



European Communities Trade Mark Association

By Email to: trade-acta-meeting@ec.europa.eu

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ECTA supports ACTA

1. Brief introduction of ECTA and its goals

The European Communities Trade Mark Association (“ECTA”) brings together approximately 1.400 persons coming from 85 countries. All of them are practising professionally in the Member States of the European Community in the field of trade marks, designs and related IP matters. These professionals are trade mark advisors, trade mark attorneys, lawyers practising in industry and all others who can be considered specialist practitioners in these areas. ECTA is therefore, an association made up of individuals coming from industry and from private practice.

ECTA acts as an informed interlocutor on all problems relating to the protection and use of trade marks and designs in the European Union.

2. General statements of support

ECTA enthusiastically welcomes the launch of the initiative to establish ACTA. Without any doubts, counterfeiting is an increasing threat to our knowledge-based economy. Significant progress has been made in the last years to tackle the problem internationally, following from the 1994 TRIPS Agreement. Over the last decade, the EU has achieved great results in this field, going much further than TRIPS. However, the continuous growth of the counterfeiting problem has shown that further measures are needed. ECTA is of the view that the so-called ‘best practice’ approach, which would consist of taking into account the most adequate of the respective legal systems of the future ACTA signatories, would be the most effective way of tackling the challenges.

3. Topics which should be addressed

ECTA believes that the following non-exhaustive list includes the topics that should be addressed by ACTA.

- A. Definition of counterfeiting: serious type of IPR infringement, which deserves to be treated as a crime as such

Counterfeiting and piracy do not only affect individual's property rights, but also harm major public interests, like innovation and creativity, consumers' health and safety, employment, social welfare, taxable income. As such, counterfeiting and piracy ought to be considered as a crime.

- B. Criminal measures: consideration of counterfeiting as a crime

ACTA should compel its signatory countries to provide for standards for effective, proportionate and deterrent criminal sanctions in relation to counterfeiting and piracy. Adequate procedures and remedies under criminal law, ensuring a proper prosecution of IP crimes, should be put in a place. ACTA member states should be free to provide for more severe penalties, including imprisonment terms, in those cases where the consumers' safety or health is being endangered.

The EU's efforts which have been made so far in trying to implement a harmonised system of criminal sanctions (cf. draft directive on criminal measures aimed at ensuring the enforcement of IP rights infringements) could contribute to the discussion on global measures to deal with IP crime.

Profits made through the infringing products should be forfeited and allocated to the rights holders to the extent of the damages which they have actually suffered.

- C. Civil measures

- (i) Best practices

Strategies for a successful protection of IP rights from ACTA member states should be imposed on ACTA members. This includes, at the very least: temporary and preliminary injunctions enabling the rights holders to prevent or oppose the distribution and commercialisation of infringing products and to obtain information concerning the distribution network or channels of trade; discovery and search and seize procedures; in addition to ordinary proceedings. The rights holders should be entitled to avail themselves of all the above remedies, both against counterfeiters and against service providers, regardless of the bad faith of the defendants.

- (ii) Damages

All damages caused to rights holders as a consequence of an IP infringement should be fully compensated. This includes, at least, lost profits, harm to goodwill and reputation, all procedural costs, including lawyers fees and investigation costs.

- (iii) Destruction

Counterfeited and pirated products should be confiscated and destroyed at the infringer's cost.

D. Customs measures

The Customs Authorities of the ACTA member countries should be entitled to carry out checks on goods found:

- (i) at import and export, whilst in transshipment or placed under a suspensive customs procedure (including transit, placing into free zones or free warehouses, placing under an inward processing procedure)
- (ii) under the control of intermediaries / transport companies, etc
- (iii) ex officio

A simplified procedure for the seizure and destruction of goods should be mandatory.

E. Internet-related issues

- (i) Intermediaries

The prevalence of counterfeit products for sale through the internet has given rise to serious concerns about the activities of intermediaries and other third party service providers. Serious consideration should be given to control the activities of these persons and to make them responsible for their actions.

- (ii) Multi-jurisdiction conflict: cross-border measures

Consideration should also be given to measures aiming to facilitate cross border enforcement of IP rights and to deal with jurisdiction over infringements occurring over the internet.

F. International cooperation

(Enhanced) cooperation and exchange of information should be promoted and achieved between law enforcement authorities of ACTA members, and between these authorities and rights holders.

4. ECTA

As a qualified representative of IP rights holders and practitioners, ECTA offers its collaboration and looks forward to seeing that its opinion is taken into consideration by the Commission.

If you have any questions in this regard or if we can assist you in any other way, please feel free to contact us again.

Yours sincerely,



Mireia Curell
President



Ignacio D Rivera Elzaburu
Chair of the Anti-Counterfeiting Committee