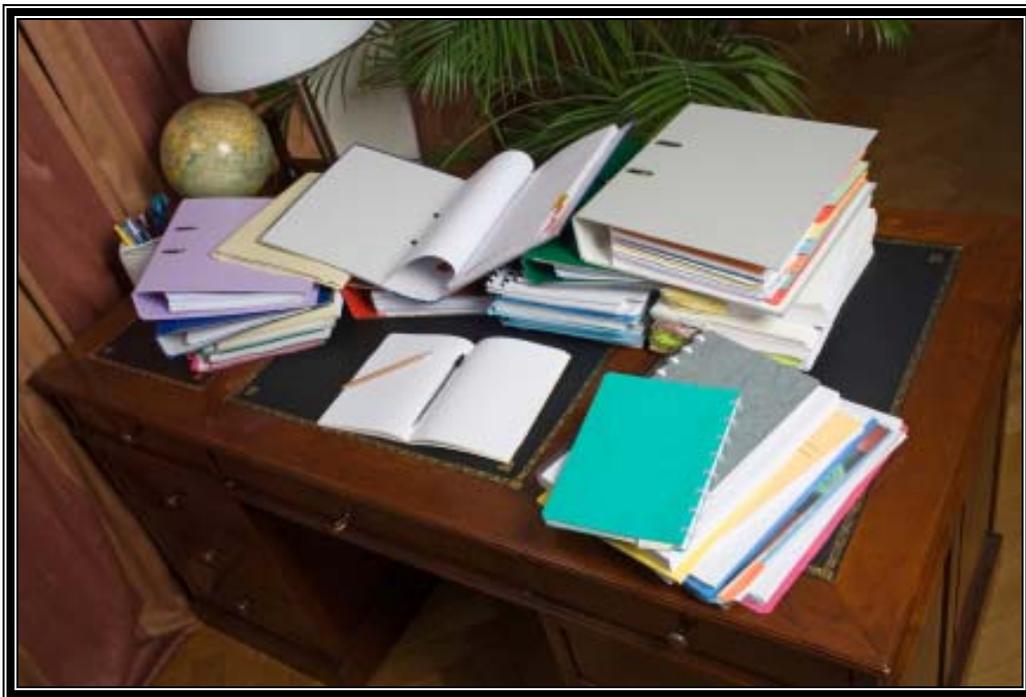




INTERNATIONAL
INTELLECTUAL
PROPERTY
INSTITUTE

How to Police Your IP – A Guide for Small and Medium-Sized Enterprises (SMEs)
Molly Torsen, IIPI



© istockphoto / Franky De Meyer, 2006

One of the biggest obstacles for SMEs that would like to use intellectual property (IP) in developing countries is the policing and enforcement of their IP abroad, particularly in leading markets like the United States and Europe. The trade in counterfeit goods is definitely no longer limited to cheap copies of luxury goods; almost every product on the market is being illegally copied, including food, pharmaceuticals, airplane parts, toys and electronic goods. This guide will discuss the different cost-effective methods SMEs have used to ensure their IP rights are not violated.

This report does not constitute legal advice. This document does not establish an attorney-client relationship. Neither IIPI nor its authors accept liability for any loss that may arise from reliance on the information contained in this report.

I. IP Enforcement Basics for SMEs

a. Copyright

Technological Protection Measures
Copying
Moral Rights

b. Trademark

Educating the Consumer

c. Patent

d. Industrial Design

e. Trade Secret

II. Contracting and Avoiding Litigation

a. International Mediation and Arbitration

III. Low-Cost Policing

a. Formulating a Menu of Policing Options: Regional and International

b. Using the Internet to Find Infringing Goods

I. IP Enforcement Basics for SMEs

Intellectual property is a valuable tool small businesses can use to protect different aspects of their creative activities. While there are various categories of intellectual property inherent in the everyday business operations of small businesses, there are several elements in these categories of intellectual property (IP) that have little to do with each other. For example, there is often no need to register a copyright in a work; it exists upon the creation of a copyrightable expression and lasts for the entire life of the creator plus another fifty to seventy years. On the other hand, to receive a patent in an invention, an inventor must apply for a patent and be issued a patent, the duration of which is generally less than 20 years. Not only are the various types of IP different from each other; they are also protected differently depending on their jurisdiction. The manner in which an SME must go about protecting and policing its intellectual property is dependant upon the type of IP it has and the jurisdiction in which it is located or does business. Perhaps the only strong similarity amongst all the policing activities and jurisdictions is that it is generally *the IP owner's responsibility to act as his or her own policeman*.

This guide to policing IP will examine copyright, trademark and patent law in turn; these are the three major categories of intellectual property. It will look briefly at industrial design and trade secret law. From there, it will look at how the formulation of a thorough and fair contract can overcome some of the issues in business dealings which can help protect intellectual property from misappropriation. Interspersed throughout, it will consider some low-cost policing activities and mechanisms that have proven useful for SMEs around the world.

Elements of an SME's IP policing plan should include:

- **Recognition of responsibility to monitor one's own products as well as products in similar lines of goods and services.**
- **Taking stock of all the IP inherent in one's business. This can include a vast array of things, including a primary product itself (copyrighted music CDs, trademarked handbags, patented medications, e.g.), client lists (trade secret), dedicated accounting software (possibly a business method patent, e.g.). It is important to remember that a single product may be comprised of several forms of IP. A coffee pot, for example, might have a patented water heating mechanism, a sleek design protected by industrial design or copyright law and a colorful logo protected by trademark law.**
- **Learning the basic IP law of the jurisdiction in which the SME is based and the major countries in which the SME does business, such as export markets. If feasible, an IP rights holder should apply for protection for trademarks, industrial designs and patents in these jurisdictions.**

- **If an SME is considering bringing suit against an entity that is infringing its intellectual property, it should assess its chances of winning a case and calculate the amount of compensation and/or damages and attorney's fees that would be at stake. An SME should also calculate the amount of money it is losing or will likely lose in the future due to the infringement.**

A. Copyright

Copyright is a form of intellectual property protection provided by a jurisdiction's law. There is no international law of copyright although there are a few main international treaties that employ minimum standards with which signatory countries must comply but there are very few generalizations about the *mechanics* of copyright laws that hold true across all jurisdictions. That being said, there are some generalizations that can be made with regard to copyright laws' overarching *purpose* and *subject matter*.

Copyright laws tend to cover literary, dramatic, musical, and artistic works. Copyright protection subsists in a creative work and is separate from the physical object itself. For example, an artist can sell his painting but he still retains copyright in that work even if he never sees it again and the owner of the painting moves to the other side of the world. Unlike other forms of IP, it is not necessary to register a work to receive copyright protection; copyright subsists as soon as a work is finished in a fixed medium. That being said, it is beneficial to register works for several reasons, one of which is that, depending on the jurisdiction, they must be registered prior to the reward of any damages resulting from trial. Also, if a work is registered with a collecting society, it may help ensure a fair distribution of royalties.

Copyright laws generally bestow upon their owner the exclusive right to do or to authorize third parties to do the following:

To reproduce the work in copies;

To prepare derivative works based upon the work;

To distribute copies of the work to the public by sale or other transfer of ownership, or by rental, lease, or lending;

To perform the work publicly, in the case of literary, musical, dramatic, and choreographic works, motion pictures and other audiovisual works; and

To display the work publicly, in the case of literary, musical, dramatic, and choreographic works, or other audiovisual work.

The owner of these rights may or may not be the author of the original work. In some jurisdictions, certain non-economic rights, called moral rights, inhere in and must remain with the author. These rights include privileges pertaining to the integrity of the work,

whether the author's name is attached to it, and a short list of other related entitlements. In other jurisdictions, the author may assign or license these rights to a third party, if those rights exist at all.

Enforcing Copyright

A. *Anti-circumvention of Technological Protection Measures*



Paolo Neo, Public Domain Photos

In recent years, the explosion of digital music and movies has brought about some special legal provisions to protect rightsholders who choose to use technological protection measures (TPM) to help ensure that the content on their digital products is not copied. Digital rights management (DRM) is an umbrella term for the management aspect of TPMs and other measures that manipulate digital technology insofar as it secures, or attempts to secure, its content from putative copyright thieves. Examples of TPMs include watermarks superimposed on digital imagery and “spoiler signals” which effectively ruin sound quality in copies of an original sound recording. The image below is an example of a watermark; Corbis has superimposed its logo across this photograph to protect it from being used by entities that do not first license it.



Snow covered cabins on mountainside, 42-15683243| RF| © Royalty-Free/Corbis

A European Copyright Directive¹ and the United States Digital Millennium Copyright Act (DMCA) make it illegal for endusers to circumvent TPMs – that is, tamper with or break them to attain access to the underlying content. The DMCA, for example, is comprised of four main provisions in this vein. It prohibits circumventing access controls; it provides for an access control circumvention device ban (sometimes called the trafficking ban); it bans copyright protection circumvention devices; and it prohibits the removal of copyright management information. The DMCA allows for both civil remedies and criminal penalties for violations of its anti-circumvention provisions. If the violations are determined to be purposeful, for commercial profit or private financial gain, the court can order significant fines and/or imprisonment.

Civil remedies for copyright infringement have not always proven to be sufficient deterrents. Many copyright infringers/pirates see confiscation and fines merely as a cost of doing business. As such, criminal remedies have been placed in copyright law updates with more frequency and bite. In the DMCA, for example, first time offenders may be fined up to \$500,000, imprisoned for five years, or both. For repeat offenders, the maximum penalty increases to a fine of \$1,000,000, imprisonment for up to ten years, or both.

These references to law having been made, it is essential to note that it will often save time and money to try to resolve an anti-circumvention – or infringement – matter with the party that seems to be in violation of the law. Mediation and arbitration (discussed below) are often very good options before resorting to a court of law. Organizations that represent copyright owners may be able to give free or inexpensive advice (e.g., Volunteer Lawyers for the Arts organizations or the Writer’s Guild of Canada)

A non-exhaustive list of organizations

International

The International Confederation of Societies of Authors and Composers (CISAC) <http://www.cisac.org>
The International Federation of the Phonogram Industry (IFPI) <http://www.ifpi.org/>
The International Federation of Reproduction Rights Organizations (IFRRO) <http://www.ifrro.org/>

National and Regional

The Japanese Society for Rights of Authors, Composers and Publishers <http://www.jasrac.or.jp>
The Australasian Performing Right Association <http://www.apra.com.au/default.asp>
The American Society of Composers, Authors, and Publishers <http://www.ascap.com>
Broadcast Music, Inc. (United States) <http://www.bmi.com/>
The Music Publishers’ Association of the United States <http://www.mpa.org/>
The Society of Composers, Authors and Music Publishers of Canada (SOCAN) <http://www.socan.ca>
La Société Professionnelle des auteurs et des compositeurs du Québec <http://www.spacq.qc.ca>
The German Authors’ Society (GEMA) <http://www.gema.de/engl/>
The United Kingdom Performing Rights Society <http://www.mcps-prs-alliance.co.uk>
La Société des auteurs, compositeurs et éditeurs de musique (France) <http://www.sacem.fr>
Buma/Stemra (the Netherlands) <http://www.bumastemra.nl/en-US/Home.htm>
The Sociedad General de Autores y Editores (Spain) <http://www.sgae.es>

¹ Directive 2001/29/EC of the European Parliament and of the Council of 22 May 2001 on the harmonisation of certain aspects of copyright and related rights in the information society

B. Copying

For copyrighted goods that have been copied without permission (such as sound recordings on discs or DVD copies), the police are the general enforcement authority although a given infringement incident must usually be brought to their attention. Depending on the jurisdiction, a copyright owner can accomplish this in a number of ways.

- Inform the police. In favorable circumstances and if the infringement activity warrants immediate action, the police may only need 24 hours' notice in order to secure warrants.
- Alert customs officials. Customs officials can keep an eye out for certain goods and impound them when they arrive; they are generally allowed to exclude infringing goods from entering into the country of destination, which subjects those goods to seizure, forfeiture and/or destruction. Action can generally be taken against an importer. Infringing goods come from all over the world, via air, ground and water; customs officials are trained to be on the look-out for a variety of goods and an array of clues that point to infringement activity.



© istockphoto / Mike Clarke, 2006

- Use a local (or international) trade association as a platform for reporting piracy. The Software and Information Industry Association (SIIA), for example, maintains a webpage through which any individual can report a variety of piracy activities, as does the Entertainment Software Association. These are two examples of American trade associations; other large national and international organizations include the British Video Association, the International Federation of the Phonographic Industry, the International Trademark Association, the

Motion Picture Association of America, the International Chamber of Commerce through the Business Action to Stop Counterfeiting and Piracy (BASCAP) and the Alliance Against IP Theft.

· Corporations that are heavily affected by IP theft also offer platforms through which consumers can report instances of piracy. Microsoft, for example, provides an interactive form on its website where piracy can be reported.

C. *Moral Rights*

Mentioned above, moral rights are non-pecuniary rights that inhere in a work, imparting a layer of protection of that work's integrity. Some basic moral rights include 1) the right of integrity such that a work is not distorted or ruined; and 2) the right of paternity such that the author's name is affixed to his work. The strength of any given moral rights laws depends on the jurisdiction. European countries tend to value these rights while common law jurisdictions place less emphasis on them. Enforcing moral rights can be very difficult. Because very few jurisdictions have strong protection for moral rights, it has become common practice in some jurisdictions for standard contracts to include clauses wherein an author or artists automatically assigns these rights to whatever entity he or she is contracting.



© istockphoto / Clayton Hansen, 2007

Artist/gallery contracts in the United States, for example, have been known to include clauses whereby an artist forfeits his moral rights. (The United States offers limited moral rights to a narrow genre of artworks). In other jurisdictions, such as France, clauses like that would have no legal effect since moral rights are inalienable; that is, an artist cannot give them away at all. It is important, then, for artists and authors to understand that their jurisdiction may offer at least a limited set of moral rights and that it is often their responsibility to negotiate to keep them.

B. Trademark

From handbags to batteries, counterfeit products are flooding the marketplace, flying in the face of the tenets of any given country's trademark law. In a recent study in China, a notorious center for fabricating counterfeit goods, customs agents confiscated products infringing IP in 1,051 cases.² Of these cases, 1009 were trademark infringements, 26 were patent infringements and 16 were copyright infringements. Like copyright law, the specific components of a trademark law depend on the jurisdiction(s) in which the trademark owner operates.

Some things to keep in mind – again, depending where an SME is doing business – include:

- Translate the SME's name, phrases and/or slogans. If doing business in China, for example, an SME should consider filing both the English name and its Chinese characters.
- An SME should file its trademark within the categories that it belongs, keeping subcategories in mind. Checking these subcategories for similar trademarks filed by competitors and/or infringers could be helpful in staving off future infringements.



Photos courtesy of AppleInsider.com

While there is something of an international “clearinghouse” mechanism through which trademark owners can apply for protection in several jurisdictions at the same time, there is no universal or international trademark law. The clearinghouse mechanism is administered by the World Intellectual Property Organization (WIPO) and is called the Madrid System. An applicant's home country must be a member of the Madrid system (as of October 2006, there are 79 member countries of the Protocol or System³) and the trademark must have been registered or successfully applied for within that country.

² See Matthew A. Powelson, Grace Li and Edward J. Kelley, *Getting the Black Market to Knock It Off: Strategies to Enforce Trademark Rights in Asia*, May 2006, available at http://calbar.ca.gov/calbar/pdfs/sections/ipsection/2006-09-07_panel-5_black-market_kelly-powelson-li.pdf

³ For more information about the Madrid Protocol and Madrid System and how they interrelate, see Madrid System for the International Registration of Marks, available at <http://www.wipo.int/madrid/en/>.

National or regional trademark offices maintain a register of trademarks which contains full application information on registrations and renewals. This enables trademark examination, search, and potential opposition by third parties. A trademark provides protection to the owner of the mark by ensuring the exclusive right to use it to identify goods or services. The period of protection varies from jurisdiction to jurisdiction, but a trademark can be renewed indefinitely if its registration and use in commerce is maintained. Trademark protection is enforced by the courts, which in most systems have the authority to block trademark infringement. Trademarks also protect prospective consumers by providing a means through which they can identify goods or services with which they have associated a certain quality or characteristic they like.



Jon Sullivan, Public Domain Photos

Enforcing Trademark

Trademark infringement is generally inclusive of “passing-off” but it is important to understand both infringement and passing-off individually. Trademark infringement is an act punishable through a legal statute that will spring from whether the mark is included in a national trademark registry and whether a third party uses a trademark that would cause a likelihood of confusion amongst the public. Trademark registration is available for both goods and services. Typical remedies for trademark infringement include injunctions, damages and an account of profits. A trademark owner can do a number of things to inform the public that his good or service is protected under trademark law.

Passing-off, generally not a statutory violation, is when a third party misappropriates another’s trademark and misrepresents that mark to the detriment of trademark owner’s goodwill or reputation; i.e., that third party markets or sells his own goods as if they were branded by another entity.

Be diligent. Firstly, a trademark owner can use the TM or ® symbols on the item. The TM symbol indicates that registration is still pending while the ® symbol indicates that the mark has been successfully registered. Secondly, he can look at trademark registrations periodically to see whether someone is registering a mark that is similar enough to his that it might cause confusion. Thirdly, he can maintain awareness of products or services

being sold in the same or similar category and, if need be, send a cease and desist letter to anyone who is using his trademark without his permission.

In a recent U.S. case,⁴ the Tillamook County Creamery Association sent a cease and desist letter to the Tillamook Country Smoker but the latter had been using the trademark “Tillamook Country Smoker” continuously since 1976 and, with the tacit permission that accompanied the Association’s silence, the cease and desist letter was seen as too late by the court and the Smoker retained its trademark.



On a grander scale, other companies have instigated legal actions against counterfeiters all over the world. In 2004 alone, Louis Vuitton, manufacturer of luxury leather goods under the French conglomerate Louis Vuitton Moët Hennessy (LVMH), undertook over 13,000 legal actions, more than 6,000 raids, approximately 950 arrests and the seizure of fake printing cylinders.⁵

Be selective in choosing franchisees. The “goodwill” of a trademark depends on several factors, amongst which are the degree to which it is recognized and the qualities that the public associates with the brand. As a trademark owner, it is important to gauge how much quality control oversight will need to be exercised when licensing your trademark to a franchisee. A contract should be drawn up between the owner and the licensee, stipulating what the franchisee may and may not do with the trademark.

C. Patents

As with copyright and trademark enforcement, much of the burden of protecting a patent falls on the shoulders of the patent owner. As a small business with a patent or a patent portfolio, there are a number of pragmatic activities and approaches that can help combat potential patent infringers.

· **Monitoring all products and processes in the field** of an SME’s patented invention(s) will allow a patent owner to understand what patents are similar to his own and will help in surmising what kind of infringements are likely. In the event an SME’s patent has

⁴ *Tillamook Country Smoker, Inc. v. Tillamook Country Creamery Ass’n*, No. 04-35843 (9th Cir. Oct. 11, 2006).

⁵ See Counterfeiting Information: Replica Louis Vuitton, available at <http://www.louisvuitton.com/info/fake/fake-00506.htm>

been infringed, it is essential to act quickly. In many jurisdictions, the time period during which a plaintiff can bring suit for a patent infringement is limited.

A patent owner should **accurately translate her patent** to the relevant language in the jurisdiction where she is applying for a patent. Because of the highly specialized nature of many patents, she should be sure to hire a professional translator; specifically one who can correctly translate technical terms and concepts in your field her work.

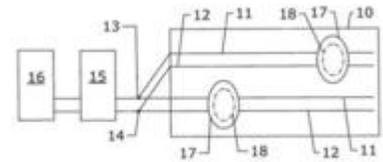
Publication Number: WO/2007/004000 **International Application No.:** PCT/IB2006/001717
Publication Date: 11.01.2007 **International Filing Date:** 23.06.2006

Int. Class.: *A61M 37/00* (2006.01), *E04H 15/00* (2006.01)
Applicant: **CAPPELLARI, Paolo** [IT/IT]; Via D. Alighieri, 2, I-23861 Cesana Brianza (IT).
Inventor: **CAPPELLARI, Paolo** [IT/IT]; Via D. Alighieri, 2, I-23861 Cesana Brianza (IT).
Agent: **GATTI, Enrico**; Giambrocono & C. S.p.a., Via E. Zambianchi, 3, I-24121 Bergamo (IT).
Priority Data: LC2005A000012 05.07.2005 IT
LC2006A000004 22.02.2006 IT

Title: SUN TENT HAVING MEANS FOR RELEASING ACTIVE PRINCIPLE

Abstract:

A sun tent characterised by comprising: a fabric having in its interior at least one pair of conductive threads; means for retaining and releasing an active principle, said means being applied in contact with said at least one pair of conductive threads; a control circuit for said at least one pair of conductive threads; a power unit for said control circuit.



Bibliographic data from a patent search through WIPO's database

D. Industrial Design

Industrial design law, sometimes simply referred to as “design law” does not exist in all jurisdictions. In the United States, for example, most of the protections offered under another jurisdiction’s industrial design law are found in copyright law, design patent law, unfair competition law or have simply grown up as common law concepts developed in court on a case-by-case basis. Industrial design in the legal sense refers generally to a product’s overarching aesthetic form or outward appearance. Some examples include the ornamentation, patterns or color of armchairs, toys, watches and sports equipment.

To enforce industrial design rights, registration is a good starting point. National and regional industrial property offices can provide specific information. Usually, the office will request drawings and/or photographs of the designs in addition to a written description profiling the design’s novelty. The European Union has recently implemented legislation enabling thin protection of unregistered designs. Like other areas of IP, it is necessary to police the avenues of distribution to ascertain whether an industrial design is being pirated.

E. Trade Secret

Trade secret is sometimes, but not always, associated with intellectual property. A trade secret is more or less self-defining: it is information that is kept from public distribution; owners of trade secrets seek to keep their special knowledge away from the public and/or competitors through a variety of legal and non-legal means, such as using non-disclosure agreements (NDAs) and non-compete clauses in employee contracts or building padlocked warehouses away from public view. Trade secret is most easily differentiated from intellectual property law insofar as a trade secret is not disclosed to the government for registration purposes as disclosure would *per se* void the nature of trade secret.

Because trade secrets fall outside the rubric of recorded IP, however, there are some special considerations that should be noted for purposes of business. Firstly, like other IP laws, the degree to which trade secrets are protected in a given jurisdiction can vary. For example, some European jurisdictions allow for employee covenants that temporarily curtail an employee's future employment possibilities if that employee has had access to a company's trade secrets; other jurisdictions do not allow for restriction on employees whatsoever. In the realm of valuation, trade secrets can pose a problem when, for example, a business is being sold. Contracts between the business buyer and seller should include mention of any important trade secrets upon which the business is based, to ensure nondisclosure and to require the seller to instruct its employees to relinquish any records and materials that would enable the reconstruction of the trade secret.



© istockphoto / Clint Hilde, 2007

Some examples of trade secret include recipes for prize-winning desserts, formulas for making soft drinks, a device for manufacturing a tape dispenser, a process for laminating a special kind of paper and know-how for fabricating an insulated thermos.

II. Contracting and Avoiding Litigation

Depending, again, on jurisdiction, completing and signing a well-written contract can be the most important legal protection an SME can provide itself *vis à vis* third parties with which it does business.

A. *What to Include in Contracts*

By their nature, contracts between two or three parties are very situation-specific. As such, it is difficult to draw up any generic guidelines regarding how to write intellectual property contracts or what terms to include. However, whether an SME is licensing its trademark to another entity in a co-branding scheme or drawing up an agreement to consign its products to a line of boutiques, a clear and concise contract, specifying the rights and obligations of all parties with regard to the intellectual property is a healthy starting point that potentially avoids later conflict.



© istockphoto / Robert Kylo, 2005

B. *International Arbitration and Mediation*

The World Intellectual Property Organization (WIPO), realizing the need for an international platform for arbitration in IP disputes, has formed an Arbitration and Mediation Center. Arbitration, an alternative to filing suit in a court of law, requires that two parties in dispute agree to submit their disagreement to one or more arbitrators who will make a binding decision. A contract between two parties might specify arbitration in the event of dispute before signing. Mediation is a process through which an impartial entity helps parties to reach a mutually satisfactory dispute settlement; the process results in a recorded, binding contract. Arbitration and/or mediation are often good choices for small businesses for several reasons.

Mediation, specifically, is an attractive option for parties that place a premium on the preservation or enhancement of their relationship, seek to maintain control

over the dispute settlement process, value confidentiality, or want to reach a speedy settlement without damage to their reputations.⁶

Other entities aside from WIPO perform these services. If the dispute is limited to parties from one jurisdiction, for example, a domestic arbiter may be more convenient. In the United States, the National Arbitration Forum has a specific intellectual property division;⁷ for Arab countries, the Arab Intellectual Property Mediation and Arbitration Society was formed in 2003 and it performs a variety of functions with the overarching goal of fostering Arab creativity;⁸ and individual law firms also participate in alternative dispute resolution (ADR) by hosting meetings in their offices.⁹ For specific types of dispute resolution, such as domain name disputes, there are specific platforms that should be consulted. For domain names, the Internet Corporation for Assigned Names and Numbers (ICANN) has approved a limited number of dispute resolution providers, including the Asian Domain Name Dispute Resolution Centre (ADNDRC); the International Institute for Conflict Prevention and Resolution (CPR); the National Arbitration Forum (NAF); and WIPO.¹⁰

III. Low-Cost Policing

While the brevity of this guide cannot address the myriad products on the international market, there are a few broad guidelines that could prevent or at least hamper large-scale counterfeiting and other IP theft. Keeping in mind that a musician in Russia will face different issues than will a seamstress in Chad or a woolen mill in Ireland, the following are often found to be useful practices for business owners and IP holders to keep in mind as they put their products into the stream of commerce. The first tenet to keep in mind is that **it is the IP rightsholder's responsibility** to police his products and insist upon legal compliance when infringement is found.

1. **Collaborate** with your contacts who help put your product in the stream of commerce. This could include wholesale distributors, retailers or other merchants, customs officers and police officials. If you find that your product is being illegally duplicated or if someone else's product is being passed off as yours, meet or communicate with people in this chain of commerce. They will only be able to protect your product if they know what your genuine product is versus the counterfeit product.
2. **Educate your employees.** The people who are handling sensitive IP information should know the extent to which it is proprietary. Provide this information

⁶ WIPO, Why Refer Intellectual Property Disputes to Mediation?, available at <http://www.wipo.int/amc/en/mediation/why-meditation.html>.

⁷ See <http://www.arb-forum.com/main.aspx?itemID=295&hideBar=False&navID=71&news=3>

⁸ See http://www.aipmas.org/AIPMASJudge.aspx?page_key=aipmasjudge&lang=en

⁹ See, e.g., Merchang & Gould, Alternative Dispute Resolution, available at <http://www.merchantgould.com/practice-profile-15.html>.

¹⁰ See ICANN, Approved Providers for Uniform Domain-Name Dispute-Resolution Policy, available at <http://www.icann.org/dndr/udrp/approved-providers.htm>.

through training, by requiring (and explaining) non-disclosure and non-compete agreements.

3. **Educate your consumers.** The world's most popular products are copied, sometimes very skillfully, leaving prospective consumers uncertain as to what they're actually about to buy. If an SME has a website, it should dedicate a webpage to illustrating how someone could tell apart its genuine product from a counterfeit product. It should stress the quality of its product (*e.g.*, the leather and seams on a bag from an haute couture design house) or ensure that its audience knows that there are only certain vendors that carry legitimate products (*e.g.*, high-end salon products often specify that consumers should only purchase their products from salons)



© istockphoto / Olivier Blondeau, 2007

Some other examples:

Levi Strauss & Co.

In order to avoid the possibility of purchasing counterfeit jeans, we suggest you purchase our products from a recognized Levi Strauss & Co. retailer. Also, look for the two most recognizable Levi's® trademarks on our jeans:

The Tab Device® trademark on the back pocket.

The Arcuate Stitching Design® trademark on the back pockets. The Arcuate Stitching Design® trademark is easily recognized as the 'double arcs' displayed on each side of the back pocket.¹¹

¹¹ See <http://www.levistrauss.com/Company/FAQ/Levis.aspx#7>

Rolex

Genuine Rolex products are sold through Official Rolex Jewellers and are not available on the Internet. All intellectual property rights such as trademarks, service marks, trade names, designs and copyrights are reserved. Nothing contained in this website may be reproduced without written permission.¹²

Designer Sunglasses

It is sometimes the wronged consumer who brings counterfeit goods to the attention of the appropriate authorities. In June of 2006, a man who purchased cheap sunglasses at the Troyeshchyna market in Kiev suffered from impaired vision after relying on false UV protection claims on his counterfeit sunglasses. He sent a complaint to the Public Relations Centre of the Directorate General of the Ukrainian Ministry of the Interior and, with the intervention of officers of the State Service for Combating Economic Crime, police shut down the sunglasses booths and seized 80,000 pairs of counterfeit Chanel, Dior and other brand name glasses.

Situations like this call for **attention from several possible sectors**: The **designer brands** being replicated can stress that their goods may only be bought in certain boutiques or locations. **Ophthalmologists** could stress to their patients that all types of glasses should meet a certain criteria and should only be purchased at eyeglass retail locations or optician's shops.



© istockphoto / Matthew Dixon, 2007

4. An SME can **notify the infringer** that it is aware of its conduct and is willing to take legal action if he continues to infringe its rights. Usually, this is done by sending the infringer a cease and desist letter. If an SME finds content on a website but cannot find contact information for the owner of the website content,

¹² See Legal notice at <http://www.rolex.com/en/index.html>

it may send a special kind of cease and desist letter to the Internet Service Provider (ISP) that is hosting the website.

5. If an SME has enough evidence that a particular party is infringing its IP rights – and note that it is the IP owner’s **responsibility to collect any evidence** -- it may want to go to a court and **request a court order** that would allow for an inspection of the alleged infringer’s premises and subsequent seizure of infringing goods. The specific steps to take to get to this point are jurisdiction-dependent and a request for a court order could be held up for some time. A court may issue an interim injunction which would require the alleged infringer to stop his activities until the final outcome of the case is reached.