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Intellectual Property, A business tool for SMEs

A Guide for the Textile and Clothing Industry



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Intellectual Property, A business tool for SMEs

*A Guide for the Textile and
Clothing Industry*



A Guide for the Textile and Clothing Industry

Clothing is our second skin. Clothing keeps us warm and protected. Clothing tells who we are, our age, gender, status, social class, culture, religion, political standing, membership in a specific group, personal taste.

Besides, textiles have many other applications. We use textiles everywhere: at home, in means of transport, in buildings, all over. There are no real substitutes for textiles in either the clothing or the interior decoration fields. And what is more important, many materials, like metal and plastics, will be replaced by textile-based materials in electronics, healthcare equipment, energy, construction, automotive, ship-building, aeronautics, machinery, furniture, personal protection, and probably new, unexpected fields in the years to come. These new textile products for innovative technical applications, as well as the emerging smart or intelligent textiles with multi-functional properties, are expected to have higher growth rates and more added value than traditional textiles.

European industry has a longstanding tradition of leadership in terms of innovation, fashion and creativity. Despite increasingly fierce global competition and relocation of manufacturing to low-wage countries, it continues to be one of Europe's major industrial sectors, with an annual turnover of more than €210 billion and a total workforce of 2.3 million. It is a major player in world trade, first in textile exports and third in clothing.

You are a part of this success: 170,000 companies in the enlarged EU, of which some 96% are SMEs, like yours, are covering a fascinating industrial landscape, and producing a myriad of different consumer and industrial products.

Textile innovation, creativity and fashion lead to opportunities. And Europe is well placed to stimulate them with a high degree of success, thanks to its economic, technological, human and knowledge-based assets.

No wonder many competitors, in their struggle to emulate Europe, try to use shortcuts and fall into the trap of piracy and counterfeiting.

Europe's technological and non-technological innovations constitute the sector's intellectual property base. It's an asset, possibly the most valuable, owned by the people, enterprises and institutions representing Europe's textile and clothing industry.

It is not only luxury items from big companies that are copied nowadays – SME's are increasingly falling victim to counterfeiters. They are the most vulnerable but at the same time the engine of our industry in Europe! And it doesn't help that some of them don't know, for instance, which of their assets are entitled to any kind of protection or that they can act against the piracy of their original designs, even if they're not registered. However, there are some who have developed the know-how to use the tools that intellectual property rights (IPRs) offer.

Let's ask ourselves a few strategic questions:

Which assets differentiate our company from our competitors? Which of those assets should be protected and how, e.g.: trade marks, designs, models, brands, packaging, industrial and business practices?

Is it worth registering our designs, since they have such brief commercial value?

How can we protect ourselves from being copied at International Fairs, or by our own business partners?

What actions can we take in certain countries when being copied?

How much might we pay for protection? To take action?

How can we make money through the protection of our assets?

Managing Intellectual Property enhances your competitiveness. Your tremendously valuable textiles and clothing assets can become even more valuable and make your company unique – a leader in its market.

Thus, IPR must be an active part of your business strategy. This Guide is meant to be a useful tool to carry out this strategy successfully inside your own company.

What you need to know about Intellectual Property Rights (IPRs)



What you need to know about Intellectual Property Rights (IPRs)

Most of you reading this Guide right now will probably argue that your business success depends heavily on the design of your products, the decisive question of whether the look of the product, be it a shoe, a sofa, a handbag or a fancy dress, fits the customer's taste. Other important elements may be the recognition of the brand in the market, as well as potential technology employed to process or equip the products.

Yet, while issues such as design, branding or the use of the latest technology seem like obvious aspects of competitive advantage to most working in your industry, experts in the field do not necessarily make the connection between these business assets and "intellectual property rights". Thus, we seek to illustrate how various forms of IP can be decisive factors in how SMEs do their business.

So, what form of knowledge assets does the concept of intellectual property encompass?

Intellectual property includes:

1. Trade secrets
2. Copyright and related rights
3. Industrial property:
 - Designs
 - Trade marks
 - Patents and utility models

Intellectual Property Rights are territorial rights. This means each country reserves the right to define intellectual property according to its own laws. Therefore, if your business has a strong international focus, you must check the relevant laws and practices in the country(ies) where you intend to do business. To do this, please go to the specific national factsheets in this guide.

1. Trade secrets and protection against unfair competition - *What does each mean?*

The concept of trade secrets is the cornerstone of "protection against unfair competition." Only selective circles of employees are allowed to know about a trade secret, and those who know should be bound by contractual arrangements to keep the sensitive trade information secret. Trade information can be considered sensitive if it relates to specific manufacturing or industrial processes or when it relates to commercial purposes, such as sales methods, consumer profiles, advertising, strategies, lists of suppliers and clients and manufacturing processes.

Thus the term "trade secret" means confidential business information that is known only to a certain circle within a business and should not be leaked outside the company.

The following are examples of trade secrets:

1. Your customer list,
2. The specific method to make your product,
3. The specific way to treat the materials when making your products.

Essentially, any business process or item that provides you with a competitive advantage in the market and that you do not want your competitors to know is a trade secret.

Thus, if anyone were to discover your unique business knowledge by spying on your firm, you could file an action against him for unfair trade practices.

Trade secrets are very easy to obtain as long as you make sure that the information remains secret.

You do not need to file for any form of protection with an intellectual property office. Therefore, it is really important that you build in trade secret protection clauses when you offer employment contracts

to your employees. Otherwise, you risk losing your trade secret. For reasons like these, trade secrets are quite a fragile form of intellectual property protection. Additionally, many firms, both large and small, often neglect to enter into the necessary contractual arrangements with business partners and employees to protect their trade secrets. You can only argue that there is a violation of your trade secrets if you have some fact-based evidence that you took action to protect your unique business information.

With this in view, sometimes you should consider protecting unique business information through other intellectual property rights (copyright, industrial rights). These intellectual property rights are much stronger and give you more solid grounds for protection.

2. Copyright and related rights

Copyright plays a crucial role in the textile and clothing, leather, furniture and footwear industries since it is free of charge, easy and fast to obtain and does not require any formalities (self-executing right). A work is considered protected by copyright as soon as it comes into creation. This protection may, for example, cover reference works, newspapers, computer programs, databases, artistic works (designs, paintings, shapes and colours) architecture and advertisements, maps and technical drawings.

You just have to be able to prove a certain date of creation and the originality or novelty of your creation.

The original creators of works protected by copyright have the exclusive right to use or authorise others to use the work under certain terms. The creator of a work can prohibit or authorise its:

- Reproduction in various forms, such as printed publication;
- Initial distribution to the public through sale and other transfer of ownership in tangible copies;
- Rental of copies to the public;
- Translations into other languages or adaptation.

Many creative works protected by copyright require mass distribution, communication and financial investment for their dissemination. Therefore, creators often license the rights to their works to the individuals or companies best able to market the works in return for payment. These payments are often made according to the actual use of the work and are then referred to as **royalties**.

Copyright is usually limited to 50 years after the creator's death (70 years for Europe), though many national jurisdictions offer different durations of the right¹.

Often, it is the company and not the original creator of the work that holds the copyright. That does not, however, mean the copyright owner can do as it pleases. In Europe², the author can always oppose any use of the creation that may discredit his reputation (so-called moral rights). Also, the owner must give name recognition to the creator.

The rights of the author are protected in many countries through "moral rights". The concept of moral rights is particularly important if the original creator is not the owner of the copyright. For example, an author usually passes on the copyright to the publishing house, yet s/he will always retain the moral rights. This means that name recognition needs to be given to the author, and the publisher may not use the work inappropriately, in a way that might discredit the author.

Economic rights include the right to work, to the free choice of employment and to just and fair labour conditions; the right to strike; the right to social security; and the right to own property. As such, they may be considered an important form of human rights. Economic rights require states to take action to protect the economic rights of its citizens.

The concept of "related rights" pertains to the performing arts, producers of sound recording (for example cassette recordings and CDs) in their recordings and broadcasting organisations in radio and TV programs. Depending on the national jurisdiction, related rights may be more restrictive than copyrights.³ Similar to other forms of intellectual property copyright and related rights are economic rights. They can be traded or sold like any other property right.⁴

Please keep in mind that, since there is no real harmonisation in Europe concerning this right, if your creation is protected under copyright legislation in one country (perhaps yours), it does not mean it will be protected by a copyright in another country (difference in the criteria). For example, in Germany, you

1. For national limits please look at the national factsheets.

2. This is different in the USA.

3. www.wipo.int/copyright/en/

4. Recently, the photographer Annie Leibovitz securitised the rights to her photos in a deal with a New York-based investment bank, which allowed her to raise a significant amount of money, based solely on her copyright!

cannot protect a three-dimensional design (dress, shoe or chair) under copyright protection.

3. Industrial Property Rights

Industrial Designs

Design rights protect independently created designs, which are new or original and have an independent character. In order to qualify for design protection, the design must not be dictated by technical or functional aspects. Design rights can be classified as industrial designs, models and utility models. Designs may under certain circumstances also be protected under copyright law.

The design may consist of three-dimensional features, such as the **shape or surface** of an article, or of two-dimensional features, such as **patterns, lines or color**.

The length of design protection depends on the respective jurisdiction and there is no one size fit all. In the E.U. for example the time limitation for a design is 25 years in total, renewable every 5 years.

In spite of the fact that international legislation foresees mainly defensive actions in the context of industrial designs, those rights provide a wide range of business opportunities. Designs can be licensed, sold and traded in any other way. Also, in the context of globalisation, it is worthwhile to note that outsourcing production to low-cost countries would not be feasible without industrial design rights. In the absence of those rights, anyone involved in the production process could legitimately imitate the design.

Designs protect only the formal appearance, while utility models protect the functional appearance. In practice, the same form can be protected by both a utility model and a design; the utility model protects the technical aspects of the product and the design its shape and look.

It is necessary to file for design protection under the appropriate class, depending on whether you file at the national, regional, European or international level. It is important to secure protection under those classes that may be of relevance to your business because you can only take legal action if someone infringes your rights in that specific class.

These classes have to do with the goods and services for which you register your design. The most com-

mon system at the international level is the Locarno classification system for design rights, which has 32 classes and 223 subclasses. The design classification system helps to retrieve information on designs in a systematic manner. Since designs are filed for a selected set of goods and services, it is easier to identify them in databases.

A protected design or a model may also be eligible for protection under copyright law, but only for designs that meet two requirements: creative character and artistic value. This is a derogation from the general rules for copyright which don't require a work to have a specific artistic value.

There are many examples of the crucial role played by design in the textile, leather, footwear, and furniture industries: the company "Sorelle", which designs and produces shoes, footwear and accessories (belts, bags, etc.) mainly protects its footwear designs in Greece. One day a well-known competitor decided to copy several models, produce them in China and import them to Greece. Because that caused a loss of one third of its annual turnover, "Sorelle" decided to file a lawsuit against the potential infringer, which caused many shops to close and an end to the commercialisation of the infringing products. Without any protection in Greece, Sorelle would surely have lost its entire market share.

Without adequate IP protection, the success of many fashion and design companies would be seriously hampered.

Trade marks

A trade mark can be any sign that serves as a "marker" for a given product or service. It helps consumers identify and purchase a product or service because its nature and quality, indicated by its **unique** trade mark, meets their needs. The sign can be a particular word, such as a personal name, letters, numbers, stylistic elements, specific colours, as well as a combination of these various stylistic elements. Essentially, it needs to be a sign that makes your product or service visually distinctive from other products or services.

You need to file for trade mark protection under the appropriate class, depending on whether you file at the national, regional, European or international level. It is important to secure protection under those classes that may be of relevance to your business because you can usually only take legal action if someone infringes your rights in that specific class. For ex-

ample, if you filed for a protection in class 25 (clothing) but not class 18 (bags) or class 14 (watch straps) and someone else uses your mark on a bag, there is not much you can do to claim your rights.

These classes have to do with the goods and services for which you register your trade mark. The most common system at the international level is the Nice classification system for trade marks, which has 34 classes for goods and 11 for services. The trade mark classification system helps retrieve information on trade marks in a systematic manner. Since trade marks are filed for a selected set of goods and services, it is easier to identify them in databases.

Trade marks can be individual or collective depending on the ownership of the IPR. Collective trade marks are typically owned by trade associations or cooperatives for the benefit of their members and identify a particular product with distinct characteristics, such as the “Leathermark”.

A number of countries also provide for the protection of certification marks, which are granted based on compliance with defined quality standards and specifications. These are different from collective trade marks in the sense that they are not necessarily owned by an association or a group but may be licensed if a company complies with the established standards.

One important requirement for certification marks is that the entity that applies for registration is considered “competent to certify” the products concerned. Certification marks may be used along with the individual trade mark of the producer of a given good.

For example, “Woolmark” is a trade mark owned by the Australian company Woolmark, which also represents the authority to grant licences if the standards are fulfilled. It is not simply a logo denoting wool content but an integral part of the world’s largest fibre quality assurance scheme.

However, notably in the case of individual trade marks, the sign must not be generic, for example filing the trade mark ‘polo’ for polo shirts would be refused; filing the trade mark ‘polo’ for a perfume passes because it is not a generic or descriptive sign for a perfume.

A trade mark protects the owner of the mark by ensuring the exclusive right to use it to identify goods or services or to licence another to use it in return for payment.

A trade mark can be renewed indefinitely upon payment of additional fees.

There are 4 levels of trade mark protection:

- National (with the National Patent Office);
- Regional (e.g. with the Benelux Office);
- European (with OHIM);
- International (with WIPO).

Trade marks are an important tool for communicating the value of a product or service to the market. Trade mark protection is the cornerstone of a variety of brand strategies based on product differentiation and market segmentation, which are very important when managing competition, creating customer demand, and securing market share. In light of that, it is clear that trade marks are crucial to your industry. In many instances, for example, it is the trade mark that determines which product a customer will buy.

In this respect, collective trade marks are quite effective to jointly market the products of a group of enterprises or industry sector. By joining efforts and resources under a collective trade mark, SMEs often overcome the difficulty of getting consumers to recognise their individual marks. The “vero cuoio” and the “vera pelle”, two collective trade marks owned by UNIC, the Italian Leather Trade Association, were the basis for a mega-seizure by the Italian authorities of counterfeit and pirated leather goods called “Operation toxic shoes”, launched in 2008. 1.7 million leather products worth some 20 million euros were confiscated in warehouses in Tuscany, Lazio and Calabria, clearing the market of illegal goods that were also found to be dangerous for consumers. Licensed users of these trade marks have to respond to strict quality specifications.

Patents and utility models

Patents are intellectual property rights that guarantee ownership of an invention. To qualify for patent protection, an invention must meet the criteria of novelty, inventiveness and industrial applicability. This means a person skilled in the art will see that your patent application contributes to the current state of research, is original and has some sort of commercial application. So, basic scientific findings do not qualify for patent protection.

Patents are usually valid for 20 years, depending on the relevant jurisdiction.

There are certain circumstances when patent protection or protection as a utility model may not be granted, namely in the following cases:

- Discoveries, scientific theories and mathematical methods;
- Aesthetic creations;
- Schemes, rules and methods for performing mental acts, for playing games or for doing business, as well as for computer programs;
- Presentations of information (e.g. tables, forms, typographical arrangements);
- Constructions and processes that are contrary to the laws of nature;
- Inventions the industrial exploitation of which would be contrary to public order or morality.

A utility model is similar to a patent, yet the criteria for obtaining this type of protection are less stringent, particularly those pertaining to the “inventive step or non-obviousness”. Granted only in certain countries, utility models only offer protection for about 7-10 years, depending on the jurisdiction (for national specificities please have a look at national factsheets). Since the prior art search is less stringent, they are usually granted within a period of 6 months. They seem particularly suitable for companies that have incremental inventions.⁵

While the core business of the textile, leather, footwear and furniture industries is not based on patents, but rather on design rights, trade marks and copyright, patents are nonetheless used in these sectors, especially in the field of technical textiles.

4. Look-alikes and other unfair trade practices

Look-alike products are those with an appearance that intentionally resembles an existing product, or for which the trade mark is made to look like a famous mark, often to benefit from the reputation or fame of the existing product. Such products or trade marks look so similar that consumers may mistakenly think the products are the same or at least made by the same company.

As business owners, you know the success of a product depends on consumer recognition. One way for a trade mark owner to enhance consumer recognition is to use distinctive product appearance or packaging,

also known as trade dress or get up, along with its trade mark.

Look-alikes harm both the business owner and the consumer. The business owner suffers losses when the consumer buys a look-alike product, mistakenly believing it to be the business's original trade marked product. The consumer suffers because look-alike products are often not of the same quality as the original trade marked product.

In most European countries, trade mark owners can seek protection against the producers of look-alike products through unfair trade legislation when there is a clear attempt by the producer of the look-alike product to benefit from the creative effort and investment of the trade mark owner. Unfair competition includes any act of competition contrary to honest practices in industrial or commercial matters, as well as all acts that create confusion with the establishment, goods or industrial or commercial activities of a competitor. One example of a law against unfair trade practices is the EU's Unfair Commercial Practices Directive (2005/29/EC)⁶, which contains provisions that might widen the scope of protection against look-alikes.

False descriptions

Similarly as in the case of look-alikes, consumers may be misled by false descriptions or false origin indications. In these deceptive practices, consumers are intentionally induced into error by an inaccurate indication of a material or of a country of origin for a given product that enjoys a wide reputation. For example, synthetic materials are sold as leather, and shoes or other fashion accessories are marked *Made in Italy* or *Made in France* when they are really made elsewhere. These cases do not constitute infringements of IPRs and redress is to be sought under provisions regarding misleading advertising or unfair trade practices.

Other unfair trade practices

You can refer to unfair competition rules if the deceptive or wrongful business behaviour of a competitor causes you economic losses. There are two broad categories of unfair competition or unfair trade practices:

5. WIPO: What is a utility model? http://www.wipo.int/sme/en/ip_business/utility_models/utility_models.htm

6. <http://eur-lex.europa.eu>

- business undertakings that confuse consumers as to the origin of the product;
- 'unfair trade practices', which comprises any other action that may cause damage through unfair competition. Common concepts that you can refer to are issues such as 'likelihood of confusion' or misappropriation of your reputation in the market.

Because the legislation against unfair trade practices is closely related to (but still distinct from) that concerning intellectual property, it is common for companies to file complaints both under intellectual property law and under commercial law. What is considered 'unfair' varies from jurisdiction to jurisdiction, as well as from business case to business case,

thus there is no rule of thumb that allows advanced determination of what actions qualify.

Typical examples of unfair trade practices are:

- Trade mark infringement;
- Wrongful advertisement and peculiar selling tactics;
- Theft of trade secrets;
- Wrongful representation of goods and services;
- Breach of confidentiality agreements by former employees.

The illegal use of any other intangible asset your company owns may also qualify as unfair competition.

Create value with your IPR



Create value with your IPR

STEP 1: FIND OUT IF YOUR ASSETS/ CREATIONS ARE REALLY NEW

When you have an idea for a new product or a design for shoes, clothes, handbags, furniture, etc. or you think about a logo or an image to distinguish and market your company, products or brands, you should ask yourself if these ideas of yours are really new or whether somebody else has already invented them (products, designs) or is using them (logo, mark, etc.) and has protected them with a patent, a design or a trade mark. When you are thinking about these means of protection (patent, design, trade mark) it is especially important to try to make sure your "ideas" are still protectable (mainly that nobody else is already using and protecting them).

In many cases, it should allow you to save time and money since it is always better to find out before initiating a protection registration procedure that something is already on the market and therefore your product cannot be protected.

Why is it advisable to conduct a design search?

Time and budget permitting, it may be wise to conduct a search before applying for a design registration. If the same or similar designs have already been disclosed somewhere else, you may not be able to register your design.

However, one must keep in mind that the number of existing designs (protected and not protected) is so big that it is really difficult to conduct a very thorough search of designs. Therefore, it may sometimes be too time-consuming to search many design databases before applying for protection and so it may sometimes be more advisable and much faster to apply for design protection without performing a detailed search. Furthermore, no search will guarantee that your design can indeed be registered. The objective is to make a

reasonable assessment of the prospects for obtaining design protection.

You can hire an attorney to do a design search or you can do it yourself or assign this task to an employee responsible for the IPRs in your company.

You can do such a search using various databases. Some free databases where you can do design searches are mentioned below:

- The Office of Harmonization for the Internal Market (OHIM) for community trade marks and designs - <http://oami.europa.eu/ows/rw/pages/>
- UKIPO Design Search tool: <http://www.ipo.gov.uk/types/design/d-os/d-find.htm>
- WIPO Trade Mark and Design Applications - <http://www.wipo.int/portal/index.html.en>

Why is it advisable to conduct a trade mark search?

You need to find out whether another business is already using a trade mark that's identical or similar to the one you intend to use and/or protect. This will help ensure that you do not violate someone else's trade mark rights.

The consequences of not doing such a search may be significant, depending of course on how widely you intend to use the trade mark and how much it would cost you to change it if any conflicts develop.

If the trade mark you want to use has already been registered by someone else, you will be precluded from using it. Also, a court will presume that you knew about the trade mark registration and will see the case this way. This may mean that if you use the trade mark improperly, you will be a "willful infringer." That means you could be held liable for damages and attorney fees and could be forced to stop using the trade mark.

To perform the trade mark search, it is advisable to hire an attorney to do a detailed search for you (since it is

a quite time-consuming activity) but this requires certain financial resources to pay the attorney; or you can perform the trade mark search yourself or assign this task to an employee responsible for the IPRs in your company.

You can do the search using various databases. Some free databases where you can do trade mark searches are mentioned below:

- The Office of Harmonization for the Internal Market (**OHIM**) for community trade marks and designs - <http://oami.europa.eu/ows/rw/pages/>
- WIPO Trade Mark and Design Applications - <http://www.wipo.int/portal/index.html.en>
- Also, the U.S. Patent and Trade Mark Office's web site (USPTO) (www.uspto.gov) allows trade mark searches.
- UKIPO Trade Mark Search tool: <http://www.ipo.gov.uk/types/tm/t-os/t-find.htm>
- Another interesting tool is TrademarkBots (TrademarkBots.com), which is a Web-based trade mark search and monitoring application. With TrademarkBots, trade mark owners and attorneys have a single source to monitor and audit unauthorised uses of trade marks.
- In addition to searching for registered (and pending trade marks), you can also conduct a search for unregistered marks by using internet search engines. For instance, by entering a proposed name in the search field on Google (www.google.com), you will get a report where the name appears on Web pages that the Google search engine has indexed. Because no search engine is 100% complete, a search should include several search engines.

Why is it advisable to conduct a patent search?

Often, due to a lack of information or time to conduct a focused search, existing inventions are re-invented, problems already solved are re-solved, and products that are on the market are re-developed. Duplication of efforts in this way costs European industry millions of euros every year.

Patents hold a goldmine of information. About 80 percent of technical information is published in patent documentation - and often nowhere else.

However, searching through patents is not an easy task. Patents are organised by classes and subclasses of inventions, similar to the way books are organised in libraries. By using this classification system, you can find

and examine patents that are in the same class as your ideas.

When an inventor comes up with an idea, the company concerned has to decide whether the idea is worth investment. Furthermore, the management of a company would want to know the areas in which to invest. A patent analysis discloses areas that are occupied and gather interest and those that are still open for action and can provide a chance to fill a niche for a company. A really innovative research team could even use patent analysis to predict the next evolutions in technology and economy.

To perform a patent search, you can hire an attorney to take care of this task or you can perform a patent search yourself or assign this task to an employee responsible for the IPRs in your company.

You can do the search using various databases. Some free databases where you can do patent searches are mentioned below:

- The Web portal of the European Patent Office – Espacenet - <http://ep.espacenet.com/>
- Google Patents - <http://www.google.com/patents>
- UKIPO Patent Search: <http://www.ipo.gov.uk/types/patent/p-os/p-find.htm>
- U.S. Patent and Trade Mark Office patent search tool - <http://www.uspto.gov/patft/>
- WIPO PCT applications - <http://www.wipo.int>
- CAMBIA Patent Lens - <http://www.patentlens.net/>
- Intellectual Property Office of Singapore - the Web site of Singapore's Intellectual Property Office has links to other sites in "search results" (SurfIP.com) - <http://www.ipos.gov.sg/topNav/hom/>
- DEPATISnet - <http://depatisnet.dpma.de/>
- FILDATA - <http://www.fildata.it/>

In addition to those databases, it is possible to do a search of national patent office sites, taking into consideration the fact that the geographical coverage may be limited to the country where the patent office is established.

To sum up

Many people prefer to pay a professional search firm to handle searches rather than do it themselves. This makes sense if your financial plans justify an initial outlay of hundreds of Euros, which is the average cost for a thorough professional search. If you work with an attorney for such a search, you should also get a legal opinion from him as to whether your proposed trade

mark, design or patent is legally safe in light of existing registered and unregistered rights.

But it is worth knowing that there are free (some examples are provided above) or private subscription-based and/or fee-based search engines that allow you to do some basic searches yourself.

Whichever approach you apply, it is always worth it to spend some time and look at what already exists on the market to avoid costly surprises and avoid being unaware of infringing somebody's rights.

STEP 2: ASSESS THE RISK LEVEL FOR EACH INNOVATIVE ASSET/MARKET/BUSINESS

Once you have identified those assets that are truly innovative and that give high added value to your company, it is time to consider some questions and main issues that can help define the level of risk related to your assets and determine the best IPR strategy.

The main issues you should consider before defining your IPR strategy are:

Risks associated with company assets

- Are your key assets/creations easy to copy? Do they need a specific know-how and/or a specific effort to develop?
- In your opinion, what would be the easiest way to copy your designs: fairs, samples, production sent, catalogues, internet, etc.?
- Do employees sign confidentiality or non-disclosure agreements (so-called NDA) as part of their initial terms and conditions of employment and annually thereafter?
- Is your relationship with external temporary employees defined by a detailed contract or NDA with specific clauses concerning IPR?

Risks associated with commercial and distribution activities

- How do you attend the main fairs: (see specific recommendations under *Danger at fairs and exhibitions*).
 - Do you present new designs each season?
 - Is an agent or third party attending fairs on your behalf?

- How is your sales and distribution network organised:
 - Are you dealing with external representatives/third parties in each country, or directly with your customers?
 - Is your relationship with external agents/third parties defined by a detailed contract or NDA with specific clauses concerning IPR?
 - Are you adequately informed of your customers' business?
 - Are your transactions with your customers protected by any kind of contract or NDA with specific clauses concerning IPR?
 - Do you protect your assets even with potential partners or customers with whom a deal has not been entered into?
 - Do you organise the transport of goods yourself? Does your packaging stand out? (trade mark – content described, etc...)
- How are your competitors treating their IPR?
 - Are they protecting their assets?
 - Are they being copied?

Risks associated with R&D, design, purchasing, production

- Which phases of your value chain are you outsourcing?
- Do those phases involve key information or knowledge that may allow external partners to copy your assets?
- Is your relationship with such partners defined by a detailed contract or NDA with specific clauses concerning IPR?
- How well do you know your business partners?
 - Who are their partners?
 - Are they subcontracting your processes?
 - Are they working with your competitors?
 - Do you visit them very often?
- Do you have an IPR agreement with them (license, etc...)? Is it exclusive? Non-exclusive? Does it allow sub-licensing by your partner?

Preparedness, awareness and readiness to act

- How do you assess your knowledge on how to react to piracy and counterfeiting?
- Do you have a specific procedure for the management of IPR?
- Are there mechanisms to detect piracy and counterfeiting?

- Is IPR responsibility clearly defined within your company?
- Do you have all the documents available for each asset in case you have to demonstrate its innovation and pioneering level?

Danger at fairs and exhibitions

The textiles and clothing, footwear, furniture and leather industries are particularly concerned by this issue. Designs presented at international fairs are often simply looted, even before their manufacturing and marketing stage.

This is even easier with the help of designers experienced in the practically instantaneous reproduction of samples or sketches. An order is then placed in a third country where labour is cheap, and then these articles come back to the European market with the design that was popular at the fair and which will be successful during that season. In many cases, counterfeiters are faster than you and register your creation under their name even during the fair.

Aware of this, some organisers of textile and clothing trade fairs have already adopted their own ethics charters¹ and rules against counterfeiting².

However, all trade fairs do not have the same approach. To minimise the risk, here are some recommendations before showing your designs/creations at a fair:

- Check that you do not infringe any protected design in the country in question.
- Make sure you benefit from protection against copies in that country (copyright, unregistered right, registered right).
- If your creation can be protected under copyright protection in that country, make sure you can prove a certain date of creation or disclosure: You may use photos of the design during a public event; copy of a publication with the photo of your design; publication on a Web site or in a newspaper or catalogue; official letter from a lawyer during a public event. Many other means exist to prove a date of creation,

like a letter sent to yourself containing the creation and which you do not open.

- If you show your creation in an EU country, you may benefit from a copyright or unregistered right protection against copies in the country in question (copyright depending on the country, unregistered community design, UK unregistered design). Like in other countries, make sure that you can prove a certain date of disclosure/publication. Bear in mind that your registered or unregistered Community design is only protected in the EU!
- Take into account that the disclosure of your design in a country may destroy the novelty criteria for further registration in the same country. Thus it is important to make sure you have another possibility to protect your creation there before and/or after the fair.
- Remember that business contracts might need to be adapted to avoid any disclosure of your creations without your consent. Your relationship with your partners should be defined by a detailed contract or non-disclosure agreement (NDA) with specific clauses concerning IPR.

Possible indications that you are being copied

It is very important to keep an eye on the market and be able to detect counterfeiting from the very beginning. This is a key step that enables you to react in time by taking the adequate actions when confronted with this situation.

This consists of checking specific issues and situations which are worth analysing. Below are some guidelines that may help you detect that you are being or will be copied:

- You see your sales dropping on a given market without a particular reason.
- Your products are suddenly photographed or seen in countries where they are not sold.
- A colleague compliments you for market penetration in a country where you are not present.
- Your customers insist on a price reduction to match the prices of a competitor on a given market: someone is probably offering similar goods in the market under the unrealistic low price.
- Products bearing your trade marks are being sold at significantly discounted prices, and/or at unauthorised shops/outlets.
- You see a product that is extremely similar to yours at a trade fair, in a shop, on the street, on the Web, etc.

1. Examples: Heimtextil in Germany or Premiere Vision in France.

2. Example: Heimtextil decides not to authorise any photos during the fair. For more information regarding the policies and general guidelines that organisers like Guangzhou and the Hong Kong Fashion Fair (run by HKTDC) follow, see:
www.cantonfair.org.cn
www.tdctrade.com

- The samples you brought to a trade fair suddenly disappear.
- Your direct competitors are being copied.
- You receive a message from the customs office that they are withholding suspicious goods similar to yours.
- Packaging contains blurred lettering, misspelled words or omits manufacturer's codes, trade marks, patents, copyrights or other information that would normally be found on products.
- You detect publicity about your products from sources other than your company and distributors.
- Your long-time customer asks you to re-explain the specific advantages of your product compared to generic ones.
- The brand is losing its prestige in the market and with clients.
- Your products are worn by individuals with different professional activity or social status than your market (this is especially relevant for prestigious brands).
- You start getting quality complaints about your products, or you hear about adverse health and consumer effects from your products, for instance as a result of poor quality of fabric/tissue, toxic or harmful dyes, etc.
- One of your producers/distributors often works independently, avoiding close collaboration with you and giving very little information about his business.
- You start receiving offers from business consultants to provide services in the fight against counterfeiting.
- Someone tries to register your company name somewhere else in the world.
- The prices of particular raw materials or pieces necessary for your product start increasing without a particular economic reason.
- Some sales representatives/designers recently left your company and you suspect they are working somewhere else in the same market.

The best way to detect that you are being copied is using your own resources: your company results, yourself, your sales results, your staff in general on the one hand, and your design, production and distribution partners or subcontractors on the other, as well as your own customers, who are physically present in national and foreign markets. If you succeed in building solid partnerships and keep direct and frequent contact with them, they should be your best source of information. This may require some time and money – but there is no doubt these efforts will help you save money and time further down the line by avoiding that you detect the copying too late.

In conclusion, assessing the level of risk of your assets in advance is key to determining whether it is worth protecting them through IPR and other means, like specific contract clauses. This assessment has to be done outside the company but also inside, as risk may well exist in the same country, the same region or even within the company!

The internal strategy for IPR control and management described in step 4 will build upon the results of this risk assessment.

STEP 3: MAKE MONEY AND CREATE VALUE USING YOUR IP

Direct Benefits

The sale, purchase or licensing of IP can generate substantial profits. However, due to a lack of awareness of the commercial opportunities provided by IP, much of it remains untapped.

So, let's explore how you can avoid this trap.

Find the right partner

To make markets more transparent and provide IP owners with a better overview of who owns what, various trading exchanges for IP have emerged recently. The aim of these exchanges is to bring the buyer and the seller together. Similar to other online exchanges, such as eBay, these IP exchanges are meant to help firms see whether they can license their various forms of IP.³

Another useful tool to help understand where there could be a potential seller, buyer, licensor or licensee for your IP is an IP database. The more comprehensive these databases, the higher the chances that you may find a partner for your IP or that a potential partner may find you. Another opportunity to directly commercialise your IP is auctions. While currently used primarily for patents, there is no reason why other forms of IP should not also be sold at auction, where bidders bid for a specific IP and it is sold to the winning bidder.

You can also identify potential licensors or licensees through networking. For example, attending the meetings of the Licensing Executive Society (LES) may be a good way to find interesting business partners. For more information on that, see <http://www.les.org>.

3. UK IPO: How licensing intellectual property can help your business. <http://www.ipo.gov.uk/licensingbooklet.pdf>

Negotiate the deal!

There are various forms of sales agreements and licensing contracts (e.g. exclusive, non-exclusive and creative common licensing agreements). When you enter into negotiation with a potential buyer or licensor, it is important that you understand very well what your IP is worth and what you bring to the table.

Your bargaining power will increase if you know how solid your IP is from a legal perspective, how likely it is to withstand potential attacks, how long your protection will last and which markets it covers. You should, furthermore, be able to make a solid case about the commercial relevance of your IP to the potential buyer or licensor, i.e. how ownership of the trade mark, patent, copyright etc. will boost revenues.

What should your contract cover?

The contract should contain all specific questions related to the price or the royalty fee, the parties to the agreement, a very clear understanding of what is being sold or licensed, under what conditions the IP is being granted, details about IP protection and infringement, confidentiality clauses, and questions related to warranties and liabilities. Make sure you receive payment, royalties or license fees in a timely manner!⁴

Selling, buying or licensing IP can be a win-win situation!

All of these deals can bring in substantial amounts of cash. In addition, they offer further opportunities for both the buyer and the seller, as well as for the licensor or the licensee. It may mean generating cash from IP the company may not directly need in its business model.

What to watch out for

If you license your IP out, there is a certain risk that the licensee will not have sufficient capacity to turn the IP into a successful source of revenue. In this case, it will be the licensor's responsibility to provide the necessary know how and back up, which may be too expensive to maintain. Thus, it is important to choose your partner wisely!

4. The waterfront Partnership: Licensing IP. <http://www.waterfrontsolicitors.com/intellectual-property>

Grasp opportunities

Effective and efficient IP commercialisation involves critical and creative thinking, as well as the constant identification of new opportunities. A variety of tools have been put in place to aid in the search for a potential licensor or licensee. Grasp these opportunities and explore how IP-based business can take on new dimensions!

Indirect Benefits

Apart from providing new income through commercialisation, IP can also boost competitiveness by bringing important indirect benefits to a company:

Enhance the value of your company

Good management of IP assets in a business or marketing plan helps enhance the value of a company in the eyes of financing institutions and investors who are taking a closer look at intangible assets. In that sense, valuation and management of IP assets become central issues in strategic decision-making.

Enhance strategic alliances

The competitiveness of many companies depends on their ability to transfer intellectual property and other intangible assets to their worldwide production processes. IPs are a factor in these decisions since they allow firms to shift innovative activities abroad, to dedicate more resources to innovation and management activities in advanced countries, and to expand operations in emerging markets.

IP enhances strategic alliances with key partners inside the value chain while establishing more effective, clear, safe and durable business relationships. Non-disclosure agreements should be signed when beginning strategic negotiations, specific clauses in contracts should be put in writing, and clear rules related to IP should be decided upon when setting up partnerships. This will undoubtedly clarify and consolidate their relationship and thus boost business activities.

Increase market share

The primary source of competitive advantage for all businesses is innovation and original creative expressions. Protecting the company's assets ensures exclu-

sivity, reduces the risk of trampling the IPR of others, and protects against copying. This exclusivity gives a 'lead-time' advantage over competitors and can even hinder them from bringing a new product or design to the market or keep them out of specific niche markets!

As a result, IP can be used to increase sales in existing markets and to open the door to new potential markets and opportunities, which leads to an improvement in market share.

Secure returns on R&D investments

Managing IP allows secure returns on R&D investments. Nothing is worse than having innovative efforts copied. Using tools to protect our IP allows us to retain control over our assets and ensure that our investment is worthwhile.

Build a sound company

A company has to protect its core knowledge and prevent the leaking of confidential knowledge to outsiders. Possessing exclusive assets and strong core knowledge makes a strong company that motivates its employees and is attractive to potential collaborators. Involving the company and its staff through formal and informal methods to protect its assets builds a sound company.

Open the door to tax optimisation

In some countries, activities related to innovation and/or R&D can lead to tax incentives, especially with regard to corporate income taxes. For instance, companies may have the freedom to amortise expenses related to these activities or to deduct part of them from the tax base. Intellectual property tax advantages also exist when revenue is obtained from patents, designs, trade secrets or layouts, since this income is tax-exempt in many cases. Do not forget to check the availability of such advantages with your national tax authorities.

Compensation for being copied

It is worth mentioning that "benefits" can be gained if you are copied, through a civil action or lodging a criminal complaint, depending on each specific case, once an infringement is detected. In many cases, court actions lead to the payment of compensations (dam-

ages) to the IPR holder, even for unregistered rights like the Unregistered Community Design.

The EU Enforcement Directive deals with this problem (Article 13) and proposes the awarding of compensatory damages corresponding to the actual prejudice (including lost profits) suffered by the rights holder as a result of the infringement. The damages are not only designed to compensate the loss suffered by the rights owner, they can also take into account the element of lost profit⁵.

It may be also possible to make money without a court hearing by entering into negotiations with the infringer or using an alternative method of dispute resolution such as mediation. You may even come to an arrangement to license the infringer to use your design, trade mark or patent, in return for a fee. Thus, as a first step, it may be worth sending a carefully worded warning letter to the person or business you suspect is copying your intellectual property rights to ask them to stop infringing and to demand damages. This may be particularly successful if the infringer has acted in good faith and bought these rights from another (unfair/infringing) company. This strategy may allow you to find new and potential clients with very little effort and investment.

If this doesn't work, you can still take legal action.

Costs and how to lower them

It should be noted that some countries have taken action at the national level to help SMEs lower the costs associated with IP protection. The UK Intellectual Property Office, for example, has abolished IP application fees.

In Germany, the law explicitly states that applicants are entitled to a significant reduction of IP application fees, provided that they demonstrate financial need and are likely to have a successful innovation. It is thus worthwhile to check the relevant legislation in each country.

You should also be aware that some countries offer direct grants and support for innovators and for protection of their IPRs.

As a rule of thumb, always check with your local authorities to see if there are grants or subsidy schemes you may tap into!

5. Directive 2004/48/EC of 29.04.2004 on the enforcement of intellectual property rights

While by no means exhaustive, the following information may be useful:

- <http://www.scottishbusinessgrants.gov.uk/rsa/999.html>

Smart Scotland provides a series of grant schemes for innovative SMEs and for costs associated with IP protection.

In Spain, several specific grants and subsidies are available for SMEs to help them protect their IP, at the national level (Ministry of Industry, Tourism and Commerce) and also at the regional level (see examples for specific grants related to IP: Catalonia, Extremadura, Aragón, Basque Country, etc.).

For more details, visit the OEPM page for grants and subsidies: www.oepm.es, section: "subsidies and grants" or contact: subvenciones@oepm.es

In relation with the SIGNO initiative of the German Federal Ministry of Education and Research, there are various SME grant schemes for the co-financing of certain IP related measures in Germany.

Costs associated with attorney fees are usually not covered by public funding schemes. Many times they may be significantly higher than the actual fees for IP protection, thus you should be cautious when approaching an attorney and double check what she/he will charge.

Litigation can be very expensive, particularly at the international level. To manage these costs it may be possible to buy intellectual property insurance that may cover some of the costs associated with litigation. Please check relevant websites of insurance companies for that. Another way to keep costs associated with litigation at a reasonable level is to seek amicable solutions through mediation and arbitration.

STEP 4: PREPARE YOUR IP STRATEGY

Many SMEs in the textile and clothing sector started as a craft. At that point, intellectual property is far from being a key issue. You actually start by looking at what other businesses have done and try to find your market niche by making similar things. Very soon, you notice that, to grow and develop, you need to make products other than those that are already on the market. You develop your own distinctive style and, with the success of your products, you start worrying about the safety of the business you've built up. That is when the IP reflex suddenly appears.

But not all SMEs in the textile and clothing sector start like this. Some are well aware of the difference of their business model from the very beginning. It is based on an original idea, an innovative business concept or a technological innovation in the production process or in the product or in another component. If your business is of this type, the protection of your intellectual property was likely your primary concern when you started on the market.

The issue of intellectual property rights and their protection eventually pops up regardless of the origin of your business. And when this occurs, you understand that you need a strategy.

To reap the full benefits of the IP system, you need to develop an IP strategy that is fully integrated into your overall business strategy.

Through timely protection and effective use of IP rights, you can become a more viable financial concern and a more attractive investment option for investors and financial institutions and, indeed, for your customers, employees, suppliers and other partners.

Which protection for which asset

Whether you protect it or not, the fruit of your imagination, in terms of new products and processes, constitutes the most valuable asset of your business. Indeed, that is how you satisfy consumer expectations, how you fill a gap on the market and how you position yourself with respect to your competitors. The management of intellectual property and innovation requires as much attention as the production or distribution, for which you obviously set strategies and goals.

In the textile and clothing sector, such concepts are as important as in any other industry.

People often speak of brands but, in our industry, there is another important active element, i.e. the **design or model**, which greatly determines the commercial success or failure of a product, in other words its added value. Therefore, investments in creation and innovation and related topics have to be taken into account in the business strategy from the start. Moreover, their protection is more difficult to ensure than that of brands.

In addition, because of the technological developments over the last few years in matters of image reproduction and electronic transmission, scanning a designs and models catalogue available to the public during

fairs and transmitting these designs and models to the other end of the world has become child's play. Then, producing fakes is easy and doesn't require any know-how. But it represents a considerable threat to research and development in important investments.

As a textile and clothing producer or manufacturer, you clearly have a business strategy. In each subsector, there are many different ways to approach the same economic activity, and maybe you recognise yourself in one of the strategies indicated below:

1. You may work exclusively on a subcontracting basis, with well-known technology, possibly with raw materials or designs supplied by the customer. Clearly, in this case, you are not likely to have an extensive IP strategy. However, if you have a process that is unique, because of the recipe used or the technique applied, you might consider protecting your trade secret and developing contractual clauses for your staff, suppliers or customers.
2. You may market your products exclusively in your local market and have hardly any competitors who are likely to copy your goods. And you might not be very interested in the subject of IP. However, if you use in your production a design that may be covered by a copyright, you would be well advised to have an IP strategy to screen designs and check for such a possibility.

3. As a textile and clothing goods manufacturer, you may have developed an innovative fabric, or a special concept that identifies a range of products. You may have chosen a specific design or pattern that is reproduced on all your creations. The shape of your articles may be original. Or it may be your personality that is the key to your success and that you want to exploit in any type of product, including textile goods. An IP strategy focusing on trade marks and design rights or copyrights and patents could well be the appropriate instrument to secure exclusivity on the market.

These are just some business examples. The reality is much richer than that. But these examples should help you understand the importance of protecting your industrial or intellectual property with instruments that are adapted to the particular asset. Industrial and intellectual property deserves its own place in your business strategy.

Regardless of the type of business you run, to build up your own IP strategy you must follow a methodology.

The following table is a simple way to help you to visualise key issues that you will need to address in your IP strategy:

Asset/risk identified	Examples of geographical coverage/ need/market	Decision	Expected benefit/SME target	priority	Next steps – persons involved	Costs to be foreseen
My particular process	The whole world	Trade secret	For competitors identifying what's in it is virtually impossible/will take so much effort that by the time they get it, the market is gone Target new secret recipe	1	Ensure that certain process steps are only made by me or X	No cost
My brand	EU, USA, Japan	Trade mark	Ensure that on my target markets nobody can copy me	1	Register, Z in charge	Check the costs
Design x	Asia, Europe	Registered Design	Enter a new market	1	X in charge	Check the costs
Patent y	USA	License patent in a country	Earn money from licences. 1M EUR.	2	Identify distribution network, Y in charge	Check the costs
Product z	The whole world	No protection	Make sure we have all the documents needed/steps to follow in case of counterfeiting	3	X in charge	No cost
Contracts with subcontractors	India	Clause in contract	Protect and clarify relationship with manufacturer	2	X in charge	No cost

After checking that your IP is well protected, it is also important to take care to use any other IP in the correct way, to make sure that:

- Purchasers are supplied with products made from original designs,
- Contract manufacturers accept only new and original designs for production,
- Purchasers of designs are not misled as to the new or original nature of their purchase,
- Suppliers of design sketches and outlines are protected with respect to potential purchasers,
- Suppliers have the assurance that their designs will not be reproduced by distributors without their permission

Example of what to check and to agree upon:

For designs produced or purchased by the company:

Never use or reproduce a design in any manner or make a product incorporating any design for which you do not hold the rights. To avoid this, ensure that the rights are assigned to you by the creator employed by you in accordance with national laws. If the designs are owned by a third party unconnected to the company, you must ensure that you acquire the rights to them. You should also preserve and keep updated documents containing at least the following information:

- The date on which the design was produced, where it was created inside the firm, and the name of the designer.
- The date on which the rights were assigned, in the event of a purchase.
- The connection between the design on file and its representation on the product, where applicable.
- A copy of the first delivery invoice.

For designs for contract production: Reproduce only models accompanied by the documents specified above. A written statement by the supplier that the above conditions have been fulfilled may be sufficient. You must also keep files on the designs produced for each supplier.

For sketches, outlines, drafts or samples of designs produced in an offer to conclude future contracts: Always include in your general conditions a penalty clause that will apply if the signatory's potential co-contractor does not accept the offer.

For designs ordered for distribution: Include a penalty clause in contracts with distributors.

Example of penalty clause:

Under no circumstances shall any outline, sketch or sample of a design communicated in connection with

an offer to supply be used in any way whatsoever by any party to whom the design was directly or indirectly communicated if the offer does not result in an agreement.

Any improper use shall, automatically and without further notice, render the person requesting the offer liable to pay compensation of a lump sum of ... EUR or ...% of the turnover (before taxes), whichever is higher. The conclusion of an agreement to supply goods, including designs, shall not in any way constitute authority for the other contracting party to reproduce those designs or cause them to be reproduced without our authorisation.

Any breach of the present clause shall, automatically and without further notice, render the other contracting party liable to pay compensation of a lump sum ofEUR or% of the turnover (before taxes), whichever is higher

Setting up operations and resources

The second issue you need to address in an IPR strategy is the question of resources.

As soon as you start accumulating IPRs, you understand that you cannot manage them by yourself. You need to delegate duties and tasks, you need people to deal with your IPRs and professionally manage them. In other words, for effective IPR management, you should set up operational procedures and mobilise human and financial resources within your company.

In terms of resources, the following issues need to be considered:

- Operational resources
 - define which department will have which role,
 - are you subcontracting IP management?
- Financial resources
 - plan internal budget (protection, renewal and litigation costs), and
 - find out about possible external grants and subsidies
- Administrative resources
 - do you have all the documents needed to protect an available asset?
 - in case of counterfeiting, are there clear operating competences?

In terms of procedures:

- Brand, Technology & Innovation monitoring/surveillance/renewal
 - procedures to ensure a given asset is not easily copied and that, if a copy appears, precise measures are taken,
 - procedures to ensure the IPRs associated with a given technology or innovation, or with the trade mark, are regularly examined for their eventual re-

- newal in the different markets where they are registered, and
- procedures to ensure that existing/future assets are really new.

This task is very important and should be an integral part of the activities of any SME. If an SME has an IP asset, monitoring and surveillance are important, and when developing a new product, monitoring, surveillance and research can help verify at an early stage whether the innovation can actually be protected.

- Training and awareness
- Any company manager must understand that IP protection may require the involvement of many departments, subsidiaries, subcontractors, etc. It is also important to consider training and awareness as regards clients, subcontractors, employees (e.g. for confidentiality agreements).

As you can see from the lists above, as far as resources are concerned, it is not so much a matter of the costs of the initial registration of your rights, but rather a question of keeping all your IPRs alive and maintaining the protection that they grant.

This may require a network of human resources capable of acting against infringements of your rights if and when they occur.

The resource intensity of formal IPR management is generally what worries SMEs. However, sound planning, wise delegation and effective operating procedures can significantly reduce the burden on SMEs and increase efficiency.

Planning and follow-up

The more IPRs you own, the more complex and the more costly their management. This is why it is highly important to avoid any waste of time and money. Efficiency in IPR management can be achieved with sound planning.

IP management involves the setting of clear goals, but also follow-up to ensure they are being reached.

As in any other business strategy, the IPR business plan for an SME in the textile and clothing sector must in-

Example of final “checklist” tool for building IP strategy:

Steps	Issues to be carried out	Person in charge	People/ resources involved	Deadline
Step 0: Preliminary internal checklist: identifying IP assets that strengthen your strategic objectives.	Prepare your internal checklist (e.g. brainstorming)			
Step 1: Find out if your assets/creations are really new.	Conduct internet search (available databases) or hire an attorney.			
Step 2: Assess the risk level for each innovative asset/market/ business.	Identify the risk level of your innovative assets (e.g. a table)			
Step 3: Make money and create value using your IP.	Establish/prioritise your own goals according to direct and indirect benefits of IP			
Step 4: Prepare your IP strategy.	Decision making on type of protection for each asset. Setting up operations and resources <ul style="list-style-type: none"> • Operational resources Internal procedure: Which department will have which role, are we to subcontract IP management? <ul style="list-style-type: none"> • Financial resources - Internal budget and available financial resources - External grants and subsidies • Administrative resources • Technology/innovation surveillance • Training and awareness Involving all departments and partners <ul style="list-style-type: none"> • Dissemination and marketing Planning and follow up <ul style="list-style-type: none"> • Planning actions • Indicators Planning and follow up <ul style="list-style-type: none"> • Planning actions • Indicators 			

clude “indicators” or milestones that can be monitored: dates of creation/publication/protection/renewals/when licensing: cost/benefits, sales results, etc/evolution of sales/market penetration related to specific assets/level of innovation of each asset/no. of people trained internally/no. of internal procedures set up, etc.

Planning and scheduling plays an important role in your IPR strategy. Your IP rights may need to be renewed at different times and in a different way in different countries. You may not want to lose the protection of your trade mark for the life of your business, but you could opt to abandon the protection of a design or certain priority rights. This is possible if a creation has exhausted its profitability or if an invention has been improved and you decide to raise the bar for the state of the art.

Last, but not least, you should plan for promotion and publicity.

Conclusion

Investing in IPRs is clearly a good strategy for textile and clothing goods companies that strive to grow and develop a distinct market niche. The keys for success: innovation, quality... and protection!

The protection of brand names and logos through instruments such as trade marks and copyrights is a natural process that imposes itself upon businesses at a certain moment of its development. But it is up to you to identify this moment and to seize the opportunities that IPRs offer in terms of communication, marketing and share value.

Designs in the textile and clothing industry are very often the most problematic creations to protect because of the enormous quantity of designs per season, their short-term commercial value, their possible protection via design legislation and/or copyright legislation (depending on the country). With or without registration, your company may be easily lost in their

administration. You should keep in mind that a good administration of evidence for dates of creation/disclosure/publication can be very useful if you face unfair competition from your competitors or sometimes from your best clients. Several other tools, such as a penalty clause and transfer deeds in contracts (i.e: those with distributors).

Investing in a collective trade mark may also allow you to spread the costs of managing your IPR among all those participating in the initiative and to provide your customers with an added value. Although it may take some time to gain notoriety and get a return on investment, collective trade marks for textile and clothing can be quite profitable, both for the participants in any such collective initiative and for the consortium managing the IPRs. This is the strategic choice made by four San Leucio (Italy) silk textile makers, G. De Negri & Za.Ma, Tesseci & Cicala, Bologna & Marcaccho and A.L.O.I.S., which announced in 2006 the founding of a consortium to unite their strengths and consolidate their position in the textile industry in view of the threat from China’s textile makers.

Their goals:

- to establish an organisational structure for joint activities to promote their industry and product;
- to create synergies with universities to innovate and stay ahead of foreign competition; and
- to register and manage a San Leucio Textile Silk Quality collective trade mark.

Only the four members of the consortium are authorised to use the trade mark for tailor-made silk fabrics, produced in San Leucio for the business-to-business sector.

Now, is it worth investing in IPR?

Clearly this is a question that every producer in the textile and clothing sector will have to respond to for its own business. But it is a fact that the most successful companies in the textile and clothing sector are those who have done so.

National Factsheets



Republic of Bulgaria

Design rights

Applicable Laws

Law on Industrial Designs in force since 14/12/1999, recent amendment 20/07/2007.

http://www1.bpo.bg/images/stories/laws/law__ids_july2007.pdf

Regulation on the Drafting, Filing and Examination of Applications for Industrial Design Registration in force since 1/02/2000, recent amendment 25/03/2008
http://www1.bpo.bg/images/stories/laws/reg_id_eg.pdf

What can and cannot be protected?

The following can be protected as an industrial design: the appearance of the whole or a part of a product resulting from the specific features of the shape, lines, contours, ornamentation, colors, or combinations thereof. A product is any industrial or handicraft article, including parts of a complex article, sets, compositions of articles, packaging, graphic symbols and topographic typefaces.

An industrial design can be registered if it is new and has an individual character.

Parts of a product can be protected only if they are visible during the normal use of the product.

The following cannot be registered as an industrial design in Bulgaria:

- computer programs;
- a design that is contrary to public order or the principles of morality.
- a design the specific features of which are solely determined by the technical function of the product.
- a design the specific features of which are solely determined by the necessity for the product, in which the design is incorporated or to which it is applied, to be mechanically assembled or put in,

around or opposite to another product, so that both products perform their functions, with the exception of a design intended to allow the assembly or connection of interchangeable products within a modular system.

Formalities

Any person having a permanent address or headquarters in the Republic of Bulgaria may file an application with the patent office (BPO), either personally or through a local IP representative. Persons with no permanent address or headquarters in the Republic of Bulgaria use a local IP representative to file an application.

The right to file a design application belongs to the creator or his successor in title. If the design is a service design, the right to file belongs to the employer or to the commissioning person.

The registration application can be delivered by hand, sent by post or by fax (+359 2 873 52 58) to the BPO. It shall contain:

- application form, available at <http://www1.bpo.bg/images/stories/blanki/01pd.doc>, with original signature;
- the name and address of the applicant;
- one or more graphic or photographic representations that clearly and fully show the design for which protection is sought.

Several designs of the same class of the Locarno International Classification for Industrial Designs may be filed in a single application.

If the application contains all that data, the patent office shall give the application a filing date.

The date the application is filed is important since that is the starting point for calculating the protection period and for determining the novelty and individual character of the design.

You can find more information concerning the filing of the application at:

http://www1.bpo.bg/index.php?option=com_content&task=view&id=117&Itemid=364

Costs (at the date of publication)

The fees due are published on the BPO Web site at: http://www1.bpo.bg/images/stories/tariff/tariff_07_new_bg.pdf.

	BGN (leva)
Filing an application	50
Examination of an application:	
- one design	150
- each subsequent design	80
- a set or a composition	240
Registration of a design	200
Issue of a registered design certificate	60
Publication of the following in the Official Bulletin:	
a) an application - for each representation	40
b) a registered design - for each representation	40

Renewal of registration	BGN (leva)
a) first renewal	300
b) second renewal	400
c) third renewal	500
d) up to 6 months after expiration of the term upon payment	extra 100 plus 50% of the corresponding fee

Examination

An application that meets the formal requirements is published in the BPO Official Bulletin. Within 2 months of the publication date, any person may file an objection, prompting a substantive examination of the design.

When judging novelty, materials may also be taken into account to prove that the design has been made public or used in any other way.

If a design is ineligible for registration, the applicant shall be notified, informed of the grounds for the refusal and allowed three months to lodge an objection.

If a design is found to be eligible for registration, the applicant shall be notified accordingly and allowed 1 month to pay the fees for registration, a registration certificate and publication. Once the design is registered a registration certificate will be issued within a month. If the appropriate fees are not paid, the application shall be deemed withdrawn.

Duration of protection

Designs are registered for a period of 10 years from the date the application is filed. The registration may be renewed for 3 successive periods of 5 years each upon payment of a fee.

Ownership of the right

The right to a design is acquired through its registration with the patent office. As of the date the application is filed, the holder of the design is given the exclusive right to use it and dispose of it, as well as to prohibit other parties from copying or using it without his consent.

If the right to a design is held by two or more persons, each holder may use the design without the consent of the other holders and without informing them of that use, unless otherwise agreed in writing.

With regard to third parties acting in good faith, the right conferred shall take effect on the date of publication of the registration of the design.

Trade mark rights

Applicable Laws

Law on Marks and Geographical Indications in force since 14/12/1999, with recent amendment 20/07/2007.

http://www1.bpo.bg/images/stories/laws/law__marks_july2007.pdf

Regulation on the Drafting, Filing and Examination of Applications for registration of marks and geographical indications in force since 1/02/2000, recent amendment 25/03/2008.

http://www1.bpo.bg/images/stories/laws/tm_grul_07__en.pdf

What can and cannot be protected?

Marks are signs that can be represented graphically and are used to distinguish the goods or services of one natural or legal person from those of other persons on the market. Such signs may be words, including the names of persons, or letters, numerals, drawings, figures, the shape of goods or of their packaging, a combination of colours, sound signals or any combination of such elements. Marks may be trade marks, service marks, collective marks or certification marks.

Formalities

An application may be filed by any Bulgarian or foreign natural or legal person. Under Bulgarian law, the applicant does not necessarily need to be an industrial or commercial establishment that manufactures or trades the goods or provides the services for which it wishes to register the mark.

Any person having a permanent address or headquarters in the Republic of Bulgaria may file an application with the BPO either personally or through a local IP representative. Persons with no permanent address or headquarters in the Republic of Bulgaria may file an application through a local IP representative only.

The registration application can be delivered by hand, sent by post or by fax (+359 2 873 52 58) to the BPO. It shall contain:

- application form, available at http://www1.bpo.bg/images/stories/blanki/tm_form02tm.doc, with original signature;
- the name and address of the applicant;
- a representation of the mark;
- a list of the goods and/or services, as defined in the International Classification of Goods and Services, for which the registration is requested.

If the application contains all that data, the patent office shall give the application a filing date.

More information concerning the filing of the application is available at:

http://www1.bpo.bg/index.php?option=com_content&task=view&id=116&Itemid=369

Costs (at the date of publication)

The fees due are published on the BPO Web site at: http://www1.bpo.bg/images/stories/tariff/tariff_07_new_bg.pdf.

	BGN (leva)
Filing of application and examination: - up to three classes - each subsequent class	200 60
Publication of application	40
Registration	300
Issue of registration certificate	60
Publication	40

Examination

Any application that satisfies the formal regularity requirements is published in the BPO Official Bulletin. Within 2 months after the publication date, any third party may file an objection. Within 1 year following expiry of this term, a substantive examination of the application is carried out regardless of whether there is an objection.

The examination procedure includes an analysis of the absolute grounds, a search of the files of marks applied for or registered via the national and international route, and examination of the relative grounds for registration. If the mark is ineligible for registration for some or all of the goods or services, the applicant shall be notified. It shall be informed of the reasons for the refusal and allowed 3 months to respond. If the applicant fails to present a reasoned objection and/or restrict the list of goods or services, the registration shall be denied.

The analysis of absolute grounds includes analysis of whether the applied mark is devoid of any distinctive character, if it consists exclusively of signs or indications that have become customary, if it consists exclusively of signs designating the kind, quality, quantity, intended purpose, value, geographical origin, time or process of production of the goods, etc. The analysis of relative grounds is an analysis for identity or similarity of the applied mark with an earlier mark, and of the goods or services of the applied mark with those of the earlier mark.

Until a decision is taken on the application, the applicant may withdraw it or restrict the list of goods or services for the mark is sought.

If the mark is found to comply with the provisions of the law, the registration shall be issued. After payment of the prescribed fees, the registration shall be entered in the State Register of Marks and, within 1 month, the applicant shall be issued a registration certificate.

Advancement of examination may be requested upon payment of 200 BGN.

Duration of protection

Marks are registered for a period of 10 years from the filing date. Registration may be renewed for an unlimited number of additional 10-year periods upon payment of a fee.

Ownership of the right

The right to a mark is acquired through registration with the patent office. As of the date the application is filed, the mark holder is given the exclusive right to use it, to dispose of it, as well as to prohibit other parties from using it in the course of trade without its consent. "Using in the course of trade" means:

- Affixing the sign to the goods or to the packaging thereof;
- Offering the goods, placing them on the market or stocking them for such purposes, or offering or supplying services under that sign;
- Importing or exporting the goods under that sign;
- Using the sign on business papers and in advertising.

The right shall take effect with regard to third parties acting in good faith starting on the date of publication of the registration of the mark.

Note: Bulgarian law stipulates the obligation to use the mark, namely if, within a period of 5 years following registration, the proprietor has not put the mark to genuine use on the territory of the Republic of Bulgaria in connection with the goods or services for which it is registered, or if such use has been suspended for an uninterrupted period of 5 years, the registration may be revoked, unless there are legitimate reasons for non-use.

Patent rights, including utility models

Applicable Laws

Law on Patents and Utility Model Registration in force since 9/11/2006, recent amendment 20/07/2007. http://www1.bpo.bg/images/stories/laws/law_on_pumr_amended_2007.pdf

Regulation on the Drafting, Filing and Examination of Patent Applications in force since 28/03/2008.

http://www1.bpo.bg/images/stories/laws/patents_regul08.pdf

What can and cannot be protected?

Patents are granted for inventions in any field of technology. The subject of a patent may be a product (article, device, machine, appliance, substance, etc.) or a process.

No utility model registration shall be granted for biotechnological inventions, methods, chemical compounds or the use thereof.

Formalities

The right to file an application belongs to the inventor or to his successor in title. If the invention is a service invention, the right to file belongs to the employer.

Any person having a permanent address or headquarters in the Republic of Bulgaria may file an application with the BPO, either personally or through a local IP representative. Persons with no permanent address or headquarters in the Republic of Bulgaria may file an application through a local IP representative only.

The application for the granting of a patent or for the registration of a utility model, available at http://www1.bpo.bg/images/stories/blanki/appl_patent.doc and <http://www1.bpo.bg/images/stories/blanki/01pm.doc>, shall contain a description of the invention/utility model, drawings.

If the application contains all that data, the patent office shall give the application a filing date.

You can find more information concerning the filing of the application at:

http://www1.bpo.bg/index.php?option=com_content&task=view&id=115&Itemid=356

Costs (at the date of publication)

The fees due are published on the BPO Web site at: http://www1.bpo.bg/images/stories/tariff/tariff_07_new_bg.pdf. If the applicant is the inventor, a micro or small enterprise, a state or public school, a state higher education establishment or an academic research organisation financed by the state, the fees for filing, examination, etc. are reduced by 50%.

Fees for inventions	BGN (leva)
Filing of applications	50
Patent claims – for each claim after the 10 th	20
Formal examination	50
Preliminary examination and verification of admissibility – for one invention	160
Preliminary examination and verification of admissibility for a group of inventions: - a group of two inventions - each subsequent invention	200 80
Search and examination of application for one invention	200
Search and examination of application for a group of inventions: - group of two inventions - each subsequent invention	300 80
Publication of an application	80
Granting of a patent	80
Publication of patent description, claims and drawings: - up to 10 pages - each page after the 10 th	100 12

Fees for utility models	BGN (leva)
Filing of application	50
Formal examination	200
Claim of priority - for each priority	20
Search at applicant's or other person's request	200
Examination of a utility model at the applicant's or other person's request	200
Registration of a utility model	100
Granting of a registration certificate	50
Publication of patent description, drawings, claims and abstract: - up to 10 pages - each page after the 10 th	100 12

Examination

A preliminary examination is carried out within 3 months for any patent application that meets the formal requirements. Up to 13 months from the date the application is filed or the priority date, the applicant may file a request for a search and examina-

tion for the application's subject matter for a fee. The application is published at the end of the 18th month and is then subject to a search and examination regarding its compliance with the novelty, inventive step and industrial applicability requirements.

A registration procedure is carried out for any utility model application that satisfies the formal requirements. This procedure does not include verification of novelty or inventive step but serves only to make sure there is no evident conflict with Art. 10 of the law. Registered utility models are published. A search and examination may be carried out at the request of the applicant/holder or a third party during the term of validity of the utility model registration.

Note: Before expiration of the term for payment of fees for the patent granting and publication, the applicant may file a request for transformation of the patent application into an application for utility model registration. The transformed application shall preserve the filing date and the priority date of the initially filed patent application, which is deemed withdrawn.

Duration of protection

The term of validity of a patent is 20 years from the date the application is filed.

The term of validity for a utility model registration is 4 years from the date the application is filed. It may be renewed for 2 successive periods of 3 years each.

You can see the maintenance fees at: http://www1.bpo.bg/images/stories/tariff/tariff_of_fees_may_07.pdf

Ownership of the right

The legal protection for a patentable invention is granted by a patent issued by the BPO that certifies the holder's exclusive right to the invention. The scope of legal protection is defined by the claims. The exclusive right to the invention entitles its holder to use it, dispose of it, and prohibit other parties from using it without his consent.

What to do if I am copied (designs, trade mark, patents)

Any holder of registered IP rights that are used illegally by others may resort to the following solutions:

- Administrative penal solution for infringing design or mark rights: submit a request to the BPO to impose sanctions for infringing IPR (the due tax is 200 BGN);
- Civil solution: bring an action before the Sofia City Court;
- Criminal law solution: bring an action before the regional court competent to hear the case;
- Application of border controls;
- Request invalidation of the wrongful registration before the BPO's "disputes" department. Request forms are available on the BPO Web site.

For industrial designs:

<http://www1.bpo.bg/images/stories/blanki/12pd.doc>

For trade marks:

<http://www1.bpo.bg/images/stories/blanki/13tm.doc>

For patents and utility models:

http://www1.bpo.bg/images/stories/blanki/request_nullity.doc

Note: It is important to be aware that the registration of a design, trade mark, patent or utility model is territorial, i.e. a registration under the national laws is effective in the territory of the Republic of Bulgaria. The Law on Patents and Utility Model Registration provides for provisional protection which is effective retroactively from the publication of the mention of the patent grant. The scope of such protection is defined by the claims.

Copyrights and related rights

Applicable Laws

Law on Copyright and Neighbouring Rights in force since 1/08/1993, recent amendment 20/07/2007

http://mc.government.bg/files/82_ZAPSP-New.doc

The Copyright and Neighbouring Rights law falls under the competence of the Ministry of Culture of the Republic of Bulgaria, Copyright and Neighbouring Rights Directorate.

Contact:

Address: 17, Al. Stamboliyski Blvd.

Phone: +359 2 9400 821

What can and cannot be protected?

Intellectual creations in the literary, scientific and artistic fields are subject to protection under the Law on Copyright and Neighbouring Rights.

Normative state documents and their translations, ideas, concepts, folklore works, news, facts, information and data are not protected by this law.

Formalities

Entitlement and exercise of author's rights (copyrights) are not subject to any formality. Therefore, no formal procedure is required for the recognition of an author's rights to a work. Submitting a work to a notary provides evidence confirming the date, which can be evaluated by a court in the event of legal proceedings on the violation of the rights to that work.

Costs (at the date of publication)

Since there are no formalities required, no costs are incurred for copyright protection.

Examination

Not applicable.

Duration of protection

A copyright lasts for the author's life and 70 years after death, starting on 1st January of the year after the author's death.

Ownership of the right

The right belongs to the creator(s). The right may be transferred or licensed by the creator(s) while alive or inherited after death for 70 more years.

What to do if I am copied (copyrights and related rights)

Civil law protection in cases of infringement of rights to Community designs shall be effected in accordance with the procedure established in the regulation. When claims are lodged and measures are requested in connection with the protection of an un-

registered community design in the Republic of Bulgaria, Bulgarian law shall apply. The competent court for claims is the Sofia City Court as a court of first instance and the Sofia Court of Appeals as a court of second instance, both courts being Community design courts as defined by the regulation.

Actions at customs

Actions by customs authorities follow EU Regulation 1383/2003, the Law on Patents and Utility Model Registration, the Law on Marks and Geographical Indications, and the Law on Industrial Designs.

Under the above laws, the holder of the right to a patent, supplementary protection certificate, registered utility model, design or mark, or the holder of an exclusive license, may request that customs officials detain goods brought across the border of the Republic of Bulgaria if there is good reason to believe that they infringe a right protected under those laws.

Border controls shall be applied upon written request to customs authorities by the holder of the right or at the initiative of customs officials.

The request shall contain a detailed description of the articles. It shall be accompanied by a copy of the protection document, as well as a document certifying that the registration is valid, both documents having been issued by the patent office.

Customs authorities shall collect fees as determined by the Council of Ministers for the consideration of requests and for the application of border controls.

If an infringement is ascertained, the customs officials shall detain the goods. They shall promptly notify the petitioner, the consignee and the consignor of the detention.

If, within 10 working days of the date on which the petitioner was notified of the detention, he fails to furnish evidence that proceedings have been initiated before the respective court to settle the dispute or that security has been allowed, the customs officials shall release the detained goods, provided that all clearance requirements are satisfied. The petitioner may file a reasoned request for the term to be extended another 10 working days.

The competent authorities shall hand down a judgment in response to an appeal from the interested

party as to whether the detention measures are to be affirmed, modified or reversed.

The customs officials shall bear no responsibility for being unable to identify the articles for which detention is requested during a control, or for detentions performed in good faith.

The customs officials may, on their own initiative or at the request of another state agency, detain goods if there are grounds to believe they infringe an IP right. In such cases, they shall promptly notify the IPR holder, the consignee and the consignor of the detention.

For information and questions for the customs agency on matters relating to IP rights:

Phone: +359 2 9859 4254 and +359 2 9859 4252

Web site: <http://www.customs.bg/bg/page/170>

Alternative ways to deal with infringements

The protection granted by the provisions of the Competition Protection Law is an alternative way to deal with infringements in Bulgaria.

Proceedings before the Commission for Protection of Competition (CPC) shall be initiated at the request of persons whose interests are affected or threatened with infringement under the Competition Protection Law, or at the request of persons whose interests are affected by acts issued in conflict with the law.

Web site: www.cpc.bg

Link to the request form:

<http://www.cpc.bg/system/storage/Forma.m2.doc>

Information on how to complete the request form:

<http://www.cpc.bg/system/storage/Forma.m1.doc>

<http://www.cpc.bg/system/storage/Forma.m3.doc>

Tel. of the CPC: +359 2 935 6113

E-mail of the CPC:

cpcadmin@cpc.bg

Contact of the Bulgarian Patent Office:

Patent Office of the Republic of Bulgaria
52b, G. M. Dimitrov Blvd.
1040 Sofia
Bulgaria
tel.: +359-2 9701 + extension number
tel.: +359-2 9701 302
fax: +359-2 873 52 58
e-mail: bpo@bpo.bg
web site: www.bpo.bg

For information about services offered by the Patent Office:

tel.: +359-2 9701 321
E-mail: services@bpo.bg

Czech Republic

Design rights

Applicable laws

The industrial design protection in the Czech Republic is regulated mainly by Act no. 207/2000 Coll. on Protection of Industrial Designs. All the relevant legal regulations, as well as other useful information, are available on the IPO CZ Web site (www.upv.cz) in both Czech and English.

What can and cannot be protected?

The results of designer's creative work can be protected by registration in the industrial design register managed by the Industrial Property Office of the Czech Republic (IPO CZ). The basic conditions for registration are novelty and individual character of the design.

Formalities

To register a work in the register, the applicant or his/her attorney must submit an application to the IPO CZ. Paper application forms are available in the IPO CZ premises, and the electronic form is available on the IPO CZ Web site (www.upv.cz). Registered users may use an online application form.

In the application, it is necessary to include a picture of the industrial design (5 copies), information about the applicant and the applicant's or his/her attorney's signature.

The registration procedures before the IPO CZ, and therefore the application filing, must be done in Czech. If the applicant's residence is outside of the EU, he/she has to be represented by an attorney who is a member of the Chamber of Patent Attorneys - <http://www.patzastupci.cz> or the Czech Bar Association - www.cak.cz.

Costs (at the date of publication)

The basic administration fees connected with industrial design protection in the Czech Republic valid as of January 2005 are as follows:

single application filing CZK 1,000.-
multiple application filing CZK 1,000.-
for the first design and CZK 600 for each subsequent design (if the applicant is also a designer, the application fees are only half of the above-mentioned amount)

Renewals	Costs (in CZK)
1 st renewal	3,000.-
2 nd renewal	6,000.-
3 rd renewal	9,000.-
4 th renewal	12,000.-

A complete list of fees is stated in the enclosure of Act. no. 634/2004 Coll. on Administrative Fees.

Examination

The industrial design application procedure takes an average of 7 months. During this period, a formal and substantial examination is performed by the examiners.

Duration of protection

If all the requirements are met and the procedure results in registration, the applicant is entitled to 5 years of protection from the date the application is filed. The owner of the rights can repeatedly renew the protection for 5-year periods, up to 25 years.

Ownership of the right

The registration of an industrial design confers upon its holder the following exclusive rights:

- The option to use the right, to prevent any third party from producing, manufacturing, selling or economically exploiting the protected industrial design without the holder's consent.
- The right to transfer the right or to grant licences to third parties to exploit the industrial design.

The rights conferred by the design right upon registration shall take effect the day the application is filed.

Trade mark rights

Applicable laws

Issues related to trade marks are governed mainly by Act no. 441/2003 Coll. on Trade Marks. All the relevant legal regulations, as well as other useful information, are available on the IPO CZ Web site (www.upv.cz) in both Czech and English.

What can and cannot be protected?

Trade mark protection in the Czech Republic can only be provided to a designation that can be graphically represented and that can distinguish products or services for which it is registered from other identical products or services placed on the market by other business sources. A trade mark can, for example, be a word, a picture, a combined designation consisting of a word and a picture, a three-dimensional designation or a colour or combination of colours.

Designations that cannot constitute a trade mark:

- a sound-based designation or those interfering with public order or morality,
- designations which may mislead the public (for example as to quality or geographical origin of goods),
- designations containing signs of high symbolic value (esp. religious symbols),
- designations with which it is apparent that the trade mark application was not filed in good faith,
- designations infringing a third person's rights, etc..

Formalities

To be registered in the trade mark register the applicant or his/her attorney must submit an application to the IPO CZ. Paper application forms are available in the IPO CZ headquarters; the electronic form is

available on the IPO CZ Web site. Registered users may use an online application form.

With the exception of word trade marks, it is necessary to enclose a picture (3 copies). The application should also contain the list of goods and services for which protection is sought.

The registration procedures before the IPO CZ, and therefore the application filing, must be done in Czech. If the applicant's residence is outside of the EU, he/she has to be represented by an attorney who is a member of the Chamber of Patent Attorneys - <http://www.patzastupci.cz> or the Czech Bar Association - www.cak.cz.

Costs (at the date of publication)

The basic administration fees tied to trade mark protection in the Czech Republic valid as of January 2005 are as follows:

Individual trade mark application fee (includes 3 classification classes)	CZK 5,000.-
Registration renewal	CZK 2,500.-

A complete list of fees is stated in Act no. 634/2004 Coll. on Administrative Fees.

Examination

The trade mark application procedure takes an average of 8 months. Within this period, a formal and substantial examination is performed by the examiners. If all requirements are met, the application is published in the Official Journal of the IPO CZ for 3 months. During this period third parties can file an opposition. A successful procedure results in registration in the National Trademark Register.

Duration of protection

The applicant is then entitled to 10 years of protection from the date the application is filed. The owner of the trade mark can repeatedly renew the protection for periods of 10 years.

Ownership of the right

The registration of a trade mark confers the following exclusive rights upon its holder:

- The right to use the trade mark for the goods or services covered by the trade mark,
- The right to prevent third parties from using, without the holder's consent, any sign, equal or similar, on products or services for which the trade mark has been protected,
- The right to use, in order to dissuade potential violations, the ® sign on its products together with the trade mark,
- The right to transfer the registration or to grant licences to third parties to exploit the trade mark, for free or for a fee,
- The rights conferred by a trade mark are effective from the day the trade mark enters into the trade mark register.

Patent rights, including utility models

Applicable laws

There are two possibilities for legal protection of technical solutions in the Czech Republic: a patent and a utility model. The two differ mainly in the duration of protection and costs; the subject of protection is the same.

Protection by patent or utility model is regulated mainly by Act no. 527/2002 Coll. on Inventions and Innovations and Act no. 478/1992 Coll. on Utility Models. All the relevant legal regulations, as well as other useful information, are available on the IPO CZ Web site (www.upv.cz) in both Czech and English.

What can and cannot be protected?

The basic conditions in both cases are novelty, inventive step and industrial applicability.

Formalities

To obtain a patent or utility model, the applicant or his/her attorney must turn in an application to the IPO CZ. By filing the application the applicant acquires priority. Paper application forms are available in the IPO CZ premises; the electronic form is available on the IPO CZ Web site. Registered users may use an online application form.

The procedures before the IPO CZ, and therefore the application filing, must be done in Czech. If the applicant's residence is outside of the EU, he/she has to be represented by an attorney who is a member of

the Chamber of Patent Attorneys - <http://www.patza-stupci.cz> or the Czech Bar Association – www.cak.cz .

Costs (at the date of the publication)

The basic administrative fees valid as of January 2005 are as follows:

Patents	Costs (in CZK)
application	1,200.- *
full examination	3,000.-
Maintenance fee 1 st -4 th year, per year	1,000.-

Utility models	Costs(in CZK)
application	1,000.- *
Validity prolongation by 3 years	6,000.-

* (if the applicant is at the same time an inventor, then the application fees are only half of the above-mentioned amount)

A complete list of fees is stated in the enclosure of Act. no. 634/2004 Coll. on Administrative Fees.

Examination

Utility model registration is based only on a formal examination, no substantial examination is performed.

The patent procedure includes both formal and substantial examination. The Czech Republic practises so-called deferred examination. A request for a full examination must be applied for within 36 months from the application's filing. The application is published 18 months after the priority date (the date on which the application was filed).

The average patent procedure takes about 4 years from the filing date, while the utility model procedure takes 2-3 months.

Duration of protection

The maximum period of validity is, in connection with the owner's will, up to 20 years from the filing date. The patent shall take effect on the date of publication of the announcement of its granting in the Official Bulletin of the IPO CZ. A registered utility model is valid for 4 years from the date the application is filed, and this period can be extended twice (in each case for three years) up to 10 years.

Ownership of the right

Patent or utility model granting confers the following exclusive rights upon its holder:

- The right to exploit the invention in any part of the country,
- The right to prevent third parties from producing, manufacturing, selling or economically exploiting the protected product or process without the owner's consent. It also prevents others from seeking protection for the same product or process, and employing or applying the same means or processes disclosed in the patent or utility model that has been granted,
- The right to transfer the right or to grant licences to third parties to exploit the invention, for free or for a fee.

What to do if I am copied (designs, trade mark, patents)

If your products or services or designations are illegally copied you can enforce your rights through judicial or extra-judicial means. In public cases, you can turn directly to the courts (www.justice.cz), while in civil cases you should contact:

- IPO CZ (www.upv.cz),
- Customs authorities (www.cs.mfcr.cz),
- Czech Trade Inspection (www.coi.cz), or
- Police of the Czech Republic (www.pcr.cz).

Many claims can, however, be solved by negotiating with the violator or through arbitration assisted by the Association of Arbitration and Mediation in IPR (www.csvts.cz/aprvdv).

Issues connected to IPR enforcement are regulated by Act no. 221/2006 Coll. (available in both Czech and English on the IPO CZ Web site – www.upv.cz).

In a dispute it is advisable to keep all the documents related to procedures before the IPO CZ upon which results you base your rights.

Copyright and related rights

Applicable laws

Act no. 121/2000 Coll. on Copyright and Related Rights, which is available in both Czech and English at the following address: <http://www.mkcr.cz/scripts/detail.php?id=2897>

What can and cannot be protected?

The subject of copyright is the so-called author's work. It is defined as a literary, artistic or scientific work that is the unique result of an author's creative work and is expressed in any objectively perceivable way. A theme of work, idea, procedures, principals, methods etc. is not considered a subject of copyright.

Formalities

Entitlement and exercise of author's rights (copyrights) are not subject to any formality. Therefore, no formal procedure is required for the recognition of author's rights to a work. Submitting a work to a notary provides evidence confirming the date, which can be evaluated by the court in the event of legal proceedings on the violation of the rights to that work.

Costs (at the date of publication)

Since there are no formalities required, there are no costs for copyright protection.

Examination

No examination is necessary, however, due to the fact that the management of a copyright is very complicated, the Czech Republic has several collective administrators whose duty it is to protect and apply the economic rights of authors and to make the subject of protection available to public. The list of collective administrators is available at the following address: <http://www.mkcr.cz/scripts/detail.php?id=360>. The activities of collective administrators are supervised by the Czech Ministry of Culture (www.mkcr.cz), which is responsible for all issues related to copyright and related rights.

Duration of protection

The economic rights last 70 years after author's death and are subject to heritage.

Ownership of the rights

The author is entitled to moral rights (such as the right to make a decision to publish, to be mentioned as an author, the right for integrity of the work etc.)

and economic rights (such as the right to spread or disseminate the work, the right to loan, rent, run or exhibit the work etc.).

All author's rights are non-negotiable and cannot be renounced.

In certain cases (e.g. use for personal needs of an individual) the use of a work is not considered to be copyright infringement.

Copyright and related rights may be subject to licence agreements, which do not have to be made in writing.

What to do if I am copied (copyrights and related rights)

If your copyright is infringed, you can enforce your rights through judicial or extra-judicial means. In public cases you can turn directly to the courts (www.justice.cz), while in civil cases you should contact:

- Collective Administrators <http://www.mkcr.cz/scripts/detail.php?id=360>
- Customs authorities (www.cs.mfcr.cz),
- Czech Trade Inspection (www.coi.cz) or
- Police of the Czech Republic (www.pcr.cz).

Many claims can, however, be solved by negotiating with the violator or through arbitration assisted by the Association of Arbitration and Mediation in IPR (www.csvts.cz/aprvdv).

Actions at customs

Applicable laws

The Czech Customs Administration operates mainly on the basis of EC Regulations no. 1383/2003, EU Regulation no. 1891/2004 191/1999 and Act. No. 13/1993. All legal rules are available at the following link: <http://www.cs.mfcr.cz/CmsGrc/Obchod-se-zbozim/ochrana-duse/Legislativa.htm>

In case of infringement, the rights owner can place a request with the Customs Administration for:

- **Application of Action** to prohibit infringement of intellectual property rights. This request is filed with Directorate of Customs in Hradec Králové using the following form: <http://www.celnisprava.cz/CmsGrc/Obchod-se-zbozim/ochrana-duse/formulare.htm>.
- **Carrying out Market Oversight**, based on Act. No. 634/1992 on Consumer Protection. It can be filed with the appropriate local Customs Administration. The inducement to carry out oversight does not require any particular form filling. The inspection within the oversight is subject to the rights owner presenting documentation. Authorities inspect whether the rights were infringed and carry out legal regulations infringement process. Then they levy a fine and decide whether the goods will be foreclosed, seized or returned.

Alternative ways to deal with infringements

Solving a dispute between two parties in a matter of industrial property rights can also be settled by mutual agreement (for example, a licence agreement). Should this fail, it is also possible to address an Arbitration Court of the Czech Republic (<http://www.rozhodcisoud.net/index.php>).

Contact of the National Patent Office:

Industrial Property Office of the Czech Republic (UPV)
Antonina Cermaka 2a
160 68 Prague 6; Czech Republic
posta@upv.cz
www.upv.cz
Tel: +420 220 383 111
Fax: +420 224 324 718

France

Design rights

Applicable laws

Industrial Property Code – Livre V articles L. 511-1 to L. 521-7.

(<http://www.legifrance.gouv.fr/>)

What can and cannot be protected?

It is possible to register an industrial design that meets both of the following conditions:

- A. it must be new
- B. it must have a distinctive character

For more information on this subject go to:

<http://www.inpi.fr/fr/dessins-et-modeles.html>

The following cannot be registered as an industrial design in France:

- Computer programs;
- Products dictated solely by their technical function;
- The shape of a product imposed by the need to be associated with another product, so that each one can fulfil its function;
- Products with a design that goes against public order or good morals.

Formalities

In France, a design or model is automatically protected by copyright. The registered design protection is an additional but useful protection.

To register drawings and models with INPI (Institut National de la Propriété Industrielle), it is necessary to complete an application and start a file. The application can be downloaded at: <http://www.inpi.fr/fileadmin/mediatheque/pdf/dm858.pdf>

You can deliver it by hand, send by post with acknowledgement of receipt or by fax (+331 53 04 52

65) to the INPI office (address: INPI - 26bis rue de Saint Petersburg 75008 Paris).

The application for an industrial design registration must contain:

- the form of deposit, in copy, with original signature;
- graphic reproductions of each drawing or model, in two identical copies for a traditional filing, or only a single copy for a simplified filing;
- “Continuation” pages if necessary, handwritten and signed;
- payment of royalties or proof of this payment;
- the original authorisation to act “on behalf of” or a copy of the permanent authorisation, if the filing is done by an agent other than a patent attorney or a lawyer.

Applicants may choose between the INPI offices and commercial court grafts to which they belong, or jurisdiction grafts ruling in commercial matters.

A simplified application is available if the applicant represents an industry that frequently renews the collections.

Costs (at the date of publication)

The application fee is 38 EUR.

Applicants also have to pay for graphic and photographic reproduction if they are not filing a simplified application. Those fees are 22 EUR for each black and white reproduction and 45 EUR for each colour reproduction.

The application fee covers the examination procedure of the design and the 5-year protection period of the design.

Every 5 years, the design protection can be renewed for another 5-year period with a maximum of 25 years by paying a 50 EUR renewal fee to the office.

For updated and more detailed figures please refer to www.inpi.fr/fr/dessins-et-modeles.html

Examination

After submission, the file will be the subject of an administrative check by the qualified services of the INPI.

After this examination, there will be a publication in the “Bulletin Officiel de la Propriété Industrielle” (BOPI). The public can see a copy of the reproductions of your design or model at the Paris INPI Office.

This publication may be immediate or may be delayed. It is your choice, according to strategic or commercial considerations. If the applicant does not want to exploit its creation immediately, it may delay the publication for a maximum of 3 years.

Applicants should note that, when filing a simplified application, the publication is automatically delayed. If the applicant wants its creation published, it must provide written notification and pay fees for reproductions.

Then the drawing or model is protected and counterfeiters incur sanctions.

Duration of protection

The protection of a design or model lasts 5 years. If an applicant desires to extend the period of protection, it can request a 5-year renewal every five years. However, the protection of a design or model cannot exceed a maximum of 25 years.

Ownership of the right

The design right resulting from registration confers the exclusive right to use the design and to authorise others to use it. It also includes the right to make, offer, put on the market, import, export, or use a product in which the design is incorporated or to which it is applied, or to stock such a product for those purposes.

Trade mark rights

Applicable laws:

Industrial Property Code – Livre VII articles L. 711-1 to L. 722-7 and R. 712-1 to R. 722-5. (<http://www.legifrance.gouv.fr/>)

What can and cannot be protected?

It is possible to register any sign capable of being graphically represented. These marks may be one or a combination of words (including slogans), letters and numerals. They may consist of drawings, symbols, three-dimensional signs such as shape and packaging of goods, audible signs such as music or vocal sounds, fragrances, or colours.

In France, it is not possible to register trade marks that:

- have no distinctive character;
- have the potential to mislead the consumer;
- do not conform to public order and morality;
- contain symbols of a state, emblems of government or foreign organisations, coats of arms, medals, names or portraits of people, or signs possessing a high degree of symbolic value (such as religious symbols), amongst others (except with the permission of the relevant parties);
- are labels of origin.

For more information on this subject, go to: <http://www.inpi.fr/fr/marques.html>

Formalities

To file an application for the registration with INPI of a trade mark it is necessary to:

- make sure the trade mark is a distinctive word, logo, picture or other sign that clearly distinguishes the specified goods and services from those of other traders;
- check whether someone else has already registered or applied to register a similar mark for similar goods or services;
- decide which classes of goods or services you require in accordance with the Nice classification list;
- fill out the form. Applicants can file an application for registration with help from: <http://formulaire-marque.inpi.fr>;
- deliver it by hand, send by post with acknowledgment of receipt, by fax (+331 53 04 52 65) to the

INPI office or by using the trade mark registration online service (available at: <http://depot-marque.inpi.fr/>) along with the fees and the necessary documents.

Costs (at the date of publication)

Paper filing	225 EUR	one to three classes
Electronic filing	200 EUR	
additional class	40 EUR for each additional class	
Caution:	for filing by fax, an additional fee of 100 EUR will have to be paid	

The filing fee covers the examination procedure of the trade mark and a 10-year period of protection for the trade mark.

Every 10 years, the trade mark protection can be renewed for another 10-year period by submitting to the office a renewal fee of 240 EUR. When submitting the renewal fee, it is possible to add new classes by submitting 40 EUR for each additional class.

Renewal should be requested during the last 6 months of the current registration validity period. An additional fee of 120 EUR must be paid if renewal is requested after the authorised period (no more than 6 months later otherwise the renewal is refused and the trade mark won't be protected anymore).

For updated and more detailed figures, please refer to www.inpi.fr/fr/marques.html

Examination

After the application is filed, INPI will respond by issuing a certificate that includes an application number and the date of application.

The request to register a mark will be published in the "Bulletin Officiel de la Propriété Industrielle" (BOPI), on average 6 weeks after the date of application.

There is a period of 2 months for anyone else to oppose the registration of a mark. The INPI also examines possible irregularities in the application by studying the formal requirements (the designation of the products and services, for example) and the basic conditions (to check that it is indeed a distinctive sign that is not prohibited or misleading).

Before registration is completed, an owner may withdraw an application (total withdrawal) or remove some of the products and services (partial withdrawal).

If an application is not withdrawn and is not rejected following an opposition or an irregularity, the mark is recorded in the national register.

A certificate of registration is issued, which guarantees the protection of the trade mark.

Duration of protection

The registration is valid for 10 years from the date the registration is granted. This period is renewable indefinitely for additional 10-year periods.

Ownership of the right

The registration of a trade mark confers upon its holder the following rights:

- The option to prevent third parties from using any sign, identical or similar, on products or services for which the trade mark has been registered without the holder's consent;
- The option to transfer the registration or to grant licences to third parties to exploit the trade mark, for free or for a fee.

Patent rights, including utility certificate

Applicable laws

Industrial Property Code – Livre VI Titre 1 articles L. 611-1 to L. 615-22 and R. 611-1 to R. 618-5

(<http://www.legifrance.gouv.fr>)

Note: There is no utility model protection in France but there is a utility certificate.

If an applicant wants protection that is cheaper and available for a shorter duration than a patent, it can apply for a utility certificate. Utility certificates provide the same protection as a patent without the expense of a search. The conditions of patentability are the same and the search report is obligatory only if action is sought against a counterfeiter.

What can and cannot be protected?

Protection can be awarded if a product is new, involves an inventive step and has industrial applicability.

There are a number of things that cannot be protected under a patent. For more information:

<http://www.inpi.fr/fr/brevets/qu-est-ce-qu-un-brevet/ce-qui-ne-peut-pas-etre-brevete.html>

Formalities

An application for a patent or a utility certificate can be made online. Only users authenticated and recorded at the INPI can file their patent applications electronically.

To file a patent application, it is necessary to fill out a form that can be downloaded at:

http://www.inpi.fr/fileadmin/mediatheque/pdf/formulaire_brevet.pdf

An applicant can deliver it by hand, send by post with acknowledgement of receipt or by fax (+331 53 04 52 65) to the INPI office. To submit an application for a patent or a utility certificate, it is necessary to present the following documents to the INPI:

- a description of the invention;
- any drawings that may be required for a complete understanding of the description;
- a summary of the invention;
- an image for publication (if drawings are required to understand the summary);
- payment of the application fees.

Costs (at the date of publication)

Application fee	36 EUR	must be paid in the month following application
Search fee for patent not required for utility certificate	500 EUR	If a deferred search is requested, it is not necessary to pay immediately
Delivery fee	86 EUR	
Additional claim	40 EUR	each, starting with the 11th claim.

A reduction of 50% on the main fees (until the 7th annuity) is granted for:

- individuals;

- SMEs of less than 1,000 employees, whose sale turnover is lower than 50 million EUR and as long as no more than 25% of its capital is held by an entity not meeting these first conditions;
- non-profit institutions in the teaching or research sector.

Those institutions and SMEs must make a request within the payment period for the application fee (maximum one month) by attaching a certificate.

Renewal fees are also reduced until the seventh year.

Maintenance Costs in 2009:

1st annuity	Including filing fee		
from 2nd to 5th annuities	36 EUR, with reduction: 18 EUR		
7th annuity	92 EUR, with reduction: 69 EUR		
8th annuity	130 EUR	15th annuity	430 EUR
9th annuity	170 EUR	16th annuity	490 EUR
10th annuity	210 EUR	17th annuity	550 EUR
11th annuity	250 EUR	18th annuity	620 EUR
12th annuity	290 EUR	19th annuity	690 EUR
13th annuity	330 EUR	20th annuity	760 EUR
14th annuity	380 EUR		

For updated and more detailed figures please refer to the www.inpi.fr/fr/brevets.html

Examination

A patent or a utility certificate is not automatically granted. The process begins once the application is filed and includes an examination (unless it is an application for a utility certificate without examination), in accordance with the law governing the protection of inventions.

Once a patent application is filed:

- INPI responds by issuing a filing receipt (application number and the date of the application);
- There is an administrative and technical preliminary examination that takes 6 to 10 months (examinations include, among others, the supervision of the French national defence department and the establishment of a search report by the European Patent Office).
- If an application is made for a utility certificate, there is no need to ask for this search. The novelty of the invention will not be evaluated.

- Publication of the preliminary search report (3 months for possible third person observations).
- Presentation of the final report attached to the granted patent.

Whatever the state of the filing, the patent application is published in the "Bulletin Officiel de la Propriété Industrielle" (BOPI) 18 months after the date of application, accompanied by the preliminary search report if it is available.

Duration of protection

The duration of a patent is 20 years from the filing or priority date.

The protection offered by a utility certificate can last a maximum of 6 years from the filing or priority date if the holder pays annual renewals.

Ownership of the right

The granting of a patent or utility certificate confers upon its owner the following rights:

- to exploit the invention in any part of the country;
- the option to prevent third parties from producing, manufacturing, selling or economically exploiting the protected product or process without the owner's consent;
- to prevent others from seeking protection for the same product or process;
- the option to transfer the right or to grant licences to third parties to exploit the invention, for free or for a fee.

What to do if I am copied (designs, trade mark, patents)

Whatever the copied right relates to a design, a trade mark or a patent, it is possible to use all modes of proof to establish the counterfeit, but there are two privileged ones: the *saisie-contrefaçon* and the holding at customs of the counterfeit goods (for more details see below under Actions at customs).

The *saisie-contrefaçon* is an expeditious procedure that may be virtual (simple description of the products), or physical (real seizure of these products).

It can be carried out by ordinance returned by the presiding judge of the competent court, the TGI (Tribunal de Grande Instance) of the place where the

goods have to be controlled before which summary proceedings are brought.

Once the industrial property rights have been protected, the owners have various means at their disposal to react against the infringers:

- A civil court proceeding involves requesting financial compensation for damages. It is the most frequent choice, particularly because there are specialised jurisdictions that are used to evaluate the amount of the damage based on a financial and technical analysis of the facts.
- The opportunity for a criminal court proceeding is twofold: it makes it possible to start a police investigation and to obtain a judgment against the counterfeiter leading to damages and/or prison. This course of action is less common than the civil procedure, in part because the civil jurisdictions are regarded as more effective with regard to damages, and also because once it has been engaged, a criminal proceeding follows its course, which limits the possibilities for negotiation.

More information is available at: <http://www.contrefacon-danger.com>

Relevant Contacts:

- Anti-counterfeit call centre +33 820 22 26 22
- DDCCRF - Direction Départementale de la Concurrence, de la Consommation et de la Répression des Fraudes - http://www.dgccrf.bercy.gouv.fr/documentation/dossier_litiges/dgccrf.htm
- Customs – by mail - <http://www.douane.gouv.fr> or by phone +33 811 02 44 44
- INPI- Institut national de la propriété industrielle, réseau local - <http://www.inpi.fr/fr/l-inpi/ou-nous-trouver/a-paris-et-en-region.html>

Copyrights and related rights

Applicable laws

Copyright and Related Rights–Industrial Property Code – Livre I - III

- Industrial Property Code, article L. 111-1 to L. 343-4 and R. 111-1 to R. 335-2
- Law on Copyright and Related Rights in the "société de l'information" (DADVSI) 1st August 2006

For more information: <http://www.legifrance.gouv.fr>

What can and cannot be protected?

Intellectual creations in the literary, scientific and artistic fields are subject to protection under the Copyright and Related Rights Code.

Ideas, processes, systems, operational methods, algorithms, concepts, principles or discoveries are not protected by this Code.

The protection of these works is independent of disclosure, publication, utilisation or exploitation.

For more information go to:

- http://www.industrie.gouv.fr/guidepropintel/fiches_pratiques/le_droit_d_auteur.htm
- <http://www.culture.gouv.fr/culture/infos-pratiques/droits/index.htm>

Note: French Jurisprudence has a very broad concept of what can be protected under copyright legislation. Therefore, it is advisable to always advocate in France for copyright protection in case of infringement, even cumulated with designs/trade mark, etc. protection. Article L.112-2 specifies that architectural works and the creations of the seasonal clothing and ornament industries may be protected by copyright.

Formalities

The copyright is an automatic right that does not require any registration formalities.

However, the creator may need to prove ownership by, among other things: a sealed envelope, letter with acknowledgement of receipt addressed to oneself, publication in a newspaper, deposit by Envelope Soleau with INPI (sealed enveloped referred to and stored at INPI, the Envelope Soleau comprises proof of the copyright and will only be opened in case of conflict concerning the copyright. Its price is 15 EUR).

The creation can also be registered by specialised companies which provide 3 services:

- collection and distribution of copyright royalties accruing to their members for the use of their works;
- defence of their members' rights against any third party, including in the courts;
- defence and improvement of authors' rights.

Although architectural works and the creations of the seasonal clothing and ornament industries may

be protected through copyright, these specialised companies are more involved with the registration and defence of copyright concerning intellectual creations in the literary, artistic and multimedia arenas.

Costs

Copyright protection requires no official cost, except when services provided by some specialised companies have been used.

Examination

Not applicable.

Duration

In general, copyrights expire 70 years after the author's death.

Ownership of the right

The author:

The ownership of the right belongs to the author of the work, i.e. the individual who made a personal capital contribution to create the work.

And this is the case regardless of the conditions of creation of the work, including works created within the framework of a contract of employment or a training course, or pursuant to a contract of order.

The law provides for exceptions:

- when the work created by an employee is a software application;
- when the work is created by a civil servant or public servant in the performance of its duties.

The producer:

The *sui generis* right or right of the producer who protects the contents from a database belongs to the producer of the database who takes the initiative and assumes the risk of the corresponding investments.

What to do if I am copied (copyrights and related rights)

In a proven case of copyright infringement, the first thing to do is contact the infringer and try to settle the infringement situation by requesting that he modify the creation, cite the real author of the work or by requesting a financial contribution. However, if the work is simply inspired by your creation, there is absolutely no legal way to prevent its spread.

If the infringer is not inclined toward compromise, the copyright owner shall initiate legal proceedings by first having a bailiff (for example, an officer sworn by a specialised company) write a statement to prove the date of the infringement and then sending a formal notice written by a lawyer to the infringer.

Relevant Contacts:

- Specialised companies:
 - **La Compagnie nationale des Experts M. C. T. H** (Maroquinerie, Chaussure, Textile, Habilement) +33 1 42 96 21 01 - E-Mail : info@expertmcth.org
 - **Union des fabricants** +33 1 56 26 14 03 - <http://www.unifab.com/>
- State organisations:
 - Anti-counterfeit call centre** +33 820 22 26 22
 - **DDCCRF** - Direction Départementale de la Concurrence, de la Consommation et de la Répression des Fraudes - http://www.dgccrf.bercy.gouv.fr/documentation/dossier_litiges/dgccrf.htm

Actions at customs

How do the French customs authorities act?

Applicable laws:

- EC Regulation 1383/2003 except the simplified procedure mentioned in Article 11.
- Contrary to other EU countries, according to the "Longuet law", (French Law No. 94/102 of 5/02/1994), customs representatives are not only allowed to check the importation or exportation of products without customs arrangement but also to control, throughout the French territory, the conveyance or the storage of goods infringing

a trade mark, a design, a copyright or a patent, regardless of whether the counterfeit goods come from a country that is a member of the European Union or a third country.

Types of actions:

A. Controlling the legality of the goods:

Customs representatives are allowed to:

- perform controls on goods in public places and on public ways;
- check goods stored in premises accessible to the public and goods stored in premises not accessible to the public after having informed the public prosecutor's department;
- visit private places, specifically a domicile, under the control of the public prosecutor's department;
- require from the holder of the goods proof of the legality of the goods s/he is holding.

B. Retaining the goods:

Custom representatives are allowed to retain controlled goods if they have suspicions about the legality of the controlled goods. Goods can be held up to 10 days by the customs officers.

Types of sanctions:

A. The retained goods infringe a trade mark or a design:

French code gives the customs representatives the right to:

- seize the goods when they are clearly presented as counterfeit trade mark (the "retenue" becomes a seizure);
- seize the means and objects used to conceal the fraud;
- impose a fine, the amount of which is between one and two times the value of the counterfeited goods;
- order a term of imprisonment up to 3 years;
- perform a transaction with the offender to settle minor cases, such as goods brought in by passengers. The transaction is a contract between the offender and customs authorities. After the transaction occurs, the counterfeit goods are automatically destroyed.

If the customs offense is committed by an organised group, the amount of the fine is between one and five times the value of the counterfeited goods and the term of imprisonment is up to 5 years.

- B. The retained goods infringe a patent, a supplementary protection certificate or plant varieties:

Contrary to the case concerning a trade mark, it is to be noted that in this kind of case, the role of customs is only to retain suspicious goods. Customs representatives are not allowed to seize the goods.

In this case, the seizure and other sanctions can only be ordered by the president of the TGI (Tribunal de Grande Instance) when civil or criminal proceedings have been requested by the licensee. If no seizure is ordered, retained goods are released by the customs representatives.

Procedures

File an Intervention Form (first step):

Customs authorities perform a control without being specifically asked by the titular holder or licensee of the intellectual property rights. However, when the titular holder or the licensee of the right wants customs to enforce the control concerning goods similar to the protected product, s/he must file an intervention form and submit it to the customs authorities.

- If the intellectual property right relates to a trade mark or a design, the adapted form is a national intervention form - Cerfa no. 12684*02. <http://www.bercy.gouv.fr/formulaires/douanes/12684.pdf>
- If the Intellectual Property Right relates to a patent, a supplementary protection certificate, plant varieties, geographical indications or geographical designations, the adapted form is the community intervention form - Cerfa no. 12683*02. <http://www.bercy.gouv.fr/formulaires/douanes/12683.pdf>

Retention of the goods (second step):

When customs representatives have suspicions about the legality of goods they are controlling, they retain the goods.

- A. If an intervention form has been filed: Customs authorities notify the titular holder or the licensee that suspicious goods have been retained, and
- if the titular holder or the licensee confirms the offence within 10 days, customs authorities transmit to her/him information such as the supplier, the recipient and the value of the goods controlled so the titular holder or the licensee can undertake a civil proceeding;

- if the offence is not confirmed within 10 days, customs authorities return the goods to the supplier.

B. If no intervention form has been filed:

- Customs authorities search for a possible titular holder or licensee to inform them that suspicious goods have been intercepted and request that they file an intervention form.

Sanction (third step):

- A. The counterfeit goods relate to a trade mark or a design:
- customs officers seize the goods;
 - the titular holder can undertake a civil/criminal proceeding with the information obtained during the retention procedure and ask the presiding judge of the competent court, the TGI (Tribunal de Grande Instance), of the place where the goods have been controlled and held back for authorisation to have a seizure-counterfeit;
- B. The counterfeit goods relate to a patent, a supplementary protection certificate, plant varieties or geographical indications
- the titular holder can undertake a civil or criminal proceeding using the information obtained during the retention procedure and ask the presiding judge of the competent court, the TGI (Tribunal de Grande Instance), of the place where the goods have been controlled and held back for the authorisation to have a seizure-counterfeit.

Main contacts

Direction générale des douanes et des Droits Indirects (Customs General Directorate)

Bureau E4 – Section de la propriété intellectuelle (Intellectual Property Unit)
11, rue des Deux communes
F – 93 558 Montreuil Cedex
Tel.: +33 1 57 53 43 51

Alternative ways to deal with infringements

According to Articles L.615-17 and L.716-4 of the Intellectual Property Code, respectively concerning patents and trade marks, it is possible to resolve any infringement conflict by submitting the conflict to an arbitration procedure. However, it should be noted that only a civil proceeding can be solved by an arbitration procedure.

Contact of the National Patent Office:

Institut National de la Propriete Industrielle (INPI)
26 bis rue de Saint Petersburg
75800 Paris Cedex 08
France
www.inpi.fr
0033(0)820 210 211
Contact@inpi.fr

Germany

Design rights

Applicable Laws

Designs Law/Geschmacksmustergesetz 2004
http://bundesrecht.juris.de/geschmmsg_2004/.

What can and cannot be protected?

Design protection may be established if the following requirements are complied with:

- Objects eligible for design protection

A design is the two- or three-dimensional appearance of the whole or a part of a product made up of the lines, contours, colours, shape, texture or the materials of the product itself or its ornamentation. A computer program is not regarded as a product.

- Typefaces

It is also possible to protect typefaces. They shall be assigned to the class of goods 18-03.

A design must be new and have individual character on the date the application is filed. Even if a design has been made available to the public by the designer during the 12 months preceding the filing date, the design is considered new. (So-called novelty grace period).

Formalities

The application must contain a signed request for registration including: details allowing identification of the applicant, a representation of the design suitable for publication and a list of the products the design is incorporated into or applied to.

Upon filing an application, a request for a 30-month deferral of publication can be submitted. In this case, the application fees will be reduced. No publication fees are incurred. This may be useful if the applicant

wishes to wait to see whether the product is accepted on the market or if, for other reasons, the design should be kept secret for the time being.

Costs (at the date of publication)

	EUR
Single application	
• Duration of protection: 5 years	70
• in case of deferment of publication	30
Multiple applications (up to 100 designs can be filed with one application)	7 EUR per individual design, but at least 70 EUR per application
• in case of deferral of publication	3 EUR per individual design, but at least 30 EUR per application
Publication of the representation	12 EUR per design

Renewal per design	EUR
6 th -10 th year	90
11 th -15 th year	120
16 th -20 th year	150
21 st -25 th year	180

For more information concerning costs, fees and expenses:

http://www.dpma.de/docs/service/formulare_eng/allgemein_eng/a9510_1.pdf

Examination

The designs unit of the DPMA ensures that the application complies with the formal requirements. This includes making sure the design is not contrary to public policy or accepted principles of morality and that the design does not constitute an improper use of items, emblems etc.

However, compliance with the substantive requirements for protection (e.g. novelty, individual char-

acter) is not examined. The latter requirements are examined by the civil courts in case of litigation.

Duration of protection

The maximum term of protection is 25 years (initial term of 5 years and 4 possible renewals of 5 years each).

In case of deferral of publication, protection will at first be limited to 30 months. Within this deferral period the applicant may decide to extend protection to 5 years. In this case, publication must follow and further fees will be due.

Ownership of the right

A design registered at the DPMA confers upon its holder the exclusive right to use it and to prevent any third party not having prior consent from using it. That means that the holder alone is entitled to put the registered design on the market, grant licences and transfer the IP right. If the author (designer) creates the design within the scope of an employment relationship or while executing an order, the employer or customer is deemed the owner of the IP right.

Trade mark rights

Applicable Laws

Trade Mark Law/Markengesetz 1994

<http://www.bundesrecht.juris.de/bundesrecht/mark-eng/gesamt.pdf>

Trade Mark Ordinance/Markenverordnung 2004

http://www.bundesrecht.juris.de/bundesrecht/mark-env_2004/gesamt.pdf

What can and cannot be protected?

A sign can be protected as a trade mark if it is registered with the German Patent and Trade Mark Office (DPMA). To apply for registration, it is necessary to file a request providing certain details.

In Germany, rights to a trade mark may also arise from distinctiveness acquired through market recognition through the use of a sign in the course of trade or from the fact that a sign is well known (notoriety).

Formalities

It is easy to apply for a trade mark in Germany. An applicant can simply file an application at the DPMA. The necessary form can be downloaded at: <http://www.dpma.de/english/index.html>.

Before completing the application form, it is important to carefully read the leaflet "Information for Trade Mark Applicants" http://www.dpma.de/docs/service/formulare_eng/marke_eng/w7731_1.pdf.

The applicant may be a natural person or a legal person or a partnership with legal capacity.

Applicants having a domicile, a seat or an establishment in Germany do not have to appoint a representative for the procedure before the DPMA. Applicants having neither a domicile nor a seat or an establishment in Germany must appoint an attorney-at-law or a patent attorney in Germany as representative.

The applicant should indicate the trade mark on the form and specify the goods/services for which trade mark protection is sought. The goods/services must be listed by class, in ascending numerical order. A separate application must be filed for each trade mark. The trade mark cannot be changed after the application has been sent to the DPMA. Once the application has been received by the DPMA, no goods and services can be added to the list. The original application for registration of a trade mark shall be signed by the applicant or applicants (a facsimile stamp is not acceptable!). Applicants can submit their documents to the DPMA in person, by post, by fax or online. Information about online filing can be found at <http://www.dpma.de/english/service/e-services/dp-madirekt/index.html>

Please note that you cannot file a trade mark application simply by sending an e-mail.

To obtain a filing date, the application must contain:

- information identifying the applicant;
- a representation of the trade mark; and
- a list of goods and services for which registration is requested.

Costs (at the date of publication)

	EUR
Application fee including the class fee for up to 3 classes	300
Class fee for the application, for the fourth class and each additional class	100

If the full amount of the application fee is not paid within 3 months from the date the application is filed, the application is deemed withdrawn.

More information is available at: "Information Concerning Costs, Fees and Expenses"
http://www.dpma.de/docs/service/formulare_eng/allgemein_eng/a9510_1.pdf

Examination

The trade mark application is processed only after the payment of the application fee and class fees, if any. The trade mark department verifies whether the documents and required information are complete. It also examines the basic requirements for protection. If the conditions are met, nothing should hinder the registration of the trade mark, and the applicant will receive a registration certificate.

Then the applicant can use the © symbol with its trade mark and apply the registered trade mark to its goods. The DPMA does not check whether similar or identical trade marks have already been registered!

Before filing, an applicant should make sure the trade mark has not been registered by another proprietor in an identical or similar form. Information about trade mark search options can be found at: http://www.dpma.de/english/trade_marks/search/index.html. Otherwise the proprietor of an earlier trade mark might file an "opposition" to the newly registered trade mark, which could result in the applicant's trade mark being cancelled.

Duration of protection

The period of protection of a registered trade mark is 10 years. It may be renewed for additional periods of 10 years. There is no formal end of protection as long as the fees are duly paid.

To renew the registered trade mark, a renewal fee must be paid, and if the renewal is applicable for

goods and services in more than 3 classes, then the class fees must also be paid.

Renewal fee	EUR
after 10 years, for up to 3 classes of goods/ services	750
for each additional class	260

Ownership of the right

The registration of the trade mark confers upon the owner an exclusive right, allowing him to claim damages if the trade mark right is infringed or to require the infringer to cease and desist the improper use of the trade mark.

The right may be transferred or assigned to another person for some or all of the goods or services. Trade marks can be sold and bought. Furthermore, it is possible to grant licences for the use of the trade mark.

Patents and utility models

Applicable Laws

Patent Law/Patentgesetz 2005
<http://bundesrecht.juris.de/patg/>

Patent Ordinance/Patentverordnung 2004 <http://www.gesetze-im-internet.de/patv/index.htm>

Utility Model Law/Gebrauchsmustergesetz 1986
<http://bundesrecht.juris.de/gebrmg/>

What can and cannot be protected?

The DPMA will only grant a patent after an examination has confirmed that the invention is patentable. The utility model can be registered without examination of the requirements for protection. For this reason, a utility model can be obtained faster and more cheaply than a patent.

Patent protection can be granted for inventions in the field of technology, either for products or processes. The utility model cannot protect processes.

Formalities

The applicant may be a natural person, a legal person or a partnership with legal capacity.

Applicants having a domicile, a seat or an establishment in Germany do not have to appoint a representative for the procedure before the DPMA. Applicants not having a domicile, a seat or an establishment in Germany must appoint an attorney-at-law or a patent attorney in Germany as a representative.

The application must be written in German. For applications in another language, a German translation must be filed within 3 months. The forms can be downloaded at <http://www.dpma.de/english/index.html>. The applicant can submit documents to the DPMA in person, by post, by fax or online. Information about online filing can be obtained at <http://www.dpma.de/english/service/e-services/dpmadirekt/index.html>.

Before completing the application form, please read the leaflet: "Information for Patent Applicants"/"Information for Utility Model Applicants". http://www.dpma.de/docs/service/formulare_eng/patent_eng/p2791_1.pdf

http://www.dpma.de/docs/service/formulare_eng/gebrauchsmuster_eng/g6181_1.pdf

Please note: It is not sufficient to send the application documents by e-mail to the DPMA. If the requirements are not met, the application is not accepted.

Costs (at the date of publication)

Costs of a patent:

Application fee	EUR
Electronic filing (including 10 patent claims)	40
- extra fee for each additional claim	20
Paper filing (including 10 patent claims)	60
- extra fee for each additional claim	30
(Optional) search without examination	250
Examination procedure after optional search	150
Examination procedure without prior optional search	350

The annual fees to maintain the application and the patent increase from EUR 70 for the third year to EUR 1,940 for the 20th year.

Costs of a utility model:

	EUR
Application fee	40
Search fee (optional)	250
1 st maintenance fee after 3 years	210
2 nd maintenance fee after 6 years	350
3 rd maintenance fee after 8 years	530

See leaflet "Information Concerning Costs, Fees and Expenses" at http://www.dpma.de/docs/service/formulare_eng/allgemein_eng/a9510_1.pdf

Examination

The DPMA examines patent applications for novelty and inventiveness only if a request for examination is filed by the applicant or by any other person within 7 years of the date of filing. The result of the examination is either granting or rejection.

The utility model is registered without examination of the protection requirements. The protection conferred by a utility model is often weaker than that provided by an examined patent. The owner or a third party may file a request for a search for prior art. A thorough examination of all requirements for protection will only take place if someone files a request to cancel the utility model registration.

Duration of protection

The maximum term of protection is 20 years for a patent and 10 years for a utility model.

Ownership of the right

A patent or utility model grants the owner an exclusive right to exploitation. The owner may grant licences and allow the licensee to exploit the invention in return for adequate consideration. Furthermore, the patent or utility model may be sold or bequeathed.

What to do if I am copied (designs, trade mark, patents)

The applicant should seek professional advice because many details and legal aspects need to be

considered. It is advisable to consult a lawyer with experience in competition law. The DPMA is not authorised to render legal advice and is not responsible for fighting IP infringement.

Specific recommendations

Information on enforcement can be found online:

<http://www.markenpiraterie-apm.de/>
http://www.zoll.de/b0_zoll_und_steuern/d0_verbote_und_beschaenkungen/f0_gew_rechtsschutz/index.html
www.piznet.de
www.patentinformation.de
http://www.signo-deutschland.de/content/index_ger.html
<http://www.patentserver.de>
<http://www.zim-bmw.de>
<http://www.dihk.de>
<http://www.original-ist-genial.de/english.html>
<http://www.conimit.de/>
http://www.plagiarius.com/e_index.html

Copyright and related rights

Applicable Laws

Copyright Law/ Urheberrechtsgesetz 2008 <http://www.gesetze-im-internet.de/urhg/index.html>
Copyright Administration Law/ Urheberrechtswahrnehmungsgesetz 2006 <http://www.gesetze-im-internet.de/urhwahrng/index.html>

What can and cannot be protected?

Unlike industrial property rights, copyright results automatically from the creation of the work. Registration in an official register is neither required nor possible in order to obtain copyright protection.

Copyrighted works must be personal intellectual creations. The subject of protection under copyright law includes literary, scientific, musical and artistic works. This list of works is not exhaustive.

Copyrighted works must be personal intellectual creations with a certain level of creativity, but the creative requirements are not very high. Limitations on copyright include the right to quote, which permits quotations of different lengths.

Formalities

No formal requirements must be met to create a copyright.

Application fees

None

Examination

Not applicable

Duration of copyright

Copyright is an exclusive right for a limited time. It expires after a statutory period and automatically enters the public domain (70 years after the author's death).

Ownership of the right

The author is the right owner.

An employee is the first owner of the copyright if a work is created under a contract of employment. However, it is possible that the employee/author must grant exploitation rights for the work to the employer under the employment contract.

As a rule, copyright is not transferable, but the author can grant others the right to use the work in any manner. Holders of exploitation rights may transfer these rights to others with the author's consent.

What to do if I am copied (copyrights and related rights)

Copyright infringement is a breach of copyright. Frequently, the copyright is infringed by illegal production or distribution of a copy of copyrighted works or the publication or exploitation of an adapted or transformed work.

Administrative measures:

No official registration is possible but the author is free to prove his authorship in a suitable manner to produce effective evidence in case of a legal dispute (e.g. deposit of documents with a public notary).

Measures under civil law:

The following claims are available to the author or the holder of an exclusive licence:

- a claim for removal to end an interference;
- a claim for injunction to prevent further infringements of the scope of protection;
- a injunction claim for damages to compensate monetary damages incurred;
- a claim for compensation of non-material damages;
- a claim for destruction of unlawfully produced copies;
- a claim for surrender of the infringing copies;
- a claim for information;
- a claim for the publication of the judgement
- a claim for presentation for inspection, if there is uncertainty about the infringement of the scope of protection;
- a claim against the infringer to return unlawfully taken fees;
- a claim for delivery of accounts, if necessary, to calculate damages.

Criminal provisions:

The following acts constitute offences under criminal law: the unauthorised exploitation of copyrighted works, the unlawful affixing of a designation of author, unlawful circumvention of technological measures of protection and the removal of necessary rights-management information, for example, the removal of copy protection.

Special recommendations:

The Copyright Arbitration Board integrated into the DPMA mediates disputes between collecting societies and users of copyrighted works.

Collection of links on copyright matters of the German Federal Ministry of Justice:

<http://www.kopienbrauchenoriginale.de/enid/3c877841ef29e92f73c301ba146cc677,0/3t.html>
<http://gvu.de>

Actions at customs

How do German customs authorities act?

According to art. 9 (1) of EC Regulation No. 1383/2003, customs authorities act if goods that are suspected of infringing intellectual property rights are imported into the EU.

In general, the owners of intellectual property rights (right holders) have to file an application for this action by the customs authorities, according to art. 5 of Regulation No. 1383/2003.

Procedures

Owners of intellectual property rights, such as trade marks, patents, design rights and copyrights, have the option to request action by the customs authorities according to Regulation No. 1383/2003, at the Central Bureau of Intellectual Property Rights (CBIPR) in Munich.

The application must contain all available information (if possible electronically) to help the customs officers distinguish between original and fake goods (for example names and addresses of manufacturers of the original products, pictures of original products, information about special security features).

If a customs office using the above-mentioned information suspects that those incoming goods are infringing an applicant's intellectual property rights, the goods will be stopped.

The right holder whose intellectual property rights are affected by the suspected infringements will be informed of the measure taken by the customs office. The right holder can also request the importer's data and some examples of the goods in question. If the right holder confirms, after examining the goods that they infringe his intellectual property rights, he has two options. He can either allow the goods to be destroyed, with the agreement of the importer and under customs supervision, or start a civil trial to confirm the infringement.

If a company owns a Community trade mark, a Community design right or any other right protected by the Community, it is possible to apply for action by the customs authorities, according to Regulation No. 1383/2003, to get protection in the 27 EU member states.



After granting the application, the CBIPR will forward all information concerning the application to the appropriate member states. Using just one application, the right holder can ask all customs offices at the borders to non-EU countries to take action against infringements of his products.

Main Contacts

For individual and detailed information, please contact the team of the Central Bureau of Intellectual Property Rights:

Bundesfinanzdirektion Südost
Central Bureau of Intellectual Property Rights
Sophienstraße 6
80333 Munich/Germany
Phone: +49 (0) 89 – 59 95 23 13
Fax: +49 (0) 89 – 59 95 23 17
Email: zgr@ofdm.bfinv.de

More information about the border seizure system is available at www.ipr.zoll.de.

Alternative ways to deal with infringements

Relevant contacts:

Patent lawyers' association/Patentanwaltskammer
<http://www.patentanwalt.de>

German Federal Bar/Bundesrechtsanwaltskammer
www.brak.de

Action Group against Product and Trade Mark Counterfeiting (APM e.V.)
<http://www.markenpiraterie-apm.de/>

Contact of the National Patent Office:

Deutsches Patent- und Markenamt
Zweibrückenstr. 12
80331 München
Germany
+49(0)89/2195-3402
info@dpma.de
www.dpma.de

Greece

Design rights

Applicable Laws

PD 259/1997
(<http://www.obl.gr/>)

What can and cannot be protected?

A design or model can be protected if:

- it is new;
- it has an individual character.

Its novelty shall not be affected if it has been displayed at an official recognised exhibition for a period of 6 months prior to the date of filing at the Industrial Property Organisation (OBI).

A design cannot be protected if:

- it is contrary to public policy or principles of morality;
- the products are dictated only by their technical function;
- the products have to be produced in the exact dimensions in order to function.

Formalities

An application with all the necessary documents (as explained below) in duplicate must be filed at the OBI premises or sent by post or fax (+30 210 6819231) by the owner or the owner's legal representative. A legal representative is required only if the owner does not have a residence or address in Greece. If the documents are sent by fax, the originals must be forwarded to the OBI within 10 days.

The documents required (in duplicate) to register a design or model are:

- a completed and signed application form available at OBI or at www.obl.gr/;

- photograph(s) or figure(s) from a PC of the design or model;
- payment receipt for the filing fee.

Additional documents, such as a power of attorney, other legal documents, payment receipts for publication and deferred publication fees, and any other corrections can be submitted within a period of 4 months from filing.

To file an application, the applicant also has priority for 6 months from the date of the first filing of either an earlier design application in a member state or an earlier national application for a utility model.

Costs (at the date of publication)

Valid from 01/05/09 until a new Administrative Council decision is issued.

For 1 graphic representation

Filing fee:	20 EUR
Publication fee:	14 EUR
Deferred publication fee:	14 EUR

Renewals	
1 st five-year period (covered by filing fee)	0
2 nd five-year period	58 EUR
3 rd five-year period	58 EUR
4 th five-year period	72 EUR
5 th five-year period	88 EUR

Examination

The application is checked for completeness and then the certificate is granted, otherwise it is withdrawn. No examination for novelty is conducted for designs or models.

The application is published 4 months after the filing date and the certificate shortly after granting.

Duration of protection

For a design or model to be kept in force, renewal fees must be paid, starting from the 5th anniversary of the registration date and every 5 years after that, up to a maximum of 25 years.

For more information, visit our site: www.obi.gr.

Ownership of the right

The entity that files the application is the owner of the design or model. The right may be transferred by written agreement or inherited. The holder of a registered design or model may also license the design or model to third parties upon written agreement.

Trade mark rights

Applicable laws

Law 2239/94
(<http://www.gge.gr/>)

What can and cannot be protected?

A trade mark is any sign that can be graphically represented and that can be used to distinguish the products or the services of one enterprise from those of another.

Signs cannot be protected if they:

- go against public order or morality;
- involve government-owned emblems or religious symbols;
- mislead customers with regard to the nature, origin and quality of the product or service

Formalities

A trade mark application form is submitted to the Ministry of Development (Direction of Commercial and Industrial property) in 6 copies, downloadable from the site www.gge.gr and signed by a lawyer.

The application shall be accompanied by:

- 10 copies of the trade mark, the dimensions of which should not exceed 9x8 cm;
- a fee for the first classification class and fees for any additional classes;
- a power of attorney for the lawyer signing the forms for the trade mark registration;

- all legal documents for the company's representation if the applicant is a company;
- a statement for applicants who are not Greek residents to agree to the jurisdiction of the courts of Athens.

For a Community Trade Mark (CTM) or an international trade mark, an additional form is required, along with a translation into Greek of the documents submitted by the Community Office of Trade Marks (OHIM).

Costs (at the date of publication)

Valid until a new ministerial decision is issued.

Application fee: 120 EUR for the 1st classification class,
30 EUR for each additional class.

Renewals	
fee for 1 st classification class	120 EUR
fee for each additional class	30 EUR

Examination

The trade mark application is examined by the Administrative Trade Mark Committee, which is responsible for its acceptance or refusal.

If it is accepted, the mark is registered, dated and signed. But an opposition to that acceptance can be filed by a third party. The opposition will also be examined by the Administrative Trade Mark Committee, where the trade mark applicant can be represented by a lawyer. If a party is not satisfied with the decision of the Administrative Trade Mark Committee, it can file an appeal to the Administrative Court of Athens (First Instance).

If the initial trade mark application is denied, the applicant can file an appeal to the Administrative Court of Athens (First Instance).

Duration of protection

A trade mark is valid for 10 years from the day after the application is filed and can be renewed for another 10-year period upon request by the owner. A renewal should be made during the last year of the first 10-year protection period. If a renewal is requested during the 6 months after the expiration of

the 10-year period, the renewal fees are increased by a 50% penalty. If the trade mark is not renewed, it is deemed invalid and is cancelled.

Ownership of the right

Registration of a trade mark confers upon its owner exclusive rights to its use in every respect, for example on its products, on its packaging and on any printed material.

The right to a trade mark is transmitted while the owner is alive or inherited in case of death.

Patent rights, including utility certificate

Applicable laws

Law 1733/1987
(<http://www.obi.gr>)

What can and cannot be protected?

Patents can be registered if they:

- are new;
- involve an inventive step;
- are capable of industrial application.

Some exclusions that are not patentable include:

- discoveries, scientific theories, mathematical methods;
- aesthetic creations;
- computer programs;
- presentation of information.

Utility Model Certificates (UMCs) are granted for novel and industrially applicable 3-dimensional objects with a definite shape and form.

Formalities

An application with all the necessary documents (as explained below) in duplicate must be filed at the OBI premises or sent by post or fax (+30 210 6819231) by the owner or the owner's legal representative.

A legal representative is required only if the owner doesn't have a residence or address in Greece. If the documents are sent by fax, the originals must be forwarded to the OBI within 10 working days.

The documents required (in duplicate) to file a patent or UMC application are:

- a signed application form available at the OBI or at www.obi.gr;
- a written description of the invention;
- claims, (at least the first main claim is required for the initial filing);
- payment receipt for the filing fee (paid at the OBI or at a bank).

At this stage, the OBI issues a filing receipt with an application number and an application filing date.

Within 4 months from the filing date, the applicant should submit any corrections or supplementary documents (such as missing claims, abstract and drawings, power of attorney if a lawyer filed the application, etc.), and pay the search report fee and fees for any extra claims beyond 10.

If the application claims priority, the priority certificate must be filed at the OBI within 16 months from the priority date.

The patent application is published 18 months after the filing date (or priority date), or if the patent is granted before the end of the 18-month period, it is published shortly after its granting.

Costs (at the date of publication)

Valid from 01/05/09 - till a new Administrative Council decision is issued.

Filing fee:	30 EUR for patents and UMCs
Search Report fee:	150 EUR for patents 0 EUR for UMCs (no search is conducted)
Fee for extra claim:	17 EUR for each extra claim
Granting fee:	95 EUR for patents 57 EUR for UMCs

Renewals for patents			
1 st to 4 th annuities (covered by filing fee)		0 EUR	
5 th annuity	60 EUR	13 th annuity	310 EUR
6 th annuity	80 EUR	14 th annuity	360 EUR
7 th annuity	90 EUR	15 th annuity	420 EUR
8 th annuity	110 EUR	16 th annuity	520 EUR
9 th annuity	135 EUR	17 th annuity	620 EUR
10 th annuity	180 EUR	18 th annuity	750 EUR
11 th annuity	220 EUR	19 th annuity	850 EUR
12 th annuity	260 EUR	20 th annuity	950 EUR

Renewals for UMCs	
1 st to 4 th annuities (covered by filing fee)	0 EUR
5 th annuity	60 EUR
6 th annuity	80 EUR
7 th annuity	90 EUR

Examination

Upon completion of the 4-month period after the filing date, the application is checked for completeness.

If the application is complete, the search report phase follows.

The search report is sent to the applicant or the applicant's patent agent. They have 3 months to submit their comments on the search report.

If comments are filed, the OBI then issues a final search report.

If no comments are filed, the initial search report is regarded as the final search report.

No substantive examination is conducted by the OBI.

The patent is granted when the granting fee has been paid.

If the patent application is complete but the search report fee has not been paid, the application for a patent is changed to an application for a utility model, provided it does not involve a method or an invention of use, in which case it is withdrawn.

For a UMC application that is complete, the next step is granting.

Duration of protection

Patents are valid for 20 years and UMCs for 7 years, provided renewal fees are paid. Renewal fees have to be paid annually starting the 5th year from the filing of application. For the validity of a patent, an extension might be given for a maximum of 5 years if a supplementary protection certificate for medicinal or plant products has been filed.

Ownership of the right

The applicant is the owner of the right.

An invention made by an employee shall belong to the employee (free invention) unless the invention is either a service invention, and thus belongs to the employer, or a dependent invention, and thus belongs 40% to the employer and 60% to the employee. In that case, the application is co-filed.

The right to a patent or patent application may be assigned, inherited or licensed following written agreement.

What to do if I am copied

- Infringement cases may be brought before a court.
- The owner, the exclusive licensee and the applicant of the patent or design may bring a civil action.
- Infringement claims may be brought before a court before the patent is granted. However, in such a case, the court may postpone the trial procedure until the patent has been granted.
- The Civil Court of First Instance (in Athens and Thessaloniki) is competent to judge infringement cases. Ordinary appeals can be filed to the Civil Court of Appeal of Athens and Thessaloniki. Under certain circumstances, a cassation at the Supreme Court (Areios Pagos) can also be filed.
- The remedies in case of condemnation of the defendant are: payment of the derived benefits or destruction of the infringing products.

Copyrights and related rights

Applicable laws

L. 2121/1993
(<http://www.opi.gr/>)

What can and cannot be protected?

Copyright mainly protects all original intellectual literary, artistic or scientific creations, expressed in any form, including databases and computer programs.

Ideas are not protected, as the purpose is to ensure their free propagation and circulation.

Furthermore, there is no protection for laws, court orders, administrative documents, folklore expressions, news and simple events, mathematical theories, discoveries and business methods.

Formalities

Entitlement and exercise of author's rights (copyrights) are not subject to any formality. Therefore, no formal procedure is required for the recognition of an author's rights to a work. Submitting a work to a notary provides evidence confirming the date, which can be evaluated by a court in the event of legal proceedings on the violation of the rights to that work.

Costs (at the date of publication)

Since there are no formalities required, no costs are incurred for copyright protection.

Examination

Not applicable.

Duration of protection

A copyright lasts for the author's life and 70 years after death, starting on 1st January of the year after the author's death.

Ownership of the right

The right belongs to the creator(s). The right may be transferred or licensed by the creator(s) while alive or inherited after death for 70 more years.

What to do if I am copied

If a violation of author's rights or related rights is suspected, an injunction can be issued to prohibit any act that would violate copyright.

In addition, in any case where an act of copyright violation is imminent - as in the case of public performance of a theatrical, cinema or musical play without the required author's permission - the local police authority should prohibit this act upon a request by the author or right holder. The district attorney, if requested, should issue an order to that effect to the

police. The same is true if a public performance began with the permission of the author but payment of the due fee is delayed for more than 2 days. In the context of civil law, the author and the right holder of a related right can file:

- a lawsuit regarding the recognition of their right;
- a lawsuit for the cessation of the violation;
- a lawsuit for the omission of the violation in the future, in case that violation or continuation or repetition of violation is threatened;
- a lawsuit for compensation and granting of no-material harm if the offender is culpable of the violation;
- a lawsuit to establish the inappropriate enrichment of the offender;
- a lawsuit for payment of the profit that the offender earned from the management of another person's property.

Almost all violations of author's rights and absolute related rights are punishable actions.

Civil penalties provide compensation for the violation of the holder's rights. The minimum penalty is double the amount gained by the offender when it infringed the right.

Criminal penalties include imprisonment for one to 10 years and a monetary penalty of 2,900 to 59,000 EUR.

For more information, please visit www.opi.gr.

Actions at customs

How do the Greek customs authorities act?

Applicable Laws

EU regulations 1383/2003; 1891/2004;
Trade Marks Law L.2239/94;
Copyrights Law L.2121/93.

Types of actions

Under this legislation, customs authorities can act "ex officio" during inspections or after the filing of an application for intervention by the companies/authorities that own an intellectual property right (IPR).

The suspected goods are "bonded/confiscated" until the IPR owner provides an expert's opinion that the

goods are counterfeited. Once that happens, the following possibilities exist:

- a) the counterfeited goods are destroyed with the consent of both the IPR owner and the owner of the goods,
- b) the "goods" remain "bonded/confiscated" and the IPR owner takes legal action against the owner of goods.

Customs authorities wait for a judicial decision before destroying the goods. In addition, a fine is imposed according to the national legislation, under which a fine of 2,000-20,000 EUR can be imposed, depending on the case.

During the first half of 2008, 37 seizures involving about 209,000 items were carried out by customs authorities.

In addition to customs authorities, the Special Investigation Service (Ministry of Economy and Finance) is also responsible for dealing with any infringement of Intellectual Property Rights and performs inspections at businesses and storehouses all over Greece seeking counterfeited products.

If the counterfeited products infringe copyrights, the products are confiscated and the infringers are sent to the public prosecutor according to the "caught in the act" rule.

If the counterfeited products infringe industrial property rights, the products are confiscated, the owner of the right is informed and prosecution is carried out after the indictment by the owner of the right.

Main contacts

General Directorate of Customs and Excise (Ministry of Economy and Finance)
www.gsis.gr
19th Directorate, Dept A.

Tel: +30 210 3225768, Email: d19diadi@otenet.gr
33th Directorate, Dept A
Tel: +30 210 7259326 Email: d33-a@otenet.gr

Special Investigation Service (Ministry of Economy and Finance)
www.ypee.gr
Tel: +30 210 3423906, Fax: +30 210 3468257
Email: info@ypee.gr

Alternative ways to deal with infringements

The protection granted by the provisions of the Greek Competition Law (146/1914) can be seen as an alternative way to deal with infringement in Greece.

Technical innovations (inventions, industrial designs) for which patents or utility model certificates have not yet been granted are protected from infringement according to the provisions of Greek Competition Law.

Contact of the National Patent/ Trade Mark/ Copyright Office:

Industrial Property Organisation (OBI)
Pandanassis 5, Paradissos Amarousiou 15125
www.obigr
Directorate of Legal Services
Tel:+30 210 6183597, E-mail: leg@obi.gr

The General Secretariat for Commerce,
Direction of Commercial and Industrial property
Kanningos square GR- 10181 Athens, Greece
www.gge.gr
Tel: +30 210 3840790, E-mail: gge@gge.gr

Hellenic Copyright Organisation
5, Metsovou Str., GR-10682 Athens, Greece
www.opi.gr
Tel: +30 210 8250750

Hungary

Design rights

Applicable laws

Act XLVIII of 2001 on the Legal Protection of Designs, available at:

http://www.mszh.hu/English/jogforras/jogforras_forma/index.html (Hungarian only)

What can and cannot be protected?

Any design can be protected if it:

- is new on a worldwide level;
- has individual character.

The design is excluded from protection:

- if it is detrimental to the normal use of the product;
- if it is merely the consequence of the technical solution or of the purpose of the product;
- if its purpose is identical to that of a design enjoying earlier priority or is similar enough to create a risk of confusion;
- if its use is contrary to the law or to the moral rules accepted by society, except in those cases where the law restricts only the selling of the product.

For more information, go to:

<http://www.mszh.hu/English/formaterv/index.html>

Formalities

To apply for an industrial design registration, the applicant must provide:

- a request for the granting of protection;
- a representation of the design;
- a denomination of the product according to the design;
- other relevant documents, if necessary;
- payment of the filing fee.

The application for registration can be filed in person, by post and online, using the applications available on the HPO Web site <http://www.mszh.hu/English/elektronikus/index.html>

Costs (at the date of publication)

Filing fee	32,000 HUF
Additional fee for each additional design (max. 50)	6,400 HUF/design

The amount is reduced by 75% if the applicant is the designer.

The filing fee should be paid within 2 months of the date of filing.

Renewal fees:

for the 1 st renewal	64,000 HUF
for the 2 nd renewal	85,400 HUF
for the 3 rd renewal	107,000 HUF
for the 4 th renewal	160,000 HUF

The mounts are reduced by 50% if the applicant is the inventor.

For more information go to: http://www.mszh.hu/English/formaterv/eforma_dij2008.pdf

Examination

Once the request, the design representation, the description of the design and any other necessary attachments are filed and the filing fee is paid, the office examines the application to determine whether the filed documents satisfy the prescribed formal requirements.

The office conducts a novelty search and draws up a search report for the design.

The office sends the search report, together with the copies of the cited documents, to the applicant upon request and upon payment of a fee.

The design application is published by the HPO 9 months after the earliest date of priority.

Publication may be deferred upon request and upon payment of a fee.

After publication, any person may file an observation. Every observation must be taken into consideration.

The office conducts a substantive examination of the application to ascertain whether the design in the application is a protectable design, meaning it is new, has individual character, is not excluded from protection and the application satisfies the requirements set forth by law.

If the design application and the representation of the design satisfy all legal requirements, the office grants protection to the design.

For more information, go to:
http://www.mszh.hu/English/formaterv/nemzeti_ut/forma_tajek_2005.html

Duration of protection and conditions of renewal

The term of design protection is 5 years, beginning on the date the application is filed.

Upon request, this term can be renewed for additional 5-year periods, for a maximum of 20 additional years.

Ownership of the right

Rights conferred by design protection:

- exclusive right to exploit the design;
- based on the exclusive right of exploitation, the right holder can prevent any person not having his consent from exploiting the design;
- exploitation covers the manufacture, use, putting on the market, offering for sale, importation, exportation of the product according to the design

and the stocking of such product for those purposes;

- the option to transfer the design right or to grant licences to third parties to exploit the design, for free or for a fee.

Trade mark rights

Applicable laws

Act XI of 1997 on the Protection of Trade Marks and Geographical Indications

<http://www.mszh.hu>

What can and cannot be protected?

Any sign that identifies and distinguishes goods or services may be protected as trade mark if it can be represented graphically. This includes words, a combination of words, slogans, letters, numerals, figures, pictures, three-dimensional forms, colours, light signals, holograms, sound signals, and a combination of the previous signs.

- A sign cannot be protected if:
- it lacks any distinctive character;
- it is contrary to public policy or to accepted principles of morality;
- it may deceive consumers;
- its registration was applied for in bad faith;
- it is identical to or similar to a mark that is well-known in the country even if the mark is unregistered;
- it would infringe or it is in conflict with any earlier rights.

Formalities

To apply for an industrial design registration, an applicant must provide the following:

- a request for trade mark registration;
- the mark with a list of goods or services it is meant to protect;
- other relevant enclosures, if necessary;
- payment of the filing fee.

An application for registration can be made in person, by mail or online, using applications available on the HPO Web site:

<http://www.mszh.hu/English/elektronikus/index.html>

Costs (at the date of publication)

Filing fee for the 1 st class of goods	74,800 HUF
Additional fee for each additional class	32,000 HUF/class

The filing fee must be paid within 2 months of the date of filing.

The filing fee includes the examination, publication and registration, thus no additional fee is to be paid to have a trade mark registered.

Renewal fee for the 1 st class of goods	74,800 HUF
Additional fee for each additional class	32,000 HUF/class

For more information, go to:
http://www.mszh.hu/English/vedjegy/vedjegy_dijtablazat_2008_en.pdf

Examination

Once the request, the mark, the list of goods or services and any other necessary attachments are filed and the filing fee is paid, the office examines the application to establish whether the filed documents satisfy the formal requirements.

The substantive examination assesses whether the mark can be represented graphically and whether it is excluded from trade mark protection.

The office carries out a search for earlier rights and draws up a search report for the mark, with due regard to the list of goods or services and sends it to the applicant.

Then the office publishes the application in the official journal of the HPO if it has found no grounds for refusal *ex officio*, and notifies the applicant of this publication.

During the registration procedure, any person can file an observation against the registration based on absolute grounds. Every observation has to be taken into consideration.

During a period of 3 months following the date of publication, oppositions to the registration of the trade mark may be submitted. An opposition fee of

64,000 HUF is payable within one month from the date when an opposition is filed.

If no opposition or observation is filed and the HPO finds no grounds for refusal *ex officio*, the HPO registers the mark. If an opposition has been filed, the HPO decides whether to register the mark, with or without having an oral hearing.

For more information go to:
http://www.mszh.hu/English/vedjegy/vedj_tajekoztato_2008.html

Duration of protection and conditions of renewal

The term of trade mark protection is 10 years beginning on the date the application is filed. This period can be renewed for additional 10-year periods without limitation.

For more information, go to:
http://www.mszh.hu/English/vedjegy/nemzeti_ut/index.html

Ownership of the right

Rights conferred by trade mark protection:

- exclusive right to use the trade mark;
- the option to prevent third parties from using, without the holder's consent, any sign identical or similar to the trade mark on products or services for which the trade mark is registered as well as on goods or services other than those for which the trade mark is registered, provided that the trade mark has a reputation in the country and the use of that sign without due cause would take unfair advantage of, or would be detrimental to, the distinctive character or the repute of the trade mark;
- the option to transfer the trade mark or to grant licences to third parties to use the trade mark, for free or for a fee.

Patent rights, including utility models

Applicable laws

Act XXXIII of 1995 on the protection of inventions by patents, available at:
http://www.mszh.hu/English/jogforras/Patent_Act_XXXIII_1995_EN.pdf

Act XXXVIII of 1991 on the protection of utility models.

What can and cannot be protected?

Patents and utility models can be granted for any invention in any field of technology that is new, involves an inventive step and can be industrially applied.

The following cannot be protected by patent:

- discoveries, scientific theories and mathematical methods;
- aesthetic creations;
- schemes, rules and methods for performing mental acts, playing games or doing business, and programs for computers;
- presentations of information.

For more information, go to:

http://www.mszh.hu/English/szabadalom/nemzeti_ut/szab_tajek_2005.html

Utility model protection can be granted to any solution related to the configuration or construction of an object or to the arrangement of parts thereof.

For more information, go to:

<http://www.mszh.hu/English/hami/>

Formalities

To apply for a patent/utility model protection, the applicant must provide:

- a request for patent/utility model protection;
- a description of the invention with one or more claims;
- an abstract (patent only);
- drawings where necessary (in every case for a utility model);
- other relevant documents, if necessary;
- payment of the filing fee and search fee.

The application for registration can be filed in person, by post or online, using the tools available on the HPO Web site: <http://www.mszh.hu/English/elektronikus/index.html>

Costs (at the date of publication)

Patent

Filing fee and search fee for a maximum of 10 claims	34,000 HUF
Fee for each additional claim: from the 11 th to the 20 th claim from the 21 st to the 30 th claim from the 31 st claim	1,700 HUF/claim 3,400 HUF/claim 5,100 HUF/claim
Examination fee	58,000 HUF
Fee for granting and printing	32,000 HUF

The filing fee has to be paid within 2 months of the date of filing.

Amounts are reduced by 75% if the applicant is the inventor.

Maintenance fees :

1 st year	48,000 HUF	11 th and 12 th years	128,000 HUF
2 nd year	53,500 HUF		
3 rd and 4 th years	80,000 HUF	13 th and 14 th years	133,500 HUF
5 th and 6 th years	101,500 HUF	15 th and 16 th years	139,000 HUF
7 th and 8 th years	112,000 HUF	17 th and 18 th years	144,000 HUF
9 th and 10 th years	123,000 HUF	19 th and 20 th years	149,500 HUF

If paid in the 4th, 5th or 6th month after the due date, a surcharge of 50% is payable.

The amount is reduced by 50% if the applicant is the inventor.

Utility model

Filing fee for a maximum of 10 claims	17,000 HUF
Additional fee for the 11 th and each subsequent claim	1,100 HUF/claim

The filing fee has to be paid within 2 months of the date of filing.

Amounts are reduced by 75% if the applicant is the inventor.

Maintenance fees:

For the 1 st year (For a maximum of five pages of the description and drawings)	21,400 HUF
Additional fee for the 6 th and any additional pages of the description and drawings	3,200 HUF/ page
for the 2 nd to the 5 th year	21,400 HUF/ year
for the 6 th to the 10 th year	32,000 HUF/ year

If paid in the 4th, 5th or 6th month after the due date, a surcharge of 50% is payable.

The amount is reduced by 50% if the applicant is the inventor.

For more information, go to:

http://www.mszh.hu/English/szabadalom/nemzeti_ut/szabad_dijtablazat_2008_EN.pdf

http://www.mszh.hu/English/hami/haszn_minta_dijtablazat_2008_EN.pdf

Examination

Patent

Once the request, the description with one or more claims and the drawings are filed and the filing fee is paid, the office examines the application to determine whether the filed documents satisfy the prescribed formal requirements.

The HPO conducts a novelty search and draws up a search report, which, together with copies of any cited document, is transmitted to the applicant.

18 months after the earliest date of priority, the HPO publishes the patent application in the official journal. Along with the publication of the patent application, or separately if the novelty search report is available at a later date, the HPO issues an official notice of the completion of the novelty search.

During the patent granting procedure, any person may file an observation with the HPO to argue that the invention or the application does not comply with the requirements of patentability. Every observation must be taken into consideration.

The HPO conducts a substantive examination of the published patent application at the request of the applicant and upon payment of an examination fee. A substantive examination may be requested along with or after the filing of the patent application, at the latest within 6 months after the date of the official notice of the novelty search.

A request for a written opinion is optional. The request should be filed within 2 months of the filing date. A fee of 28,000 HUF should be paid within a month of the request's filing.

The written opinion is an early assessment of whether the invention appears to meet the requirements of novelty, inventive activity and industrial application. This written opinion is supplied only to the applicant.

Before the granting of a patent, the text of the description, claims and drawings on which the grant is based are transmitted to the applicant.

The fee for granting and printing is payable within a period of 3 months after receipt of the above-mentioned documents.

For more information, go to:

http://www.mszh.hu/English/szabadalom/nemzeti_ut/szab_tajek_2005.html

Utility model

The substantive examination covers all legal requirements except the novelty of the utility model and the existence of an inventive step.

This does not mean those models that are not new or do not involve an inventive step can be protected. These requirements are examined after granting if an adverse party initiates an annulment procedure against the model.

If the application satisfies all the legal requirements, the office grants protection for a utility model and announces it in the official journal.

Duration of protection and conditions of renewal

Patent protection has a term of 20 years beginning on the date the application is filed.

Utility model protection has a term of 10 years beginning on the date the application is filed.

Ownership of the right

The granting of a patent or utility model confers upon its owner the following rights:

- the exclusive right to exploit the invention in any part of the country;
- the option to prevent third parties from making, using, putting on the market or offering for sale a product or process which is the subject matter of the invention, or stocking or importing the product for such purposes;
- the exclusive right to prevent others from seeking protection for the same product or process, and employing or applying the same means or processes disclosed in the patent or utility model that has been granted;
- the option to transfer the right or to grant licences to third parties to exploit the invention, for free or for a fee.

More detailed information on this issue:

http://www.mszh.hu/English/jogforras/Patent_Act_XXXIII_1995_EN.pdf

What to do if I am copied (designs, trade mark, patents)

If your rights are exploited or used unlawfully, it is advisable to seek help from a professional representative (patent attorneys:

<http://www.szabadalmikamara.hu/indexfoENG.htm> ,

or lawyers:

<http://www.magyarugyvedikamara.hu/>)

Once the industrial property rights are registered, right holders have various means at their disposal to react to the infringement of their rights. They may:

- File an official complaint with the relevant administrative and/or criminal authorities (e.g. the police, the National Consumer Protection Authority, the Hungarian Customs and Finance Guards or the Prosecution Service of the Republic of Hungary) if the right holder thinks administrative or criminal actions need to be taken against the infringement and/or the infringer;
- Request that the Metropolitan Court recognise the fact of infringement.
In connection with the infringement case, and even before the filing of a lawsuit, it is possible

to request a preliminary measure to stop the infringement.

- If the holder has suffered damages as a result of infringing activities, damages may also be claimed under the rules of civil liability.

The Hungarian Patent Office does not receive or forward any complaints relating to infringements.

Relevant professional representatives:

- Hungarian Chamber of Patent Attorneys <http://www.szabadalmikamara.hu/indexfoENG.htm>
- Hungarian Bar Association <http://www.magyarugyvedikamara.hu/>
- Online Directory of Hungarian Lawyers <http://ugyved.jogiforum.hu/ugyved/>

Relevant authorities:

- Prosecution Service of the Republic of Hungary <http://www.mklu.hu/cgi-bin/index.pl?lang=en>
- National Consumer Protection Authority <http://www.nfh.hu/>
- Hungarian Customs and Finance Guards <http://www.vam.hu/welcomeEn.do>

Copyright and related rights

Applicable laws

Act No. LXXVI of 1999 on Copyright, <http://www.mszh.hu/jogforras/9976.html> (Hungarian only)

Decree 18/2006. (IV. 12.) IM of the Minister of Justice on the detailed rules of the voluntary register of works kept at the Hungarian Patent Office: http://www.mszh.hu/English/jogforras/onkentes_munyilvantartas_18-2006im.pdf

What can and cannot be protected?

Intellectual creations in the literary, scientific and artistic fields are subject to protection under the Copyright Act regardless of the mode or form of expression. Copyright protection shall derive from the individual and original nature of the creation.

The following are excluded from copyright protection:

- ideas, principles, procedures, concepts, methods of operation or mathematical operations;
- legal provisions, court and other official resolutions, announcements and documents issued by an authority;

- facts and daily news;
- expressions of folklore.

Computer programs and databases that have a creative character are entitled to copyright protection.

Copyright protection is not linked to the disclosure, publication, utilisation or exploitation of the work.

For more information, go to:

[http://www.mszh.hu/English/szerzoi jog/index.html/](http://www.mszh.hu/English/szerzoi jog/index.html)

Formalities

The registration of copyrights and related rights is merely optional, declarative and only ensures an initial presumption of authorship. The protection as such is automatic.

The registration of a literary, artistic or scientific work should be requested by the owner(s) of the rights or by their representative(s) at the Hungarian Patent Office.

To register a work, an applicant needs to present the following:

- a request form;
- copy of the work to be registered;
- power of attorney, if necessary.

An administrative service fee of HUF 5,000 (about 20 EUR) must be paid.

The registration of a literary, artistic or scientific work can be requested at the competent collective societies as well.

Duration of protection

In general, the term of protection is the life of the author plus 70 years.

- The term of protection for related rights is 50 years. The term for related rights shall be calculated from the date of:
 - the presentation by the performer;
 - the work's entry into circulation by the author of the phonogram or movie;
 - the first transmission by a broadcasting entity.

Ownership of the right

In general, the copyright belongs to the natural person who creates the work. The law provides for some special regulations, such as in cases of collective works, joint works or employee works, and commissioned works.

The author has both moral rights and economic rights. The economic rights give the author the exclusive right to use the work or to authorise a third person to use it. Independently of the economic rights, and even after its transmission or extinction, the author retains the moral rights to its work, namely the right to claim its authorship and assure its authenticity and integrity.

Some special regulations allow the transfer of economic rights (e.g. collective works, employee works, computer programs, films) to third parties. Moral rights are not transferable.

Licences may be granted exclusively and non-exclusively. Any licence agreement shall be made in writing.

Free use is allowed only in the case of works already made available to the public. Free use shall not prejudice the normal use of the work, and shall not prejudice the legitimate interests of the author. Additionally it shall meet the requirements of fairness and shall not focus on purposes incompatible with those of the free use act. The Act generally specifies further conditions of the free use in each case (e.g. the indication of the author's name, the exclusion of making a profit through the use).

What to do if I am copied (copyrights and related rights)

The Copyright Act and the Criminal Code provide for a large variety of ways to enforce an author's rights. In case of infringement of copyright, the right holder can:

- demand that the occurrence of infringement be declared by the court;
- demand an injunction to stop further infringing activity;
- demand acknowledgment from the infringer by way of a declaration or by other appropriate means;
- demand that the infringer give information on the identity of third persons involved in the production and distribution of the infringing objects

or the provision of infringing services and their channels of distribution;

- demand restitution of the profits obtained from the infringing activity;
- demand termination of the infringement;
- demand the recall and definitive removal or destruction of the infringing objects from the channels of commerce;
- demand compensation for damages.

If infringement of a copyright occurs, the right holder can also initiate criminal proceedings or the implementation of customs measures.

Relevant Contacts:

- National Authority of Consumer Protection - <http://www.nfh.hu/portal/>
- Public Security Police - <http://www.police.hu/>
- Hungarian Customs and Finance Guard <http://www.vam.hu/welcomeEn.do>

Collective societies

Under the following link you can find a list of all Hungarian collective societies:
<http://www.mszh.hu/English/szerzoi jog/intezmenyek/magyar/>

Actions at customs

Applicable laws

- EC Regulation No. 1383/2003;
- Article 11 of EC Regulation No. 1383/2003, simplified procedure for the destruction of goods;
- EC Regulation No. 1891/2004
- Government Decree No. 371/2004.

Customs action on request

In Hungary, the Hungarian Customs and Finance Guard shall act on requests submitted by holders of intellectual property rights. The application for action can be based on infringement of IPR (counterfeiting, piracy).

If a right holder suspects that its IPRs may be being violated, it should contact the Central Hungarian Regional Directorate of the Hungarian Customs and Finance Guard.

To request a customs action, the right holder should fill out the form "National Application for Action" or "Community Application for Action".

The application form shall be submitted to:
Hungarian Customs and Finance Guard
Central Hungarian Regional Directorate
Department for the Protection of Intellectual Property Rights
H-1143 Budapest, 112-114 Hungária krt., Hungary

The application for action is examined by the IPR department. If the application is granted, the applicant is informed of the decision, which shall be forwarded to the national customs offices. The IPR department shall specify the period, not more than 1 year, during which the customs offices are to take action. This period can be extended at the right holder's request.

If a customs office finds that goods are suspected of infringing an intellectual property right covered by the granted application, it shall suspend release of the goods or detain them. These goods can be inspected by the right holder. The right holder shall notify the customs office within 10 working days that court proceedings have been initiated against the IPR infringement.

The application for action shall be accompanied by a declaration in which the right holder agrees to bear all costs of keeping the goods under customs control and, if applicable, for the destruction.

A simplified procedure for the destruction of infringing goods shall be applied in Hungary.

Customs action ex officio

Customs authorities shall also act *ex officio* if they have sufficient reason to suspect that goods infringe intellectual property rights. The authority shall inform the right holder that an application for action may be lodged. If the right holder is unknown, the authority shall contact the Hungarian Patent Office or the organisations for collective management of copyrights, which have 3 working days to provide information on the right holder.

Main contacts

To take action against possible infringements of intellectual property rights, the holder should contact the Hungarian Customs and Finance Guard. The ap-

plication for customs action shall be filed with the IPR Department of the Central Hungarian Regional Directorate. The contacts are:

Tel.: +36-1-4704155 or +36-1-4704100

Fax: +36-1-4704253 or +36-1-4704140

E-mail: vpkmp.sztvo@vam.gov.hu

Alternative ways to deal with infringements in Hungary

As an alternative dispute resolution forum, the parties concerned by infringement of IPRs may stipulate the jurisdiction of the Arbitration Court attached to the Hungarian Chamber of Commerce and Industry. An arbitration agreement may come in the form of an arbitration clause in a contract or in the form of a separate agreement.

If arbitral proceedings have not already been instituted, the Arbitration Court may conduct conciliation-mediation proceedings between the parties in the dispute to peacefully resolve the dispute.

The language of the proceeding may be Hungarian, English or German. The arbitral tribunal shall apply the law stipulated by the parties.

The arbitral tribunal conducts the proceedings according to the provisions of its own present Rules of Proceedings, which are available at:
<http://www.mkik.hu/index.php?id=1407>

Main links and contacts for additional support

Contacts: Secretary of the Arbitration Court attached to the Hungarian Chamber of Commerce and Industry

www.mkik.hu

Tel: +36-1-474-5180

Fax: +36-1-474-5185

E-mail: vb@mkik.hu

Contact of the Hungarian Patent Office:

Industrial Property Information and Education Centre

1054 Garibaldi u.2,

P.O.Box 552, H-1370, Budapest

+36 1474 5561

www.hpo.hu; mszh@hpo.hu

Italy

Design rights

Applicable laws

Italian Code of Industrial Property Rights, published on 4/03/2005 as Legislative Decree No. 30/2005 and following modification (articles 31/44).

What can and cannot be protected?

The design must be new and have individual character.

For further information, please go to: www.uibm.gov.it

Design applications not demonstrating new and/or individual character requirements cannot be registered. Designs that go against public order or good morals cannot be protected either.

Design protection applies only to the formal appearance, while utility models protect the functional appearance. In practice, the same form can benefit from both utility model and design protection at the same time. In this case, with reference to the same object, the law allows the owner to apply for and be granted both utility model and design protection at the same time.

A protected design or model may also be eligible for protection under copyright law, but only for designs that meet 2 additional requirements: creative character and artistic value. This is a derogation from the general rules for copyright, which don't require a work to have a specific artistic value.

Formalities

An application must be made on the appropriate form and filed with one of the chambers of commerce, or sent by registered post with proof of re-

ceipt of delivery to the UIBM (Italian Patent and Trademark Office), via Molise 19, 1-00187 Roma. E-filing for applications has been available since 2006. It can be made through: www.uibm.gov.it/it/telemaco.htm

The application shall contain:

- Information identifying the applicant and any attorney,
- Information containing an indication of the design as a title and, if necessary, the product features to which it is intended to be applied.

In addition to the application, the following documentation shall be attached:

- Representation of the design in drawings, which may be replaced by photographic reproductions or by samples;
- A design description, if needed to understand the design itself;
- Documentation concerning the appointment of a representative if the applicant has appointed one.

Registration protects the appearance of a product, but there are no specific aesthetic requirements. Multiple designs can be included in a single application if the products are in the same class and don't exceed the upper limit for number of designs. There is no period of secrecy, except upon request by the applicant to prevent accessibility for a maximum of 12 months from the date of filing or the date of priority.

For further information, please go to: www.uibm.gov.it/it/moduli/Istruzioni_deposito_modulo_O.pdf

Costs (at the date of publication)

Filing Fee:

- for a single design:
 - filed in electronic form: 50 EUR;
 - filed in paper form: 100 EUR.

- for multiple designs:
 - filed in electronic form: 100 EUR;
 - filed in paper form: 200 EUR.

Maintenance costs:

2nd five years: 30 EUR; 3rd five years: 50 EUR; 4th five years: 70 EUR; 5th five years: 80 EUR.

Examination

Applications are subject to a formal examination by the Italian Patent and Trade Mark Office UIBM.

Duration of protection

The exclusive right takes effect from the date the application is filed and has a validity of 5 years, which is renewable for an additional four terms of 5 years each, up to a maximum of 25 years.

To keep a registered design in force, renewal fees must be paid. Payment of fees can be made to the Poste Italiane postal account no. 668004 (owner account Agenzia delle Entrate – Centro Operativo di Pescara).

Ownership of the right

The registration of an industrial design confers on its holder the exclusive right to use it and prevent third parties not having its consent from using it.

Trade mark rights

Applicable laws

Italian Code of Industrial Property Rights, published on 4/03/2005 as Legislative Decree No.30/2005 (articles 7/28)

What can and cannot be protected?

All signs capable of being represented graphically can constitute a trade mark, provided that they possess a distinctive character capable of distinguishing the goods or services of an enterprise from the goods and services of another one.

It is not possible to apply for a trade mark dealing with the following subjects:

- portraits and names of people without the consent of the person concerned;
- coats of arms, flags, official emblems and other signs covered by international conventions in force;
- words, figures or signs contrary to law, public order or morals;
- signs capable of deceiving consumers about geographical origin, nature and quality of goods or services;
- signs that, if used, constitute an infringement of a third party's exclusive IPRs.

In Italy, you can also protect collective marks.

Formalities

An application must be made on the appropriate form and filed with one of the chambers of commerce, or sent by registered post with confirmation of delivery to the UIBM (Italian Patent and Trade Mark Office), via Molise 19, 1-00187 Roma. E-filing has been available for applications since 2006. It can be made through: www.uibm.gov.it/it/telemaco.htm

To file a trade mark application, the following is required:

- compiled C module with applicant(s) information;
- list of goods/services according to the International Classification of Goods and Services);
- payment fees,
- power of attorney signed by the applicant(s).

If the application concerns the registration of a collective mark, a copy of the regulation concerning the use of this mark and the controls and sanctions relating thereto must also be attached.

For further information please go to: www.uibm.gov.it/it/moduli/Istruzioni_deposito_modulo_C.pdf

Costs (at the date of publication)

Filing fee

- For one class: 101 EUR; for any additional class: 34 EUR; power of attorney: 34 EUR.

Maintenance costs

- For one class: 67 EUR; for any additional class: 34 EUR; power of attorney: 34 EUR.

Collective trade mark filing fee

- For each class; 337 EUR; power of attorney: 34 EUR;

Collective trade mark maintenance costs

- For each class: 202 EUR; power of attorney: 34 EUR;

Stamp duty and secretarial fees

A stamp duty of 14.62 EUR must be applied to the original C application module. To obtain an application receipt, the applicant should pay:

- 14.62 EUR (stamp duty) + 43 EUR (secretarial fees) in the case of authentic document copy for legal use;
- 40 EUR (secretarial fees) in the case of simple document copy.

If the application is made through an attorney, it will be necessary to put a stamp duty of 14.62 EUR on the power of attorney.

Examination

UIBM provides for formal (the completeness and regularity of the documentation filed) and substantive (distinctiveness, lawfulness and lack of deceptiveness) examinations. The opposition procedure is under implementation.

Duration of protection

An applicant can apply to register a trade mark for periods of 10 years, indefinitely renewable. The exclusive right takes effect after registration, but is retroactive to the date the application is filed. To renew a mark without any change, it is sufficient to submit an application and pay the fees due within the 12 months preceding the expiry of the 10-year period in force or within the following 6 months with a surcharge.

Ownership of the right

A registered trade mark confers upon its holder the exclusive right to use it. The trade mark holder has the right to prevent third parties from using in economic transactions without prior consent:

- any sign identical to the trade mark in relation to goods or services identical to the ones for which the trade mark is registered;
- any sign identical or similar to the registered trade mark in relation to identical or similar goods or

services if there is a risk of confusion on the part of the public;

- any sign identical or similar to the registered trade mark in relation to goods and services that are not similar to those for which the trade mark is registered in the case of well-known trade marks.

Patent rights, including utility models

Applicable laws

Italian Code of Industrial Property Rights, published on 4/03/2005 as Legislative Decree No. 30/2005 (articles 45/81 and 82/85)

What can and cannot be protected?

Both patents and utility models define an intellectual creation with technological content in any field, but they are two different IP rights which cannot be combined. Patents and utility models differ in the innovative step required.

The object of a patent is a new invention that involves inventive activity and is capable of industrial application. Meanwhile, a utility model consists of improvements in shape that do not realize a solution to a technical problem but which confer a particular utility on a product that already exists. Thus, the improvement brought about by the shape just gives a product more efficacy and/or a greater comfort in handling but does not transform the object into something substantially new and different.

However, by law, anyone applying for a patent for an industrial invention may at the same time file an application for a utility model to be executed if the patent application is refused or accepted only in part.

Both of these IP rights have existed in the Italian legal system for about 70 years. The reason is not to provide an easier way to patent an invention by setting up a sort of minor patent. The main aim is to have a tool to protect a specific innovation dimension related to the functionality.

The following inventions cannot be protected by patent:

- discoveries, including scientific theories and mathematical methods;
- plans, principles and methods for intellectual activities, aimed at games or commercial activities and software;
- presentations of information.

Methods of surgical or therapeutic treatment, as well as methods of diagnosis, for both humans and animals, cannot be the object of a patent for invention. Animal breeds and means of obtaining them cannot be the object of a patent for invention either.

Divisional applications apply to a very specific situation. The law establishes the principle of unity of invention, which requires that a patent only cover one invention. In the case of an application containing several inventions, only the principal will be considered the object of the patent application, and the applicant may file separate divisional applications for each other invention.

These applications will benefit from the filing date of the initial application but will be treated as independent applications.

Formalities

Any application for an invention or utility model is subject by law to a period of secrecy of 18 months, of which the first 90 days - which cannot be waived under any circumstances - are to allow defence authorities to check their interest in the invention. Proprietors may decide to make their applications available to the public earlier, and applications may be revealed after the above-mentioned 90 days. Proprietors residing in Italy must obtain authorisation from the Italian Patent and Trade Mark Office, which must obtain the opinion of the defence authorities, if they wish to directly file a patent application abroad, and they cannot do so before the end of the irrevocable period of secrecy of 90 days.

Priority must be claimed at the same time as the application for the patent or, at the latest, within the following two months, without exceeding 12 months from the priority date claimed. The priority claim must provide details of the first filing and related documentation and must be accompanied by a translation into Italian. If this documentation is not filed with the priority claim, it must be submitted within 6 months of the application's filing.

An application must be made on the appropriate form and filed with one of the chambers of commerce, or sent by registered post with acknowledgment of delivery to the UIBM (Italian Patent and Trademark Office), via Molise 19, 1-00187 Roma. E-filing has been available for applications since 2006. It can be done through: www.uibm.gov.it/it/telemaco.htm

The following documents are requested for submission:

- description of the invention's claim to novelty and distinguishing features;
- summary and description of the invention;
- drawings for description understanding;
- image for publication (if required);
- payment of the application fees.

For further information, please go to: http://www.uibm.gov.it/it/moduli/Istruzioni_deposito_modulo_A.pdf

http://www.uibm.gov.it/it/moduli/Istruzioni_deposito_modulo_U.pdf

Costs (at the date of publication)

Patent filing fee

- online filing: 50 EUR;
- paper filing for a document less than 10 pages: 120 EUR;
- paper filing for a document with more than 10 pages and less than 20 pages: 160 EUR;
- paper filing for a document with more than 20 pages and less than 50 pages: 400 EUR;
- paper filing for a document with more than 50 pages: 600 EUR;
- any claims after the 10th: 45 EUR;
- priority report research fee: 200 EUR **Utility model fee**;
- online filing: 50 EUR; **paper filing**: 120 EUR.

Stamp duty and secretarial fees

- authentic application receipt document copy for legal use: 14.62 EUR (stamp duty) + 43 EUR (secretarial fees);
- simple application receipt document copy: 40 EUR (secretarial fees).

If an application is made through an attorney, it will be necessary to put a stamp duty of 14.62 EUR on the power of attorney.

Patent and utility model maintenance costs:

To keep a patent for an invention in force, renewal fees must be paid on the 5th anniversary of the filing date and every year after that. Meanwhile, to keep a utility model in force, renewal fees must be paid from the second 5 year period and every year after that up to 10th year.

For further information, go to: www.uibm.gov.it/it/tasse

Examination

Patent:

All applications are subject to formal and substantive examination by UIBM and then kept secret for military purposes for a maximum of 90 days. Since 1/07/2008, an agreement between UIBM and the European Patent Office EPO for the Italian search report has been in effect:

- EPO shall produce a search report together with a “patentability opinion” within 9 months from the filing date and send it to UIBM. In this way, the applicant may decide whether or not to proceed with foreign extensions.

An application is publicly available 18 months after the filing date. If the application is rejected, UIBM informs the applicant of the reasons for refusal. The applicant can appeal to the relevant commission. A revocation request of a granted patent could be obtained through specialised court sections dealing with industrial property rights.

Utility model:

All applications are subject to formal and substantial examination by UIBM.

Duration of protection

The exclusive right takes effect from the date the application is filed and has a term of 20 years for patents and 10 years for utility models.

Maintenance fees must be paid yearly to the Poste Italiane postal account no. 668004 (owner account Agenzia delle Entrate – Centro Operativo di Pescara).

Ownership of the right

Starting from the date when the application is made public, the granting of a patent confers on its owner the exclusive right to exploit it and specifically:

- (goods) to prevent third parties, without owner consent, from producing, using, commercialising, selling or importing the good;
- (services) to prevent third parties, without owner consent, from using the process or using, commercialising, selling or importing the good manufactured with the patented process.

What to do if I am copied? (designs, trade mark, patents)

If intellectual property rights are infringed, the right owner may lodge a civil or criminal case in the courts by filing a complaint with the relevant authorities (Guardia di Finanza www.gdf.it, Polizia locale, Polizia di Stato, Carabinieri, and Polizia Forestale, Custom Agency, www.agenziadogane.it).

In 2003, 12 specialised IP sections were established at the courts and courts of appeal of Bari, Bologna, Catania, Florence, Genoa, Milan, Naples, Palermo, Rome, Turin, Trieste and Venice. The specialised sections have jurisdiction in disputes regarding patent, utility model, trade mark, new plant variety, design and copyright infringement/validity, as well as unfair competition affecting the protection of industrial and intellectual property.

In actions related to IPR disputes, a summary (shortened) proceeding has been introduced to achieve a shorter timeframe for judicial decisions, and the new legal provisions are aimed at “stabilising” the provisional measure making the case on the merits optional.

A party can take both civil and criminal action to protect its rights.

In the case of civil action, the owner of the right can ask for precautionary measures to temporarily inhibit the violation. In the event the violation has been ascertained, the judge can order the cessation of manufacture, commerce and use of goods, arrange for their destruction, and assign the goods to the right holder without compromising its right of compensation for damages. When awarding damages, the judge shall also take into account the negative economic consequences for the right holder (e.g. missed earnings, moral damages suffered from the violation). The right holder can ask for the profits of the infringer as an alternative to the compensation of the loss of profits, as long as the amount exceeds such compensation.

Copyrights and related rights

Applicable laws

- Italian law no. 633 passed on 22/04/1941 establishes the protection of intellectual works in literature, music, visual arts, architecture, theater and cinema.

- Cinematographic work and audiovisuals -Law no. 93/1992
- Copyright and Related Rights Code – Law no. 248/2000

What can and cannot be protected?

A wide range of intellectual works and efforts come under the protection of copyrights, such as artistic, literary, theatrical and musical works, films and visual arts. Copyright also extends to scientific or didactic writings, architectural works, radio and television productions, photographs, the work of interpreters, translations, minimally original music collections, computer software, etc.

Related or neighbouring rights are those granted by law not to the author of the work but to the subjects connected to it. The most important neighbouring rights are those granted to performers, phonographic producers, producers of cinematographic or audiovisual works, and to radio and television broadcasting companies.

Other neighbouring rights with much weaker protection than that provided by copyright are those granted to authors (or publishers) in connection with those works that do not properly represent “intellectual works”. This is the case for photographs, sketches of theatrical scenery, critical editions of works of public domain, unpublished works published after copyright has expired, etc.

Formalities

The registration of copyrights and related rights is merely optional, declarative, assuring only an initial presumption of authorship.

There are no procedures to be followed to obtain the recognition of copyright. Copyright stems directly from the creation of the work.

Filing of unpublished works could be done with the Italian Association of Authors and Publishers (SIAE).

A request for deposit of unpublished works must be mailed to SIAE or submitted directly to the OLAF Section at SIAE's Headquarters.

The applicant must provide the following:

1. A completed and signed copy of the form (mod. 350), which can be obtained either directly from

SIAE's OLAF Section or from any other SIAE branch office located in any Italian regional capital.

2. A copy of the unpublished work, signed in original and in full with first name and last name (with the exclusion of pseudonyms) by all authors and other right holders on each and every written sheet, including the title heading. If the work is not reproduced on paper but on carriers such as videocassette, magnetic tape, floppy disk, cassette, CD, CD ROM, DVD, etc., the full signature of all authors, and other right holders, if any, must be placed – together with the title – on an adhesive label stuck directly on the carrier.

3. The deposit fee.

4. If the fee is paid at the post office, the applicant must provide the original receipt proving payment. If the fee is paid through bank transfer, the documentation showing the transaction has been made must be provided.

If, within 60 days from the date of its receipt by SIAE, the mailed request for deposit is not completed following the requirements specified above, SIAE will return the unpublished work to its rightful owner at his/her own expense, and the deposit request will be cancelled. Moreover, SIAE will reimburse the deposit fee if already paid; deducting only the administrative expenses (27.59 EUR).

Costs (at the date of publication)

The fees to deposit unpublished works at SIAE vary according to the method of payment selected:

By money order addressed to: SIAE – Sezione OLAF, account number 76808005

- 55 EUR for SIAE members;
- 110 EUR for authors who are not SIAE members;
- 220 EUR if the deposit is requested by a legal person (societies, associations, institutions and so on) having the right to the economic exploitation of the works, or by a natural person (other than the author) who has acquired the right to the economic exploitation of the work from the author.

By bank transfer, check, or at SIAE's offices

- 55 EUR for SIAE members;
- 111.81 EUR (including a 1.81 EUR revenue stamp for authors who are not SIAE members);
- 221.81 EUR (including a 1.81 EUR revenue stamp if the deposit is requested by a legal person (societies, associations, institutions and so on) hav-

ing the right to the economic exploitation of the works, or by a natural person (other than the author) who has acquired the right to the economic exploitation of the work from the author.

The bank transfer must be addressed to:
UNICREDIT BANCA DI ROMA SpA – Roma Caravaggio
– Piazzale dell’Industria, 46 – 00144 Roma – codice
IBAN IT69 N 03002 05276 000002906956.(*)

(*) Please remember to always specify the title of the work and the details concerning the consignor. The registration costs are as follow:

- One stamp of 14.62 EUR for each request module;
- Registration fee (if necessary).

For further information, please contact the *Information desk*

Ph. + 39 06 59902615-2806-2623

fax + 39 06 59902435

urp@Siae.it

open to public from Monday to Friday from 9 a.m. to 12:30 p.m. and on Tuesdays and Thursdays also from 2:30 p.m. to 4:00 p.m.

Examination

Not applicable.

Duration of protection

Copyright protection in Italy starts from the moment of creation and lasts 70 years after the death of the author. When the author is unknown, duration is 70 years from the first publication.

Ownership of the right

The ownership of the right lies with its creator or with the creator’s Italian or foreign successor in title. The author has both patrimonial and moral rights.

Moral rights are ensured by law to protect the author’s personality and are preserved even after the assignment of the economic rights. Moral rights are not subject to legal terms of protection.

The most important moral rights are:

- Paternity of the work (i.e. the right to claim one’s status as author);
- Integrity of the work (i.e. the possibility to oppose any change that might damage the author’s reputation);

- Publishing right (the possibility to decide whether to publish the work or not).

The most important economic rights are:

- Reproduction right (i.e. the right to reproduce an unlimited number of copies in any way);
- Performance, recitation, or public reading right (i.e. the right to present the work to the public in all the above-mentioned forms);
- Communication to the public right (i.e. the right to diffuse the work through radio, television, satellite, cable, Internet, etc.);
- Distribution right (i.e. the right to sell the work);
- Adaptation right (i.e. the right to change the original work modify it, adapt it, etc.).

All these rights allow the author to grant or deny authorisation for the use of his work and to benefit from it economically.

What to do if I am copied (copyrights and related rights)

Infringement of copyright can be prosecuted and sanctioned under civil law and criminal law.

For more information: **SIAE General Direction**, Viale della Letteratura 30, 00144 – Roma; phone: 06 59901; fax: 06 59647050/52; www.siae.it

Actions at customs

How do the Italian customs authorities act?

Customs authorities are called upon to counter any possible infringement or abuse of correct rules of free trade. The Italian “Agenzia delle dogane” has the power to suspend the release of goods or block suspicious goods. The Italian Customs Agency has created FALSTAFF, a multimedia database, as a support tool to combat counterfeiting. For more information go to:

<http://www.agenziadogane.it/wps/wcm/connect/ee/HomePageEn/Falstaff/About+Falstaff/>

FALSTAFF, integrated with National Customs Information System AIDA, is fed by the right holders requesting an action that may be combined with photos, leaflets, manuals and any other elements useful for an easier and timely identification of the authentic product. The application for action can also be entered by giving particulars concerning the identity of

the importer, exporter or holder of the goods, place of production, routes followed, transportation and packaging modes, scheduled arrival and departure dates, value of the products, the routes followed by traffickers and the country or countries of production of the suspect products, so that a right holder is aware that counterfeit goods may be subject to a customs operation by a certain operator at a certain customs office and may indicate this information in the request for action.

Should any doubts arise as to the authenticity of a product, a customs official may query FALSTAFF and make a comparison between the suspected counterfeit products and the authentic products to detect any technical differences between them.

All national customs declarations are checked in real time by the electronic system AIDA and valued by specific risk profiles generated on the basis of the parameters indicated in the application for action. By this action, if one declaration contains data concerning suspected products, it is possible to immediately intercept the goods for a physical control and alert the right holder (also by sms).

Procedures

An application for an intervention by national customs authorities can be made using a paper form downloaded from <http://www.agenziadogane.it/> and presented to the competent custom office.

Main contacts

Italian Customs Agency Ufficio Antifrode,
71 Mario Carucci St. - 00143 Rome
Tel.: +39 0650246401; Fax: +39 0650957300
E-mail: dogane.antifrode@agenziadogane.it

Alternative ways to deal with infringements

Recently, some changes concerning anti-counterfeiting institutions have occurred in Italy. The change consists essentially in a shift from an individual to a

collective body, while the competences and functions concerning the monitoring and the policies to combat counterfeiting remain the same. Since July 2008, the Ministry of Economic Development, in collaboration with the Guardia di Finanza has provided a new service, *Filo Diretto* (telephone, fax and e-mail), dedicated to businesses and consumers to assist in case of infringements of IPRs: the call centre (00390647055437) is open from 8:30 to 17:30, Monday to Friday (excluding holidays). Alternatively, it can be contacted by fax (0647055390) or a notification e-mail

(anticontraffazione@sviluppoeconomico.gov.it) managed by the Directorate general combating counterfeiting – Italian patent and Trademark Office.

Further information is available on the Ministry of Economic Development's Web site devoted to counterfeiting: www.noalfalso.it/

A network of IP helpdesks located in the Italian Trade Commission offices (Istituto per il Commercio Estero – ICE) in markets considered sensitive by Italian enterprises has also been set up. Countries where IP helpdesks have been established include: China (Beijing, Guangzhou, Shanghai and Hong Kong), India (New Delhi and Mumbai), Taiwan (Taipei), Vietnam (Ho Chi Minh City), Korea (Seul), United Arab Emirates (Dubai), the Russian Federation (Moscow), Turkey (Istanbul), Brazil (San Paolo) and the U.S. (New York).

They are run by IP experts (an Italian IP expert supported by a local IP expert) and provide information on how the local IP system works (registration procedures for each IPR and enforcement procedures in the event of infringement). There is also special legal assistance if the solution to an infringement case represents a pilot case to open the market.

Contact of the National Patent Office

Direzione generale per la lotta alla contraffazione -
Ufficio Italiano Brevetti e Marchi
Via Molise 19
00187 ROMA – Italy
www.uibm.gov.it; www.uibm.eu
0039 06 47055800
callcenter@uibm.eu

Lithuania

Design rights

Applicable laws

Law on Design of Republic of Lithuania (LR Dizaino įstatymas) No. IX-1181, last updated 17/07/2008. http://www3.lrs.lt/pls/inter3/dokpaieska.showdoc_l?p_id=325317

What can and cannot be protected?

An industrial design must be “new” and must have an “individual character”.

Important: you cannot disclose your design to the public more than one year before your application date.

The following can't be registered as a design:

- computer programs;
- design contradictory to the principles of public morality;
- heraldry and other official symbols of Republic of Lithuania (except in special cases);

Formalities

You can apply for exclusive design rights on Lithuanian territory, in the EU internal market or internationally through the Lithuanian State Patent Bureau (further LSPB). You can download and complete the registration forms in Lithuanian here: <http://www.vpb.gov.lt/index.php?n=171&l=lt>

You can deliver it by hand or send it by post to the LSPB office. The documents and data required to file a national application are:

- a request for registration (one application may include up to 10 design “samples”);
- photographs or drawings of the article embodying the design (from 8x8cm to 10x14cm);
- the name of the design and indication of the class (the Locarno classification);

- a summary description of the design;
- declaration of the author and the document proving transfer of copyrights (LSPB forms);
- power of attorney (when needed);
- if a priority date is claimed, a copy of the priority document certified by the registrar in the relevant country.

However, individuals who are not residents of the EU, should apply for these rights only with the assistance of a patent attorney.

Costs (at the date of publication)

Title of fees for national designs	LT
Filing an application (one design)	320
Filing fee for an additional design in one application	120
Registration, publication, grant of certificate	320
Renewal fees: second 5-year period	800

Note: fees are 50% less for individuals. See updated and additional figures at <http://www.vpb.lt/index.php?n=172&l=lt>

Renewals should be requested before the final 6 months of the registration's validity. If a deadline is missed, it is still possible to extend the registration within 6 months of expiry, but an additional 50% fee applies.

Examination

An examination is conducted to check formalities, such as whether the design in the application corresponds to the design definition and whether it is contrary to morality. The LSPB does not examine novelty and individual character criteria. The applicant is responsible for checking that the design is novel and should, therefore, search the Lithuanian national system <http://www.vpb.lt/index.php?n=165&l=lt>

and European registered design databases. The market and other relevant sources should also be searched.

Lack of novelty may be grounds for invalidation of a design registration. Also, the certificate cannot be issued if a third party opposes the registration (within 3 months) in the appeals division of the LSPB. After the certificate is granted, invalidation of a national design can only be sought through a court proceeding.

The design will be published in the Official Gazette of LSPB within 6 months of the application date when an examination has been completed and payment has been made. Then it will be made public. The applicant can ask to delay the publication by 30 months for strategic reasons.

Duration of protection

The duration of a national registration is 5 years from the filing date. The registration may be renewed 4 times (for 5 years each time).

Ownership of the right

The holder of a registered industrial design shall:

- have the exclusive right to use the design and to authorise others to use it. It also includes the rights to manufacture, offer, sell, put on the market, import or export, and use the products or parts which are a copy of the registered industrial design.
- benefit from copyright protection that automatically enters into effect on the date of its creation.

Trade mark rights

Applicable laws

Lithuanian law on trade mark rights (LR Prekių ženklų įstatymas, No. VIII-1981, last updated 08/06/2006) http://www3.lrs.lt/pls/inter3/dokpaieska.showdoc_l?p_id=279274

What can and cannot be protected?

It is possible to register any sign capable of being expressed graphically. Lithuanian law provides for registration of the following marks:

- words, personal names, artistic pseudonyms, company names, slogans;
- letters, numerals;
- drawings, emblems;
- three-dimensional form (the shape of goods, their packaging or containers);
- colours or combinations of colours, their compositions;
- any combination of the signs above.

Sounds may be registered if they can be reproduced graphically. In principle, taste and smells are not excluded from the registration, though as yet no acceptable way of representing them graphically has been discovered. The law contains provisions for the registration and protection of collective marks.

You can't register a mark that has no distinctive character, is an appellative name, could mislead, is against morality, contains symbols of state, is of big value, especially religious, etc. (see more details in art. 6 of the trade mark law).

Formalities

Trade mark registration and protection in Lithuania can be obtained under 3 systems: a) national; b) Madrid Protocol with designation of Lithuania or the EU ; c) international.

(For more information, go to the European and international factsheets.)

Each system provides equal rights in the territory of Lithuania. The date of acquisition of trade mark rights is established by the date of application or priority date (if applicable).

You can register your trade mark by filling out an application and other forms in Lithuanian: <http://www.vpb.lt/index.php?n=186&l=lt>

When registering your mark, you should be aware that:

- a request for registration and all other documents should be submitted in Lithuanian;
- multi-class applications (including goods and services) and applications for 3-D marks are allowed;
- claiming convention priority is allowed;
- an application with priority for a part of a good or service may be filed;
- proof of use or intention to use is not required;

- letters of consent or agreements with holders of earlier trade marks are not filed;
- series applications, split applications and the division of an application are not allowed under national law;
- goods and services should be listed in accordance with the Nice Classification;
- disclaiming of unprotected elements may be indicated in the application or such disclaimers may be made on the examiner's demand.

The filing documents, which can be delivered by hand or sent by post to the LSPB office include:

- a request for registration;
- a document certifying payment of the fee;
- power of attorney (when applicable);
- a request for priority to be granted (where appropriate);
- a permit issued by the appropriate authorities if the applied mark contains national symbols;
- consent of the owner of the rights for a copyrighted work, the name or surname of a famous person, etc.

The owner of a national mark may be a legal or physical person from any country. Representation by a local attorney is not obligatory for EU residents. Applicants from outside the EU must use a national attorney. In case of disputes, a national attorney's assistance is necessary as all documentation and processes are effected in Lithuanian.

Costs (at the date of publication)

At the date of publication, fees are as follows:

Title of the fee	LT
Filing an application in one class	240
Filing fee for each additional class	120
Registration, publication, granting of a registration certificate	240
Renewal of one class	240
Renewal of each additional class	120

The filing fee covers the registration procedure for the trade mark and a 10-year period of protection. The same rule applies to the renewal fee. Fees are 50% less for physical persons. See updated and additional figures at <http://www.vpb.lt/index.php?n=187&l=lt>

Examination

After the application is submitted, LSPB will issue a receipt that includes an application number and date.

Formal Examination. The LSPB will check the documents against formal requirements and determine whether all the necessary documents have been properly filled out and submitted.

Examination of the mark against absolute requirements. The examination is conducted only with regard to the contents of the mark and not with regard to the applicant's behaviour. If the examiner denies registration, the applicant may respond within 3 months by submitting argumentation in support of the mark.

In the case of refusal after the re-examination, the applicant reserves the right to lodge an appeal with the LSPB.

Appeal of refusal. The appeal will be considered by the Appeal Board of the LSPB. Normally, such appeals are oral hearings, though the applicant is allowed to submit written argumentation instead.

Registration and publication. If the mark is approved for registration, the applicant is notified to pay the publication fee. Within 1-2 months, the mark will be published in the Official Gazette of the LSPB.

Opposition by a third party. Opposition can be filed within 3 months of publication. This period cannot be extended. Evidence may be submitted no later than 2 weeks before the hearing date. The presence of the parties is not mandatory. Any party that is unsatisfied with the decision of appeal board has the right to appeal in court.

Granting of a National Registration Certificate.

It takes at least 1 year from the date the application is filed (and longer if there are any problems) before the certificate is issued.

The LSPB does not examine whether trade mark applications infringe the rights of third parties by misleading because they are similar to another that is already registered or for which an application is pending. Therefore, it is very important before starting the application to search databases and check applications and registered trade marks. See: <http://www.vpb.lt/index.php?l=lt&n=180>

Duration of protection

The 10-year registration validity period starts on the date the application is filed. Renewal of the registration (for 10 years at a time) should be obtained within the last year of validity.

Ownership of the right

After the certificate is granted, the holder can prevent third parties from using any sign, identical or similar, in products or in services for which the trade mark has been registered. He can initiate infringement actions in court, grant licenses etc. The holder could not do those things while the mark application was pending. Rights assignments and changes with regard to national marks become valid and take effect in Lithuania after this is recorded in the LSPB register. Licenses, whether exclusive or non-exclusive, may cover all or part of a product, have a limited or unlimited term of validity, and be granted for all or part of the territory. National law requires that the proof of a license must be signed by both parties.

Patent rights, including utility models

Applicable laws

Lithuanian Patent Law (LR Patentų įstatymas, No. I-372, last updated on 10-05-2007) http://www3.lrs.lt/pls/inter3/dokpaieska.showdoc_l?p_id=297858

Decree from the Minister of Economy of 27-08-2008 on reimbursement of up to 100% of European and PCT patent costs for Lithuanian residents and legal entities.

http://www.ukmin.lt/lt/dokumentai/aktai/detail.php?ID=9140&phrase_id=178447

Utility models are not subject to the law in Lithuania.

What can and cannot be protected?

Patents are granted for technical solutions that meet 3 criteria: a) be new, b) involve an inventive step; c) be capable of industrial application and available for any inventions in all fields of technology provided. Patentable subject matter may be a method, device or material.

For the full list of the non-patentable inventions, see Art 2 of the Lithuanian Patent Law.

Protection of inventions in Lithuania is granted on the basis of national, international or European patent system procedures. All these systems guarantee equal rights for patents to be valid in Lithuania. See more: <http://www.vpb.gov.lt/index.php?l=lt&n=137>

Formalities

Application forms must be filled out from here: <http://www.vpb.lt/index.php?n=147&l=lt>. You can deliver documents by hand or send them by post to the LSPB office. The documents you need to provide are:

- a request to grant a patent;
- a description of the invention;
- the text of claims;
- drawings (if they are necessary to understand the essence of the invention);
- an abstract;
- a document confirming the right to file a patent application (if not filed by the inventor) and the inventor's authorship declaration;
- power of attorney;
- priority document certified by the patent office of the relevant country (if priority is claimed).

A foreign applicant not residing in the EU and seeking to patent his invention in Lithuania must appoint a local agent to act before the local patent office. All documents should be submitted in Lithuanian.

The period from the filing to the granting of a patent is 24 months.

Costs (at the date of publication)

Official Patent Fees	LT
Filing an application (up to 10 claims)	400
Filing each additional claim (national)	40
Early publication (at the applicant's request)	120
Grant of patent (national)	240

Note: all fees are 50% less for individuals.

See more figures at:

<http://www.vpb.lt/index.php?n=148&l=lt>

Annuities for Patents

Patent validity year	LT	Patent validity year	LT
from 1 st to 2 nd	included in the filling fee	8 th	640
3 rd	280	9 th	720
4 th	320	10 th	800
5 th	400	from 11 th to 15 th	1000 each year
6 th	480	from 16 th to 20 th	1,200 each year
7 th	560		

The annual fee should be paid within the last 2 months of the year. If the deadline is missed, a 6-month extension of the period for payment is allowed, but the fee is increased by 50%. If the annual fee is not paid for a year, the patent owner loses exclusivity for its rights.

Examination

Once a patent application is submitted, the LSPB responds by issuing a filing receipt with an application number and date. The LSPB checks applications against formal requirements to determine whether an invention can be patented. It does not conduct searches during its examination. Applicants are responsible for conducting patent searches among national, PCT and European patents valid in the territory of Lithuania.

If an examiner turns down an application, the applicant may file an appeal. The appeals department will hold an oral hearing, and if the examiner's decision is not reversed, the applicant may take the case to court.

The LSPB does not conduct examinations to determine novelty or whether the invention involves an inventive step.

Third parties may demand the invalidation of a patent on these grounds by initiating a court action (for the first instance - Vilnius District court).

Within 18 months (6 months upon special request by the applicant) of the patent application date, it is published in the Official Gazette and included in the online database at:

<http://www.vpb.lt/index.php?l=lt&n=332>.

Duration of protection

National law establishes a 20-year period of patent validity.

Ownership of the right

Acquiring the rights. If the inventor creates an invention at work while performing his duties as an employee, the economic rights for the patent belong to the employer, unless otherwise agreed upon. The inventor is entitled to an authorship fee based on the economic value of the patent and the agreement with employer. If the invention comes about during the execution of the agreement between 2 parties, the ownership rights belong to the entity identified in the agreement as the Intellectual Property Right owner.

The inventor, together with other authors, if any exist, owns all moral rights. See more on acquisition of rights in Art.7-9 of the patent law.

Owners' rights. The owner of the patent has the exclusive right to exploit the invention and to prevent third parties from doing so without his permission. This includes making, using, offering, selling, importing or exporting product or products obtained directly by the patented process.

The owner can assign or transfer any or all exclusive rights or grant a license to another party. A license or assignment of rights becomes valid in Lithuania when it is recorded in the register of the national patent bureau.

Useful links

State Patent Bureau of the Republic of Lithuania
<http://www.vpb.lt/>

Official Gazette of the State Patent Bureau (publishes all new IP records)
<http://www.vpb.lt/index.php?n=245&l=en>

Patent information Center (information, consultations on all industrial property) <http://www.tb.lt/PIC/PIC.htm>

Industrial Property protection journal (archives 4 x year)
http://www.tb.lt/PIC/PNA/pram_nuos_apsauga.htm

What to do if I am copied (designs, trade mark, patents)

If your rights are infringed, depending on the manner and extent to which they are infringed and how far you are willing to go, you can:

a) bring a civil case to court, which allows you to stop illegal actions and claim damages, including attorney fees.

b) make a claim to police and initiate administrative procedures (a resolution might result in a fine of 1,000-3,000 Lt, about 290-870 EUR and confiscation of manufacturing equipment) or even a criminal case that might lead to a fine or even imprisonment of up to 2 years. This is a much more effective way to stop illegal actions and takes less time, but it limits the possibility for negotiation available in a civil case.

c) make a report to a customs office if suspicious or counterfeited goods are entering the country's territory.

For enforcement activities, you should contact the police, the prosecutor's office or customs authorities, respectively. An important role is played by the **forensic center, which** examines the counterfeited goods.

Disputes involving patents, designs and trade marks are subject to consideration at 2 levels. First, the LSPB Appeal Board considers oppositions and appeals arising before the patent is granted or a certificate for a trade mark or design is issued. The bureau does not consider such disputes if they arise after a certificate is granted. In such an event, a case must be made before a court.

In addition to the provisions above, trade mark law provides an opportunity to file a case on the grounds of bad faith. When relevant, you should consider competition law and sue on the grounds of unfair competition. Infringement actions are subject exclusively to the court's consideration (for all IP cases - Vilnius District Court is the first instance).

You can contact the appropriate IP association (SNB-REACT, LATGA) for advice or assistance. It is useful to consult an IP attorney with experience in disputes and infringement cases, which allows you to estimate the chance of success and to develop the most efficient and cost-saving strategy.

Relevant contacts

List of patent attorneys in the Republic of Lithuania
<http://www.vpb.lt/index.php?l=en&n=322>

The SNB-REACT association (acts against counterfeit goods for the sports, footwear, fashion and other industries, assists customs offices in the Baltic states).
<http://www.snbreact.nl/snb-react/EN/UnitsBalticEN.htm>
 ph :+370-52122866

Police office (IPR infringement department in the Criminal Police bureau at the Ministry of Interior)
 Saltoniškių g. 19, LT-08105 Vilnius
<http://www.policija.lt/index.php?id=3010>
 ph:+370-52719776

Lithuanian Prosecutor's office
 Rinktinės g. 5A, LT-01515, Vilnius.
 ph:+370 5266 2305, fax:+3705266 2317,
 e-mail: info@prokuraturos.lt; www.prokuraturos.lt

Forensic Science Center of Lithuania (FSCL) ph: +370-52638540, e-mail: info@ltec.lt; <http://www.ltec.lt/>

Vilnius District Court
 Address: Gedimino av. 40/1, LT-01501 Vilnius.
 ph:+370-52617325, fax: +370-52625645,
 e-mail: vapygarda@vat.lt

Copyrights and related rights

Applicable laws

Republic of Lithuania Law on Copyright and Related Rights (LR Autorių teisių ir gretutinių teisių įstatymas) No. VIII-1185, last updated on 13/05/2008. Original text: http://www3.lrs.lt/pls/inter3/dokpaieska.showdoc_l?p_id=316557

English version:
http://www3.lrs.lt/pls/inter3/dokpaieska.showdoc_l?p_id=318375

What can and cannot be protected?

Though industrial property rights give you stronger protection, for images and design works you may also benefit from copyright protection. Using a copyright, you can protect your creation if it is: 1) an original literary, scientific or artistic work, that is 2) the

result of creative activities of an author, and 3) expressed in any objective form.

The protection of the creation has nothing to do with disclosure, publication or exploitation.

Copyright does not apply to ideas, procedures, processes, systems, methods of operation, concepts, principles, discoveries or mere data (see more in Art. 3 and 4).

Formalities

To obtain your copyright, unlike industrial protection where you need to apply for registration, there are no formalities to affirm your ownership rights. You obtain them automatically when your work is released. But sometimes you can get into trouble when you need to prove your ownership. Therefore, to demonstrate the existence, content and date of the creation, it is advisable to take preventative measures: 1) the author should: a) procure an envelope *soleau*, b) send a letter with acknowledgement of receipt addressed to yourself, c) publish an advertisement of the work in the press, or 2) use the creation deposit service of the relevant organisation.

Costs (at the date of publication)

There are no costs associated with obtaining a copyright, though there are costs associated with monitoring and enforcing your rights.

For computer program and database rights, you can deposit your creation at "Infobalt" (see www.infobalt.lt/agentura; costs varies from 600 - 1,070 LT).

Duration of protection

An author's economic rights run for the life of the author and for 70 years after his death, irrespective of the date when the work is lawfully made available to the public. The protection of the author's moral rights has no time limit.

Ownership of the right

The author of a work is the natural person or group of persons who have created that work (moral right). An author's economic rights to a work created by an employee executing his duties for 5 years are auto-

matically transferred to the employer, though it is unlimited for software, unless otherwise provided for by an agreement. Employers should be careful when hiring a person from outside - if in the contract you miss the copyright ownership provision, the author acquires the economic rights by default. Only the right owner can authorise a person/company and grant a license (for ordinary or exclusive economic rights) for usage, modification, etc. of the work. Make sure to notify the public of your ownership, indicating owner's name and date of work release, e.g. © Owner's name, 2003. This is helpful, not only to inform others of your rights but also to prevent unauthorised usage.

What to do if I am copied (copyrights and related rights)

If your rights are infringed, depending on the manner and extent of the infringement you can:

a) contact the infringer and try to settle the situation by requesting the cessation of illegal actions. You might also ask for financial compensation.

b) bring a civil case before a court:

- claiming recognition of your rights;
- prohibiting the continuation of unlawful acts;
- preventing acts where the rights may be infringed or damage may be caused;
- claiming redress of the infringed moral rights;
- demanding unpaid remuneration for unlawful use of a work;
- demanding compensation for property damages, including lost income and other expenses, non-pecuniary damage.

If sufficient grounds exist to suspect that an infringement of copyright has been committed, you can request that a court apply provisional and preserving evidence measures. These are necessary to prevent any imminent infringement or to forbid the continuation of the infringement.

c) make a claim to police and initiate an administrative or criminal case, which might lead to the levying of a fine or imprisonment for 2 years, or if it was an act under constraint to steal the copyright, 3 years imprisonment.

d) make a report to a customs office that counterfeited goods are entering country territory (see more in Customs chapter).

For enforcement activities, you should contact a particular association or police office directly (see above).

Relevant contacts:

LANVA association (copyright antipiracy activities in Lithuania: music, audiovisual works, software), e-mail: info@anva.lt;

LATGA association (in charge of Authors rights, Art and Design division, e-mail: latga@latga.lt; <http://www.latga.lt>)

Copyright division at the Ministry of Culture
ph :+370-5219 34 63; info@lrkm.lt;

Actions at customs

The Lithuanian law for customs control over the export and import of goods allows customs control measures to be applied at the Lithuanian border. If customs authorities suspect that goods are counterfeited, they may keep them:

- by acting on their own (ex-officio);
- by acting on the request of a right holder.

When goods are withheld by customs, authorities immediately inform the right owner or its representative so they can come check them. This person is allowed to inspect the goods and take the samples.

If the assumption that goods are produced illegally is confirmed, the right owner must bring a complaint before a court within 10 days. A copy marked by the court should be presented to the customs authorities. They hold the goods until the court makes a final decision. Otherwise, the goods are put on the market for circulation. In certain cases, goods can be destroyed even without a court order.

If you want to prevent counterfeited goods from entering the market, you, as the right owner, should request that customs apply control measures. Then your industrial property will be included in the list under observation by customs. For this purpose, you

must present them with the following documents (no fee or guarantee is requested):

- application form (2 copies);
- copy of registration of IP rights (if registered);
- documents on applicant empowerment, demonstrating right owners authorisation to represent him;
- declaration by applicant to cover the costs associated with the storage and destruction of goods.

It is very important that customs authorities have detailed information on distinctive features of the original goods so officials can recognise when goods are counterfeited.

Forms to apply for customs control measures:
<http://www.cust.lt/lt/rubric?rubricID=563>

Lithuanian Customs Office
ph:+370-800 55544, +370-52666124.
E-mail: info@cust.lt; <http://www.cust.lt/>

Please secure of your industrial property (trade marks, etc.) on the list under observation by customs
<http://www.cust.lt/lt/rubric?rubricID=562>

Alternative ways to deal with infringements

The Lithuanian court system's history of solving IP disputes spans only a few decades. Therefore, it lacks particular experience. If you have a complicated dispute in which an expert opinion is important, you may consider bringing copyright litigation before the Lithuanian Copyright Board, which is an intermediary body in charge of mediating disputes.

Contact information for the National Patent Office

State Patent Bureau of the Republic of Lithuania
Kalvarijų str. 3, LT-09310 Vilnius, Lithuania
<http://www.vpb.lt/>
ph: +370 5 278 02 90; fax: +370 5 275 0723
e-mail: info@vpb.gov.lt

Poland

Design Rights

Applicable Laws:

Act of 30th June 2000 - the Industrial Property Law (Journal of Laws of 2003, no. 119, text 1117, as subsequently amended) and respective Regulations of the Prime Minister.

Full list and texts of legal acts in English are available on the Web site of the Polish Patent Office (PPO): <http://www.uprp.pl/English/Law/>

What can and cannot be protected?

It is possible to register an industrial design that meets both of the following conditions:

- it must be new.
- it must have individual character.

Special attention should be paid to disclosure to the public before registration. This is accepted only under certain conditions.

For more information on the subject see Article 103 of the Industrial Property Law. The consolidated text of the act is available in English at: http://www.uprp.pl/rozne/ip_law_amend/ip_law_amend.doc

The following cannot be registered as an industrial design in Poland:

- Computer programs;
- Products with a design that goes against public order or morality;
- Products with a design that includes the signs specified in Article 131 (2) of the Industrial Property Law;
- Products that constitute part of a complex product used for repair of that product in order to restore its original appearance;
- Products that are solely dictated by their technical function;

- Products that must be reproduced in their exact form and dimension to permit the product to be mechanically connected to, or to interact with, another product.

Formalities

An application may be filed personally or by an authorised person. It can be made online.

For online application forms (available exclusively in Polish), go to:

[http://www.uprp.pl/English/Procedure + before + the + PPO/Forms/](http://www.uprp.pl/English/Procedure+before+the+PPO/Forms/)

To apply for an industrial design registration, you need to:

- file the application for registration;
- make the due payment.

An industrial design application should contain:

- Applicant's details;
- Definition of the subject-matter of the application;
- Petition for the granting of a right of registration;
- Relevant illustrations, in particular drawings or photographs;
- Descriptions explaining the illustrations;
- Payment of a fee for the first protection period.

Note: an industrial design application may also contain samples of a textile fabric.

If you are not established in Poland, you may only act when represented by a patent agent. In the case of legal representation by a patent agent, you have to enclose a power of attorney in writing.

Costs (at the date of publication)

Basic fee is 300 PLN for one industrial design application.

Renewal fees:	
1 st design protection period (1 st , 2 nd , 3 rd , 4 th and 5 th year of protection)	400 PLN
2 nd design protection period (6 th , 7 th , 8 th , 9 th and 10 th year of protection)	1,000 PLN
3 rd design protection period (11 th , 12 th , 13 th , 14 th and 15 th year of protection)	2,000 PLN
4 th design protection period (16 th , 17 th , 18 th , 19 th and 20 th year of protection)	3,000 PLN
5 th design protection period (21 st , 22 nd , 23 rd , 24 th and 25 th year of protection)	4,000 PLN

For specific fee tables (in English), go to: <http://www.uprp.pl/English/Law/>

Examination

Industrial design registration is granted after having established that the application has been duly completed (no substantive examination).

Granted rights are recorded in the Industrial Designs Register.

Decisions of the PPO are subject to request for re-examination of the matter within the meaning of the Code of Administrative Procedure.

Anyone may submit opposition to a final decision of the PPO granting a right of registration within 6 months from the publication in *“Wiadomości Urzędu Patentowego”* (PPO's second-level Official Gazette) of the mention of the grant.

A right of industrial design registration is subject to invalidation by anyone who has a legitimate interest, provided they are able to prove that the statutory requirements for the granting of the right have not been satisfied.

Decisions and orders issued by the PPO are subject to complaint to the administrative courts.

Duration of protection

Protection lasts a maximum of 25 years. Registration is valid for 5 years, starting from the date of application and can be renewed for further periods of 5 years, up to a maximum of 25 years.

Renewal should be made before the end of the protection period. If a renewal application is submitted late but no later than 6 months after this period, an extra fee is payable.

Ownership of the right

The registration of an industrial design gives its holder the following rights:

- exclusive right to exploit the design for profit or for professional purposes throughout the territory of Poland;
- the right to prevent any third party from making, offering, putting on the market, importing, exporting or using a product with this design, or stocking such a product for those purposes;
- the option to transfer the registration or to grant licences to third parties to exploit the industrial design;
- the option to label the industrial design as protected to dissuade third parties from potential violations (by the words “industrial design no.” or any similar indication).

Trade mark rights

Applicable Laws:

Industrial Property Law and respective Regulations of the Prime Minister.

For a full list and the texts of legal acts in English, go to the PPO's Web site:

<http://www.uprp.pl/English/Law/>

What can and cannot be protected?

The types of trade marks that can be registered are: verbal, pictorial, mixed, sound, three-dimensional, slogans and collective.

The signs that cannot be protected as trade marks are those that:

- cannot constitute a trade mark;
- have no sufficient distinctive character;
- have the potential to mislead the consumer;
- infringe third parties' personal or economic rights;
- are against the law, public order or morality;
- have had protection applied for with the PPO in bad faith;
- include the names, symbols, coats of arms of the Republic of Poland, Polish towns, communities,

emblems of the armed forces, government, organisations, Polish decorations, distinctions, medals, names and symbols of other countries, international organisations, symbols of a religious, patriotic or cultural nature, officially recognised signs accepted for the use in trade.

For more information, see Articles 129-132 of the Industrial Property Law (in English) at: http://www.uprp.pl/rozne/ip_law_amend/ip_law_amend.doc

Formalities

To obtain protection for your trade mark:

- file an application for registration;
- make the due payment.

An application for registration can be filed personally or by an authorised person.

It needs to include:

1) Registration form stating applicant's personal details/authorised person's details, request for granting the right of protection, trade mark details, product classes, and the signature.

A registration form (exclusively in Polish) is available for download at:

[http://www.uprp.pl/English/Procedure + before + the + PPO/Forms/](http://www.uprp.pl/English/Procedure+before+the+PPO/Forms/)

- 2) Priority document – if applicant claims priority;
- 3) 5 photographs or reprints of the trade mark;
- 4) 2 more black-and-white pictures;
- 5) 2 tapes or digital carriers with the "sound trade mark" recorded.

If you are not established in Poland, you may only act when represented by a patent agent. If you use legal representation by a patent agent, you have to enclose a power of attorney in writing.

Costs (at the date of publication)

Single fee	
Paper filing	550 PLN*
Electronic filing	500 PLN*
each class in excess of 3	120 PLN
Renewal fees (for a 10 year protection period)	
up to 3 classes, for each class	400 PLN*
each subsequent class	450 PLN*

*In the case of collective trade mark, collective guarantee trade mark or trade mark filed for collective right of protection – the amount of the fee is subject to increase by 100%.

More information on fees is available in English at: <http://www.uprp.pl/English/Law/>

Examination

The trade mark application undergoes a full substantive examination and the protection is granted after it has been established that the requirements for the grant have been satisfied.

Within 3 months after the trade mark application is filed, the PPO shall publish it. Starting from the date of publication, anyone may see your trade mark and the list of goods for which it is intended and may submit to the PPO their observations as to the existence of grounds that may cause a right of protection to be denied.

Granted rights of protection for trade marks are recorded in the Trade Mark Register.

Decisions of the PPO are subject to request for re-examination within the meaning of the Code of Administrative Procedure.

Anyone may submit opposition to a final decision of the PPO granting a right of protection within 6 months from the publication of the granting in "Wiadomości Urzędu Patentowego".

A right of protection for a trade mark is subject to invalidation by anyone who has a legitimate interest provided s/he is able to prove that the requirements for the granting of the right have not been satisfied.

Decisions and orders issued by the PPO are subject to complaint to the administrative courts.

A regular trade mark is granted protection, on average, 16 months after the application is filed.

Duration of protection

The right of protection is granted for 10 years and can be renewed for further periods of 10 years for all or part of the goods.

Renewal should be made before the end of the protection period. If a renewal application is submitted

late but no later than 6 months after this period, an extra fee is payable.

Ownership of the right

The registration of a trade mark gives the following rights to its holder:

- The exclusive right to use the trade mark for profit or for professional purposes throughout the territory of the Republic of Poland;
- The option to use the symbol ® next to the trade mark to indicate that the trade mark has been registered;
- The option to transfer ownership of the trade mark or to grant licences to third parties to exploit the trade mark.

Patent rights, including utility models

Applicable Laws:

Industrial Property Law

Respective Regulations of the Prime Minister (full list and texts of acts in English can be found at: <http://www.uprp.pl/English/Law/>)

What can and cannot be protected?

Patent protection may be granted for any invention that is:

- new;
- involves an inventive step;
- has industrial applicability.

You cannot protect the following using a patent:

- discoveries, scientific theories and mathematical methods;
- aesthetic creations;
- schemes, rules and methods for performing mental acts, doing business or playing games;
- programs for computers;
- presentations of information;
- inventions whose exploitation would be contrary to public order or morality;
- plant or animal varieties or essentially biological processes for the production of plants or animals;
- methods for treatment of the human or animal body by surgery or therapy or diagnostic methods applied on human or animal bodies.

Formalities

An application for a **patent/utility model** may be filed personally or by an authorised person and must contain:

1. An application form stating:
 - Applicant's personal details
 - Subject-matter of the application
 - Request for granting a patent for an invention.

An application form (exclusively in Polish) is available for download at:

<http://www.uprp.pl/English/Procedure+before+the+PPO/Forms/>

2. Description of the invention (3 copies)
3. Patent claims
4. Drawings (3 copies)
5. Abstract of patent description (2 copies).

The application is considered to have been filed on the date on which it is received by the PPO, also via fax or on-line.

Since 1/10/2008, it has been possible to file **applications on-line through:**

<http://www.uprp.pl/Polski/uslugionline/>

If you are not established in Poland, you may only act when represented by a patent agent. If you use legal representation by a patent agent, you have to enclose a power of attorney in writing.

For a list of patent agents, go to: www.rzecznikpatentowy.org.pl

Costs (at the date of publication)

Single fee	
patent/utility model application	550 PLN*
electronic filing of patent/utility model application	500 PLN*

*If one application covers more than two inventions, the fee is increased by 50%.

Renewal fees	
1 st , 2 nd , 3 rd year of protection	480 PLN
4 th year of protection	250 PLN
5 th year of protection	300 PLN
6 th year of protection	350 PLN
7 th year of protection	400 PLN
8 th year of protection	450 PLN
9 th year of protection	550 PLN

Renewal fees	
10 th year of protection	650 PLN
11 th year of protection	750 PLN
12 th year of protection	800 PLN
13 th year of protection	900 PLN
14 th year of protection	950 PLN
15 th year of protection	1,050 PLN
16 th year of protection	1,150 PLN
17 th year of protection	1,250 PLN
18 th year of protection	1,350 PLN
19 th year of protection	1,450 PLN
20 th year of protection	1,550 PLN

Further details on fees can be found in English at:
<http://www.uprp.pl/English/Law/>

Renewal should be made before the end of the patent protection period. If a renewal application is submitted late but no later than 6 months after this period, an extra fee is payable.

Examination

The patent/utility model granting procedure consists of formal and substantial examinations of the application.

First stage - **formal examination** of the application means the application should be revised for compliance with formal requirements: completeness of application (proper forms, required pictures, etc.) and the due fees paid. Formal examination lasts 18 months - then the application is published in the *"Biuletyn Urzędu Patentowego"* (PPO's first-level Official Gazette). The applicant may ask for earlier publication.

Until a patent has been granted, third parties may submit any observations to the PPO regarding the existence of factors that may cause a patent to be denied.

After application is published, a report on the state of the art is open to third parties.

The next step after publication is substantive examination. The procedure concludes with the taking of a decision on the grant, or refusal to grant a patent. Decisions are published in *"Wiadomości Urzędu Patentowego"*.

Granted patents are recorded in the Patent Register.

Decisions of the PPO are subject to a party's request for re-examination within the meaning of the Code of Administrative Procedure.

Anyone may submit opposition to a final decision of the PPO granting a patent within 6 months from the publication of the grant in *"Wiadomości Urzędu Patentowego"*.

A patent may be subject to invalidation by anyone who has a legitimate interest provided s/he is able to prove that the requirements for the grant have not been satisfied.

Decisions and orders issued by the PPO are subject to complaint to the administrative courts.

Duration of protection

The duration of a patent is 20 years, starting from the date of filing.

The duration of utility model is 10 years, starting from the date of filing.

Ownership of the right

It is the inventor who is entitled to exploit a granted patent, however the patent may also be jointly granted to a number of persons.

The scope of protection granted by a patent is determined by patent claims interpreted along with drawings and patent specification.

A patent gives the following rights to its holder:

- to gain profits from the invention;
- to use the invention for business purposes;
- to prevent any unauthorised use of the invention (e.g. selling, putting invention on market, etc.);
- to license another party to use the invention.

What should I do if I am copied? (designs, trade marks, patents)

Protection of industrial property rights can be done through the courts either by criminal or civil proceedings. However, more extensive results can be achieved in civil proceedings.

The competent court in these proceedings is the District Court.

The holder of the right that has been infringed may require:

- the cessation of the infringement;
- the surrender of unlawfully obtained profits;
- the elimination of the consequences of the infringement;
- compensation for damages in accordance with the general principles of law or by a lump sum equal to the licence fee.

The right holder is also entitled to request the publication of a statement in the press concerning the infringement.

The person entitled to enforce their claims in the case of infringement is:

- the right holder, or
- a licensee (holder of an exclusive licence, recorded in the Patent Register).

The entitled persons can enforce their claims for infringement for the period starting the day after the date of publication of the application in *"Biuletyn Urzędu Patentowego"*.

The claim is barred 3 years after the date when the right holder learned about the infringement, but no later than 5 years after the infringement occurred.

As for the criminal proceedings, the results can be achieved quicker though it is necessary for a single infringement to comply with each and every element established in the criminal law.

Examples of the criminal actions are as follows:

- Arrogating the authorship to oneself;
- Misleading another person as to the authorship;
- Marking goods with a counterfeit trade mark to place them on the market;
- Filing another person's invention, utility model, industrial design, etc, by anyone who is not entitled to be granted the IP right for the granting of a patent, a right of protection or a right to registration.

To report offences concerning the misappropriation of IP rights, you should call the national police or inform customs.

Relevant Contacts:

Polish National Police
Criminal Bureau of the General Police Headquarters
Business Fraud Combating Division
ul. Puławska 148/150,

02-514 Warszawa
Poland
Tel: +48 22 601 23 24
Fax: +48 22 601 34 67
<http://www.policja.pl/>

Ministry of Finance
Customs Policy Department
IPR Division
ul. Świętokrzyska 12
00-916 Warszawa
Poland
Tel.: +48 22 694 31 33
Fax: +48 22 694 31 34
Customs Information Service;
E-mail: informacja.celna@mofnet.gov.pl

Copyrights and related rights

Applicable Laws:

Act of 4/2/1994 on copyright and related rights
Full text in English can be found at:
http://www.mk.gov.pl/cps/rde/xbcr/mkid/act_on_copyright.pdf

Note: All issues with respect to copyrights and related rights are dealt with by the Polish Ministry of Culture and National Heritage. Its Web site is accessible through:
<http://www.mkidn.gov.pl>

What can and cannot be protected?

Copyright protection is provided to the author regardless of whether the formalities have been complied with or not. It is guaranteed by law if the author's work:

- shows creative activity;
- has individual character;
- is established in any form.

Copyright grants protection for such works as:

- Literary, journalistic, scientific and cartographic works and computer programs;
- Artistic works;
- Photographic works;
- String musical instruments;
- Musical works as well as musical and lyrical works;
- Theatrical works, theatrical and musical works, as well as choreographic and pantomime works;
- Audiovisual (including film) works.

You cannot be granted protection for:

- Discoveries;
- Ideas;
- Procedures;
- Methods and principles of operation or mathematical concepts;
- Legislative acts and their official drafts;
- Published patent specifications and industrial design specifications.

Duration of protection

Copyright consists of 2 different types of rights:

1. Author's moral rights
2. Author's economic rights

Moral rights do not expire after the author's death.

Economic rights expire 70 years after the author's death.

Ownership of the right

The copyright holder is generally the author. S/he is authorised to exploit moral and economic rights, especially the right:

- to sign the work with his/her name or pseudonym, or to make it available to the public anonymously;
- to decide to make the work available to the public for the first time;
- to control the manner in which the work is used;
- to use the work exclusively;
- to receive remuneration for the use of the work.

What should I do if I am copied? (copyrights and related rights)

If a copyright holder's rights are infringed, s/he can take civil or penal measures.

a. Civil measures:

The right holder may request that the person who has infringed his/her author's economic rights:

- cease the infringement;
- eliminate the consequences of the infringement;
- compensate damages.

and also (irrespective of the above-mentioned claims),

- make a single or multiple press announcements
- pay an appropriate sum of at least double the probable value of the benefits received by the of-

fender of the infringement in favour of the Fund for Promotion of Creative Activity.

b. Penal measures

There is a specific list of acts that are penalised and:

- Prosecuted at the request of the copyright holder (e.g. usurping the authorship or misleading others as to the authorship of all or a part of another person's work or another person's artistic performance);
- Prosecuted by virtue of office – (e.g. plagiarism, illegal dissemination of works).

Actions at customs

1. Applicable Laws:

Council Regulation (EC) No. 1383/2003
Commission Regulation (EC) No. 1891/2004

2. Application for customs action:

The right holder may submit an application for customs action. There are 2 basic requirements concerning the application:

1. It has to contain a sufficiently accurate description to make selection and identification possible.
2. The right holder has to prove that s/he owns intellectual property right, or that s/he is the authorised user of the right.

Intellectual property rights in question are:

- trade mark, Community trade mark;
- design, Community design;
- copyright or related right;
- patent;
- Supplementary Protection Certificates;
- plant variety right;
- designation of origin of geographical indications.

Since 2008, customs has worked with the help of the "VINCI", a special electronic IP rights protection system. Its main function is to collect and process information delivered by producers concerning original and counterfeit goods to detect pirated products more efficiently. Business circles and all IP rights owners in Poland are advised to cooperate with customs in this matter.

3. Procedure:

The agency responsible for investigating these applications in Poland:

Customs Chamber in Warsaw
ul. Modlińska 4
03-216 Warszawa
Poland
Tel.: +48 22 614 42 51
E-mail: IC440000@war.mofnet.gov.pl

- Application is free of charge;
- Applicant is notified of the customs decision within 30 working days of the receipt of the application;
- If an application for action is granted, the competent customs department specifies the period during which the customs authorities are to take action (generally one year). This period may be extended upon request, at the latest 30 working days before the expiration of the initial application for action;
- An application should be submitted on specific forms (model forms are annexed to Council Regulation 1383/2003).

Note: application for action may be taken both as a preventive measure and as a reaction to infringements.

4. Useful information can be found at:

Polish Customs:
<http://www.clo.gov.pl/>

Contact of the National Patent Office and other relevant organisations:

Patent Office of the Republic of Poland
Al. Niepodległości 188/192
00-950 Warszawa
Poland
Tel.: +48 22 5790 000
E-mail: informacja@uprp.pl
www.uprp.pl

Copyrights and related rights
Ministry of Culture and National Heritage
ul. Krakowskie Przedmieście 15/17
00-071 Warszawa
Poland
Tel.: +48 22 42 10 555
Fax: +48 22 82 69 148
E-mail: rzecznik@mkidn.gov.pl
<http://www.mkidn.gov.pl>

Protected Designation of Origin (PDO), Protected Geographical Indication (PGI) and Traditional Speciality Guaranteed (TSG)
Ministry of Agriculture and Rural Development
ul. Wspólna 30
00-930 Warszawa
Poland
Tel.: +48 22 623 22 08, +48 22 623 27 96
Fax: +48 22 623 23 00
E-mail: oznaczenia@minrol.gov.pl
www.minrol.gov.pl

Plant varieties rights
Research Centre for Cultivar Testing
63-022 Słupia Wielka
Poland
Tel.: +48 61 285 23 41
Fax: +48 61 285 35 58
E-mail: sekretariat@coboru.pl
www.coboru.pl

Portugal

Design rights

Applicable laws

Industrial Property Code (IPC) – Decree-Law- no. 36/2003.

Amendments to the IPC – Decree-Law no. 143/2008.

What can and cannot be protected?

It is possible to register an industrial design that meets both of the following conditions:

- it must be new
- it must have distinctive character

The applicant should pay particular attention to disclosure to the public before registration. This is only acceptable under some conditions.

The following cannot be registered as an industrial design:

- computer programs;
- products dictated solely by their technical function;
- communications products;
- products with a design that goes against public order, morality and proper behaviour.

For more information in Portuguese and English go to:
www.inpi.pt [Design – How to protect your design].

Formalities

An application for registration can be made online, using the tools available on the INPI-PT Web site: www.inpi.pt [Online Services – Design - Filing].

To apply for an industrial design registration, an applicant must provide the following:

- a description of the industrial design with a maximum of 50 words per product (optional);
- graphical representations or photographs of the industrial design;
- picture(s) for publication;
- payment of the application fees.

An application may include up to 100 products, provided that they belong to the same class in the International Classification of Industrial Designs and Models (multiple applications).

If the applicant is not established in Portugal, it can directly access INPI's services by indicating an address in Portugal or providing an e-mail address or a fax number to receive notifications.

If the applicant is represented by an authorised representative, the relevant power-of-attorney must be provided. This document is not necessary when the representative is an industrial property agent.

Costs (at the date of publication)

Filing Fee *	Online	Paper
Up to 5 products	90 EUR	180 EUR
Per additional product	10 EUR	20 EUR

* includes publication and, in case of opposition, the examination.

Maintenance Costs – per product	Online	Paper
1 st Five Years	0	0
2 nd Five Years	30 EUR	60 EUR
3 rd Five Years	40 EUR	80 EUR
4 th Five Years	50 EUR	100 EUR
5 th Five Years	60 EUR	120 EUR

For updated figures, please go to: www.inpi.pt [Industrial Property – Table of Fees].

It is possible to obtain support for the protection of industrial property rights integrated into a major project. For more information, go to:

- www.inpi.pt [Propriedade Industrial – Apoios à PI]
- www.incentivos.qren.pt

Examination

Industrial design registration is not granted automatically. Once an application is filed, it is subject to a formal examination and then published online in the Industrial Property Bulletin. Then there is a 2-month period during which those who consider themselves harmed by the potential granting of the registration may file oppositions.

An examination evaluating the novelty and originality requirements is performed only if a third party files an opposition.

INPI decisions may be appealed through the Lisbon Commercial Court for a period of 2 months following the publication of the decision in the Industrial Property Bulletin.

Duration of protection

The registration is valid for 5 years from the date the application is filed and can be renewed for additional periods of 5 years each, up to a maximum of 25 years.

For information on how to maintain a design right go to: www.inpi.pt [Design - Maintenance].

Payment of maintenance fees (every 5 years) can be performed directly online using the tools available on the INPI-PT portal.

<https://servicosonline.inpi.pt/registos/main/start.jsp?timo=D&lang=EN>

Ownership of the right

The registration of an industrial design confers upon its holder the following rights:

- The option to prevent third parties from producing, manufacturing, selling or economically exploiting the protected industrial design without the holder's consent.
- The option to label an industrial design as protected to dissuade potential violations (by using the words "industrial design no." or the initials "DM no.").

- The option to transfer the registration or to grant licences to third parties to exploit the industrial design, for free or for a fee.
- Any registered industrial design also benefits from the protection afforded it by copyright, from the date on which it was created, or defined, in any form.

For more information on this subject go to: www.inpi.pt [Design – Maintenance].

Trade mark rights

Applicable laws

Industrial Property Code (IPC) – Decree-Law- no. 36/2003.

Amendments to the IPC – Decree-Law no. 143/2008.

What can and cannot be protected?

The following types of trade marks can be registered: verbal, pictorial, mixed, sound, three-dimensional, slogans and collective.

It is not possible to register trade marks that:

- have no distinctive character;
- have the potential to mislead the consumer;
- are against the law and public order, or that offend morality and proper behaviour;
- contain symbols of a state, emblems of government or foreign organisations, coats of arms, medals, names or portraits of people, or signs possessing a high degree of symbolic value (such as religious symbols), amongst others (except with the permission of the relevant parties);
- constitute a violation of another person's rights or that might favour acts of unfair competition.

For more information on this subject, go to: www.inpi.pt [Trademarks – What is a trademark?].

Formalities

An application for registration can be made online, using the INPI-PT Web site:

www.inpi.pt [Online Services – Trademarks – Filing].

If the sign to be protected is not only verbal, the applicant must submit a picture of the trade mark when filing the application.

The applicant may also need to present documents proving claims made in the application, such as claims of a right to priority, or declarations of consent or authorisation regarding the use of elements included in the trade mark.

If the applicant is not established in Portugal, he can directly access INPI's services by indicating an address in Portugal, an e-mail address or a fax number to receive notifications.

If the applicant is represented by an authorised representative, the relevant power-of-attorney must be provided. This document is not necessary if the representative is an industrial property agent.

Costs (at the date of publication)

Filing Fee *	Online	Paper
1 st class	90 EUR	180 EUR
Per additional class	30 EUR	60 EUR

* includes examination and publication.

Maintenance Costs	Online	Paper
One class	45 EUR	90 EUR
Per additional class	30 EUR	60 EUR

For updated figures please go to: www.inpi.pt [Industrial Property – Table of Fees].

It is possible to obtain support for the protection of industrial property rights integrated in a major project. More information is available at:

- www.inpi.pt [Propriedade Industrial – Apoios à PI]
- www.incentivos.qren.pt

Examination

Trade mark registration is not granted automatically. The application process begins once the application is submitted and includes an examination in accordance with the rules governing the composition of trade marks.

Once an application is filed, it is subject to a formal examination and then published online in the Industrial Property Bulletin. Then there is a phase during which those who consider themselves harmed by the potential granting of the registration may file oppositions.

When the opposition phase comes to an end (applicants may reply to oppositions), the application is subject to a substantial examination, following which the decision is issued.

At the end of this process – and if no grounds for refusal are found – the trade mark is considered protected!

A regular trade mark is granted on average 3 months after the application is filed.

INPI decisions may be subject to appeal through the Lisbon Commercial Court for a period of 2 months after the publication of the decision in the Industrial Property Bulletin.

Duration of protection

Registration is valid for 10 years from the date it is granted. This period is renewable indefinitely for additional periods of 10 years.

During its validity period, the essential elements of a trade mark cannot be altered.

For information on how to maintain a trade mark go to: www.inpi.pt [Trade marks - Maintenance].

Payment of registration and renewal fees can be made online at the INPI-PT Web site:

<https://servicosonline.inpi.pt/registos/main/start.jsp?timo=M&lang=EN>

Ownership of the right

The registration of a trade mark confers upon its holder the following rights:

- The option to prevent third parties from using any sign, equal or similar, in products or services for which the trade mark has been protected, without the holder's consent.
- The option to mark its products with the words "Marca Registada" or the initials "M.R." to dissuade potential violations.
- The option to transfer the registration or to grant licences to third parties to exploit the trade mark, for free or for a fee.

Patent rights, including utility models

Applicable Laws

Industrial Property Code (IPC) – Decree-Law no. 36/2003.

Amendments to the IPC – Decree-Law no. 143/2008.

What can and cannot be protected?

Protection can be awarded for inventions that are new, involve an inventive step and have industrial applicability.

The applicant should pay particular attention to disclosure to the public before application. This is only acceptable under certain conditions.

The following cannot be protected by patent:

- Discoveries, scientific theories or mathematical methods;
- materials or substances that already exist in nature or nuclear materials;
- aesthetic creations;
- projects, principles or methods of carrying out intellectual activities in the area of games, or in the field of economic activities, as well as computer programs, as such, without any contribution;
- presentations of information;
- methods of surgical or therapeutic treatment, as well as methods of diagnosis, for both humans and animals. However, products, substances or compounds used in these methods can be protected.

Inventions can be protected by 2 types of industrial property rights: patents and utility models.

Patent or utility model - how to choose?

The choice lies with the applicant, who should consider the advantages and disadvantages of each type of protection before making a decision. Protecting an invention by means of a utility model involves an administrative procedure that is faster and simpler than the process of applying for a patent. This type of protection cannot be granted to inventions dealing with biological material or chemical and pharmaceutical substances or processes. With respect to utility models, 2 types of applications can be filed – with or without an examination. On the

other hand, applications for patents must always be examined since this is a fundamental part of the patent granting process.

The major advantage of utility models is that applicants are only required to pay the filing fee. They can postpone, or may even never pay, the examination fee (which is normally higher because it is a more costly and demanding intellectual task). This fee is paid only when/if it is deemed necessary (for example, if the owner would like to initiate legal proceedings).

The relationship between a utility model and a patent has a certain amount of flexibility. In effect, at the request of the applicant, an invention submitted for protection by utility model can also be protected by patent (or vice-versa), simultaneously or consecutively, within a year from the date of the first filing.

For more information, go to:

www.inpi.pt [Patents – What is a patent?].

Formalities

An application for a patent or a utility model can be made online using the tools available on the INPI-PT Web site:

www.inpi.pt [Online Services – Patents – Filing].

To submit an application for a patent or a utility model, the applicant must present the following to INPI, in Portuguese:

- a description of the invention's claim to novelty and distinguishing features;
- a description of the invention;
- any drawings that may be required for a complete understanding of the description (where applicable);
- a summary of the invention;
- an image for publication (if drawings are required to understand the summary);
- payment of the application fees.

Applicants not established in Portugal can directly access INPI's services by indicating an address in Portugal or giving an e-mail address or a fax number to receive notifications.

If the applicant is represented by an authorised representative, the relevant power-of-attorney must be provided. This document is not necessary if the representative is an industrial property agent.

Costs (at the date of publication)

Filing Fee	Online	Paper
Patent Filing Fee *	90 EUR	180 EUR
Utility Model Filing Fee **	50 EUR	100 EUR
Utility Model Exam Fee	75 EUR	150 EUR

* includes exam and publication.

** includes publication.

Maintenance Costs:

Are free until the 4th annuity.

The values for subsequent annuities and updated figures can be consulted at: www.inpi.pt [INPI – Introduction – Table of Fees].

Note that payments made online benefit from substantial discounts.

It is possible to obtain support for the protection of industrial property rights integrated into a major project. More information is available at:

- www.inpi.pt [Propriedade Industrial – Apoios à PI]
- www.incentivos.qren.pt.

Examination

A patent or utility model is not automatically granted. The process begins once the application is filed and includes an examination (unless it is an application for a utility model without examination), in accordance with the law governing the protection of inventions.

Once a patent application is filed, it is subject to a formal examination and then published online in the Industrial Property Bulletin 18 months after the filing or priority date. At the time of application, the applicant can request that the publication be anticipated.

For a utility model, the time for publication is shorter – 6 months instead of 18 months. At the time of filing, or even later (up to 18 months after the filing or priority date), the applicant can request that publication be anticipated, or postponed, if there is a desire to keep the invention secret.

After the filing date, a search is performed to determine the novelty and inventive step of the invention. This report is supplied only to the applicant and can

be an important factor in the decision to extend the protection to other countries.

Following the publication of the application, a 2-month opposition phase begins, during which anyone who considers themselves harmed as a result of the granting can file a complaint.

Once the opposition phase has ended, the application is subject to an examination (except in case of a utility model application in which an examination has not been requested and no complaint is filed). The conclusion of this process is the notification of the granting, refusal, or partial granting.

INPI decisions may be subject to appeal through the Lisbon Commercial Court for a period of 2 months following the publication of the decision in the Industrial Property Bulletin.

Duration of protection

The duration of a patent is 20 years, starting from the filing or priority date.

The duration of a utility model is 6 years, starting from the filing or priority date, but this period can be extended. During the final 6 months of the validity period, the owner can request an extension for a period of 2 years, and during the final 6 months of this supplementary period, a second and final request for extension of the protection period can be made, again for a period of 2 years. The duration of a utility model's protection, including 2 extensions, cannot exceed 10 years, starting from the date the initial application was filed.

Maintenance fees for patents and utility models are payable yearly, and are known as annuities.

For information on how to maintain patents rights go to: www.inpi.pt [Patents - Maintenance].

Payment of annuities can be made online on the IN-PI-PT Web site:

<https://servicosonline.inpi.pt/registos/main/start.jsp?timo=P&lang=EN>

Ownership of the right

The granting of a patent or utility model confers upon its owner the following rights:

- to exclusively exploit the invention in any part of the country;
- the option to prevent third parties from producing, manufacturing, selling or economically exploiting the protected product or process without the owner's consent. It also prevents others from seeking protection for the same product or process and employing or applying the same means or processes disclosed in the patent or utility model that has been granted;
- the option to label products as protected to deter potential violations (by using the words 'patented' or 'patent no.' or the abbreviation 'Pat. no.'; 'Utility model no.'; or 'M.U. no.'; or 'U.M. no.');
- the option to transfer the right or to grant licences to third parties to exploit the invention, for free or for a fee.

For information on the limitations on rights conferred by a patent, go to:
www.inpi.pt [Patents – Maintenance – What rights are conferred?].

Provisional Patent Applications

What is it?

It is a new way to present a patent application that is easier, simpler and more accessible:

- it is sufficient to present a description of the invention, in Portuguese or in English;
- it enables the establishment of the priority of an invention;
- it is valid for 12 months and could, within this timeframe, be converted into a definitive application.

The provisional patent application may not be admissible in some countries as a way to establish the priority of an invention. The applicant should always ask about the requirements in the countries where protection is sought.

What needs does the provisional application respond to?

- Lack of immediate financial capacity to go for a complete application;
- Lack of time to evaluate an invention's potential;
- Lack of time to formalise an integral patent application when faced with the need to proceed with an imminent disclosure of the invention.

How to present the provisional application?

- Present the complete identification of the applicant;
- Submit a document, in Portuguese or in English, that describes the invention (for example, a scientific paper). The document should describe the object of the application in a manner sufficient enough to allow the execution of the invention by a person competent in the matter;
- Pay a reduced fee.

A Provisional Patent Application can be made on the INPI-PT Web site:
www.inpi.pt [Online Services – Patents - Filing].

What are the following steps?

INPI sends the applicant a search report with information about the existing state of the art (if the report is requested).

Before the 12 months period has ended, the applicant should request the conversion of the provisional application into a definitive patent application.

If the provisional patent application is not converted within 12 months, the applicant loses all benefits and the application is considered withdrawn.

How to convert a provisional patent application into a definitive application?

Present, in Portuguese, all documents necessary for a patent application.

The definitive application resulting from the conversion cannot contain subjects not included in the provisional application.

After requiring the conversion, the normal steps of a complete application follow.

For more information, go to:
www.inpi.pt - [Patents – Protection in Portugal – Provisional Patent Application].

Costs (at the date of publication)

Fees	Online	Paper
Filing Fee	10 EUR	20 EUR
Search Fee	20 EUR	40 EUR
Conversion to a definitive patent application	60 EUR	120 EUR

For updated figures please go to: www.inpi.pt [Industrial Property – Table of Fees].

What to do if I am copied (designs, trade marks, patents)

Once the industrial property rights have been protected, the owners have various means at their disposal to react against their infringement:

- If they want the offenders to be punished, they can file a criminal case with the courts by lodging an official complaint with the relevant authorities (the Authority for Economic and Food Safety (ASAE), the Customs Brigade of the National Republican Guard (GNR) or the Public Prosecution Office). **INPI does not receive or forward complaints relating to infringements.**
- If the aim is to be compensated for immaterial or actual damages suffered as a result of the infringing activities, the owner should know that violations give rise to non-contractual civil liability and that the offender may be obliged to compensate.

Any person who infringes another's rights could face a prison sentence, have their assets seized to pay an equivalent fine, penalties or compensation, or be forced to cease their commercial activity (by having their business closed down, for example).

Relevant Contacts:

- **ASAE** – Food Safety and Economic Authority - www.asae.pt
- **GNR** - Fiscal Brigade of the National Republican Guard - www.gnr.pt
- **DGAIEC** – Customs General Directorate www.dgaiec.min-financas.pt
- **INPI** - National Institute of Industrial Property - www.inpi.pt
- **PSP** - Public Security Police - www.psp.pt

Copyrights and related rights ¹

Applicable laws

Law no. 16/2008 – Amends and republishes the Copyright and Related Rights Code.

Computer Programs Juridical Protection Regime – Decree-Law no. 252/94.

What can and cannot be protected?

Intellectual creations in the literary, scientific and artistic fields are subject to protection under the Copyright and Related Rights Code.

Ideas, processes, systems, operational methods, algorithms, concepts, principles or discoveries aren't protected by this code.

Computer programs with a creative character are entitled to protection analogous to that provided for literary works. The same is applied to databases.

The protection of these works is independent of disclosure, publication, utilisation or exploitation.

For more information, go to:

- <http://www.wigac.ml.pt/>
- <http://www.assoft.pt/>

Formalities

The registration of copyrights and related rights is merely optional, declarative, assuring only an initial presumption of authorship.

The registration of a literary, artistic or scientific work should be requested by the owner(s) of the rights or by their representative(s). The registration can be done online at: <http://www.wigac.ml.pt/>

For information on how to register computer programs, go to:

<http://www.assoft.pt/default.asp?flag=1&idmenu=3&idsubmenu=25&idsubsubmenu=4&ind=0>

1. The information provided in this section was retrieved from the competent entities' Web sites.

Costs (at the date of publication)

The optional registration costs at **IGAC** – *Institution for the General Inspection of Cultural Activities* are as follows:

- Basic Fee: for each work – 25 EUR
- Discontinuance of the registration act – 10 EUR
- Certificate for one work: 40 EUR

Examination

Not applicable.

Duration of protection

In general, copyrights expire 70 years after the author's death, even if the work has only been published posthumously.

The related rights expire after 50 years:

- after the representation or execution by the performer;
- after presentation by the author of the phonogram, videogram or movie;
- after the first transmission by a broadcasting entity.

Ownership of the right

In general, the copyright belongs to the intellectual creator of the work. The law provides for exceptions, such as in the case of collective or joint works, or works done by contract or order.

The author has both patrimonial and moral rights. Patrimonial rights give the author the exclusive right to use the work or authorise a third person to use it totally or partially. Independent of the patrimonial rights, and even after transmission or extinction, the author has moral rights to its work, namely the right to claim its paternity and assure its authenticity and integrity.

What to do if I am copied (copyrights and related rights)

If the aim is to have the offenders punished, the owner can file an official complaint with the relevant authorities: Institution for the General Inspection of Cultural Activities (IGAC), Authority for Economic and Food Safety (ASAE), National Republican Guard (GNR), Public Security Police (PSP), Public Prosecution Office.

Other contacts for complaints of infringements of copyrights and related rights can be made:

- By e-mail to: combatepirataria@igac.pt
- By post to: **IGAC** - Institution for the General Inspection of Cultural Activities

Palácio Foz, Praça dos Restauradores
Apartado 2616 , 1116-802 Lisboa
Tel. 351 21 321 25 00;
Fax: 351 21 321 25 66

or

Rua Gonçalo Cristovão, nº 84, 5º Dt, 4000-264 Porto
Tel. 351.223.394.520; Fax: 351.223.394.529
E-mail: igacgeral@igac.pt

Relevant Contacts:

- **ASAE** – Food Safety and Economic Authority - www.asae.pt
- **GNR** - Fiscal Brigade of the National Republican Guard - www.gnr.pt
- **PSP** - Public Security Police - www.psp.pt
- **IGAC** - Institution for the General Inspection of Cultural Activities – www.igac.ml.pt
- **DGAIEC** – Customs General Directorate - www.dgaiec.min-financas.pt

Actions at customs

How do the Portuguese customs authorities act?

Applicable Laws:

- EC Regulation no. 1383/2003;
- Article 11º, Regulation no. 1383/2003, simplified procedure for the destruction of goods;
- EC Regulation no. 1892/2004;
- Decree-Law no. 360/2007.

In general, Portuguese customs agents act on intervention requests submitted by the holder of the rights. Note that this request can be based on a suspicion of counterfeiting alone! For the duration of the validity of the intervention request, if customs agents suspect a product infringes these rights, it contacts the expert identified by the holder of the rights to examine the goods. If suspicions are confirmed, the goods are temporarily held by customs pending an action by the right holder. It is up to the holder to decide on subsequent actions, such as whether to file

a criminal case in court or make an agreement with the rights infringer.

Procedures

If you have a serious suspicion that your products could be subject to an intellectual property rights violation in Portugal, you should contact the Customs General Directorate (DGAIEC).

To request a customs intervention, you should fill out the form "Application for Customs Intervention – National IP" (11.3011) or "Application for Customs Intervention – Communitarian IP" (11.3012), available at:

http://www.dgaiec.min-financas.pt/publicacoes_formularios/formularios/default.htm

The application form should be submitted directly or by post to:

Direcção Geral das Alfândegas e dos Impostos Especiais sobre o Consumo (DGAIEC)
Direcção de Serviços de Regulação Aduaneira
Rua da Alfândega, nº5 r/c
1149-006 Lisboa

The request is examined by the Customs General Directorate. If it meets the necessary requirements, it is deferred. The applicant is informed of the decision, and the requirement is forwarded to all National Customs Offices. Usually this application is valid for a year and can be extended, at the rights holder's request, for another year.

Note that it is not possible to calculate the storage and destruction costs for seized goods beforehand. The vast majority of warehouses where the goods are temporarily stored are owned by private enterprises, which consider several factors in determining the final price (the effective deposit time of a given physical space, the volume of goods, etc.). The destruction of goods is either carried out by customs authorities or may require the hiring of an outside company.

According to the law, the right holder should temporarily bear the costs of storing and destroying the goods.

More information available at:

<http://www.dgaiec.min-financas.pt>

Main contacts

To prevent possible infringements of your intellectual property rights, you should contact the Customs General Directorate (DGAIEC). In so doing, you will enable this entity to act in an expeditious manner and with accurate information about the products and rights to be protected. You should file an application for customs action at the Customs General Directorate (DGAIEC). The contact information is:

- Tel.: +351.21.881.3890
- Email: dsra@dgaiec.min-financas.pt

Alternative ways to deal with infringements

Since 23/10/2008, there has been a new way to deal with infringements in Portugal, the ARBITRARE – Arbitration Centre for Industrial Property, Domain Names, Companies and Designations.

It is possible to contact this centre to resolve any conflict regarding industrial property, domain names, companies and designations not concerning inalienable rights and which, by special law, are not submitted exclusively to a court of law or to compulsory arbitration.

Procedures

The procedural documentation, namely the petition for submission to arbitration and the written answer, shall, as a rule, be presented electronically at: <http://www.arbitrare.pt>

This petition must contain:

- a) The identity of the parties and of any other entities involved and their addresses;
- b) Indication of the address and electronic mail address at which the petitioner should be notified;
- c) Account of the facts and grounds on which the petition is based, as well as a brief but precise presentation of the claims;
- d) Reference to the types of evidence presented or to be presented;
- e) Indication of the value of the dispute;
- f) Reference to the language to be used in the arbitral proceedings (Portuguese or English).

The petition must be accompanied by the arbitration agreement, the documents the claimant intends to use to prove the facts on which the petition is based,

as well as proof of payment of the procedural costs, within the terms of the respective regulations.

The dispute will be resolved within a maximum of 6 months, except in very complex cases, for which the time limit may be extended for another 6 months.

By law, the arbitrator's decision has the same executive power as the county court's sentence.

More information available at:
<http://www.arbitrare.pt>

Contact to the Portuguese Industrial Property Office:

Instituto Nacional da Propriedade Industrial (INPI)
Campo das Cebolas;
1149-035 Lisboa; Portugal
www.inpi.pt
Tel.: +351.21.881.8100, Fax: +351.21.886.9859
Email: atm@inpi.pt

Romania

Design rights

Applicable Laws

Design Law No. 129/1992

What can and cannot be protected?

A design or model of an article having two or three dimensions can be protected if:

- it is new;
- it has an individual character.

All the relevant details are available at: <http://www.osim.ro/desene/pdmi.htm>

A design or model cannot be protected if:

- it is determined by a technical function;
- it has a purpose and appearance contrary to morality or public order.

Formalities

A standard application form for design registration is provided free of charge by the national patent office (OSIM). The application may be filed directly at OSIM or by mail.

The application shall contain:

- applicant's name and address;
- representative's name and address (where appropriate);
- a graphic representation and an indication of the product;
- a short description of the characteristic elements of the new appearance of the product;
- design author's name and address.

The application shall also include in annex:

- representative's power of attorney (where appropriate);
- copies of the graphic reproductions of the design;
- payment of the application fees.

Representation by an authorised IP attorney is compulsory **only** for persons not having a domicile or registered office in Romania, except for the application filing procedure.

Costs (at the date of publication)

Fee for individual designs	EUR
Filing the application:	
a) for the first design	30
b) for each additional design	10
Publication:	
a) for each figure, in the standard space (6x 6cm), white-black	
b) for each figure in the standard space (6x 6cm), color	20
c) for the characteristic elements (up to 30 words)	100
Examination:	
a) for the first design	50
b) for each additional design	10
Issuance of the certificate of registration:	
a) for 1-20 designs	20
b) for 21-50 designs	30
c) for 51-100 designs	50
Maintenance in accordance with the certificate of registration for every year of protection, for the first five years:	
a) for 1-20 designs	100
b) for 21-50 designs	125
c) for 51-100 designs	150
Renewal of the certificate of registration for every year of protection:	
a) for 1-20 designs	20
b) for 21-50 designs	25
c) for 51-100 designs	30

Examination

Once a design application is filed and the formal conditions are met, the application is published in the Official Bulletin of Industrial Property (BOPI), upon payment of a fee. Interested parties may oppose the registration of the design in writing.

The most important procedure is the substantive examination, during which the design/model applica-

tion is examined for novelty and individual features and is compared with the current state of the art in the field.

If the registration is approved, a protection title, the Design/Model Registration Certificate, is granted upon payment of a fee.

Duration of protection

The term of protection of a design registration certificate is at least 10 years and at most 25 years, starting the day the application is filed.

Ownership of the right

Throughout the period of validity of design registration, the owner has the exclusive right to use the design and to prevent any third party not having prior consent from using it.

The owner has the right to prohibit third parties from performing the following acts without permission: reproducing, manufacturing, putting on the market or offering for sale, importing, exporting or using a product having the design incorporated or applied thereto or storing such a product for the above-mentioned purposes. The right may be transferred in whole or in part and can be inherited.

Trade mark rights

Applicable Laws

Law no. 84/1998 on Trade Marks and Geographical Indications

What can and cannot be protected?

A trade mark doesn't protect the product itself. It is sign that serves to distinguish the goods or services of a natural or legal person from those belonging to other persons.

The following can be registered as trade marks: words, including personal names, drawings, letters, numbers, figurative elements, 3-D forms, especially the form of the goods or their packaging, combinations of colours, as well as any combinations of these signs.

The following items are excluded from protection and cannot be registered:

- those without distinctive character;
- those capable of misleading the public with respect to the geographical origin, quality or nature of the good or service;
- those contrary to morality or public order.

All the relevant details are available at:
<http://www.osim.ro/marci/pmarc.htm>

Formalities

The right to a trade mark belongs to the natural or legal person who first files an application to register the trade mark, in accordance with legal conditions.

A standard request form for trade mark registration is provided by OSIM free of charge. The application may be filed directly at OSIM or by mail.

The registration of a trade mark requires the filing with OSIM of an application written in Romanian on a standard form, comprising:

- applicant's name and address;
- representative's name and address (where appropriate);
- the list of the goods or services for which the registration is requested, according to the Nice Classification.

The application shall also include in annex:

- representative's power of attorney (where appropriate);
- copies of graphic reproductions of the trade mark;
- payment of the application fees.

Costs (at the date of publication)

Fees for individual trade marks	Euros
Filing the application	10
Publication:	
a) black-and-white	30
b) color	100
Examination:	
a) for a class of products or services	
- black-and-white	110
- color	190
b) for each additional class of products and/or services	50
c) additionally for a figurative element or a word mark with special graphics	30
Issuance of the certificate of registration:	50

Fees for individual trade marks	Euros
Renewal of registration:	
a) for a class of products or services	
- black-and-white	120
- color	200
b) for each additional class of products and/or services	50
c) additionally for a figurative element or a word mark with special graphics	30

Examination

Once a trade mark application is filed and formal conditions are met, the most important procedure is the substantive examination, during which the trade mark application is examined for legal conditions and anteriority, distinctive and descriptive features, and compared with the current state of the art in the field.

If the registration is approved, a protection title, the Trade mark Registration Certificate, is granted upon payment of a fee.

The application is published in the Official Bulletin of Industrial Property (BOPI), upon payment of a fee. Interested parties may oppose the registration of the trade mark in writing.

Duration of protection

The term of protection of a trade mark registration certificate is 10 years, starting on the date the application is filed. The protection may be renewed at the end of every 10-year period of protection.

Ownership of the right

The registration of a trade mark confers upon the owner a right to exclusive use of the trade mark for the goods and/or services that were registered, as well as the right to prohibit others from using it or imitating it fraudulently.

The rights to a registered or renewed individual trade mark may be transferred in whole or in part, for payment or free of charge. The collective trade mark is not transferable.

Important:

- The protection for Community Trade Mark and Design has been extended to Romania since its accession to the European Union on 1/01/2007 and is to be taken into consideration.
- Particular attention is to be paid to the collision trade mark - commercial name: priority data could make a difference in terms of protection, but trade mark offers the most extensive protection.

Patent rights, including utility models

Applicable Laws

Patent Law No. 64/1991

Law on Utility Models No. 350/2007

What can and cannot be protected?

A patent protects the technical solution embodied in products and/or processes that are new, involve an inventive step and have industrial applicability.

A utility model protects only new products with industrial applicability.

All the relevant details are available at:

http://www.osim.ro/brevete/modele_utilitate.html

<http://www.osim.ro/brevete/pbrev.html>

The following are excluded from protection:

- discoveries, scientific theories, mathematical methods, computer programs; methods for treatment or diagnosis of humans or animals;
- inventions contrary to public order or morality.

Formalities

A standard request form for patent/utility model application is provided free of charge by OSIM. The application may be filed directly at OSIM or via electronic means.

The application shall contain:

- the prescribed form of the registration request;
- a description of the invention;
- claims;
- drawings referred to in the description.

Representation by an authorised IP attorney is compulsory only for persons not having a domicile or registered office in Romania.

Costs (at the date of publication)

Procedure	For patent (EUR)	For utility model (EUR)
Filing the application	30	30
Publication of application	100	Not applicable
Drawing up and publishing the search report	100	100
Examination	400	Not applicable
Publication of the decision of grant and issuance the title	100	400 (first six years of protection included)

Maintenance in force (for patents):

For 1st and 2nd annuities – free of charge

3 rd annuity – 150 EUR;	10 th annuity – 280 EUR;
4 th annuity – 160 EUR;	11 th annuity – 300 EUR;
5 th annuity – 180 EUR;	12 th annuity – 320 EUR;
6 th annuity – 200 EUR;	13 th annuity – 340 EUR;
7 th annuity – 220 EUR;	14 th annuity – 370 EUR;
8 th annuity – 240 EUR;	15 th annuity – 400 EUR;
9 th annuity – 260 EUR;	For 16 th to 20 th annuity – 500 EUR each

Renewal of utility models (from the 7th to the 10th year of protection): 500 EUR.

Important:

- The government provides grants that lower costs (up to 50% of the amount due), provided that the applicant or the owner of the granted patent/utility model has not taken over or transferred the right in legal conditions or for payment.
- Another line of grants is available for SMEs, provided the profit is reinvested in non-corporal assets, like IPRs (patents, trade marks, copyrights, software).

For more information, see the link: http://www.mim-mc.ro/programe/profit_reinvestit2008

Examination

The patent application shall first be checked with regard to the formal aspects. If the formal conditions are met, the patent fees are paid and no withdrawal has taken place, the patent application shall be published within a maximum of 18 months from the filing date. The publication of a patent application may be accompanied by the publication of a search report.

During the substantive examination, the examiner checks whether:

- the invention is disclosed in a clear, complete manner;
- the invention is new, involves an inventive step and is industrially applicable.

An examination board takes the decision to grant or to refuse the protection based on a report drawn up by an examiner. The decision may be appealed by the applicant within 3 months from the communication. All decision shall be published in the BOPI, upon payment of fees.

Any third party may request that the office revoke the patent in whole or in part within 6 months of publication. The grounds for revocation shall refer to a failure to comply with the patentability conditions: novelty, inventive step, industrial applicability.

For utility models, the application is subject to the following procedures:

- formal examination;
- carrying out the search report;
- publication of the decision to register, along with the search report.

For utility models, no substantive examination takes place, and the certificate is granted on the applicant's responsibility.

Duration of protection

The maximum validity period for a patent is 20 years from the date the application was filed, provided the maintenance fees are paid, and without possibility of renewal.

The protection period for a utility model is 6 years, with a possibility of renewal for a maximum total of 10 years.

Lack of payment of maintenance or renewal fees will result in the loss of the rights conferred by a patent or utility model.

Ownership of the right

The patent or the utility model gives the owner the right to prevent third parties from performing the following acts, without authorisation:

- for products (including those obtained from a patented process): manufacture, commercialisation, offer for sale, use, importation or storage meant for commercialisation, offer for sale or use thereof;
- for processes (protected only by patents, not by utility models): use thereof.

Patent or utility model rights can be transferred in whole or in part by license or assignment and can be inherited.

Copyrights and related rights

Applicable Laws

Copyright Law no. 8/1996

According to Romanian law, a work of intellectual creation shall be acknowledged and protected, without regard for its disclosure to the public, simply by virtue of its creation.

What can and cannot be protected?

The subject of a copyright shall be original works of intellectual creation in the literary, artistic, or scientific fields, regardless of their manner of creation, specific form or mode of expression and independent of their merit and purpose. Copyright shall also include derived works created from one or more pre-existing works.

All details are available at: <http://www.orda.ro/>

Formalities

No formalities are required to ensure protection for those rights.

The registration in the National Registers managed by the Romanian Copyright Office (ORDA) of audio-visual works or computer programs is **optional**.

Costs (at the date of publication)

Since it is optional, registration fees vary by operation from 15 EUR to 150 EUR, depending on the kind of work to be registered.

Duration of protection

The copyright for a literary, artistic or scientific work comes into being at the time of the work's creation, regardless of the specific form or manner of expression thereof.

The author of a work has both moral and economic rights. The moral rights consist mainly of deciding whether, how and when the work will be disclosed to the public and demanding recognition for the authorship of the work.

The economic rights last for the author's lifetime and after his death shall be transferred by inheritance, according to civil legislation, for a period of 70 years, regardless of the date on which the work was legally disclosed to the public.

Ownership of the right

Unless proved otherwise, the person under whose name the work was first disclosed to the public shall be presumed to be the author. The author of a work shall have the exclusive economic right to decide whether, how and when his work is to be used or exploited, including the right to authorise the use of the work by others.

The author or the owner of the copyright may only transfer the economic rights by contract to other persons, by exclusive or non-exclusive transfer (license).

What to do if I am copied

To enforce their IP rights, owners have the following means:

- civil action, by which payment of full damages to the owner and the recall or removal of the infringing goods from the market or the destruction of the goods may be ordered by courts;

- criminal prosecution (mainly if there is a large-scale counterfeiting of goods with an important impact on the market). To initiate action in criminal cases, a prior complaint by the right holder is not mandatory since state institutions conduct the proceedings. However, the full cooperation of the IP rights holder is required. The courts can order imprisonment or fines or compensation of damages for losses suffered by the owner.

The competent courts for infringement cases are the Bucharest courts, which have specialised panels.

Useful contacts:

Inspectoratul General al Politiei Române (IGPR)
Romanian General Police Inspectorate

Parchetul de pe lângă Înalta Curte de Casatie si Justitie a României (Ministerul Public)
Public Ministry

Autoritatea Nationala a Vamilor (ANV)
National Customs Authority

Autoritatea Nationala pentru Protectia Consumatorilor (ANPC)
National Authority of Consumer Protection

Oficiul de Stat pentru Inventii si Marci (OSIM)
State Office for Inventions and Trade Marks

Oficiul Român pentru Drepturile de Autor (ORDA)
Romanian Copyright Office

Camera Nationala a Consilierilor în Proprietate Industriala
National Chamber of IP Attorneys

Camera de Comert si Industrie a României (CCIR)
Romanian Chamber of Commerce and Industry

Uniunea Producătorilor de Fonograme din România (UPFR)
Romanian Phonograms Producers

International Federation of the Phonographic Industry (IFPI)
Federatia Internationala a Industriei Fonografice

Worldwide Customs Organizations (WCO)
Organizația Mondială a Vămilor

Organizația Mondială a Proprietății Intelectuale (WIPO)

World Intellectual Property Organization

Actions at customs

The applicable law is Law no. 344/2005, regarding measures to ensure the observance of intellectual property rights during customs operations, which include the provisions of the EC Regulation 1383/2003.

Procedures

To ensure intervention by customs authorities, IP right holders must file an application to record each relevant IP right, which allows customs to seize any goods suspected of infringing the recorded rights if they are imported into or exported to Romania.

The customs authorities can act even without a written application if there is a suspicion that certain goods might infringe an IP right valid in Romania. When such an event occurs, customs procedures are suspended and/or the goods are seized. The IP rights owner and the importer or the designee of the goods involved are informed. If the infringement is confirmed, the goods are destroyed (provided the destruction costs are paid by the right holder).

For specific procedural details follow the link:
<http://www.customs.ro/212/section.aspx>

Main contacts

Autoritatea Națională a Vămilor
Str. Matei Millo nr. 13,
Sector 1, București
www.customs.ro

Alternative ways to deal with infringements

As an alternative way to deal with infringements, the Court of International Commercial Arbitration can settle international and domestic commercial disputes or litigation and also to provide free consulting.

More relevant details are available at: <http://arbitration.ccir.ro/index.htm>



Another way to deal with infringement is to consult the Law on the Repression of Unfair Competition. According to this law, any misleading commercial practice, such as false statements associated with other businesses signs, practices or acts (so called "free riding") are considered unfair competition. The law provides for imprisonment or fines once a civil action is filed.

Another way to prevent infringement is to protect a company's confidential information through non-disclosure contracts with its employees. In so doing, the secret information, in fact, becomes a monopoly on the market. However, the lack of formal protec-

tion does not prevent third parties from reaching and using similar information once it is independently discovered.

Contact of the National Patent Office

Oficiul de Stat pentru Inventii si Marci (OSIM)

Str. Ion Ghica nr. 5,
030044, Sector 3, Bucuresti
Romania
www.osim.ro
0040(21) 306.08.00, 306.08.01-306.08.29
office@osim.ro

Spain

Design Rights

Applicable Laws

Industrial Design Legal Protection Act 20/2003 and Royal Decree 1937/2004 of Implementing Regulations to Act 20/2003.

Full text available at www.oepm.es

What can and cannot be protected?

The appearance of all or part of a product resulting from the particular characteristics of the lines, contours, colours, shape, texture or materials of the product itself or its ornamentation can be protected. The designs may be two- or three-dimensional.

Applications that are not new or show only the technical function of a product cannot be protected.

Formalities

You can fill out and file Application Form 3201 "Industrial Design Application", available at www.oepm.es, under *How we can protect...? > Industrial Designs > All forms*.

Graphical representations of the designs to be protected have to be included in the spaces provided. The application cannot cover more than 50 designs, and they must all belong to the same class of goods. This restriction shall not apply in the case of two-dimensional decorations. For guidance on how to fill out the application, you can follow the example annexed to the application form.

Proof of payment of application fees must be included with the application form. Payment can be made at the LA CAIXA bank office in the OEPM (Oficina Española de Patentes y Marcas) premises, Paseo de la Castellana, 75. Madrid, Spain, using the payment

forms provided there. Elsewhere in Spain, you can request payment forms by letter, phone or e-mail at informacion@oepm.es. From abroad, you can wire the fee amount to the OEPM's La Caixa bank account, IBAN: ES 22 2100 5038 31 0200001807 SWIFT: CAIXES BB XXX and include a copy of the transfer receipt with the application form.

On-line filing and payment is set to be introduced soon. Please check the OEPM Web page for availability.

Protection can be applied for in person at the OEPM in Paseo de la Castellana 75, 28046 Madrid, phone number (+34) 902 157 530, or sent by mail to the above address.

After filing a copy of the application in person or by mail, an application number and a filing date shall be returned as a filing receipt.

A detailed leaflet in Spanish, "Manual informativo para los solicitantes de Diseños Industriales", explaining all you need to know about industrial design applications can be downloaded at www.oepm.es. Patent attorneys are only required for non-EU residents but may nevertheless be used by everyone to handle full procedures. Check the patent attorney list at www.oepm.es under *List of Industrial Property Agents*.

Costs (at the date of publication)

As of 2009, the application fee for 1-10 designs is 90.85 EUR and for up to 50 designs 305.43 EUR. Other costs may apply when invoking priority, modifications, suspensions or oppositions. For a complete list of fees see www.oepm.es under *Industrial Designs > All fees*

Cost of design renewal is 103.24 EUR for up to 10 designs.

To renew, you must submit a Renewal Application Form 3207, available at www.oepm.es under *All forms*. It must be submitted with the receipt of payment of the renewal fee within the 6 months prior to the termination of the corresponding validity period.

Examination

The application is examined to ensure that it meets certain formal requirements. If any possible infringement of the law is detected, notification is mailed to the address in the application form. A period of 1 or 2 months is allowed for a response, depending on the case. Notification of anything observed during the processing of an application that prevents it from being registered will be sent to the stated address, giving the applicant the opportunity to remedy the defects found.

If the application does not lack any essential information and all mistakes or deficiencies are corrected in due time, the registration of the industrial design is recorded in the designs database, available at SITA-DEX:

<http://sitadex.oepm.es/ServCons/SitJurExpGra>. It is also possible to search for registered designs or to get information to oppose any possible infringing application at www.oepm.es. Oppositions have to be filed within 2 months of the granting's publication.

Administrative procedures last 3 months on average. Nevertheless, for applications that have all of the essential information required in the filing process or for which deficiencies have been corrected, procedures can be performed in 2 months.

Duration of protection

Protection lasts for 5 years. You may renew it every 5 years up to a maximum of 25 years.

Ownership of the right

Registered designs may be transferred or licensed, but those actions must be recorded in the OEPM database. Those forms can be also found at the www.oepm.es.

After registration, the office may warn you that a potential infringing application exists. An opposition can be filed at the OEPM (Form 3202).

Trade mark rights

Applicable Laws

Main applicable laws are:

Trade Marks Act 17/2001 and Royal Decree 687/2002 of Implementing Regulations to Act 17/2001. Full text available at www.oepm.es.

What can and cannot be protected?

Words, logos, pictures or any other distinctive signs can be protected, provided they are neither generic nor descriptive. Three-dimensional, deceptive or illegal signs are not allowed. To find out more on this topic, please refer to www.oepm.es.

A trade name is the sign or designation identifying a company in the trade that is used to distinguish it from other companies that perform identical or similar activities, whereas a trade mark distinguishes the products or services that the company manufactures, markets or renders. The trade name does not have to coincide with the corporate name, so it is possible to choose a trade name that is different from the corporate name. The same natural or legal person can have several trade names, if desired, to identify commercial activities belonging to different economic sectors. Thus, a trouser manufacturer could register the name it uses in its manufacturing activities, in its relations with suppliers, clients, etc., as the trade name. The sign or name these trousers are marketed under would be the product's trade mark.

Formalities

Fill out and file Application Form 4101 "Trade mark registration application" or Form 4301 "Trade name registration application", available at www.oepm.es under *How we can protect...? > National trade mark/ Trade name*.

You can follow the example on how to fill out the application in the leaflet "Information manual for trade mark applicants", where you will also find all you need to know about trade marks and trade name applications. It can be found at www.oepm.es under *National trademark > Booklets. Catalogues > Booklets*.

Proof of payment of application fees must be included with the application form. Payment can be made at the LA CAIXA bank office located in the OEPM premises, Paseo de la Castellana, 75. Madrid, Spain, using the payment forms provided. Elsewhere in Spain, you can request payment forms by letter, phone or e-mail at informacion@oepm.es. From abroad, you can wire the fees due to the OEPM's La Caixa bank account, IBAN: ES 22 2100 5038 31 0200001807 SWIFT: CAIXES BB XXX and include a copy of the transfer receipt with the application form.

Protection can be applied for in person at the OEPM in Paseo de la Castellana 75, 28046 Madrid, phone number (+34) 902 157 530, or sent by mail to the above address.

The application must include the words, logos, pictures or any other signs you want to protect and proof of payment.

After filing a copy of the application in person or by mail, an application number and a filing date shall be returned as a filing receipt.

On-line filing and renewals are available with a 15% discount. Please check www.oepm.es under *Online formalities*.

Patent attorneys are only required for non-EU residents but may nevertheless be used by everyone to handle full procedures. Check the patent attorney list at www.oepm.es

Costs (at the date of publication)

As of 2009, there is a 154.38 EUR fee per class of products or services (15% discount when using on-line filing).

There could be other costs involved when invoking priority, modifications, suspensions or opposition proceedings, as shown in the table:

Express procedure	51.11 EUR
Foreign priority	21.88 EUR
Oppositions	44.29 EUR
Renewals, each class	178.73 EUR

For a complete list of fees, see www.oepm.es under *All fees*.

Examination

Trade mark or trade name registration applications filed with the OEPM are examined to check compliance with the requirements of admissibility, form and legality within a period of 1½ months from reception of the application. You will be notified of any incidents that may arise during the processing of your application that would make the registration impossible. You will be asked to resolve any problems detected (submission date, form requirements, absolute and relative prohibitions).

Applications are published in the Spanish Official Industrial Property Gazette within 2½ months from the date of reception, provided the application does not have any formal problems and there have been no requests to resolve problems with the application documentation, and also provided it is not deemed to contravene public order or decency. If the application has any of the above problems, it will be published within 5 months from the date of reception of proof of corrections by the OEPM.

If the application is correct or problems have been remedied in due time, the registration of the trade mark or trade name shall be recorded in the SITADEX database.

You will be notified when your registration title is issued so you can collect it.

You should be aware that the OEPM conducts a computer search on each trade mark or trade name application to detect possible registration incompatibility with previous existing trade marks. As a trade mark holder, you will be notified if this search detects any application that may affect your rights. This will also enable you to object to the registration of any later requested trade mark.

Duration of protection

Trade marks are granted for 10 years from the application date and can be renewed indefinitely for consecutive periods of 10 years.

Ownership of the right

Registered trade marks or trade names may be transferred or licensed, but those actions must be recorded in the OEPM database. The necessary forms can be found under www.oepm.es.

After registration, the office may warn you of a potential infringing application. An opposition can be filed at the OEPM (Form 4104).

Patent rights, including utility models

Applicable Laws

Patent Act 11/1986 and Royal Decree 2245/1986 of Implementing Regulations to Act 11/1986.

Full text available at www.oepm.es.

What can and cannot be protected?

A patent can be applied to a new process, device, product or the improvement or advancement of any of these.

A utility model protects inventions of a less inventive nature than those protected by patents, for example the set-up or structure of an object from which some use or practical advantage can be obtained. The device, instrument or tool protected by a utility model is characterised by its "utility" and "practicality" and not its "aesthetics", as is the case for an industrial design.

Formalities

Fill out and file Application Form 3101 at www.oepm.es under *National Patent/Utility model* > *All forms*, according to the instructions. You can also follow the example on how to fill out the application in the leaflet *Information manual for patent applicants*. A filing receipt, which includes an application number and a filing date, shall be issued.

To apply for a patent or a utility model, you must send the following with the application form:

- a written description (to allow others to read what the invention is and how it works),
- one or more claims (specify the elements of your invention that you want to protect in terms of their technical features),
- drawings (when necessary) to illustrate your invention,
- an abstract (a summary that includes the important technical aspects). Not required for utility models.

Proof of payment of application fees must be included with the application form. Payment can be made at the LA CAIXA bank office in the OEPM premises, Paseo de la Castellana, 75. Madrid, using the payment forms provided. Elsewhere in Spain, you can ask for payment forms by letter, phone or e-mail at informacion@oepm.es. From abroad, you can wire the fees due to the OEPM's La Caixa bank account, IBAN: ES 22 2100 5038 31 0200001807 SWIFT: CAIXES BB XXX and include a copy of the transfer receipt with the application form.

Protection can be applied for in person at the OEPM in Paseo de la Castellana 75, 28046 Madrid, phone number (+34) 902 157 530, or sent by mail to the above address.

After filing a copy of the application in person or by mail, an application number and a filing date shall be returned as a filing receipt.

On-line filing is available with a 15% discount. Please check at *Online formalities > Solicitud-e de invenciones*.

You should be aware of the main inventors' mistakes that can hinder the patentability of your invention:

- Marketing the product before patenting it,
- Publishing research work before patenting it,
- Not patenting the invention and keeping it secret,
- Thinking that what one does not know does not exist,
- Not respecting the priority periods.

Costs (at the date of publication)

As of 2009, a fee of 91.69 EUR is paid when filing your patent or utility model application (15% discount when using online filing); main fees are shown in the table:

Filing fee	91.69 EUR
Search and written opinion	664.51 EUR
Optional substantive examination	378.31 EUR
Granting fee	28.25 EUR

To remain in force, annuity fees are due every year from the 3rd year through the 10th year for utility models or through the 20th year for patents.

Maintenance Costs in 2009:

1 st and 2 nd annuity	Included in <u>filing fee</u>		
3 rd annuity	22.64 EUR	12 th annuity	259.76 EUR
4 th annuity	28.25 EUR	13 th annuity	298.22 EUR
5 th annuity	54.05 EUR	14 th annuity	337.03 EUR
6 th annuity	79.77 EUR	15 th annuity	375.57 EUR
7 th annuity	105.36 EUR	16 th annuity	428.11 EUR
8 th annuity	131.15 EUR	17 th annuity	478.47 EUR
9 th annuity	156.85 EUR	18 th annuity	529.97 EUR
10 th annuity	182.59 EUR	19 th annuity	581.37 EUR
11 th annuity	221.23 EUR	20 th annuity	632.85 EUR

There are other costs involved when invoking priority, modifications, suspensions or oppositions. For a complete list of fees, look under www.oepm.es under *National Patent/Utility model> All fees*.

Renewal fees have to be paid annually starting the 3rd year from the date the patent application is filed. The renewal payment deadline is calculated from the date of publication of the granted patent until 3 months after. If the granting gets delayed, you will often also have to pay the 4th or 5th year.

Renewal fees for the utility models have to be paid annually starting the 3rd year from the date the utility model application is filed.

Examination

Before a search report is issued, the patent application is subject to a formal and technical examination, including prohibitions, industrial application and unity of invention. Once the application is correct, an official communication is sent to the applicant to inform him that he should pay the search fee if it has not already been paid.

The search report, which contains the relevant state of the art and the written opinion, is sent to the applicant before the application is published.

18 months after the filing date, the application and search report are published. The publication may happen sooner if the applicant so requests using the *Accelerated Grant Programme (programa de Concesión Acelerada de Patente nacional, CAP)*.

After publication of the search report, the applicant has two options:

– Granting the patent without substantive examination

If within 3 months of publication of the search report the applicant chooses the procedure without substantive examination, the application will be granted within approximately 8 months, after third parties have had the opportunity to comment on the patentability of the invention and the applicant has had a chance to comment on the search report and modify the claims if so desired.

– Granting procedure with substantive examination

If within 3 months of publication of the search report the applicant chooses the procedure with substantive examination, the office will first open a 2-month opposition period. Then the application will be examined along with any opposition. If any objection is detected, or if any opposition has been filed, the office will issue a first communication containing the results of the substantive examination, and the applicant will have 2 months to answer and modify the claims if desired. If the application is still not correct, the applicant will have a second opportunity to correct it. After this second communication, the examiner will decide whether to grant or reject the application.

– Utility model procedure

The application is published for filing oppositions. To avoid possible infringements of existing inventions, it is advisable when oppositions are filed to modify those claims affected by the documents on which the opposition is based or to plead as considered appropriate. The OEPM will decide whether to grant or reject the application and the applicant will be notified of the decision.

Duration of protection

The patent is granted for 20 years from the application date, but yearly fees must be paid once it has been granted. The utility model is granted for 10 years from the application date.

Ownership of the right

After a patent is obtained, the office continues to play a relevant role. The OEPM publishes your patent on its Web page and distributes it to the main patent offices around the world, which undoubtedly helps

it become known and possibly marketed. Likewise, if you manage to transfer or license the technology protected by your patent, the OEPM records those variations to make third parties aware of them. If you have trouble marketing it, you can also offer your patent through the OEPM by making a full licence offer. The office will reduce the maintenance fee by 50% and will publish your offer. The necessary forms can be found at the mentioned link.

What to do if I am copied (designs, trade marks, patents)

Enforcement of industrial property rights can be done through either criminal or civil court proceedings. The first of these can obtain results more quickly and clearly, although it is necessary to have exact compliance with each and every element set forth under criminal law for it to be effective.

Civil courts are not so immediate, but broader results can be achieved and issues from other legal spheres can be dealt with. Civil courts may order the cessation of the acts (sales, marketing), compensation for the damages suffered, and the withdrawal and destruction of the products.

- Criminal Procedures/Information Points:

Since 1st October 2004, crimes against duly registered industrial property rights have been pursued by the courts. According to the resolutions in the Fast Trials Act, Spain's law enforcement and security forces can carry out the initial steps of prevention and seizure without the need for criminal proceedings. Nevertheless, to ensure the effective pursuit of these offences the prompt intervention of the holder is practically indispensable.

This means that the offence has become pursuable by the courts, but the holder's intervention is required to establish the false or genuine nature of the goods seized in each case by the police and, in many cases, to notify them of the crime committed, which will then be pursued by the courts. To achieve the aforementioned objectives and to make enquiries or ask for information about the owner or patent attorney related to the misappropriation of industrial property rights, you can contact the Spanish Patent and Trademark Office by telephone (+34) 902157530, fax (+34) 913496856 or pirateria@oepm.es.

To report offences related to the misappropriation of industrial property rights, you can call the National

Police (091) or the Municipal Police (092). Similarly, to report this type of crime, you can also go to the nearest Civil Guard office or call them on 062.

For any questions on this subject, you can send an e-mail to webmaster@guardiacivil.org, which you can also access on the Web site www.guardiacivil.org, either directly or through the Ministry of the Interior Web site www.mir.es.

You can report the offence either in writing or as a verbal statement, which must include the identity of the person reporting the offence and any available details of the case and the circumstances. This information is extremely helpful to focus and expedite action taken by law enforcement and security forces.

More information on court proceedings can be found at www.oepm.es > *All about industrial property*> *Measures to counter industrial piracy*> *Court Proceedings*,

Copyrights and related rights

Applicable Laws

Main applicable laws are:

- Consolidated version of the Intellectual Property Act of 11/11/1987, approved by Royal Legislative Decree 1/1996 of 12/04/1996 http://www.mcu.es/propiedadInt/docs/RDLegislativo_1_1996.pdf
- Royal Legislative Decree 281/2003 of 7/03/2003 establishing the Intellectual Property General Registry

<http://www.mcu.es/propiedadInt/docs/ReglamentoRegistro.pdf>

What can and cannot be protected?

Copyright protects books, pamphlets, writings, and other works of the same nature; drawings, paintings, engravings, lithographs; photographs and analogous works.

A full list of what is included and excluded from protection can be found at:

<http://www.mcu.es/propiedadInt/CE/PropiedadIntelectual/PreguntasFrecuentes/PropiedadIntelectual.html#c>

Formalities

Works do not need to be registered as protection is accorded by the mere fact of their creation. Nevertheless, registration provides solid proof that rights do exist and belong to their holders. Another great advantage of registering is publicity stemming from registered rights.

When a copyright has been registered, it is always convenient to indicate the reservation of rights using the © symbol in the case of a work or service or the ® symbol in the case of phonograms.

To claim registration, an application form must be submitted along with the appropriate documentation to any of the regional registers or provincial offices of the Central Register of Intellectual Property.

Applications for registration should include:

-The official registration application form. Since there are many different forms according to the kind of work or registration, please check <http://en.www.mcu.es/propiedadInt/CE/RegistroPropiedad/ImpresosSolicitud.html>:

- A copy of the work, performance or production, in the form and by the means indicated in the official form,
- The documentation required in each case by the applicable legislation,
- Receipt for corresponding fee payment. This is made once the settlement amount has been drawn up by the register on the official form.

Registration takes effect from the date the request is filed with the register.

To avoid confusion, you should be aware that, when dealing with copyright matters in Spain (laws, registry, procedures, etc.), you should always address intellectual property, which falls under the Ministry of Culture's jurisdiction, in the General Registry of Intellectual Property.

Costs (at the date of publication)

Upon filing, a 12.43 EUR fee (as of 2009) must be paid. There could be other fees involved. For a full updated list of fees, see: <http://www.mcu.es/propiedadInt/CE/RegistroPropiedad/Tasas.html>

Duration of protection

The general duration of the rights of use is the author's lifetime plus 70 years following his/her death. The duration is different for moral rights and for the work of authors who died before 1987.

Once the rights protection has expired, the work or service becomes public domain and can be freely used by anyone.

Ownership of the right

Works or services may be used but require authorisation from the holders of the rights.

Public dissemination of works and services over the Internet does not imply that the holder of the rights has waived the right to authorise the use of the work or service, nor declined to obtain compensation.

For authorisation to use works and services, you can contact the holders of the rights to request their authorisation. For certain works or services, you may contact the collective management entities of intellectual property rights.

Copyrights are generally transferable by means of a written document.

What to do if I am copied (copyrights and related rights)

The use of works and services without authorisation from their holders could represent a violation of intellectual property rights. In case of violation, the holder can exercise the criminal and/or civil actions stipulated by law.

Piracy, in the most serious cases, is covered by the Criminal Code, and may be punished by fines and prison sentences.

You should consult a lawyer specialised in this matter as the Office of Intellectual Property is not responsible for advising physical or legal persons.

Actions at customs

How do the Spanish customs authorities act?

Applicable laws

Main applicable laws are:

- EC Regulation 1383/2003¹
- Spanish Criminal Law

Customs authorities' duties:

- inspection of goods;
- retain the inspected goods if they suspect infringement of intellectual property rights.

Purpose of intervention:

- Goods which are or incorporate:
 - trade marks,
 - patents,
 - industrial designs,
 - supplementary protection certificates,
 - plant variety certificates,
 - geographical indications and appellations of origin.
- Molds that allow falsifying signs or goods

Request for action by the customs authorities:

The submission of applications for action shall enable the right holders to retain goods during certain periods to prevent the entry of such goods in commercial networks.

- During an inspection, if the customs authorities suspect that any goods could be considered to violate registered intellectual property rights, they may retain the goods for 3 days.
- Customs authorities contact the right holder and the licensee.

When the owner/licensee submits application for action:

- The application for action must follow the official form www.aeat.es,
- Along with the application, the following documents must be submitted:
 - A certificate of ownership and validity of the property right it seeks to assert,
 - A declaration by the owner where he assumes liability towards third parties and assumes to the costs of destruction of goods which infringe his rights.

- The application must be sent to the Departamento de Aduanas e Impuestos Especiales,
- The customs administration will issue a decision granting or denying the requested action and may agree to the intervention of the goods during 1 year. The applicant may extend that period,
- If there is a detaining decision, customs will contact the importer and the right holder,
- The right holder shall have 10 days to bring a lawsuit before the Spanish civil or criminal courts to enforce his right. This period may be extended by 10 additional days,
- The right holder may examine the merchandise and even take the samples necessary to enforce its legal claims,
- After the 10-day period – and an extension when applicable – passes without a lawsuit being filed, customs will release the goods. On the other hand, if a lawsuit has been brought, the goods will be retained.

If the owner/licensee files no request for action:

- If within 3 days the owner/licesee does not submit an application for action, the customs authorities shall authorise the release of goods

Cost

The cost of destruction of goods varies widely depending on the location and nature of the goods. The presence of toxic substances would thus imply a much higher cost of destruction.

There are no official costs for the destruction of the goods and only estimates are available. A wide variation in the costs of destroying the goods can be observed in different geographical areas. For example, the destruction of the goods in a single container with a capacity of 9 tonnes in Valencia would cost 1,620 EUR, whereas in Algeciras it would cost 9,000 EUR.

There is also a shortage of companies engaged in the destruction of fraudulent goods. This means the additional cost of transportation of the goods from the customs office to the point of destruction should be added to the cost.

Main contacts

- The National Association for the Protection of Trademarks (ANDEMA).
<https://www.camaras.org/publicado/andema/andema.html>

1. <http://eur-lex.europa.eu/en/index.htm>

- Spanish Customs Service
www.aeat.es/aeat/aeat.jsp?pg=aduanas/es

Alternative ways to deal with infringements

There is no way to deal with infringements other than exercising civil and criminal actions before the Spanish courts. For further information on judicial procedures, see "What to do if I am copied".

Announcement about online formalities

The OEPM will be undergoing big changes in electronic applications and payments through 2009. Some procedures are already offered and the progress can be checked at www.oepm.es > *Online formalities*.

Please note that all forms will only be available in Spanish.

Contacts of the Spanish Patent Office:

Oficina Española de Patentes y Marcas (OEPM)
Paseo de la Castellana 75
28046 Madrid
Spain
www.oepm.es
0034 902 157 530
información@oepm.es

United Kingdom

Design rights

Applicable Laws

The Registered Designs Act 1949
<http://www.ipo.gov.uk/regdesignactchanges.pdf>

What can and cannot be protected?

It is possible to register designs that meet both the following conditions:

- It must be new
- It must have an individual character

For more information on this subject go to:
<http://www.ipo.gov.uk/types/designs>

Designs cannot be registered in the UK:

- if they are not new;
- if they have no individual character;
- where the design is set because of technical function;
- if they are against policy or accepted morality;
- If they contain protected flags and international emblems.

Formalities

To register drawings and models, you need to complete an application. The application can be downloaded at:
<http://www.ipo.gov.uk/df2a.pdf>

You can deliver it by hand or send it by post to the Intellectual Property Office, Concept House, Cardiff Road, Newport, South Wales, NP10 8QQ.

- The application for a design registration must contain a complete set of illustrations of the design, which can be drawings or photos or, in some cases (where the design is on a flat surface), samples.
- Payment should be provided with the application and may be included via a cheque made payable

to the Intellectual Property Office or by using a credit or debit card.

- Applications must be submitted to the Intellectual Property Office on form DF2A.

Costs (at the date of publication)

The application fee is 60 GBP.

On receipt of an application together with a fee, an examiner will check it and decide if it is acceptable. The application fee covers the examination procedure and the 5-year protection period for the design.

Every 5 years, the design protection can be renewed for another 5 year-period by paying renewal fees (2nd period 130 GBP, 3rd period 210 GBP, 4th period 310 GBP and 5th period 450 GBP.

For updated and more detailed figures, please refer to www.ipo.gov.uk

Examination

On receipt of an application together with a fee, an examiner will check it and decide if it is acceptable.

A letter is then sent to the applicant (normally within 2 months) with the results of the examination.

If there are objections to the design, there is an opportunity to challenge objections raised.

If the examiner does not object to the design, or if the applicant is able to successfully challenge the objections, the design is registered in the UK Designs Register and is published in the Registered Designs Journal.

It normally takes around 3 months for a design to become registered.

Duration

The protection of a design lasts for 5 years from the date of registration. If an applicant wishes to extend the period of protection, it can request a 5-year renewal every 5 years. However, the protection of a design lasts for a maximum of 25 years.

Ownership of the right

The design right resulting from registration confers the exclusive right to use the design and to authorise others to use it. It also includes the right to make, offer, put onto the market, import, export, or use a product in which the design is incorporated or to which it is applied, or to stock such a product for those purposes.

Trade mark rights

Applicable Laws

The Trade Marks Act 1994
<http://www.ipo.gov.uk/tmact94.pdf>

What can and cannot be protected?

It is possible to register any sign capable of being graphically represented. These marks may be one or a combination of words (including slogans), letters, and numerals. They may consist of drawings; symbols; three-dimensional signs, such as the shape and packaging of goods; audible signs, such as music or vocal sounds; fragrances; or colours.

In the UK, it is not possible to register trade marks that:

- describe your goods or services or any characteristics of them;
- have become customary in your line of trade;
- are not distinctive;
- are 3-dimensional shapes, if the shape has a function or adds value to the goods;
- are specially protected emblems;
- are offensive;
- are against the law, for example, promoting illegal drugs; or
- are deceptive.

For more information on this subject, go to:

<http://www.ipo.gov.uk/types/tm/t-about/t-whatish.htm>

Formalities

To file an application for the registration of a trade mark, it is necessary to:

- Make sure the trade mark is a distinctive word, logo, picture or other sign that clearly identifies the specified goods and services from those of other traders;
- Check whether someone else has already registered or applied to register a similar mark for similar goods or services;
- Decide which classes of goods or services you require in accordance with the Nice classification list;
- Fill out the form. Applicants can file an application for registration with help from: <http://www.ipo.gov.uk/types/tm/t-applying.htm>
- Deliver it by hand, file online <http://www.ipo.gov.uk/types/tm/t-os/t-os-forms/tm3-introduction.htm>, or by post.

Costs (at the date of publication)

Filing fee first class	200 GBP
Additional class	50 GBP

Renewal Fees (every 10 years)

Renewal fees first class	200 GBP
Additional class	50 GBP

For updated and more detailed figures, please refer to www.ipo.gov.uk

The filing fee covers the examination procedure of the trade mark and a 10-year period of protection for the trade mark.

Every 10 years, the trade mark protection can be renewed for a new 10-year period by submitting to the office a renewal fee of 200 GBP for one class (plus 50 GBP per additional class).

Renewal should be requested during the final 6 months of the current registration validity period.

Examination

After the application is filed, it is examined in accordance with the Trade Marks Act and, if accepted, is

published in the trade mark journal, allowing others to make observations on its acceptance or oppose its registration.

At the end of the opposition period of 6 weeks, if there have been no objections or challenges have been rejected, the trade mark will automatically go forward to become registered.

A certificate of registration is issued and guarantees the protection of the trade mark.

Duration of protection

The registration is valid for 10 years from the date of application. This period is renewable indefinitely for additional 10-year periods.

Ownership of the right

The registration of a trade mark bestows upon its owner the following rights:

- The option to prevent third parties from using without the owner's consent any sign, the same or similar on products or services for which the trade mark has been registered;
- The option to use the ® symbol to dissuade potential infringers;
- The option to sell or transfer ownership or grant licenses to a third party to exploit the trade mark for a fee.

Patent rights

Applicable Laws

The Patents Act 1977

<http://www.ipo.gov.uk/patentsact1977.pdf>

What can and cannot be protected?

Protection can be awarded if a product is new, involves an inventive step and has an industrial application.

A patent cannot be granted for:

- a scientific or mathematical discovery, theory or method;
- a literary, dramatic, musical or artistic work
- a way of performing a mental act, playing a game or doing business;

- the presentation of information, or some computer programs;
- an animal or plant variety;
- a method of medical treatment or diagnosis;
- something that goes against public policy or morality.

Formalities

An application for a patent can be made online. It is also possible to download a file and submit it by hand, by fax or by post. For more information visit: <http://www.ipo.gov.uk/types/patent/p-applying/p-apply.htm>

A patent application should include:

- a description containing enough information for others to create your invention;
- drawings showing the technical features and construction of your invention;
- an abstract, a short summary, of up to 150 words, of your invention which includes all of the most important technical features of your invention;
- claims, a definition in words of the invention that you want to protect;
- an address in the UK to which correspondence can be sent.

Costs (at the date of publication)

Filing fee	30 GBP
Search fee	100 GBP
Examination fee	70 GBP

Maintenance Costs in 2009:

Year 5	50 GBP	Year 13	210 GBP
Year 6	70 GBP	Year 14	230 GBP
Year 7	90 GBP	Year 15	250 GBP
Year 8	110 GBP	Year 16	270 GBP
Year 9	130 GBP	Year 17	300 GBP
Year 10	150 GBP	Year 18	330 GBP
Year 11	170 GBP	Year 19	360 GBP
Year 12	190 GBP	Year 20	400 GBP

The filing fee is 30 GBP, but this can be paid within 12 months. The search fee is 100 GBP, and the examination fee is 70 GBP.

No further fees are required until the 4th year when an annual renewal fee is required.

For updated and more detailed figures, please refer to the www.ipo.gov.uk

Examination

A patent is not automatically granted. Once the application is filed:

- A formal examination needs to be done within 12 months of the application date at which time the application is examined against published patents and documents to verify that the invention is new and inventive.
- 18 months after the application date, the invention is published in the patent journal.
- A request for examination must be made within 6 months of the publication date, at which time the application is examined for any deficiencies.
- If these deficiencies can be overcome, the application will be approved. The patent will be re-published in its revised format.

Duration of protection

The duration of a patent is 20 years from the filing or priority date.

Ownership of the right

The granting of a patent confers upon its owner the following rights:

- the option to prevent third parties from making, manufacturing, selling, importing or exploiting the protected product or process without the owner's consent;
- to exploit the invention in any part of the country;
- the option to label products as protected to deter potential infringers by using the wording patented or patent number;
- the option to transfer the right or to grant licenses to third parties to exploit the invention for a fee.

What to do if I am copied (designs, trade marks, patents)

As an IP rights owner, you can show your IP is protected and take legal action using provisions of civil law to seek injunctions and/or claim damages if your IP right is infringed. You should seek advice from a legal professional, such as a patent attorney, before entering into any disputes.

It may be worthwhile, however, to try to work out a solution with the infringer before taking any potentially costly legal action, for instance through mediation.

The unauthorised use of your IP is a criminal offence in some instances and can lead to prosecution under Section 94 of the Trade Mark Act in relation to trade mark infringement. If there is sufficient evidence, the UK police or trading standards officers can launch criminal proceedings under trade mark law. The Intellectual Property Office is not responsible for policing the Register of Trade Marks.

If you suspect someone is passing off, infringing, or counterfeiting goods or services under your mark, we recommend that you consult your local trading standards office. You can find details for your local trading standards service on its Web site: www.tsi.org

You can also seek appropriate professional help from a solicitor or a trade mark attorney.

A guide book entitled The Supply Chain Tool Kit has been produced in conjunction with the national IP Crime Group to increase awareness of IP crime in legitimate business supply chains and offer advice on how to strengthen and protect IP assets.
<http://www.ipo.gov.uk/ipctoolkit.pdf>

Further information can be found at:

<http://www.ipo.gov.uk/types/design/d-manage/d-useenforce.htm>

<http://www.ipo.gov.uk/types/patent/p-manage/p-useenforce.htm>

Copyrights and related rights

Applicable Laws

The Copyright, Designs and Patents Act 1988.
<http://www.ipo.gov.uk/cdpact1988.pdf>

What can and cannot be protected?

Copyright protects independently created artistic and creative works, which include:

- written works, novels, newspaper articles, lyrics for songs, instruction manuals;
- dramatic works, dance, mime;
- musical works, sound recordings;

- artistic works, photographs, sculptures, films and broadcasts;
- software and databases.

Formalities

There is no official registration system for copyright in the UK. As long as the work is created and fixed in some fashion, for example in writing, an original work qualifies for copyright protection if it falls into one of the categories of material protected by copyright.

Costs

There are no fees for copyright protection in the UK.

Examination

Not applicable.

Duration of protection

The length of time a copyright work is protected depends on the category or type of work and is usually calculated from the death of the creator.

Written, theatrical, musical, artistic and film:

- life of the creator plus 70 years from the end of the year of death

Sound recordings:

- 50 years from the end of the year in which it was made or, if published in this time, 50 years from the end of the year of publication

Broadcasts:

- 50 years from the end of the year the broadcast is made

Published editions

- 25 years from the end of the year in which the edition was first published

Protection cannot be extended beyond these periods.

Ownership of the right

In general, copyright belongs to the creator or author of the work. The law provides for exceptions, such as in the case of employment, collective or joint works or works done by contract or order.

The ownership of copyright gives the following rights to authorise or prohibit any of the following things in relation to their works:

- copying the work in any way;
- issuing copies of the work to the public;
- renting or lending copies of the work to the public;
- performing, showing or playing the work in public;
- broadcasting the work or other communication to the public by electronic transmission;
- making an adaptation of the work;
- the option to transfer the right or to grant licenses to third parties to exploit the invention for a fee.

What to do if I am copied (copyrights and related rights)

Copyright is essentially a private right, so decisions about how to enforce your right, such as what to do when your copyright work is used without your permission, are generally for you to take.

If the whole or a substantial part of your work has been used without your permission and none of the exceptions to copyright apply, your copyright is said to have been infringed.

Although you do not have to, it is usually a good idea and will save you time and money if you try to resolve the matter with the party you think has infringed your copyright. In some cases, it may be necessary to demonstrate to the court that you have tried to solve the matter with the other party, for instance through mediation, before starting court proceedings.

If you cannot resolve the matter with the other party, going to court may be the right solution. But it would be a good idea to seek legal advice at an early stage and to consider alternative solutions, such as mediation.

One of the many organisations representing copyright owners may also be able to give you advice or, if you are a member, sometimes act on your behalf.

If you do go to court, the courts can:

- stop that person from making further infringing use of the material by granting an injunction;
- award the copyright owner damages;
- make the infringing party surrender the goods to the copyright owner.
- Deliberate infringement of copyright on a commercial scale may be a criminal offence, which means additional solutions are available.

A guidebook entitled The Supply Chain Tool Kit has been produced in conjunction with the national IP Crime Group to increase awareness of IP crime in legitimate business supply chains and offer advice on how to strengthen and protect IP assets.
<http://www.ipo.gov.uk/ipctoolkit.pdf>

Unregistered design in the UK

Applicable Laws

The Copyright, Designs and Patents Act 1988.
<http://www.ipo.gov.uk/cdpact1988.pdf>

What can and cannot be protected?

The UK unregistered design protects the internal or external shape or configuration of an original design

It is not possible to protect any of the two-dimensional aspects of a design, such as patterns, but these may be protected by copyright or registered designs.

Formalities

An unregistered design is an automatic right for which there is no registration system. The right exists as soon as the design is created, but it may be wise to keep a note of when the design was first recorded in material form and when products made to the design were first made available for sale or hire.

Costs (at the date of publication)

There are no costs associated with unregistered designs.

Examination

Not applicable.

Duration of protection

An unregistered design lasts either 10 years from the first marketing of products that use the design, or 15 years from the creation of the design, whichever is earlier. For the first five years, the owner can stop anyone from copying the design. For the rest of the time, the design is subject to a licence of right. This means that anyone is entitled to a licence to make and sell products copying the design.

Ownership of the right

An unregistered design gives the owner the right to stop anyone from copying the shape or configuration of the product.

Actions at customs

How do the customs authorities act?

Applicable Laws

- EC Regulations no. 1383/2003;
- Goods Infringing Intellectual Property Rights(Customs) Regulations 2004
- Trade Marks Act 1994
- Trade Marks(Customs) Regulations 1994
- Copyright, Designs and Patents Act 1988
- Copyright (Customs) Regulations 1989.

The Council Regulation (EC) No. 1383/2003 allows a right holder to lodge an application with the UK HM Revenue and Customs to prohibit entry into the community and the exportation or re-exportation from the Community of counterfeit and pirated goods and goods infringing:

- patent;
- national or Community plant varieties;
- designations of origin; or
- geographical indications and geographical designations.

Procedures

If you want customs actions in the UK you should

- complete form C1340 (Intellectual Property Rights Application), or
- if you want customs action in two or more member states, complete form C1340A (Community Intellectual property Rights Application).



When you submit an application, you must complete and sign both parts of the form including the declaration in Annex 1B (or Annex IIB for Community request)

Forms are available at:-
<http://customs.hmrc.gov.uk>

You must provide:

- a detailed description of the goods to enable customs to recognise them;
- any specific information you may have concerning the type or pattern of fraud;
- name and address of person to contact;
- proof that you hold the rights.

Applications should be sent to customs:

- 30 working days before you expect infringing goods to be imported or exported; or
- Before you want the monitoring period to commence.

If you have not filed an application, you may be notified of suspected infringing goods discovered during the course of customs checks, and invited to submit an application within three working days. Customs authorities are permitted to detain the suspected infringing goods for three days pending an application and no longer. Failure to lodge an acceptable application within this period will result in the release of the goods.

Applications should be sent to:
HM Customs & Excise
Intellectual Property Rights
Bowman House
100-102 Talbot Street
Nottingham, NG1 5NF

You will not be charged a fee for applications submitted under EC Regulation, but you will be liable to pay all costs incurred, for example storing and destroying goods. You must also indemnify customs against action by the owner if it is determined that the goods do not infringe an IP right.

Main contacts

To prevent possible infringements of your intellectual property rights, you should contact HM Revenue & Customs, complete the appropriate form and provide accurate information on the products and rights to be protected.

For further information on procedures, applications and general advice, contact HM Revenue & Customs:

- Tel.: +44 115 971 2113 (Applications Unit)
- Tel.: +44 1702 367980 (Policy Information)

Email: intenquiries@hmrc.gsi.gov.uk

Alternative ways to deal with infringements

The IPO has launched a mediation service that helps companies and individuals involved in IP disputes. Mediation is an alternative form of dispute resolution and allows opposing parties to talk about their disputes and to reach an agreement without the need for a court hearing.

The following are examples of when mediation is possible:

- Disputes about licensing of IP rights;
- Concerns about infringement of rights;
- Trade mark opposition and invalidation proceedings;
- Disputes over patent entitlement;
- Disputes over trade mark/patent ownership;
- Disputes over inventorship.

The IPO will invite parties to consider mediation as opposed to litigation. The parties can select any mediator they choose, and the IPO has a number who have been accredited.

For further details contact:
Mediation
Room GY62, Concept House
Cardiff Road, Newport, NP108QQ
Telephone 01633 811010
Email: sas@ipo.gov.uk

Contact the National Patent Office:

UNITED KINGDOM
The Intellectual Property Office
Concept House
Cardiff Road, Newport
South Wales, NP10 8QQ
United Kingdom
www.ipo.gov.uk
enquiries@ipo.gov.uk
+ 44 (0) 8459 500 505



Other Factsheets





China

China became a member of the World Intellectual Property Organization in 1980 and acceded to some international intellectual property treaties, such as the Paris Convention. After joining the World Trade Organization in 2001, amendments and changes to the Chinese Patent, Trade Mark and Copyright laws were needed to comply with the Trade Related Aspects of the Intellectual Property Rights (TRIPs). The Chinese intellectual property system tends to be in line with international practice but challenges remain, especially with regard to counterfeiting and piracy. Amendments to the legislation are scheduled.

Protection under patent law: design and patent

Applicable Laws:

The Patent Law of 1992 and 2000 and their Implementing Regulations, effective from 28/12/2002; the third Amendment of Patent Law, effective from 01/10/2009. Unlike the European system, Chinese Patent Law also includes industrial designs, which can be registered as a *Design Patent*.

What can be protected:

Invention patent protection: applies to a new technical solution relating to a product, a process, or the improvement of a product or process. The invention shall possess novelty, inventiveness and be applicable. There is a long process of substantive examination before an invention patent is granted.

Utility model patent protection: applies to a new technical solution related to the shape or structure of a product or a combination thereof. This patent category is unusual and particular to the Chinese patent law system. There is no substantive examination before ownership rights are granted to the inventor for a utility model patent.

Design patent protection: applies to a new design of a product's shape or structure or the combination of its colour, shape and/or structure, provided that: the features of the shape and configuration of pattern or ornamentation are suitable for industrial application or use; the features are of aesthetic effect, i.e., not for technical or functional effect. Protection is granted as long as the design is not identical or similar to any design disclosed either in China or elsewhere, in publications anywhere in the world and does not infringe any prior right of any other person. Both utility model and design patents concern the appearance of the product, however **utility model** patents focus on shape for its technical effect while **design** patents focus on shape for its aesthetic effect. Unlike some European patent laws, Chinese patent law does not expressly state whether textures or materials can be registered as a design. However, in practice, if the texture or material is sufficiently original, it will be automatically protected by **copyright**. In addition, it is possible to register a texture or material as a utility model patent, knowing that the validity of the patent may be challenged in the future by a third party as there is no examination for granting such a patent.

Formalities:

Design protection and utility model protection: can be obtained by filing a patent application with the State Intellectual Property Office (SIPO). China is a first-to-file jurisdiction (see below under Good to know). SIPO conducts a review before issuing the certificate of patent and publishing that right in the *Patent Gazette*. The publication includes data contained in the design patent request and an abstract of the description, along with the drawings or images of the design. The patent enters into effect on the date of publication. Upon notification from SIPO, the applicant generally has two months to complete the relevant administrative procedures, including payment of initial fees, to secure the patent. If they're not completed, the design patent is deemed aban-

done. The process takes about six months from the filing date. In contrast to invention patents, the application process for design and utility models does not include a substantive examination.

Invention patent protection: the examination and approval process is done by the Patent Administration Authority of the State Council. The application is published within 18 months, after a preliminary examination. The applicant then has 3 years to request that a substantive examination be performed. Overall, it takes about two to three years for the Patent Administration Authority to grant a patent.

Costs

Standard fees for a **Design and utility model:** 500 RMB. For an **Invention Patent:** 900 to 4,000 RMB.

In addition, an annual fee (also called a “maintenance fee” or “renewal fee”) shall be paid, starting from the year which the patent right is first granted. The fee increases annually, depending on the period of time for which the design has been protected:

Annual fees for an invention patent (RMB)	
From the 1 st to 3 rd year	900/year
From the 4 th to 6 th year	1,200/year
From the 7 th to 9 th year	2,000/year
From the 10 th to 12 th year	4,000/year
From the 13 th to 15 th year	6,000/year
From the 16 th to 20 th year	8,000/year

Annual fees for a utility model/design (RMB)	
From the 1 st to 3 rd year	600/year
From the 4 th to 5 th year	900/year
From the 6 th to 8 th year	1,200/year
From the 9 th to 10 th year	2,000/year

Duration:

10 years for a design patent or utility model, starting from the date the patent application is filed with SIPO. The same is true if the application is based on a foreign-priority right. The term of protection of an invention is 20 years from the date of filing.

Ownership of the right:

The owner of the patent may not be the inventor but the person responsible for providing financial

support or technical facilities. A patent can be transferred within the scope of an employment contract or by a transfer contract.

Enforcement:

What are my options if I am infringed and have protected my rights?

Two legal actions are possible: judicial and administrative.

Judicial action: The competent court for patent disputes is the Intermediate People’s Court of the locality of the infringement or the locality of the defendant. The compensation liability of the infringer can be established and calculated based on the losses caused by the infringement or the illegal gains obtained by the infringer.

Administrative action: The owner can bring an action before the Administration of Industry and Commerce, charged with investigating complaints. The competent administration is usually that situated in the location where the infringement takes place or where the counterfeiting goods are stored or seized. Although such action does not provide compensation, the administration may: stop the infringement; confiscate the illegal income from the infringement; confiscate infringing duplicates; impose administrative fines.

What are my options if I am infringed and have not protected my rights?

Alleging infringement of a non-registered invention or design is difficult without patent rights. For designs, the only option would be to allege copyright infringement since no registration is necessary to claim an authorship right through **copyright**. For invention and design, another possibility would be to base a legal action on the **Chinese Unfair Competition Law**. This requires proof that this law has been violated and a loss suffered. In practice, it may be difficult to obtain a favourable decision based on this alone.

Good to know:

It is important to file as early as possible to avoid losing rights to a patent.



Protection under trade mark law

Applicable Laws:

The Trade Mark Law in force since 01/12/2001 and the Regulations on Implementation of Trade Mark Law, 03/08/2002.

What can be protected:

Any visually perceptible sign, including words, figures, letters, numbers, three-dimensional signs, colour combinations, or combination of the above that has distinctive characteristics and is easy to distinguish can be protected as a trade mark. The following may not be used as a trade mark and registered as such: names similar to the state name, national flag, emblem, medals of the People's Republic of China, specific names or places where Central State authorities are located, or the name and image of landmarks; those already registered or infringing a third party's rights; those with a racially discriminatory nature or an exaggerated or deceptive nature; those consisting exclusively of the generic name, depiction or model number of the goods concerned or lacking distinctiveness.

Formalities and examination:

The application for the registration of a trade mark shall indicate the class of the goods and the designation of goods with respect to which the trade mark is intended to be used. If the trade mark is to be used on other goods in the same class, a separate application must be filed. The application is presented to the Trade Mark Office. Preliminary approval is usually received within 15 months of the application date. The approved application will then be advertised in the *Trade Mark Gazette* for a three-month opposition period. If no opposition is filed within this period, or if the Trade Mark Office finds the opposition not well founded, the Trade Mark Office will issue a registration certificate. In practice, the registration process takes 24-36 months.

Costs:

Applicants are required to pay a filing fee of approximately 1,000 to 2,000 RMB per application in each class or for each additional application for a single mark in other classes. In addition to these costs, it is necessary to take into consideration the cost of a

search for a priority trade mark and the fees of the trade mark agent (mandatory for a foreign person or entity to complete a registration). Such fees and costs are established by each trade mark agent.

Duration:

Protection for 10 years from the issuance of the certificate and possible renewal for further protection before the expiration of the initial term or, at the latest, within the first six months following the expiration. In the absence of renewal, the same trade mark may not be registered during one year. Finally, if the trade mark is not actually used for a continuous period of three years, a party or the Trade Mark Office can ask for its cancellation. The absence of use must be established by relevant details, such as a market survey stating that the mark is not known to the public. However, any use (commercial advertising or activities) is sufficient to refute the presumption of non use.

Ownership of the right:

depends on the name(s) mentioned on the registration form.

Enforcement:

What are my options if I am infringed and have protected my rights?

In the event of an infringement of a trade mark, the right holder may request a preliminary injunction for property preservation measures from the People's Court. The civil jurisdiction will make a ruling within 48 hours. A request can be brought before the administrative Technical Supervision Bureau, which can investigate and confiscate the fake product on site without a warrant or a lengthy procedure. In addition, there are two other legal actions:

Judicial action:

Within two years of the date the owner is aware or should be aware of the infringement, a civil action before the People's Court can be brought to seek damages. The damages are generally equal to the profits gained by the infringer or the losses incurred by the owner. Statutory damages are also available in cases involving the infringement of a registered trade mark, up to 600,000 RMB.

Administrative action:

The owner can bring an action before the Administration of Industry and Commerce to investigate and order: the ceasing of infringement; confiscation of the illegal income from the infringement; confiscation of duplicates; imposition of administrative fines (no damages granted).

What are my options if I am infringed and have not protected my rights?

If the trade mark is not registered and the certificate of trade mark duly issued, it will be difficult to claim any infringement of one's rights in China, unless the trade mark can be considered a **well-known trade mark**. For inventions and designs, another possibility would be to base a legal action on **Unfair Competition Law**. This requires proof of the violation of this law and loss suffered. In practice, it may be difficult to obtain a favourable decision based on these legal grounds alone. A well-known trade mark benefits from recognition regardless of registration. This can prevent others from registering a similar trade mark and from incorporating it to a company name. The trade mark owner may apply for protection of its well-known trade mark in China using the following means: raising an objection with the Chinese Trade Mark Office; requesting the cancellation of a registration or applying to the local Administration of Industry and Commerce to stop the illegal use. In infringement cases, courts or administrative bodies tend to grant larger awards to owners of well-known trade marks, and subject infringers to more severe punishment.

Good to know:

The Chinese Trade Mark Law imposes a first-to-file rule to obtain rights. Prior use of an unregistered trade mark does not grant any right unless it is a well-known trade mark. However, if two similar trade marks are filed the same day, approval will be given to the trade mark first used in commerce.

Protection under copyright law

Applicable Laws:

The Copyright Law of 27/10/2001 and its Implementing Regulations of 02/08/2002.

What can be protected:

The definition of a work protected by copyright is not exhaustive under Chinese law and concerns all creation and inventive work. It specifically includes "*graphic works such as drawings of engineering designs, drawings of product designs, maps, schematic drawings etc...and three-dimensional model works*". The shape of a shoe or a perfume bottle can, for example, be protected.

Formalities:

Although no registration is necessary for an author to hold a copyright on an original work, registration can be filed with the State Copyright Bureau of the State Council, which handles registration for overseas authors or copyright owners. Registration is a simple process and is highly advisable as it strengthens a copyright. The following documents are required: application forms; identity certificate for the applicant; description of the work; pledge letter for the right; sample of the work and any documents showing the copyright (ex: agreements).

Costs and Time:

The State Copyright Bureau will complete the examination and issue the registration certificate within a month of receiving the application. Registration fees range from 100 to 1,000 RMB for each registration. The fee amount depends on the nature of the work (musical, written or architectural work, etc.) and whether it is requested by an individual or a legal entity (for instance: up to 200 RMB for a company). Furthermore, it also depends on the length of the work.

Duration:

Perpetual for the moral rights of an author (including the right of attribution, revision and integrity of a work). For the economic rights (including the right to use, display, broadcast, reproduce and market the work), it is the author's lifetime plus 50 years after the author's death if the author is an individual, and 50 years from the first publication if the author is a legal entity.



Ownership of the right:

The author of the work is automatically the owner of the right. However, it is possible to transfer ownership to a third party in the scope of an employment contract or a transfer agreement.

Enforcement:

What are my options if I am infringed and have protected my rights?

Two types of legal action are available with regard to copyrights: administrative action or judicial action.

Administrative action:

The National Copyright Administration and its national and local offices can hear copyright-related cases. The competent administration is usually situated in the location where the infringement takes place or where the counterfeiting goods are stored or seized. Although such action does not provide compensation, the administration may impose the following punishments/orders: stop the infringement; confiscate the illegal income from the infringement; confiscate duplicates; apply administrative fines.

Judicial action:

The competent People's Court is the court where the infringer resides, where the infringement has been performed, or where the infringement results occurred. In addition to the measures described above, the court may grant damages to compensate the plaintiff. The court can order the infringing party to pay damages based on the actual loss incurred by the rights holder. In practice, if the actual losses are difficult to evaluate, the damages can be based on the illegal income earned by the infringer. If neither can be established, the court may award damages up to RMB 500,000.

What are my options if I am infringed and have not protected my rights?

Even if the copyright has not been registered in China, the ownership of the right is automatically granted to its author. Registration is not a prerequisite to bring a legal action for infringement of copyright,

but it may be more difficult to prove ownership without registration.

Good to know:

The copyright law protects works upon their creation, regardless of whether or not the author is Chinese. The registration of the work before the Copyright Office does not enhance or change the automatic copyright protection, but does enable third parties to oppose it.

Customs law in China

Applicable Laws:

Customs Law, 08/07/2000; Regulations on Customs Protection of IPR, 01/03/2004, and Circular on its implementation, 01/07/2004. On 05/06/2008, the State Council issued an 'Outline of the National Intellectual Property Strategy' emphasizing that China will strengthen customs law enforcement and border protection to maintain order in imports and exports and improve intellectual property protection. A draft of the Implementing Measures on Customs IPR Protection is being written and could be voted on in 2009.

How can I ask customs to defend my rights?

Recording IP rights with Chinese customs is not mandatory to obtain protection, but it is highly recommended.

Formalities:

Registration of IPR shall be made with the General Administration of Customs (GAC). The right holder files an application with the GAC by presenting the necessary documents, including the application form, certificates, copy of the business licence, and photos of the goods and packaging. Within 30 days, the GAC notifies the applicant of its decision on whether or not to archive the registration and provides the full package application. IP owners can check and amend their registration online: www.customs.gov.cn.

Costs and Duration:

The cost for registering one right is RMB 800. An extension by renewal of the record is free of charge. In addition, the cost of the seizure or deposit should also be considered (see below). Registration is valid for 10 years and can be renewed six months prior to the expiration of the term. The extension term is also 10 years. But this term will not extend beyond the expiration of the IP right registration.

Enforcement:

Request by the IPR holder for an unrecorded IP right:

If the IPR holder discovers that suspected infringing goods are about to be imported or exported, he can request that customs detain the goods. An application letter and evidence of the ownership of the rights should be brought to customs.

In addition, the holder shall provide a financial guarantee equivalent to the value of the detained goods. If the request of seizure happens to be justified, the guarantee shall be returned to the IPR holder.

Discovery by Customs of a recorded IP right:

Customs will notify an IPR holder in the event that any suspected infringing goods are discovered. Within three days of receipt of the notice, the holder shall revert to customs and either: request the seizure of the suspected goods or state his willingness not to seize the goods and the reasons for that decision. In practice, this time is often too short to consider all aspects involved and to take a wise decision.

A guarantee shall be paid by the IPR holder upon each notice of suspected goods, based on the value of said goods. Another option is to pay a general guarantee of up to RMB 2,000, which is valid until 30th June of the following year and subject to revaluation each year.

Good to know:

Recording an IP right with customs is no longer a precondition for detention of infringing goods, but it allows IPR holders to obtain the most protection since, in the absence of prior registration, customs requires

a separate deposit to detain the shipment and will detain the goods beyond 20 days unless the IP owner obtains a preliminary order from the Chinese Court. Therefore, if the import/export of counterfeit goods is suspected or expected, it may be advisable to register with customs.

Protection Of Trade Secrets

The main category of non-registerable rights is **trade secrets**, which are defined as technical and management information, unknown to the public, that is of practical value and for which the holder has taken measures to maintain confidentiality.

The Chinese Unfair Competition Law

Provides protection for non-registered rights and prohibits business operations from engaging in any of the following activities:

- Obtaining trade secrets by theft, duress, or other illegal means;
- Disclosing, using, or allowing others to use trade secrets obtained by illegal means;
- Disclosing, using, or allowing others to use trade secrets in breach of an agreement.

If you suspect an infringement of your trade secrets, you can bring a civil proceeding before the People's Court and seek compensation for damages. You can also bring an administrative action before the Administration of Industry and Commerce (AIC) which may order the infringer to cease its actions and impose a fine between 10,000 and 200,000 RMB. In addition, appropriate measures can be taken by the IPR holder, such as entering into a confidential agreement, requesting that employees abide by internal rules and confidentiality obligations. Any non-disclosure agreement or confidentiality agreement shall be set forth in a legally binding contract.

Case Study

A European company specialised in garments relocated its sourcing to China. Most of its collections were designed and manufactured in China but sold in European stores. In 2006, the company noticed that the exact same original fabrics (including the texture and pattern) were used for other clothing products (in different shapes, designs and collections of garments) under a different trade mark. Considering the large number of products in each collection, the com-



pany had decided it was too expensive to register the drawings or designs of the collection in Europe or in China. However, the company decided to take legal action against the suspected manufacturing company, to cease this use of the fabrics.

As the company had no formal IPR registration in China, the legal grounds for such action could only be based on copyright and on Unfair Competition Law. The company chose an administrative action since it was thought to be less expensive and quicker. In addition, the loss was difficult to evaluate and the reward of damages therefore uncertain. The action for copyright infringement was brought to the local Administration of Industry and Commerce where the infringing manufacturing company was based. The company brought the following evidence: drawings, previous collections using the same pattern, invoices to the manufacturing companies, comparison between both products and fabrics. Upon inspection, the AIC ordered the infringing manufacturer to stop using the same fabrics and patterns for other clients and ordered a fine of 50,000 RMB. In addition, the company and the manufacturer ended their cooperation.

Key administrations/contacts

Department	Official names	Contact
SIPO	State Intellectual Property Office	http://www.sipo.gov.cn/sipo2008 Tel: 010-62083114, 010-62356655, 010-62083608
Trademark Office	China Trade Mark Office (CTMO)	http://202.108.90.72/trade-e/index.jsp Tel:010-88650000, 010-88651802
Copyright Bureau of the State Council	National Copyright Administration	http://www.ncac.gov.cn/GalaxyPortal/inner/bqj/index.jsp Email: copyright@ncac.gov.cn
General Administration of Customs (GAC)	General Administration of Customs	http://www.customs.gov.cn/publish/portal0/ Tel:010-65194114, 010-65195489, 010-65195584
AIC in Shanghai	Administration of Industry and Commerce	http://www.sgs.gov.cn/sgs/en/index.jsp Tel:021-64220000

India

Protection under Design Law

Applicable Laws

The Designs Act of 2000 and the Design Rules of 2001 constitute the basis for design protection in India. India is not a member of the Hague System for international registration of Industrial Designs so it is not possible to use this system for design protection in India.

What can and cannot be protected?

The following criteria need to be met to obtain design protection in India.

- The design must:
- be new or original;
- not be previously published in any country;
- be reproducible by industrial means;
- not be contrary to public order or morality;
- be significantly distinguishable from known designs or combinations of known designs;
- not be comprised of or containing scandalous or obscene matter, appealing to the eye;
- not fulfil a mere technical function, but respond to certain aesthetical features.

According to Indian law, design protection is not available to those not residing in India or not represented through an agent residing in India.

Formalities

The design application needs to contain the full name, address and nationality of the applicant, and an address for services in India. It needs to be accompanied by drawings, photographs from all angles, 5 copies of each pose, a list of countries to claim the priority (if any), where the application for design has been filed, along with the date and application number, the class in which the application is to be filed, and the name of articles to which the design is

to be applied.¹ The Design Office can assist in searching design databases, to help gain an understanding what type of designs are already protected in India. Be careful: India does not date an application until the accompanying fees are received by the IP office.

Best contact if you have further questions:

Assistant Controller of Designs
Design Office
7th Floor, 2nd MSO Building
Nizam Palace, J.C. Bose Road
Kolkata 700 020
Tel.: +91 33 281 3421
Fax: + 91 33 281 3423

Costs

Application for design registration for: 1000 Rs

Extension of copyright: 2000 Rs

An in-depth overview of fees can be found in the A.J.C. Guidelines for Registration which can be downloaded for free on the Web site of the Indian IP office.²

Examination

The application is examined and any objections raised by the Design Office. Once all objections are removed, the office issues the design protection. The design application is then published in the Official Gazette and published in the register of Designs. This takes an average of 6-12 months.

1. Premier Registration Service: Trade Marks In India <http://www.patentindia.org/design.htm>

2. <http://ipindia.nic.in/ipr/design/designs.htm>

Duration of protection

Design protection is granted for 10 years, but can be extended by an additional 5 years. Don't forget, if you do not pay the renewal fees for your design application, your protection is void. So pay your renewal fees on time.

Ownership of the right

Under normal circumstances, the creator of the design is the owner. If, however, the original creator of the design has done this work in the context of his/her employment, the employer owns the design, unless otherwise specified in the contract. It is also possible to transfer the design right to a third party, but you need to state this in the contract.

Good to know

India follows a "first to file" system. Therefore, you need to make sure that you apply for registration as soon as you can so nobody else claims that design before you. Also, make sure you file for the application before you publish your design, otherwise the IP office will not give you the necessary protection.³

The flip side to this is that you don't need to prove that your design has a commercial use at the time of filing.

Protection under trade mark law

Applicable Laws

Trade mark law in India is governed by the Indian Trade Mark Act of 1999. India is a member of the Madrid Protocol for the international registration of trade marks (see the part of this Guide on international protection).

What can and cannot be protected?

In India, the following subject matter qualifies for trade mark protection:

- Any name, including a personal or surname of the applicant or predecessor in business or the signa-

ture of the person, which is not unusual for trade to adopt as a mark.

- An invented word or any arbitrary dictionary word or words that are not directly descriptive of the character or quality of the goods and services.
- Letters or numerals or any combination thereof.

You can qualify your mark for trade mark protection either by filing an application or by using the mark on goods and services in the course of business.

Trade mark registration is usually refused if the mark is merely descriptive or deceptive, if it is just a surname or merely ornamental, if it is customary in current language, if it is offensive to religious feelings or any class of Indian society, or if it is scandalous or obscene.

Formalities

The following documents must be submitted to obtain trade mark protection in India:

- The full name, address and nationality of applicants;
- Description of trade mark, one copy if the mark is in label form;
- List of all items, be they good or services to which the mark is applied or proposed to be applied;
- Date since which it has been used if the mark is already being used in India;
- List of countries where the mark is to be protected. Do not forget to put a date on this list, so you can be assured that your application has precedence over potential applications filed after your date of filing.

The Indian Patent Office offers an overview of forms that need to be filled out.

Costs

The filing of a trade mark costs 2,500 Rs per class. The renewal of a trade mark costs 5,000 Rs per class.⁴

Examination

The completed application is examined and objections are raised by the trade mark office. It usually

3. <http://newdelhi.usembassy.gov/iprdesign.html>

4. http://ipindia.nic.in/tmr_new/FREQUENTLY_ASKED_QUESTIONS.htm

takes 2-3 years to obtain trade mark protection if there are no objections. After any objections are cleared, the mark is advertised in the Official Gazette. The registration certificate is issued 4-6 months after the end of the opposition period. Should there be an opposition, the registration certificate is issued after the opposition is dismissed. Such an opposition may be filed by any legal entity that believes that your application violates its rights. The trade mark office then checks whether these claims are justified. If they are, it may not grant your trade mark, or you may be able to file your application in different classes than that of the trade mark held by these other legal entity, if possible.

Duration of protection

Trade mark protection lasts 10 years, but can be renewed indefinitely. Don't miss the deadlines, and don't forget to pay your renewal fees.

Ownership of the right

Under normal circumstances, the creator of the trade mark is the owner. If, however, the original creator of the trade mark has done this work in the context of his/her employment, the employer owns the mark, unless otherwise specified in the contract. It is also possible to transfer the trade mark to a third party, but you need to state this in the contract. Thus, any person "claiming to be the proprietor" of the trade mark can apply for registration of the trade mark.

Good to know

India follows a 'first to file' system. You do not need to show that you have researched the databases on existing trade marks. However, doing so will give your application more solid grounds and make it less susceptible to challenges by third parties. It is also important to know that in India you can base your application on the mere intention to use the mark at some point.

Even if you have not registered your mark, you still enjoy trade mark protection if you can show that you have used it in your business.

Thus, you can take action against counterfeiting even if you have not filed for trade mark protection.

Protection under patent law, including utility models

Applicable Laws

The main applicable laws are the Patent Act and the Patent Rules. India is a member of the Patent Cooperation Treaty (PCT). Utility patents are not in use in India.

What can and cannot be protected?

You can get a patent in India for the following subjects: art, process, method or manner of manufacture, machine, apparatus or other articles, substances produced by manufacturing, computer software which has technical application to industry or is used with hardware, product patent for food, chemical, medicines or drugs.

You cannot patent inventions that are contrary to public order or morals, movies or TV productions, traditional knowledge, or components relating to traditional knowledge.

Formalities

The Web site of the Indian Patent Office offers a comprehensive and in-depth document entitled "Information for filing a patent application" that explains in great detail all the administrative steps necessary to file patent application. Since 2007, the Indian Patent Office has had an online filing system for patent application. Applications must be filed in either English or Hindi.

The following documents must be submitted to obtain patent protection in India:

- Application form;
- The full name, address and nationality of applicants and inventors;
- Specification, provisional/complete drawings, claims and abstracts;
- List of countries to claim priority (if any), where the application/applications for the granting of a patent has/have been filed, along with date and application number;
- Fee in cash, by local cheque or by demand draft;
- Declaration of inventorship where provisional specification is followed by complete specification or in case of convention application;
- A power of attorney (if filed through a patent agent).

Costs

The application filing fee is 1,000 Rs for an individual and 4,000 Rs for a legal entity for up to 10 claims and 30 pages. Don't forget to pay your renewal fees.⁵

To facilitate payment in U.S. dollars, an account has been opened in New York:

CO/IN in the name of the Controller General of Patents, Designs & Trademarks, with the state Bank of India, New York Branch, 460, Park avenue, New York-NY-10022

Account Number: 21 22-250821-001.

Examination

After a patent application is filed in India, the patent office examines the patent. When the first examination report is issued, the applicant is given the opportunity to correct the deficiencies to meet the objections raised in the examination report. If the applicant misses the deadline to reply to these objections, the application becomes void. If the objections raised can be eliminated, the patent can be granted and it is published in the Official Journal of the patent office, available at www.ipindia.nic.in. This usually takes 18 months. Before a patent is granted and after the publication of the application, any person can oppose your application.

Duration of protection

A patent is valid for 20 years from the date of application. After that, the invention becomes part of the public domain.

Ownership of the right

The patent belongs to the person whose name is entered in the register, the person or persons registered as grantee or proprietor. This ownership gives you the right to license or otherwise deal with the patent so as to extract value from it. Under Indian law, a patent is considered a movable property. Thus, the rules applicable to movable property also apply to patents.

5. <http://ezinearticles.com/?patents-in-india:Law-and-Procedure&id=69217>

Good to know

India follows the "first to file" system, so inventors should be quick to file their applications. The Indian IP office also recommends filing an application before an invention has full commercial relevance. As in the case of trade marks and designs, it is advisable to use a local law firm to ensure that the subject of your application enjoys adequate protection.

Protection under copyright law

Applicable Laws

Copyright in India is governed by the Copyright Act. India is also a member of the Berne Convention and, through this treaty, it extends protection to all copyrighted works originating in any of the convention countries. Foreign works first published in another member country of the Berne Convention are therefore given the same copyright protection in India as Indian works, and there is no need to apply any extra procedures.⁶

What can and cannot be protected?

Copyright is granted for original literary, musical, dramatic and artistic works, cinematograph films, sound recordings and computer programs.

Copyright is not granted for work that is not original, for ideas or concepts, names, short word combinations, slogans, short phrases, methods, plots, or factual information.

Formalities

The fixation of a work in any tangible form automatically enjoys copyright protection. Foreign nationals enjoy the same copyright protection in India. It is not necessary to use the © indication for copyright protection, but it may be used to notify the general public.

The voluntary registration of a copyright is possible through the Copyright Office of the Department of Education in India. Entries made in the Register of

6. Ezine Articles: Copyright in India: Law & Procedure, <http://ezinearticles.com/Copyright-in-India:-Law-and-Procedure&id=73309>

Copyrights may serve as evidence in case of litigation.⁷ A sample of such a form and the entire application process can be found at <http://education.nic.in/copyright.asp>.

Costs

Since copyright is self executing it is free of charge.

Examination

Since copyright is a self-executing right, there is no examination of the subject matter.

Duration of protection

Copyright protection is granted for 60 years after the death of the author or the end of the year in which the work was made, first published, performed etc.

Ownership of the right

Under normal circumstances, the author is the owner of the work. If, however, the original creator of the work has done this work in the context of his/her employment, the employer owns the work. However, it is possible to transfer the copyright to the employee. It is therefore very important to clarify the ownership of copyright in the employment contract. It is also possible to pass the copyright on to a third party, but this must be stated in the contract.

Good to know

The contact details of the copyright office:
Registrar of Copyrights
B.2/W.3, C.R. Barracks,
Asturba Gandhi Marg
New Delhi 110 003
Tel: +91/ 338 43 87

7. Government of India Ministry of Human Resource Development Department of Secondary Education and Higher Education Handbook of Copyright Law, <http://education.nic.in/copyright.asp>

What to do if I am copied?

You may claim infringement of your intellectual property rights in the following cases:

- If the design, trade mark or patent shows fraudulent or obvious imitation and if you can demonstrate that an alleged infringer or infringement aimed to take action in that respect.
- If you find imported products for sale that contain your IP, even though you did not consent to it.
- If you find your IP published or for sale and it is a fraudulent imitation of your design rights.

IP infringement in India carries a minimum of 6 months and maximum of 3 years of imprisonment and monetary fines that are significant by local standards, namely between 25,000 and 50,000 Rs. Indian police also have the power to conduct raids to seize any potential goods or services infringing IP.

In India, you may take legal action against patent infringement if a third party manufactures a patented product, uses a patented process or offers to sell or sells patented products, uses products acquired directly by the patent process for production or business purposes, or imports or exports patented products or products that are acquired through patented processes. However, there are acts that do not constitute an infringement, such as making, constructing, using, selling or importing a patented invention solely for uses reasonably related to the development and submission of information. For in-depth information, it is advisable to consult a local attorney.

A lawsuit against infringement can be initiated either in an Indian District Court or in the High Court, depending on the amount of money that is at stake and the place of residency of the rights holder. Should you file a complaint, you will have to demonstrate that the alleged infringement involves a violation of your intellectual property rights and that you suffered economic loss because of the alleged infringement. In India, you have 3 years from the cause of action to file a lawsuit. Most Indian courts will stop the infringer while the court examines the case if the right holder is able to establish the rights before the court and is able to illustrate that the rights were violated and that this has caused significant damage.⁸

Remember that copyright protection is self executing. Therefore, you can take legal action against infringement even if you did not file for any form of

8. <http://newdelhi.usembassy.gov/iprpatents.html>



protection. A similar situation holds for trade mark infringement. Because trade mark protection is based on the 'legitimate use of the mark' in India, you may bring litigation even if you have not filed for any form of protection. The illustration of the mark's market power, paired with a demonstration of how the infringement caused you loss in market share, is sufficient evidence for a case against counterfeiting and piracy.

Action at the customs

Since India is a member of the WTO, it is obliged to take action against the trading of pirated goods and services. The Intellectual Property Rights Enforcement Rules of 2007 are meant to provide a regulatory framework for customs provisions related to intellectual property. Most importantly, these rules make the trading of counterfeited goods illegal. This newly introduced law was accompanied by relevant reforms of customs. In addition, customs authorities were given the power to take action on their own if they detect counterfeits. In that context, a pirated

good is defined as any product or service that violates existing intellectual property laws.

If your goods or services are pirated, you should write a letter to the custom authorities asking them to suspend the infringing goods. Don't forget to accompany your letter with relevant proof, as well as your contact details and the sum of money (the exact amount is determined by customs) that the customs views necessary to protect the importer, as well as the customs authorities themselves, from any potential liabilities arising from your complaint.

Should the custom authorities intend to stop the importation of counterfeited goods, they will send you a letter. Be careful, you have to reply to this letter within 10 days, otherwise customs will not take action.

Once the customs authorities have stopped the importation of these counterfeited goods, you have the chance to examine them and even take action in other countries where you do business.

Russia

Protection of a creation without formalities

The law provides no rights for unregistered trade marks or unregistered designs. Registration is granted on a first come, first served basis.

Copyright protection

Applicable Laws:

Part IV of the Civil Code (230-FZ) entered into force on 1.1.2008. It replaces the Law on Copyright and Related Rights (No. 5351-I of 9.7.1993 as amended on 20.7.2004).

What can be protected?

Copyright extends to works of science, literature and art that result from creative activity, and to the parts of such works (incl. their titles) that fit the originality requirements. Therefore, logos, device marks, labels and three-dimensional objects that are the product of creative work enjoy copyright protection. Not protected by copyright are: official documents (laws, court decisions, etc.) and official translations thereof; state emblems and official signs (flags, armorial bearings, decorations, monetary signs and other state symbols and official signs); works of folklore; communications concerning events and facts that have informational character.

Formalities:

Copyright is unusual in the way that rights come into existence and are protected from the date of the creation of a work, by virtue of the very fact of its creation, so no formalities (official recording, etc.) are needed to establish protection.

Duration of protection:

up to 70 years after the author's death.

Industrial Designs

Applicable Laws:

Part IV of the Civil Code (230-FZ) entered into force on 1.1.2008¹.

Obtaining protection:

Industrial design protection can only be obtained by filing a national patent application through ROSPAT-ENT. This process consists of 4 stages: (i) filing an application, (ii) formal examination, (iii) substantive examination, (iv) granting patent protection by issuing a design patent.

What can be protected?

Industrial design patents are granted for an artistic engineering embodiment of a commercially produced or handcrafted article that forms its exterior, i.e. the design appearance of the article. Industrial designs may be three-dimensional or flat, e.g. packaging, a tag, a logo or a type, as well as composite products, separate parts that can be assembled into a composite article, etc.

Formalities:

When preparing a design application, you should keep in mind that the image of the exterior of the article is the key document, as it contains all the in-

1. http://www.wto.org/english/thewto_e/acc_e/a1_russie_e.htm

formation about the industrial design. It should be precise, clear and provide the idea and the details of the article's exterior. An application should contain a request for the granting of a patent, description of the industrial design, representations of the article and a list of essential features which, along with the picture of the article, are supposed to determine the scope of legal protection provided by the patent. To verify whether an industrial design meets the aforementioned requirements, an examination is carried out at ROSPATENT upon the completion of which the search for similar artistic engineering solutions is performed. If it is determined that the industrial design meets the requirements, ROSPATENT allows the design with the claimed list of essential features. Otherwise, ROSPATENT refuses to grant protection. A refusal may be appealed in the Chamber for Patent Disputes in the prescribed order.

To qualify for protection, the design must comply with the patentability requirements that say an industrial design should be innovative and original. To file a design application, you need 8 clear representations of each variant, a power of attorney (simply signed, see below), full details about the applicant (address, full name, nationality, etc.) and a brief description of the design for which the registration is sought.

Costs:

The fees for a design are:

Object of the fee	Additional fee (1 to 5 designs – per design)	Additional fee (as of 5 designs per design)
Filing and examination	600 RUB/ national 2,700 RUB/foreign	+1,050 RUB/ national +3,000 RUB/ foreign
Granting of industrial design	2,400 RUB/national 10,800 RUB/foreign	/

Good to know:

As taxes for foreign companies/individuals are 3 times higher than for national companies/individuals it is advisable to create a Russian company (for permanent activities).

Examination:

In addition to the drawings, the design must include a disclosure explaining the use of the design and the set of essential features. The scope of protection of a Russian design is determined by combining the set of essential features with the drawings, i.e. an infringing product must fulfil all essential features depicted in the drawings. Because the scope is defined in this manner and because ROSPATENT examines all filed designs for absolute novelty (without any border limits), a design patent is a quite effective form of protection in Russia.

Duration of protection:

Design patenting is valid for 10 years. It can be renewed for a maximum of 25 years.

Ownership of the right:

Any creation may be mentioned as the property of the employer in a job contract. If not, the employee remains the sole owner of this creation. Licence agreements for patents and designs are similar to those for utility patents and must be registered to be valid.

Trade mark rights

Applicable Laws:

Part IV of the Civil Code (230-FZ) entered into force on 1.1.2008. Part IV Chapter 76 § 2 "Right to a Trade Mark and a Service Mark", among other clauses, provides for the legal regime of trade marks, their registration requirements and the procedure for registration with the Russian Trade Mark and Patent Office (ROSPATENT). It also defines the scope of the trade mark owner's rights, the notion of "trade mark use" and establishes civil remedies for trade mark infringement

Obtaining protection:

Trade mark registration may be obtained by filing a national trade mark application through ROSPATENT. For commercial and protection reasons, trade marks should be registered. Registration is prima facie evidence of ownership and validity. Registration can generate royalties through licensing. There is no le-

gal requirement to register a mark, but rights against infringers are only acquired through registration. If a mark is not registered, designations generally do not enjoy legal protection, and there are 2 major risks:

- Infringement of third party's earlier trade mark rights for the identical or confusingly similar designations registered for the same or similar goods or services;
- Applying for and obtaining registration of the same designation by a third party (innocent or acting in bad faith) ahead of the rightful good faith user.

Therefore, it is highly desirable to register a trade mark and to start such use within 3 years from the date of registration, as 3 years of non-use makes a trade mark vulnerable for cancellation upon any third party's request. The duration of a registration is 10 years from the application date.

What can be protected?

The trade mark law provides a non-exhaustive list of designations that can be registered as trade marks. A trade mark may be registered in any colour or combination of colours. However, there are certain limitations. A designation will not be registered as a trade mark if it is not distinctive or consists only of elements which: are in common use to designate goods of a certain kind; are generally adopted symbols and terms; describe goods, including the type, quality, quantity, properties, purpose or value of the goods and the place and/or time of their manufacture or sale; or represent the shape of goods which are determined exclusively or mainly by the properties or function of the goods. These signs may, however, be incorporated as non-protected elements, provided that they are not overpowering. The law also prohibits the registration of signs with elements that are: misleading or capable of misleading consumers with respect to a product or its manufacturer; or contrary to public interest, principles of humanity or morals.

Scope:

A Russian application only has effect in Russia. Trade mark registration can also be obtained through international trade mark registration with extension to Russia filed via the Madrid Agreement or Protocol. The Russian Federation is a signatory to the following international treaties: Locarno Agreement establishing an International Classification for Industrial

Designs (1968); Madrid Agreement concerning the International Registration of Marks (1891); Madrid Protocol relating to the Madrid Agreement Concerning the International Registration of Marks (1989); Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the registration of trade marks (1957); Paris Convention for the Protection of Industrial Property (1883); Trade Mark Law Treaty to approximate and streamline national and regional trade mark registration procedures (1994).

The Working Party on the accession of the Russian Federation to the World Trade Organization (WTO) was established on 16.6.1993². One criterion for WTO accession is that Russia must meet the minimum standards of the Trade Related Aspects of Intellectual Property (TRIPS) Agreement, a comprehensive multilateral agreement on intellectual property.

Formalities:

Before considering filing a trade mark application, it is advisable to conduct a clearance **trade mark search** through ROSPATENT. The search will reveal third parties' registered trade marks and pending applications, which can present potential obstacles to a designation of interest. The examination procedure is composed of formal and substantive examinations. A **formal** examination is conducted within 1 month of the date the application is filed (to verify whether the application meets the formal requirements). After the formal examination, ROSPATENT issues a decision either accepting the application for consideration or rejecting it. This is followed by the **substantive** examination to verify whether the claimed designation complies with the requirements for registration of a trade mark. The examiner is entitled to issue enquiries and notifications during the substantive examination. The deadline to respond to notifications is 6 months from the date of notification.

It is not possible to oppose a trade mark application during examination, but it is possible to lodge a cancellation action after registration. The time limit for cancellation actions based on the grounds of similarity is 5 years from the publication date.

A trade mark is registered on the basis of a decision to register by ROSPATENT following the substantive examination. The trade mark is entered into the Reg-

2. http://www.wto.org/english/thewto_e/acc_e/a_russie_e.htm

ister of Trade Marks within 1 month of payment of the registration fee. If no registration fee is received, the application is treated as being withdrawn and the trade mark is not registered. The examination takes about 6-9 months.

Information to provide:

Designation to be protected and trade mark type (word, logo, combined); a complete list of goods or services on which the trade mark will be used (preferably grouped according to the Nice Classification); information about applicant: official name, legal address, country; a document certifying payment of the fee for filing an application in the prescribed amount; a power of attorney (if you are represented).

Costs:

For preliminary search within 7 days (including registered marks and filed applications) word/combined mark in 1 class: **113 EUR (30 EUR for each additional class)**. Upon receiving notification of positive decision, a company shall pay trade mark registration and issuance of certificate fees.

For filing an application: about **400 EUR (1 class)** plus **70 EUR** for each additional class; for registration, **365 EUR**.

Duration of protection:

10 years from the filing date. The period may be extended, by 10-year periods, at the request of the right holder, which should be filed during the last year of the expiring term.

Upon request, a trade mark owner may be given a 6-month grace period after expiration of the registration period to renew protection, provided the owner has paid an additional fee.

Prolongation of the trade mark registration shall be entered by the federal executive authority on intellectual property (ROSPATENT) in the Register and the Trade Mark Certificate.

Ownership of the right:

Any legal entity or natural person engaged in business activities (i.e., an individual entrepreneur) can apply for a trade mark.

It is also possible to register collective marks which may be owned by an association of persons (i.e., of legal entities and/or natural persons).

Cession and licences:

The exclusive rights to a trade mark for some or all of the goods for which it has been registered may be assigned. Assignment is not allowed if it would mislead consumers with regard to the goods or their manufacturer. In addition, the right to use a trade mark for some or all of the goods for which it has been registered may be granted under a licence agreement. Both types of agreement are subject to mandatory registration with ROSPATENT. Unless registered, they are deemed invalid.

Good to know:

As 35% of the trade mark requests are rejected, ensure that your trade mark or a very similar one is not already registered in the Russian Federation and avoid legal oppositions and objections.

What should I do if I am copied?

The use without the owner's permission of a trade mark or a confusingly similar sign for the goods for which the trade mark has been registered or similar goods constitutes an infringement. The goods and the labels and packaging of those goods on which the trade mark or a confusingly similar sign is used unlawfully, are deemed counterfeit. The owner of a trade mark can resort to statutory solutions in the case of infringement. Depending on the nature and gravity of the infringement, administrative, civil or criminal options are available. There are no specialised IP courts in Russia. The commercial courts handle civil trade mark infringement matters.

Administrative action:

The Code of Administrative Offences states that unlawful use of a trade mark is punishable by confiscation of the infringing goods and an administrative

fine of 1,500 RUB (35 EUR) to 2,000 RUB (46 EUR) for individuals; 10,000 RUB (235 EUR) to 20,000 RUB (470 EUR) for government officials; and 30,000 RUB (705 EUR) to 40,000 RUB (940 EUR) for legal entities. The court considers the case within 15 days of receipt of the statement of case. A petition may also be filed to the anti-monopoly service on grounds of unfair competition involving a trade mark. That authority can issue a directive ordering the infringer to cease the illicit activities.

Civil action:

Before the courts, the trade mark owner may demand the cessation of infringement (e.g. an injunction). In addition, it may claim damages for losses and lost profits, as well as recovery of the profits received by the infringer. Instead of damages, the owner may demand compensation of between 100,000 RUB (2,349 EUR) and 5 million RUB (117,000 EUR). In addition, the following civil law remedies are available in connection with the unlawful use of a trade mark:

- publication of the court's decision for the purpose of restoring the owner's commercial reputation;
- removal of the illegally used trade mark from the counterfeit goods and packaging at the infringer's expense; and
- destruction of the counterfeit goods and packaging at the infringer's expense if the infringing trade mark cannot be removed.

The court may order injunctive relief forbidding the defendant to perform actions related to the subject matter of proceedings or ordering the seizure of the defendant's property. The court shall consider the petition for injunctive relief no later than the day after the claimant files such a petition with the court.

Civil proceedings take between 3 and 6 months to render a first-instance decision.

Other points to bear in mind are:

- There is no full recovery of legal fees.
- The parties face no disclosure obligations.
- No mandatory alternative dispute resolution procedure exists in the Russian legal system.

Criminal action:

The Criminal Code provides criminal sanctions for trade mark infringement. In order to qualify for criminal prosecution, the infringement should cause significant damage or be recurrent. The infringer may face:

- a fine of up to 200,000 RUB (4,700 EUR); or
- forced labour of between 180 and 240 hours; or
- correctional work for up to 2 years.

If the infringement is carried out in collusion or by an organised group of infringers, the offenders can be punished by:

- a fine of up to 500,000 RUB (2,350 EUR); or
- a fine on the infringer's salary or income for up to 3 years;
- detainment for 4-6 months or imprisonment for up to 6 years.

Criminal cases are launched and investigated by the Ministry of the Interior and then tried by the criminal courts. An investigation usually takes 2-3 months from the date the proceedings are instituted. In exceptional cases, this term may be prolonged by up to 12 months. The term for consideration in the court, including the appeal stage, is at least 4 months. A key point is that successful investigation and completion of the proceedings is possible only if the trade mark owner actively participates from the start of the proceedings up to the court ruling. Counterfeits may be seized during investigation of the case based on a petition of an investigator approved by the courts. The trade mark owner has no opportunity to withdraw a criminal action, for example, in the event of settlement with the infringer.

Good to know:

The newly approved "Rules for Recognition of Trade Marks as Well-Known in the Russian Federation" may play a significant role in current and future trade mark disputes by providing useful criteria and guidelines for the courts to make consistent and reasoned determinations that certain trade marks are "well-known." According to the new rules, 60% of consumers surveyed must recognise a trademark for it to be considered "well-known."

Patents

Applicable Laws:

Federal Law No. 230-FZ "Civil Code of the Russian Federation, Part Four" (18.12.2006).

According to the **Eurasian Patent Convention**, 9 countries (Russia, Belarus, Kazakhstan, Armenia, Azerbaijan, Moldova, Kyrgyzstan, Turkmenistan, Tajikistan) can be covered by 1 Eurasian patent that is valid in all

the countries for 3 years from the international filing date and can be maintained in the selected countries simply by paying annuities.

Two independent procedures are possible:

a Russian patent or a Eurasian patent. The Eurasian patent is recommended as the process is faster and more successful.

What can be protected?

To obtain a patent, the claimed work has to meet the following criteria: global novelty, inventive step level and industrial applicability.

Costs:

Object of the fee	national	foreign
Filing of a patent	+13,000 RUB/national	+39,000 RUB
Examination and granting	+2,100 RUB	+ 6,300 RUB

Formalities:

In Russia, examination on merits is conducted to confirm patentability of an invention. With regard to novelty, the applicant has a 6-month grace period from the date of public disclosure of information.

The applicant has a right to defer examination (substantive) proceedings for 3 years from the filing date of the application. After 18 months have passed from the filing date, ROSPATENT publishes information on the application. Upon receipt of a patent application, examining officers of ROSPATENT carry out the formal examination to ensure the formal requirements have been met, and, at the applicant's request, the substantive examination which includes the patent. If the requirements outlined in the Patent Act are met, a patent is granted. From the patent filing date, the patents are examined in the order they were received. The approval or rejection of a patent application can take over 3 years. Then, if the patent application is found to be in compliance, a notice of allowance will be sent to the applicant, or to applicant's attorney or agent of record, if any, and a fee for issuing the patent is due within 3 months from the date of the notice.

Duration of protection:

20 years (from the filing date).

Ownership of the right:

Individuals and legal entities may file invention applications. In the course of the examination, the number of applicants and individuals may be changed at their request. A patent is issued in the name of the applicants who become patent holders upon the receipt of the patent. The applicants may choose how the patent should be used, including income distribution, by signing a written agreement. If an agreement is not signed, each of the patent holders has the right to use the patented invention in their own economic activity without seeking mutual approval of this activity by the other holders.

Good to know:

Given the simplified examination for utility patents (formal examination only), utility model patents are issued earlier than invention patents (which undergo a lengthy substantive examination)

Protection of utility models

Applicable Laws:

idem

What can be protected?

Only two conditions need to be met for utility models – novelty and industrial applicability.

Costs:

Object of the fee	Additional fee (1 to 25 utility models – per utility model)	Additional fee (as of 25 utility models per utility model)
Filing and examination	+2,700 RUB/national +7,000 RUB/foreign	+260 RUB/national +780 RUB/foreign
Grant of utility model	+10,000 RUB/national +30,000 RUB/foreign	/

Formalities:

The procedure to obtain protection for a utility model is shorter and simpler than that for a patent.

Examination:

An examination of a utility model's compliance with the conditions for protection is not conducted by the patent office. A utility model is granted on the applicant's responsibility without a guarantee of its validity.

Duration of protection:

10 years from the application filing date. Can be extended by ROSPATENT for 3 additional years upon a petition by the patent assignee.

Ownership of the right:

A natural person whose creative work resulted in the invention, utility model or industrial design shall be recognised as the author thereof. If an invention, utility model or industrial design results from the joint creative work of 2 or more natural persons, those persons shall be recognised as the joint authors thereof. The conditions for exercising author's rights shall be determined by an agreement between them.

Good to know:

A utility model can be acquired quickly and is a very efficient form of protection, whereas the process for a patent takes years. When a patent is granted, the applicant must either cancel the utility model (or the patent) or, if there is no double patenting, both can be maintained.

What should I do if I am copied?

Russian law provides civil, administrative and criminal liability for IPR infringement

The following copyright and neighbouring rights infringements are considered criminal offences:

- Plagiarism that causes major harm to the right owner.

- Illicit use of copyrighted works or works protected by neighbouring rights; and large-scale purchase, storage and transport of fake copies with intent to sell.

The following infringements of inventors' rights and patents are considered criminal offences:

- Illicit use of an invention, utility model or industrial design.
- Unauthorised disclosure of the substance of an invention, utility model or industrial design prior to official publication.
- Usurpation of inventorship or coercion into co-inventorship, provided the offence causes major harm.

These offences are punishable by fine (maximum **200,000 RUB**, or about **6,000 USD**) or imprisonment of up to 2 years. For aggravated offences (repeated offences or conspiracy), the penalties are a fine of up to **300,000 RUB** (about **8,500 USD**) or imprisonment of up to 5 years.

Enforcement:

Court prosecution IP infringement cases are handled by:

Commercial (arbitrazh) courts have jurisdiction in the matters relating specifically to commercial activity and transactions. Consequently, legal entities and/or officially registered "individual businessmen running their business without incorporation of a legal entity" (so-called "PBOUL's") can be parties in the "arbitrazh" process.

Arbitration procedure is rather fast:

- Decision of the first instance to be taken in 3 months
- Decision of the second instance in 1+1 months
- Decision of the third instance in 1+1 months

The patent examination can be requested in the first and appeal instances. The examiner may be interrogated by the parties.

Courts of general jurisdiction are competent to hear and decide civil cases involving an individual as one of the parties. In addition, courts of general jurisdiction handle criminal prosecution involving IP rights violation and IP-related felonies.

Some cases are referred to administrative bodies: **Chamber for Patent Disputes** hears and decides the following oppositions, complaints and declarations:

- appeals against an examiner's refusal to grant a patent (e.g. patents for inventions, utility models or designs),
- opposition to third parties' trade marks, appellations of origin and international registrations designating Russia,
- requests to recognise a trade mark as a "well-known mark" in the Russian Federation.

The Anti-Trust authorities handle unfair competition cases, particularly based on the Competition Protection prohibiting unfair competition related to misappropriation and unauthorised use of companies' goodwill and means of products/services individualisation.

Damages in patent disputes: Civil code Article 15-2 provides for the compensation of direct damages and lost profit. Income received by the infringer can be considered lost profit. Compensation of moral damage is also available if infringement resulted in personal suffering of the right holder. No punitive damages exist in patent law or in design and utility model law (punitive damages are available for trade mark infringement only).

Good to know:

Practical problem: "patent racketeers" who copy foreign firms and became the holder of Russian patents for these inventions. To avoid this, a patent application should be filed in advance for every invention which shall be used in Russia. The same problems are presented by so-called "trade mark trolling and hijacking."

Customs action:

The Customs Code does not allow the entry of goods into Russia whose importation would infringe intellectual property rights. An IP owner may apply for inclusion of its right in the Customs Register. Under Russian law, customs has no *ex officio* powers. Upon inclusion of the right in the register, the Customs Authority monitors the importation of goods bearing that right and, if such goods are imported by an unknown importer, the authority may suspend the release of such goods and inform the right owner accordingly.

To initiate a customs inspection, the right owner must forward an application to the Federal Customs Service of the Russian Federation requesting that it

undertake protective measures and temporarily suspend circulation of allegedly counterfeit or pirated goods. The following information should be attached to this application:

Full corporate details, address and corporate status of the right owner and its representative;

Power of attorney in the name of the representative, if any; List of valid rights in Russia along with copies of registration certificates;

List of specific goods covered by the right registrations in relation to which customs should initiate its checks;

List of authorised dealers and importers of the genuine goods in Russia;

Specific information about allegedly counterfeit or pirated goods;

Information on reported cases of trade mark infringement;

Term requested for the recordal (max. 5 years with possibility of renewal);

Undertaking by the right owner to reimburse any damage suffered by parties as a result of unlawful customs suspension; and

Document confirming that the right owner has secured its undertaking by way of a bank guarantee or insurance of liability for the amount of 500,000 RUB.

Procedure:

Under the Customs Code, if the customs inspection reveals suspicious goods, the goods are detained for 10 days. Along with the detention, customs informs both the importer and the right owner or its representative indicated in the register of the detention. Within a 10-day period, which can be extended only once for a further 10 days, the right owner:

- - has a right to examine the goods, obtain samples and pictures;
- - must inform customs as to whether the goods are counterfeit.

If the goods are counterfeit, the right owner must initiate legal proceedings against the importer. Failure to initiate legal proceedings within the above-mentioned period results in the release of the goods.

The customs recordal will be effective only if a right owner appoints a local representative to liaise with various customs contact points on a day-to-day basis and an expert who is officially authorised to conduct an expert examination of alleged counterfeits on behalf of the trade mark owner to determine whether the detained goods are counterfeit and provide customs with a written expert opinion within the applicable timeframe. Failure to provide responses to customs requests connected with the detention of allegedly counterfeit goods may serve as grounds to withdraw the right from the register and to stop customs detention.

Main links and contacts for additional support

ROSPATENT, Federal Institute of Industrial Property
Post address: bld. 30-1, Berezhkovskaya nab., Moscow, G-59, GSP-5, Russia, 123995
FAX: (499) 243-33-37, (495) 234-30-58
Phone: (499)240-60-15, (499)240-61-38 (E-mail: fips@rupto.ru)

Alliance Media National Business Partnership
Phone **(495)234-53-80**
Fax **(495)234-53-63**
E-mail allmedia@allmedia.ru
Postal address: **Bolotnaya Str., 12 building 3 -115035, Moscow, Russia**
Website: <http://www.business-in-russia.com>

Federal Customs Service of the Russian Federation
Inspection & Information Transfer Control Branch
11/5, Novozavodskaya st. Moscow, Russia
Phone: +7 095 449-7747/7531
Fax: +7 095-449 7812
E-mail: GUTNR_Ashurkov@mail.customs.ru

Russia-Europe Textile Alliance (RETA)
9/3, Polslannikov per.105005 Moscow, Russia
Tel.: +7 (495) - 589 18 81
Fax +7 (495) - 589 18 82
E-mail : igors08@yandex.ru



United States of America

Protection under design law

Applicable Laws

There is no design law in the U.S. and you can only protect your design through patent law, trade mark law and copyright law.

The U.S. offers design protection through 'design patents', 'trade dress' and copyright. The applicable laws are as follows:

The Vessel Hull Design Protection Act; Copyright protection under title 17 of the United States Code; the Copyright, Designs and Patents Act 1988, in particular Chapter 48; the Lanham Act.

What can and cannot be protected?

Protection for designs related to fashion and other product designs with short business cycles is extremely limited in the U.S. since there is no design law in place.

To protect your designs, you need to refer to patent law, trade mark law and copyright. Since these regulations are explained in the following chapters, you will find under the 'design rights' section only those specifications that are particular to designs and, in some instances, signify an exception to the overarching principles of patent, trade mark and copyright law.

Design protection through design patents

With respect to design patents, the typical criteria for patentability are slightly modified in that, rather than looking for "novelty, non obviousness and commercial applicability", design patents are defined through "novelty, non obviousness and ornamentality."

Design protection through trade dress

To receive trade dress protection the trade dress must be either inherently distinctive, or have acquired distinctiveness through secondary meaning and must serve no utilitarian or aesthetic function. The notion of 'trade dress' refers to features of the visual appearance of a product, like its packaging or product shape.

Design protection through copyright

To enjoy design protection under copyright law, original works of authorship must be fixed in a 'tangible medium of expression'. This means the design must be put down on paper, photographed or filmed. If you can't demonstrate that your design has been fixed on paper, you can't claim protection under copyright law.

However, if you want to use copyright law to protect your design you can't protect goods that have both a functional and an aesthetic purpose. This rationale makes the protection of designs that are commonly used in the footwear, leather, furniture and textile industries a particular challenge because the general consensus among the courts in the U.S. is that the pictorial, graphical, or sculptural aspect of a fashion work is too close to the functional aspects of the work to make any kind of separation possible. Therefore, in most instances your design may not qualify for copyright protection in the U.S.

Formalities

The formalities for design protection under patent, trade mark and copyright law are exactly the same as for any other form of patent, trade mark and copyright protection.

Costs

The costs for design protection under trade mark and copyright law are exactly the same as for any other form of trade mark and copyright protection. Yet, if you wish to protect your design as a patent, the costs are lower than for other patents. The filing fee for a design patent is 100 USD, the issue fee is 400 USD and there are no maintenance fees.

Examination

The examination for design protection under patent, trade mark and copyright law is exactly the same as for any other form of patent, trade mark and copyright protection.

Duration of protection

The duration of design protection under trade mark and copyright law is exactly the same as for any other form of trade mark and copyright protection. But design protection under patent law is valid for only 14 years. Since the filing of a design patent can take several years, it may not be the best form of protection for the footwear, leather, furniture and textile industries.¹

Ownership of the right

The ownership for design protection under patent, trade mark and copyright law is exactly the same as for any other form of patent, trade mark and copyright protection.

Good to know

There is no adequate design protection for products and services with short business cycles. Since designs in the footwear, leather, furniture and textile industries often last for a period that is substantially shorter than the application process for IP protection, the current regulatory framework for design protection in the U.S. causes specific problems for these industries.

1. U.S. Department of Commerce, Patent and Trademark Office. A Guide to Filing a Design Patent Application. <http://www.uspto.gov/web/offices/pac/design/index.html>

Protection under trade mark law

Applicable Laws

The main applicable laws and regulations for trade mark protection are:

The Trademark Act, the Madrid Protocol for the international registration of trade marks.

What can and cannot be protected?

The criteria of 'commercial use' is really crucial under U.S. trade mark law. This means you can only file for trade mark protection if you are using or intend to use the mark in your business. This means the mark must be used on your goods and services and play a role in your advertising or sales strategy. At the very least, you must have the intent to use your mark in these contexts, and the U.S. authorities ask you to swear that you are going to do so. If in fact, you file your trade mark based on the intention of using it at some point, the USPTO asks you to begin the actual use of the mark in business before it will register the mark.

Trade mark registration is usually refused if among other things the mark is merely descriptive or deceptive or if it is just a surname or merely ornamental.

Formalities

To avoid the rejection of your mark, it is best to do a trade mark search before you submit your application. The USPTO allows you to conduct a search free of charge via the Electronic Search System, (TESS). An applicant needs to fill out an application via the 'Trademark electronic application System' (TEAS).

For a paper application, please call the USPTO at (800) 786 9199 to obtain a printed form and mail it to:

The Commissioner for Trademarks. P.O. Box 1451, Alexandria, VA 22313-1451, USA.

The USPTO does not accept applications submitted by fax. An in-depth explanation of how to file a trade mark application can be found on the Web site of the USPTO.² Don't forget, you can file for trade mark

2. <http://www.uspto.gov/web/offices/tac/doc/basic/appcontent.htm>



registration in the U.S. through WIPO by using the Madrid system. For further information, check the factsheet on international registration procedures.

Costs

U.S. trade mark registration fees are as follows:

Application for registration, per international class (paper filing) 375 USD.

Application for registration, per international class (electronic filing, TEAS application) 325 USD.

Filing a Statement of Use under §1(d)(1), per class 100 USD.

Certifying an International application based on single application or registration, per class 100 USD.

Certified copy of registered mark, with title and/or status, expedited local service 30USD.

Recordal application fee 20 USD.

Examination

After you have filed the application, it is forwarded to an examining attorney, who checks whether your application is complete and whether there are any conflicting marks. Following that, your application is either successful, is accepted with revisions or fails.

If the application is successful it will be published in the Official Gazette.

If no one opposes the application, or if an opposition is unsuccessful, either a Certificate of Registration will be issued for applications based on use, or a Notice of Allowance will be issued for intent-to-use applications.

Duration of protection

Trade mark registration is initially valid for 10 years, but can be renewed for further 10-year periods indefinitely upon evidence of continued use.

Ownership of the right

Under normal circumstances, the creator of the trade mark is the owner. If, however, the original creator of the trade mark has done this work in the context of his/her employment, the employer owns the mark, unless otherwise specified in the contract. It is also possible to transfer the trade mark to a third party, but you need to state this in the contract. Thus, any person "claiming to be the proprietor" of the trade mark "used" or "intended for use" can apply for the registration of the trade mark.

Good to know

In the U.S., trade marks can last indefinitely if the owner continues to use the mark and files all necessary documentation at the appropriate time. The rationale for U.S. trade mark law is strongly based on commercial use. This means that even if you have not filed for trade mark protection but can illustrate that you have been using your trade mark to do business, you enjoy trade mark protection. This may be seen as an advantage for IP owners having missed out on filing adequately for trade mark protection in the U.S.

Protection under patent law, including utility patents

Applicable Laws

The main applicable laws are title 35, United States Code, as well as the American Inventors Protection Act and public law 106-113.

What can and cannot be protected?

Any invention that is new and useful, be it a process, a machine, a manufactured good or a composition of matter, as well as any new or useful improvement to an existing technology qualifies for patent protection. Processes can also qualify for patent protection. You can't patent an idea or a suggestion.

Formalities

USPTO offers both electronic and paper-based filing. For electronic filing it recommends using the EFS-Web System. The inventors Assistance Center provides support to inventors.

It can be reached at 800-PTO-9199, (800-786-9199) or 001 571-272-1000.³

If you want to file a utility patent, the USPTO requires that, just like with other patent applications, it be filed in English or accompanied by an official translation into English. An application must include:

- Utility Patent Application Transmittal form,
- Fee Transmittal Form and Appropriate Fees,
- Application Data Sheet,
- Specifications (with at least one claim),
- Drawings (when necessary),
- Executed oath or declaration,
- Nucleotide and/or Amino Acid Sequence Listing (when necessary).

Costs

Fees vary, according to application.

Basic filing fee: 300 USD.-

Search fee: 100-540 USD.

Examination fee: 140-220 USD.

Post Allowance Fee: 300-1,510 USD.

General fees: 10-50 USD.

Draftman's fees: 100-400 USD.

Costs for filing a utility patent can range from 4,500-12,000 USD or more.

Examination

An examiner reviews the application and performs a patentability search based on the claims of your application. Following that, your application gets accepted, accepted with a request to make certain amendments or refused. Inventors are advised to keep their invention secret and sign and date the notes. It is to the patent applicant's advantage to file an application as quickly as possible. Important to note: if you have previously published or sold your invention, the patent application will be void.

Duration of protection

Patent protection lasts 20 years, but don't forget to pay your annual renewal fees.

Ownership of the right

The patent belongs to the inventor of the invention of the patent. The owner has the right to license the patent or transfer the ownership of the patent to a third party.

Good to know

The U.S. patent system is a "first to invent" system and not a "first to file" system. Patent litigation in the U.S. can be very expensive and it may be advisable to settle potential disputes through alternative dispute resolution mechanisms. The USPTO publishes the patent application eighteen months after the filing date and in doing so is compliant with most other countries. Finally, an inventor who makes secret, commercial use of an invention for more than a year prior to filing a patent is not eligible for patent application.

Protection under copyright law

Applicable Laws

Copyright is governed by the Copyright Act.

What can and cannot be protected?

Copyright law includes literary, musical, dramatic, choreographic, pictorial, graphic, sculptural, audiovisual, derivative and architectural works, as well as sound recordings, and compilations. The U.S. does not recognise any "natural rights" of the author, thus the idea of "moral rights" of the author is only expressed in a very indirect way in U.S. copyright law. Furthermore, there are 5 basic rights protected by copyright in the U.S.: the right to make copies of your work; the right to prepare derivatives that are based on the original work that enjoys copyright protection; the right to sell, license or distribute copies of your work in the market; the right to perform your work in public; and the right to make your work publicly available.

Work that has not been fixed in any tangible form and ideas cannot be protected. This means that you must put your work on paper, photograph it, tape it or film it. If you can't demonstrate that your design has been fixed in some material way, you can't claim protection under copyright law.

3. <http://www.uspto.gov/web/offices/pac/dapp/pacmain.html>

Formalities for copyright registration

Copyright registration is voluntary. From the moment you put your work on paper, you enjoy copyright protection. However, it is possible to register your copyright in the U.S., which will give you a stronger position in case of litigation.

The formalities for voluntary copyright registration are as follows: you need to sign your application, add a title, provide your contact details, and give a brief description of what you want protected by copyright. Should you apply for copyright protection in a language other than English, you need to accompany your application by a validated translation.

Costs

The copyright office charges 35 USD for an online registration and 45 USD for a paper registration. The U.S. provides fee reductions for SMEs as well as Small Business Innovation Research Grants.⁴ This covers your application for one work and includes the cost of an acknowledgement by the copyright office, as well as registration in its records.

Examination

Following your application, the register will study your application to determine whether it can be protected by copyright law. If the register determines that it can be and that all the formal requirements have been met, you will receive a certificate of registration. This certificate contains all the information you provided in the application. Should the registrar determine that copyright protection cannot be granted, you will receive a letter saying that.

Duration of protection

Depending on whether you are the author of the work or whether the subject matter of protection was work for hire, you enjoy protection either for 70 years after your death, for 120 years after the creation of the work or for 95 years after publication, whichever is shorter.

4. U.S. Small Business Administration. Grants Overview <http://www.sba.gov/hotlist/sbir.html>

Ownership of the right

Under normal circumstances, the author is the owner of the work. If, however, the original creator of the work made the work in the context of his/her employment, the employer owns the work. However, it is possible to transfer the copyright to the employee. It is therefore very important to clarify the ownership of copyright in the employment contract. It is also possible to transfer the copyright to a third party, but you need to state this in the contract.

Good to know

In the U.S., like in most other jurisdictions, copyright is a self-executing right, thus there is no need for formal registration. In spite of this, the U.S. offers copyright registration.

What to do if I am copied

The U.S. recognises that counterfeiting is a serious problem, and the USPTO has set up a hotline to help IP owners protect their rights. Called STOP! – The Strategy Targeting Organized Piracy – aims to combat organised crime and imitation. It provides IP owners one-stop-shop services to protect them from counterfeiting in the U.S., as well as abroad. The contact number is 1-800-786-9199 or 1-866-999-HALT.⁵

Under U.S. copyright law, a claim of infringement is justified if it concerns protected work, if the defendant copied the protected work, and if the defendant's copying of the protected work was an infringement. To a certain extent, however, copying is permissible. This is expressed in the "fair use" clause, which states that "reasonable" quoting is permissible. The distinction between "fair use" and infringement is not easily determined since there is no specific number of words, lines, or notes that may be used without permission.

Be careful! Even if you acknowledge the source of the copyrighted material, you need to obtain the permission of the copyright owner.

All infringement claims against the U.S. that did not arise in a foreign country must be filed with the U.S. Court of Federal Claims within 3 years of the infringing action. There is no "IP police". Thus, if the owner

5. Further online information at www.uspto.gov/main/profiles/stopfakes.htm

does not take action against the infringer, the U.S. will not automatically pursue action against the infringer. Therefore, IP owners must file a lawsuit in federal court to pursue their own remedies. Monetary compensation in the U.S. can be very high, as can attorney fees. The U.S. jurisdiction also provides for criminal penalties. In the case of copyright infringement, for example, it foresees a maximum of 1 million USD and imprisonment of 10 years. In the case of trademark infringement a lawsuit can be brought for infringement of either registered or common law trademark rights, if the issue could not be resolved through mediation. Remedies include injunctive relief to prohibit future infringement, the impoundment and destruction of goods bearing infringing trademarks, an infringer's profits, the trademark owner's actual damages and court costs. Attorney's fees may be awarded in exceptional cases. Where the infringement involves the use of a "counterfeit" or virtual duplicate of a registered mark, statutory damages of up to USD 1,000,000 may be awarded along with the imposition of an award of reasonable attorney's fees unless the infringer proves extenuating circumstances.

Right holders can take various legal, technological, and business strategic steps to prevent or at least minimise counterfeiting. Once counterfeiting has become a problem for your company, consult with counsel regarding strategies to confront the issue. Depending upon the territory involved, you may be able to conduct raids, work with customs agents to prevent import or export of the counterfeit goods, or file civil and/or criminal actions against the perpetrator.

Protection of your creation by other means

The fixation of a work in any tangible form automatically enjoys copyright protection. There is no need to use the © symbol to protect your right, provided that it was created before 1976. Foreign nationals enjoy the same copyright protection in the U.S. as U.S. citizens. Furthermore the U.S. enjoys good copyright relations with a variety of countries.⁶

If the copyright owner's country of origin has signed a bilateral agreement of mutual recognition, the work is automatically protected in the U.S. Equally,

there is no need to register the trade mark in the U.S. The rights to the mark are established "based on legitimate use of the mark". Likewise the symbol "TM" for trade mark and "SM" for service mark may be used regardless of whether or not you have filed a registration with the U.S. Patent and Trademark Office. This does not, however, hold for the federal registration symbol "®".⁷

Action at customs

The United States Immigration and Customs Enforcement (ICE) agency seeks to play a leading role in detecting counterfeit products. In doing so, it collaborates with the National Intellectual Property Rights Coordination Center (IPR Center), the ICE Cyber Crimes Center and the entire network of U.S. embassies. The National IPR center is composed of staff from U.S. Customs and Border Protection, as well as the FBI.

If you want to ensure that the ICE can detect potential counterfeit products, it is best to send a copy of your intellectual property registration to the agency. The list of your IP-protected products is then sent to all U.S. customs agents, who are responsible for screening all imported goods. Should allegedly counterfeited goods be seized at customs and the importer is unable to show that it is the rightful intellectual property owner, the goods are seized by customs.

To ensure that ICE can seize alleged counterfeit products, you can contact them directly and inform them that you have reason to believe that counterfeit products are about to be imported to the U.S.

U.S. Immigration and Customs Enforcement
National Intellectual Property Rights
500 12th Street SW
Washington, DC 20024

Phone: 1-866-IPR-2060, or 1-866-477-2060
Fax: (202) 307-2127

You can also contact ICE if you need assistance or help or any further information regarding action taken by customs against counterfeiting. Customs can then detect the goods and seize counterfeits if they find them.

6. United States Copyright Office: Circular 38a: International copyright Relations of the United States for the status of specific countries, www.copyright.gov/help/gaq/faq-who.html

7. USPTO: Trademarks: Basic Facts: Should I register my Mark? www.uspto.gov/web/offices/tac/doc/basic/register.htm

European Factsheet

In Europe, intellectual property rights (IPR) were originally considered a prerogative of Member States (protection limited to the national territory). Fortunately, the European Union has harmonised legislation and created community IPR legislation in some areas. Nowadays, companies have two options:

- Protecting their IPR at the national or regional level (with or without registration) with national/regional procedures and limits under similar rules, and/or
- Protecting their IPR at the EU level with EU limits but a unique procedure.

EU Protection of a creation without formalities

If your creation is a design/logo/model, you have two options:

- **Protection via national copyrights:** as there is no EU copyright protection, please refer to the specific national fiches to know if this is possible for your creation.
- **Protection via the unregistered Community design protection (UCD)**

The Unregistered Community Design (UCD)

Applicable law:

Council Regulation (EC) No. 6/2002 of 12/12/2001 on Community designs

What can be protected?

It can be the outward appearance of a product or part of it, resulting from the lines, contours, colours, shape, texture, materials and/or its ornamentation. It can be synonymous with the branding and image of a company. A product can be any industrial or handi-

craft item including packaging, graphic symbols and typefaces. It only covers the appearance of a product. A UCD needs to be “new” and have “individual character”.

Formalities:

None; applicable from the date of **disclosure** of designs to the public **within the EU**. This disclosure implies that those working in the same sector and operating within the EU could reasonably be considered to be aware of the design. This may occur through designs going on sale or through prior marketing or publicity. As long as you can prove the **date of disclosure** of your creation within the EU, you have protection against copying (but no other rights).

Costs:

None, apart from possible external services for disclosure (lawyer, brochures, publications...etc.).

Duration of protection:

The relevant designs will be protected for **three years**. Until the end of the **first year** after disclosure you have the option to **register** your UCD (still new) at the EU or national level if it seems to have an interesting commercial value for your company. If not, you can use it for three years and still benefit from copyright protection in some countries (check each country). After the first year, your design cannot be registered at the EU or national level.

Ownership of the right:

The right to Registered (RCD) or unregistered community design belongs to the designer or his/her successor in title. If two or more persons have developed a design, the right to the Community Design

shall vest with them jointly. However, if an employee develops a design in the course of his/her duties or following instructions given by his/her employer, the right to the RCD/UCD shall vest with the employer, unless otherwise agreed upon or otherwise specified under national law. An RCD/UCD may be licensed for the whole or part of the Community. A license may be exclusive or non-exclusive.

Rights conferred The UCD confers the exclusive right to use but provides a weaker form of protection than the RCD: protection against copy infringements only (bad faith or slavish copies).

The rights conferred by the UCD do not extend to acts done privately and for non-commercial purposes, to acts done for experimental purposes, and to acts of reproduction for teaching purposes.

What to do if I am copied?

Before starting legal proceedings, it may be useful to send a letter of summons to the infringer to ask him to stop infringing and demanding some damages (which may lead to the end of the infringement). If not, since Member States must designate one or more Community design courts of first and second instance that are responsible for infringement actions, the competent court is the national court in which the defendant is domiciled or has an establishment or where the right was registered. These courts have an exclusive jurisdiction for the following actions: infringement actions or threatened infringement of Community designs; actions for a declaration of invalidity of an unregistered Community design; and counterclaims for a declaration of invalidity of a registered Community design. In all cases, the judgement is valid and may be enforced in all of the Member States of the European Union.

The enforcement of Community Design rights through criminal provisions may depend on the national law of the individual EU member states.

Good to know

- - The date of disclosure must be established whenever necessary, for example: photo of the design during a public event; copy of a publication with the photo of your design (with a date); publication on the Web site (with a certain date); official letter from a lawyer during a public event, ...etc..

- Bearing in mind this need for evidence, some contracts might need to be adapted to avoid any disclosure of designs without the consent of the design holder.
- Your UCD must first be disclosed within the EU territory to benefit from UCD protection
- Your UCD does not protect you against copying outside Europe
- Your UCD may be lost if your counterpart can prove a date of creation earlier than your date of disclosure. Then contracts with potential clients to whom you intend to show your design before any disclosure might need to be drafted.
- Your UCD is lost if a jurisdiction considers it is not new/has no individual character.
- Your UCD protection may be entirely acceptable for a short-term design portfolio. The RCD, on the other hand, provides more certain, broader and longer protection.
- It is possible to cumulate the protection under designs and copyright legislations in some countries.

EU protection of a creation with formalities

The Registered Community Design (RCD)

Applicable laws:

Council Regulation (EC) No. 6/2002 of 12/12/2001 on Community designs

What can be protected?

Same rules as for the UCD.

Formalities:

Automatic protection, without examination of the merits, provided the design is new and possesses an individual character; possibility to protect, through a single deposit, up to 100 designs belonging to the same sub-category.

An application may be submitted to the OHIM (Office for Harmonization in the Internal Market in Alicante), national patent offices (NPO) or the Benelux Office. In all cases, the application is transmitted to the OHIM, which conducts a formal examination and, if applicable, grants the Community design by entering it in the Community Design Register. The entry is

then published by the OHIM in a bulletin open to the public. The applicant may request that publication be deferred for a period of 30 months from the date of filing to protect sensitive information.

Costs:

The fees for a Community design are very low and particularly attractive when compared to the cumulative costs of national registration in all the EU Member States.

Object of the fee	€	2-10 designs/design	11 or more designs/design
Registration	230	115	50
publication	120	60	30
Deferment of publication	40	20	10

Examination:

The OHIM encourages the electronic filing of design applications using a format similar to that for the Community Trademark applications. Shortly after filing, each application is examined on its compliance with the definition of a “design” and whether it is contrary to public policy or morality. There will be no novelty examination. If there are no deficiencies or objections, an application proceeds rapidly to registration and publication, probably within less than **three months** from the filing date. There is no publication of designs in a paper bulletin. Publication will be done electronically on the OHIM Web site and on CD-ROMs.

Duration of protection:

An RCD is valid for five years from the date the application is filed. It can be renewed up to four times, for five years each time, giving a total period of protection of 25 years. How to renew: You can either renew an RCD yourself or ask a representative to do it. The application can be submitted either via OHIM’s e-renewal system or by filing a paper form. If you are filing via e-renewal or the paper form, you can indicate whether you wish to renew all the designs covered by a multiple registration or only some designs.

Ownership of the right:

The right to an RCD or UCD belongs to the designer or his or her successor in title. If two or more persons have developed a design, the right to the Community Design shall belong to them jointly. However, if an employee develops a design in the course of his/her duties or according to instructions given by his/her employer, the right to the RCD/UCD shall belong to the employer, unless otherwise agreed or otherwise specified under national law. An RCD/UCD may be licensed for the whole or part of the Community. A license may be exclusive or non-exclusive.

Rights conferred:

The RCD confers on its holder the exclusive right to use it and to prevent any third party not having his consent from making, offering, putting on the market or using a product in which the design is incorporated, or even from importing, exporting or stocking such a product for those purposes. The RCD can be enforced against a design that is a copy but also against a design that has been created independently, without copying (protection against imitations even if the imitator claims it acted in good faith). The rights conferred by the RCD do not extend to acts done privately and for non-commercial purposes, to acts done for experimental purposes, or to acts of reproduction for teaching purposes.

What to do if I am copied?:

Same advice as for the UCD.

Good to know:

- Your RCD must first be disclosed within the EU territory to benefit from RCD protection
- Your RCD does not protect you against copying outside Europe
- Your RCD may be lost if your counterpart can prove a date of creation prior to your date of registration.
- Your RCD is lost if a jurisdiction considers it is not new/has no individual character
- It is possible to accumulate protection for designs, unfair competition and copyright legislations (in some countries).

Specific recommendations:

If a company launches a new product and has a new name/logo that is to be sold in Europe and fears the counterfeiting of this product, it is advisable to apply for a Community Design and a Community Trade Mark. The advantage of the Community Design is that there is **no opposition phase**. Also, the costs for the Community Design compared to the Community Trade Mark are very low.

The Community Trade mark (CTM)

Applicable law:

Directive 89/104/EEC of 21/12/1988, to approximate the laws of the Member States relating to trade marks, harmonized rules of national legislations and defined signs that may be registered as trade marks; Council Regulation (EC) No. 40/94 of 20/12/1993 created, in parallel with the national trade marks, the CTMR.

What can be protected?:

Broad definition of what can be registered as a CTM: slogans, sounds, smells and gestures. Goods and/or services (NICE classification) can be registered. Registration may also take the form of a collective trade mark to guarantee the origin, nature and quality of goods and services by making them distinguishable (beneficial to members of the association or body owning the trade mark).

Formalities:

Advantage of a sole procedure resulting in a trade mark having effect in the 27 EU countries. It is necessary to apply either directly to the Community Trade Mark Office (OHIM) or via a national trademark office of an EU member state, which will forward it to OHIM.

An application for a CTM should include information about the applicant, a representation of the mark and a list of the goods/services for which registration is sought. The identification of goods is the key feature. The CTM application must be filed in any of the 22 languages of the EU (the "first language"). In addition, a second language that is one of the 5 languages of the OHIM (ES, GE, EN, FR, IT) must be indicated.

Once examination for absolute grounds¹ is completed, the CTMR is sent to the various countries for a search (in addition to a search by OHIM on CTMR).

The CTM is then published in the Gazette of the OHIM. If there are no objections from third parties, it is registered.

Barring any impediments to registration, the registration process takes approximately **12 to 18 months**. Trade mark owners can expedite the process by up to **six weeks** by paying the final registration fees as soon as the notification requesting them is received.

A legal person that has its place of business or a real and effective establishment in the Community may file an application directly through its legal representative. An employee is also entitled to file an application on behalf of the company to which he/she is attached with an authorisation signed by the legal representative. The employee of a subsidiary company can be classified as an employee of the parent company.

Costs:

Procedure	For 3 classes	Per class after 3
Classic application	900	150
Electronic application	750	150
Registration	850	150

Fees must be paid in euros. The basic application fee must be paid within a month of the date of submission of the application for the receipt date to be the filing date.

Duration of protection:

10 years from the date the application is filed. Registration may be renewed for further periods of 10 years. The request for renewal shall be submitted within a period of six months ending on the last day of the month in which protection ends. The fees shall also be paid within this period. Renewal shall take effect the day following the date on which the existing registration expires and shall be registered. After the Community trade mark has been registered, a period of **five years** begins. After this period, or any other

1. **Absolute grounds for refusal: reasons for refusing registration rooted in the nature of the mark itself, where it is descriptive, functional or objectionable.** Ex: Signs which are devoid of any distinctive character or which are contrary to public policy or to accepted principles of morality;

uninterrupted five-year period, a third person may act for forfeiture if the mark is not used in the EU.

Ownership of the right:

A CTM confers on its proprietor an exclusive right. The proprietor is entitled to prevent all third parties who do not have his consent from using in the course of trade the same or similar signs for identical or related goods and/or services as those protected by the CTM. A collective Community trade mark may be owned by several right holders.

What to do if I am copied:

The court that has jurisdiction is the court of the Member State where the defendant is domiciled (or has an establishment). Right holders can choose between suing a civil action and lodging a criminal complaint.

Civil action:

Relief that can be obtained: **Damages:** Based on estimated lost profits/lost sales/loss of goodwill, etc.; **rendition of accounts** of profits earned from sales of infringing goods; **delivery** of infringing goods. Factors that strengthen your **civil suit:** **trade mark** and/or copyright registration; reputation and goodwill of the **trade mark** which show that it has become source identifier for your goods, eg. sales figures, ads, invoices, length of use, record of enforcement, the stronger the **trade mark**, the broader the protection; evidence of misuse by the infringer. The CTMR national courts have exclusive jurisdiction in cases of: infringement against CTMR; threatened infringement; declaration of non-infringement; counter-claims for revocation.

Any rulings by one of these Courts have effect in the entire territory of the EU.

Criminal action:

May be sufficient to "clean the market". For cognizable offences, there are **two options**: a criminal complaint with the police for arrest and seizure or a criminal complaint before the district court for seizure. For non-cognizable offences, there are **two options**: a criminal complaint before the district court for a search and seizure warrant against infringing

parties or a criminal complaint before the district court for a search and seizure warrant against unknown persons. The **advantages of a criminal procedure**: immediate deterrent effect, lots of publicity, may lead to arrest, may lead to conviction, less expensive. Its **disadvantages**: can't settle, state case, no control, no permanent injunction, no damages, etc.

Good to know:

Advantages of a CTM: cost-effective protection throughout the EU; consolidation of registration in each Member State, simplified while retaining national seniorities. Use in one Member State is sufficient to defeat a non-use attack. OHIM will notify CTM proprietors of any later conflicting applications. It is not necessary to base a CTM application on a national registration or application. It is possible to convert a CTM into national applications in the event of a rejection. The payment of fees is split between application and registration. **Disadvantages of a CTM:** If a CTM application is rejected in any of the EU member states the entire application fails. The unitary nature of the system means the CTM cannot be assigned or transferred in only part of the EU. Since the only way to deal with prior conflicting rights before registration is through opposition, a large proportion of CTM applications have been opposed. However, most opposition appears to have been settled by agreement. The registration process can be lengthy (18-24 months) and even longer if a dispute arises.

- It is possible to cumulate the protection under trade mark, unfair competition, and copyright legislations in some countries.

The European Patent

Applicable law:

In the EU, patent protection is currently provided by two systems, neither of which is based on a Community legal instrument: the national patent systems and the European patent system. The national patent system has undergone *de facto* harmonisation with the signing of several international conventions, including the **Convention on the Grant of European Patents (the Munich Convention) on 05/10/1973** to which all EU Member States have acceded. It provides a single procedure for the granting of European patents, establishes the **European Patent Office (EPO)** to grant patents, which then become national patents subject to national rules. At present, 31 countries are

members of the European Patent Organisation. Although the Munich Convention creates a single system for granting patents, there is still no Community patent.

What can be protected?

Patents are granted only for inventions that are new, involve an inventive step and are industrially applicable. One way of checking whether or not your product or idea has already been invented and patented by somebody else is to consult esp@cenet, the EPO's free online database. For more information go to Patents and utility models, page 14 of this Guide.

Formalities:

Applications can be filed with the EPO in any language. However, the official languages of the EPO are English, French and German. If the application is not filed in one of these languages, a translation must be submitted. Although the services of a professional representative are mandatory only for applicants residing outside Europe, the EPO advises all applicants to seek legal advice. A request for the granting of a European patent must be filed on the form prescribed by the European Patent Office (Form 1001).

Examination:

It takes about three to five years from the date the application is filed for a patent to be granted. There are two main stages: examination of formalities and preparation of a search report. There is also a substantive examination in which the EPO, at the applicant's request, investigates whether the invention meets all the requirements.

Costs:

A large part of the cost of obtaining European patent protection in several European countries is incurred after the European patent is granted. For each country in which validation of the European patent is required, a translation needs to be filed into the national language of that state, with few exceptions. Since there are 22 languages in European Member States, this can represent a considerable cost if protection across Europe is required.

Duration of protection:

20 years as from the application date; 20 years from the International filing date for the national phase of PCT patents; 20 years from the European filing date for extension applications. The protection fees are to be paid annually, prior to the expiration of the year for which the protection fees have been paid or three months after the expiration date with a 25% fine or three to nine months after the expiration of the protection period at the latest with a 50% fine.

Ownership of the right:

Almost all attributes of a European patent, i.e. ownership, validity, and infringement, are determined independently under national laws.

What to do if I am copied?

Refer to the national fiches.

Specific recommendations:

Inventions can be protected either as a patent or a utility model. One of the fundamental differences is that patents have to do with audited property rights, whereas utility model rights are not audited. It is therefore easier, faster and less expensive to obtain utility model rights. The duration of a patent is usually 20 years, while utility model lasts 10 years. In Europe, utility models are available in Austria, France, Germany and Spain (non-exhaustive list).

How do I defend my creation at customs?

Applicable law:

Council Regulation (EC) No. 1383/2003 of 22/07/2003 concerning customs action against goods suspected of infringing certain IPR and the measures to be taken against those goods sets out the conditions under which the customs authorities may intervene in cases where goods are suspected of infringing IPR.

Scope of regulation:

The regulation defines "counterfeit goods" as: goods, including packaging, bearing without au-

thorisation a trade mark identical to the trade mark validly registered for the same type of goods, or which cannot be distinguished in its essential aspects from such a trade mark and which thereby infringes the trade mark holder's rights under Community law and/or the national law in the country where the application for customs action is made. "Pirated goods" are "goods which are or contain copies made without the consent of the holder of a copyright or related right or design right".

The regulation applies to any kind of IPR and any kind of customs regime (import, export, transit, transshipment) regarding traffic with third countries (not within the EU).

Procedure:

The system allows customs authorities, on their own initiative or upon request, to retain goods suspected of infringing certain IPR. Goods found to be infringing an IPR will be destroyed or disposed of outside commercial channels. To submit an application for action, the right holder must meet two conditions: provide a sufficiently accurate description to make identification possible and prove that the applicant is the holder of the right. The application may be national or European (community right/community application). All information on the IPR shall be translated into all national languages in this case. In each case, the application is accompanied by a declaration from the right holder accepting liability and the payment of all costs (storage; destruction...etc.).

Duration:

Customs authorities have no more than **30 working days** to give their decision. If accepted, the intervention is valid for at least a **year** (or more depending on country and IPR concerned). The application for an action allows a period of **10 days** (to be extended once upon request) to refer the matter to the competent authority and to obtain all the necessary information concerning the name and address of the declarant and, as the case may be, of the addressee. During this period, the right holder can also inspect the goods and receive samples.

A simplified procedure:

This allows goods to be abandoned for **destruction without the need to determine whether IPR has**

been infringed. It exists under several conditions: the written confirmation of the right holder within 10 days that the goods infringe its IPR and the written confirmation or silence of the declarant, consignee or holder of the suspected goods on the decision to destroy the goods. The destruction must be carried out, unless otherwise specified in national legislation, at the expense and under the responsibility of the right holder. The simplified procedure is optional for Member States and its implementation may vary from one country to another. Currently Bulgaria, Finland, France, Italy and Luxembourg do not apply it.

Good to know:

This application is free of charge and the control made has no link with any other customs control departments/information. However, several difficulties exist, like costs for the translation of the application forms into all languages of EU customs; for the mandatory representative of the company in each and every EU Member State; for storage and destruction of the infringing goods, added to the costs for the judicial procedure, which very often cannot be charged to any infringer on EU territory; coupled with the difficulties of making customs aware of the possible piracy of more than 5,000 new designs (per season and per right holder), especially for designs with short-term value.

Conclusion:

This customs procedure is useful for trade marks and also other Intellectual Property Rights. However, for designs, it is useful only if your designs have a significant commercial value and/or if you can provide specific information to customs to target the appropriate shipment/infringement.

How do I enforce my rights in Europe?

Applicable law:

Directive 2004/48/EC of 29/08/2004 on the enforcement of intellectual property rights.

Scope of the Regulation: It requires all Member States to apply effective, dissuasive and proportionate remedies and penalties against those engaged in counterfeiting and piracy. It applies to all infringements of IP rights under Community and national law. It applies to enforcement of intellectual prop-

erty rights, which include industrial property rights. It covers solutions available in the civil courts, but not criminal offenses.

Content:

It brings national legislation across the EU on civil sanctions and solutions closer into line with 'best practices'. It includes procedures covering evidence and the protection of evidence and provisional measures, such as injunctions and seizures. Solutions include the destruction, recall or permanent removal from the market of illegal goods, as well as financial compensation, injunctions and damages. There will be a right of information allowing judges to order certain persons to reveal the names and addresses of those involved in distributing the illegal goods or services, along with details of the quantities and prices involved. It also signals to Member States certain measures (such as the publication of judicial decisions and the development of professional codes of conduct) that contribute to the fight against infringements.

Good to know:

This directive has been implemented into national laws. Even though its measures are intended for acts carried out on a commercial scale, the Member States

may also apply these measures to non-commercial acts. Therefore, its implementation may vary from one country to another.

Main contacts at the EU level

OHIM: Office for Harmonization in the Internal Market- Avenida de Europa, 4 - E-03008 Alicante-Spain- Phone: + 34 96 513 9100 from 8.30 to 18.30 : www.oami.europa.eu

EPO: European Patent Office: 80298 Munich-Germany. Centralised EPO Customer Services: + 49 89 2399-4636. www.epo.org

CUSTOMS AUTHORITIES: please visit the EU website: http://ec.europa.eu/taxation_customs/customs/customs_controls/counterfeit_piracy/right_holders/index_en.html

EURATEX: European Organisation of Apparel and Textile - 24 rue Montoyer B-1000 Brussels- Phone: + 32 2 285 48 93 – Website: www.euratex.eu

For information from the EU Commission, please visit: http://ec.europa.eu/internal_market/indprop/index_en.htm

http://ec.europa.eu/trade/issues/sectoral/intell_property/index_en.htm

http://ec.europa.eu/enterprise/sme/support_en.htm

International Factsheet

What is the added value of international IP registration?

The overall increase in international trade and foreign direct investment has led to the need for an apt legal structure to protect intellectual property internationally in an easy, uncomplicated and cost-effective way. The following “one-stop-shops” or trade facilitators,

- the Hague System for the International Registration of Industrial Designs (“Hague”),
- the Madrid System for the International Registration of Trademarks (“Madrid”), and
- the Patent Cooperation Treaty for the International Registration of Patents (“PCT”),

all of which are administered by the World Intellectual Property Organization, allow firms, regardless of size and background, to adequately protect their IP in a number of designated countries in a very cost- and time-efficient way.

“Hague”, “Madrid” and the “PCT” are based on a similar idea. Consider the following case: a London-based footwear SME wants to expand its business into 15 countries worldwide. How can it ensure protection for the special technology (patent) associated with its shoe, the specific design of the shoe and the brand (the trade mark)? Without “Hague”, “Madrid” and the “PCT”, the SME would have to hire lawyers in all 15 countries to file for IP protection in the respective national languages with the respective national IP offices. Can you imagine how much time that would take, how complicated it would be and how much it would cost? If our shoe manufacturer took this approach, it would probably never be able to afford international expansion and might go out of business before even starting to think about going global. If, however, the company uses “Hague”, “Madrid” and/or the “PCT”, it will be able to protect its IP relatively quickly, at a relatively low cost, and may not even need a lawyer. Thus, the main value of these systems is to simplify filing and renewal procedures by offering a single entry point to many differ-

ent jurisdictions in one language with a single set of fees in single currency, while also guaranteeing protection in many different countries.

International design registration

Applicable laws:

International design registration is governed by the Hague System for the International Registration of Industrial Designs. This consists of the Hague Agreement (1925), revised at London (1934) and at The Hague (1960)² (supplemented by the Additional Act of Monaco (1961), the Complementary Act of Stockholm (1967), and the Protocol of Geneva (1975) and amended in 1979 and the Geneva Act (1999).

Who can file protection and in which country?

The following criteria need to be met to obtain international design protection:

The applicant must:

- Be a national of a country that is party to the treaty, thus a member state to the treaty or an international organisation adhering to the treaty;
- Have a domicile in the territory of a contracting country;
- Have a real or effective industrial or commercial establishment or habitual residence in the territory of a contracting country.

Protection can only be obtained in those countries that are party to the relevant treaties. For the time being, there are 56 contracting parties to the ‘Hague Agreement.’ The European Community is a member of the Hague Agreement and the Geneva Act, but not of the London, Hague and Stockholm Act. Individual members of the European Union have chosen to be members of the Hague Agreement, as well as the various treaties amending the Agreement. The

list of contracting parties for designs can be downloaded at: <http://www.wipo.int/hague>.

Formalities:

An application is usually filed through the National Patent Office, though in some circumstances it is also possible to file directly with WIPO. The necessary electronic documents can be downloaded from the following Web site, <http://www.wipo.int.treaties>.

This document contains the necessary explanatory notes to file an application.

No national application or registration is required for design protection. Up to 100 designs can be included in the same application, provided that they are all of the same class (according to the Locarno classification).

Costs:

The applicant pays a basic fee, a publication fee and either a standard fee or an individual fee for each designated party.

An in-depth overview of fees can be found in a document that can be freely downloaded on the WIPO Web site.¹

For example, registering one industrial design, with 10 reproductions, a description of 300 words in 10 different markets out of Spain costs 2,797 Swiss francs or 1,850 euros.

Examination:

International filing can be done directly through WIPO, i.e. through electronic filing. For design protection, examination procedures usually take 6 to 12 months. The applicant may request that the publication of the designs be deferred for a maximum of 30 months from the filing date.

Duration of protection:

Design protection is granted for 5 years initially but can be extended by an additional 5 years, up to the

total length of design protection allowed in the designated country. For renewal, it is necessary to fill out form "DM/35", available on WIPO's Web site.²

International trade mark registration

Applicable law:

International trade mark registration is governed by the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to the Madrid Agreement.

Who can file protection and in which country?

The following criteria need to be met to obtain international trade mark protection.

The applicant must:

- Be a national of a country that is party to the treaty, and thus a member state to the treaty or an international organisation adhering to the treaty;
- Have a domicile in the territory of a contracting country;
- Have a real or effective industrial or commercial establishment or habitual residence in the territory of a contracting country.

Protection can only be obtained in those countries that are party to the relevant treaties. Currently, there are 72 contracting parties to the Madrid Protocol and 57 contracting parties to the Madrid Agreement. The European Community is a member of the Madrid Protocol, but not the Agreement. Individual members of the European Union have chosen to be either a Member of the Protocol, the Agreement or both. The list of contracting parties can be downloaded on WIPO's Web site, <http://www.wipo.int/treaties>.³

Because the number of contracting parties is limited, a trade mark owner cannot rely on the system in some parts of the world, including huge parts of Latin America.

1. <http://www.wipo.int/hague/en/fees/sched.htm>

2. <http://www.wipo.int/hague/en/forms>

3. http://www.wipo.int/treaties/en/documents/pdf/madrid_marks.pdf

Formalities:

International trade mark applications can only be filed through a national patent office and not directly through WIPO. WIPO's Web site (<http://www.wipo.int/madrid>) contains all necessary documents, as well as explanatory notes relating to trade mark registration.

WIPO suggests directly contacting its trade mark sector and filling out the forms, which allows WIPO to reply via e-mail to your queries.

Sector of Trademarks, Industrial Designs and Geographical Indications

World Intellectual Property Organization

34, chemin des Colombettes, P.O. Box 18,

1211 Geneva 20, Switzerland

Tel.: (41-22) 338 9111

Fax.: (41-22) 740 1429

Costs :

An in-depth overview of fees can be found in a document that can be freely downloaded on the WIPO Web site, <http://www.wipo.int/madrid>.⁴

The applicant pays a basic fee, a designation fee and a supplementary fee for each class of goods and services beyond 3 and a complementary fee for the designation of each contracting party.⁵ For example, registering a trade mark in colour, including graphical designs in 10 different markets, in 10 different classes with a basic registration in Spain costs 7,412 Swiss francs or 4,904 euro, excluding attorney fees.

Examination:

The examination for international trade mark protection generally takes maximum 18 months if it is not denied. When filing for international trade mark registration, an applicant should be aware during the examination process that the international mark depends on the national mark. For the first 5 years, international registration is completely dependent on the basic application. This means that during the first 5 years of the life of the international registration if the basic application or registration is refused, withdrawn, cancelled or restricted, in part or in

whole, the international registration ceases as well. However, after 5 years, the international registration becomes independent of the national registration.⁶

Duration of protection:

Trade mark protection is granted for 10 years and may be renewed for an additional 10 years by paying a renewal fee to WIPO.

International patent registration

Applicable law:

International patent registration is governed by the Patent Cooperation Treaty.

Who can file protection and in which country?:

The following criteria need to be met to obtain international patent protection:

The applicant must:

- Be a national of a country that is party to the treaty, thus a member state to the treaty or an international organisation adhering to the treaty;
- Have a domicile in the territory of a contracting country;
- Have a real or effective industrial or commercial establishment or habitual residence in the territory of a contracting country.

Protection can only be obtained in those countries that are party to the relevant treaties. Currently, there are 141 contracting parties to the Patent Cooperation Treaty.⁷ The European Community is not a member of the PCT, however individual members of the EC are members of the PCT.

Formalities:

All an applicant needs to know about direct filing with WIPO can be found on the following Web site:

6. USPTO: The Madrid Protocol: Frequently asked Questions by US Trademark Owners Seeking International Rights, p.5 <http://www.uspto.gov/web/trademarks/madrid/madridfaqs.htm>

7. The list of contracting parties can be downloaded at: http://www.wipo.int/pct/guide/en/gdvol1/annexes/annexax_a.pdf

4. <http://www.wipo.int/madrid/en/fees/sched.html>

5. The fee calculator can be found at: <http://www.wipo.int/madrid/en/fees>

<http://www.wipo.int/pct/>

WIPO has set up some supports to help with the application:

For the "PCT":

PCT Information Service

Telephone: +41 22 338 8338

Fax: +41 22 338 8339

E-mail: pct.infoline@wipo.int

Web site: www.wipo.int/pct/en/infoline.htm

To file international patent applications directly with WIPO, please contact:

PCT Receiving and Processing Section

34, chemin des Colombettes

CH-1211 Geneva 20, Switzerland

Telephone: +41 22 338 9222

Fax: +41 22 910 06 10

E-mail: ro.ib@wipo.int

Costs:

The applicant pays a basic fee, a designation fee and a handling fee. An in-depth overview of fees can be found in a document that can be freely downloaded on the WIPO Web site.⁸

Applicants who file electronically may be entitled to fee reductions. More details about PCT electronic filing can be found at www.wipo.int/pct-safe/en/.

For example, filing with the Austrian, Spanish and Finnish patent offices through the PCT costs 13,047 Swiss francs or 8,633 euros if filed electronically and in under 30 pages. This fee includes examination fees, handling fees, search fees, transmission and international filing fees, plus the e-filing reduction.

Examination:

Once the application has been received by WIPO, it checks whether all the formal requirements for IP protection have been met.

Note: WIPO does not undertake any substantive examination of the application, it only checks that all the formalities have been met. Furthermore, the decision of whether or not to grant protection is up to the applicant's national patent office, not to WIPO. This being said, it is rare that a national

patent office rejects an application that has been filed through WIPO. If no refusal is presented by a contracting party within the prescribed time limit, international registration is granted. The time from filing to registration usually takes 18 to 30 months, as long as there are no objections. In the context of a patent application, the PCT also offers an international search report and allows patent applicants to "buy time" because an applicant has at least 18 months before it needs to meet the national requirements.

Duration of protection:

Patent protection is granted for 20 years and must be maintained through the payment of annual fees to the international bureau of WIPO.

Main take away

The Hague Agreement, the Madrid System and the PCT have turned international IP protection into an economical and simple affair by requiring minimal formalities and expenses. The fact that various languages are accepted for filing allows a multitude of market participants to file in their native language. Less red tape and a predictable time frame for trade mark registration have further helped convince stakeholders to use this system. However, this being said, it must be stressed that the geographical coverage of the "Hague", "Madrid" and "PCT" system is still limited. Many crucial markets, such as Argentina, Bolivia, Panama or Cambodia are not covered by "Hague", "Madrid" or the "PCT", meaning the system does not provide any help in these markets.

Action against infringement at the international level

Any potential litigation will not be dealt with centrally but under the law of the respective country. This means that there is currently no international "one-stop-shop" for litigation. In the case of infringement in foreign markets, a right holder has to deal with the legal context provided in various different jurisdictions. In this respect, at least, the TRIPS Agreement provides for minimum enforcement standards that members of the WTO need to abide by. However, there is no supranational system of enforcement.

8. <http://www.wipo.int/pct/en/fees>. An overview of a reduction in fees is available at: http://www.wipo.int/pct/en/fees/epo_fee_reduction.htm

If the holder does not want to pursue litigation, it may opt for mediation and arbitration, also called “alternative dispute resolution.” The advantages of this approach may be that it is cheaper than litigation and the holder may keep its trade secrets since it is a “closed door” procedure. The WIPO Arbitration

and Mediation Centre⁹ serves as a forum for all forms of IP disputes. The International Trade Mark Association INTA, <http://www.inta.org>, and the CPR Institute for Dispute Resolution, <http://www.cpradr.org/>, offer a list of neutral mediators, as well as information on alternative dispute resolutions, in cases involving trade marks and unfair competition.

9. <http://www.wipo.int/amc/en/index.html>

Case Studies

Textiles and clothing

Design

The following case study is an example showing that even if a design is unprotected, you can take action if it is copied.

A Spanish textile company was sentenced for copying an unregistered design, and had to pay an indemnity of more than 20,000 EUR for damages to the textile SME that created the original design.

Company A, from Spain, presented a new striped fabric it created at several trade fairs. Company B, also from Spain, placed an order for this fabric but never confirmed it to Company A. Unexpectedly, a few months later, Company B started manufacturing garments with the same design. The innovative aspect of the design was a key issue in solving this case: though Company B said striped fabrics are not original, Company A was able to demonstrate that their stripes, as well as the combination of colours, had a highly creative component which gave them originality and singularity, so a court in Barcelona agreed to apply the European norm for unprotected designs.

Company X operates in the clothing sector, and its design department creates a new collection every year. Six months after having exhibited its next collection for the first time at a national fashion event, Company X decided to apply for design registration for 5 new models. Company X filed its application through the Portuguese Industrial Property Institute (INPI) Web site. To benefit from the 12-month grace period that allows disclosure prior to the application date, the company indicated its participation in the national fashion event, the date and place at which it occurred and presented a document certifying that the models in question were disclosed at the event. If the disclosure of their creations had occurred prior to the 12-month period, these models would no longer be considered new and, therefore, wouldn't be eligible for registered design protection.

The following case study is an example of what can happen when you don't protect your creations, namely through design protection.

Company A operates in the Personnel Protective Equipment (PPE) sector, and most of its clients are big, international clients. One of its clients placed a large order and simultaneously asked Company A to develop a specific design for those products. Company A did so, showed it to the client and, surprisingly, saw the order cancelled. Later on, Company A saw its products exhibited in a fair by a Chinese Company and also learned that the root was that lost client who, after cancelling the order, placed the same order with a Chinese company for a lower price. When this happened, it was too late for Company A to reclaim the design authorship.

Unregistered Community Design

A report by Verband der Deutschen Heimtextilien-Industrie e.V. (association of the German home textiles industry) (www.heimtex.de)

The company concerned is a German manufacturer of high quality fabrics for curtains and decoration. As an exhibitor, it regularly showcases its new collections at Heimtextil Frankfurt, Germany's leading trade fair for home textiles.

If the textile pattern is new and has individual character, the company automatically acquires an unregistered Community design right (UCD) for the design, simply by making it available to the public. The priority certificate may serve as evidence of the disclosure (evidence can also be provided via the industrial association or lawyer's office) if the design is not entered in the register within the grace period. There are no costs for this type of design protection, but it only lasts three years and the design is only protected against copying.



Fig. 1. Design of Alfred Apelt GmbH
(www.apeltstoffe.de)



Fig. 2. Seized copy at discounter



Fig. 3. Copy Original

Photos: Alfred Apelt GmbH, Courtesy of "Verband der Deutschen Heimtextilien-Industrie e.V", 2009.

In this case, tablecloths and runners with the pattern (Fig. 1), designed by Alfred Apelt GmbH (hereinafter A), were offered for sale at a food retail chain (hereinafter B) (Fig. 2) without obtaining approval by A. The copied pattern corresponded in every design feature to the protected design (Fig. 3).

A decided to enforce his UCD by legal action. At the hearing on a request to cease and desist, B divulged its upstream supplier (hereinafter C), purchasing volumes and prices, and undertook to withdraw the product from the market while promising to pay a penalty in the event of a breach of contract. C, on the other hand, also made a declaration to cease and desist, incurring a penalty for breach of contract in favour of A, and divulged its upstream supplier/manufacturer, as well as all order information. On the basis of the infringer's profits gained by B, settlement negotiations were also conducted with C on a lump sum compensation for damage suffered from the sale of the infringing goods because, during the out-of-court negotiations, B had only agreed to divulge its upstream supplier C on the condition that all claims by A against B be fully and finally settled. However, this agreement was made on the condition that the agreement was no longer valid if A and C could not reach consensus on the payment of damages. In the end, A and C reached agreement on the payment of damages.

Conclusion:

Although the claim to information about the upstream supplier and purchasing volumes and prices can now be enforced, under certain circumstances, using an urgent court order, infringers regularly provide the requested information to avoid a further dispute with the right holder. In addition, they sign a declaration to cease and desist with a penalty clause, by which the cause of complaint is removed.

In the individual case, it can be helpful if the enforcement of IP rights is supplemented by PR activities, within the allowable limits.

The UCD constitutes a cost-neutral 'first measure' that provides protection against copying and is limited to a non-extendable period of three years. Although Germany's supreme court has rendered decisions on UCDs, a registered right is more easily enforceable over a longer period of time.

Trade mark

The famous German clothing and accessories' firm started in Metzingen in the 1920s becoming a public company only in 1985. Commercial success and a worldwide distribution network have exposed the brand to a surge in counterfeits and trademark oppositions but an in-house lawyer is playing a proactive role. Working closely with the creative department allows identifying at an early stage what and how to protect.

Patent

Company Z is a textile company that produces high-tech sports gear. Its clients are all major international sports brands. Recently a cooperative project between Company Z and a client, Company X, led to discovery of a new sewing method. The two decided Company Z would retain patent rights to the invented technology, and Company X would be the exclusive licensee. Meanwhile, a competitor, company F, began producing sports gear similar to that that was patented. Prosecution currently under way in the UK and DE.

Two years ago, some home textiles were made using a specific type of yarn with a specific composition. In the end, the final product was presented to the clients with additional characteristics, and every home textile company was using the same composition. One day, some of the companies started to hear from a Belgian company that managed to register a patent, first national, then European, for the specific composition of that yarn and its benefits in the final product.

This was something that every home textile company was doing, so they thought patenting it was impossible.

The result was that many companies had to remove their products in the countries where the patent was valid or pay a high fee.

Copyrights

Small Enterprise X introduced children's T-shirts decorated with cartoon characters onto the market. The enterprise did not find any trace of the characters in the trade mark and design databases and so presumed that they were not protected and that their use was legal. The enterprise did not understand

that the cartoon characters were protected under copyright. As copyright is a self-executing right, it was not registered in any database. It was a surprise, therefore, when they received a declaration from Company Z, a cartoon film producer, that stated that X was infringing its copyrights. Small Enterprise X reached an out-of-court settlement with Company Z. Enterprise X could continue selling the product after payment of compensation and royalties from further sales. The compensation resulted in the loss of a few years' profit for small Enterprise X.

Leather

Design

The HUGO BOSS IP portfolio is carefully reviewed, notably as regards the new possibilities offered by EU registered designs. Design rights are used mainly for leather products, such as bags or wallets and shoes. This is having an impact and the success is visible, especially in the creative department, as stylists see that the value of their work is not being underestimated.

A Bulgarian manufacturer of summer bags displays on the market, during the season, original products that prove so successful he can't meet the demand. Inspired by the success, he invests the entire gain in improving his production equipment and produces a significant number of bags to offer on the market next season. However, another enterprising Bulgarian, seeing the success of the articles, organises their production abroad and imports into Bulgaria a great number at a much lower price. When the first manufacturer realises he is about to fail in the realisation of his product due to the uncompetitive prices, he decides to protect his rights by registering a design. He applies to the patent office to find, regretfully, that he is too late since the novelty of his design is already gone. As a result, the first manufacturer suffers losses leading to termination of his business. If, prior to placing his goods on the market, the manufacturer had protected his interests by registering an industrial design, he could have prevented the entry of the competing articles into Bulgaria with the assistance of the customs authorities under Bulgarian law.

Trade mark

The two Collective Trade Marks presented above are owned by UNIC, the Italian Leather Trade Association, and are at the origin of the mega-seizure by



Italian authorities of counterfeit and pirated leather goods called Operation “Toxic Shoes” in September 2008. 1.7 million leather products worth some 20 million EUR were confiscated in warehouses in Tuscany, Lazio and Calabria, ridding the market of illegal goods that were also found to be dangerous to consumers. Licensed users of these marks have to respond to strict quality specifications.

A legal challenge is the protection of trade marks like BOSS or HUGO. Their registration may not be taken for granted in certain countries, as exclusive rights for the word HUGO may be opposed by name holders in say, Spain, and BOSS is a word with a meaning in English (chief or director). Nevertheless HUGO BOSS is recognized as a famous trade mark in class 25 in China.

Before launching product Z on the market, Company Y decided it was important for its marketing strategy to associate it with a new trade mark. In this endeavour, the company has spent a considerable amount of money to create the most appropriate trade mark. The product was launched in the market with its new trade mark. However, the company has neither registered the new trade mark nor done a search of trade mark databases in order to make sure it wouldn't infringe another company's rights. After a few months, the police apprehended their products, and the company was accused of copying the trade mark of Company W. Company Y was using a trade mark similar to Company W's registered trade mark. As a result, Company Y has been ordered to make a compensation payment to Company W and has suffered substantial losses as a result of the investments made in its marketing strategy and from the production costs of the products that were subject to destruction.

Footwear

Trade mark

15 years ago, a small Lithuanian enterprise started building a network of haberdashery and footwear shops. For different reasons, the enterprise was forced to change its brand name twice. That caused a loss of customers. Shortly after the new brand was registered with the National Patent Office as a trade mark, like lightning out of a clear sky came a claim by the famous Italian company of Gianni Versace. It accused the enterprise of unfair competition and declared that the Lithuanian trade mark was very similar to the Italian trade mark “Versus Versace”. The National Patent Office examined the Italian complaint and confirmed this. It came as a big shock to the Lithuanian enterprise since it did not have such intentions. Sadly enough, before registering the trade mark, the company had invested more than one million Litas in the business to introduce the new mark. That demonstrates how important it is to carry out a thorough investigation before applying for a trade mark!

Company W positions itself in the footwear market as an innovative enterprise. It has recently developed a new collection of sandals, which have both a new shoe sole concept and original design models. Considering the market potential of this collection the company has also decided to create a new trade mark that should be associated with it. In order to obtain higher security for the novelty of these innovations, Company X has done searches in the Portuguese Industrial Property Institute (INPI) design and trade mark databases, available online free of charge, and has asked INPI services to search patent databases. Nothing similar was found in any of these areas. Therefore, before launching their new collection on the market, Company X decided to apply to register its new trade mark, new sandals design and the protection by patent of its innovative sole concept.

Patents

Inventor X constructed a special football boot. He applied for a patent in country Z and then offered the invention for sale to a big name sport apparel manufacturer, Company Y. Company Y did not buy the invention but a few years later introduced the football boot onto the market of country Z as its own product. Inventor X had a patent for the invention and filed a patent infringement lawsuit against Company

Y. In response, company Y initiated an invalidity procedure. As a result of the invalidity procedure, the patent remained valid. The inventor won the lawsuit and received substantial compensation. However, because the football boot was only protected in country Z, inventor X must tolerate the fact that Company Y is free to sell the boot in other countries. Even today, Company Y receives substantial income from these sales.

Action at customs

Company Y received information that its new shoe collection was being produced in China and commercialised in Portugal. Since Company Y had duly registered this collection design in Portugal, it contacted the Portuguese police to present a complaint on the infringement of its rights. The company also decided to inform the Portuguese Customs and Special Taxes Department that goods that violated its industrial property rights were coming into Portugal from China. These actions enabled the apprehension of goods that were already being commercialised in Portugal and enabled the Portuguese customs to seize a container of goods that passed through their control some months later.

Furniture

Designs

The holder of a registered industrial design for furniture notifies the patent office that his rights to the design have been infringed, and the patent office initiates administrative proceedings. A check is done at the factory indicated by the design holder, where it is established that the articles have an identical design. A statement of infringement is drawn up, as well as a penal provision. The infringer appeals the penal provision in court but fails. As a result, a penalty is imposed on the infringer, and the object of the infringement is destroyed.

“JOIN” is a company that designs and produces furniture. It protects some of its designs in Greece. Two of its bedroom models, one protected by a design title and the other without, were copied. The company launched judicial proceedings. For the unpro-

tected design, according to unfair competition law, the judge ordered the infringer a) to withdraw the products from the market, and b) to make an announcement in the media. For the protected design, the infringer was given a 10-month prison sentence and was ordered to pay a 3,000 EUR fine and 15,000 EUR indemnity, as well as the court costs.

SME A has been among the leaders on the Polish market of exclusive home furniture for over 30 years. It has also long been the owner of several certificates of registration and protection. In spite of that, in 2004, another Polish company, SME B, started to introduce onto the market counterfeits of SME A's products (faithful copies) that were imported from China as “no name” products. SME B argued their products were bought in Singapore and manufactured in China and denied that SME A was the author of the industrial design (but said SME A purchased the design in China/Singapore and registered it in Poland as its own). As a result, SME A sued SME B for infringement and got a favourable judgment ordering SME B to cease importing and marketing the counterfeits. By another court action (for surrender of unlawfully obtained profits) SME A was awarded compensation for losses caused by SME B's activity.

Trade mark

The Lithuanian Enterprise X produces settees and cabinets. As the local market develops rapidly, the competition gets more and more intense. Company X chooses to invest in brand advertising and trade mark marketing. It tries to make its trade mark visible on all relevant details of the furniture. The media advertising strategy also helps increase its sales. Last year, sales were at 250%, undoubtedly the result of its sound and powerful trade mark name and extensive marketing activities. Recently it decided to extend the warranty period an extra year (one year is standard for furniture producers) as a sign of its excellent quality and to become most competitive in the market.

Based on Enterprise X's sales strategy, we draw your attention to the fact that “if you want to acquire a customer, you need to have a strong trade mark and develop your brand”.