

27 October 2015

Mr. Paul Maier  
Director  
European Observatory on Infringements of Intellectual Property Rights  
Office for the Harmonization of the Internal Market  
Avenida de Europa, 4  
E-03008 Alicante, Spain  
Via email: [observatory@oami.europa.eu](mailto:observatory@oami.europa.eu)

## **Re: EU Observatory Work Programme 2016 – INTA Comments**

Dear Mr. Maier,

On behalf of the International Trademark Association (INTA), we thank you for the opportunity to provide comments on the draft 2016 Work Programme for the European Observatory on Infringements of Intellectual Property Rights.

INTA is pleased to have participated as a stakeholder of the Observatory since its inception. Our Association benefits from being an active stakeholder in all five of the Observatory's Working Groups. We congratulate the Observatory on its work this year and applaud you for such achievements as the three sectorial study of the economic impact of infringements released in 2015.

We also support the trademark-related and anticounterfeiting projects planned for 2016 as many are a continuation or expansion of existing projects. We provide additional comments and recommendations below.

### **1. 2016 Budget**

INTA commends the ambitious work plan set forth for the Observatory for 2016 and looks forward to assisting with its development and implementation. We recommend that the work plan include a projected budget for the various activities and that this becomes a standard practice when presenting stakeholders with annual or multi-annual strategic and work plans. The activities of the Observatory are funded by trademark and design registration fees, the expenditure of which is of great interest to INTA members. We also recognize that several of the Observatory's projects are non-trademark related and we reiterate our request that consideration be given to establishing a mechanism that would aim towards equitable funding by non-trademark or design-related stakeholders.

## 2. Projects planned for 2016 in the area of Public Awareness (Section 3.1.1)

**Helping SMEs protect their IP rights:** INTA applauds the work of the Observatory in demonstrating how IP has a positive impact on the economy and employment through its IPR contribution study and the SME scoreboard. Now that the positive contribution of IP has been demonstrated, the Observatory should take action in helping trademark owners (small, medium and large) develop those rights. The Observatory should consider developing a campaign targeting SMEs and focusing on effective IPR enforcement. This campaign should inform SMEs about the difference types of IPRs they can use and ways to develop a strategy to use various types of IPRs to effectively protect their products and services. The campaign should also touch upon ways to register and enforce their rights in other jurisdictions as SMEs expand to other markets.

Such projects should be developed in cooperation with existing EU initiatives such as the European IPR Helpdesk and the IPR SME Helpdesks for China, ASEAN and the MERCOSUR.

**Repetition of IP Perception Study:** INTA promoted the information in the IP Perception study and found it very helpful in our advocacy efforts. We welcome the repetition of the study and look forward to receiving the results.

**IP Education Network:** INTA welcomed the first study on IP Education. INTA notes that the proposed “IP Education Network” will be made up of “specialised stakeholders”. We would be interested in learning how such “specialised stakeholders” will be selected or appointed.

## 3. Projects planned for 2016 in the area of Enforcement (Section 3.1.2)

**Enforcement Database:** INTA applauds any effort to support the work of customs authorities and supports the proposed plan to map NICE classification of goods and services to permit more streamlined reporting and analysis of enforcement information, linking the rights holders and the customs product management systems. However, the different purposes and mechanisms of the two classification or codification systems should be borne in mind and it should continue to be clear that the mere classification or codification does not replace an assessment of the identity or similarity of the goods from a trademark law perspective. For customs purposes with a view to trademark enforcement, the level of detail contained in the CN Tariff codes is quite irrelevant as, for example, clothing will normally remain just clothing independently of the material used.

**Focus on online infringements:** Given the lack of jurisdictional limits of the Internet, it would be useful to consider sites outside of the EU. This would require experts with various language skills (from EU and non-EU countries) to properly gather information and monitor trends.

**Study on control mechanisms for ensuring the enforcement of Geographical Indications:** INTA appreciates the wide range of issues that are considered by the Observatory. However, as pointed out under point 1, IPs who benefit from these projects should contribute to their funding.

**Building Knowledge and Competences in IP Enforcement:** Observatory-planned events would benefit from input from the Working Group stakeholders. We would suggest that, whenever possible, the Observatory include the private sector to participate in these events and trainings. Rights holders and IP practitioners are dealing with the most current issues in the field and will be able to share best practices.

**European Intellectual Property Prosecutors Network:** INTA supports knowledge building and experience sharing between prosecutors. We suggest that IP practitioners and rights holders be involved in such capacity building events.

**Framework to Reduce IP Infringements in Europe:** As part of this activity, the Observatory might consider the development of a set of criteria to screen sites which would flag intermediaries that have proven to protect IP rights. The criteria might be along the lines of “Best Practices” which INTA developed in 2009 and is currently updating for circulation in 2016 (see <http://www.inta.org/Advocacy/Documents/INTA%20Best%20Practices%20for%20Addressing%20the%20Sale%20of%20Counterfeits%20on%20the%20Internet.pdf> ) The converse would be for the Observatory to develop a mechanism to warn consumers of intermediaries that have proven to infringe on IP rights.

#### 4. Projects planned for 2016 in the area Legal and International (3.1.3)

**Trade Secrets Litigation Trends:** This report should include some information on (1) measures taken by courts to preserve trade secrets during litigation (protective orders), (2) sanctions taken by courts in case of non-compliance by experts/witnesses/parties of their duty not to disclose upon a protective order, and (3) evidentiary weakness/flows stressed by courts in actions where trade secrets were alleged.

#### 5. Projects planned for 2016 in the area IP in the Digital World (3.1.4)

INTA representatives on this Working Group have highlighted that the primary focus of the working group is copyright and piracy issues. Online counterfeiting is a big priority to INTA’s membership, and we would like to see more of a focus on trademark-related activity in 2016.

#### 6. Projects planned for 2016 in the area Economics and Statistics (3.1.5)

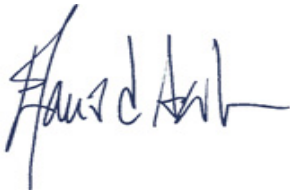
**Repetition of the IP Contribution Study (industry-level):** INTA promoted the information in the IP Contribution Study and found it very helpful in our advocacy efforts.

We applaud the repetition of the study and look forward to seeing the trends found since 2013.

- 7. Classification of Projects and Studies:** Due to the high output of the Observatory's work and the many projects considered by the Working Groups, we would find it useful to give codes or numbers to the Observatory projects and reports. The names of the projects can change over time, so numbers would provide some sort of consistency and clarity to the Work Programme's many tasks.

Thank you for your consideration of our comments. We would be happy to further discuss. Please contact INTA's Europe Chief Representative Officer, Christina Sleszynska, at [csleszynska@inta.org](mailto:csleszynska@inta.org) or INTA Anticounterfeiting Advisor, Maysa Razavi, at [mravazi@inta.org](mailto:mravazi@inta.org).

Sincerely,

A handwritten signature in blue ink, appearing to read "Etienne Sanz de Acedo". The signature is fluid and cursive, with a long horizontal stroke at the end.

Etienne Sanz de Acedo  
CEO  
International Trademark Association