



Promoting Intellectual
Property Rights in the
ASEAN Region

IPR PROTECTION FROM A CIVIL LAW PERSPECTIVE

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FOREWORD

TRIPS Agreement: minimum standards agreement (Article 1) →

Members are obliged to provide for the standards of protection set out in the Agreement, i.e.:

- Level of protection must be respected (the various rights have to be recognized)

- Enforcement of rights must comply with the TRIPS standards

Members can provide more extensive protection if they so wish

Members are free to determine the appropriate method of implementing the provisions of the Agreement within their own legal system and practice

FOREWORD

PART III. ENFORCEMENT OF INTELLECTUAL PROPERTY RIGHTS

Article 42: “Members shall make available to right holders civil judicial procedures concerning the enforcement of any intellectual property right covered by this Agreement [...]”

CIVIL REMEDIES

Injunctions

Damages

Other Remedies

PROVISIONAL MEASURES

CIVIL REMEDIES AGAINST IPRs INFRINGEMENTS

Injunctions (Article 44):

Order to desist from an infringement

Exception allowed for goods acquired in good faith

Damages (Article 45):

Adequate compensation for the injury suffered by the right holder because of an infringement by an infringer who knew or should have known that he was engaged in an infringing activity

In appropriate cases, where the Members authorize it, **recovery of profits** and/or payment of **pre-established damages** (statutory damages) EVEN where the infringer did not knowingly, or without reasonable grounds to know, engage in infringing activity

Judicial expenses, which may include appropriate attorney's fees

CIVIL REMEDIES AGAINST IPRs INFRINGEMENTS

Other remedies: seizure and destruction (Article 46):

Judicial authorities shall have the authority to order that:

Infringing goods be disposed of outside the channels of commerce or, unless it would be contrary to the constitutional principles, **destroyed**, without any compensation;

Materials and implements the predominant use of which has been in the creation of the infringing goods **be disposed of outside the channels of commerce**, without any compensation

Need for proportionality between the seriousness of the infringement and the remedies ordered, as well as the interests of third parties

Indemnification of the defendant where the plaintiff have abused enforcement procedures (Article 48)

CIVIL REMEDIES AGAINST IPRs INFRINGEMENTS

PROVISIONAL MEASURES (Article 50)

Judicial authorities must have the authority to order **prompt and effective** provisional measures in order to:

- (a) **prevent infringements** from occurring; and
- (b) **preserve relevant evidence** regarding the alleged infringement

Provisional measures **may be ordered inaudita altera parte** ("*ex parte*", i.e., without hearing previously the alleged infringer), where any delay is likely to cause irreparable harm to the right holder, or where there is a demonstrable risk that evidence might be destroyed

Requirements:

- Reasonably available evidence
- Security or equivalent assurance "sufficient to protect the defendant and to prevent abuse"

PRACTICAL ISSUES IN ADJUCATING CASES

Judge's main tasks in practice when trying a case

- Fix the facts
- Assess those facts from a legal point of view
- Establish the specific consequences

Issues arise in IP proceedings regarding assessment of:

- Notional concepts used by the law in defining the relevant conduct (“likelihood of confusion on the part of the public”, “common general knowledge”, “person skilled in the art”)
- Evidence – Expert evidence
 - Role of the expert: Illustrate the court and the parties on those matters that require technical knowledge, NOT elucidate legal questions
 - Appraisal by the Court: assess the outcome of the expert opinion, taking into consideration not only conclusions, but also materials, explanations and analysis on which conclusions are based

PRACTICAL ISSUES IN ADJUCATING CASES

... In doing so, issues arise in IP proceedings regarding assessment of:

- Damages calculation – Adequacy
 - European Union: scheme for calculating damages laid down in Directive 2004/48, of 29.04.2004
 - Applies to any infringement of IPRs as provided for by EU law/national law of Member States
 - Principle of restitutio naturalis → no room for punitive damages
 - Statutory damages are not envisaged.
 - Twofold damages calculation scheme AT THE CHOICE OF THE INJURED PARTY:
 - (1) Negative economic consequences, including right holder's lost profits and unfair profits made by the infringer (non-cumulative)
 - (2) License analogy
- Moral prejudice

PRACTICAL ISSUES IN ADJUCATING CASES

Issues related to interpretation of IP laws

- Brand new laws
- (In many cases) New institutions – no precedents
- Due regard to international law must be given
- Need for interpretation in harmony with international conventions
- Need for keeping abreast with the developing IP international law
- Consistency with other jurisdictions



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