

Current overview of practical legal instruments in anti-counterfeiting enforcement in the EU

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Introduction

EUIPO
source

**1 in 10
Europeans**



have been tricked
into buying
counterfeit goods

€ 121 billion

of fake goods are making
their way into the EU
every year



COVID-19 has shown us

**fakes and piracy
are everywhere**

Millions of fake face masks
and other personal protection
equipment **have been
seized across the EU**



If you buy a

**fake product
online or access
pirated digital
content:**



You're **risking**
your health and
safety



You're **funding**
organised crime



You're **putting your**
money and personal
details at risk

Is it worth it?



Situation

The COVID-19 pandemic and the rise in online shopping has shed new light on the risks and damages posed by IPR infringement in Europe. As online trade is booming – over of 70% of Europeans shopped online in 2020 (Eurostat) – uncertainty regarding counterfeit products has become a growing concern for consumer protection.

One of the challenges is finding counterfeit products on the worldwide web. Most counterfeits are sold online, and online commerce is fast, anonymous and versatile.

How can companies successfully combat counterfeits?

How can they successfully track down counterfeited products on the Internet?

EXISTING CHALLENGES IN IPR ENFORCEMENT

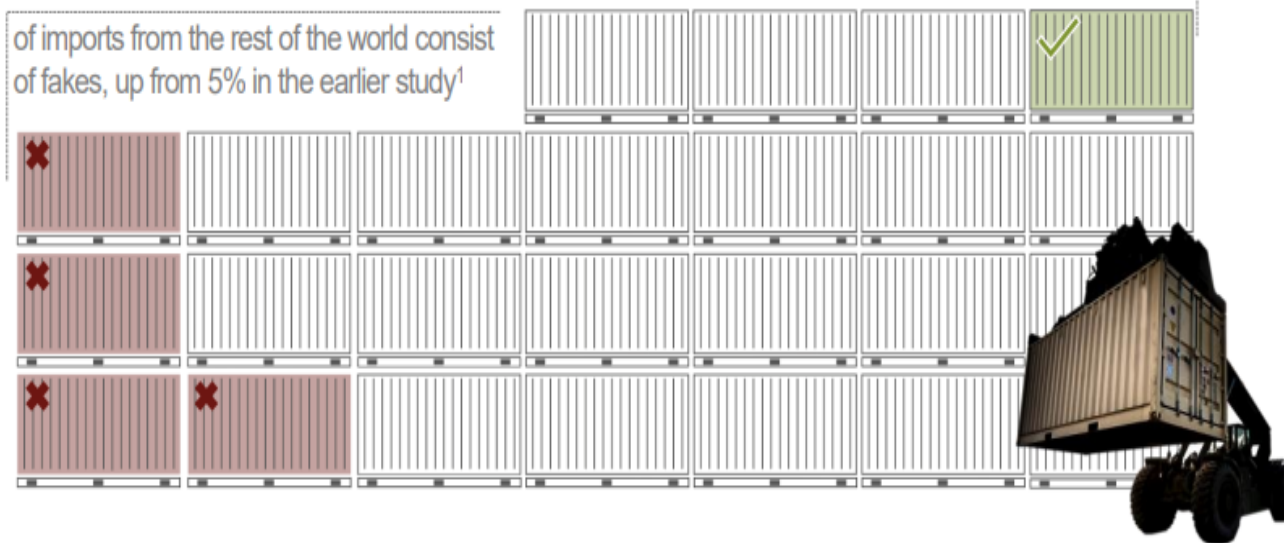
EU Trade:

6.8%

of imports from the rest of the world consist of fakes, up from 5% in the earlier study¹

1%

Customs authorities manage to inspect



I. How to monitor the EU online market to avoid the continuation of infringements and counterfeiting?

It is advisable to monitor the online marketplace by checking companies' webs **or e-commerce portals** using a trade mark/design without authorisation. It may be that illegal copies of products are on online sale or that competitors are using marks that are in conflict to a EU trade mark / CD.

A good way of monitoring is to use the **IP protection tools** offered by a number of e-commerce marketplaces to make it easier to take action and use the resources they make available.

What are the main IP protection tools in e-commerce portals?

- **Notification systems:** these allow to report listings that are potentially infringing IP rights. They typically require to provide information about the company, the IP rights (e.g. trade mark registration number) and the allegedly infringing listings (e.g. URL).
- **IP protection programmes:** these are put in place by a limited number of marketplaces to support cooperation with IP owners. They typically provide a simplified process to notify any allegedly infringing listings and a dashboard to keep track of the notifications and their outcomes. They also facilitate searches for listings that may infringe rights. Normally a pre-registration is required.
- **Contact point:** some marketplaces do not have notification systems or forms, so any IP infringements may have to be reported by email, with no specific format, to the contact point.
- **Registration:** it is advisable to sign in on the most important portals where the IP protection programme is offered (**ebay, amazon, Facebook, Wish**) by entering a contact information in the EU, preferably an IP firm.



II. How to monitor the EU (physical) market to avoid the continuation of infringements and counterfeiting? Customs...

THE EU PLATFORM FOR THE ENFORCEMENT OF IPRS



Promoting and supporting intellectual property value

Home About the Observatory Intellectual property for... Facts, Figures and Case Law News & events

IP ENFORCEMENT portal

The single EU platform to deal with IPR enforcement matters
A free, multilingual and secure tool

LOG IN

Request a [rights holder](#) or [enforcer](#) account

The IP Enforcement portal is the integration of the EDB, ACIST and ACRIS tools in a single platform



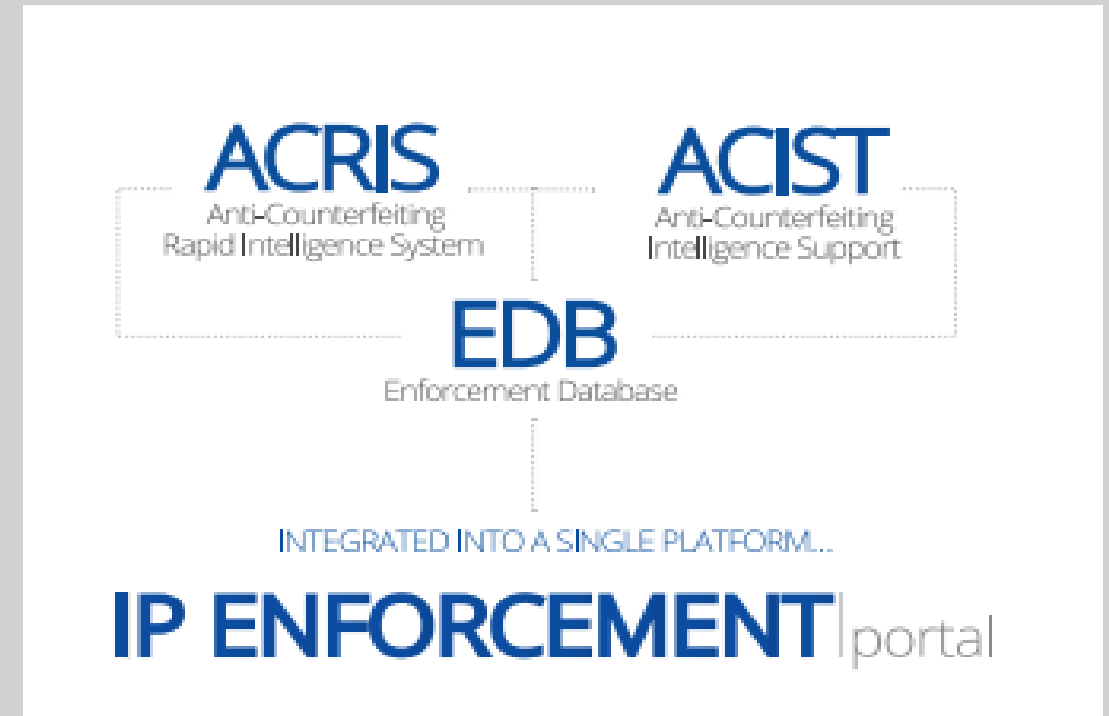
Sharing your information with enforcers in the IP Enforcement Portal - Application for Action or Alert?

05 February 2020

An EU Council regulation (Regulation (EU) No 608/2013 of the European Parliament and

EU IP Enforcement Portal (IPEP), features and requisites for use

- It is a tool developed under the umbrella of EU Regulation 386/2012(EU Observatory) and is **created to prevent and tackle the infringement of IPR and to distinguish genuine products from counterfeits.**
- The IP Enforcement Portal (IPEP) is an interactive, reliable and user-friendly tool for EU IPR enforcement, serving and facilitating a **secure communication tool between all related parties:** rights holders (and/or their legal representatives), EU enforcement authorities, the EU Commission and its EU delegations around the world.
- The Portal is the integration of the Enforcement Database (EDB), the Anti-Counterfeiting Intelligence Support Tool (ACIST) and the Anti-Counterfeiting Rapid Intelligence System (ACRIS).



IPEP, features and requisites for use

- This platform **enables rights holders to protect their rights against counterfeiting by sharing information** on their products, IP rights and contact data with EU enforcement authorities.
- **This will make it easier for enforcers to recognise originals from fake goods** (on the basis of information such as packaging, identifiers, logistics, genuine traders, production place), contact the rights holders if needed and take action. **Access is restricted to the rights holder or enforcement authorities** to prevent potential infringers or pirates from accessing sensitive information in order to perfect their copies.
- To open an account, **you need a valid IPR registered in the EU** (national, EU or international TM/D). **Free of charge.**
- **Either the IPR owners and its legal representatives can create and manage the account.** Normally the legal representative is the person managing the account and acting on behalf of the rights holder, keying in product information and filing a customs Application for Action (AFA). **For enforcers one of the main challenges is to find a rights holder and contact with them** in the context of a detention.
- **All EU customs and over 25 police forces have access to IPEP**, including the EU agencies, EUROPOL and the EU anti-fraud agency OLAF. All enforcement authorities registered in IPEP have access to the company information.



The *Exchange Information* function

The tool is a free of charge, secure platform enabling real-time exchange of information between right holders and enforcement authorities

BUILT UPON TMview AND DesignView



Right holders enter information on their products, such as contact data, logistics, identifiers, packaging, prior cases, etc. and upload their IPRs

Enforcers can easily access the information with one search and have the assurance that the information is based on a valid IP right and the user behind has been authenticated

Dashboard

IP ENFORCEMENT portal

Hello, [nicola.sernjovski](#) | [Language: English](#) v

[Log out](#)

[Dashboard](#) | [Company Information](#) | [Product Portfolio](#) | [Application for Action \(APA\)](#) | [Suspicious Case Room](#) | [Alerts for Customs and Police](#) | [Company Portfolio](#) | [Customs and Police Repository](#) | [Statistics](#)

[User management](#) | [Report non-EU cases](#)

Dashboard

Quick access to the different functions of the system.

[Refresh Dashboard](#)


Product Portfolio


[Add a new Product](#) | [Delete Selected Rows](#)


[Select All \(On this page\)](#)


[SELECT](#) | [MAIN IMAGE](#) | [PRODUCT NAME](#)


Product name

 Sun glasses (demo) | [SHARE](#) | [🔍](#) | [📄](#) | [🗑️](#)

 Sun furniture (demo) | [SHARE](#) | [🔍](#) | [📄](#) | [🗑️](#)

 Sun hats (demo) | [SHARE](#) | [🔍](#) | [📄](#) | [🗑️](#)

 Sun clothing (demo) | [SHARE](#) | [🔍](#) | [📄](#) | [🗑️](#)

 Sun Cream (demo) | [SHARE](#) | [🔍](#) | [📄](#) | [🗑️](#)

Access Log

Previous 1 2 3 4

5 Next

USER NAME	BELONGS TO	ROLE	DATE AND HOUR
nicola.sernjovski	Eupo 1	Company	Thursday 10, August 2017, 12:25:12
nicola.sernjovski	Eupo 1	Company	Friday 11, August 2017, 10:47:34
nicola.sernjovski	Eupo 1	Company	Wednesday 10, August 2017, 10:44:07
m.hinz	Eupo 1	Company	Tuesday 5, September 2017, 11:27:27
massimo.a.monelli	Eupo 1	Company	Tuesday 5, September 2017, 14:43:57
nicola.sernjovski	Eupo 1	Company	Tuesday 5, September 2017, 15:55:20
nicola.sernjovski	Eupo 1	Company	Wednesday 6, September 2017, 15:33:21
nicola.sernjovski	Eupo 1	Company	Thursday 7, September 2017, 14:10:04

- Overall display of the different features of the tool
- Access Log – see which enforcement authority has viewed your account info and when
- View account statistics and overall statistics on the use

Product information

General Info

Product Images/Videos

+ Add File



View IPR related to this Product

Genuine Logistics

Packages

Goods Clearance Details

Past Cases

Companies Involved

Market Value (EU)

Traders

Accompanying Documents

Genuine Logistics



Production Distribution Importation Transportation

- Information that will help enforcers to detect counterfeits

IPEP, features and requisites for use

- Customs Regulation (EU) 608/2013 created the so called **Application for Action (AFA) to request EU customs to detain goods** found to be suspected of infringing IPR.
- **Without an AFA** in place, **it is difficult for customs to correctly identify infringing products and to contact the holders**. In addition, without a valid AFA, only the option of an ex-officio AFA remains open, which is only valid within 4 days of notification.
- AFAs can be submitted to the national customs authorities or to IP Enforcement portal (IPEP). If submitted to IPEP, it reaches the chosen national authorities in a structured form (which facilitates the tracing of pirated goods) and translated into their local language.
- Union AFA covers more than one Member State and national AFA covers only the member state where it is filed.



Suspicious Cases

Suspicious Case

Sender / Receiver *

Company Contact *

Suspected Goods *

Attached Images

Documents Attached

Exchange Information

Answer Type *

Pending

Product

Pending

Product section

Genuine goods

Infringing goods

More information requested

Need to check the goods physically

See comments

More information re: Art.17.4 (Customs only)

Infringing goods, we agree to destruction

Comments

Documents Attached

+ Add File

Download

- Receive notifications on suspicious goods by enforcement authorities
- Authorities set deadline and get 'read receipt'
- Exchange information with the enforcement authorities and download into pdf

The enforcement community is accessing...

- Customs authorities of all MS
- The police community of the Portal is growing:
25 police & internal market authorities
Europol
OLAF

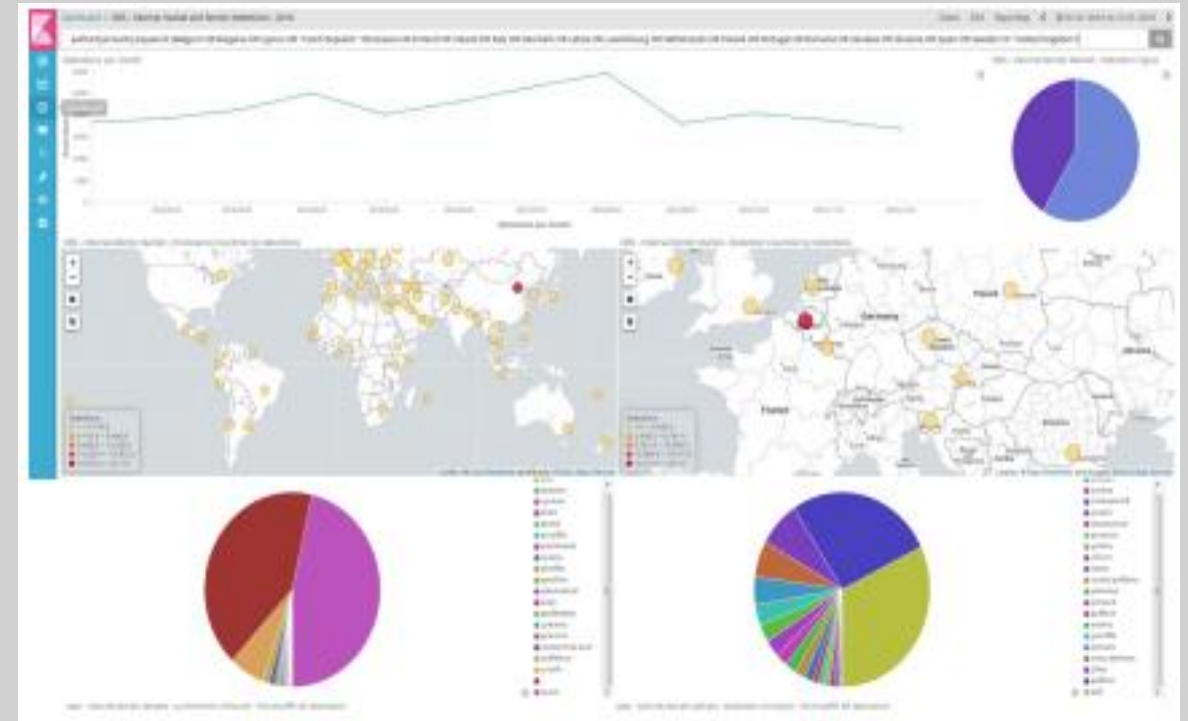
Status of IPEP

- Exchange information & Report detentions
- Exchange information
- Report detentions



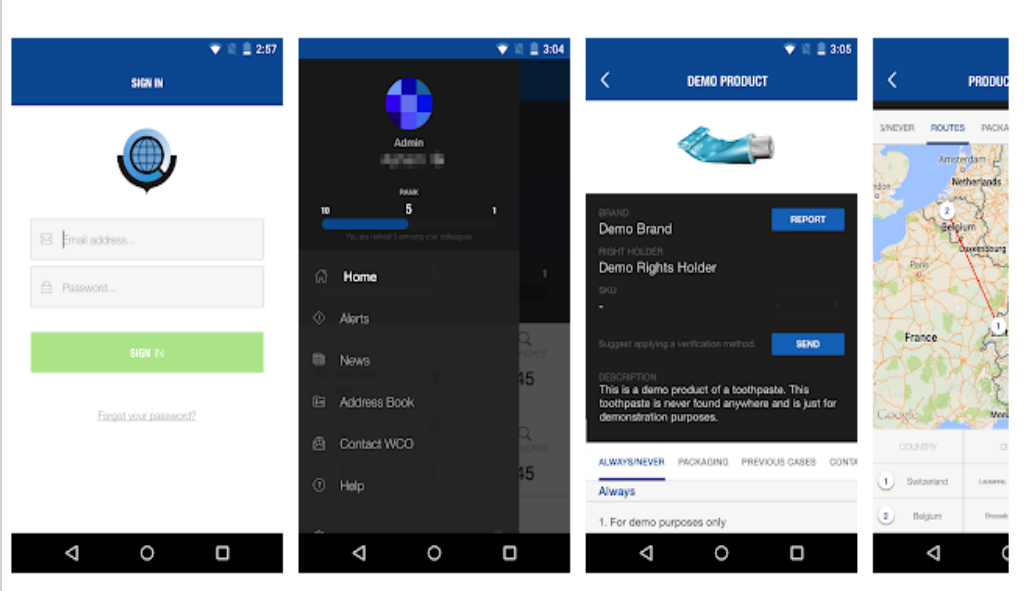
IPEP, features and requisites for use

- The **IPEP allows** the parties concerned to have **access to EU local and worldwide statistics.**
- This portal **enables IPR owners to protect their products, e-file and expand Application for Action (AFAs) and keep them connected** via alerts and suspicious cases.
- **IPR include trademarks, designs, geographical indications, Patents, Copyright, Plant Variety.**
- **Legal practitioners (attorneys-at-law)** may also have access and it is **recommended** that they do so in order to monitor the database at European level and act diligently in case of notifications.



Other international options:

- The **Interface Public-Members (IPM) platform** is the **World Customs Organization's** unique tool in the fight against counterfeiting. IPM is a web and mobile platform. It is used by Customs Officers in more than 80 countries and allows operational data concerning products to be communicated directly to Customs officers on the ground, facilitating the identification and verification of counterfeit goods.
- From the basic functionality of a genuine and fake database, featuring pictures and basic descriptions of products, this has now developed to a more complex system offering additional options, including the ability to send alerts to Customs officers, an e-learning feature and a mobile application.
- The latest update of this application introduces new functionality to detect counterfeit products by scanning the barcodes of thousands of original products, allowing customs officials to detect whether these codes match those of the originals, whether they come from where they say they come from, or whether they belong to the series they claim to belong to on their packaging.
- It works in a similar way to IPEP but is not free, it is financed by subscriptions from rights holders.



Last but not least, how to act in the EU once a counterfeit product is detected...

Basic legal overview, how EU IP legal system works on trademarks and designs

In the current EU 27 (following the BREXIT) there is a unified trademark law through the EUTMR 2017/1001 and CDR 6/2002 (both administered by the EUIPO in Alicante, Spain).

- EU trademarks (EUTM) and community designs (CD) coexist with national trademarks and designs of the Member States.
- **In civil jurisdictional matters**, both EUTM and CD can be enforced before EUTM and CD national courts, which exist in all member states. These national EUTM and CD courts co-exist with the national courts deciding on national trademarks and national designs infringements in each member state.
- **Enforcement actions under civil law** must be brought at national level either before the EUTM and CD national courts (when an EUTM or CD is involved) or before national courts (when only national trademarks or national designs are involved). EUTM and CD national courts are competent to order measures in all Member States and its judgements are valid and enforceable through the EU territory.
- **In criminal matters** there is only national legislation in each member state. There is no common or harmonized criminal law in the EU; each member state has its own. Measures under criminal law apply when counterfeiting and piracy activities are involved.
- **Enforcement actions under criminal law** are only brought at national level using only the relevant national law.



Thank you for your attention!

For any information or request, please contact me at
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