed criminal enforcement measures **send a strong deterring message to the market and to individual infringers. They increase the chances that fraudsters will look for other, easier targets.**

Team spotlight



Fabian Pfuhl

Frankfurt
fabian.pfuhl@hoganlovells.com

Fabian defends his clients against any form of product piracy. In a long-standing client relationship he represents one of the world’s biggest pharmaceutical companies, counseling them in a multitude of anti-counterfeiting cases.

Bases to cover

In order to achieve the best possible results with criminal enforcement measures, there are some aspects that deserve particular attention:

- **Know the prosecutors:** An essential part of successful criminal enforcement is building a strong network with the responsible investigation and prosecution authorities. In almost all European countries, special enforcement units exist for certain aspects of IP infringements such as for IT, pharmaceuticals or foodstuff related crimes. Maintaining a good working relationship with the police forces and public prosecutors of these specialized units is a key factor in making criminal enforcement effective for IP owners.

Furthermore, our experience shows that continuous contact with the relevant authorities leads to mutual support for both sides: while the authorities benefit from our IP-, industry- and case-related knowledge for their investigative work, IP owners benefit from their additional investigations.

- **Examine the case:** IP owners affected by criminal activities hold far-reaching rights to influence and participate in ongoing investigations. The right to review the evidence on file is of particular importance.

Reviewing the evidence on file is a good way to learn more about the perpetrators behind an IP infringement and the relevant facts of a case. The key task during the review of criminal files is to not get lost in a myriad of criminological details but rather to extract only the specific information needed for the enforcement. In a perfect setting, the facts and evidence obtained by the prosecution provide the IP right owner with all the information needed to **initiate further enforcement measures**, such as a civil damages action.

- **Trace relevant assets:** Criminal investigations may also bring additional insight into the financial situation of the infringer, including the whereabouts of their money and other assets.

In addition to tracing ill-gotten assets, the prosecution has the option to freeze accounts, seize cash or impose selling restrictions on real estate. These measures can be extremely helpful in **decreasing the risk of infringers making their assets disappear**.

- **Organize potential partners:** Whenever IP owners are confronted with organized crime, other companies will often be affected by the same activities.

More than in any other proceedings, **criminal enforcement allows for synergies among various affected parties** – a coordinated filing of criminal complaints will often enhance the speed and the outcome of the authorities' criminal investigations. Acting as joint plaintiffs in criminal trials will typically lead to a more severe punishment for infringers.

Team spotlight



Yvonne Draheim
Hamburg
yvonne.draheim@hoganlovells.com

Legal 500 names Yvonne a 'solution- orientated lawyer who has a profound knowledge', with regard to Trademark and unfair competition work.

Manage the reach: IP-related crimes are mostly multi-country crimes. It is therefore not unusual that criminal enforcement authorities in different countries work on the same case but investigators in each country may not be aware of the other ongoing investigations. Even if there is awareness, proceedings in different countries are rarely well coordinated.

In all multi-country investigations, IP owners should act as facilitator and joint contact point for the national authorities. To achieve the best results, **we need to help the prosecution authorities to see the full picture of the case they are investigating.** It is therefore essential to guide and coordinate their work and particularly to bring the right people together and to keep key investigators updated on relevant case developments.



Customs enforcement

Fake products are typically manufactured in one country, shipped to distribution hubs in others and sold in further countries; thereby profiting from low production costs in one part of the world and high sales prices in others. Whenever a shipment crosses borders, customs can check the goods to be cleared. Upon request, such checks can include an assessment of possible IP right infringements and prevent infringing products from entering the market.

In the European Union, a common procedure allows for efficient customs action against counterfeit products crossing the outer borders of the European Union which currently includes 28 member states.

The underlying law also provides for regular disclosure of information on infringements and infringers. Consequently, customs enforcement is a key element of the Integrated IP Enforcement strategy.



Customs alert:

Recording a customs monitoring application

To trigger customs action, the right owner needs to submit an application form to the national customs authorities of any one EU member state of their choice. Once the customs authorities of this state have approved the application, they will inform their national counterparts in all EU member states covered by the application. Recording a customs monitoring application with authorities within the European Union is free of charge. Recordal will be made for an initial term of 12 months with the possibility of consecutive renewals.

The application for customs monitoring must comprise the following information:

- **Identity and role of the applicant:** Not only right holders but also third parties and, in particular, licensees qualify (with possible limitations depending on the scope of the license).
- **IP rights covered:** Harmonized European IP rights such as EU trademarks and designs allow for fully harmonized customs action and accounted for more than 97% of all actions taken by the European customs in 2014. In addition, national customs applications on a European or national law basis may serve to enforce copyrights or patents – or any other national IP right.
- **EU member states covered:** The right holder can request action in one, several or all EU member states with one and the same application and therefore cover up to 28 European states at once.

- **Information on how to distinguish genuine and counterfeit goods:** High-quality supplementary information is key for running a successful customs monitoring program. This information must reflect the requirements of the national head office approving the application as well as the needs of the customs officers on the ground in all countries covered. Based on many years of cooperation with the customs authorities across the EU, we know what is required, what works and what doesn't.

Once approved, knowledge about the application must be spread among the officers clearing shipments on the ground. This is why we set up tailor-made training events with customs. We instruct key officers at the entrance gates into the European Union for the specific products at issue and explain how to identify suspicious shipments. In the course of our everyday communications with customs, we then refine and update this knowledge for the officers on the ground.

“When it comes to cross-border cases and litigation they take up most complex and serious cases.”

Chambers Global, 2018

Customs action:

Processing of Detentions

If a customs monitoring application is recorded, the customs authorities will carry out random inspections and will stop suspicious shipments. Suspicious features may include the origin of the shipment (from a destination never used by the right holder for genuine products), the particular assortment of components (the specification of which would be unusual for genuine products) or a suspicious address indicated as the sender, the importer or the recipient.

The current basic procedure to be followed is also harmonized:

- **Notification:** Customs will notify the right holder and recipient about the detention of the shipment. With that notification, the right holder will be informed about the type and quantity of products detained. Upon request, the right holder will also receive pictures or samples of the products for inspection and usually also information about the sender and recipient of the shipment.
- **Verification:** After receipt of a notification, swift action is necessary. The right holder needs to verify within an initial deadline of only 10 working days whether the detained shipment contains counterfeit products or not.
- **Confirmation:** If confirmed to be counterfeit, the detained products can be destroyed, provided the right holder confirms the infringement in time, consents to destruction of the products and the recipient does not oppose. In the vast majority of cases destruction of counterfeits can therefore be achieved prior to the products entering the European market without the need to conduct court proceedings.

- **Opposition:** In the rare case that the importer opposes destruction in time, the right holder needs to overcome the opposition within the deadline of 10 working days which can be extended for a maximum of 10 further working days upon reasoned request. If the recipient cannot be persuaded to withdraw the opposition, this may ultimately require commencing infringement proceedings to prevent the release and entry of counterfeits into the market. In individual EU member states, different types of proceedings will qualify as infringement proceedings and different attitudes exist towards granting an extension of the deadline of 10 working days.

It is key to employ state of the art technology when handling customs work. Smart use of technology speeds up communication and facilitates the storage, collection and analysis of infringement data. To this end, we at Hogan Lovells employ our customized Inprotech® IT system. On the basis of comprehensive data, we identify counterfeit hotspots and key players, infringement patterns and shifts of activity. That information is fed back into our Integrated IP Enforcement strategy and allows us to precisely identify targets of further enforcement activity under criminal law, civil law and online enforcement action. As a result, we are able to employ the different IP Enforcement tools most efficiently.

Enforcement and prosecution

Having the correct IP rights to rely on is crucial to successful Integrated IP Enforcement. A strong enforcement strategy involves having clearly defined, enforceable rights, or at least knowing the limitations of the rights that you have.



A smart trademark and design portfolio takes into account a wide range of different factors for each brand, including:

- the **speed** with which enforcement is needed and the anticipated **type of infringer** – for example, for new products which are expected to be short-lived or copied by unsophisticated infringers, design rights are often sufficient, especially for the purposes of internet take-downs, allowing quick registration at minimal cost. By contrast, established brands will typically benefit significantly from the enhanced scope of protection offered under the trademark law of dilution, enabling enforcement against use on dissimilar goods and services;
- the ability to **protect the get-up** of a product beyond its brand name – often the look and feel is what is copied by infringers: color, for example, is the element which is most copied by lookalike products and the element which first draws consumers’ attention in respect of everyday products. Whilst color trademarks are very hard to register in the EU without evidence of acquired distinctiveness, often color can be strategically protected as part of figurative trademarks or by way of designs when a product is first launched;
- the **geographical scope** of the actual or intended use
 - EU trade marks and Community designs obtained via the EU Intellectual Property Office in Alicante, Spain allow brand owners to easily expand use beyond their first market in the EU to other parts of Europe and also seek EU-wide trademark injunctions against infringers. However, they won’t always be appropriate, especially for local language marks or non-traditional marks such as shape marks which would require substantial evidence of use and acquired distinctiveness in all 28 EU countries. In such cases, consideration should be given to strategic national filings;
- possible **defensive filings** – for example, filing for part of a brand name (e.g. one word of a two word brand) can give significant protection against third parties, both during the first five years (when trademarks are not subject to use) and later on if the part of the brand is either naturally used in an independent distinctive manner or marketing teams can be convinced to run campaigns to establish such independent use;
- **budget** and value for money – a smart portfolio doesn’t just contain rights for the sake of it. Designs can be bundled together and filed as multiple applications to reduce cost. Trademarks should be filed in all classes in which products are in fact being used, or in which there is a genuine intention to use. Whilst many companies have traditionally had a custom of filing very broadly in all peripheral goods and service classes, that custom is now changing in the EU as legislators are actively taking steps to reduce perceived “cluttering” of trademark registers by moving from multi-class filing and renewal fees to single class filing and renewal fees (resulting in increased costs for trademark owners who file broadly) and the European Courts are increasingly finding that trademark re-filings can constitute bad faith.

Team spotlight



Andreas Renck

Alicante
andreas.renck@hoganlovells.com

Andreas focuses on international trademark portfolio filing and defense strategies, with an emphasis on color, position and sound marks. He has a strong record in dealing with complex and technically difficult prosecution matters.

Having a robust portfolio registered is only the first step towards an optimum *Integrated IP Enforcement Strategy*. To get the most out of their portfolios IP owners should also:

- have an effective **watch service** in place to monitor third party filings. In terms of unsophisticated infringers, this will often be the first way in which infringing use becomes apparent. In terms of major competitors, this often reveals potential new product plans or packaging changes, enabling IP owners to strategically prepare to file interim injunctions once products hit the market.
- actively and consistently write to third parties requesting **limitations** or **withdrawals** or file **oppositions**. By consistently keeping the register “clear”, either by getting appropriate limitations to exclude core goods, total withdrawals or succeeding in oppositions, IP owners deliver a clear message to infringers that they will not tolerate infringements. In our experience the only check made by many infringers prior to proceeding with launching their products or services in the EU is a check of the EU Trade Mark register maintained by the EU Intellectual Property Office. If such a check shows a strong record of action an infringer is much more likely to adopt an alternative brand.
- **bring cancellation** actions in support of enforcement activities. For example, torpedo revocation actions can often be filed before the EU Intellectual Property Office to give additional leverage against third parties in complex enforcement situations.

Meeting Room

Team spotlight



Imogen Fowler

Alicante

imogen.fowler@hoganlovells.com

Clients say Imogen ‘provides extremely commercial advice in a very user-friendly way and, importantly for us, assesses risk based on her excellent knowledge of our industry, similar industries and the current legal landscape.’



National enforcement

Civil and criminal enforcement procedures are governed by the laws of the individual European countries. In addition to the legal differences, national judges and prosecutors do not always apply harmonized European laws in a fully consistent manner. Knowing the full scope of national peculiarities is therefore paramount to finding the best venue for any type of action. Our Integrated IP Enforcement team is at home in all major jurisdictions. We know their intricacies inside out. We know what it means to evaluate the risks and chances of success in each jurisdiction in a consistent and cohesive manner. On the back of many years of experience working as a team, we can tell IP owners where and how to proceed in any given case.

Some of the most typical particularities of individual European jurisdictions are set out in the following chapters.

An aerial photograph of Paris, France, taken during the 'golden hour' of sunset. The Eiffel Tower stands prominently in the center of the frame, its dark silhouette contrasting with the warm, orange and yellow light of the sky. The city's dense urban landscape, characterized by numerous buildings with blue-tiled roofs, stretches out around the tower. In the background, the modern skyscrapers of the La Défense district are visible on the horizon. The overall atmosphere is serene and picturesque.

France

French courts are particularly specialized and concentrated where IP enforcement is concerned – this being just one of the advantages of taking action in this jurisdiction.

- **Concentration of specialized judges:** Only a small percentage of civil courts have jurisdiction to handle IP matters (Bordeaux, Lille, Lyon, Marseille, Nanterre, Nancy, Paris, Rennes and Fort-de-France). These courts are highly specialized. The Paris court is deemed to be the most experienced one and there is a tendency to go to Paris if that is at all possible.
- **Preliminary injunctions:** Preliminary injunctions are granted in straightforward cases, i.e. when the infringement and the validity of the IP rights are not in question. Preliminary injunctions requested on an ex-parte basis, however, are very rarely granted.
- **Collection of evidence of acts of infringement during trade fairs:** As ex-parte injunctions are so rare in France, it is in practice hard to have infringing goods or advertising removed from booths during the course of trade fairs. However, gathering evidence of infringing acts is possible through two types of infringement seizure, both of which are carried out by a bailiff. The first type is with the prior authorization of a judge by means of an ex-parte order and must be carried out by a bailiff in accordance with the terms of the order. The second is without any authorization, in which case the bailiff will only be entitled to take photographs outside of the booth and/or to acknowledge a purchase of infringing goods made by an independent party at the booth.
- **Inadmissibility of screenshots as evidence of an IP infringement:** Screenshots of webpages can be validly used as evidence of acts of IP infringement only if they are made by a bailiff within the frame of a report. Otherwise, they cannot be taken into account by French judges.
- **Efficiency of French customs authorities:** French customs authorities are reliable, easily reachable and always ready and happy to help. Hence, filing an application for customs action on the basis of the provisions of the French Intellectual Property Code in addition to an EU-wide customs application is advisable. French customs are entitled to retain allegedly infringing goods in circumstances other than those provided by the EU regulation No. 608/2013, i.e. not only at the borders of the French territory but also within France (e.g. supermarkets).
- **Moderate amounts of damages and reimbursement of counsel's fees:** Even in cases where French courts acknowledge acts of infringement and the economic and moral prejudice has been extensively demonstrated, French courts do not award high amounts of damages and generally agree to order only the partial reimbursement, by the defendant, of the plaintiff's counsel's fees.

Team spotlight



Olivia Bernardeau-Paupe

Paris

olivia.bernardeau-paupe@hoganlovells.com

Olivia has significant experience with trademarks, industrial designs and models, copyright, unfair competition and parasitism, image and privacy law, press law, consumer law and advertising law.



Germany

Germany is typically seen as an attractive venue for IP enforcement. There are a number of reasons that support this view.

There are also a few pitfalls that IP owners should be aware of. Here are some of the most relevant aspects:

- **High case volumes – profound experience:** Without a doubt, Germany is the European jurisdiction with the highest number of court cases for all IP rights, including trademarks, designs and copyright. As a result, judges are typically very experienced and the outcome of judgments is often predictable.
- **Witnesses and experts are rarely summoned:** Due to the high number of cases, German courts seek to handle each matter extremely efficiently. That means witnesses or experts are hardly ever requested to appear before court. This is a relief for many plaintiffs that may not be entirely sure how a particular witness or expert might perform under examination by the court or the counsel of the opposing side.
- **Ex-parte injunctions:** Perhaps the most distinctive feature of German IP proceedings is that preliminary injunctions are – in the great majority of cases – granted on an ex-parte basis. That means the respondent will not be notified or even heard before the injunction is issued. Respondents who anticipate that an injunction may be in the making, frequently file so-called “protective briefs” with the courts, i.e. briefs containing all arguments in defense against a potential, future application for a preliminary injunction.
- **Raids at trade fairs:** Whether on the basis of a preliminary injunction or by intervention of the police, raids on trade fairs are a standardized procedure. Many trade fairs have a bailiff, a police officer or even a judge on-site in order to deal with and possibly remove any infringing product, advertising or even an entire booth.
- **Strict urgency requirement:** A clear restriction of the otherwise very attractive preliminary injunction proceedings is the strict “urgency requirement”. The motion for a preliminary injunction must be filed within four to six weeks after first knowledge of the infringement. IP owners must therefore move swiftly in order not to lose this option.
- **Relatively moderate amounts of damages:** If the action is for damages, Germany may not be the most attractive venue to litigate trademark or design infringements. Even if a right owner has complied with the fairly strict German requirements for substantiating the amount of damages, it is still not certain whether courts will grant any satisfactory damage award.

Team spotlight



Morten Petersenn

Hamburg

morten.petersenn@hoganlovells.com

Morten led a landmark case that attracted high international interest by reaching the German Supreme Court for the international Hard Rock Cafe group, on the basis of the misleading use of a trade name and logo.



Italy

The IP owner may rely on multiple instruments and strategies in Italy in order to enforce its rights.

Here are our tips:

- **Customs seizure:** Italian Customs are particularly proactive and well-trained and the seizure is carried out in a very short time frame. After the seizure run by Customs, a criminal investigation starts. Through this procedure, the IP owner can obtain pictures of the seized goods as well as details on the name of their importer and exporter.
- **Raids on premises:** When handling raids, Guardia di Finanza (Italian Tax Police) is proactive against IP infringement and is capable of collecting useful information concerning the quantity of counterfeit products, their value and the distribution network through which the products are offered on the Italian market. In addition, Guardia di Finanza works closely with Public Prosecutors to investigate IP infringements during raids.

- **Criminal actions:** Criminal actions are particularly effective since Italian Authorities (Public Prosecutor and Tax Police) are entitled to immediately seize the infringing goods and to collect invoices and other financial data of the business run by the infringer. The risk of imprisonment following criminal action in Italy might persuade infringers to stop offering and selling counterfeit. In addition, the costs of the initial investigations are borne by the Italian Authorities, so the right holder does not need to take initial actions at its own expense.
- **Preliminary injunctions:** Bringing preliminary injunction proceedings in Italy is particularly effective where the right holder must react promptly to stop the infringement and is not seeking to be awarded damages. Indeed, even if the injunctions are rarely granted on an ex-parte basis, the proceedings, including the appeal phase, are usually concluded within 3 to 4 months. Also, compared to other EU countries, Italian courts tend to take a softer approach in evaluating the urgency requirement and to grant the injunction in case of inherent violation of the IP right.
- **Search orders:** If the right holder is not in the position to collect evidence of the infringement on the market or needs to obtain samples of an infringing product that is not yet available, Italian law grants the IP holder the right to seek a search order. This allows us to access the premises and plants of the alleged infringer, usually without prior notice. The evidence to search may concern both “commercial” aspects, such as documentation showing that an infringing activity was committed, and technical aspects, such as evidence on the actual features and use of the allegedly infringing product. According to our experience, search orders are easily granted by Italian courts if initial evidence of infringement is lodged by the right holder and the order would serve to gather additional evidence on the infringement.
- **Civil actions:** Ordinary infringement proceedings constitute an effective instrument where the infringement is serious and the right holder needs to take a more aggressive approach to seek a permanent injunction. In Italy, IP litigation is heard by specialized courts, composed of judges experienced in IP matters. That said, the costs of the proceedings are often lower compared to other European countries. Moreover, specialized courts are becoming quicker than in the past in rendering their decision, thus becoming a more appealing venue for foreign right holders. The courts have also recently shown a more generous approach in awarding damages to the right holder.

Team spotlight



Giovanni Ghirardi

Milan

giovanni.ghirardi@hoganlovells.com

Giovanni is praised for his ‘in-depth legal knowledge’ (Legal 500, 2016) for both trademark and patent work. He has extensive experience in litigation involving complex pan-European issues, cross-border measures, declaratory non infringement claims, preliminary injunctions and seizures.



Poland

IP enforcement work is becoming more important in Poland and the number of experienced judges is growing.

There are, however, a number of specific aspects that one should be aware of:

- **Witnesses are frequently summoned:** Under Polish civil procedure, a court should summon a court expert if “special information” is required to rule on the case. This is very often used in patent litigation, but sometimes also in design or copyright cases. In trademark cases, experts are unlikely to be heard.
- **Growing case volumes – increasing experience:** The number of cases is still growing and so is the experience of judges. However, this is far more advanced in cities such as Warsaw or Kraków with their strong academic base and developed market. That said, the outcome of IP cases in smaller towns can still be surprising.
- **Ex-parte injunctions:** As in Germany, preliminary injunctions are, in a great majority of cases, granted on an ex-parte basis. It normally takes about two weeks from the filing of a request until an order on a preliminary injunction is issued. The respondent is not informed about the request for a preliminary injunction and is not given an opportunity to respond. Also, if a preliminary injunction consists of, e.g., the seizure of infringing goods (or in any other action that requires a bailiff’s assistance), the court’s decision would be provided to the infringer by the bailiff along with the seizure. However, the pitfall is that the plaintiff must file the statement of claim and commence the main proceedings within the time specified by the court (a maximum of two weeks) – otherwise the injunction expires.
- **No strict urgency requirement:** There is no “urgency requirement” under Polish law that would oblige a plaintiff to file a statement of claim or, at least, move for an injunction within any specified deadline after the first knowledge of an infringement. On the other hand, the plaintiff should not wait too long as this may provoke the argument of tolerating the infringements that could weaken the plaintiff’s case.
- **Evidence for damages:** The courts are somewhat unwilling to award significant damages unless the amount of the damages actually incurred is very well substantiated. Alternatively, however, plaintiffs can seek compensation in the amounts corresponding to the actual value of the legitimate use of the IP in question (e.g., market license fees), hence it is always advisable that the party seeking compensation gathers all the respective market data on how much the use of their IP is worth.

Team spotlight



Ewa Kacperek

Warsaw
ewa.kacperek@hoganlovells.com

Ewa aided the rebranding process of a global mobile phone operator, in Poland; representing the client in disputes with other telecommunications operators and in particular, challenging matters concerning protection of the single color trademark of the client.

Russia

Russian IP law and practice have developed quickly over the last couple of years.



The codification of IP law, the establishment of a specialized IP court and numerous clarifications of specifics of IP disputes by the Presidium of the IP Court substantially contributed to efficiency of IP dispute resolution in Russia:

- **Fast and moderate:** The proceedings before the Russian courts are very fast. The 2 month timeline is observed for resolution of straightforward cases before the state commercial court of first instance. More complex cases requiring, e.g. expert opinion, last up to 6-8 months. The speed of the proceedings helps to keep costs at quite a moderate level.
- **IP oriented:** IP disputes are considered by the specialized IP Court, which reviews the cases as the court of the first instance (e.g. with respect to IP invalidity actions) and as the court of the second appeal (e.g. with respect to IP infringement actions). The judges of the IP Court are 100 percent focused on IP disputes.
- **Dispersed but connected:** It is notorious that Russia is the world's largest country, covering 11 time zones and 85 regions (sub-sovereign entities). Though the majority of IP cases are heard before the Moscow-based courts, there are still many cases falling within the jurisdiction of the regional courts. Such circumstances were in the past considered as an obstacle to successful infringement claims in regional courts, due to higher costs of the proceedings (e.g. the price of airline ticket Moscow-Vladivostok is often above the price of the ticket Moscow-New York) and uncertainty of the results due to the lack of IP specialized judges in the regions. The recently introduced option for a hearing via a video conference made it possible to consider the dispute from a Moscow-based court and increased the interest of right holders in pursuing cases in the regions.
- **IP owner friendly customs:** Apart from civil action, administrative action may be initiated by customs authorities when counterfeit goods are detected. Recordal of trademarks with customs and prompt reaction to customs notifications is an efficient remedy to prevent copyright and trademark infringement at the stage of import of goods into Russia. The customs officers are well-experienced and knowledgeable in anti-counterfeiting actions. Such actions before the Russian courts are initiated and handled, to a large extent, by the customs authorities and the input required from the right holder's side is fairly limited.
- Don't underestimate the criminal route: Russian law provides for criminal liability for IP infringements. The Russian criminal prosecution authorities are particularly skilled in cases involving copyright and trademark infringements. Criminal action against IP infringement would require proving direct intent and damages incurred (thresholds depend on the type of IP right affected by the infringement). Legal entities are not subject to criminal liability, while, corporate officers, such as CEOs, may be held liable in IP infringement. The latter may be used as a solid argument in pre-trial negotiations with IP infringers.

Team spotlight



Vironika Pilyugina
Moscow
vironika.pilyugina@hoganlovells.com

Vironika mainly focuses on trademark enforcement, litigation and dispute resolution matters as well as trademark portfolio management. She is a registered trademark attorney and listed in Euromoney's Expert Guide to the World's Best Trademark. Lawyers in 2015.



Spain

Over recent years, coupled with the sophistication of the local legal market, the Spanish IP system has slowly become more specialized and efficient, generating an increased sensibility by all enforcing authorities (civil and criminal courts, customs authorities and police):

- **Specialized IP courts:** Since September 2004, commercial courts are competent to hear, on an exclusive basis, all IP-related claims. In the case of the Madrid and the Barcelona commercial courts – where the majority of IP cases are heard – this has caused a certain specialization in IP matters. Of course, the Community Trademark Court, located in Alicante (where the EUIPO is seated), is one of the most knowledgeable IP courts in Spain.
- **Timing:** The specialization of some courts also affected the handling time of the proceedings. It is no longer unusual that a first instance judgment be rendered in Spain within 12 months of filing. Timings have slowed down a bit in recent years since the economic crisis commenced as commercial courts are also competent to hear insolvency proceedings. In general, the Barcelona first instance courts would be quicker than the ones in Madrid whilst handling times in the second instance are rather similar across the courts.

- **The plaintiff's advantage:** The procedural laws in Spain are quite formalistic in different ways. One of the most relevant aspects involves deadlines. Deadlines are short and non-extendable. Whilst this has pros and cons for both plaintiffs and defendants, it certainly puts the defendant in a difficult position at the outset of the case. Under the civil procedural rules the defendant has a non-extendable 20 working-days deadline to submit a defense brief.
- **Preliminary injunction proceedings:** Obtaining an ex-parte injunction is extraordinary –the principle being the requirement for a hearing to be held. The law requires the plaintiff to show a qualified urgency and courts interpret this requirement rather restrictively. Hence, the rule in Spain is that preliminary injunction proceedings are inter partes as well as that the petition is filed with the complaint on the merits. The procedural rules in preliminary injunction proceedings do not provide for a written response by the defendant, hence, in principle, the plaintiff is at a disadvantage, as it attends the hearing with no knowledge of the defense of the other side.
- **Preparation of main action:** The plaintiff and the defendant are expected to file their full case with their initial briefs. Hence, the complaint and defense brief must include all facts and legal grounds as well as the documentary evidence on which they are based. Only exceptionally will the parties be allowed to submit additional documentation to the proceedings. The plaintiff is expected to submit its expert evidence with the complaint whilst the defendant may announce it and file it later. Between 45 and 55 percent of the costs would be incurred at the preparation stage.
- **Limited recovery of legal costs:** The losing party will bear the costs, with some exceptions. That said, the cost recovery and exposure are rather limited in Spain and the winning party will be unlikely to recover 100 percent of the attorneys' costs.
- **Customs:** Spain ranks fifth in number of customs seizures based on IP rights in the European Union. The customs authorities are committed and very keen to collaborate with IP owners.
- **Criminal justice:** criminal proceedings are effective and less costly in the short-run –suitable for quick seizures- but not so in the long run. The investigation phase of the proceedings may take several years. In addition, criminal courts have traditionally maintained a rather restrictive interpretation of the requirements of IP offenses which has made it difficult to obtain a court decision.

Team spotlight



Ana Castedo

Madrid
ana.castedo@hoganlovells.com

Ana has extensive experience litigating patents, trademarks and copyrights. According to Chambers, clients draw attention to Ana's "quick response, deep technical knowledge and involvement in the matters that we entrust to her."



The Netherlands

The Netherlands has a long-established history in the field of IP enforcement and it is seen as an attractive venue.

There are a number of benefits in litigating before the Dutch courts:

- **Expert IP Court:** The District Court of The Hague provides a specialized court for IP related matters in the field of trademarks, designs and patent cases. Judges are experts in the field of IP. The judges have a thorough understanding of the English language and thus, it's usually not necessary to translate documents. For matters not relating to trademarks, patents or design rights, the IP rights owner is not limited to the District Court of The Hague and can litigate (and obtain preliminary injunctions) in other district courts as well.
- **Preliminary injunctions:** It is possible to obtain preliminary injunctions in cases of trademark, design- or copyright infringement. In matters, where the infringement is obvious (e.g. counterfeits) or pressing (e.g. trade fairs), an injunction may even be granted ex-parte. In most matters, however, a preliminary injunction is granted after an oral hearing. A preliminary injunction can be obtained within a couple of weeks.
- **Interim judgment in proceedings on the merits:** if a case is too complex to deal with in injunction proceedings or if there is doubt as to the urgent interest, it is possible to obtain interim measures in the course of the proceedings on the merits.
- **No strict deadline:** There is no strict deadline to obtain a preliminary injunction. The IP right owner only requires an urgent interest. As a rule, the IP right owner has an urgent interest as long as the infringement continues.
- **Cost order and damages:** In the Netherlands, the infringing party will be ordered to bear the costs of the entire proceedings, including legal fees of the prevailing party. As these cost orders can come to considerable amounts, this often has a chilling effect. That said, Dutch courts are moderate in awarding damages.
- **Customs:** Dutch customs are experienced in dealing with IP infringements. Dutch customs have a specialized and accessible IP infringement task force, with whom the IP rights owner can communicate in English.

Team spotlight



Marc Wallheimer

Amsterdam

marc.wallheimer@hoganlovells.com

Marc was the lead counsel to BDO in a worldwide trademark dispute involving 220 cases in 40+ jurisdictions. The matter was brought to a favorable settlement for our client in 2014.



United Kingdom

The UK is typically seen as an attractive venue for civil litigation, being one of the main commercial litigation centres in the world.

However, it is also viewed as expensive in comparison with other European jurisdictions.

- **Stability and commitment:** The UK is politically stable, with a strong rule of law. It is a member of all the main intellectual property (“IP”) treaties. It is committed at the very least to ensuring that protection afforded to IP in the UK meets all relevant international standards, if it does not exceed them.
- **Parliamentary backing:** The treatment of IP is considered to be sufficiently critical to the UK economy that there is a Minister for IP (currently, Baroness Neville-Rolfe) who is responsible for managing UK government IP policy, including in conjunction with the EU. As an example, parliamentary time over the last year has already been devoted to three separate IP initiatives and frequent consultations are run by the UK IPO on how the law should operate.

- **A high-level, International forum:** As a result of English law's dominance in international contracts, the courts are experienced in hearing high-value, complex claims with the result that the UK is the venue of choice for many international litigants.
- **Specialization across the spectrum:** The UK has a robust and internationally respected enforcement system, with a variety of specialist IP courts. These range from special divisions within the existing High Court (major claims) and County Court (known as the Intellectual Property and Enterprise Court ("IPEC"), where lower value or smaller claims are heard) to tribunals operated by or under the aegis of the IPO.
- **A structure for swift case management:** All IP claims (irrespective of value) before the High Court and the IPEC will usually be heard by a specialist and experienced judge who will have practiced in IP law at a high level for at least 20 years before becoming a judge. IP claims are dealt with under separate civil procedure rules, which amongst other things allow issues of validity and infringement to be dealt with at the same time, rather than in separate actions, and allow for early and active case management by the judges. The main IP courts in London sit in the new and up-to-date courts complex, where the highest value, most complex commercial and contract cases are heard.
- **Evidence to put competitors on the back foot:** As a common law country, evidence is placed at a premium so cross-examination of witnesses is common and disclosure (called discovery in the U.S.) is commonly available. Whether IP owners welcome this may depend on the case, but it means that the UK is a good venue to find out what IP owners' competitors are doing and to put them to inconvenience and cost.
- **Favorable costs and remedies:** Although UK litigation is expensive, a high proportion of the winner's costs will be paid by the loser, usually two-thirds in a typical case, but rising to approximately 85 percent in cases where a party is judged to have pursued an unwise case or to have behaved badly. A successful claimant would also expect to gain the benefit of a comprehensive set of other remedies, including an injunction to prevent further infringements, damages as well as other relief (depending on the nature of the infringement).

Team spotlight



Sahira Khwaja

London

sahira.khwaja@hoganlovells.com

Sahira acts for multinational corporates in industries such as food (Mars and PepsiCo), pharmaceuticals (Merck Sharp & Dohme) and fashion, in brands and commercial IP matters. She co-led on Amazon's appeal in Lush v Amazon and is currently appearing in various designs enforcement matters in the UK IP courts.



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