

Enforcement Strategies for Designs as an Applied Art – Europe
An Anthology for IP Practitioners

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November, 2022

Acknowledgements

This Committee Report was produced by the Designs and Copyright Subcommittee. Special thanks to all the members of the said committee as well as to INTA members who contributed strongly to the production of this report, also acknowledged hereafter.

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Executive Summary

The Enforcement Strategies for Designs as an Applied Art – Europe: An Anthology for IP Practitioners report provides guidance regarding the protection of industrial designs in various European countries under different aspects of intellectual property law (copyright law, design law and trademark law), with a focus on potential enforcement strategies in various European jurisdictions. The report not only deals with substantive law (including remedies available), but also summarizes procedural aspects.

After a quick introduction, the first chapter explains the legal situation in various European Union (“EU”) Member States, starting with the underlying law of the European Union, *inter alia* the European Union trademark regulation and the Community Design regulation. In this context, the report explains that copyright law, with regards to the protection of industrial designs, is hardly harmonized within the European Union. Therefore, copyright protection of industrial design in general has to be assessed on the basis of the national laws of the EU Member States. However, as regards copyright protection, the European Court of Justice has established a certain harmonized level over the past years. The report concludes that industrial designs may enjoy copyright protection, design protection and trademark protection in all EU Member States that have been examined, provided that the respective legal requirements are met. Practitioners will appreciate that the report also briefly summarizes the respective legal requirements.

The report then turns to the legal situation in certain European countries which are not EU Member States and allows an easy comparison with the situation in the EU by covering the same topics already mentioned above. Notably, the legal situation in these countries is quite similar to the legal situation in the EU Member States, whereby some of these countries even have expressly considered EU regulations and EU case law when drafting their national provisions. As a consequence, also in these countries, industrial designs may be protected by copyright law, design law and trademark law.

A concise conclusion is presented at the end of the report.

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Report Summary

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A. Introduction

Industrial designs or works of applied arts encompass, among other things, furniture, lamps, household appliances, textiles and fashion products. These products all have a utilitarian purpose, but at the same time they possess a unique and outstanding design.

Quite often the designers or the manufacturers of the goods face the problem that their unique design is copied by third parties who try to profit from the outstanding design by offering cheap replicas in poor quality. In order to protect their design products against such copy-cats, many right holders invest large sums both to obtain intellectual property rights and to take legal action against counterfeit products.

One of the basic challenges in this context is the question of whether industrial designs may be protected at all. The crucial question is whether the product design consists of specific aesthetic features or whether it is merely based on technical features. This may vary depending upon the applicable law in each country. Besides, the effectiveness of enforcing IP rights infringements varies in each country and right holders need to assess which is the best strategy to take action against counterfeit products in each country.

The aim of this Report is to provide a basic overview about different schemes of protection and civil law enforcement strategies for industrial designs throughout Europe, namely protection under copyright law, design law and trademark law. Possible protection under unfair competition law/passing-off is not dealt with.

The Report Summary is based on information provided by IP experts in various European countries and is separated into two sections, the first one covering the European Union¹ ("EU", sec. B.) and the second one focusing on various non-EU countries² (sec. C.). This Report Summary provides a general overview of the main similarities and differences for design protection throughout Europe based on the contributions from the IP experts. The country-specific contributions from the IP experts are included at the end of the Report Summary.

B. Enforcement Strategies in the EU

Possible means of protection for industrial designs within the EU are copyright law, design law, trademark law and possibly unfair competition law/passing-off (the present report does however not deal with competition law/passing-off). In particular, design and trademark law are harmonized

¹ The Report Summary is based on information concerning the following EU countries: Bulgaria, Croatia, Germany, Finland, France, Italy, Poland, Romania, Slovenia, Spain, Sweden, The Netherlands.

² The Report Summary is based on information provided by IP experts in Albania, Bosnia and Herzegovina, Kosovo, Russia, Serbia, The United Kingdom ("UK"), Ukraine and Uzbekistan.

to a large extent within the EU. Copyright law is primarily governed by national law and are only harmonized to a certain extent within the EU.

I. Protection under Copyright Law

To date, there is no full harmonization of copyright within the EU. The EU has adopted various directives concerning certain aspects of copyright law (e.g., the highly controversial EU Directive 2019/790 on Copyright in the Digital Single Market). Besides, the European Court of Justice (“ECJ”) has established a certain harmonized level of copyright protection over the past years.

1. Registration Requirement

In compliance with the Berne Convention for the Protection of Literary and Artistic Works dated 9 September 1886, to which all EU member states are signatories, copyright arises with the time of creation of the work. Thus, registration of the copyright is not required and not possible in most EU countries. In certain countries, e.g., in France the date of first publication of a work may be registered with the French Intellectual Property Office (INPI).

2. Requirements for Copyright Protection for Industrial Designs and Scope of Protection

The copyright laws of many EU countries explicitly state that works of the applied art may be protected by copyright. Even though, to date, the specific criteria for copyright protection are governed by national law, they are quite similar: In most EU Member States the work must be the result of the designer’s own individual creation and fulfill a certain level of originality (the threshold of which is rather low).

Only recently, the ECJ handed down its first judgment concerning copyright protection for works of applied art, which might lead to further harmonization within the EU. In this case concerning copyright protection for jeans designs, the ECJ ruled that works of applied art may be protected both under copyright law and design law. Furthermore, the ECJ ruled that the only relevant criteria to establish copyright protection is an original and individual creation and that the work does not need to possess any specific aesthetic features (ECJ, decision of 12 September 2019, docket no. C-683/17 – Cofemel).

3. Copyright Infringement

The specific requirements to prove copyright infringement vary depending upon the national law. The key elements are:

- Work protected by copyright.
- Counterfeit product infringing the copyright protected original.

- No entitlement of the infringer to market, distribute, offer for sale, or advertise the counterfeit product.
- Entitlement to claim copyright infringement: owner of the copyright or licensee.

4. Benefits and Challenges

The main benefit is the long term of protection, namely 70 years after the designer's death (in Italy the term of protection is 80 years if the designer died prior to 1987).

In addition, under copyright law there is no use requirement. Thus, copyright may be enforced irrespective of whether the work has been marketed and there is no need to provide information on sales figures, marketing activities, etc.

One of the main challenges is to prove that a work of the applied arts is protected by copyright and that, despite its utilitarian purpose, its aesthetic features are not only based on its technical function but vest in an individual creation of the designer.

Besides, the person claiming a copyright infringement must prove his entitlement to enforce the copyright. This may be challenging if the designer has granted usage rights and the parties did not conclude a written contract.

II. Protection under Design Law

Industrial designs may also be protected by designs (the term "design patent" is not used within the EU). Designs are two- or three-dimensional appearances of the whole or part of a product resulting from the features of the product itself or its ornamentation, e.g., the lines, contours, colors, shape, texture or materials.

There are three possible ways of obtaining design protection in the EU Member States:

- **Community Designs:**
Community designs are governed by the Community Design Regulation ("CDR", (EC) No. 6/2002) and may be registered with the European Union Intellectual Property Office ("EUIPO"). Community designs enjoy protection in all EU member states.
- **National designs:**

National designs may be registered with the respective national intellectual property offices. The requirements are governed by national law. Nevertheless, there is a high level of harmonization, since all EU countries had to implement Directive 98/71/EC on the legal protection of designs, which stipulates the basic requirements for design protection.

- **International designs:**

International designs may be registered with the World Intellectual Property Organization (“WIPO”) in accordance with the Hague System for the International Registration of Industrial Designs (<https://www.wipo.int/hague/en/>). When filing an application for an international design, the applicant may designate any number or all countries affiliated with the Hague System. An international design is a “bundle” of national designs, which means that protection of the design is subject to the national law of the countries for which the design has been designated. All EU Member States and the EU itself are affiliated with the Hague System.

1. Registration Requirement

In principle, designs must be registered with the respective intellectual property offices. The basic term of protection for designs is five years. The term may be prolonged for five-year periods up to a maximum term of protection of twenty-five years.

One exception to the registration requirement is the unregistered Community design (Art. 11 CDR), which enjoys protection for three years as from the date when it was first made available to the public within the EU.

2. Requirements for Design Protection and Scope of Protection

a) Registered Designs

The requirements for registered Community designs and national designs are basically the same. The two key requirements are:

(i) Novelty

A design is considered as new, if no identical design has been disclosed prior to the date of filing the design application. Designs are identical if they only differ in immaterial details.

(ii) Individual Character

A design enjoys individual character if the overall impression produced by the design on the informed user differs from the overall impression produced on such a user by any other design that has been made available to the public before. When assessing the individual character

of a design, the degree of freedom of the designer in creating the design must be taken into consideration. The larger the designer's freedom, the larger is the scope of protection of a design.

Shapes of a product may not be protected under design law if the appearance is solely dictated by their technical function.

When a design application is filed, the IP offices only check the formal requirements of the application, but do not examine whether the criteria of novelty or individual character are met. Thus, any design registration may be challenged by third parties due to a lack of novelty or individual character.

Certain appearances are excluded from design protection, e.g., product shapes that only result from the technical function of the product.

b) Unregistered Community Designs

Unregistered Community designs must also meet the above-mentioned criteria of novelty and individual character. They only provide protection against direct copying of the protected design.

3. Design Infringement

The key elements of a design infringement are:

- Valid design registration.
- The overall impression of the infringing design is the same as the one of the registered design. The designs do not have to be identical. The scope of protection depends on the designer's freedom when creating the design. Relevant criteria are, inter alia, previously existing designs and technically required features. The larger the designer's freedom the more differences are required in order to avoid a design infringement.
- When enforcing an unregistered Community design, the right holder must also prove that the infringing design is the result of direct copying of the unregistered Community design.
- Entitlement to claim the design infringement: owner of the design or licensee.

4. Benefits and Challenges

One major benefit is that it is quite easy to obtain a design registration and, thus, a formal right that may be enforced against third parties. It is possible to include various designs in one multiple application. In case the applicant wants to keep the application secret, he may request a deferral of the publication of the design

application for up to thirty months. Besides, there is no use requirement concerning designs.

Since the IP offices do not examine whether the criteria of novelty and individual character are met, design registrations may be challenged by third parties, either in cancellation proceedings before the competent IP office or in infringement proceedings.

It is crucial to clearly separate between the aesthetical and technical functions of the appearance of the product, since appearances only resulting from the technical features cannot be protected as designs.

III. Protection under Trademark Law

Industrial designs may also be protected by trademarks, in particular 3D-trademarks that are protecting the shape or form of a product (the term “trade dress” is not common within the EU). Within the EU, the following three types of trademarks exist:

- **EU trademarks:**
EU trademarks are governed by the EU Trademark Regulation (“EUTMR”, Regulation (EU) 2017/1001) and may be registered with the EUIPO. They provide protection within all EU Member States.
- **National trademarks:**
National trademarks are governed by national law and can be registered with the national IP offices in the respective EU Member States. The requirements for national trademarks are harmonized to a large extent, since all EU Member States had to implement the EU Trademark Directive (Directive (EU) 2015/2436).
- **International registrations:**
Applications for international registrations may be filed with the WIPO in accordance with the Madrid System. International registrations are a “bundle” of national trademarks that are governed by the respective national trademark laws or EU trademark law, in case the applicant designated the entire EU.

1. Registration Requirement

Registration of a trademark is mandatory for EU trademarks and international registrations, meaning that such rights only exist upon registration with the EUIPO and the WIPO.

National trademarks may be registered with the respective national IP offices. In addition, several EU countries (e.g., Germany, Finland, France, Italy, Spain, Sweden and The Netherlands) provide trademark protection for unregistered trademarks if certain criteria are met, e.g., in case of well-known trademarks.

The basic term of protection for trademarks is ten years. The trademarks may be renewed for ten-year intervals and there is no maximum term of protection.

2. Requirements for Trademark Protection and Scope of Protection

A sign may be protected as a trademark if the relevant public perceives the sign as an indicator of the commercial origin of a product. The respective EU and national trademark laws explicitly state that shapes of goods or packaging may be protected as trademarks. Thus, in principle it is possible to obtain trademark protection for industrial designs, e.g., as a three-dimensional shape mark.

However, it is very difficult to obtain trademark protection for industrial designs, since a sign may not be protected as a trademark if the sign exclusively consists of a shape that

- results from the nature of the goods themselves,
- is necessary to obtain a technical result, or
- gives substantial value to the goods.

Many trademark applications for product shapes have been rejected based on these absolute grounds of refusal (e.g., the shape of the Lego brick, c.f., ECJ, decision of 14 September 2010, docket no. C-48/09 P, the shape of the Rubik's cube, c.f., ECJ, decision of 10 November 2016, docket no. C-30/15 P and the shape of the Bang Olufsen speakers, c.f., General Court, decision of 6 October 2011, docket no. T-508/08.)

Besides, three-dimensional trademarks may also be rejected based on the absolute ground of refusal of a lack of distinctiveness. Only recently, the General Court ruled that the shape of a faucet could not be protected as a three-dimensional trademark, since its overall shape did not sufficiently differ from other faucets available on the market (General Court, decision of 19 June 2019, docket no. T-213/18).

In case a trademark has been successfully registered for the shape of a product, it provides protection against the use of identical or similar signs for identical or similar goods or services. The scope of protection depends on the level of distinctiveness of the earlier trademark. The higher the level of distinctiveness of the earlier trademark (e.g., due to an extensive use) the broader is the scope of protection.

3. Trademark Infringement

The basic requirements to prove trademark infringement are:

- Registered or unregistered trademark.
- Use of an identical or similar sign in the course of trade for identical or similar goods, creating, thus, a likelihood of confusion.
- Entitlement to enforce the trademark infringement: trademark owner or licensee.

4. Benefits and Challenges

Trademarks enjoy an unlimited term of protection, but are subject to a use requirement after a grace period of five years.

One major challenge is to obtain a trademark registration for industrial designs. Many applications have been rejected based on absolute refusal grounds (Sec. B.III.2.)

IV. Remedies

The remedies are governed by national law and may vary depending on the rights on which the claims are based. Nevertheless, the basic remedies are quite similar in most EU countries and encompass, inter alia, the following measures:

- Injunctions (court order to cease and desist).
- Recall of infringing products.
- Information concerning the scope of the infringing activity (e.g., number of infringing products sold and still on stock, name of commercial customers).
- Seizure and destruction of infringing products.
- Payment of damages.
- Payment of fines in case of future infringements.
- Publication of the court decision.
- Rectification (public announcement or infringement by the infringer).

V. Procedural Aspects

Procedural aspects are also governed by national law and there are quite a lot of differences among the EU Member States (e.g., concerning the statutes of limitation or the competent courts).

Whilst it is not necessarily required, it is usually recommended to send out a warning letter to the infringer before taking further legal action.

Many countries offer preliminary injunction procedures, which enable the claimant to obtain a preliminary court decision within a much shorter period of time than the full-scale proceedings. Once again, the specific requirements and the effectiveness of the preliminary proceedings vary among the Member States. In Germany, for example, it is possible to obtain an (ex-parte) preliminary injunction within a couple of days (or in case of a tradeshow even within a few hours), whilst in other countries even the preliminary injunction proceedings may take several weeks, or months and most countries do not grant any ex-parte decisions at all.

C. Enforcement Strategies in Non-EU Countries

In principle, the requirements for protection of industrial designs and the enforcement strategies in non-EU countries are similar to those in the EU countries. Several countries even strive at harmonizing their national laws with EU laws and ECJ decisions. In order to avoid repetition, this report will highlight certain basic requirements and differences from the protection strategies in the EU Member States.

I. Protection under Copyright Law

1. Registration Requirement

Many non-EU countries have signed the Berne Convention (one exception is Kosovo) and there is no need to register a copyright. In Bosnia and Herzegovina, it is possible to deposit a copyright, since 2010, but not all authors are using the possibility of depositing their copyright.

2. Requirements for Copyright Protection, Scope of Protection

Most national copyright acts explicitly state that works of applied art may be protected by copyright law. As in the EU Member States the work must be an individual creation of the author. In most countries the originality threshold is not very high. In Russia there is no originality requirement at all. However, in the UK copyright only exists in artistic works of craftsmanship.

Copyright protection encompasses moral and economic rights and the owner of the copyright is entitled to take action against imitations of his copyright-protected work.

3. Copyright Infringement

The basic requirements for a copyright infringement are the following:

- Copyright protection for the industrial design.
- Imitation of the design protected by copyright.
- Authorship or entitlement to enforce the copyright.

4. Benefits and Challenges

One of the major benefits is the long term of protection, which in most countries lasts 70 years after the author's death. Within Uzbekistan, however, the term of protection is only 50 years after the author's death.

It may be difficult to prove that the work is indeed protected by copyright and who is the author of the work.

II. Protection under Design Law

1. Registration Requirement

Industrial designs must generally be registered in order to be enforced against third parties. Designs may be registered either as national designs with the respective national IP offices. Many non-EU countries (one exception is Kosovo) also allow the registration of international designs with the WIPO.

The UK provides for unregistered national designs. UK unregistered design rights protect original designs which are not common place.

2. Requirements for Design Protection, Scope of Protection

The main requirements for design protection are similar to the ones in the EU (namely novelty and individual character of the design). Registered designs provide protection against any design which does not produce an overall different impression that the original design on the informed user.

3. Design Infringement

In order to prove a design infringement, the following requirements must be met:

- Valid national or international design registration.
- Use of the registered design, e.g., by imitation, incorporation of the registered design into another product or application of the registered design to another product.

4. Benefits and Challenges

Benefits of design registrations are that the registration procedure is quite easy and that there is no need to prove ownership in the design (which may be one major obstacle when enforcing copyrights).

However, the term of protection is rather limited (usually a maximum term of 25 years). Besides, it may be difficult to prove the novelty and individual character of a design.

III. Protection under Trademark Law

1. Registration Requirement

Whilst several EU Member States provide protection for non-registered trademarks, trademarks usually have to be registered in non-EU countries. In Albania, however, unregistered signs may be protected as a trademark if they are well-known or extensively used.

National trademarks can be registered with the national IP offices. In many non-EU countries, it is also possible to register trademarks as international registrations with the WIPO (one exception is Kosovo).

2. Requirements for Trademark Protection, Scope of Protection

The requirements to obtain trademark protection are quite similar to the ones in the EU countries. Like in many EU countries it may be difficult to obtain trademark protection for the shape of a product as a 3D trademark.

As in the EU, trademarks provide protection against the use of any identical or similar sign for identical or similar products or services, if this use is likely to create a likelihood of confusion concerning the commercial origin of the products.

3. Trademark Infringement

The following criteria must be met to prove a trademark infringement:

- Valid trademark registration.
- Use of a similar sign for similar products in the course of trade creating a likelihood of confusion.

4. Benefits and Challenges

Trademarks may be renewed indefinitely and there is no need to prove ownership.

It may, however, be difficult to successfully register a 3D trademark for industrial designs.

IV. Remedies

The remedies available and their scope vary according to national law. Nevertheless, the basic remedies are quite similar and encompass, i.a.,

- Injunctions (order to cease and desist).
- Payment of damages.
- Seizure and destruction of the infringing goods and marketing materials.
- Publication of the decision.

- Payment of fines.

In Russia the right holder may even request the liquidation of the entity offering the infringing products.

V. Procedural Aspects

Procedural aspects are governed by national law. Whilst it is usually not mandatory it is very common to send out a warning letter to the infringer before initiating legal proceedings in order to find an out of court solution.

There appear to be certain difficulties in effectively enforcing IP rights infringements in several non-EU countries due to a lack of experience of the judges and/or the authorities involved.

D. Conclusion

The above comparison shows that there are quite a lot of similarities with respect to the protection of industrial designs throughout Europe.

Industrial designs may be protected by copyright law, design law and trademark law and despite certain differences based on the respective national laws, the material requirements to obtain protection are quite similar. This is the case concerning the EU Member States where the laws are harmonized to a great extent. But also, many non-EU countries strive at applying similar principles as the EU countries.

The main differences can be found concerning the remedies available in case of infringements and procedural aspects. Besides, the effectiveness of measures against counterfeit acts appears to differ throughout Europe. Whilst the level of protection is quite high in western Europe, it is more difficult to successfully enforce infringements in eastern Europe, in particular in non-EU countries in eastern Europe.

Country Reports

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INTRODUCTION

The works of applied art and designs are explicitly listed in the Albanian Copyright and Related Rights Law as subject-matter of copyright protection in Albania. Designs could be protected also by registering a 3D trademark under the Albanian Industrial Property Right Law. However, trademark protection is only available to designs which are distinctive, i.e., capable of designating the origin of the goods they are applied to.

Sending out a warning letter is not a procedural requirement. In practice, however, such letters are often sent in attempt to settle conflicts amicably and avoid litigation. Such letters might also facilitate the task of proving that an infringer has acted in bad faith, despite being notified of infringement, and in claiming higher amounts of damages.

Preliminary injunctions are also available. They are usually granted on the condition of payment of a deposit to the court, which serves as a security that can be allocated to the defendant in case the court denies the claims on the merits. Preliminary injunctions are usually granted within 1-2 weeks.

In general judges are keen to follow EUCJ decisions given in analog cases, however, this is not a practice followed by all judges.

1. Copyright Enforcement Strategies

- a. Registration as a pre-requisite to action?

No registration is required to enforce copyright in Albania.

- b. Scope of protection

Copyright protection in Albania encompasses two categories of rights: moral and economic rights.

The moral rights include:

- right of disclosure
- right to claim authorship
- right to remain anonymous or choose a pseudonym
- right to demand indication of the author's name, pseudonym or other sign of authorship
- right of integrity
- right of modification
- right to access the original work
- right to retract

The economic rights cover the right to use and authorize any use of the work by third parties, including:

- reproduction

- distribution
- public performance
- broadcasting
- transmission by cable
- presentation before public
- translation
- transformation and synchronization
- communication to the public
- import and export

c. Key elements of infringement cause of action

- ownership of a valid copyright: copyrightable subject-matter, authorship or other form or entitlement, copyright term has not expired
- use of a protected work

d. Remedies

- injunctions
- damages
- seizure and destruction of infringing copies
- seizure of materials and equipment used for committing the infringement
- publication of judicial decisions

e. Challenges and benefits

The benefits of copyright protection in designs as applied art include wider scope and longer term (70 years from the author's death) compared to other forms of protection. There are no registration requirements and procedures. Challenges include the need to prove ownership of a valid copyright as an additional element of infringement cause of action.

2. Design Patent Strategies

a. Registration as a pre-requisite to action?

Design registration is a pre-requisite to action. In Albania designs can be registered nationally with the Albanian Industrial Property Office. As of January 9, 2019 Albania, ratified the Hague Agreement and designs may be registered also internationally with WIPO.

b. Scope of protection

The scope of protection of an industrial design includes any design which does not produce on the informed user a different overall impression. A registered national or international design confers to its holder the exclusive right to use it and to prevent any third-party from using it without his consent.

c. Key elements of infringement cause of action

- ownership of a registered or pending design
- use of a product in which the infringing design is incorporated or to which it's applied

d. Remedies

- injunctions
- damages
- seizure and destruction of infringing products
- publication of judicial decisions
- fines

e. Challenges and benefits

Benefits: If an industrial design is not registered or otherwise protected under Copyright or IP law, the owner cannot take actions against infringements.

Challenges: If the infringing products are seized by the customs and the same are destroyed the destruction costs are paid by the IP right holder and are not compensated, also the destruction process should be organized by the IP holder together with the customs authorities. For the time being the Internal Market Inspectorate is not functioning and it has no experience nor any practice for the seizure and destruction of infringing products.

3. Trademark/Trade Dress Strategies

a. Registration as a pre-requisite to action?

Registration is not a pre-requisite to action. Trademark protection in Albania encompasses protection of both registered and unregistered trademarks. In Albania trademarks can be registered nationally with the Albanian Industrial Property Office or internationally with WIPO.

b. Scope of protection

The scope of protection encompasses the right to prohibit the use in the course of trade of a sign:

- which is identical to a registered trademark for similar or identical goods
- giving rise to likelihood of confusion as to the origin of the goods due to the similarity with a mark and similarity with the goods
- which is identical or similar, even when the goods are not similar nor identical, for which the mark has been registered, and in case if the mark is reputed in Albania, and without due cause takes unfair advantages of, or is detrimental to, the distinctive character or the good name of the mark.

c. Key elements of infringement cause of action

- ownership of a valid trademark registration or pending application
- unregistered well – known trademark, or extensively used in the Albanian territory
- use of a sign in the course of trade within the scope of protection

d. Remedies

- injunctions
- damages
- seizure and destruction of infringing products
- publication of judicial decisions

e. Challenges and benefits

Benefits: A trademark registration can be renewed indefinitely. Availability of protection for unregistered well-known trademarks, or extensively used in the Albanian territory.

Challenges: Based on the Albanian IP Law a trademark should be distinctive in order to obtain registration. If the infringing products are seized by the customs and the same are destroyed the destruction costs are paid by the IP right holder and are not compensated, also the destruction process should be organized by the IP right holder together with the customs authorities. For the time being the Internal Market Inspectorate is not functioning and it has no experience nor any practice on the seizure and destruction of infringing goods.

4. Unfair Competition Strategies

Competition law/passing Off is not dealt with in this report.

5. Common Law and/or Other Non-Statutory Claim Strategies

Common Law and other non-Statutory claims are not available in Albania.

Bosnia

Contributor: Tarik Prolaz, PETOSEVIC Bosnia and Herzegovina

INTRODUCTION

The works of applied art and designs are explicitly listed by the Bosnia Copyright and Related Rights Act as subject-matter of copyright protection. They are also protectable as registered design rights. Designs may be also registered as three-dimensional trademarks as long as they are they fit into the definition of a trademark, meaning that they are capable of distinguishing goods from different sources.

Sending out a warning letter is not a procedural requirement. In practice, however, such letters are often sent in attempt to settle conflicts amicably and avoid lengthy and often expensive litigation.

Preliminary injunctions are available, but rarely granted.

1. Copyright Enforcement Strategies

- a. Registration as a pre-requisite to action?

No registration is required to enforce copyright in Bosnia.

- b. Scope of protection

Copyright protection in Bosnia encompasses two categories of rights: moral and economic rights.

The moral rights include:

- right of initial disclosure
- right to claim authorship
- right to remain anonymous or choose a pseudonym
- right to demand indication of the author's name, pseudonym or other sign of authorship
- right of integrity
- right to access the original work
- right to retract

The economic rights cover the right to use and authorize any use of the work by third parties, including:

- reproduction
- distribution
- right to lease
- public performance
- communication to the public
- audio-visual transformation
- translation

c. Key elements of infringement cause of action

- ownership of a valid copyright: copyrightable subject-matter, authorship or other form or entitlement, copyright term has not expired
- use of a protected work

d. Remedies

- injunctions
- damages
- seizure and destruction of infringing copies
- seizure of materials and equipment used for committing the infringement
- publication of judicial decisions

e. Challenges and benefits

The benefits of copyright protection in designs as applied art include wider scope and longer term (70 years from the author's death) compared to other forms of protection. There are no registration requirements and procedures.

Challenges include the need to prove ownership of a valid copyright as an additional element of infringement cause of action. The deposition of copyright introduced in 2010 makes this task much easier. However, it has not yet fully been accepted by the authors and it entails certain formal actions and fees. Copyright protection is only available to the author, i.e., the individual who has created the work, and is not assignable. By exception, for works made for hire, the rights are vested with the employer or the entity, which has commissioned the work. Therefore, copyright enforcement is available to a limited number of interested persons.

Copyright protection is available to any work, resulting from a creative process. It is sufficient for the work to be an author's individual creation and the originality threshold is not high.

2. Design Patent Strategies

a. Registration as a pre-requisite to action?

Design protection in Bosnia encompasses protection of only registered designs.

Local Industrial Design Law provides for protection of industrial designs registered with its national Patent Office. Bosnia is also a party to the Hague Agreement Concerning the International Registration of Industrial Designs.

b. Scope of protection

The scope of protection of an industrial design includes any design which does not produce on the informed user a different overall impression. A registered design confers on its holder the exclusive right to use it and to prevent any third party not having his consent from using it.

c. Key elements of infringement cause of action

In respect of registered designs:

- ownership of a valid design registration
- use of a product in which the infringing design is incorporated or to which it is applied

d. Remedies

- injunctions
- damages
- seizure and destruction of infringing products, compensation of destruction costs
- publication of judicial decisions

e. Challenges and benefits

Benefits: no need to prove ownership in registered designs as it is evident from the registration itself.

3. Trademark/Trade Dress Strategies

a. Registration as a pre-requisite to action?

Trademark registration is a pre-requisite to action. Bosnia is also party to the Madrid Agreement and Protocol Concerning the International Registration of Marks.

b. Scope of protection

The scope of protection encompasses the right to prohibit the use in the course of trade of a sign:

- which is identical to a registered trademark for identical goods;
- giving rise to likelihood of confusion as to the origin of goods due to similarity with a registered trademark and similarity of the goods;
- which without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of a registered trademark.

c. Key elements of infringement cause of action

- ownership of a valid trademark registration
- use of a sign in the course of trade within the scope of protection.

d. Remedies

- injunctions
- damages
- seizure and destruction of infringing products, compensation for destruction costs
- publication of judicial decisions

e. Challenges and benefits

Benefits: no need to prove ownership in a registered trademark; possibility to indefinitely renew a trademark registration.

Challenges: Bosnian Trademark Act allows trademark registration only for distinctive signs. Product shapes are often not perceived by consumers as trademarks and the offices tends to refuse registration of 3D marks unless they are unusual in relation to the goods or contain distinctive elements. Therefore, the availability of trademark protection to designs is in practice somewhat limited as they might not meet the distinctiveness requirement. In addition, trademark protection entails the obligation to use the design in order to maintain its registration as a trademark.

4. Common Law and/or Other Non-Statutory Claim Strategies

Common law or other non-statutory claims are not available in Bosnia.

Bulgaria

Contributor: Dimitar Batakliiev, PETOSEVIC Bulgaria

INTRODUCTION

The works of applied art and designs are explicitly listed by the Bulgarian Copyright and Related Rights Act as subject-matter of copyright protection in Bulgaria. They are also protectable as registered or unregistered industrial designs under the Industrial Design Act and Council Regulation (EC) No. 6/2002 on Community Designs. Designs could be protected also by registering a 3D trademark under the Trademarks and Geographical Indications Act or Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trademark. However, trademark protection is only available to designs which are distinctive, i.e., capable of designating the origin of the goods they are applied to.

Sending out a warning letter is not a procedural requirement. In practice, however, such letters are often sent in attempt to settle conflicts amicably and avoid litigation. Such letters might also facilitate the task of proving that an infringer has acted in bad faith, despite being notified of infringement, and in claiming higher amounts of damages.

Preliminary injunctions are also available. They are usually granted on the condition of payment of a deposit to the court, which serves as a security that can be allocated to the defendant in case the court denies the claims on the merits. Preliminary injunctions are usually granted within 1-2 weeks.

A possible challenge to the efficient enforcement of rights in Bulgaria is the practice of appointing court experts in infringement proceedings. Such experts could be asked different questions concerning the conflicting designs, which quite often pertain to questions of law rather than to questions of fact or do not require specialized knowledge. As a consequence, experts tend to step in the shoes of the court and their opinions influence to a great extent the final judgment. Moreover, judges usually side with the expert in drafting the judgment rather than the parties' arguments against the expert opinion.

1. Copyright Enforcement Strategies

a. Registration as a pre-requisite to action?

No registration is required to enforce copyright in Bulgaria.

b. Scope of protection

Copyright protection in Bulgaria encompasses two categories of rights: moral and economic rights.

The moral rights include:

- right of disclosure
- right to claim authorship
- right to remain anonymous or choose a pseudonym
- right to demand indication of the author's name, pseudonym or other sign of authorship

- right of integrity
- right of modification
- right to access the original work
- right to retract

The economic rights cover the right to use and authorize any use of the work by third parties, including:

- reproduction
- distribution
- public performance
- broadcasting
- transmission by cable
- presentation before public
- translation
- transformation and synchronization
- communication to the public
- import and export.

c. Key elements of infringement cause of action

- ownership of a valid copyright: copyrightable subject-matter, authorship or other form or entitlement, copyright term has not expired
- use of a protected work

d. Remedies

- injunctions
- damages
- seizure and destruction of infringing copies
- seizure of materials and equipment used for committing the infringement
- publication of judicial decisions

e. Challenges and benefits

The benefits of copyright protection in designs as applied art include wider scope and longer term (70 years from the author's death) compared to other forms of protection. There are no registration requirements and procedures.

Challenges include the need to prove ownership of a valid copyright as an additional element of infringement cause of action. Copyright protection is only available to the author, i.e., the individual who has created the work, and is not assignable. By exception, for works made for hire, the rights are vested with the employer or the entity, which has commissioned the work. Therefore, copyright enforcement is available to a limited number of interested persons.

Copyright protection is available to any work, resulting from a creative process. It is sufficient for the work to be an author's individual creation and the originality threshold is not high.

2. Design Patent Strategies

a. Registration as a pre-requisite to action?

Design protection in Bulgaria encompasses protection of both registered and unregistered designs.

Bulgarian law provides for protection of industrial designs registered with its national Patent Office or with the EUIPO. Bulgaria is also party to the Hague Agreement Concerning the International Registration of Industrial Designs.

Unregistered Community designs are protected under the Community Design Regulation.

b. Scope of protection

The scope of protection of an industrial design includes any design which does not produce on the informed user a different overall impression. A registered national or Community confers on its holder the exclusive right to use it and to prevent any third party not having his consent from using it.

An unregistered Community design confers on its holder the right to prevent unauthorized use by third parties only if the contested use results from copying the protected design. Protection does not extend to independent works of creation by a designer who may be reasonably thought not to be familiar with the design made available to the public by the holder.

c. Key elements of infringement cause of action

In respect of registered designs:

- ownership of a valid design registration
- use of a product in which the infringing design is incorporated or to which it is applied

In respect of unregistered designs:

- proof of the date and place of the first disclosure of the design in a way enabling the interested circles within the European Union to become aware of the disclosure itself.
- use of a product in which the infringing design is incorporated or to which it is applied

d. Remedies

- injunctions
- damages
- seizure and destruction of infringing products, compensation of destruction costs
- publication of judicial decisions

e. Challenges and benefits

Benefits: no need to prove ownership in registered designs as it is evident from the registration itself. Availability of protection for unregistered designs.

Challenges with respect to unregistered designs: the requirement to prove the date and place of the first disclosure of the design in a way enabling the interested circles within the European Union to become aware of the disclosure itself.

3. Trademark/Trade Dress Strategies

a. Registration as a pre-requisite to action?

Trademark registration is a pre-requisite to action. Trademarks can be registered with the Bulgarian Patent Office and the EUIPO. Bulgaria is also party to the Madrid Agreement and Protocol Concerning the International Registration of Marks.

b. Scope of protection

The scope of protection encompasses the right to prohibit the use in the course of trade of a sign:

- which is identical to a registered trademark for identical goods;
- giving rise to likelihood of confusion as to the origin of goods due to similarity with a registered trademark and similarity of the goods;
- which without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of a registered trademark.

c. Key elements of infringement cause of action

- ownership of a valid trademark registration
- use of a sign in the course of trade within the scope of protection.

d. Remedies

- injunctions
- damages
- seizure and destruction of infringing products, compensation for destruction costs
- publication of judicial decisions

e. Challenges and benefits

Benefits: no need to prove ownership in a registered trademark; possibility to indefinitely renew a trademark registration.

Challenges: The Bulgarian Trademark and Geographical Indications Act allows trademark registration only for distinctive signs. Product shapes are often not perceived by consumers as trademarks and the offices tends to refuse registration of 3D marks unless they are unusual in relation to the goods or contain distinctive elements. Therefore, the availability of trademark protection to designs is in practice somewhat limited as they might not meet the distinctiveness requirement. In addition, trademark protection entails the obligation to use the design in order to maintain its registration as a trademark.

4. Common Law and/or Other Non-Statutory Claim Strategies

Common law or other non-statutory claims are not available in Bulgaria.

Croatia

Contributor: Ivan Kos, PETOSEVIC Croatia

INTRODUCTION

The works of applied art and industrial design are anticipated by the Croatian Copyright and Related Rights Act as subject matter of copyright protection. They are also protectable as registered or unregistered industrial designs under the Croatian Industrial Design Act and Council Regulation (EC) No. 6/2002 on Community Designs. Designs can also be protected by registering a 3D national trademark under the Croatian Trademark Act or as EUTM under Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017. The trademark protection is only available to designs, which are sufficiently distinctive, and as such are capable to identify the origin of the covered goods.

Sending out a warning letter is not a procedural requirement, but they are often sent in an attempt to settle the conflict quickly and to avoid formal proceedings, which are lengthily and associated with additional costs. Majority of disputes are settled amicably since the infringers are not often aware that their use is infringing third party rights.

Preliminary injunctions are also available and are usually granted within 1 month.

A possible challenge to the efficient enforcement of rights in Croatia is the practice of appointing the court experts in infringement proceedings based on design rights and copyrights since the perception of the informed or expert user is relevant in the assessment. The expertise may have decisive role in such proceedings, since it could go beyond the mere factual abstract. This is not applicable for the claims based on trademark rights where perception of the public is relevant in likelihood of confusion test and where specialized knowledge is not required. On the other side it may be difficult to obtain trademark protection for product design, without additional distinctive features.

1. Copyright Enforcement Strategies

a. Registration as a pre-requisite to action?

Registration is not required to enforce copyright in Croatia.

b. Scope of protection

Copyright protection in Croatia encompasses moral, economic and other rights of the author.

The moral rights include:

- right of first disclosure
- right of recognition of authorship
- right of respect for the work and honor the reputation of the author
- right of revocation

The economic rights cover the exclusive right to use the copyright work and to prevent third parties from any use of the work which include:

- reproduction
- distribution and rental
- publication of a copyright to the public (i.e. public performance, public stage presentation, public transmission, public communication of fixed works, public presentation, broadcasting, rebroadcasting, public communication of broadcasting, right of making available to the public).
- alteration of the work

The other rights provide protection for other interests of the author in respect of his work and include:

- rights to remuneration
- resale right
- additional rights (i.e., right of access to the work, right to prohibit the public exhibition)

c. Key elements of infringement cause of action

- ownership of a valid copyright: copyrightable subject-matter, authorship or other form or entitlement, copyright term has not expired
- unauthorized use of a protected work

d. Remedies

- establishment of the infringement
- cease and desist from the infringing use
- damages, compensation and penalties, unfair profits
- destruction of infringing copies
- publication of judicial decisions
- injunctions

e. Challenges and benefits

The benefits of copyright protection in designs as applied art include wider scope and longer term (70 years from the author's death) compared to other forms of protection (excluding trademarks). There are no registration requirements and procedures.

Challenges include the need to prove ownership of a valid copyright as an additional element of infringement. Copyright protection is only available to the author, i.e., the individual who has created the work, and it cannot be transferred.

For works made for hire, the rights are vested with the employer or the entity, which has commissioned the work.

The author can grant another party the right to exploit a copyright work and to enforce the copyright with respect to economic rights.

Copyright protection is available to any work, resulting from a creative process. It is sufficient for the work to be an author's individual creation and the originality threshold is not high.

2. Design Patent Strategies

a. Registration as a pre-requisite to action?

Design protection in Croatia encompasses protection of both registered and unregistered designs.

Croatian law provides for protection of industrial designs registered with its national Patent Office or with the EUIPO. Croatia is also party to the Hague Agreement Concerning the International Registration of Industrial Designs.

Unregistered Community designs are protected under the Community Design Regulation.

b. Scope of protection

The scope of protection of an industrial design includes any design which does not produce on the informed user a different overall impression. A registered national or Community design confers its holder the exclusive right to use it and to prevent any unauthorized use.

An unregistered Community design confers on its holder the right to prevent unauthorized use by third parties only if the contested use results from copying the protected design. Protection does not extend to independent works of creation by a designer who may be reasonably thought not to be familiar with the design made available to the public by the holder.

c. Key elements of infringement cause of action

In respect of registered designs:

- ownership of a valid design registration
- unauthorized use of a product in which the design is incorporated or to which it is applied

In respect of unregistered designs:

- proof of the date and place of the first disclosure of the design in a way enabling the interested circles within the European Union to become aware of the disclosure itself.
- use of a product in which the design is incorporated or to which it is applied.

d. Remedies

- establishment of the infringement
- cease and desist from the infringing use
- damages, usual compensation, unfair profits
- seizure and destruction of infringing goods
- publication of judicial decisions
- injunctions

e. Challenges and benefits

Benefits: no need to prove ownership in registered designs as it is evident from the registration itself. Availability of protection for unregistered designs.

Challenges with respect to unregistered designs: the requirement to prove the date and place of the first disclosure of the design in a way enabling the interested circles within the European Union to become aware of the disclosure itself.

3. Trademark/Trade Dress Strategies

a. Registration as a pre-requisite to action?

Trademark registration is a pre-requisite to action. Trademarks can be registered with the Croatian IP Office and the EUIPO. Croatia is also party to the Madrid Agreement and Protocol Concerning the International Registration of Marks.

b. Scope of protection

The scope of protection encompasses the right to prohibit the use in the course of trade of a sign:

- which is identical to a registered trademark for identical goods;
- giving rise to likelihood of confusion as to the origin of goods due to similarity with a registered trademark and similarity of the goods;
- which without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of a registered trademark.

c. Key elements of infringement cause of action

- ownership of a valid trademark registration
- unauthorized use of a sign in the course of trade within the scope of protection.

d. Remedies

- establishment of the infringement
- cease and desist from the infringing use
- damages, compensation and penalties, unfair profits
- destruction of infringing copies
- publication of judicial decisions
- injunctions

e. Challenges and benefits

Benefits: no need to prove ownership in a registered trademark, since it follows from trademark registry; possibility to indefinitely renew a trademark registration.

Challenges: The Croatian Trademark Act allows trademark registration only for the distinctive signs. Product shapes, *per se*, are often not perceived by consumers as

identifiers of origin, unless they are unusual for the relevant goods. Therefore, the availability of trademark protection to designs is somewhat limited, as they might not meet the distinctiveness threshold. In addition, trademarks are subject to use requirements, in terms of enforcement and maintenance of trademark registration.

4. Common Law and/or Other Non-Statutory Claim Strategies

Common law or other non-statutory claims are not available in Croatia.

Finland

Contributor: Pauliina Heine and Irmeli Nokkanen, Papula-Nevinpat Finland

INTRODUCTION

***Remarks – the comments below were made under the perspective of civil claims, not criminal law and might not encompass exceptions applied to a specific case.**

1. Copyright Enforcement Strategies

a. Registration as a pre-requisite to action?

Copyright in Finland is governed by the Copyright Act (404/1961). Additionally, copyright is regulated by the Copyright Decree (574/1995). In accordance with the Copyright Act, a person who has created a literary or artistic work shall have copyright therein, whether it be a fictional or descriptive representation in writing or speech, a musical or dramatic work, a cinematographic work, a photographic work or other work of fine art, a product of architecture, artistic handicraft, industrial art, or expressed in some other manner. Copyrights are not registrable.

b. Scope of protection

The rights covered by copyright are set out in two sections in the Copyright Act, economic and moral rights. Economic rights include the exclusive right to control a work by reproducing it and by making it available to the public, in the original form or in an altered form, in translation or in adaptation, in another literary or artistic form, or by any other technique.

The exclusive right of reproduction includes making copies of the work in whole or in part, directly or indirectly, temporarily or permanently and by any means or in any form whatsoever. The transfer of the work on to another device by which it can be reproduced is also considered as reproduction.

A work is made available to the public when it is communicated to the public by wire or wireless means, performed in public or publicly displayed, or when copies thereof are offered for sale, rental or lending it, or are otherwise distributed to the public. Authors of works of fine art may receive resale remuneration where their works are professionally resold.

Moral rights include the right to be acknowledged as the author, the right of integrity, the right of the author to have access to the work, the right of the author to prevent the publication of the work or to make modifications to new editions of the work, and protection of the work against violations of cultural interests after the death of the author.

c. Key elements of infringement cause of action

Has someone unlawfully made a copy is one question and the other relevant question is whether the work exceeds the threshold of originality required for copyright protection. A work is protected by copyright if it can be considered as the author's own intellectual creation reflecting his or her personality. The usual criterion may be whether anyone embarking on the same design task could end up with a similar product. If the answer to this question can be considered as yes, then the product in question shall not be sufficiently independent and original in the copyright meaning.

d. Remedies

The Market Court is the competent court in copyright infringement matters in civil cases (in criminal cases the competent court is the District Court).

If a person infringes the copyright, the Court may prohibit him to proceed with or repeat the act. Additional remedies include compensation to the author for using the work or importing a copy of work into the country or bringing a copy of work onto the territory of Finland for transportation to a third country. However, the illegal reproduction of a work for private use shall be subject to compensation only in the case that the maker of the copy has known or should have known that the material copied has been made available to the public in violation of the Copyright Act. In addition, and if the work is used willfully or out of negligence, the infringer shall also pay damages for any other loss, including mental suffering and other detriment.

Further remedies include fine or imprisonment for up to 2 years for a copyright offence in accordance with the Criminal Code.

Further remedies include fine for a copyright violation in accordance with the Copyright Act, or fine or imprisonment for up to 2 years for a copyright offence in accordance with the Criminal Code.

e. Challenges and Benefits

Challenges:

As there is no registration of copyright, it may be difficult for third parties to know whether a certain piece of work enjoys copyright protection or not.

Benefits:

Benefits include that works enjoy protection automatically as long as they are considered "works" under the copyright law.

2. Design Patent Strategies

a. Registration as a pre-requisite to action?

In Finland protection for designs can be obtained either through national design rights (in Finnish “mallioikeus”) or through Community designs which are in force in the entire European Union. A national design right is always based on registration whereas a community design can be either registered or unregistered.

National design rights are governed by the Registered Designs Act (221/1971) and the Registered Designs Decree (252/1971). The Registered Designs Act, as amended in 2002, implements in Finland the EU Design Directive (98/71/EC) harmonizing the national laws of the European Union member states with respect to conditions for protection and the scope and duration of protection. Community designs are governed by the Community Design Regulation ((EC) No 6/2002).

National Finnish design right and registered Community design can be obtained also through international registrations designating Finland and the EU.

The replies to the question below are based on Finnish national law only.

b. Scope of protection

The right to a design implies that no person other than the owner of the design right is entitled to use the design without his consent. The use covers, among other things, the making, offering, putting on the market, using, importing, exporting, or stocking for these purposes of a product which matches the design or in which the design is incorporated. The rights conferred by a design right do not cover private use of the design for non-commercial purposes, use of the design for experimental purposes, nor acts of reproduction for the purposes of making citations or of teaching, provided that such acts are compatible with fair trade practice and do not unduly prejudice the normal exploitation of the design, and that mention is made of the source.

The scope of the protection conferred by a design includes any design which does not produce on the informed user a different overall impression. In assessing the scope of protection, the degree of freedom of the designer in developing his design is taken into consideration.

c. Key elements of infringement cause of action

Whether the differences are enough or not to produce on the informed user a different overall impression if the designs are not identical.

Who can be considered informed user in particular case.

The degree of freedom of the designer

Is the registration valid and the registration requirements novelty and individual character are fulfilled. Finnish Patent and Registration Office makes a substantial examination; however, it is very limited and covers only Finnish national designs, not e.g., registered Community designs which are in force in Finland.

Are all the features of the design covered by a design right or not: A design right does not subsist in features of appearance of a product which are solely dictated by its technical function or which must be reproduced in their exact form and dimensions in order to permit the product in which the design is incorporated to be mechanically connected to or placed in, around or against another product so that either product may perform its function, however a design right shall subsist in a design serving the purpose of allowing multiple assembly or connection of mutually interchangeable products within a modular system.

Whether a design is a component part of a complex product or not: the design of a product which constitutes a component part of a complex product is considered to be new and to have individual character, if the component part remains visible during normal use of the product and if the visible features of the component part fulfil in themselves the requirements as to novelty and individual character.

d. Remedies

The Market Court is the competent court in design infringement matters in civil cases (in criminal cases the competent court is the District Court of Helsinki). Anyone who infringes the right to a design may be prohibited by the Court from continuing or repeating such act.

If the infringement was made intentionally or through negligence, the infringer shall pay reasonable compensation for the use of the design, as well as compensation for the further damage caused by the infringement. If the negligence was minimal, the amount of compensation may be reduced.

If the infringement was made without intention or negligence, the infringer shall pay compensation for the use of the design, in so far as such compensation may be found reasonable.

Proceedings for compensation for an infringement shall be instituted within five years from the time when the damage was caused, otherwise the right to the compensation will be lost.

If the infringement was intentional the infringer is liable to a fine for violation of the right to a design unless the act is punishable as an intellectual property offence under section 2 of Chapter 49 of the Criminal Code. Punishment for an intellectual property offence is a fine or imprisonment for maximum of two years.

e. Challenges and Benefits

Challenges:

Very limited number of case law in Finland.

If the accused design is not identical, whether the differences are enough or not to produce on the informed user a different overall impression.

Are all the features of the design covered by a design right or not.

Benefits:

Protection is available for spare parts in Finland.

3. Trademark/Trade dress strategies

a. Registration as a pre-requisite to action?

In Finland protection for trademarks can be obtained either as national trademark rights, as EU trademarks that are in force in the entire European Union, or as international trademarks designating either Finland or the EU. An EU or international trademark right is always based on registration whereas a national trademark can be either registered or unregistered, in case the exclusive right has been obtained through establishing the mark by extensive use.

National trademark rights are governed by the Trademarks Act (7/1964) and the Trademarks Decree (296/1964). The reform of the Trademarks Act is currently underway, with the aim of implementing the new EU Trademark Directive (Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trademarks). It is currently expected that the new Act will enter into force in the beginning of 2019.

EU trademarks, on the other hand, are governed by the European Union trademark regulation (Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trademark).

The replies to the question below are based on Finnish national law only.

b. Scope of protection

The exclusive right to a trademark includes that no-one other than the proprietor of the trademark may use the following as a mark of their goods in the course of trade without the proprietor's consent:

- 1) a mark that is identical with the protected trademark for identical goods;
- 2) a mark that, due to its identicalness with or similarity to the protected trademark for identical or similar goods causes a risk of confusion among the public, which also includes a risk of association between the mark and the trademark.

If the trademark has a reputation in Finland, and the use of the mark without due cause would take unfair advantage of the distinctive character or the repute of the trademark, or be detrimental to the distinctive character or the repute of the trademark, no-one other than the proprietor of the exclusive right to the trademark may in the course of trade use a mark that is identical with or similar to the trademark with a reputation without the consent of the proprietor, even if the goods for which the mark is used are not identical or similar to those for which the trademark with a reputation is protected.

The following are considered use in the course of trade: affixing the mark to the goods or to the packaging thereof; offering the goods or putting them on the market, or stocking them for those purposes, under the mark; importing or exporting the goods under the mark, or importing the goods for transport to a third country; using the mark on business papers in marketing; and other corresponding use of the mark, including oral use.

However, the owner of a trademark cannot prohibit a third party from using the trademark in the course of trade, if its use is for example necessary for indicating the purpose of the goods and the use is in accordance with good business practices.

The Finnish Trademarks Act also contains provisions relating to the passivity of the owner of the prior mark. Accordingly, the exclusive right to a registered trademark is retained parallel to a trademark registered or established previously, if the registration was applied for in good faith, and the proprietor of the previously registered or established trademark has not taken action to prevent the use of the trademark registered later although the proprietor has been aware of its use for a period of five years. Furthermore, the exclusive right to an established trademark is retained parallel to a trademark registered or established previously, if the proprietor of the previously registered or established trademark has not acted within a reasonable time to prevent the use of the trademark established later, and the trademark established later was adopted in good faith. In both cases, it may be ruled that one or both marks concerned may be used only in a specific manner.

Protection may also on some instances be awarded under the Finnish Unfair Business Practices Act (1061/1978), based on which good business practice may not be violated nor may practices that are otherwise unfair to other entrepreneurs be used in business.

c. Key elements of infringement cause of action

Key elements for success in relation to enforcement

Whether the use may be considered to have been in the course of trade and whether the marks/goods may be considered identical or similar (or whether the infringed mark has a reputation in Finland).

d. Remedies

The Market Court is the competent court in trademark infringement matters in civil cases (in criminal cases the competent court is the District Court of Helsinki). The Court may issue a permanent injunction prohibiting the infringer from using the infringing mark or any other mark that is confusingly similar to the trademark owner's mark or to issue an order to discontinue this use. Also, compensation of the use of the mark becomes payable, as well as compensation for all the damage caused by the infringement. Compensation for damage requires intent or negligence, but even if no negligence is found, the infringer is obliged to pay a reasonable compensation for the use of the mark.

Further remedies include fine for a violation of trademark rights in accordance with the Finnish Trademarks Act, or fine or imprisonment for up to 2 years for an intellectual property offence in accordance with the Criminal Code.

e. Challenges and Benefits

Challenges:

Even though a prior right to a trademark can be obtained through establishing the mark, proving that the mark is established may in practice be difficult, and the existence of an established trademark cannot be verified from databases. With regard to marks with reputation, the Finnish PTO maintains a list of marks considered to have a reputation in Finland, but this list is neither binding nor exhaustive. Finally, and for infringement cases, damages are only awarded for actual damage occurred, which as such also includes pure economic loss. However, proving actual damage may be difficult, for which reason the level of damages awarded has in general been quite moderate.

Benefits:

The Finnish PTO conducts a full examination of trademark applications on both absolute and relative grounds. This includes prior trademark applications and registrations (national, EU, IR) in force in Finland, trade names and surnames. The examination improves legal certainty and predictability, however established trademarks are not included.

4. Common Law and/or Other Non-Statutory Claim Strategies

Not available.

France

Contributor: Frank Valentin and Cédric Meiller and Lylia Lanasri, Altana

INTRODUCTION

1. Copyright Enforcement Strategies

a. Registration as a pre-requisite action?

No. There exists no obligation to voluntarily register the copyright in a work in France. However, any claim based upon copyright must necessarily be documented with a creation date. As a mere precautionary rule, various means are offered to the owner to secure this date included with the French IP Office.

France is a party to the Berne Convention, which states that the copyright starts to exist immediately when the work is created (as long as the idea is embodied).

As a result, under French law, the author has an exclusive intangible property right that is enforceable against all, by the mere fact of its creation. The work shall be deemed to have been created, independently of any public disclosure, solely by virtue of the completion, even if incomplete, of the author's conception ([Articles L111-1 and L111-2 of the French Intellectual Property Code – "IPC" –](#)).

b. Scope of protection

The scope of protection is provided in Part I, Book I of the French IPC (See Link).

According to the Article L112-2 of this Code, the following, in particular, shall be considered works protected under copyright:

- books, brochures and other literary, artistic and scientific writings;
- lectures, addresses, sermons, pleadings and other works of such nature;
- dramatic or dramatic-musical works;
- choreographic works, circus acts and feats and dumb-show works, the acting form of which is set down in writing or in other manner;
- musical compositions with or without words;
- cinematographic works and other works consisting of sequences of moving images, with or without sound, together referred to as audiovisual works;
- works of drawing, painting, architecture, sculpture, engraving and lithography;
- graphical and typographical works;
- photographic works and works produced by techniques analogous to photography;
- works of applied art;
- illustrations, geographical maps;
- Plans, sketches and plastic works relating to geography, topography, architecture and science;
- software, including the preparatory design material;

- the creations of the seasonal clothing and ornament industries. Seasonal clothing and ornamental industries are those industries which, because of the requirements of fashion, frequently renew the shape of their products, and in particular sewing, fur, lingerie, embroidery, fashion, footwear, gloves, leather goods, the manufacture of high-novelty or special haute couture fabrics, the production of ornamental and botanical fabrics and the manufacture of upholstery fabrics.

This list is non-exclusive, the following conditions must be satisfied for all works in order to benefit from French copyright protection: the work must be fixed in a material form and the work must be original. A work is considered original if it is endowed with the personality of its author. Considerations such as the merit of the author or the purpose of the work, the type of work or the form of expression are irrelevant. The French courts shall simply be convinced by the creative effort of the claimant (e.g. [Cass. civ.1, March 7th 2018, n°17-11905](#)).

The originality is no longer presumed. According to recent decisions, the plaintiff must demonstrate that his creation is original (e.g. [Cass. civ. 1, November 8th 2017, n°16-22105](#)).

The author owns both the economic rights and the moral rights to his work.

- The author shall enjoy the economic rights throughout his life. Upon the death of the author, this right shall continue to be enjoyed by his successors during the current calendar year and the following seventy years ([Article L123-1 of the French IPC](#)).
- The moral rights are perpetual, inalienable and imprescriptible, and is transmissible by death to the author's heirs. The exercise may be conferred on a third party by virtue of testamentary provisions ([Article L121-1 of the French IPC](#)).

French copyright can also apply to a registered design or model right thanks to the so-called "unity of art" theory that allows the accumulation of protection by the French copyright and a registered design or model.

c. Key elements of infringement cause of action

The economic rights of the author are (i) the performing right, which consists of the communication of the work to the public by any means, and (ii) the reproduction right, which consists of the fixing of the work in a material form.

The moral right includes the following prerogatives:

- the right for the author to divulge his work;
- the right to have his/her name indicated on any reproduction or representation of his work;

- the right to the integrity of the work: the right to oppose any distortion, mutilation of his work as well as to oppose any modifications that would alter the spirit of his work;
- the author has the right to withdraw his work from the market after its publication provided that he or she indemnifies the assignee for any harm suffered as a result of the reconsideration or the withdrawal.

Any representation or reproduction in whole or in part made without the consent of the author or his successors or assigns is unlawful. The same applies to translation, adaptation or transformation, arrangement or reproduction by any art or process ([Article L122-4 of the French ICP](#)).

However, according Article L122-5 of the French IPC (see [link](#)), there are certain exceptions to the exclusive rights granted to the owner (e.g. copies or reproductions reserved strictly for the private use; parody, pastiche and caricature; etc.).

Any reproduction, representation or distribution, by any means whatsoever, of a creation protected by the French copyright in violation of the author's rights, constitutes an infringement ([Article L335-3 of the French IPC](#)).

d. Remedies

A copyright holder can enforce its right by bringing a legal action before the civil court. Regularly constituted professional defense organizations shall also be entitled to bring legal proceedings to defend the interests for which they are statutorily responsible ([Article L331-1 of the French IPC](#)).

Civil actions and claims relating to literary and artistic property, including where they also concern a related question of unfair competition, shall be brought before one out of 10 lower civil courts "TGI, which have an exclusive jurisdiction to judge infringement concerning intellectual property.).

The statute of limitations for bringing a copyright infringement claim is five years from the date on which the claimant became aware or ought reasonably to have become aware of the infringing act.

According to the French IPC, several remedies are available against a copyright infringer ([Part 1, Book III, Title III](#)):

- Search and seizure and legally admissible investigation measures ([Articles L332-1 to L332-3 of the French ICP](#));
- Seizure of revenues ([Articles L331-1 to L333-4 of the French ICP](#));
- Technical protection and information measures ([Article L331-5 to L331-1 of the French IPC](#));
- Award of monetary damages. The court shall take into account separately:

- the negative economic consequences of the infringement of rights, including loss of income and loss suffered by the injured party;
- the moral prejudice caused to the latter;
- And the profits made by the author of the infringement, including the savings in intellectual, material and promotional investments that he has made from the infringement.

However, the court may, as an alternative and at the request of the injured party, award a lump sum as damages. This amount is higher than the amount of royalties or fees that would have been due if the infringer had requested permission to use the right infringed. This sum is not exclusive of compensation for moral prejudice caused to the injured party ([Article L331-1-3 of the French IPC](#)).

While the French courts used to retain the possibility of obtaining distinct damages for infringement of copyright and design or model, the French jurisdiction have considered that a double compensation is not fair (TGI Paris, September 29th 2016, n°14-18124: PIBD 2016, n°1061, III, p.932; TGI Paris, March 30th 2017, n°15-05884).

- The court may order the precautionary seizure order of the capital assets and real estate of the alleged infringer ([Article L331-1-1 of the French ICP](#)).
- The court hearing the case on the merits or in summary proceedings may order, if necessary under penalty payment, injunction to disclose all the information regarding the distribution networks and the quantities of infringing products ([Article L331-1-2 of the French ICP](#)).
- In the event of a civil sentence for infringement, the court may, at the request of the injured party, order the recall or removal from trade circuits, destruction or confiscation for the benefit of the victim, the objects made or manufactured in breach of the rights of the victim. The court may also order, at the defendant's costs, any appropriate measure to publish the judgment (e.g. publication in full or by extract in newspapers, website). The court may also order the confiscation of all or part of the revenue generated by the infringement ([Article L331-1-4 of the French ICP](#)).

The duration of the proceedings depends on the complexity of the case and on the availability of court time. However, a proceeding at first instance will usually last 12 to 18 months. Moreover, under the French Procedure Code:

- In cases where it is required to immediately ongoing or imminent copyright infringements, copyright holders can obtain interim measures (prohibitive injunction, provisional damages) before the president of the court and can expect a preliminary decision within a few days or weeks. However, the president will not rule on the merits of the case (the infringement) but will only order interim measures. Furthermore, for an urgent matter, an expedited proceeding can be requested, which enables the plaintiff to obtain a first

instance decision on the merits of the case within three to six months (e.g. [Articles 788, 808 and 809 of the French Procedure Code](#)).

- It is also possible to obtain the award of legal costs ([Article 700 of the French Procedure Code](#)).

Alternatively, a copyright infringement can be pursued before the criminal courts since copyright infringement is also a criminal offense. ([Articles L335-1 and following of the French IPC](#)). Such option is usually triggered or favored when facing a gross infringement of a famous or indisputable work of art, because criminal judges are not quite keen on tackling IP issues.

e. Challenges and benefits

Challenges:

- One difficulty for the claimant may consist in giving evidence of its standing to proceed against copyright infringements, specifically when the rights in the work have been transferred to a third party without concluding any written contract.
- Companies in France however may benefit from a presumption of ownership provided they are able to show that the work upon which they claim copyright was disclosed under their name.
- Furthermore, it may be quite challenging to prove the originality and the reflection of the personality of the author for some works (e.g. design used for practical purposes or a mere catch phrase).

Benefits:

- One major benefit is the very long period of protection of the economic rights, namely 70 years after the author's death.
- Furthermore, copyright exists immediately with the creation of the work regardless merit or destination and there is no requirement to use copyright work. Besides there is no minimum threshold notoriety, and no need to prove marketing and sale activities.

2. Design Patent Strategies

a. Registration as a pre-requisite to action?

Yes. Under French law, French designs or models have to be registered with the French National Institute of Industrial Property (INPI. See [link](#)). Moreover, events affecting the designs or models must be recorded in the register (assignment contract, license, etc.).

b. Scope of protection

Designs are two-dimensional appearances and models three-dimensional appearances of the whole or a part of the product, resulting from the features of, and in particular its lines, contours, colors, shape, texture or materials, eligible for protection. These features can be those of the product itself or its ornamentation. Is deemed to be a product any industrial or handicraft item, including inter alia parts intended to be assembled into a complex product, packaging, get-up, graphic symbols and typographic typefaces, but excluding computer programs ([Article L511-1 of the French IPC](#)).

Only a design which is new and has individual character can be protected ([Article L511-2 of the French IPC](#)):

- A design or model shall be deemed to be new if, on the date of the filing of the application for registration or on the date of priority claimed, no identical design or model has been disclosed. Designs or models shall be deemed to be identical if their features differ only in immaterial details ([Article L511-3 of the French IPC](#)).

The novelty of the model is assessed not according to the use that the consumer can make of it but with regard to the elements of the filing (Paris, October 24th 1997, PIBD 1998. III.88).

- A design or model has individual character if the overall visual impression it produces on the informed observer differs from that produced by any design or model disclosed before the date of the filing of the application for registration or before the date of priority claimed. In assessing individual character, the degree of freedom of the creator in developing the design or the model shall be taken into consideration ([Article L511-4 of the French IPC](#)).
- According to the Article L511-5 of the French IPC (See [Link](#)), the design or model of a part of a complex product (which is considered as a product composed of multiple components which can be replaced) is only considered to be new and to present an individual character to the extent that :
 - the component part, once it has been incorporated in the complex product, remains visible during normal use of the latter by the end user, excluding maintenance, servicing or repair work;
 - those visible features of the component part fulfil in themselves the requirements as to novelty and individual character.

Designs or models that are contrary to public policy or accepted principles of morality are not protected. Moreover, shall not be eligible for protection:

- The appearance of a product whose features are solely dictated by the technical function of the product. This means that the only legitimate protection would be through patents;
- The appearance of a product whose exact form and dimension must necessarily be reproduced in order to allow it to be mechanically associated to another product by being placed against it, connected to it or being placed inside or outside of it in a manner allowing both of these products to perform its function.

However, a design or a model serving the purpose of allowing multiple assemblies or connections of mutually interchangeable products within a system whose design is modular shall be eligible for protection ([Articles L511-7 and L511-8 of the French IPC](#)).

The maximum term of protection for a design is 25 years from the date of filing ([Article L513-1 of the French IPC](#)). Indeed:

- Registration takes effect, as from the date of the filing of the application, for a period of 5 years, which may be extended by periods of 5 years within a maximum limit of 25 years.

c. Key elements of infringement cause of action

The protection of the design or model is acquired by registration. It is granted to the creator or to his successor-in-title. The applicant for registration is, failing evidence to the contrary, considered to be the beneficiary of this protection ([L511-9 of the French IPC](#)).

The registration of a design or model confers upon its holder a property right, on French territory, that may be assigned or licensed by him ([Article L513-2 of the French IPC](#)).

Unless with the consent of the owner of the design or model the making, offering, putting on the market, importing, exporting, using or possession for these purposes, of a product in which the registered design is incorporated, shall be prohibited ([Article L513-4 of the French IPC](#)). Those exploitations of a design or model without the consent of the right holder shall constitute an infringement.

The protection conferred by the registration of a design or model shall be extended to any design or model which does not produce on the informed observer a different overall visual impression ([Article L513-5 of the French IPC](#)).

The informed observer is defined as an observer with particular vigilance, whether because of personal experience or extensive knowledge of the sector concerned ([Cass. com., April, 3rd 2013, n° 12-13356](#)).

However:

- The rights conferred by the registration of a design or model shall not be exercised concerning ([Article L513-6 of the French IPC](#)):
 - acts done privately and for non-commercial purposes;
 - acts done for experimental purposes;
 - acts of reproduction for the purposes of making citations or teaching, if these acts mention the registration and the name of the right holder, provided they are compatible with fair business practices and do not prejudice the normal exploitation of that design or model.
- The rights conferred by the registration of a design or model shall not extend to acts covering a product comprising this design or model, when this product has been put on the market in the European Community or in the European Economic Area by the owner of the design or model or with his consent ([Article L513-8 of the French IPC](#)).

d. Remedies

The civil action for infringement is brought by the owner of the design. However, the beneficiary of an exclusive right of exploitation may, unless otherwise provided in the licensing contract, bring an infringement action if, after formal notice, the owner of the design does not bring such action ([Article L521-2 of the French IPC](#)).

Any party to a license agreement is entitled to intervene in infringement proceedings brought by another party in order to obtain compensation for its own damage.

Civil actions and design or model claims, including where they also concern a related question of unfair competition, shall be brought exclusively before one out of the 6 lower civil courts “TGI” which have an exclusive jurisdiction to judge infringement of designs or models.).

The statute of limitations for bringing a design right infringement claim is five years from the last infringing act which the claimant became aware of or ought reasonably to have become aware of. Infringement of a design or model can be proven by any means.

To facilitate the proof, the French Code allows, through ex-parte ruling of the competent jurisdiction, the seizure of counterfeit goods under the condition that the plaintiff brings a civil or criminal action ([Article L521-4 of the French ICP](#)).

The available remedies for registered design holders are identical to those offered to copyright owners (see above)

e. Challenges and benefits

Challenges:

- The design or model invoked has to respect the French criteria, however its validity may be challenged in front of the court as a claim or counterclaim. It can be challenged to clearly separate between the technical and aesthetic features of the design or model.
- No statute of limitation is applicable when challenging the validity of a registered design right.

Benefits:

- Simple registration procedure and possibility to include various representations in one application. The INPI checks the application on its form (application form, fees paid, etc.) and, on its content, checks that the application is not contrary to public policy and morality. In the event of objections from the INPI, it is possible to make regularizations and comments. The INPI does not examine the novelty or individual character of the design or model when registering it. Those criteria can only be contested by third parties.
- Formal right that may strengthen one's position and is easy to obtain.
- Possibility to defer the publication of the design application if the applicant wants to keep the design secret:

- for a maximum of three years in case of classic filing concerning all reproductions attached to the application form;
- for a maximum of 30 months in case of simplified filing concerning all or part of the reproductions attached to the application form.

However, if the publication demand is not made within the time limit, the INPI will declare the forfeiture of the filing for the design or model not published.

3. Trademark/ Trade Dress Strategies

a. Registration as a pre-requisite to action?

Yes. Any natural person or legal entity can apply for a French trademark before the French National Institute of Industrial Property (INPI, See [link](#)). Moreover, events affecting the trademark must be recorded in the register (assignment contract, pledge etc.).

However, the Article 6bis of Paris Convention for the Protection of Industrial Property provides that a trademark constituting a well-known trademark should be protected without need of registration ([Articles L714-4](#) and [L713-5 of the French IPC](#)).

b. Scope of protection

The scope of protection is provided in Part II, Book VII of the French IPC (Cf. [link](#)).

According to the Article L711-1 of this Code, a trademark or service mark is a sign capable of graphic representation which serves to distinguish the goods or services of a natural or legal person.

The following, in particular, may constitute such a sign:

- Denominations in all forms, such as: words, combinations of words, surnames and geographical names, pseudonyms, letters, numerals, abbreviations;
- Audible signs such as: sounds, musical phrases;
- Figurative signs such as: devices, labels, seals, selvedges, reliefs, holograms, logos, synthesized images; shapes, particularly those of a product or its packaging, or those that identify a service; arrangements, combinations or shades of color.

The following shall not be of a distinctive nature and are excluded from trademark protection:

- signs or names which in everyday or technical language simply constitute the necessary, generic or usual designation of the goods or services;
- signs or names which may serve to designate a feature of the product or service, particularly the type, quality, quantity, purpose, value, geographical origin, time of production of the goods or furnishing of the service;
- signs exclusively constituted by the shape imposed by the nature or function of the product or which give the product its substantial value.

As a result, the graphic elements of a design or model can be protected through trademarks if the sign is not exclusively constituted by the shape imposed by the nature or function of the product or which give the product its substantial value. Those mark can be invoked along with other rights such as copyright (e.g. [Cass. com., March 11th 2003, n°02-16.141](#)).

The following may not be adopted as a mark or an element of a mark ([Article L711-3 of the French IPC](#)):

- signs excluded by Article 6ter of the Paris Convention for the Protection of Industrial Property of March 20, 1883, as revised or by paragraph 2 of Article 23 of Annex 1C to the Agreement Establishing the World Trade Organization;
- signs contrary to public policy or morality or whose use is prohibited by law;
- signs liable to mislead the public, particularly as regards the nature, quality or geographical origin of the goods or services.
- No statute of limitation is applicable to an action aiming at challenging a mark on the above grounds.

Moreover, may not be adopted as a trademark a sign infringing earlier rights, such as copyright, personality rights, trade names, the list of possible prior rights, ([Article L711-4 of the French IPC](#)):

The ownership of the trademark is acquired through registration. The trademark may be acquired in co-ownership. The registration shall take effect from the filing date of the application for a period of ten years, renewable indefinitely ([Article L712-1 of the French IPC](#)).

c. Key elements of infringement cause of action

The registration of the trademark confers on its owner a right of ownership of the trademark for the goods and services he has designated. French law does not protect unregistered trademarks.

The following are prohibited, unless authorized by the owner:

- the reproduction, use or affixing of a mark, even with the addition of words such as: "formula, manner, system, imitation, kind, method", as well as the use of a reproduced mark, for goods or services identical to those designated in the registration;
- the removal or modification of a mark duly affixed ([Articles L713-1 and L713-2 of the French IPC](#)).

The following are also prohibited, unless authorized by the owner, if this may lead to a risk of confusion in the minds of the public:

- the reproduction, use or affixing of a mark, as well as the use of a reproduced mark, for goods or services similar to those designated in the registration;
- the imitation of a trademark and the use of an imitated trademark, for goods or services identical or similar to those designated in the registration ([Article L713-3 of the French IPC](#)). All prohibited uses must take place "in the course of trade"

In assessing the likelihood of confusion, account shall be taken of the signs as they appear from the registration, without taking into account the conditions under which the mark is used.

The likelihood of confusion must be assessed overall in the light of the overall impression produced by the marks, taking into account, in particular, the degree of visual or conceptual similarity between the signs, and the degree of similarity between the goods and the knowledge of the market ([Cass. com., March 15th 2017, n°15-19513](#)).

To appreciate the risk of confusion in the minds of the public, the risk is assessed in relation to the consumer of average attention ([Cass. com., June 27th 2018, n°17-13390](#)).

French law also provides specific protection for “renowned” trademarks enabling its owner to take action in cases when, even though the controversial use does not concern the specific goods or services protected by the registration, it is felt that the user is taking advantage of the fame of the trademark.

The owner of a trademark who, without just cause, has not made serious use of it for the goods and services covered by the registration for an uninterrupted period of five years shall forfeit his rights ([Article L714-5 of the French IPC](#)). It is therefore recommendable prior to any infringement action to check whether the Trademark is or not eligible to forfeiture of rights

d. Remedies

Infringement of the trademark owner's right constitutes an infringement for which the author is liable under civil law ([Article L716-1 of the IPC](#)).

The civil action for infringement is brought by the owner of the trademark. However, the beneficiary of an exclusive right of exploitation may bring an action for infringement, unless otherwise stipulated in the contract if, after formal notice, the holder does not exercise this right. Any party to a license agreement is entitled to intervene in infringement proceedings brought by another party in order to obtain compensation for its own damage ([Article L716-5 of the French ICP](#)).

Civil actions and claims relating to trademarks, including where they also concern a related question of unfair competition, shall be brought exclusively before any of the 6 The statute of limitations for bringing a design right infringement claim is five years from the last infringing act which the claimant became aware of or ought reasonably to have become aware of. ([Article L716-5 of the French ICP](#)).

According to the French IPC, several remedies are available against a trademark infringer:

- Provisional and protective measures, can be asked by request or summary proceedings under the regime of the Article L716-6 of the French ICP.

These measures are indeed common to other IP rights and now essentially stem from EC Directive 2004/48 dated April 29, 2004 in relation to the respect of IP rights.

- French law also provides a regime for detention under customs control of infringing products. The products may be seized, removed from trade circuits or destroyed (Articles L716-8 and followings of the French ICP).

The duration of the proceedings depends on the complexity of the case and on the availability of court time. However, a proceeding at first instance will usually takes 12 to 18 months.

A trademark infringement can be pursued criminally ([L716-10 of the French IPC](#)).

e. Challenges and benefits

Challenges:

- Registration three-dimensional trademarks (e.g. consisting of the packaging of goods) is difficult, many objection from INPI are based on lack of distinctiveness or the existence of a technical function (e.g. [Cass. com., May 30th 2007, n°05-16.898](#)).
- Since French jurisdiction tend to be severe when it comes to assess the distinctiveness of a trademark, it is important to show that such distinctiveness could stem from the use of the sign which can be regarded as a key factor to gain on distinctiveness.
- Choosing the right trademark or strengthen its use prior an infringement action to avoid a possible forfeiture of rights.

Benefits:

- Unlimited protection (a trademark is registered for an initial term of 10 years, starting on the day of filing. It can be renewed for additional 10-year terms indefinitely).

4. Common Law and/or Other Non-Statutory Claim Strategies

Not applicable

Germany

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INTRODUCTION

The Apple iPad, Mart Stam's tubular steel chair, Stokke's "Tripp Trapp" chair, the Wagenfeld lamp and the Lego brick are just a few examples of famous industrial design products.

The designers or manufacturers strive to protect the unique design of their products against counterfeit products. However, obtaining protection for industrial design products or works of applied art may be difficult and may be denied if the design follows from the technical function of the product.

The aim of this report is to provide a basic overview about different schemes of protection and civil law enforcement strategies for industrial design products within Germany, namely protection under copyright law, design law and trademark law.

1. Copyright Enforcement Strategies

a. Registration as a pre-requisite to action?

No. There is no registration requirement and there exists no public authority to voluntarily register the copyright in a work in Germany.

b. Scope of protection

Germany is a party to the Berne Convention, which states that copyright arises upon the creation of the work. Under German law copyright is protected during the creator's life and 70 years after the creator's death.

The scope of protection is stipulated in Sec. 1 and 2 of the German Copyright Act ("Urhebergesetz", https://www.gesetze-im-internet.de/englisch_urhg/). According to Sec. 2 (1) No. 4 of the German Copyright Act, works of applied art may be protected by copyright.

Key requirement for copyright protection is that the work is the author's own intellectual creation. This is the case if the work enjoys a degree of individuality and artistic value. Whilst it is not sufficient that a work is – at its time of creation – merely different from other existing works, an absolute novelty of the work is not required. Thus, in principle, it is possible that the same work has been created by two different authors independently from each other.

In the past, German courts requested a higher level of artistic value for works of applied art than for works of art. In the so-called "Geburtstagszug" (birthday train) decision the German Federal Court of Justice ruled that the same level of artistic value and individuality applies for both works of art and works of applied art (German Federal Court of Justice, decision of 13 November 2013, GRUR 2014, 175 - Geburtstagszug).

Based on the above-mentioned principles, German courts have, i.a., ruled that the following industrial design products are protected by copyright:

- Mart Stam's tubular steel chair:



(German Federal Court of Justice, decisions of 27 February 1961, docket no. I ZR 127/59, GRUR 1961, 635 – “Stahlrohrstuhl” and 27 May 1981, docket no. I ZR 102/79, GRUR 1981, 820 – “Stahlrohrstuhl II”).

- Eileen Grey's “Adjustable Table E1027”



(Higher Regional Court of Karlsruhe, decision of 22 September 1993, docket no. 6 U 92/93, GRUR 1994, 283 – “Eileen Gray I”).

- The USM Haller furniture:



(Higher Regional Court of Frankfurt on the Main, decision of 11 February 1988, docket no. 6 U 182/85, GRUR 1990, 121, 122 – *USM-Haller*)

- Stokke's “Tripp Trapp” chair:



(Hanseatic Higher Regional Court of Hamburg, decision of 21 August 2002, docket no. 5 U 217/01, BeckRS 2002, 8899).

- The Wagenfeld lamp:



(German Federal Court of Justice, decision of 15 February 2007, docket no. I ZR 114/04, GRUR 2007, 871).

- A jewelry ring:



(Higher Regional Court of Dusseldorf, decision of 30 May 2000, docket no. 20 U 4/99, ZUM-RD 2001, 385).

- A chimney:



(Higher Regional Court of Cologne, decision of 26 June 2009, docket no. 6 U 199/08, GRUR-RR 2010, 89, 90 – “Kaminofen”).

- A city railway:



(German Federal Court of Justice, decision of 8 May 2002, docket no. I ZR 98/00, GRUR 2002, 799 – Stadtbahn II).

c. Key elements of infringement cause of action

According to Sec. 97 of the German Copyright Act, any person who infringes the copyright may be required by the injured party to eliminate the infringement or in case of a risk of repeated infringements to cease and desist.

The key elements required for an infringement action are:

- Work that is protected by copyright.
- Infringement of the copyright.
- Illegality of the infringement.
- Entitlement to take action against the infringement (e.g., author or licensee).
- Passive legitimization (usually the infringer; under certain conditions a disturber, e.g., intermediaries like Amazon, Youtube, etc., may also be held liable).

If the industrial design product is protected by copyright, the crucial question is whether the later work infringes this copyright. This is the case if the infringing work is an (unauthorized) derivative work, within the meaning of Sec. 23 of the German Copyright Act, and not a (legitimate) free usage of an earlier work, within the meaning of Sec. 24 (1) of the German Copyright Act. The question whether something is an (unauthorized) derivative work or a (legitimate) free usage of an earlier work is to be determined by the degree of similarities of the objects and not by the differences, because the public's attention is generally more focussed on the similarities of two objects than on the features that are different.

A free usage pursuant to Sec. 24 (1) of the German Copyright Act only exists if an independent work, i.e., a completely independent new creation, has been accomplished. This means that an earlier, copyright-protected work may only have been used to inspire the own, new creation of the creator of the subsequent work. In this respect, the threshold for a new creation and for a new, independent work is high (German Federal Court of Justice, decision of 11 March 1993, docket no. I ZR 264/91, GRUR 1994, 191, 183 – “Asterix-Satire”).

d. Remedies

According to the German Copyright Act, remedies encompass temporary and permanent injunctions, information concerning the infringing activity (e.g., on supply and sales of the infringing products), seizure and destruction of infringing products and other copyright infringing material (e.g., product catalogues). In case of intentional or negligent copyright infringements, the infringer is obliged to pay the injured party damages for the prejudice suffered as a result of the infringement.

Before initiating court proceedings, the right holder should send a warning letter to the infringer, requesting the infringer to sign a cease-and-desist declaration (Sec. 97a of the German Copyright Act).

In cases where it is required to immediately prohibit ongoing or imminent copyright infringements, German law provides very efficient means of obtaining preliminary injunctions by the competent courts within a couple of days or even within a couple of hours (e.g., during a tradeshow). These preliminary court orders usually encompass a preliminary injunction to immediately stop the infringing activity. Under certain circumstances (e.g., during a tradeshow), the court may even order the seizure of the infringing goods in order to secure the claims for destruction of the infringing products. An application for a preliminary injunction will only be granted by German courts if the matter is urgent. Most German courts grant a one-month grace period between knowledge of the infringing action and the filing of an application for a preliminary injunction.

Full-Scale proceedings may encompass permanent injunctions as well as annex claims (e.g., information claims, destruction and payment of damages).

The competent courts are the District Courts or the Regional Courts (depending upon the value of the claims in dispute) at the place where the infringing activity took place (in case of infringements on the Internet, the right holder may freely choose the court). Most German States have named specific courts, which are exclusively competent for copyright infringements.

e. Challenges and benefits

Challenges:

One major challenge is to prove the entitlement to proceed against copyright infringements. If the rights in the work have been licensed to a third party, it may be difficult to prove the chain of title, e.g., because the parties did not conclude any written contract.

Furthermore, it may be quite challenging to obtain copyright protection for specific works, e.g., for works of the applied art with a purist and minimalistic design. In this case it is required to prove that the shape of the product does not merely result from its technical function but has an aesthetic value. It may be helpful to provide expert opinions from design professors in order to underline that the work is protected by copyright. However, even if copyright is granted for works of the applied art, the scope of copyright protection may be very narrow, in particular in case of minimalist designs.

Benefits:

One major benefit is the long period of protection for copyright, namely 70 years after the author's death. Furthermore, copyright exists immediately with the creation of the work. Besides, there is no requirement to use the copyrighted work nor any minimum threshold of notoriety and, thus, no need to prove marketing and sales activities.

2. Design Patent Strategies

a. Registration as a pre-requisite to action?

Yes. Designs must be registered with the German Patent and Trademark Office (GPTO).¹ The maximum term of protection for a design is 25 years from the date of filing.

b. Scope of protection

Designs are two-dimensional or three-dimensional appearances of the whole or a part of a product resulting from the features of the product itself or its ornamentation, in particular, the lines, contours, colors, shape, texture or materials (Sec. 1 of the German Act on the Legal Protection of Designs ("Designgesetz"), http://www.gesetze-im-internet.de/englisch_geschmmg/englisch_geschmmg.html).

A design can only be protected if it is new and has individual character. A design shall be deemed to be new if no identical design was disclosed prior to the date of filing the application. Designs shall be deemed to be identical if their features differ only in immaterial details (Sec. 2 (2) of the German Act on the Legal Protection of Designs).

According to Sec. 2 (3) of the German Act on the Legal Protection of Designs, a design shall have individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been disclosed prior to the date of filing of the application. In assessing individual character, the degree of freedom of the designer in developing the design shall be taken into consideration.

Features of appearance of a product which are solely dictated by their technical function may not be protected as a design (Sec. 3 (1) No. 1 of the German Act on the Legal Protection of Designs).

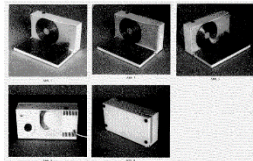
According to the ECJ, in order to decide whether the features of appearance of a product are exclusively dictated by its technical function, it must be established that the technical function is the only factor which determined those features, the existence of alternative designs not being decisive in that regard. It is up to the

¹ Designs may also be protected as Community Designs which can be registered with the EUIPO or as international designs registered via the WIPO. This report primarily covers national German design registrations with the GPTO, but due to the harmonization within the EU, the criteria outlined in this report also apply to Community Designs to a large extent.

national courts within the EU to take account of all the objective circumstances relevant to each individual case. In that regard, there is no need to base those findings on the perception of an 'objective observer' (ECJ, decision of 8 March 2018, docket no. C-395/16, GRUR 2018, 612– DOCERAM GmbH/CeramTec GmbH).

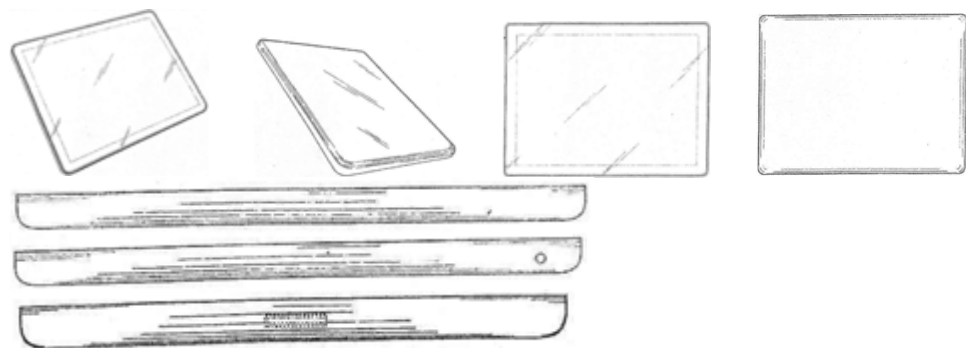
In compliance with EU case-law, German courts have ruled that the following industrial design products may be protected as designs, since their appearance is not merely dictated by their technical function:

- A housekeeping cutter:



(German Federal Court of Justice, decision of 1 October 1980, docket no. I ZR 111/78, GRUR 1981, 269) – Haushaltsschneidemaschine II.

- The Apple „iPad“:



(Higher Regional Court of Dusseldorf, decision of 31 January 2012, docket no. I-20 U 175/11, GRUR-RR 2012, 200 – Tablet PC).

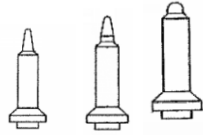
- A kitchen knife:



(Higher Regional Court of Frankfurt on the Main, decision of 14 June 2018, docket no. 6 U 24/17, GRUR-RR 2018, 331).

On the other hand design protection was denied for the following products due to the mere technical function of the appearance:

- Centering pins:



(Higher Regional Court of Dusseldorf, decision of 6 December 2018, docket no. 20 U 124/15, GRUR-RR 2019, 211 – Zentrierstifte II).

- A frying pan with a rust red coating and brown speckles that change the color when the pan is heated:



(Regional Court of Frankfurt on the Main, decision of 21 March 2018, docket no. 2-06 O 79/18, BeckRS 2018, 20847).

c. Key elements of infringement cause of action

Key elements of an infringement cause of action are:

- Design right.
- Owner of the design registration or entitlement to proceed against infringements.
- Infringing design.
- Infringing action, e.g., production, offering for sale, putting on the market, rental or import of the infringing design.
- Passive legitimization: (usually the infringer; under certain conditions a disturber, e.g., intermediaries like Amazon, Youtube, etc., may also be held liable).

A design is infringing when the overall appearance of the infringing design is the same as the one of the registered design. The designs do not have to be identical. The scope of protection of a design depends on the amount of freedom of the designer in developing the design. Relevant criteria are, inter alia, previously existing designs and features which are technically required. The more freedom the designer has, the more differences are required in order to create an overall different impression of a design.

d. Remedies

Remedies encompass temporary and permanent injunctions, information concerning the infringing activity (e.g., on supply and sales of infringing products), seizure and destruction of infringing products/design infringing material. In case of intentional or negligent design infringements, the infringer is obliged to pay the injured party damages for the prejudice suffered as a result of the infringement. For further details please see Sec. 1.d.

Before initiating court proceedings, the right holder should consider sending a warning letter to the infringer, requesting the infringer to sign a cease-and-desist declaration.

The Regional Courts in Germany are exclusively competent for design disputes. The German States have allocated design disputes to certain Regional Courts to ensure the cases are handled by judges with specific expertise in design matters.

e. Challenges and benefits

Challenges:

- A design will be registered when the formal requirements are met. The GPTO does not examine the novelty or individual character of the design when registering it. Thus, any design registration may be contested by third parties and may be cancelled.
- One of the crucial factors when assessing whether a design may be eligible for registration and when invoking a design infringement is to clearly separate between the technical and aesthetic features of the design.

Benefits:

- Simple registration procedure.
- Formal right that may strengthen the right holder's position and is easy to obtain.
- Possibility to defer the publication of the design application for 30 months if the applicant wants to keep the design secret.
- Possibility to include various designs in one multiple application.

3. Trademark/Trade Dress Strategies

a. Registration as a pre-requisite to action?

In principle, trademarks must be registered with the GPTO.²

² Trademarks may also be protected as European Union Trademarks ("EUTM") which can be registered with the EUIPO or as international trademarks registered via the WIPO. This report primarily covers national German trademark registrations with the GPTO, but due to the harmonization within the EU, the criteria outlined in this report also apply to EUTMs to a large extent.

According to Sec. 4 No. 2 and 3 of the German Trademark Act (“Markengesetz”, c.f., https://www.gesetze-im-internet.de/englisch_markeng/index.html), the following two exceptions apply:

- The use of a sign in the course of trade insofar as the sign has acquired public recognition as a trademark within the affected trade circles, or
- a trademark constituting a well-known mark within the meaning of Article 6bis of the Paris Convention for the Protection of Industrial Property.

b. Scope of protection

The scope of protection is stipulated in the German Trademark Act.

According to Sec. 3 (1) of the German Trademark Act, three-dimensional designs, the shape of goods or of their packaging, as well as other wrapping, including colors and color combinations may be protected as trademarks. Thus, in principle it is possible to obtain trademark protection for industrial designs, e.g., as a three-dimensional shape mark.

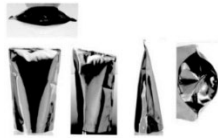
However, it is quite difficult to obtain trademark protection for industrial designs, since a sign may not be protected as a trademark if the sign exclusively consists of a shape which

- results from the nature of the goods themselves,
- is necessary to obtain a technical result, or
- gives substantial value to the goods (Sec. 3 (2) of the German Trademark Act).

Besides, three-dimensional trademarks may also be rejected based on the absolute ground of refusal of a lack of distinctiveness. Only recently, the EU General Court ruled that the shape of a faucet cannot be protected as a three-dimensional trademark, since its overall shape does not sufficiently differ from other faucets available on the market (General Court, decision of 19 June 2019, docket no. T-213/18, BeckRS 2019, 11609).

German courts follow the restrictive approach of the EU courts concerning the protection of three-dimensional trademarks for industrial design products (concerning European case-law c.f., e.g., ECJ, decision of 14 September 2010, docket no. C-48/09 P, GRUR 2010, 1008 – Lego Brick, ECJ, decision of 10 November 2016, docket no. C-30/15 P, GRUR Int. 2017, 140 – Rubik’s Cube and General Court, decision of 6 October 2011, docket no. T-508/08, GRURInt 2012, 560 – Bang Olufsen Speakers). Thus, German courts and the GPTO have repeatedly rejected three-dimensional trademark applications for industrial designs, e.g.:

- The three-dimensional shape of a stand-up pouch:



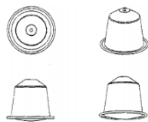
(German Federal Patent Court, decision of 28 June 2017, docket no. 26 W (pat) 63/14, BeckRS 2017, 430).

- A lounge chair:



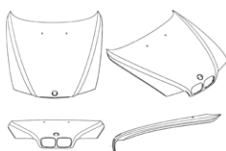
(German Federal Patent Court, decision of 8 June 2011, docket no. 26 W (pat) 93/08, BeckRS 2011, 25017).

- The Nespresso capsule:



(German Federal Patent Court, decision of 17 November 2017, docket no. 25 W (pat) 112/14, GRUR 2018, 522, case pending with the German Federal Court of Justice).

- A bonnet:



(German Federal Court of Justice, decision of 24 May 2007, docket no. I ZB 37/04 – Fronthaube, GRUR 2008, 71).

- A baby bodysuit:



(German Federal Patent Court, decision of 24 June 2019, docket no. 27 W (pat) 52/17, BeckRS 2019, 14776).

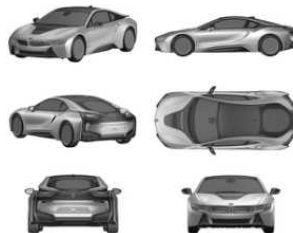
- A book cover:



(German Federal Patent Court, decision of 29 July 2014, docket no. 27 W (pat) 520/14, BeckRS 2014, 16785).

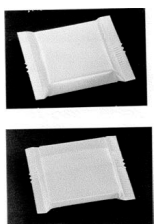
On the other hand, the following three-dimensional trademark applications were granted:

- Black belt and kidney-shaped grille of a BMW car design:



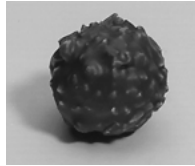
(German Federal Patent Court, decision of 17 July 2019, docket no. 28 W (pat) 504/16, BeckRS 2019).

- The packaging of a chocolate bar:



(German Federal Court of Justice, decision of 18 October 2017, docket nos. I ZB 105/16 and I ZB 106/16, GRUR 2018, 404 (Ritter Sport) and German Federal Patent Court, decision of 13 December 2018, docket no. 25 W (pat) 79/14, BeckRS 2018, 42402, appeal pending before the German Federal Court of Justice, docket nos. I ZB 42/19 and I ZB 43/19).

- The Rocher chocolate:



(German Federal Court of Justice, decision of 9 July 2009, docket no. I ZB 88/07, GRUR 2010, 138 – ROCHER-Kugel).

In case a trademark has been successfully registered for the shape of a product, it provides protection against the use of identical or similar signs for identical or similar goods or services. The scope of protection depends on the level of distinctiveness of the earlier trademark. The higher the level of distinctiveness of the earlier trademark (e.g., due to an extensive use) the broader is the scope of protection.

c. Key elements of infringement cause of action

Key elements of an infringement cause of action are:

- Registered/non-registered trademark.
- Right holder or entitlement to proceed against infringement.
- Use of infringing sign in the course of trade.
- Risk of Confusion between the conflicting signs, i.e.:
 - Identity/similarity of the products,
 - Identity/similarity of the signs and
 - Enhanced distinctiveness of the earlier trademark (e.g., due to long-lasting and extensive use of the trademark).

These criteria are interdependent, meaning that a higher degree of similarity of the products may counteract a lower degree of similarity of the signs. In particular, an enhanced degree of distinctiveness of the earlier trademark may influence the degree of a likelihood of confusion between two signs.

d. Remedies

Remedies encompass temporary and permanent injunctions, information concerning the infringing activity (e.g., on supply and sales of infringing products), seizure and destruction of infringing products/trademark infringing material. In case of intentional or negligent trademark infringements, the infringer is obliged to pay the injured party damages for the prejudice suffered as a result of the infringement. For further details please see Sec. 1.d.

Before initiating court proceedings, the right holder should consider sending a warning letter to the infringer, requesting the infringer to sign a cease-and-desist declaration.

The Regional Courts in Germany are exclusively competent for trademark disputes. Many German States have allocated trademark disputes to certain Regional Courts within the respective states to ensure that the cases are handled by judges with specific expertise in trademark matters. Trademark disputes based on a European Union Trademark are allocated to one or two specific Regional Courts within the German States.

e. Challenges and benefits

Challenges:

Registration of three-dimensional trademarks for products of industrial design is difficult. Many trademark applications have been rejected, since the design merely consists of the shape of the goods, follows from the technical function of the product or adds substantial value to the goods.

Trademarks must be used at the latest five years after the registration.

Benefits:

The term of protection for trademarks is unlimited.

4. Common Law and/or Other Non-Statutory Claim Strategies

Not applicable

Italy

Contributor: Lorenzo Attolico, Nctm Studio Legale

INTRODUCTION

1. Copyright Enforcement Strategies

a. Registration as a pre-requisite to action?

No, it isn't. As known, copyright protection exists from the moment the work is created and fixed in a perceptible form.

Under article 2, no. 10) of the Italian copyright law no. 633/1941, any work of industrial design is protected, provided that it possesses i) a creative character and ii) an artistic value, meaning that the design's value goes beyond the strict functionality and/or the mere elegance of the forms.

The first requisite of the creative character is somehow similar and close to the novelty requirement provided for by the design protection legislation.

By contrast, pursuant to the relevant case law, the further requirement of the artistic value is generally ascertained and assessed by referring to **any relevant acknowledgments received by the design in cultural and institutional environments**, such as:

- **the design being included in exhibitions, museums and/or in artistic events;**
- **the design being mentioned by specialized magazines and critical articles;**
- **the design being awarded special prizes.**

To this respect, please note that works of industrial design usually receive artistic acknowledgement by cultural and institutional environments only after several years from publication and disclosure to the public.

b. Scope of protection

Copyright protection grants to the individual who created it the right to be recognized as its author. Moreover, from an economic viewpoint, copyright protection grants to the right holder, *inter alia*, the exclusive right to utilize it and to prevent any third party not having his consent from utilizing it, including the reproduction, making, publication, distribution and marketing of the same design and/or of any product in which the design is incorporated, as well as of any adaptation or elaboration thereof.

Copyright protection starts from the moment of the creation of the design and lasts until 70 years after the death of the author.

c. Key elements of infringement cause of action

First of all, the right holder claiming against copyright infringement must prove that its own design possesses a creative character and an artistic value (see previous letter a).

Furthermore, for the purpose of assessing copyright infringement, the right holder must be able to show that:

- the second, infringing work appropriated and embedded the essential creative elements of its own original design;
- the two works of art/designs differ for secondary aspects only, to the extent that it may be reasonably concluded that such differences have been added to the second work with the sole purpose of disguising plagiarism;
- ultimately, the second work of art does not possess one or more conceptual features and, thus, it cannot be recognized to have different and autonomous dignity and/or a creative value.

To this regard, please note that, for the purpose of copyright infringement action, it is not necessary to prove that the infringing work produces to the average consumer and/or to the informed consumer the same overall impression produced by the original design.

d. Civil Remedies

Right holders might obtain:

- i. an order prohibiting the counterparty from proceeding with the use and the acts which have infringed or would infringe the protected design;
- ii. financial penalty for any further infringement;
- iii. seizure of the infringing products, and of the materials and implements predominantly used in order to manufacture and/or promote and marketing the infringing goods;
- iv. information be provided on the origin and distribution networks of the infringing goods, including the name and address of the producers, manufacturers, distributors, suppliers and other prior owners of the goods or services, as well as of wholesalers and retailers, and information on the quantities produced, manufactured, delivered, received or ordered, and also the price of the goods or services in question;
- v. any further measure/provision in order to eliminate the effects of the infringing conduct;
- vi. publication of ruling.

Such remedies can also be granted by Courts as an interim relief (when the party initiates a cautionary proceeding).

Right holders might also seek compensation for financial damages caused by the unlawful conduct. To this regard, right holders do not have to prove the fault or negligence of the counterfeiting/infringing party.

e. Challenges and benefits

The term of protection granted by copyright law is way longer than the term of protection granted by design patent law.

On the other hand, not all industrial designs are protected under copyright law, but only those works which are found to possess artistic value. Since the artistic value of industrial designs usually receives general acknowledgment from the public and the cultural institutions only after several years from publication, copyright enforcement generally comes into play as a last resort, when the relevant design has been already published and marketed for several years, and the exclusive rights provided for by design patent law have already expired.

Notwithstanding the above, please note that, from a legal point of view, the claim against copyright violation has an autonomous standing, and therefore it can be raised cumulatively with the design infringement claim.

2. Design Patent Strategies

a. Registration as a pre-requisite to action?

As a general rule, national and/or EU registration is required in order to obtain a full and extended protection of the designs. Nonetheless, the EU regulation no. 6/2002 also grants a (more limited) form of protection to unregistered designs in the EU territory.

1. *Registered Designs*

In order to be registered either at the EU and/or at the Italian Intellectual Property Office (EUIPO and UIBM, respectively), a design must meet, *inter alia*, two requirements:

- ii. novelty: no identical design made available to the public before the date of filing of the application. Nevertheless, publication or disclosure to the public made by the designer, his successor in title/licensee during the 12-month period preceding the filing of the application for registration does not exclude the novelty status of the design (grace period);
- iii. individual character: the overall impression produced by the design on ***the informed user*** must differ from the overall impression produced on such a user by any other design which has been made available to the public.

II) *Unregistered Designs*

In order to receive protection under EU law, an unregistered design must meet the same requirements set for registered designs, *i.e.*, novelty (no identical design made available to the public before the disclosure/first release of the design for which protection is claimed) and individual character.

b. Scope of protection

1. *Registered Designs.*

The registration of the design grants to its holder the exclusive right to use it and to prevent any third party not having his consent from using it, including the making, offering, putting on the market, importing, exporting or using of a product in which the design is incorporated or to which it is applied, or stocking such a product for those purposes.

National and/or EU registered designs are protected for a period of five years as from the date of the filing of the application. The right holder may have the term of protection renewed for one or more periods of 5 (five) years each, up to a total term of 25 (twenty-five) years from the date of filing.

II) *Unregistered Designs*

An unregistered design grants to the right holder a more limited scope of protection.

Indeed, use of the unregistered design by third parties is prohibited only to the extent that such use results from direct copying of the protected design. By contrast, third parties are allowed to use designs which are even identical to the one for which

protection is claimed, provided that such use derives from an independent work of creation by a designer who may be reasonably thought not to be familiar with the first protected design.

Moreover, unregistered designs are protected for a period of 3 (three) years as from the date on which the design was first made available to the public within the EU Community.

c. Key elements of infringement cause of action

1. *Registered Designs.*

The right holder claiming against design infringement must prove that the infringing product/design:

- ii. has not been released to the public before the filing for application (and/or the disclosure to the public during the grace period) of the first protected design;
- iii. produces on informed users the same overall impression of the protected design. Please note that the benchmark of the informed users differs from the one of the average consumer, in the sense that informed users might grasp subtle differences in similar designs.

II) Unregistered Designs

In addition to the requirements of proof generally required for design infringement, the right holder claiming against infringement of unregistered design must also prove that the infringing products results from direct copying of the first protected design. Evidence of direct copying can also be provided through substantive presumptions, such as by referring to the high degree of similarity between the design and the infringing product, and/or to the wide reputation and knowability of the first unregistered design.

d. Civil Remedies

Right holders might obtain:

- i. an order prohibiting the counterparty from proceeding with the use and the acts which have infringed or would infringe the design;
- ii. financial penalty for any further infringement;
- iii. seizure of the infringing products, and of the materials and implements predominantly used in order to manufacture and/or promote and marketing the infringing goods;
- iv. information be provided on the origin and distribution networks of the infringing goods, including the name and address of the producers, manufacturers, distributors, suppliers and other prior owners of the goods or services, as well as of wholesalers and retailers, and information on the quantities produced, manufactured, delivered, received or ordered, and also the price of the goods or services in question;
- v. any further measure/provision in order to eliminate the effects of the infringing conduct;
- vi. publication of ruling.

Such remedies can also be granted by Courts as an interim relief (when the party initiate a cautionary proceeding).

Right holders might also seek compensation for financial damages caused by the unlawful conduct. To this regard, right holders do not have to prove the fault or negligence of the counterfeiting/infringing party.

e. Challenges and benefits

i) Given that, for the purpose of assessing the designs' likeness, the applicable benchmark is the one of the informed user, this might purport that sometimes even those designs/products which are quite similar might be found to differ from each other, therefore excluding design infringement.

ii) If the design is created for a "seasonal product", that is to say the product will be marketed for two or three years, it is not appropriate to deposit the application. Nevertheless, in such case, it would be crucial to demonstrate the date of first disclosure (presentation at any fair, dated catalog, sales invoices, etc.).

3. Trademark/Trade Dress Strategies

a. Registration as a pre-requisite to action?

Even if it is advisable to register the trade dress at the Italian and/or EU Trademark Offices, as a general rule, registration is not a pre-requisite to action.

Indeed, right holders might seek for protection of their own designs also under unregistered or *de facto* trademark rules.

Nevertheless, compared to registered shape trademarks, unregistered trademarks enjoy a weaker juridical protection: the holder can prevent third parties from registering and/or using a trademark/trade dress which is identical or similar to the *de facto* trademark only provided that the right holder is able to prove that, through use, the trademark has gained a widespread fame throughout the national territory.

b. Scope of protection

Shape trademark protection covers the shapes and lines of products which, given their unusual, arbitrary or imaginative character, play a distinctive function, meaning that such shapes allow the public to distinguish and identify the origin and the source of the same products. In this respect, designs might be registered and/or protected as shape trademarks.

However, according to the applicable laws (article 9 of the Italian Code of Industrial Property) not all lines/shapes can be registered as shape trademarks, but only those lines/shapes which do not "*give a substantial value to the product itself*" (*i.e.*, which do not play a decisive, substantial effect on the appreciation of the products by the public). In fact, those lines and shapes which possess a substantial aesthetic value can be protected by design registration.

The rationale is that shapes and lines of products should be alternatively registered and protected as designs or shape trademarks. Nevertheless, given that it might be difficult to distinguish between "distinctive character" and "substantial aesthetic character" right holders often apply for registration of the shapes and lines of their products (of parts thereof) both as shape trademark and as designs.

Unlike copyrights and patents, shape trademark rights can last indefinitely as long as the owner continues to use the mark to identify its goods or services. In fact, Italian and EU trademarks are protected for a period of 10 years since the date of the application, and registration can be renewed indefinitely for a 10-year period each.

c. Key elements of infringement cause of action

The right holder claiming against trademark infringement must prove that:

- i. the infringing product embeds the shapes and lines which are identical or similar to the shape trademark owned by the same right holder

and thus,

- ii. a. there exists a likelihood of confusion and/or association between the two signs and the related products on the part of the public, including likelihood of association between the sign and the trademark.

or

- b. the use of the infringing sign and product takes unfair advantage of, or is detrimental to, the distinctive character or the reputation of the protected shape trademark.

d. Civil Remedies

Right holders might obtain:

- i. an order prohibiting the counterparty from proceeding with the use and the acts which have infringed or would infringe the shape trademark;
- ii. financial penalty for any further infringement;
- iii. seizure of the infringing products, and of the materials and implements predominantly used in order to manufacture and/or promote and marketing the infringing goods;
- iv. information be provided on the origin and distribution networks of the infringing goods, including the name and address of the producers, manufacturers, distributors, suppliers and other prior owners of the goods or services, as well as of wholesalers and retailers, and information on the quantities produced, manufactured, delivered, received or ordered, and also the price of the goods or services in question;
- v. any further measure/provision in order to eliminate the effects of the infringing conduct;
- vi. publication of ruling.

Such remedies can also be granted by Courts as an interim relief (when the right holder initiates a cautionary proceeding).

Right holders might also seek compensation for financial damages caused by the unlawful conduct.

e. Challenges and benefits

Registration as a shape trademark can potentially grant a perpetual protection to the design, as long as the owner continues to use the design/shape trademark to “identify” its goods or products. However, as already explained, not all lines/shapes can be registered as shape trademarks, but only those lines/shapes which do **not**

“give a substantial value to the product itself” (i.e. which do not play a decisive, substantial effect on the appreciation of the products by the public).

Kosovo

Contributor: Kujtesa Nezaj, SDP KOSOVE (PETOSEVIC Subsidiary)

INTRODUCTION

The works of applied art and designs are explicitly listed by the Law on Copyright and Related Rights as subject-matter of copyright protection in Kosovo. They are also protectable as registered industrial designs under the Law on Industrial Designs in Kosovo. Designs could be protected also by registering a 3D trademark under the Law on Trademarks. However, trademark protection is only available to designs which are distinctive, i.e., capable of designating the origin of the goods they are applied to.

Sending out a warning letter is not a procedural requirement. In practice, however, such letters are often sent in attempt to settle conflicts amicably and avoid litigation. Such letters might also facilitate the task of proving that an infringer has acted in bad faith, despite being notified of infringement, and in claiming higher amounts of damages.

Preliminary injunctions are also available. They are usually granted on the condition of payment of a deposit to the court, which serves as a security that can be allocated to the defendant in case the court denies the claims on the merits. Preliminary injunctions are usually granted within 1-2 weeks.

1. Copyright Enforcement Strategies

- a. Registration as a pre-requisite to action?

No registration is required to enforce copyright in Kosovo.

- b. Scope of protection

Copyright protection in Kosovo encompasses two categories of rights: moral and economic rights.

The moral rights include:

- right of disclosure
- right to claim authorship
- right of integrity
- right to retract.

The economic rights cover the right to use and authorize any use of the work by third parties, including:

- reproduction
- distribution
- leasing
- public interpretation
- use by audiovisual media service
- public communication
- public disclosure
- making the work available to public

- adaptation.

c. Key elements of infringement cause of action

- ownership of a valid copyright: copyrightable subject-matter, authorship or other form or entitlement, copyright term has not expired
- use of a protected work

d. Remedies

- injunctions
- damages
- seizure and destruction of infringing copies
- seizure of materials and equipment used for committing the infringement
- publication of judicial decisions

e. Challenges and benefits

The benefits of copyright protection in designs as applied art include wider scope and longer term (70 years from the author's death) compared to other forms of protection. There are no registration requirements and procedures.

Challenges include the need to prove ownership of a valid copyright as an additional element of infringement cause of action.

Copyright protection is available to any work, resulting from a creative process. It is sufficient for the work to be an author's individual creation and the originality threshold is not high.

2. Design Patent Strategies

a. Registration as a pre-requisite to action?

Design protection in Kosovo encompasses protection of registered designs only.

Kosovo law provides for protection of industrial designs registered with its national IP Office. Kosovo is not party to the Hague Agreement Concerning the International Registration of Industrial Designs.

b. Scope of protection

The scope of protection of an industrial design includes any design which does not produce on the informed user a different overall impression. A registered national confers on its holder the exclusive right to use it and to prevent any third party not having his consent from using it.

c. Key elements of infringement cause of action

In respect of registered designs:

- ownership of a valid design registration
- use of a product in which the infringing design is incorporated or to which it is applied

d. Remedies

- injunctions
- damages
- seizure and destruction of infringing products, compensation of destruction costs
- publication of judicial decisions

e. Challenges and benefits

Benefits: no need to prove ownership in registered designs as it is evident from the registration itself.

3. Trademark/Trade Dress Strategies

a. Registration as a pre-requisite to action?

Trademark registration is a pre-requisite to action. Trademarks can be registered with the Kosovo IP Office. Kosovo is not party to the Madrid Agreement and Protocol Concerning the International Registration of Marks.

b. Scope of protection

The scope of protection encompasses the right to prohibit the use of a sign:

- which is identical to a registered trademark for identical goods;
- giving rise to likelihood of confusion as to the origin of goods due to similarity with a registered trademark and similarity of the goods;
- which without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of a registered trademark.

c. Key elements of infringement cause of action

- ownership of a valid trademark registration

d. Remedies

- injunctions
- damages
- seizure and destruction of infringing products, compensation for destruction costs
- publication of judicial decisions

e. Challenges and benefits

Benefits: no need to prove ownership in a registered trademark; possibility to indefinitely renew a Trademark registration.

4. Common Law and/or Other Non-Statutory Claim Strategies

Common law or other non-statutory claims are not available in Kosovo.

Poland

**Contributor: Monika Wieczorkowska and Katarzyna Pikora and Paulina Mleczak,
Wardynski & Partners Poland**

INTRODUCTION

1. Copyright Enforcement Strategies

a. Registration as a pre-requisite to action?

Registration is not a pre-requisite to be able to enforce copyright.

Under the Copyright and Related Rights Act of 4 February 1994, a work of art is automatically protected by copyright from the time of creating it, whether completed or not.

b. Scope of protection

Copyright gives the owner an exclusive right to use the work and to dispose of its use in all the fields of exploitation and to receive remuneration for the use of the work.

Therefore, an owner can prohibit others from using a design, whether commercially or not, that is identical to the design of the owner or differs in minor details but takes over the design's creative elements. In particular, the owner can oppose copying the design by use of any technology, marketing, renting, or any other public dissemination of the design.

The owner, however, cannot oppose:

- marketing of the original or a copy of the design in Poland if it had been introduced into trade in the European Economic Area (exhaustion of rights);
- use of a copy of the design if the design has been disseminated and is for personal use (permitted use of protected work).

Copyright protection is for 70 years after the death of the creator.

c. Key elements of infringement cause of action

A plaintiff would have to evidence in litigation that:

- he owns copyright to the design
- the design is a work of art within the meaning of copyright law
- the defendant uses an identical design or a similar design that takes over the creative elements of the protected design

The evidence of the ownership depends on how the design was created:

- (i) The first scenario is that the plaintiff created it; proof would be the design on which authorship is revealed or other documentary proof that authorship was publicly disclosed.

- (ii) The second is that the plaintiff acquired copyright by contract; proof would be contractual documentary of transfer of all of the copyright to the plaintiff; a transfer must be in writing.
- (iii) The third is the plaintiff acquired copyright from an employee who created a design within the scope of work duties of the employee; documentary proof would be the contract of employment and declaration of the employee on creating the design (or other proof of creating the design by an employee within work).

The evidence that design is a work of art within the meaning of copyright law is to show that the design is a manifestation of creative activity. That means that the design has creative and individual qualities which differentiate it from other designs. Proof would be the private expert opinions on creativeness/individual character and scope of design freedom as well as examples of other designs available at the market.

To evidence the use of the infringing design, a plaintiff must submit all possible documents showing that the defendant produces the design, sells, rents, leases, publicly displays or uses it in any other form. These will be e.g., images of the designs, proofs of purchase of the infringing design, Internet printouts, offers or any advertising materials showing the infringing design. To prove that compared designs are identical or similar, samples should be submitted. In addition, plaintiffs usually submit private expert opinions to support the argumentation.

Still, in litigation both parties usually move for a court expert opinion. The final determination whether the infringing design is identical or similar to the protected design to such extent that there is an infringement belongs to the judge.

d. Remedies

An owner can seek the civil remedies:

- cessation of infringement
- removing effects of infringement
- repairing the damage pursuant to general rules, which means having to quantify the amount, or damages as an amount corresponding to a double remuneration that the owner of copyright would have obtained had the owner consented to use of the work of art;
- surrender of unjustified benefits
- publication of a single or multiple announcements in the press or communicating to the public all or a part of a court judgment
- withdrawal of unlawfully produced objects, assigning them to the owner as part damages, or destroying them.

e. Challenges and benefits

The main challenge is proving ownership of copyright, e.g., employers that are corporations often cannot identify the employees that created a design, when it was created, cannot locate or do not have contracts that apply to the creators.

Another challenge is to persuade a court that a design is copyrighted; a court appointed expert opinion is usually necessary which increases the uncertainty of litigation and prolongs it.

The benefit is that Polish courts usually accept that a low level of creativity is required to be able to deem a specific item to be a work of art.

2. Design Patent Strategies

a. Registration as a pre-requisite to action?

Registration of a design is a pre-requisite to enforce protection of a design patent (the right stems from registration of a design). Obtaining registration is usually quick and easy.

A registration right is granted under Industrial Property Law Act of 30 June 2000 (“**IPL**”) by the Polish Patent Office (“**PPO**”) for a design which is a form of a product or its part (with exclusion of computer programs) and is novel and has an individual character. It is easy to obtain registration; the PPO checks only the formal requirements of an application and does not assess, as a rule, whether the design is novel or has individual character.

Unregistered designs are not protected under the IPL; protection would may be sought under the Combating Unfair Competition Act of 16 April 1993 (“**CUCA**”) (this report does however not deal with unfair competition).

b. Scope of protection

The right from registration is limited to the products for which the design is protected. Protection extends to any design which does not produce on an informed user an overall impression that is different to the design that is protected. The test of an overall impression must take into account the scope of creative freedom that applies in designing a product.

An owner of the registered design can:

- exclusively use it commercially or professionally in Poland
- prohibit others from using, manufacturing, offering, selling, importing, exporting a product in which the design is incorporated or storing it for those purposes in Poland.

However. the right from registration does not protect the features of a product that:

- are exclusively required for technical functioning, or
- must be reproduced in an exact form and dimensions to enable mechanical connection or interaction with another product.

Other limitations are:

- the so-called repair clause, which means that a protection of a registered design does not apply to products which are component parts used to repair the complex product to restore its original appearance
- the holder of a design patent cannot prohibit third parties from using the design for personal use or use not related to business
- An owner cannot oppose the sale or further marketing of product which incorporates a design if the owner marketed, or consented to the prior marketing of the product in Poland, or the European Economic Area (exhaustion of rights)

Besides, a user in good faith of a product at the moment of design priority may still use it free of charge in his enterprise at the same extent.

The right is for 25 years from the date of applying in the PPO divided into five 5-year periods.

c. Key elements of infringement cause of action

A plaintiff would have to evidence in litigation that:

- he owns the registered design
- use of an infringing design is commercial or professional or that there is a threat of such use
- the infringing design that is being used makes the same overall impression on an informed user as does the plaintiff's design.

A registration certificate issued by the PPO is a proof of ownership (and if the right was granted more than 5 years ago, proof of payment of the renewal fee).

To evidence the use of the infringing design, a plaintiff would have to file in court documents such as a sample product together with proof of purchase, photos of the infringing products, press releases or publications, advertisements or announcements published by the defendant.

To prove that the disputed design makes the same overall impression on an informed user as does the design of the plaintiff requires:

- defining an informed user
- proving the degree of creative freedom in designing
- indicating the similarities and differences between designs.

Plaintiff is also to specify which features determine the general impression of the design and why the differences do not change that impression.

There is uncertainty reported cases and jurisprudence as to whether the assessment of the overall impression produced by the compared designs requires an expert opinion. The prevailing view is that an assessment of design protection grounds is a legal issue and is,

therefore, subject to an independent normative assessment by the court; thus, the court should not entrust it to an expert.

However, in practice courts would rely on court expert opinions. To note is that private expert opinions are treated only as a party's standpoint and are unlikely not be deemed significant.

d. Remedies

An owner is entitled to seek the following civil remedies:

- cessation of infringement
- surrender of unjustified benefits
- damages, when infringement is culpable:
 - damages pursuant to general rules, which means having to quantify the amount, or
 - damages as an amount corresponding to a license fee or other appropriate amount that the owner would have obtained had the owner consented to use of the patent
- publishing part or all of the court decision or information about the decision
- a court decision that infringer's products which have been unlawfully manufactured or labelled have to be destroyed, withdrawn from the market or awarded to the plaintiff.

If an owner become aware of a threat of infringement, e.g., a third party is preparing to market a product that copies a design, the owner can demand that the third party refrains from preparing to infringe.

e. Challenges and benefits

The main challenge is proving that a disputed product creates the same overall impression; even though an assessment is for a court, courts tend to rely on court expert opinions.

Another challenge may be the necessity to defend validity of the design in the separate proceedings before the PPO. Enforcing design patent often encourages the defendant to attempt to invalidate design before the PPO. The consequences of which is additional, administrative proceedings in the PPO in which the owner is a defendant. Besides, that may result in adjourning judgment on infringement until invalidation proceedings end.

The benefit is ease of proof - certificate of registration is sufficient proof that a plaintiff can sue. Then the plaintiff only has to focus on proving infringement.

3. Trademark/Trade Dress Registration as a pre-requisite to action?

Registration of a trademark is a pre-requisite to enforce trademark protection.

Trademark is registered under IPL by the PPO which examines only formal requirements and absolute grounds for refusal. Then the trademark is published for opposition purposes on relative grounds. Lack of oppositions means that the trademark is registered.

Designs, being applied art, can be protected as figurative or three-dimensional trademarks. However, in practice it is difficult to register a shape of a product because the PPO will not register a shape that is:

- dictated totally by the nature of a product
- required to obtain a technical result
- gives substantial value to the product.

Trade dress could be protected as a registered trademark or as an unregistered designation under competition law.

a. Scope of protection

An owner can exclusively use a registered trademark commercially or professionally in Poland.

The owner can prohibit others from using it on products, packaging, and from marketing such products, importing, exporting or storing them for the purpose of marketing, placing the trademark on documents relating to marketing the products and using the trademark in advertising.

Protection extends to any designation that is:

- identical to the trademark and is used for identical goods
- identical or similar to the trademark and is used for identical or similar products if there is a risk of confusion which includes the risk of associating the two trademarks
- identical or similar to a reputed registered trademark, irrespective of goods for which it is used if such use may bring undue advantage, be detrimental to the distinctiveness or repute of the trademark.

Protection applies from the date of an application to register the trademark and is for 10 years. It can be prolonged for consecutive 10-year periods.

b. Key elements of infringement cause of action

A plaintiff in litigation would have to provide evidence that:

- he owns the registered trademark and uses it
- the third party uses in Poland a designation that is identical or similar to the trademark and that evokes risk of confusion or infringes the repute of the trademark.

To evidence ownership of the registered trademark the plaintiff must submit a registration certificate issued by the PPO (and if the right was granted more than 10 years ago, the plaintiff must also demonstrate payment of the renewal fee).

To evidence use of the infringing designation in a commercial or professional manner, the plaintiff must submit to court all possible documents showing any form of use of the designation by the defendant, in particular a sample of the test-purchased infringing product together with the proof of purchase, photos of the infringing products, press releases or publications, advertisements or announcements published by the defendant.

Then, the plaintiff should demonstrate that the designation used by the defendant is identical or confusingly similar to the registered trademark. The proof of risk of confusion does not require evidence of actual confusion at the market, however evidence of consumer errors may significantly strengthen the case. Expert opinion evidence is not required as the assessment of a risk of confusion is made by the judge.

If the ground of action is a reputed registered trademark, the plaintiff must submit evidence confirming that the trademark had reputation on the day of infringement and the infringing design is similar to that trademark.

Repute is proved by providing information and documents showing that the trademark was known by a significant portion of the relevant public and was highly regarded. As a rule, the evidence submitted in such a case consists of:

- advertisements
- press articles
- information on the amount of goods sold bearing the trademark
- expenditure incurred on advertising campaigns, public surveys
- awards given for products bearing the trademark.

c. Remedies

An owner can seek the following civil remedies:

- cessation of infringement
- surrender of unjustified benefits
- damages, when infringement is culpable:
 - damages on general principles which means having to quantify the amount, or
 - damages as an amount corresponding to a license fee or other appropriate amount that the owner would have obtained had the owner consented to use of the patent

- publishing part or all of the court decision or information about the decision
- a court decision that infringing products which have been illegally manufactured or labelled as well as the means and materials which have been used to manufacture them have to be destroyed, withdrawn from the market or awarded to the owner of the trademark.

If an owner evidences a threat of infringement, e.g., a third party is preparing to market a product that copies a 3-D trademark, the owner can demand that the third party refrains from preparing to infringe.

d. Challenges and benefits

The main challenge in enforcing a 3-D or a graphic trademark is that a defendant may seek to invalidate registration of the trademark which would mean (i) additional, administrative proceedings in the PPO in which the owner would be a defendant, (ii) infringement proceedings could be adjourned until invalidation proceedings end.

The benefit is ease of proof of a right to sue - a certificate of registration suffices. Then a plaintiff only has to prove infringement. Also, protection under IPL is broad, it applies to identical and similar trademarks.

4. Common Law and/or Other Non-Statutory Claim Strategies

Not applicable to Poland.

Romania

Contributor: Florina Firaru, PETOSEVIC Romania

INTRODUCTION

In Romania, the works of applied art and designs are explicitly listed by the Romanian Law no. 8 / 1996 on Copyright and Related Rights Act as subject-matter of copyright protection in Romania, provided that the relevant conditions are met, in particular the condition that the design must be of sufficient originality.

Works of applied art and designs are also protectable as registered designs under the Romanian Law no. on designs and models or unregistered under and the Government Ordinance No. 211/2008 for approval of the Implementing regulations of Law No. 129/1992 on designs and models; further, they are also protectable as registered or unregistered designs by the EU Council Regulation (EC) No. 6/2002 on Community Designs.

Protection of a design under the design legislation does not exclude protection of the same design by copyright, and therefore cumulative protection of a design by both a design registration and by copyright is possible.

Designs could be protected also by registering a 3D trademark under the Trademarks and Geographical Indications Act or Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trademark. However, trademark protection is only available to designs which are distinctive, i.e., capable of designating the origin of the goods they are applied to.

To enforce their rights, right holders need to rely on the provisions of the specific legislation applicable to intellectual property rights, identified above.

Sending out a cease-and-desist letter is not a prerequisite for lodging a civil or criminal lawsuit. In practice, however, such letters are often sent in attempt to settle conflicts amicably and avoid litigation. Such letters might also facilitate the task of proving that an infringer has acted in bad faith, despite being notified of infringement, and in claiming higher amounts of damages.

Preliminary injunctions are also available. They are usually granted on the condition of payment of a deposit to the court, which serves as a security that can be allocated to the defendant in case the court denies the claims on the merits. A decision of the first instance in the preliminary injunction proceedings is usually granted within 3-6 months, depending on the circumstances of each case.

1. Copyright Enforcement Strategies

- a. Registration as a pre-requisite to action?

No registration is required to enforce copyright in Romania.

- b. Scope of protection

Copyright protection in Romania encompasses two categories of rights: moral and economic rights.

The moral rights include:

- right of disclosure
- right to claim authorship
- right to decide under what name the work will be disclosed;
- right to demand respect for the integrity of the work and to oppose any modification or any distortion of the work if it is prejudicial to his honor or reputation;
- right to retract

The economic rights cover the right to use and authorize any use of the work by third parties, including:

- reproduction
- distribution
- import
- rental
- lending
- communication to public
- broadcasting
- retransmission by cable
- making of derivative works

c. Key elements of infringement cause of action

- ownership of a valid copyright: copyrightable subject-matter, authorship or other form or entitlement, copyright term has not expired

d. Remedies

- civil actions for infringement, including injunctions;
- criminal complaints;
- actions for preservation of the evidence used for committing the infringement;
- requests for award of damages and trial fees
- seizure and destruction of infringing copies
- seizure of materials and equipment used for committing the infringement
- publication of court decisions

e. Challenges and benefits

The benefits of copyright protection in designs as applied art include wider scope and longer term (70 years from the author's death) compared to other forms of protection. There are no registration requirements and procedures.

Copyright protection is available to authors of original works of applied art, resulting from a creative process.

Challenges include the need to prove the condition that the work is of sufficient originality. There is no specific criteria or requirement established by the copyright legislation, so this condition is being analyzed by the courts on a case-by-case basis.

2. Design Patent Strategies

a. Registration as a pre-requisite to action?

Design protection in Romania encompasses protection of both registered and unregistered designs.

The Romanian law provides for protection of industrial designs with the State (Romanian) Office for Inventions and Trademarks or with the EU IPO. Romania is also party to the Hague Agreement concerning the International Registration of Industrial Designs.

Unregistered Community designs are protected under the Community Design Regulation.

b. Scope of protection

The scope of protection of an industrial design includes any design which new and has individual character. A registered national or Community confers on its holder the exclusive right to use it and to prevent any third party not having his consent from using it.

An unregistered Community design confers on its holder the right to prevent unauthorized use by third parties only if the contested use results from copying the protected design. Protection does not extend to independent works of creation by a designer who may be reasonably thought not to be familiar with the design made available to the public by the holder.

c. Key elements of infringement cause of action

In respect of registered designs:

- ownership of a valid design registration

In respect of unregistered designs:

- proof of the date and place of the first disclosure of the design in a way enabling the interested circles within the European Union to become aware of the disclosure itself.
- use of a product in which the infringing design is incorporated or to which it is applied

d. Remedies

- civil actions for infringement, including interim injunctions;
- criminal complaints
- customs measures
- damages and trial fees
- publication of court decisions

e. Challenges and benefits

Benefits: no need to prove ownership in registered designs as it is evident from the registration itself. Availability of protection for unregistered designs.

Challenges with respect to unregistered designs: the requirement to prove the date and place of the first disclosure of the design in a way enabling the interested circles within the European Union to become aware of the disclosure itself.

3. Trademark/Trade Dress Strategies

a. Registration as a pre-requisite to action?

Trademark registration is a pre-requisite to action. Trademarks can be registered with the State Office for Inventions and Trademarks and the EUIPO. Romania is also party to the Madrid Agreement and Protocol Concerning the International Registration of Marks.

b. Scope of protection

The scope of protection encompasses the right to prohibit all third parties not having his/her consent from using in the course of trade:

- any sign that is identical with the trademark, for products or services that are identical with those for which the trademark is registered;
- any sign where, because of its identity with or similarity to the trademark and the identity or similarity of the products or services covered by the trademark and the sign, there is likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association between the sign and the trademark; and
- any sign that is identical with or similar to a registered trademark and is used in connection with products or services different than those for which the mark is registered, where the mark enjoys reputation in Romania and where the use without due cause of the sign would be detrimental to the distinctive character or the repute of the registered trademark.

c. Key elements of infringement cause of action

- ownership of a valid trademark registration
- use of a sign in the course of trade within the scope of protection.

d. Remedies

- civil actions for infringement, including interim injunctions
- criminal complaints
- customs measures
- damages and trial fees
- publication of court decisions

e. Challenges and benefits

Benefits: possibility to indefinitely renew a trademark registration.

Challenges: The Romanian Trademark and Geographical Indications Act allows trademark registration only for distinctive signs. Product shapes are often not perceived by consumers as trademarks and the offices tends to refuse registration of 3D marks unless they are unusual in relation to the goods or contain distinctive elements. Therefore, the availability of trademark protection to designs is in practice somewhat limited as they might not meet the distinctiveness requirement. In addition, trademark protection entails the obligation to use the design in order to maintain its registration as a trademark.

4. Common Law and/or Other Non-Statutory Claim Strategies

Common law or other non-statutory claims are not available in Romania.

Russia

Contributor: Mayya Pak, PETOSEVIC Russia

INTRODUCTION

Part IV of the Russian Civil Code directly grants copyright protection to designs and works of applied art as well as stipulates protection of registered trademarks and industrial designs. Additionally, the Federal Law on Protection of Competition prohibits imitation of registered and unregistered designs, if such imitation might result in confusion between competitors' goods and services.

Sending a cease-and-desist letter is only a pre-requisite to filing a claim for damages or compensation with the court. However, sending the letter is a common practice that helps to avoid unnecessary litigation and expenses connected with it.

Preliminary injunctions are available, however threshold for obtaining them is relatively high, especially since only commercial courts are entitled to ask an applicant to provide a counter indemnity. However, a special swift application procedure for preliminary measures exists for online infringements.

1. Copyright Enforcement Strategies

- a. Registration as a pre-requisite to action?

Registration is not required to enforce copyright in Russia.

- b. Scope of protection

In Russia two types of rights fall into scope of copyright protection: moral and economic rights.

The *moral rights* include:

- right of disclosure;
- right to claim authorship;
- right to remain anonymous or choose a pseudonym;
- right to demand indication of the author's name, pseudonym or other sign of authorship;
- right of integrity;
- right of modification;
- right to access the original work;
- right of succession;
- right to retract.

The *economic rights* cover the right to use and authorize any use of the work by third parties, including:

- reproduction;
- distribution;

- public display;
- import and export;
- rental;
- public performance;
- communication over the air;
- communication by cable;
- relay or retransmission;
- translation or other processing;
- practical implementation of an architectural, design, city planning, or park or garden plan;
- communication to the public.

c. Key elements of infringement cause of action

- ownership of a valid copyright: copyrightable subject-matter, authorship or other form or entitlement, copyright term has not expired;
- use of a protected work.

d. Remedies

- injunctions;
- statutory compensation;
- damages;
- recognition of a right;
- seizure and destruction of infringing copies and (or) materials and equipment used for committing the infringement;
- publication of judicial decisions;
- liquidation of the infringing legal entity (upon the prosecutor's request only).

e. Challenges and benefits

Benefits:

- absence of registration requirement;
- longer term of protection in comparison with protection of industrial designs;
- protection is granted to all works of science, literature and art made as a result of creative process that have an objective form;
- no originality requirement.

Challenges:

- harder to prove copyright ownership than rights to industrial design or trademark. A mere registration of copyright is not considered as sufficient proof.

2. Design Patent Strategies

a. Registration as a pre-requisite to action?

Registration and obtaining a patent to industrial design is a pre-requisite for its protection in Russia. Patents to industrial design are granted by Rospatent to designs which are new and original.

b. Scope of protection

The following rights fall into scope of industrial design protection:

- author's right to obtain a patent;
- right to use a patent, which includes rights to import into Russia, manufacturing, exploitation, offer for sale, sale, other introduction into civil circulation or storage for such purposes of a product that incorporate the industrial design.

c. Key elements of infringement cause of action

- ownership of a valid industrial design registration;
- use of a product in which the infringing design is incorporated or to which it is applied.

d. Remedies

- injunctions;
- statutory compensation;
- damages;
- recognition of a right;
- seizure and destruction of infringing copies and (or) materials and equipment used for committing the infringement;
- publication of judicial decisions;
- liquidation of the infringing legal entity (upon the prosecutor's request).

e. Challenges and benefits

Benefits:

- registration proves ownership;
- scope of protection covers also similar designs that have similar purpose of use.

Challenges:

- only registered designs are protected;
- the term of protection cannot exceed 25 years from the date of the initial application;
- interim protection is available only if publication of design application has been requested by the applicant.

3. Trademark/Trade Dress Strategies

a. Registration as a pre-requisite to action?

Trademark registration is a pre-requisite to action. National trademarks are registered by Rospatent. Russia is also party to the Madrid Agreement and Protocol Concerning the International Registration of Marks.

b. Scope of protection

The rightsholder may dispose the trademark for individualization of goods, work, or services with respect to which the trademark has been registered, in particular by using it:

- on goods including labels and packaging of goods, that are produced, offered for sale, sold, displayed at exhibitions and fairs, or otherwise introduced into civil circulation within Russia, or are kept or transported for this purpose, or imported into Russia;
- while performing work or rendering services;
- on documents introducing goods into civil circulation;
- while offering goods for sale, work for performance, and services for rendering as well as in announcements, on signboard, and in advertising;
- in the Internet, including in a domain name and for other means of addressing.

The rightsholder has a right to prohibit the use of his trademark and similar signs with respect to the goods for the individualization of which the trademark has been registered or similar goods if such use would result in a likelihood of confusion.

c. Key elements of infringement cause of action

- ownership of a valid trademark registration;
- use of a sign in the course of trade within the scope of protection.

d. Remedies

- injunctions;
- statutory compensation;
- damages;
- recognition of a right;
- seizure and destruction of infringing copies and (or) materials and equipment used for committing the infringement;
- publication of judicial decisions;
- liquidation of the infringing legal entity (upon the prosecutor's request).

e. Challenges and benefits

Benefits:

- registration proves ownership;
- protection can be prolonged indefinitely (subject to renewal registration).

Challenges:

- registration takes around 1 year;
- protection is granted only to distinctive marks that have not fallen into public domain, are not descriptive and are compliant with other pre-requisites for trademark registration;
- a legal action based on trademark registered in bad faith or improper use of trademark might cause an invalidation of the trademark.

4. Common Law and/or Other Non-Statutory Claim Strategies

Common law or other non-statutory claims are not available in Russia.

Serbia

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INTRODUCTION

Intellectual property is still in development in this jurisdiction, meaning that there is a lack of practice and IP experts/judges in court cases that could establish unified rules.

It is necessary to invest additional work in the enforcement of intellectual property rights, and one of the key demands should be stronger cooperation between the bodies competent for the enforcement of rights and their unified procedure and joint actions.

However, great efforts are made to meet the standards of developed countries, especially in the legislation area (local laws are constantly being harmonized with EU regulations).

The works of applied art and designs are explicitly listed by the Serbian Copyright and Related Rights Law (Official Gazette *no. 104/2009, 99/2011, 119/2012 and 29/2016 - decision of The Constitutional Court*) as subject-matter of copyright protection. In order to obtain protection, it is not necessary to have registration, however, work must be an author's original intellectual creation, expressed in a certain form, regardless of its artistic, scientific or some other value, its purpose, size, contents and way of manifestation, as well as the permissibility of public communication of its contents.

Designs are also protectable under the Law on protection of industrial designs (Official Gazette *no. 104/2009, 45/2015 and 44/2018*) as well as under the Trademark law (Official Gazette *no. 104/2009, 10/2013 and 44/2018*) by registering 3D trademark. With respect to requirements, marks that consist exclusively of 3D shape which results from the nature of the goods themselves, or the shape of goods which is necessary to obtain a technical result, or the shape which gives substantial value to the goods cannot be protected as trademarks. In other words, 3D marks may be protected if they are sufficiently distinctive.

Sending out a warning letter is not a procedural requirement, but such letters are often sent in attempt to settle conflicts amicably and avoid litigation. Preliminary injunctions are also available and efficient.

1. Copyright Enforcement Strategies

a. Registration as a pre-requisite to action?

Registration is not required to enforce copyright in Serbia.

b. Scope of protection

Author has moral and pecuniary rights.

Moral rights:

- right to claim authorship
- right to be named

- right of disclosure
- right of protection of the work's integrity
- right to oppose unbecoming exploitation of the work

Pecuniary rights – author has the right to commercial exploitation of its work, as well as of a work resulting from the modification of its work:

- right to affix or reproduce
- right to place in circulation copies of the work
- right to rent copies of the work
- right to perform
- right to present
- right to transmit performance or presentation
- right to broadcast
- right of re-broadcasting
- right to public communication, including the interactive communication of the work to the public
- right to adapt, arrange or alter the work in some other manner
- right to communicate a broadcasted work to the public
- right to communicate a work from a sound or picture carrier to the public

Author also has rights in relation to the owner of an authorship work:

- right of access to a copy of the work
- right to follow (*droit de suite*)
- prohibit the exhibition of the original work of fine arts
- priority right of modification of a work of architecture
- right to special remuneration
- right to special remuneration for lending copies of work

c. Key elements of infringement cause of action

- ownership of a valid copyright: copyrightable subject-matter, authorship or other form or entitlement
- use of a protected work

d. Remedies

- determination of the infringement
- termination of the infringement
- destruction or alteration of the objects instrumental to the infringement on rights, including copies of the subject-matter of protection, their packaging, stencils, negatives, etc.
- destruction or alteration of the tools and equipment that have been used for production of the objects instrumental to the infringement of rights, if necessary
- damage compensation
- publication of the court decision at the defendant's expense

e. Challenges and benefits

The benefits of copyright protection in designs as applied art include wider scope and longer term (70 years from the author's death) compared to other forms of protection. There are no registration requirements and procedures.

Challenges are difficulties in proving prior ownership in infringement proceedings.

2. Design Patent Strategies

a. Registration as a pre-requisite to action?

Registration is pre-requisite to action. Serbian law provides protection for national industrial designs registered with the Serbian IPO as well as international designs registered in line with Hague Agreement.

b. Scope of protection

Author has moral and pecuniary rights.

Moral rights include the right of author to have its name indicated in the registration application, documents and certificate of the industrial design.

Pecuniary right is right of the industrial design author to enjoy economic benefits from utilization of the protected industrial design.

The scope of protection of an industrial design includes any design which does not produce on the informed user a different overall impression.

c. Key elements of infringement cause of action

- ownership of a valid design registration
- use or publication of a product in which the infringing design is incorporated or to which it is applied

d. Remedies

- determination of the infringement
- termination of the infringement
- seizure, destruction or alteration of the infringing objects
- destruction or alteration of the tools and equipment that have been used for production of infringing objects
- damage compensation
- publication of the court decision at the defendant's expense
- providing information on any third persons participating in infringement of the right to be revealed

e. Challenges and benefits

Benefits: easy to prove ownership of registered designs as it is evident from the registration itself

Challenges: Sometimes, it may be difficult for the author to fulfil the requirement of novelty and individual character of industrial design.

3. Trademark/Trade Dress Strategies

a. Registration as a pre-requisite to action?

Trademark registration is a pre-requisite to action. Serbian law provides protection for national trademarks registered with the Serbian IPO as well as international trademarks registered in line with the Madrid Agreement and Protocol Concerning the International Registration of Marks

b. Scope of protection

The scope of protection encompasses the right to prohibit the unauthorized use of:

1) a trademark identical to an earlier protected mark for identical goods/services;

2) a trademark identical to an earlier protected trademark for similar goods/services, or a trademark which is similar to earlier protected trademark for identical or similar goods/services, if there is a likelihood of confusion among the relevant public, including the likelihood of association of that trademark with the trademark holder's earlier protected trademark.

The trademark holder can also prohibit the following:

1) affixing the protected trademark to the goods, the packaging for the goods or labeling instruments (labels, stickers, bottle stoppers, and the like);

2) offering of goods, their placement into circulation or storage for such purposes, or supply of services under the protected trademark;

3) import or export of the goods under the protected trademark;

4) using the protected trademark in business documentation or in advertisements.

c. Key elements of infringement cause of action

- ownership of a valid trademark registration
- use of a sign in the course of trade within the scope of protection.

d. Remedies

- determination of infringement;
- termination of the infringement;
- seizure, exclusion from the channels of commerce, destruction or alteration of the infringing objects without any compensation

- seizure, exclusion from the channels of commerce, destruction or alteration of the tools and equipment used to manufacture the infringing objects, without any compensation, if necessary, for the protection of rights
- damage compensation
- publication of the court decision at the expense of the defendant providing information about third parties participating in the infringement of rights

e. Challenges and benefits

Benefits: easy to prove ownership of a registered trademark; possibility to indefinitely renew a trademark registration.

Challenges: Trademark holder is obliged to use its trademark, in order to maintain registration.

4. Common Law and/or Other Non-Statutory Claim Strategies

Common law or other non-statutory claims are not available in Serbia.

Slovenia

Contributor: Barbara Mencin and Maja Žnidarič, PETOSEVIC Slovenia

INTRODUCTION

Designs as works of applied art and industrial design are protected as copyright pursuant to the Slovenian Copyright and Related Rights Act. They can be protected also as registered or unregistered Community designs pursuant to the Council Regulation (EC) No. 6/2002 on Community Designs or as registered national designs pursuant to the Slovenian Industrial Property Act.

Design protection is also possible by registering a 3D trademark, either as an EU trademark (Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trademark) or as a national trademark according to the Slovenian Industrial Property Act.

In case of infringement, usually a warning letter is sent to the infringer in order to avoid litigation and try to settle a dispute amicably. Also, sending a letter may serve as a proof in possible litigation that the infringer has been notified about the infringement and that he should be aware of the infringement. However, sending a warning letter is not prerequisite to court action.

Preliminary injunctions are also available but are difficult to prove/substantiate and are rarely granted.

A possible challenge to the efficient enforcement of rights in Slovenia is lack of court practice.

1. Copyright Enforcement Strategies

a. Registration as a pre-requisite to action?

Copyright registration is not pre-requisite to action. According to the Slovenian Copyright and related rights Act, copyright belongs to author by mere creation of work.

b. Scope of protection

Copyright protection covers exclusive personal powers (moral copyright), exclusive economic powers (economic copyright) and other author's powers (other rights of the author).

The moral rights include:

- right to first disclosure,
- right to recognition of authorship,
- right to integrity of the work,
- right to withdrawal of the work.

The economic rights protect author's economic interests and the author is entitled to exclusively allow or prohibit use of his copyright, which include:

- right of reproduction,
- right of distribution,

- right to rent,
- right of public performance,
- right of public transmission,
- right of public communication by means of phonograms or videograms,
- right to public display,
- right of broadcasting,
- right of rebroadcasting,
- right of secondary broadcasting,
- right of making available,
- right of transformation.

c. Key elements of infringement cause of action

- existence of a copyright,
- ownership of a valid copyright,
- existence of an infringement.

d. Remedies

- injunctions;
- prohibition of infringement and future infringement;
- removal claims (recall, removal, destruction);
- damages;
- civil penalties;
- publication of judgment.

e. Challenges and benefits

Benefits: Designs as works of applied art and industrial design that are protected under copyright enjoy longer protection (70 years from the author's death) and in some respect wider scope of protection compared to registered design protection under the Industrial Property Act. There are also no registration requirements and registration/maintenance costs.

Challenges: proving ownership of a valid copyright (*legitimitio ad causam*).

Copyright protection is available to the owner of a copyright (or in cases of work-for-hire to the employer). However, in case said persons do not take an action against an infringer, the author of an infringed work may file an action against such infringer.

2. Design Patent Strategies

a. Registration as a pre-requisite to action?

Design protection in Slovenia encompasses protection of both registered and unregistered designs (only Unregistered Community designs).

Designs can be registered as national designs before the Slovenian IPO, as Community designs before EUIPO or as international designs through the Hague system.

Unregistered Community designs are protected under the Community Design Regulation.

b. Scope of protection

A registered national design confers on its holder the exclusive right to use it and to prevent any third party not having his consent from using it. The scope of protection of an industrial design includes any design which does not produce on the informed user a different overall impression.

An unregistered Community design confers on its holder the right to prevent unauthorized use by third parties only if the contested use results from copying the protected design. Protection does not extend to independent works of creation by a designer who may be reasonably thought not to be familiar with the protected design.

c. Key elements of infringement cause of action

In respect of registered designs:

- existence of a design,
- ownership of a valid design,
- existence of an infringement/unauthorized use of the design.

In respect of unregistered designs:

- proof of the date and place of the first disclosure of the design in a way enabling the interested circles within the European Union to become aware of the disclosure itself,
- proof that the design refers to the disclosed design,
- proof that the alleged counterfeiter has copied the protected design.

d. Remedies

- injunctions;
- prohibition of infringement and future infringement;
- removal claims (recall, removal, destruction);
- damages;
- publication of judgment.

e. Challenges and benefits

Benefits: Extract from the register is sufficient to prove ownership of a registered design. Possible protection without registration (Unregistered Community designs).

Challenges (registered design): term of protection is limited (maximum of 25 years).

Challenges (unregistered designs): requirements with respect to proving disclosure, awareness of the disclosure and that design has been copied. Unregistered designs grant the right to prevent use only in case of intentional (bad faith) copying.

3. Trademark/Trade Dress Strategies

a. Registration as a pre-requisite to action?

Trademark registration is a pre-requisite to action. Trademarks that are valid in Slovenia can be registered as national trademarks before the Slovenian IPO, as EU trademarks before EUIPO or as international trademarks designating Slovenia or the EU through the Madrid system.

b. Scope of protection

Trademark right enables the owner to prevent all third parties not having his consent from using in the course of trade a sign:

- that is identical to a trademark for identical goods/services;
- that is identical or similar to a trademark for identical/similar goods/services and can cause likelihood of confusion which includes likelihood of association with the earlier trademark;
- that is identical or similar to a trademark and that without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the reputation of a trademark.

c. Key elements of infringement cause of action

- ownership of a valid trademark registration;
- unauthorized use of a sign in the course of trade within the scope of protection.

d. Remedies

- injunctions;
- prohibition of infringement and future infringement;
- removal claims (recall, removal, destruction);
- damages;
- publication of judgment.

e. Challenges and benefits

Benefits: Extract from the register is sufficient to prove ownership of a registered trademark; trademark is valid for 10 years; however, it can be renewed indefinitely.

Challenges: According to the Slovenian legislation only a sign that has sufficient distinctive character can be registered as a trademark. Regarding 3D marks, they must be perceived distinctive/unusual with respect to goods in question and shall not result merely out of technical characteristics or of shape of goods. In addition, trademarks undergo a use requirement in order to maintain their registration as trademarks.

4. Common Law and/or Other Non-Statutory Claim Strategies

Common law or other non-statutory claims are not available in Slovenia.

Spain

Contributor: Maite Ferrándiz and Beatriz Bejarano, Grau & Angulo Abogados

INTRODUCTION

1. Copyright Enforcement Strategies

a. Registration as a pre-requisite to action?

The copyright notice is not mandatory according to Spanish legislation, as the copyright of a work corresponds to the author for the mere fact of its creation.

However, a work can be deposited at the Copyright Registry as a means of evidence since, according to the Copyrights Act, unless proven otherwise, it is presumed that the registered copyrights exist and belong to the owner identified in the Registry.

b. Scope of protection

The subject matter of copyright comprises all original literary, artistic or scientific creations expressed by any means or medium, whether tangible or intangible, known at present or that may be invented in the future, including, among others, brochures, writings, speeches, musical compositions, dramatic and choreographic works, audiovisual works, sculptures, paintings, drawings, models, graphs, maps, projects of architectural works and works of engineering, designs related to topography, geography and, in general science, photographs and computer programs.

Without prejudice to the copyright in the original work, the derived works such as translations and adaptations, revisions, updated editions and annotations, compendiums, summaries and extracts or musical arrangements are also subject to copyright. The result of the creative activity is protected by copyright when it generates new original works.

c. Key elements of infringement cause of action

Any non-authorized use of the work, in particular, the reproduction, distribution, communication to the public and transformation of the work, which cannot be covered by any of the limitations to the author's rights, shall be deemed infringing.

d. Remedies

The holder of the copyrights can request the cessation of the illicit activity, the compensation of damages and the publication of the judgment.

The cessation of the illicit activity can include the adoption of measures to suspend the infringing activity and to avoid the resumption of the infringement; the withdrawal and destruction of the illicit specimens and the disabling or destruction of the devices, equipment, tools, etc. destined to perform the infringement; the removal or sealing of the devices used for the public communication of the work; the confiscation, disabling and, if necessary, destruction of instruments whose unique use is to facilitate the unauthorized removal or neutralization of any technical device used to

protect a software; and the suspension of the services provided by intermediaries to third parties who use them to infringe IP rights.

In urgent cases, the injured party can also request the following interim injunctions:

- The intervention and deposit of the income obtained from the illegal activity or, where appropriate, the consignment or deposit of the amounts due as compensation.
- The suspension of the activity of reproduction, distribution and public communication or of any other activity that constitutes an infringement, as well as the prohibition of these activities if they have not yet been implemented.
- The seizure of copies produced or used and of the material used mainly for reproduction or public communication and of the instruments, devices, products and components used for the suppression or alteration of the information for the electronic management of rights.
- The seizure of the equipment, apparatus and material supports which shall be subject to the payment of the compensation claimed as private copying and the appropriate compensation for damages.
- The suspension of services provided by intermediaries to third parties who use them to infringe IP rights.

e. Challenges and benefits

One of the benefits of the copyright is the long-term protection. Although some works have a different term protection, as a general rule, the protection lasts until 70 years after the death of the author and, for those authors who died before 1987, the copyright protection lasts 80 years from his or her death.

However, the fact that there is no constitutive registration of the copyrights over a work can, in some cases, cause uncertainties.

2. Design Strategies

a. Registration as a pre-requisite to action?

Yes, the right of the design is acquired by registration, except the case of the protected unregistered Community designs (which also produce effects in Spain), which can be protected for a period of three years as of the date on which the design was first made available to the public within the Community.

b. Scope of protection

A design must meet the following requirements to be protected:

- Be a design, that is, the appearance of the whole or a part of a product resulting from the features (in particular, the lines, contours, colors, shape, texture or materials) of the product itself or its ornamentation.

-Be novel; and

-Have individual character

c. Key elements of infringement cause of action

The holder of the rights can prevent all third parties from using the design, or any other design which does not produce a different overall impression on an informed user, in the course of trade, without the owner's consent.

d. Remedies

-Cessation of the infringing acts.

-Compensation for damages.

-Adoption of measures to avoid the continuation of the infringement, such as the removal of the infringing products from the market or the seizure of the means used to commit the infringement.

-Destruction of the infringing products or their transfer for humanitarian purposes.

-Delivery of the infringing means or objects at cost price and on account of the corresponding compensation for damages.

-Publication of the judgment, at the infringer's expense.

-When possible, in urgent cases, the injured party can request interim injunctions, which in limited and very exceptional cases, can be adopted *ex parte*.

e. Challenges and benefits

Protection is lower than in the field of copyright or trademarks, since for the registered designs such protection is granted for five years from the date of filing of the application and may be renewed for successive periods of five years up to a maximum of 25. As regards the unregistered Community designs, such protection is only for 3 years.

One of the advantages of industrial design protection is that, unlike trademarks, the design does not expire due to lack of use. In other words, the owner of a design may not use it during the 25 years of protection and, even so, that design may not be subject to expiration due to lack of use.

3. Trademark/Trade Dress Strategies

a. Registration as a pre-requisite to action?

Yes, the Spanish Trademarks Act states that the right of the trademark is acquired by registration. However, it recognizes rights of unregistered trademarks which are "well-known" in Spain within the meaning of Article 6 bis of the Paris Convention.

b. Scope of protection

A trademark may consist of any sign, particularly words, including persons' names, drawings, letters, numerals, colors, the shape of goods or their packaging, or sounds, provided that such a sign be suitable for:

(a) Distinguishing the goods or services of one company from those of other companies, and

(b) Being represented in the Register of Trademarks in such a way as to enable the competent authorities and the general public to determine the clear and precise object of the protection afforded to its owner.

c. Key elements of infringement cause of action

A trademark infringement occurs when a third party, without the consent of the owner, uses in the course of trade:

- Any sign that is identical to the trademark in relation to goods or services that are identical to those for which the trademark is registered.
- Any sign that, since it is identical or similar to the trademark and since the goods or services are identical or similar to those for which the trademark is registered, creates a likelihood of confusion among the public (the risk of confusion includes the risk of association between the sign and the trademark).
- Any sign that is identical or similar to the trademark in relation to goods or services that are not similar to those for which the trademark is registered, when the trademark is reputed in Spain and (i) when the use of the sign is made without fair cause, implying taking an unfair advantage of the distinctive character or the repute of the trademark; or (ii) when the use is detrimental to that distinctive character or the repute of the trademark.

d. Remedies

- Cessation of the infringing acts.
- Compensation for damages.
- Adoption of measures to avoid the continuation of the infringement, such as, for example, the removal of the infringing goods, packaging or advertising material.
- Destruction or transfer for humanitarian purposes of the goods unlawfully identified with the infringing sign.
- Attribution of ownership of the seized products, materials or other means.
- Publication of the judgment, at the infringer's expense.
- In urgent cases, the injured parts can request the adoption of interim injunctions, which in limited and very exceptional cases, can be granted *ex parte*.

e. Challenges and benefits

One of the benefits is that Trademark protection lasts for ten years from the filing date of the trademark application and this period may be renewed for successive ten-year periods without limitation.

One of the challenges is that the trademark's protection can expire if, within five consecutive years the trademark is not genuinely and effectively used in Spain for the goods or services for which it is registered.

4. Common Law and/or Other Non-Statutory Claim Strategies

5. Additional Answers

- **Are works of the applied art (e.g., furniture) protected by Spanish copyright law?**

Yes, the Spanish Copyrights Act states in its Article 10.1.e) that *"The object of copyrights is all original literary, artistic or scientific creations expressed by any means or medium, tangible or intangible, currently known or invented in the future, including: "Sculptures and works of painting, drawing, engraving, lithography and graphic comics, comics, as well as their essays or sketches and other plastic works, applied or not"*.

In order for a work of the applied art to be protected under copyrights, it must be original. In this respect, the majority of the doctrine and the case law considers that only a design that is "especially creative" or original can be considered a copyright work. The reason for such a conclusion is that if the author of a formal creation, which could already have the framework of special protection conferred by the design regulation, aims to invoke the protection of copyright, the work of the applied art in question must have a "plus" of creativity (among others, the Judgments of the Supreme Court (Civil Chamber), of 27 September, 2012, and of the Barcelona Court of Appeal (Section 15) of 26 April, 2019).

- **May copyright, designs and (shape) trademarks for works of the applied art be enforced simultaneously?**

Yes, it is possible, provided that the requirements demanded under the different Laws are met. In fact, the enforcement of several intellectual property rights on the same intangible good has explicit legal recognition in several regulations of the different intellectual property rights.

In this sense, Article 3.2 of the Spanish Copyrights Act expressly contemplates the possibility of the simultaneous enforcement of copyright and *"the industrial property rights that can exist over the work"*.

On the other hand, the Spanish Industrial Design Act (Act 20/2003 of 7 July, on Legal Protection of Industrial Designs) also stipulates in the Explanatory Memorandum, section II, that an original or especially creative design can also enjoy the protection provided by copyright.

Besides, the tenth Additional Provision of the Spanish Industrial Design Act establishes that *"The protection recognized in this law for industrial design shall be independent, cumulative and compatible with that which may derive from copyright when the design in question presents itself with the degree of creativity and originality necessary to be protected as an artistic work under the rules governing copyrights"*.

Although in theory accumulation is possible, in order to enforce the protection of the three referred IP titles on the same intangible good, it would be necessary to prove that the infringement, in an independent way, invades the three spheres of protection. Moreover, in practice, it is very difficult that the Spanish Courts recognize the infringement of the three aforementioned intellectual property rights over the same intangible good simultaneously. The Courts usually set limits on such accumulation to avoid that unrestricted cumulative protection could lead to a disproportionate legal protection.

Sweden

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INTRODUCTION

1. Copyright Enforcement Strategies

a. Registration as a pre-requisite to action?

The Swedish Copyright Act does not require registration as a pre-requisite to action. The author, his or her rightsholder or a licensee entitled to exploit the work, can bring an action regarding copyright infringement to the Court.

b. Scope of protection

Swedish Copyright legislation is internationally harmonized. Sweden is *inter alia* a party to the Berne Convention for the Protection of Literary and Artistic Works and the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS). Furthermore, has Sweden, as a member of the European Union, transposed *inter alia* the Directive 2001/29/EC of the European Parliament and of the Council of 22 May 2001 (the “Infosoc Directive”) as well as the Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights (the “Enforcement Directive”).

Swedish Copyright legislation thereby acknowledges copyright protection to any author who has created a literary or artistic work regardless if the work is a fictional or descriptive written or oral expression. This means that a computer program, a musical or dramatic work, a cinematographic work, a photographic work or any other work of fine art, an architectural work or work of applied art and a work expressed in some other manner could constitute a work subject to copyright protection (see Chapter 1 Section 1 of the Swedish Copyright Act (SFS 1960:729), in the following the Copyright Act). Regardless of the origin of the author or the place of creation of the work, the protection is the same.¹ It should be noted that the copyright to a work is unaffected even if the work has been registered as a design.

Copyright in a work subsists until the end of the seventieth year after the year of death of the author or, in the case of a work with multiple authors after the year of death of the last surviving author.²

The Copyright Act do not include a definition of originality, but according to case law from the Court of Justice of the European Union (“CJEU”) as well as case law from Swedish Courts, a work, to enjoy copyright protection, must be a product of

¹ In addition to the copyright protection to literary or artistic works, Swedish legislation also acknowledges copyright protection for neighbouring rights (right for creative artists, producer rights, catalogue rights, and rights for photographers), but for the purpose of this toolkit this has been omitted.

² The term for protection for neighbouring rights, for example photographs is 50 years from the year in which the photograph was produced and for catalogues for 15 years from the year in which the product was completed.

the author's own intellectual creation whereby the creativity has been expressed in an original manner through free and creative choices.³

Chapter 1 Section 2 of the Copyright Act establishes the exclusive rights of the author:

"Subject to the limitations set forth below, copyright shall include the exclusive right to exploit a work by making copies of the work and making the work available to the public, in either the original or an altered form, via a translation or adaptation, in another literary or artistic form, or in another technical manner.

The making of copies shall include any direct or indirect, temporary or permanent reproduction of the work, irrespective of the form or through which method the reproduction is performed and irrespective of whether this occurs in whole or in part.

The work is deemed to have been made available to the public in the following cases:

1. When the work is communicated to the public. This occurs when the work is a made available to the public by wire or by wireless means from a place other than where the public may normally access the work. Communication to the public includes also acts of communication that occur in such a manner that members of the public may access the work from a place and time which they themselves choose.
2. When the work is publicly performed. Public performance includes only such cases where the work is made available to the public, with or without the use of a technical device, at the same place as where the public may normally access the work.
3. When copies of the work are publicly exhibited. Public exhibition includes only such cases where a copy of a work is made available to the public, without the use of a technical device, at the same place as where the public may normally access the copy. Where a technical device is used, the act is instead a public performance
4. When copies of the work are offered for sale, leased, lent, or otherwise distributed to the public.

Acts of communication to the public and of public performance shall also be deemed acts of communication and performance that, within the scope of commercial activities, are directed toward, or are performed for, a comparatively larger group of persons."

Following the above the scope of protection for copyright includes the so-called economical rights – the exclusive right to reproduction, communication to the public, making available to the public and distribution. Consequently, an author may prohibit others from using the work without the author's permission.

³ See CJEU judgments in C-5/08, *Infopaq International*, C-403/08 and C-429/08, *Football Association Premier League and Others*, and C-145/10, *Painer*.

Furthermore, the author is granted moral rights which is included in the Copyright Act Chapter 1 Section 3. This means that a work may not be altered in a manner which is prejudicial to the author's literary or artistic reputation or to his or her individuality, nor may it be made available to the public in such a form or in such as context as to be prejudicial in the manner stated. The name of the author shall also be stated to the extent and in the manner required by normal custom if copies are made of a work or where the work is made available to the public. The moral rights are extensive, and an author may only in relation to uses which are limited in nature and scope, with binding effect, waive his or her moral right.

The exclusive right is for certain uses limited, for example use in scientific research, teaching, use for the benefit of people with a disability, public security and political speeches (the limitations are listed in Chapter 2 of the Copyright Act). Hence, when establishing if enforcement of the exclusive right will be possible an assessment of the use of the work in the specific case must be conducted.

c. Key elements of infringement cause of action

Should an author identify that someone without the author's permission uses the work – reproduction, making available to the public, communication to public or in other ways distributing – there are different measures that the author may adopt to bring the infringement to an end. The Copyright Act establishes that an infringement is criminal and may result in fines or even imprisonment (see Chapter 7 Section 53 of the Copyright Act). Furthermore, may an author initiate civil proceedings regarding the infringement which will also be the starting point for the below elaboration regarding the key elements of an infringement cause of action.

As a first step it is important to collect and ensure evidence of the infringement by for example acquiring the infringing goods, conducting searches on internet, in store or similar. The material and measures conducted should be kept confidential and legal advice should be sought at an early stage. Should the securing of evidence prove difficult there are procedural measures available; *for example*, to submit a request to provide information⁴ or a request for an infringement investigation to the Court⁵. It could be noted that in principle any person, defendant or other third party, who holds a written document that can be assumed to be of importance as evidence is obliged to produce it, according to the Swedish Code of Judicial Procedure (SFS 1942:740)⁶. The same applies to objects, if the object can be brought to the court conveniently. The court could therefore issue an order for a party to produce such a document to the court, or to any person designated by the court, or to make such an object available for inspection. The obligation is however limited insofar the documentation or object is subject to confidentiality.

In relation to the specific procedural measures to gain access to information regarding the infringement the rightsholder must typically demonstrate at least a likelihood that an infringement has occurred. Thereby, before such actions are

⁴ See Chapter 7 Section 53 c of the Copyright Act.

⁵ See Chapter 7 Section 56 of the Copyright Act.

⁶ See Chapter 36 of the Code of Judicial Procedure.

sought, the rightsholder must determine if the right in question has been infringed or not. This assessment is based on the following steps:

- 1) establishing that the work is protected by copyright (see above discussion regarding originality);
- 2) assessing the similarities between the work and the infringing product. Close imitations will typically fall inside the scope of protection of the work;
- 3) determining that the use in question was unlawful and do not fall under any exception.

A request to provide information may only be granted if the author demonstrates a likelihood that someone has committed an infringement and it can be assumed to facilitate an investigation into an infringement or a violation which relates to the goods or services. Furthermore, it is only if the arguments in favour of the measure outweigh the inconvenience or other harm that the measure would cause to the party affected by the order or to any other opposing interest that an order may be issued.

The order may, under a penalty of fine, be directed to one or several of the parties that has committed, or aided and abetted, the infringement or committed, or aided and abetted, the violation; on a commercial scale, has exploited a good that the infringement or the violation concerns; on a commercial scale, has used a service that the infringement or the violation concerns; on a commercial scale, has made an electronic communication service available or another service that has been used in connection with the infringement or the violation; or has been identified, by someone that is considered a party according to the previous, as being involved in the production or distribution of a good or the making available of a service that the infringement or the violation concerns.

The information that an order typically will relate to refers to the origin and distribution networks for the goods or services in respect of which the infringement or the violation has been committed. Information concerning the origin or distribution network of goods or services may specifically refer to: i) the names and addresses of producers, distributors, suppliers and others who have previously possessed the goods or made the services available; ii) the names and addresses of intended wholesalers and retailers; iii) information concerning how much has been produced, delivered, received or ordered and the price set for the goods or services.

The obligation to provide information does not include information which, if revealed, would disclose that the provider of the information or any person closely related to him or her as referred has committed a criminal act.

It should be noted that anyone who (except for a party that has committed, or aided and abetted, the infringement) has been ordered to provide information is entitled to reasonable compensation for costs and inconvenience. The compensation must be paid by the party that has requested the order to provide information.

An alternative is *an infringement investigation* whereby the Court may – for the purpose of preserving evidence relating to the infringement, where it can reasonably be assumed that someone has committed, or aided and abetted, an infringement – order that an investigation be undertaken in respect of that party in order to search for objects or documents that can be assumed to be of importance for the inquiry into the infringement or the violation. An order for an infringement investigation may be issued only if the arguments in favour of the measure outweigh the inconvenience or other harm that the measure would cause to the affected party or any other opposing interest.

A motion regarding infringement investigation may be filed by the author or the rightsholder or a party entitled to use the work pursuant to a licence. Where legal proceedings have not yet been initiated, the motion shall be submitted in writing. Before an order for an investigation is issued, the counterparty shall be provided an opportunity to respond. However, under such circumstances where a delay would entail a risk that objects or documents of importance for the investigation into the infringement would be removed, destroyed or distorted, may the Court immediately issue an order which remains in effect until otherwise decided.

The applicant must provide security to the Court for the injury which may be incurred by the counter party through the infringement investigation and is hence a prerequisite for the issuance of an order for infringement investigation. In cases where the applicant is not able to provide security, the Court may release him or her from this requirement. The security shall be examined by the Court unless it has been approved by the counterparty. Typically, the security is a bank guarantee and amounts to 50 000 – 300 000 SEK depending on the scope of the investigation.

An order for an infringement investigation is enforceable with immediate effect. Where an application for its execution has not been filed within one month from the order, the order becomes invalid. The order is executed through the local Enforcement Authority in Sweden. The applicant's counterparty shall be informed about the execution only where the order for an infringement investigation has arisen after hearing from the counterparty. The Enforcement Authority has the right to take photographs and to make video and sound recordings of such objects for which it is authorised to search as well as make copies of, and extracts from, such documents for which it is authorised to search. When an order for an infringement investigation is to be executed, the counterparty has the right to an attorney. The execution must not begin before the attorney has arrived, but should the investigation thereby be unnecessarily delayed or if there is a risk that the purpose of the measure otherwise will not be achieved the investigation can proceed without the attorney's arrival.

It should be noted that if the applicant does not, within one month from the conclusion of the execution, file an action or initiate in some other manner a proceeding relating to the issue, any measure which has been taken in the context of the execution of the infringement investigation shall be invalidated, to the extent this is possible.

In parallel to the measures to secure evidence (or after such measures), a *cease-and-desist letter* will typically be sent to the infringer requesting the infringer to immediately stop the infringing acts as well as withdrawing or destroying infringing goods, providing information about the infringement and paying damages. It should be noted that a cease-and-desist letter should be balanced and objectively correct. Otherwise, it could be considered an act of unfair marketing.

If the infringer does not respond or rejects the author's request, an action may be brought to the Patent and Market Court, located in Stockholm, which has exclusive jurisdiction to try cases regarding intellectual property rights. Decisions and judgments of the Patent and Market Court can be appealed to the Patent and Market Court of Appeal if leave to appeal is accepted.⁷

An infringement action under the above-mentioned circumstances may be brought by the author or his or her rightsholder or by a party that, due to a licence, is entitled to exploit the work, and will include a *request for an injunction*, which would prohibit the infringer from continuing to commit, or aid and abet, an act constituting an infringement *i.e.* an injunction may be issued to prevent an actual, attempted or prepared infringement.⁸ The injunction will typically be combined with a fine. To be successful the author must prove that the infringement has occurred. Swedish legislation also provides the possibility to request that the infringing goods shall be *recalled, altered, taken into custody or destroyed, compensation for the damage* caused by the infringement, *publication of the judgment* in Swedish newspapers and *compensation for litigation costs* (further information regarding the remedies is provided under section d below).

It is also possible to file a request for *preliminary injunction* (interlocutory injunction).⁹ The author must in such case demonstrate a likelihood that an act constituting an infringement or an aiding and abetting of the act, occurred and if it can reasonably be expected that the defendant, through the continuation of the act, or the contribution thereto, lessens the value of the copyright's exclusive right. The injunction would if granted cover the period until the case has been finally adjudicated or another decision has been taken. The defendant must be provided the opportunity to respond, unless a delay would lead to a risk of loss (the Court may consequently issue the preliminary injunction *ex parte* under certain circumstances).

A preliminary injunction may only be issued if the author provides security to the Court for the damage that may be incurred by the defendant. If the author is not capable of providing such security, the Court may release him or her from such a requirement. When the case is adjudicated, the court shall decide whether an injunction issued under the second paragraph shall remain in effect.

It should be noted that Swedish law also recognises so called blocking injunctions which could be issued against intermediaries and other persons who facilitate the

⁷ <http://www.patentochmarknadsoverdomstolen.se/Funktioner/English/The-Swedish-courts/Patent-and-Market-Courts/>

⁸ See Chapter 7 Section 53 b of the Copyright Act.

⁹ see Chapter 7 Section 53 b second paragraph of the Copyright Act

copyright infringement. From recent case law it could however be established that a decision is only rendered if it fulfils the principles of proportionality, *i.e.*, that the injunction strikes a fair balance between the rightsholders interests and the freedom of business for the intermediary and the freedom of information for the internet users. In the case in question the Patent and Market Court of Appeal found that the user's right to freedom of information on internet outweighed the rightsholders' interests, considering in particular the share of the infringing material in proportion to legal material and the functionality and relevance of the invoked domain names, and consequently could the preliminary blocking injunction not be issued.¹⁰

d. Remedies

Sweden has implemented the Enforcement Directive and since August 2009 the remedies following the EU legislation is available, not only in relation to copyright but to all intellectual property rights, in Swedish intellectual property right legislation. Following the outline of the Enforcement Directive, and as have been further elaborated above, Swedish legislation provide:

- *Provisional and precautionary measures*; in addition to the possibility to gain an interlocutory injunction Swedish law also provide the possibility to the seizure or delivery up of the goods suspected of infringing an intellectual property right so as to prevent their entry into or movement within the channels of commerce.¹¹
- *Corrective measures*; the Court may, upon request by the claimant, order that any property involved in an infringement or violation shall be *recalled from the market, altered or destroyed* or that some other measure shall be taken.¹² The same applies to means of assistance that have been used, or intended to be used, in connection with the infringement or the violation. The corrective measures also apply to acts constituting attempts and preparations for an infringement or a violation. The corrective measure should be reasonable and appropriate in relation to the infringement. Specifically, in relation to copyright, measures that may be relevant include ordering that the name of an author shall be displayed on copies or that an artwork subject to misrepresentation must be restored to its original state. The defendant shall pay for the corrective measure unless there are specific reasons to decide otherwise.
- *Injunctions*; see above.
- *Damages*; according to Swedish Copyright legislation as well as other legislation covering intellectual property rights, damages for infringement is governed by the overall principle that the rightsholder, despite possible

¹⁰ Decision of the Patent and Market Court of Appeal 1 of February 2019 in the case PMÖ 9945-18. For CJEU case law, see for example C-610/15 - Stichting Brein.

¹¹ See Chapter 7 Section 53 b second paragraph and following of the Copyright Act and Chapter 15 Section 1 and 3 of the Code of Judicial Procedure.

¹² See Chapter 7 Section 55 of the Copyright Act.

evidentiary difficulties, shall be fully compensated for the damage caused by the infringement (*restitutio in integrum*). This is achieved through a two-sided cumulative approach. On the one hand, the rightsholder shall be entitled “*reasonable compensation*” for the unlawful use of the right and on the other hand, in proportion to what the rightsholder can prove and for acts that has been carried out intentionally or negligently, compensation for “*further damage*”.¹³

The “*reasonable compensation*”, according to Swedish case law and jurisprudence, should reflect the license fee that would have been paid if a license had been granted to the infringing party (*a hypothetical license*).¹⁴ This hypothetical license fee is decided on a case-by-case basis but usually it is established either by a) an accepted license fee on the market under similar circumstances, or b) a purely approximated license fee based on available evidence depending on the circumstances.

“*Further damage*” compensates the rightsholder for additional damage caused by the infringement or violation. When the amount of the compensation is determined, particular consideration must be given to 1) lost profits, 2) profits made by the party that committed the infringement or the violation, 3) damage to the reputation of the work, 4) non-pecuniary damage and 5) the interest of the author or the rights holder in avoiding infringements.

It should be noted that the right to claim damages for a copyright infringement is time-barred if the action is not filed within ten years from the date of the injury.

While acknowledging the difficulties in obtaining evidence to fully substantiate the damages claim, the courts have the possibility to apply Chapter 35 section 5 in the Code of Judicial Procedure which allows the court to estimate the damage to a reasonable amount if full proof cannot be presented at all, or only with difficulty. This may also be done provided that the proof can be assumed to entail costs or inconvenience not being in a reasonable proportion to the size of the damage and the claimed compensation concerns only a lesser amount. The above-mentioned rule is often invoked in intellectual property right cases. However, the Swedish Supreme Court has made it clear that the rule does not relieve a party from its obligation to put forward the amount of investigation which could reasonably be achieved.¹⁵

- *Legal costs*; the successful party is as a main rule (Chapter 18 Section 1 of the Code of Judicial Procedure) entitled compensation for incurred reasonable and proportionate legal costs and other expenses and this shall be borne by the unsuccessful party, unless otherwise decided or

¹³ See Chapter 7 Section 54 of the Copyright Act.

¹⁴ Prop. 2008/09:67 p. 227.

¹⁵ NJA 2005 p. 180 (Formsprutarmålet).

equity does not allow this. In case of a settlement, both parties typically carry its own litigation costs.

- *Publicity measures*; the Copyright Act, as well as the for this question relevant IP legislation, establishes that the Court may order the infringing party that has committed, or aided and abetted, the infringement to pay for appropriate measures to distribute information about the judgment in the case.¹⁶

It should finally be noted that a rightsholder may apply to the Swedish Customs (Sw. Tullverket) for enforcement of intellectual property rights.¹⁷ Thereby the rightsholder may prevent infringing goods to enter into the market (EEA) meanwhile the question of infringement is assessed.

e. Challenges and benefits

In general, the threshold for copyright protection for applied arts in Sweden are relatively low, but on the other hand the scope of protection is usually limited to close imitations. Nonetheless it is important that an exhaustive review of the creative process which resulted in the work and what form elements that may have been known at the time of creation is conducted before initiating proceedings.

In a recent case, judgment rendered by the Patent and Market Appeal Court 22 March 2019¹⁸, a wristwatch was considered protected by copyright whereby the Patent and Market Appeal Court clearly specifies that the assessment of copyright protection must be made in accordance with case law from CJEU *i.e.*, two cumulative conditions must be satisfied for subject matter to be classified as a 'work' (reference is made to CJEU judgment in C-340/17, *Levola Hengelo*, and C-5/08, *Infopac*). These two cumulative conditions are 1) the subject matter concerned must be original in the sense that it is the author's own intellectual creation and 2) the subject matter must be expressed in a manner which makes it identifiable with sufficient precision and objectivity, even though that expression is not necessarily in permanent form.

If an author seeks a preliminary assessment of whether a work of applied art or similar is protected by copyright and if that copyright has been infringed the author may, without initiating legal proceedings, apply to the Svensk Form Copyright Panel to be provided a preliminary assessment regarding the copyright protection of a work of applied arts and an assessment if another product is infringing the copyright to the work. The Svensk Form Copyright Panel is an impartial expert body within Svensk Form (the Swedish Society of Crafts and Design). After application – either one party matters which would relate to the question of copyright protection or two-party matters which relate to a claim of infringement – to the panel the panel will prepare the matter and in two party matters, when

¹⁶ See Chapter 7 Section 53 h of the Copyright Act.

¹⁷ See Regulation (EU) No 608/2013 of the European Parliament and of the Council of 12 June 2013 concerning customs enforcement of intellectual property rights and repealing Council Regulation (EC) No 1383/2003

¹⁸ Case No PMT 5885-18.

relevant, also summon the parties to a meeting. After the matter has been fully prepared the panel will render a written opinion regarding copyright protection for works of applied art or in case of a two-party matter, if the work has been infringed. The opinion is not binding. The opinion could be kept confidential if requested by the applicant. The cost of an assessment of copyright is 29 500 SEK.

Conducting proceedings in Sweden, disregarding legal costs, are in relative terms not costly as the Court fee only amounts to 2 900 SEK (ca 280 EUR). The fee is recoverable should the claimant be successful in the proceedings.

2. Design Patent Strategies

a. Registration as a pre-requisite to action?

A pre-requisite to pursue an action according to Swedish law under the Swedish Design Protection Act (SFS 1970:485) is that a registered design or unregistered design exists and is in force. The design holder, or a licensee entitled to exploit the design, can bring an action regarding copyright infringement to Court.

b. Scope of protection

EU legislation regarding designs have had a great impact on Swedish design legislation through the Council Regulation (EC) No. 6/2002 of 12 December 2001 on Community designs (the “Design Regulation”), which has full effect in Sweden, and the Directive 98/71 EC of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs (The “Design Directive”) which in 2002 was implemented through changes in the Swedish Design Protection Act (SFS 1970:485), in the following the Design Protection Act.

There are three closely linked and to some extent overlapping ways to protect a design in Sweden; 1) through national Swedish registration in accordance with the Design Protection Act, 2) through a registered Community Design (RCD) according to the Design Regulation or 3) through an unregistered Community Design according to the Design Regulation. For the purpose of this toolkit, the focus will be on national Swedish registered design rights, however, in terms of enforcement of a design right the same principles more or less apply.

As mentioned in the previous section regarding copyright, a work of applied arts may uphold copyright protection as well as being a registered design and often will the protection overlap.¹⁹ It should also be noted that since the design protection refers to the appearance of the product (in whole or in part) which is a result from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation. Thereby it is possible to protect the technical function of a product through patents (which would be excluded for design protection) and the appearance of the physical product through design (a kind of double protection).

¹⁹ See Chapter 1 Section 10 of the Swedish Copyright Act.

The purpose of the design protection is to stimulate the development of new products. Hence a prerequisite for registration is that the design is new and has individual character. From Section 2 of the Design Protection Act follows that:

“A design shall be deemed new if no identical design has been made available to the public before the date of the filing of the application for registration or, if priority is claimed according to Articles 8 to 8d below, before the date of priority. Designs shall be deemed to be identical if the sole differences between them are insignificant details.

A design shall be deemed to have individual character if the overall impression it produces on the informed user differs from the overall impression given by any other design which has been made available to the public before the date indicated in the second paragraph of this section. In determining whether the design has an individual character, the degree of freedom of the designer in developing the design shall be considered”

From Section 2 a of the Design Protection Act further follows that a design for a part of a complex product shall be considered to be new and having an individual character only if 1) the component part a design or part thereof, once it has been incorporated into the complex product, remains visible during the normal use of that product; and 2) the design itself insofar as it is visible fulfils the requirements of novelty and individual character, as set out in section 2 mentioned above.

An additional, negative requirement for design protection is based on technical function whereby Section 4 a of the Design Protection Act establishes that a design right may not include such details in the appearance of the product which are dictated solely by the technical function of that product. Thereby, even if the overall appearance of the design is novel and has individual character should all the features (details) in the design solely be dictated by a technical function, the design will not be eligible for protection. Consequently, when enforcing a design right the rightsholder must always remember that features that have a technical function cannot be invoked as part of the scope of protection.

Upon registration the designer or the designer’s successor obtains an exclusive right to the design.²⁰ The scope of the protection solely includes the economic rights, *i.e.*, that no third party may use the design without the consent by the holder of the design right. Section 5 of the Design Protection Act sets forth the scope of the protection:

“The design right entails that no third party may use the design without consent by the holder of the design right (the design holder) subject to the exceptions set out in Sections 7 to 7b. The prohibition against use includes, in particular, the manufacture, offering for sale, putting on the market, importation into and exportation from Sweden, or using of any product in which the design is incorporated or to which it is applied, or stocking such a product for those purposes. The design right includes any other design that does not produce, on the informed user, a different overall impression than that of the registered design (scope of

²⁰ The Design Protection Act (1970:485), Section 1a.

protection). In assessing the scope of protection, the degree of freedom of the designer in developing the design shall be considered.”

However, the scope of the protection excludes some acts in relation to the use of the protected designs. Private use and use with non-commercial purposes, experimental purposes and reproduction with the purpose of quotation or teaching (under certain conditions) are excluded from the right of protection. Further exceptions are, *inter alia*, products used as equipment on foreign ships and aircrafts entering Sweden temporarily and the use of products which have been put on the market, either by the design holder himself or by another person but with his consent.²¹ Further limitations to the exclusive right may also be applicable according to additional laws. Hence, when establishing if enforcement of the design right will be possible an assessment of the use of the design in the specific case must be conducted to conclude if the use amounts to an infringement.

It should be noted that the design right does not entail any moral rights, except that the designer’s name shall be stated at registration, as copyright protection.

A Swedish registered design is in force from the day of application to the end of a five-year period. The five-year period can be extended with renewed registration fees five times, providing a maximum protection of 25 years from the day of application. An unregistered design has protection under three years from the day on which the design was first made available to the public within EU.

c. Key elements of infringement cause of action

To avoid repetition reference is made to the key elements of an infringement action in a copyright matter. The relevant provisions could be found in Sections 35 – 40 in the Design Protection Act.

As with copyrights the specific procedural measures to gain access to information regarding the infringement the rightsholder must typically demonstrate at least a likelihood that an infringement has occurred. Thereby, before such actions are sought, the rightsholder must determine if the right in question has been infringed or not. This assessment is based on the following steps:

- 1) ensuring that the registered design or unregistered design is in force and protected;
- 2) assessing the similarities between the design and the infringing design, with the purpose to exclude that the informed user may experience a different overall impression of the new design in comparison with the allegedly infringed design;
- 3) determining that the use in question was unlawful and do not fall under any exception.

²¹ Design Protection Act (1970:485), sections 7 to 7b.

The Design Protection Act also acknowledges a right for the rightsholder to *request* the infringer or someone else to *provide information*²² or the right to an *infringement investigation*²³.

An action may be brought to the Patent and Market Court, located in Stockholm, which has exclusive jurisdiction to try cases regarding intellectual property rights. Decisions and judgments of the Patent and Market Court can be appealed to the Patent and Market Court of Appeal if leave to appeal is accepted (see further above).

d. Remedies

In view of the Enforcement Directive that Sweden has implemented the remedies available corresponds to the ones already elaborated under section 1 d above. In relation to damages for infringement in the industrial rights such as design rights anyone who wilfully or negligently commits an infringement shall pay reasonable damages for the use of the right as well as damages for the further injury caused by the infringement. In case the infringement is neither wilful nor negligent, the infringer shall pay damages for the use of the right, insofar as that is reasonable. It should also be noted that the right to claim damages is forfeited if proceedings have not been commenced within five years from the time the damage arose.²⁴

It should further be noted that the rightsholder may bring a declaratory action to determine whether or not the design registration provides protection against another design where uncertainty exists in this respect and the uncertainty is prejudicial to him or her. The same applies to a person who is engaged in, or intends to engage in, a business activity where a certain registered design could present an obstacle for the activity (*declaratory action regarding non-infringement*).²⁵

The relevant provisions could be found in Sections 35 – 40 of the Design Protection Act.

e. Challenges and benefits

From a procedural perspective it should be noted that an infringement action often is countered by a revocation action regarding the design registration. If the opposition period has ended a revocation action could be brought before the Patent and Market Court. Otherwise, the revocation action could be brought before the Swedish Patent and Registration Office.

A Swedish registered design has, as mentioned above, protection against any other design that does not produce, on the informed user, a different overall impression than that of the registered design (scope of protection). In assessing the scope of protection, the degree of freedom of the designer in developing the design shall be considered. It should however be noted that there are no

²² See Section 35 c of the Design Protection Act.

²³ See Section 37 a – 37 h of the Design Protection Act.

²⁴ See Section 36 of the Design Protection Act.

²⁵ See Section 41 of the Design Protection Act.

precedential case law and only a few decisions from the courts of first and second instance. Therefore, relying on case law regarding copyright protection for applied arts, and considering that most designs can be assumed to be of relatively simple character, the scope of protection of a design is typically relatively narrow.

3. Trademark/Trade Dress Strategies

a. Registration as a pre-requisite to action?

A pre-requisite to pursue an action according to Swedish law under the Swedish Trademark Act (SFS 2010:1877) is that a registered trademark exists and is in force. The holder of the trademark, or a licensee entitled to exploit the trademark, can bring an action regarding trademark infringement to Court.

b. Scope of protection

Similarly, to the design rights, EU legislations have had an impact on Swedish trademark legislation. The Swedish Trademark Act follows for example closely the Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trademarks and furthermore is Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union (“EU Trademark Regulation”) directly applicable in Sweden. In addition to these provisions, Sweden has also adopted the Paris Convention for the Protection of Industrial Property²⁶, the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS)²⁷, the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks²⁸ as well as the Madrid Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks²⁹. For the purpose of this toolkit the question regarding protected designation of origin and protected geographical indications and possible collision between these rights and trademarks have been omitted.

There are consequently several ways to gain protection for a trademark in Sweden; 1) through a national Swedish registration in accordance with the Swedish Trademark Act, 2) through registration of a Community trademark, 3) through registration of a trademark under the Madrid Protocol with Sweden as designated country and 4) through establishment on the market in Sweden (see Section 7 of the Swedish Trademark Act). For the purpose of this toolkit, the focus will be on national Swedish registered trademarks, however, in terms of enforcement of a trademark the same principles more or less apply.

A trademark may, according to Chapter 1 Section 4 of the Swedish Trademark Act consist of:

²⁶ See https://www.wipo.int/treaties/en/text.jsp?file_id=288514

²⁷ See https://www.wto.org/english/docs_e/legal_e/27-trips.pdf

²⁸ See <https://www.wipo.int/treaties/en/classification/nice/>

²⁹ See https://www.wipo.int/treaties/en/registration/madrid_protocol/index.html

“[...] all symbols capable of being represented graphically, particularly words, including personal names, as well as devices, letters, numerals, and the design or ornamental aspects of a product or its packaging, provided that such symbols have distinctive character.”

This means that in addition to traditional trademarks – word or figure marks – sound marks or smell marks are also included. Furthermore, does Swedish legislation specifically acknowledge the protection of trade dress *i.e.*, that a product or its packaging may be registered as a trademark. However, the possibility and scope of protection is limited. It should however be noted that according to Chapter 1 Section 9 of the Swedish Trademark Act no exclusive right may be acquired in marks which consist solely of a form which derives from the nature of the goods, a form which is necessary to achieve a technical result, or a form which confers significant value on the goods. This will bar registration of goods which for example contain features which refers to a technical result which in relation to products and packaging have specific relevance. The purpose is to avoid granting an in principle perpetual monopoly to a rightsholder for goods that may restrict fair competition or would be contrary to public interests.

In addition to formal requirements for registration, a registration is only possible if the trademark which is to be registered have *distinctive character* for the goods or services to which it pertains. Furthermore the trademark may not be identical to the mark for goods or services of the same type; be identical or similar to the mark for goods or services of the same or a similar type, where there is a risk of confusion, including the risk that use of the symbol will lead to the belief that there is a connection between the party using the symbol and the proprietor of the mark; be identical or similar to a mark which is known within Sweden by a significant portion of the relevant public, where the use pertains to goods or services and involves improper exploitation of or, without good cause damages, the distinctive character or reputation of the mark; or where it can be confused with a symbol which was used in Sweden or abroad by any party at the time of the application and which is still in use, unless the applicant acted in good faith at the time of the application.³⁰

Upon registration or in case of establishment on the market the rightsholder obtains an exclusive right to use the trademark.³¹ The scope of the protection solely includes the economic rights, *i.e.*, that no third party may in commercial activities use a symbol which is identical or similar to the registered trademark for identical or similar goods or services without the consent by the rightsholder. Chapter 1 Section 10 of the Swedish Trademark Act sets forth the scope of the protection:

“The exclusive right in a mark pursuant to sections 6–8 shall entail that no party other than the proprietor, unless permission has been granted by the proprietor, may use in its commercial activities a symbol which is:

³⁰ See Chapter 2 Sections 4 – 11 of the Swedish Trademark Act.

³¹ See Chapter 1 Section 10 of the Swedish Trademark Act.

1. identical to the mark for goods or services of the same type;
2. identical or similar to the mark for goods or services of the same or a similar type, where there is a risk of confusion, including the risk that use of the symbol will lead to the belief that there is a connection between the party using the symbol and the proprietor of the mark; or
3. identical or similar to a mark which is known within Sweden by a significant portion of the relevant public, where the use pertains to goods or services and involves improper exploitation of or, without good cause damages, the distinctive character or reputation of the mark.

“Use” means

1. affixing the symbol to goods or their packaging;
2. offering the goods for sale, placing them on the market, storing them for such purposes, or offering or providing services under such symbol;
3. importing or exporting goods under the symbol; or
4. using the symbol in commercial activities and advertising.”

However, the exclusive rights are limited; it does not provide any independent protection for a part of the mark which lacks distinctive character and will not prevent any other person from using his or her company name, name or address; information regarding the nature, quality, quantity, intended use, value, geographic origin, or other characteristics of the goods or services or the date on which the goods or services are produced. It does further not prevent any other person from using the mark, where necessary to indicate the intended purpose of the goods or services, particularly in respect of accessories or spare parts, as long as this occurs in accordance with sound business practices. Neither shall the exclusive right to a collective mark, guarantee mark, or certification mark not prevent any third party from using, in its commercial activities, the mark or designation as it refers to geographic origin, provided this takes place in accordance with sound business practice. The exclusive right in such a mark shall not prevent a party entitled to use a geographic name from doing so. Furthermore, the exclusive right in a mark shall not prevent a party other than the rightsholder from using the mark for goods which the rightsholder, or another party with the rightsholder’s consent, have placed on the market under the mark within the European Economic Area (*exhaustion*). The limitation due to exhaustion do not apply where the condition of the goods has been changed or diminished after they were placed on the market or where there is any reasonable ground for the rightsholder to oppose the use.³²

It should be noted that the exclusive right does not prevent the use of the mark in advertisements (for commercial purposes) if it is done in compliance with the Swedish Marketing Practices Act (2008:486).

³² See Chapter 1 Section 12 of the Swedish Trademark Act.

In light of the above, when establishing if enforcement of the trademark will be possible an assessment of the use of the design in the specific case must be conducted to conclude if the use amounts to an infringement.

A Swedish trademark can be in force infinitely from the day of application, in ten-year periods, as long as the annual fee is paid. However, a trademark must be used.³³ According to Chapter 3 Section 2 of the Swedish Trademark Act a registered trademark may be revoked if the rightsholder has not made genuine use of the trademark in Sweden. The relevant provision reads:

“A registration of a trademark may be cancelled where the proprietor has not made actual use of the mark in Sweden for the goods or services for which it is registered for a period of five years from the date on which the question of registration was conclusively resolved, or within a period of five consecutive years. However, the registration may not be cancelled on the grounds of non-use if there are valid reasons why the trademark has not been used.

Such “use” as referred to in the first paragraph shall be equated with:

1. the trademark being used in a form other than that registered where the deviation pertains only to details which do not change the distinctive character of the mark; and
2. the goods or their packaging have been affixed with the trademark in Sweden for export purposes only.

“Use of a trademark by a proprietor” shall be equated with the trademark being used by any other party with the proprietor’s consent.

The registration may not be cancelled where the trademark has been used during the period between the expiry of the five-year period and the submission of an application to cancel a registration. Use which commences or resumes after the expiry of five-year period and within three months before the submission of the application to cancel shall, however, be disregarded where the preparations to commence or resume use were taken after the proprietor learned that an application to cancel would be made.”

From the above follows that the rightsholder must often be active and monitor any possible registrations or uses of marks which are similar to the registered trademark as passivity – if the rightsholder knew of, and tolerated, the new mark in Sweden for five consecutive years following the date of registration – may result in side-by-side existence.

In relation to trade dress it could be noted that the scope of protection is determined in the same manner as for traditional trademarks, *i.e.* that an overall assessment of the risk of confusion between the trademark and the allegedly infringing mark (trade dress). A risk of confusion, exists if the marks are identical or at least similar

³³ The user requirement refers to the time after registration. There is no immediate user requirement, and an applicant for a trademark registration must not show that the mark is used or intended to be used.

to each other and concerns the same goods or goods of similar kind. Whether or not there exists a risk of confusion will ultimately be a question for the Courts (PRV). It should also be mentioned that well known marks could have a protection that goes beyond the risk of confusion by which means that the marks may not actually lead to the risk of confusing the average consumer but risks damaging the well-known mark or concerns an unfair use of the mark.³⁴

The judgments from the CJEU is commonly referred to by Swedish Courts and the case by case assessment of the scope of protection of a trademark in an infringement situation will follow EU principles, in particular when it concerns enforcement of an EU trademark.

c. Key elements of infringement cause of action

Regarding the key elements of an infringement cause of action please see section 2 c above regarding design rights. The relevant provisions could be found in Chapter 8 Section 1 – 8 and Chapter 9 of the Trademark Act.

d. Remedies

Regarding available remedies see section 2 d above. The relevant provisions could be found in Chapter 8 Section 1 – 8 and Chapter 9 of the Trademark Act.³⁵

e. Challenges and benefits

The main advantage of a trademark registration or trade dress registration is that it could provide a practically perpetual protection. It is neither uncommon that trademarks also have a high economical and commercial value. However, a trademark owner must always seek to ensure that the trademark is perceived just as a trademark to avoid dilution and the risk that the trademark becomes generic to the goods or services to which the trademark pertains.

Furthermore, see the aspects discussed under section 2 e.

4. Common Law and/or Other Non-Statutory Claim Strategies

N/A.

³⁴ Swedish case law relies on the judgments of the CJEU, whereby the details of the limitation of the protection of a trade dress could be found there.

³⁵ Regarding injunctions (Chapter 8 Section 2), damages (Chapter 8 Section 4 and 5), recall, alteration etc (Chapter 8 Section 7), obligation to distribute information about the judgment (Chapter 8 Section 8). In Chapter 9 the provisions regarding request to provide information and infringement investigation is found.

The Netherlands

Contributor: Jacqueline Schaap, Visser Schaap & Kreijger

INTRODUCTION

1. Copyright Enforcement Strategies

- a. Registration as a pre-requisite to action?

NO. Under Dutch Law (Dutch Copyright Act, or 'Auteurswet'), copyright arises automatically upon creation of a work. In compliance with the Berne Convention, the Copyright Act does not contain any formal requirements to obtain copyright protection, like registration or use of a copyright notice. Copyright is obtained by the mere creation of a work. Therefore, no registration is required to *obtain* copyright, nor is it a pre-requisite to *take action* against infringement of copyright.

- b. Scope of protection

Copyright is the exclusive right (i.e., right of prohibition) of the author of a literary, scientific or artistic work to **make** the work **available** to the public and to **reproduce** it (section 1 DCA). Copyright is assignable in whole or in part. The author, or his successor in title, may grant a licence to a third party for the whole or part of the copyright (Section 2 DCA). Copyright expires after 70 years following the year of the author's death (section 37 DCA)

- c. Key elements of infringement cause of action

Making available to the public (section 12-12b DCA) and/or reproduction (section 13-14 DCA) of a work without prior authorization of the author/copyright owner

- d. Remedies

Prohibition of the infringing use and an action for **damages** (section 27 DCA). In addition to compensation, the author or his successor in title may claim that whoever has infringed his copyright be ordered to **surrender the profits** he has accrued by reason of the infringement, and to render account thereof (section 27a DCA). Other remedies include (among others) the right to request **information** about the origin and distribution channels of the infringing products, **claim as property**, or claim a **recall**, the **destruction** or **rendering unusable** of the infringing products and **disclosure of the judgement** to the public (section 28 DCA), rectification (public announcement of infringement). Please note that EU wide prohibition measures are possible.

- e. Challenges and benefits

2. Design Patent Strategies

Please note we do not have the possibility of Design patents. We just have the possibility of design registrations.

Design Enforcement Strategies

a. Registration as a pre-requisite to action?

Yes and no.

One can choose between a:

- i. **Benelux design**, via the Benelux Office for Intellectual Property (BOIP). The protection will last for a period of 5 years, which can be extended for 4 times, for a period of 5 years each time, up to a maximum of 25 years.
- ii. **Community design**, via the European Intellectual Property Office (EUIPO). Uniform European legislation applies to the community design that offers exclusive protection throughout the entire European Union. The design right offers a maximum of 25 years' protection, and the right must be renewed every 5 years.
- iii. **International design**, via the World Intellectual Property Organization (WIPO). An international design offers protection in a large number of countries throughout the world, i.e., those countries that are affiliated with the Hague Agreement of 1925. Protection may be applied for any number or all affiliated countries. An international design is a 'bundle' of national designs. The protection of the design is therefore subject to the national law of the countries designated when registering.

The exclusive right to a design does **not** arise **automatically** the first time it is used, but by **filing an application/registration** (section 3.5 Benelux Convention on Intellectual Property (BCIP)), but this is "Without prejudice to the right of priority": A right of prior use shall be recognized for third parties who, prior to the filing date for a design or to the priority date, manufactured on Benelux territory products that are identical in appearance to the design filed or that do not produce a different overall impression on an informed user. (Section 3.20 BCIP).

An exception to the rule of registration as a pre-requisite to action is the **unregistered Community Design** (note: the BCIP does not provide for protection of unregistered designs). This type of design right is not established by registration, but arises automatically when **making** a design **available** to the public. A design is protected as an unregistered Community design for a period of three years, starting from the date when the design was first made available to the public within the EU. An unregistered Community Design gives one the right to prohibit third parties from using the design without the owner's authorisation, but only in case of counterfeiting (derivation).

b. Scope of protection

A design shall be protected to the extent that it is **new** and has **individual character** (Section 3.1 BCIP; article 4 Community Design Regulation). A (Community) Design provides an exclusive right to:

- **use** the design: manufacture, provide, trade, sell, supply, lease, import, export, exhibit, use, or have in stock for one of these purposes;
- **prohibit** third parties from using the design without your authorisation.

The scope of the protection conferred by a Community design shall include any design which does not produce on the informed user a different overall impression. In assessing the scope of protection, the degree of freedom of the designer in developing his design shall be taken into consideration. (Article 10 Community Design Regulation)

Excluded from protection are:

- the features of appearance of a product which are solely dictated by its **technical function**.
- the features of appearance of a product which must necessarily be reproduced in their exact form and dimensions in order to permit the product in which the design is incorporated or to which it is applied to be mechanically connected to or placed in, around or against another product so that either product may perform its function. (Section 3.2 BCIP)

c. Key elements of infringement cause of action

The rights holder can take legal action against the sale or manufacture of any design that infringes its design, in the sense that it creates a **similar overall impression** on the informed user.

d. Remedies

Aside from an order to **prohibit** the infringement, the most important available remedies are **damage claims**. The BCIP also provides for the possibility to request a **transfer of profits** made as a result of the infringement and a specification of these profits in case the infringer acted in bad faith. In addition, the rights holder can request all kind of information about the **origin** and sales of the infringing products, the **recall** or **destruction** of the infringing goods, **publication** of the judgement, rectification (public announcement of infringement).

e. Challenges and benefits

3. Trademark/Trade Dress Strategies

a. Registration as a pre-requisite to action?

YES (with the exception of famous trademarks). According to section 2.19 of the Benelux Convention on Intellectual Property (trademarks and designs) (BCIP): "With the exception of the holder of a trademark which is well known within the meaning of Article 6bis of the Paris Convention, and regardless of the nature

of the action brought, no one may claim in court protection for a sign deemed to be a trademark as defined in Article 2.1 (1) and (2), unless that claimant can provide evidence of registration of the trademark which it has filed.

All Dutch civil courts have jurisdiction over claims for infringement of a trademark registered for the Benelux territory (Belgium, the Netherlands, and Luxembourg). Infringement of registered European Union Trademarks (EUTMs) is the sole jurisdiction of the District Court (and the Court of Appeal) of The Hague, unless it concerns preliminary injunction proceedings.

b. Scope of protection

Section 2.20 BCIP:

The owner of a registered trademark can object to:

- a. Use in the course of trade of a sign that is identical to the trademark for goods or services that are identical to those for which the trademark is registered;
- b. use in the course of trade of a sign in respect of which, because it is identical or similar to the trademark and the goods or services covered by the trademark and the sign are identical or similar, there exists on the part of the public a likelihood of confusion that includes the likelihood of association with the trademark;
- c. use in the course of trade of a sign which is identical or similar to the trademark for goods or services which are not similar to those for which the trademark is registered, where the trademark enjoys a reputation in the Benelux territory, where use of the sign without due cause would take unfair advantage of or be detrimental to the distinctive character or the repute of the trademark;
- d. use of a sign for purposes other than those of distinguishing the goods or services, where use of the sign without due cause would take unfair advantage of or be detrimental to the distinctive character or the repute of the trademark.

c. Key elements of infringement cause of action

See answer under b.

d. Remedies

The following remedies are available for trademark infringement:

- order to cease and desist

- i. damages and in case of bad faith lost profit
- ii. accounting of defendant's profits
- iii. information about sales, supplier, distribution channels etc.
- handing over infringing labels, packaging or products;
- destruction;
- publication of the verdict
- recall of infringing products;
- rectification;

Please note that EU wide prohibition measures are possible even in case the defendant is not established in the Netherlands

e. Challenges and benefits

4. Common Law and/or Other Non-Statutory Claim Strategies non existent

Ukraine

Contributor: Mariya Koval, Ilyashev and Partners Ukraine

INTRODUCTION

1. Copyright Enforcement Strategies

- a. Registration as a pre-requisite to action?

No, copyright is not binding to be registered in Ukraine

- b. Scope of protection

Protection is granted to all works (works in the domain of science, literature and art), both promulgated and non-promulgated, finished and unfinished, irrespective of their purpose, genre, volume, goals (education, information, advertising, propaganda, entertainment, etc.)

The legal protection is extended only to the form of expression of a work, and shall not apply to any ideas, theories, principles, methods, procedures, processes, systems, manners, concepts, or discoveries, even if they are expressed, described, explained or illustrated in a work.

- c. Key elements of infringement cause of action

Copyright and (or) related rights infringements that give grounds for seeking remedies shall be:

- a) actions by any person that infringe the personal non-proprietary rights of copyright and (or) related rights holders and their proprietary rights, subject to the proprietary rights restrictions
- b) piracy in the sphere of copyright and (or) related rights - publication, reproduction, importation into the customs territory of Ukraine, exportation from the customs territory of Ukraine, and distribution of counterfeit specimens of works (including computer software and databases), phonograms, videograms and broadcast organization programs;
- c) plagiarism - promulgation (publication), in full or in part, of another person's work under the name of a person who is not the author of this work;
- d) importation into the customs territory of Ukraine, without permission of the persons holding the copyright and (or) related rights, of specimens of works (including computer software and databases), phonograms, videograms and broadcast programs;
- e) actions that pose a threat of infringement of copyright and (or) related rights;
- f) any actions for the intentional circumvention of technical means of protection of copyright and (or) related rights, in particular the production, distribution, importation for distribution and use of means of such circumvention;

- g) forging, altering or eliminating rights-management information, in particular rights-management information in electronic form, without the permission of the copyright and (or) related rights holders or the persons implementing such management;
- h) the distribution, importation into the customs territory of Ukraine for distribution purposes, and broadcast of objects of copyright and (or) related rights from which rights-management information, in particular that in electronic form, has been eliminated or altered without the permission of the copyright and (or) related rights holders;
- e) camcording, cardsharing

d. Remedies

The protection of personal non-proprietary and proprietary rights of copyright and (or) related rights holders shall be effected in compliance with the procedure prescribed by administrative, civil and criminal legislation.

Civil Law Remedies for the Protection of Copyright and Related Rights:

Persons holding copyright and related rights shall have the right to seek protection of their copyright and (or) related rights by lodging claims in compliance with the established procedure with a court of law and other bodies pursuant to their powers.

In the case of violation by any person of the copyright and (or) related rights stipulated in Article 50 of this Law, of non-observance of the conditions for using works and (or) objects of related rights stipulated by contract, for the use of works and objects of related rights in circumvention of technical means of protection or by the forging of rights-management information and (or) documents, or for the creation of a threat of unlawful use of objects of copyright and (or) related rights, and for other infringements of personal non-proprietary and proprietary rights of the persons holding copyright and (or) related rights, persons holding copyright and (or) related rights shall have the right:

- a) to require the recognition and renewal of their rights;
- b) to lodge claims with a court of law requiring renewal of the infringed rights and (or) the termination of actions infringing copyright and (or) related rights or posing a threat of their violation;
- c) to lodge claims requiring reimbursement of moral (non-proprietary) losses;
- d) to lodge claims requiring reimbursement of losses (material damage), including lost profit, or collection of the income derived by the infringer as a result of his violation of copyright and (or) related rights, or payment of compensation;
- e) to require the termination of preparations for an infringement of copyright and (or) related rights, including the suspension of customs procedures, if there is a suspicion that counterfeit specimens of works, phonograms, videograms or means of circumvention might be allowed into or from the customs territory of Ukraine, in compliance with the procedure stipulated in the Customs Code of Ukraine;
- f) to participate in the inspection of the production premises, storage facilities, technological processes and business operations relating to the production of specimens of works, phonograms and videograms with respect to which there are grounds to suspect violation or threat of violation of copyright and (or) related rights;

- g) to require, including by court procedure, the publication in the mass media of information about infringements of copyright and (or) related rights and of court judgments with respect to infringements;
- h) to require the provision, by the persons infringing the claimant's copyright and (or) related rights, of information about third parties involved in the manufacture and distribution of counterfeit specimens of works and objects of related rights or means of circumvention, and the relevant distribution channels;
- i) to require other measures envisioned by legislation, concerning the protection of copyright and related rights.

A court of law shall have the right to issue a resolution or award concerning:

- a) the reimbursement of moral (non-proprietary) damages resulting from an infringement of copyright and (or) related rights, specifying the amount of the reimbursement;
- b) the reimbursement of damages resulting from an infringement of copyright and (or) related rights;
- c) collection from the infringer of copyright and (or) related rights of income derived from the infringement;
- d) the payment of compensation, to be prescribed by the court, in an amount from 10 to 50,000 minimum salaries, in lieu of damage reimbursement or income collection;
- e) a prohibition on the publication of works, their performance or staging, the issuance of specimens of phonograms, videograms, their broadcasts, termination of their distribution, removal into protective custody (confiscation) of counterfeit specimens of works, phonograms, videograms or broadcast programs, as well as equipment and materials for the production and reproduction thereof, publication in the press of the information about the infringement, etc., if, in the course of court proceedings, the fact of copyright and (or) related rights infringement, or the fact of actions posing a threat of infringement of these rights, is proven;
- f) to require the provision, by the persons infringing the claimant's copyright and (or) related rights, of information about third parties involved in the manufacture and distribution of counterfeit specimens of works and objects of related rights, or means of circumvention, and the relevant distribution channels.

Administrative Law Remedies for the Protection of Copyright and Related Rights:

Illegal use of the object of intellectual property rights (**literary or artistic work, their performance, phonograms, broadcast organization, computer program, database**, scientific discovery, invention, utility model, industrial design, mark for goods and services, topography of the integral chips, rationalization proposals, plant varieties, etc.), assignment of authorship to such an object or other intentional violation of rights to the object of intellectual property rights protected by law, entails the imposition of a fine of ten to two hundred tax-free minimum incomes of citizens with the confiscation of illegally manufactured products and equipment and materials that are intended for its manufacture.

Criminal Law Remedies for the Protection of Copyright and Related Rights:

Illegal reproduction, distribution of works of science, literature and art, computer programs and databases, as well as illegal reproduction, distribution of performances, phonograms, videograms and broadcast programs, their illegal replication and distribution on audio and video cassettes, floppy disks, and other media, camcorders, card reader or other deliberate infringement of copyright and related rights, as well as financing such actions, if it caused material damage to a significant extent, shall be punishable by a fine of two hundred to one thousand tax-free minimum incomes, or correctional labor for a term up to two years, or imprisonment for the same term.

2. The same actions, if committed repeatedly, or by prior conspiracy by a group of persons, or caused material damage in a large measure, shall be punishable by a fine of from one thousand to two thousand non-taxable minimum incomes, or correctional labor for a term up to two years, or imprisonment for a term of two to five years.

3. The actions provided for in paragraphs 1 or 2 of this article, committed by an official using the official position or an organized group, or if they caused material damage in a particularly large amount, shall be punishable by a fine of two thousand to three thousand tax-free minimum incomes, or by deprivation of liberty for a term of three to six years, with the deprivation of the right to occupy certain positions or engage in certain activities for a term up to three years or without such.

e. Challenges and benefits

Court proceedings is the most effective way for enforcement.

f. Are works of the applied art (e.g., furniture) protected by Ukrainian Copyright Law?

Yes, the works of the applied art are protected by the Law of Ukraine "On copyright and related rights".

g. May copyright, designs and (shape) trademarks for works of the applied art be enforced cumulatively?

Yes, it is possible to enforce copyright, designs and (shape) trademarks for works of the applied art cumulatively (in one lawsuit) against one defendant or connected defendants.

2. Design Patent Strategies

a. Registration as a pre-requisite to action?

Yes, registration is compulsory

b. Scope of protection

The legal protection is granted to an industrial design that does not contradict the public order, principles of humanity and morals, and complies with the patentability conditions.

The object of an industrial design may be the shape, picture, or coloration, or their combination, which define the appearance of an industrial product and are intended to satisfy aesthetic and ergonomic demands.

c. Key elements of infringement cause of action

A patent may be recognized completely or partly invalid by the court in the following cases:

- (a) nonconformity of a patented industrial design to patentability conditions;
- (b) existence of features that were not presented in the filed application in the aggregate of substantial features of an industrial design;
- (c) grant of a patent as a consequence of filing the application with infringement of rights of third persons.

When having recognized a patent or a part thereof invalid, the Office informs of this in its official bulletin.

A patent or a part thereof which have been recognized invalid are considered null and void from the date of publication of data about the grant of the patent.

Any offence against the rights of the owner of a patent is considered an infringement of rights of the owner of the patent, which entails responsibility in accordance with the current legislation of Ukraine.

On request of the owner of the patent, such an infringement is to be ceased and the infringer is bound to compensate the owner of the patent for inflicted losses.

Restoration of infringed rights of the owner of the patent may also, by his consent, be demanded by a person who/ has acquired a license.

d. Remedies

The protection of rights for an industrial design is provided in the court and another procedure determined by legislation.

The jurisdiction of courts covers all legal relations arising in connection with the application of the Law of Ukraine "On Protection of Rights to Industrial Designs".

Courts, in accordance with their competence, shall resolve, in particular, disputes about:

- authorship of an industrial design;
- determination of a fact of use of an industrial design;
- determination of the owner of a patent;
- infringement of rights of the owner of a patent;
- right to the previous use;
- compensation.

- e. Challenges and benefits

Court proceedings is the most effective way for enforcement.

3. Trademark/Trade Dress Strategies

- a. Registration as a pre-requisite to action?

Trademark - yes, registration is compulsory.

Trade dress – registration is not compulsory (for the purpose of unfair competition procedure), but desirable.

- b. Scope of protection

The legal protection shall be granted to a mark that does not contradict the public order, principles of humanity and morality and is not subject to the grounds for the refusal of the legal protection.

The proprietor of the trademark certificate shall be entitled the right to use the mark and exercise other rights provided by the Law of Ukraine “On the Protection of Rights to Marks for Goods and Services”.

Intellectual property rights to a trademark are:

- 1) the right to use the trademark;
- 2) the exclusive right to authorize the use of the trademark;
- 3) the exclusive right to interfere with the misuse of the trademark, including the prohibition of such use.

- c. Key elements of infringement cause of action

1. If a mark is not used in Ukraine fully or with respect to a part of goods and services listed in the certificate within three years from the date of publishing the information on granting the certificate or from other date after the publication, any person has the right to appeal to the court with a declaration for fully or partially pre-term termination of the certificate validity.

2. A trademark certificate may be fully or partially invalidated by the court in the following cases:

- a) The registered mark does not meet the requirements for granting the legal protection;
- b) The certificate contains elements of the mark reproduction and the list of goods and services that were not presented in the filed application;
- c) The certificate was granted in the result of the filing an application with the infringements of rights of other persons.

If the certificate is considered to be fully or partially invalid, the Institution shall inform about it in its official bulletin.

The certificate or a part of the certificate that have been considered to be invalid, are considered to be those that are out of effect from the date of filing the application.

3. Any offence against rights of the proprietor of a certificate, including the actions that shall be agreed upon with the proprietor of the certificate but are carried out without his consent as well as a preparation for such actions, shall be considered to be an infringement of the rights of the proprietor of the certificate, which shall entail liability according to the legislation of Ukraine currently in force.

The use of the marks and designations in domain names without the certificate proprietor's consent shall be also considered an infringement of the proprietor's rights.

d. Remedies

On the request of the proprietor of the certificate, any offense against rights of the proprietor of a certificate shall be terminated, and the infringer shall indemnify the actual damage to the proprietor of the certificate.

The proprietor of the certificate may also request to remove illegally used mark or sign from goods or goods package, which is so much similar to the mark that the mark and the sign may be confused, or to liquidate the produced reproductions of the said mark or the sign, which is so much similar to it that they may be confused.

The person who was granted a license shall be also entitled to the right to require the restoration of the affected rights of the proprietor of the certificate by the certificate owner consent.

The protection of rights to a mark is provided in courts or under other procedure determined by the legislation.

The jurisdiction of courts covers all legal relations arising in connection with the use of the Law of Ukraine "On the Protection of Rights to Marks for Goods and Services".

The courts, according to their competence, shall resolve disputes regarding:

- determination of the certificate owner;
- conclusion and execution of licensing agreements;
- infringement of the certificate owner rights.

Administrative Law Remedies for the Protection of Copyright and Related Rights:

Illegal use of the object of intellectual property rights (literary or artistic work, their performance, phonograms, broadcast organization, computer program, database, scientific discovery, invention, utility model, industrial design, **mark for goods and**

services, topography of the integral chips, rationalization proposals, plant varieties, etc.), assignment of authorship to such an object or other intentional violation of rights to the object of intellectual property rights protected by law, -

entails the imposition of a fine of ten to two hundred tax-free minimum incomes of citizens with the confiscation of illegally manufactured products and equipment and materials that are intended for its manufacture.

Criminal Law Remedies for the Protection of Copyright and Related Rights:

Unlawful use of the mark for goods and services, trade name, qualified indication of the origin of the goods, or other intentional violation of the right to these objects, if it caused material damage in a significant amount, shall be punishable by a fine of one thousand to two thousand non-taxable minimum incomes of citizens.

2. The same actions, if committed repeatedly, or by prior conspiracy by a group of persons, or caused material damage in a large measure, shall be punishable by a fine of three thousand to ten thousand non-taxable minimum incomes of citizens.

3. The actions provided for in paragraphs 1 or 2 of this article, committed by an official using the official position or an organized group, or if they caused material damage in a particularly large amount, shall be punishable by a fine of ten thousand to fifteen thousand tax-free minimum incomes of citizens with the deprivation of the right to occupy certain positions or engage in certain activities for a term up to three years or without such.

e. Challenges and benefits

Court proceedings is the most effective way for enforcement.

4. Common Law and/or Other Non-Statutory Claim Strategies

Ukraine does not use Common Law provisions and other non-statutory claim strategies are not possible.

United Kingdom

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INTRODUCTION

1. Copyright Enforcement Strategies

a. Registration as a pre-requisite to action?

Copyright is a right that occurs automatically as soon as a work is recorded, provided the relevant criteria are met. It is not necessary to register this right in

order to enforce it. The copyright symbol i.e., © is optional but frequently used as a means of putting people on notice of copyright and discouraging copying.

b. Scope of protection

Copyright protects original literary, dramatic, musical or artistic works, plus sound recordings, films, broadcasts or typographical arrangements. It is the protection that copyright affords 'artistic works' which is most applicable to designs. A Work of applied art (e.g., furniture) is protected by UK copyright law to the extent it constitutes a work of artistic craftsmanship (WAC) or a sculpture. Artistic quality is required to qualify as a WAC but not as a sculpture (although artistic intent is relevant). In any event, mass-produced and primarily functional objects are unlikely to be protected in this way.

Copyright, rights in designs, (shape) trademarks and passing off may be enforced cumulatively with respect to works of applied art. But to the extent copyright and UK unregistered design right subsists in the same work, the claimant must bring a copyright claim.

c. Key elements of infringement cause of action

Copyright is not a monopoly right and therefore it is necessary to prove direct or indirect copying of the whole or "substantial" part of the work.

"Substantial" is a qualitative not quantitative assessment, and therefore if the most interesting or important part of the work is copied it does not matter if this is only a small proportion of the work as a whole.

d. Remedies

Remedies include search orders, freezing orders, interim injunctions, delivery up of goods, seizure of infringing copies, final injunctions and damages or an account of profits.

e. Challenges and benefits

Challenges:

- It is necessary to prove copying in an infringement claim.

Benefits:

- There is no requirement for registration associated with copyright.

2. Design Patent Strategies

a. Registration as a pre-requisite to action?

In the UK Design Patents do not exist; instead, there are registered design rights. At the time of writing, it is possible to enforce UK registered designs (UKRDs) and Registered Community Designs (RCDs) in UK actions but this will change following the UK's exit from the EU. The UK will, automatically and for free, create new UK registered designs equivalent to all RCDs on the register at the exit date (note that any RCD applications still pending at exit date will not benefit from this). It is necessary to register designs in order to enforce UKRDs and RCDs but unregistered design rights which do not require any form of registration may also be enforced in the UK. Unregistered design rights are discussed in more detail below.

b. Scope of protection

UKRDs and RCDs protect the appearance of the whole or part of a product resulting from the lines, contours, colors, shapes or texture of the product itself or ornamentation. They do not protect features which are dictated solely by technical function nor features of shape that allow for items to be mechanically connected to or fit in or around or against another article.

c. Key elements of infringement cause of action

A registered design can be enforced against identical designs and non-identical designs that create the same overall impression on the "informed user". The informed user is a notional person who uses the product, is particularly observant, has knowledge of the design features normally included in the designs in question and is aware of design freedom constraints.

Registered designs are monopoly rights and therefore there is no requirement to prove copying when enforcing a registered design right. However, it is common for the validity of a design registration to be challenged in response to a design infringement claim.

In order for a registered design right to have been infringed, an infringing act must have been committed. This will occur when another person 'uses the design' for commercial purposes without consent. Specified acts of infringement include making, offering for sale, importing, exporting or stocking a product in which the design is incorporated.

d. Remedies

Remedies include search orders, freezing orders, interim injunctions, delivery up of goods, seizure of infringing copies, final injunctions and damages or an account of profits.

e. Challenges and benefits

Challenges:

- It is necessary to apply for registration and pay a small registration fee.
- UK and EU registered designs must be registered within 12 months of the first date of public disclosure of the design.

- Registration of a design internationally can be very complex as different countries have different rules regarding grace periods. This means it is possible to jeopardize protection in certain countries if you prematurely or incorrectly apply for registration in other countries.

Benefits:

- Registered designs are monopoly rights and so there is no need to prove copying.
- There is no substantive examination meaning it is relatively easy and quick to obtain a registration (though the registration may be found invalid at a later date if challenged by a third party).
- It is a relatively inexpensive right (i.e., much cheaper than patents and cheaper than trademarks).
- There is no requirement for use of a design for the registration to remain valid.

3. Trademark/Trade Dress Strategies

Trade Dress is not, as such, an available cause of action in the UK. This section therefore focuses exclusively on trademarks. Trade dress claims are often brought as 'passing off' claims, discussed further below.

a. Registration as a pre-requisite to action?

Registration is a pre-requisite to an action for registered trademark infringement (but see below for 'passing off' claims based on unregistered trademarks). Three- and two-dimensional designs can be registered as trademarks, though it is challenging to obtain a trademark registration for a three-dimensional design. It should be noted that two-dimensional designs may also be registered as UKRDs and RCDs: this is a useful way of obtaining protection for a company logo which is not able to benefit from trademark registrations (i.e., because it does not have the necessary acquired distinctiveness, or to cover the gap before registration).

b. Scope of protection

A trademark registration protects any sign capable of being represented graphically, which is capable of distinguishing goods or services of one undertaking from those of other undertakings. This includes but is not limited to figurative marks, word marks and three-dimensional marks.

It should be noted that whilst designs such as packaging can be protected using a three-dimensional trademark, as alluded to above, case law indicates that it is harder to establish distinctive character of a three-dimensional mark representing the shape of a product than a word mark or figurative mark.

At the time of writing there are three ways of obtaining registered trademark protection covering the UK: (i) a UK registered trademark (UKTM); (ii) an EU registered trademark (EUTM); or (iii) an internal registration designating the UK. After Brexit, EUTMs will cease to cover the UK. The UK will, automatically and for free, create new UK registered trademarks equivalent to all EUTMs on the register

at the exit date. Note that any EUTM applications still pending at exit date will not benefit from this, but there will be a 9-month period during which EUTM owners can apply for national UK registrations claiming priority from such EUTM applications.

c. Key elements of infringement cause of action

A trademark is infringed by the use in the course of trade without the trademark owner's consent of:

- an identical sign used in relation to identical goods or services;
- an identical or similar sign with a reputation used in relation to any goods; or
- a similar sign used in relation to identical goods and services (or vice versa) where there is a "likelihood of confusion".

In particular, the visual, aural or conceptual similarity of the marks must be considered, which should be based on the overall impression given by the marks, taking into account their distinctive and dominant components. "Use" of a mark includes, but is not limited to, affixing the sign on any goods or packaging, selling the goods under the sign, and using the sign in advertising.

d. Remedies

Remedies for trademark infringement include injunctions, damages or an account or profits, order for erasure or obliteration of offending signs from infringing materials, and orders for delivery up and destruction of offending goods.

e. Challenges and benefits

Challenges:

- Registering trademarks is more expensive than registering design rights.
- It is hard to obtain trademark registrations for three-dimensional designs representing the shape of goods or their packaging.
- Use is required to avoid the mark being vulnerable to a revocation action.
- Questions arise about whether there has been any relevant "use" of a trademark such as to affect its functions, which do not arise in a registered design action

Benefits:

- Provided that the trademark is renewed correctly registered trademark protection can be indefinite.

4. Common Law and/or Other Non-Statutory Claim Strategies

Unregistered design rights.

a. Registration as a pre-requisite to action?

Unregistered design right, like copyright, occurs automatically if the relevant criteria are met. At the time of writing there are two unregistered design rights available in the UK: the UK unregistered design (UKUDR) and the unregistered community design (UCD). After Brexit, any new UCD will cease to cover the UK. The UK has provided that UCD in existence at the exit date will continue to have the benefit of a UK right having the same level of protection as UCDs. This right will expire on the same day as it expires in the EU, meaning that its maximum duration will be three years.

b. Scope of protection

UK unregistered design right protects original designs which are not commonplace. Unlike the UKRD and UCD which provide for the same scope of protection, the scope of protection afforded by UKUDRs and UCDs is different. The key difference between UCDs and UKUDRs is that UCDs provide for protection of two-dimensional designs and UKUDRs do not.

c. Key elements of infringement cause of action

An unregistered design right can only be infringed if there is direct or indirect copying (conscious or subconscious). Nevertheless, as with copyright, a rebuttable presumption of copying exists where there is sufficient similarity between the allegedly infringing article and the design, and it can be demonstrated that defendant had an opportunity to copy.

Secondly, an infringing act must have occurred. Such acts include: the reproduction of an article to the design or creating a record of the design for the purposes of creating articles from the design, without the right holder's consent.

d. Remedies

Remedies for unregistered design right infringement include injunctions, delivery up or destruction of goods, and damages or an account of profits.

e. Challenges and benefits

Challenges:

- Duration of an unregistered design right is much shorter than the full term of protection for a registered design.
- Requirement to establish copying in an infringement claim.

Benefits:

- Unregistered design rights occur automatically so there is no need to register the right and there are therefore no registration fees.
- Flexibility in framing the "design" for which unregistered design protection is claimed.

Uzbekistan

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INTRODUCTION

Uzbek Copyright Law provides protection of designs as an applied art, nevertheless, threshold of such protection mainly depends on proving copyrightable subject-matter. As with regards to enforcement of design through copyright, there is a requirement to collect enough evidence to prove authorship related to copyright. It is also possible to protect the design through 3D mark registration as a trademark, which usually takes less time than obtaining patent for design, however 3D mark has to be distinctive, purely functional shapes are not registrable as trademarks.

Obtaining patent for design can be also considered as an option of protection. The scope of protection is limited to the substantive features of design, rather than a visual representation of design. Uzbek legislation does not prohibit enforcing all 3 kinds of rights (copyright, design patent and trademark).

In Uzbekistan trademark, design patent and copyright infringement actions are to be brought before economic and civil courts also, current legislation permits administrative actions to be initiated by the authorized state body (Intellectual Property Agency). When dealing with intellectual property cases courts tend to involve experts, either upon court's own initiative or parties' request. Intellectual Property Agency (furtherly referred to as the "Agency") is usually involved by the court to give an expert opinion when dealing with IPR infringements. Experts from the Agency usually lack objectiveness, especially when conflicting mark or design had been granted protection.

1. Copyright Enforcement Strategies

- a. Registration as a pre-requisite to action?

Copyright registration is not a pre-request to action.

- b. Scope of protection

Law on Copyright and Related Rights of Uzbekistan presumes moral and economic rights.

The moral rights include:

- right to claim authorship
- right to the author's name (i.e., to indication of the author's name, author's pseudonym or keeping anonymity)
- right of disclosure
- right of integrity
- right to access the original work of visual art
- right to retract.

The economic rights include the following:

- reproduction

- distribution
- translation
- right of adaptation, arrangement and other alterations
- communication to the public
- making available to the public
- rental
- importation
- broadcasting
- rebroadcasting
- communication by wire
- demonstration before public
- public performance
- right of remuneration.

c. Key elements of infringement cause of action

- The work is eligible for copyright protection in Uzbekistan;
- term of copyright protection has not expired;
- unlawful use of the copyrighted subject matter.

d. Remedies

- restitution
- damages including for moral harm & economic loss
- administrative fines, however the procedure is not smooth and well-established.
- seizure and destruction of infringing copies
- seizure of materials and equipment used for committing the infringement
- publication about the court decision in respect of the infringement with indication of the infringer.

e. Challenges and benefits

Benefits of design to be protected through copyright includes:

- longer term of protection (life of the author+ 50 years after the author's death);
- automatic protection in foreign countries (possibility to enforce copyright in any member state of Berne Convention);
- no registration requirement;
- if copyrighted work is famous in Uzbekistan, it enjoys priority over conflicting trademark registration and such registration may be subject to the cancellation action within 5 years followed from the trademark publication date based on relative grounds. Art. 10 (14) of the *Law on Trademarks, Service Marks and Appellations of Origin* provides that trademark shall not be registered if it is identical or confusingly similar to the titles of works of science, literature and art, which are famous in the Republic of Uzbekistan, as well as their characters and quotations therefrom, works of art or their fragments, without the permission of the copyrights holder or his successors (heirs). Said Law does not define "famous" criteria;

- in case of work made for hire author automatically gets back all economic rights after 10 years the work had been communicated to the public or earlier upon employer's consent, whereas employer retains its right to be indicated on any use associated with the work.

Due to absence of copyright registration requirement, associated challenges are:

- proving that the work is copyrightable;
- proving the authorship over the work;
- proving the date the work has been created on.

2. Design Patent Strategies

a. Registration as a pre-requisite to action?

Design patent is a pre-requisite to action.

b. Scope of protection

The Law on Inventions, Utility Models and Industrial Designs of Uzbekistan provides protection of design through the enforcement of exclusive rights, namely:

- unauthorized production, use, import, sale, offer for sale and any use for the purpose of placing the product into the commercial circulation or storage of the product;
- the protection of design is granted through the set of substantive features derived from the image of a design.

c. Key elements of infringement cause of action

- Patent for design has been granted;
- The design patent is valid (the validity term is 10 years which is extendable for 5 additional years, therefore the maximum protection period of the design is 15 years only);
- Infringement of exclusive rights of the patent owner (use of all substantive features depicted in the design patent in the infringing product).

d. Remedies

- injunctions
- fines and damages for economic loss
- administrative fines, however, the procedure is not smooth and well-established
- seizure and destruction of infringing goods
- seizure of materials and equipment used for committing the infringement
- publication of judicial decision.

e. Challenges and benefits

The benefits of enforcement of intellectual property rights through design patent are:

- no need to prove ownership;
- no need to prove the date of creation of the work;
- prior design rights enjoy protection over trademarks.

The challenges are:

- patents enforceable only in Uzbekistan;
- shorter term of protection;
- costs for obtaining a patent and keeping it valid;
- limited scope of protection. The protection is granted within the set of substantive features, which sometimes may differ from the image of a design.

3. Trademark/Trade Dress Strategies

a. Registration as a pre-requisite to action?

Trademark registration is a pre-requisite to trademark infringement action.

b. Scope of protection

The *Law on Trademarks, Service Marks and Appellations of Origin* of Uzbekistan provides the following scope of protection:

- registration or use of mark which is identical to trademark in relation to similar goods/services;
- registration or use of mark which is confusingly similar to trademark in relation to similar goods/services;
- registration or use of a false mark by means of creating public confusion.

c. Key elements of infringement cause of action

- valid trademark registration;
- use by a third party of a confusingly similar/identical mark in respect of the similar goods/services covered by the trademark registration;

d. Remedies

- injunctions
- fines and damages for economic loss
- administrative fines, however, the procedure is not smooth and well-established
- seizure and destruction of infringing goods
- seizure of materials and equipment used for committing the infringement

- publication of judicial decisions.

e. Challenges and benefits

Benefits of trademark registration are:

- no need to prove ownership of rights;
- no need to prove date of creation of such rights;
- possibility to indefinitely renew trademark registration.

The challenges are:

- use requirement;
- similarity of goods/services;
- protection limited to the territory of Uzbekistan only;
- trademarks incorporating functional designs are usually not protectable and can be challenged.

- Common Law and/or Other Non-Statutory Claim Strategies

Common law or other non-statutory claims are not applicable to Uzbekistan.