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**SYNTHESISOFISSUES CONCERNINGDIFFICULT IESANDPRACTICES
INTHEFIELD OFENFORCEMENT**

DocumentpreparedbytheSecretariat

TABLE OF CONTENTS

	<u>Paragraphs</u>
I. INTRODUCTION.....	1 to 6
II. IDENTIFY DIFFICULTIES IN ENFORCEMENT OF INDUSTRIAL PROPERTY IN ALL MEMBER STATES (INDUSTRIALIZED COUNTRIES, DEVELOPING COUNTRIES AND COUNTRIES IN TRANSITION), INCLUDING DIFFICULTIES IN IMPLEMENTATION OF THE PROVISIONS OF THE TRIPS AGREEMENT ON ENFORCEMENT OF INDUSTRIAL PROPERTY AND QUESTIONS RELATED TO <i>EX OFFICIO</i> ENFORCEMENT PROCEDURES.....	7 to 41
A. Lack of National Coordination.....	11
B. Need for International Cooperation.....	12
C. Close Connection with Private International Law.....	13
D. Lack of Awareness on the Side of the Public.....	14
E. Training Needs.....	15
F. Judicial Issues.....	16 to 20
(a) High Cost of Litigation.....	16
(b) Complex and slow procedures.....	17
(c) Backlogs in intellectual property offices and the overdue publication of registered intellectual property rights.....	18
(d) Provisional measures.....	19 and 20
G. Damages.....	21 to 24
H. Evidentiary Rules.....	25 to 27
I. Lack of Alternative Dispute Resolution Systems.....	28
J. Border Enforcement.....	29 to 34
(a) The lack of cooperation on the side of right holders following <i>ex officio</i> action.....	30
(b) Lack of human resources, technical equipment and storage space for confiscated goods.....	31
(c) Infringing items are too often placed back in circulation.....	32
(d) Requirements for excessive security bonds in provisional remedies.....	33
(e) No legal basis for <i>ex officio</i> action.....	34
K. Criminal Action.....	35 to 38
(a) Instituting a criminal action.....	35
(b) Criminal penalties do not provide effective deterrence.....	36
(c) Law enforcement authorities do not have adequate investigatory and coercive powers.....	37
(d) Lack of training and awareness.....	38
L. Information.....	39 and 40
(a) Legal procedures to obtain information from the infringers are missing.....	39
(b) The potential of court rulings in raising public awareness is not being used	40
M. Regulation of Optical Media Manufacturing.....	41

Paragraphs

III. IDENTIFY EFFECTIVE OR BEST PRACTICES FOR ENFORCEMENT OF INDUSTRIAL PROPERTY IN MEMBER STATES, INCLUDING EFFECTIVE PRACTICES FOR IMPLEMENTATION OF THE PROVISIONS OF THE TRIPS AGREEMENT ON ENFORCEMENT OF INDUSTRIAL PROPERTY, IN PARTICULAR, LESS COSTLY AND TIME-CONSUMING PRACTICES FOR EFFECTIVELY ENFORCING RIGHTS.....	42 to 78
A. National Cooperation and Coordination.....	42 and 43
B. Intellectual Property Offices as Contact Points and Information Providers.....	44
C. International Cooperation.....	45 and 46
D. Public Awareness and Cooperation.....	47
E. Right Holder Cooperation.....	48
F. Judicial Procedure.....	49 to 62
(a) Provisional measures.....	50 to 53
(b) Damages.....	54 and 55
(c) Evidentiary rules.....	56 to 58
(d) Surrender of profits and destruction of goods and/or implements.....	59
(e) Recall of infringing goods and list of customers.....	60
(f) Legal costs.....	61
(g) Nullification of intellectual property rights.....	62
G. Border Measures.....	63 and 64
H. Criminal Procedures.....	65 to 67
I. Information.....	68
J. Publication of Court Decisions.....	69
K. Specialized Courts, Training and Intellectual Property Reference Library.....	70 and 71
L. Accelerated Procedures.....	72
M. Mediation and Arbitration.....	73
N. Issue of Jurisdiction.....	74
O. Infringing Goods at Exhibitions.....	75
P. Regulation of Optical Media Manufacturing.....	76 to 78
IV. INTERNET ENFORCEMENT ISSUES.....	79 to 83

I. INTRODUCTION

1. During the First Session of the *Advisory Committee on Enforcement of Industrial Property Rights (ACE/IP)* held in Geneva on October 19 and 20, 2000, the ACE/IP proposed that the International Bureau initiate four studies as set forth in paragraph 8(e)(iv) of WIPO document ACE/IP/1/3 (Summary by the Chair).

2. The Joint Meeting of the *Advisory Committee on Enforcement of Industrial Property Rights* (Second Session) and of the *Advisory Committee on Management and Enforcement of Copyright and Related Rights in Global Information Networks* (Third Session), held in Geneva from December 18 to 20, 2001, was concluded with a Summary by the Chair¹. In paragraph 1 of the Summary by the Chair, adopted by the Advisory Committees, it was stated that “[T]he Advisory Committees unanimously agreed that the issue of enforcement of intellectual property rights was of great importance to all countries. The Committees also agreed that the World Intellectual Property Organization (WIPO) was in a particularly appropriate position to gather information concerning enforcement of intellectual property rights and to coordinate activities undertaken by the Committees jointly with various intergovernmental and non-governmental organizations aiming at establishing adequate and effective enforcement systems.”

3. Pursuant to the above, the International Bureau transmitted a “Request for Information”² to Member States and Organizations invited as Observers to the ACE/IP meeting. To date, responses were received from 24 Member States³, two intergovernmental and 1 non-governmental organizations⁴. It was understood, following the Summary by the Chair⁵ subsequent to the Joint Meeting of both Advisory Committees mentioned in paragraph 2 above, that the responses would relate, horizontally, to the field of industrial

¹ WIPO Document ACE/IP -ACMEC/3.

² WIPO Circular 6562, dated July 17, 2001.

³ Australia, Austria, Barbados, Czech Republic, Colombia, Guatemala, Hungary, Ireland, Japan, Kyrgyz Republic, Mexico, Netherlands, Pakistan, The former Yugoslav Republic of Macedonia, Spain, Russian Federation, Saint Lucia, Switzerland, Trinidad and Tobago, Turkey, United Kingdom, Ukraine, United States of America and Viet Nam.

⁴ The European Communities and the World Health Organization (WHO).

⁵ Brazilian Intellectual Property Association (ABPI); Anti-Counterfeiting Group (ACG) United Kingdom; American Intellectual Property Law Association (AIPLA); *Asociación Latinoamericana de Integración* (ALADI), Uruguay; CEDIQUIFA, Argentina; European Writers' Congress (EWC), Spain; *Fédération Internationale des Conseils en Propriété Industrielle* (FICPI); International Anti Counterfeiting Coalition (IACC), United States of America; International Chamber of Commerce (ICC), France, on behalf of organizations from Colombia, Peru, and Morocco; International Federation of the Phonographic Industry (IFPI), United Kingdom, on behalf of the following organizations: Business Software Alliance (BSA), International Federation of Film Producers Associations (FIAPF), International Publishers Association (IPA), Interactive Software Federation of Europe (ISFE), International Video Federation (IVF), Motion Picture Association (MPA) and International Intellectual Property Society (IIPS), United States of America.

⁶ WIPO document ACE/IP -ACMEC/3.

property as well as to copyright and related rights. Paragraph 1(c) of the Summary by the Chair⁷ reads as follows:

“(c) as regards the preparation of model enforcement provisions and practices, and the resolution of problems and difficulties, etc., in the enforcement field, the Advisory Committee:

(i) recommended that Member States, in particular those which had not already done so, and international, intergovernmental and non-governmental organizations in both the industrial property and the copyright fields be invited to submit comments, observations and suggestions to the International Bureau by February 28, 2002;

(ii) requested the International Bureau to prepare, primarily on the basis of the information received from Member States and international, intergovernmental and non-governmental organizations, a structured synthesis of issues concerning practices in the enforcement field, including Internet enforcement issues, and relating to the possible future work referred to in the introductory part to paragraph 1(c), which would serve as a basis for discussion at the next WIPO meeting on enforcement in 2002. That documents should not be confined to legal aspects only but also include all matters raised by the governments and relevant organizations;

(iii) requested the International Bureau to establish a list of contact points on the basis of the list of participants of the meeting and subsequently extended based on additional information from governments.”

4. The current document is based on the responses to Request I “[I]dentify difficulties in enforcement of industrial property in all Member States (industrialized countries, developing countries and countries in transition), including difficulties in implementation of the provisions of the TRIPS Agreement on enforcement of industrial property and questions related to ex officio enforcement procedures” and Request II “[I]dentify effective or best practices for implementation of the provisions of the TRIPS Agreement on enforcement of industrial property, in particular, less costly and time-consuming practices for effectively enforcing rights” of the Request for Information, referred to in paragraph 3, above. The purpose of the Request for Information was to assist the ACE/IP-ACMEC to identify issues for discussion and areas where international cooperation in the framework of WIPO appears to be both necessary and realistically achievable. The present document also makes reference to interventions made during the Joint Meeting of the Advisory Committee on Enforcement of Industrial Property Rights (Second Session) and of the Advisory Committee on Management and Enforcement of Copyright and Related Rights in Global Information Networks (Third Session), held in Geneva from December 18 to 20, 2001. As was requested in the Summary by the Chair, the present document establishes a list of contact points on the basis of the list of participants of the first ACE/IP-ACMEC joint meeting. The views and opinions contained in the present document reflect only those which were expressed during the ACE/IP-ACMEC meeting and in the responses received on account of the “Request for Information”; the Secretariat has neither embellished the content of those responses, nor inserted its own views herein.

⁷ WIPO document ACE/IP-ACMEC/3.

5. The phenomenon of counterfeiting and piracy of intellectual property rights is a serious international problem, with confirmed links to other forms of organized crime. Counterfeiting and piracy have been shown to cause multi-billion dollar losses annually to right holders and industry, and have had, in some instances, devastating consequences on public health and safety. Member States also suffer considerable losses in the form of lost tax revenues, lost employment opportunities, and lost investments. The responses unanimously supported the proposition that this problem, of global nature, can be fought more successfully if right holders have adequate legal rights and remedies, including effective criminal and civil enforcement provisions. A global approach to address the problem was deemed necessary, because counterfeiters and pirates take advantage of inconsistencies and weaknesses in national laws to organize their operations to avoid detection, prosecution and sanctions. The responses further asserted that counterfeiters and pirates benefit from the lack of appreciation for intellectual property rights, not only on the side of law enforcement agencies, but also on the side of the consumer public.

6. Holders of intellectual property rights often own and manage a portfolio of rights that includes both industrial property and copyright and related rights. Moreover, most of the practical problems are the same in respect to the enforcement of industrial property rights and in respect to the enforcement of copyright and related rights. The responses suggested that the fight against counterfeit goods and pirated copyright works should be a coordinated one, embracing all the relevant stakeholders and including all the protectable intellectual property rights. Therefore, in the present document, unless expressly excluded, the term "counterfeit goods" also includes "pirated copyright works" and *vice versa*. Finally, references to "national intellectual property offices" should be understood to incorporate both *industrial property* and *copyright* offices.

II. IDENTIFY DIFFICULTIES IN ENFORCEMENT OF INDUSTRIAL PROPERTY IN ALL MEMBER STATES (INDUSTRIALIZED COUNTRIES, DEVELOPING COUNTRIES AND COUNTRIES IN TRANSITION), INCLUDING DIFFICULTIES IN IMPLEMENTATION OF THE PROVISIONS OF THE TRIPS AGREEMENT ON ENFORCEMENT OF INDUSTRIAL PROPERTY⁸ AND QUESTIONS RELATED TO *EX OFFICIO* ENFORCEMENT PROCEDURES

7. In general, the responses indicated that in many Member States, the principal barrier to eliminating counterfeiting and piracy does not subsist in the substantive law⁹, but rather in the

⁸ Subsequent to the Summary by the Chair, WIPO document ACE/IP -ACMEC/3, the Request for Information was not limited to issues of industrial property, but dealt horizontally with issues relating to copyright and related rights.

⁹ To assist their member countries, the World Customs Organization (WCO) has developed model legislation to give customs authorities power to implement the border measures provided for in the TRIPS Agreement. The model legislation took into account the need for flexibility and respect for different legal and other traditions and had involved consultations with the governments and the private sector. The model legislation is currently under review and the updated draft model legislation will be put through the Committee system to the Council for adoption in June 2003. Should Member States be in doubt as to their enforcement obligations under the TRIPS Agreement, the Secretariat of WIPO could make available a "Questionnaire on the Enforcement of Intellectual Property Rights under the TRIPS Agreement," which will assist

remedies and penalties available (or not available) to stop and deter counterfeiting and piracy. It was stated that enforcement systems are, in many cases, ineffective due to a lack of human resources, funding and practical experience in the enforcement of intellectual property rights; a general lack of training of enforcement officials, including the judiciary; insufficient knowledge on the side of right holders, as well as the general public, concerning their rights and remedies; legislation not being drafted effectively or extensively; and systemic problems resulting from insufficient national and international coordination, including a lack of transparency.

8. In a number of Member States, the responses indicated that the system of justice is slow, uncoordinated, with long delays, minimal positive results, and is costly and not uniform in application, even within the borders of the same state. Some Member States do not provide for *ex officio* action at the border or, where they do, they do not always have the required cooperation from the right holder to pursue the matter. In some Member States, it was claimed, preliminary injunctions are either granted too late or, where granted in time, were often difficult to enforce. Alternatives proposed, such as arbitration or alternative dispute resolution systems, were seen as too often under-developed, or their awards were not fully enforceable. Many claimed that too often, there was a failure to seize and destroy contraband; infringing goods have been simply resold, re-labelled or re-exported. Further, some responses pointed out that a lack of judicial or administrative orders to seize and destroy implements used in manufacturing contraband leads to continued illegal commercial activities by the same infringer or his business partners.

9. Some responses asserted that an under-estimation of the value of intellectual property rights has contributed to ineffective enforcement. Some of those responses underscored some of the related aspects of the problem: the low level of knowledge of intellectual property rights and how to manage these rights; the cost and time involved in initiating and prosecuting an enforcement action in the courts; and the fear that parties with more resources can abuse the system and force an unfair outcome on smaller parties. The vast majority of responses stated that to be effective, the enforcement system should be practicable, fast, not expensive and predictable, and the outcomes of enforcement actions should be fair, just and independent of the financial strengths of the parties to the dispute. Education programs should be designed to help owners of intellectual property rights to understand what their rights entail and how to manage these rights, including which enforcement strategies to implement. To enhance this aspect of the intellectual property rights system, some felt that it would be useful for governments to assess the value of the industrial sector based primarily on intellectual property rights in terms of a percentage of the Gross Domestic Product. This could lead to an appreciation of the value of intellectual property rights in terms of a country's economic environment, as well as in respect to economic, social and cultural growth and development.

[Footnote continued from previous page]

Member States to self-evaluate their legal systems, in general, and the protection provided thereunder. International enforcement obligations, arising from the WIPO Copyright Treaty (WCT) and the WIPO Performances and Phonograms Treaty (WPPT), will be referred to under item IV, "INTERNET ENFORCEMENT ISSUES," below.

10. Based on the information contained in the responses, the following is a summary of the *difficulties*¹⁰ experienced by some Member States in their endeavor to effectively implement international obligations in the field of the enforcement of intellectual property rights.

A. Lack of National Coordination

11. A national enforcement policy is effective if it takes into account that enforcement is a coordinated effort among relevant branches of government. Furthermore, it should also involve the participation of right holders or associations of right holders, who are well placed to air their experiences and needs in the area of enforcement and to assist in training and education programs. Structured cooperation would also assist customs and police authorities in obtaining necessary or relevant information concerning right holders or, alternatively, giving them access to intellectual property databases, which would assist in establishing contact with right holders who, in turn, could assist in product identification, and in judicial and administrative proceedings. Finally, in order to discourage public support for the illegal trade in counterfeit goods and pirated copyright works, there should be an expanded public awareness of both the value of intellectual property rights, and of the negative socio-economic impact of counterfeiting and piracy.

B. Need for International Cooperation

12. In addition to beneficial cooperation projects between governments and international organizations, there is a particular need for governments to work in tandem to combat cross-border infringements and illegal operations. Such cooperation could be enhanced by harmonized legal frameworks and implementing procedures. The sharing of information among customs agencies about exports, imports and the trans-shipment of goods could greatly contribute to tracking down the source of infringing goods. Similarly, exchange training programs for enforcement officials have proved to be valuable in the fight against counterfeiting and piracy.

C. Close Connection with Private International Law

13. Enforcement issues are closely related to issues concerning private international law. It was stressed that there is a need for coordinated cooperation between Member States and international organizations. Internet pirates, in particular, have been able to hide behind the lack of harmonized jurisdiction and choice of law regimes.

D. Lack of Public Awareness

14. One of the biggest problems Member States claimed is that consumers do not always realize the real dangers linked with supporting illegal trade in counterfeit goods or pirated copyright works. In supporting this illegal trade, they are often directly supporting organized crime. It often escapes the public that not only will legal employment opportunities be reduced, but that governments will not be able to realize certain taxes, a consequence affecting other vital areas such as health and welfare.

¹⁰ Not listed in order of importance.

E. Training Needs¹¹

15. Responses cited the accelerated development of information and other technologies, and the rapid pace of globalization, as compelling reasons for ongoing training and education programs. Legislative and judicial intellectual property issues, resulting from existing and newly negotiated international legal instruments, can become complex and multifaceted. To address these and other related issues, several responses suggested that Member States should develop and maintain integrated, long-term intellectual property education and training strategies, including related areas such as private international law.

F. Judicial Issues

(a) High cost of litigation

16. Some responses reflected that frequently, right holders feel discouraged by the high costs of infringement litigation. Evidentiary requirements to establish counterfeiting or piracy are often time-consuming and costly. The costs of litigation are also increased by significant time delays in obtaining interim and final relief against infringers. A few responses claimed that in some Member States, the lack of intellectual property expertise in the judiciary and in legal representatives also have an adverse impact on gaining fair and timely outcomes in infringement proceedings. These foregoing factors, together with insufficient rights or procedure to recover litigation costs, can serve to discourage right holders from attempting to enforce their rights through the legal system.

(b) Complex and slow procedures

17. Complex and time-consuming procedures can contribute to high litigation costs and result in undue time delays in obtaining effective and timely relief.

(c) Backlogs in intellectual property offices and the non-timely publication of registered intellectual property rights

18. It was pointed out that backlogs in the registration process of certain intellectual property rights, and/or the failure or delay to publish such perfected rights within a reasonable time, can have a negative impact on the protection of these rights and may further complicate infringement actions, leading to long time delays and additional wasted costs.

(d) Provisional measures

19. Many responses stated that proceedings *inaudita altera parte* are often not available, are hindered by excessive restrictions and are sometimes used for abusive purposes. The procedures for obtaining effective provisional measures were often seen as unreasonably cumbersome, costly and time-consuming. Infringing material, or other evidence in cases involving the infringement of intellectual property rights, by its nature can be easily removed or destroyed. Acquiring evidence is therefore often impossible in many cases unless searches

¹¹ See WIPO document WIPO/CME/2, "Existing Needs for Training and for Development of Enforcement Strategies; Report on WIPO Activities in Favor of Developing Countries and Countries in Transition, from July 2000 to June 2002, with Regard to Training, Technical Assistance and Awareness Building in the Field of Enforcement."

and seizures can be conducted without prior notice to the infringing party. Responses noted that many Member States still do not provide for civil *ex parte* search and/or seizure orders, or do provide for such orders but make them unduly burdensome to obtain. Disproportional demands for security bonds can also effectively inhibit right holders from obtaining relief through provisional measures, whereas unreasonably short time limits for initiating legal proceedings can undermine the effectiveness of provisional measures. Infringement proceedings often involve substantial quantities of evidence and require highly complicated preparation for their use in court proceedings. Differing time periods in Member States can exacerbate this problem, as more and more proceedings involve cross-border piracy and must be brought at the same time in different Member States.

20. Counterfeiters and pirates often accrue considerable fortunes as a result of their illegal activities. There are two major obstacles preventing the use of these assets to compensate aggrieved right holders. Firstly, it was noted that although most Member States make asset-freeze orders available to right holders, finding the assets is often difficult or impossible. Financial institutions are reluctant to disclose information about assets even after receipt of a validly issued freeze order; in many Member States, orders can only be obtained concerning known and specified bank accounts. Secondly, *ex parte* orders issued in one state may not be enforceable in another, giving the infringer time to transfer certain assets and/or incriminating evidence to locations not reachable by the right holder or the court.

G. Damages

21. Several of the responses stated that legal provisions relative to establishing, calculating and enforcing civil damages differ too widely from jurisdiction to jurisdiction, and therefore do not provide an effective deterrent. It is very difficult to prove actual losses and monetary damages in most intellectual property rights infringement cases. Infringers are engaging in illegal activity and, therefore, most neither keep records nor easily discoverable supplies of goods to determine the extent of counterfeiting and piracy. Without sufficient deterrents on a national and global level, counterfeiters and pirates, who are increasingly more sophisticated in their infringing methods, will continue their criminal activities to the detriment of governments, right holders and the public at large.

22. Some stated that too often, the legal provisions on damages not only fail to adequately compensate right holders, but in fact provide powerful financial incentives for piracy. For instance, damages are sometimes limited strictly to the “lost profits” of the right holder, or are calculated on the basis of “pirate prices” which, in practice, may produce an nominal sum that the counterfeiter or pirate is willing to risk as a cost of doing business. Sometimes, courts let unlicensed pirates rectify their infringement simply by acquiring licensed copies after the infringement.

23. The amount of actual damages suffered by the right holder is often difficult and/or prohibitively expensive to prove. By the very nature of counterfeiting and pirate activities, infringers are rarely found in possession of anything but a small fraction of the total number of infringing goods and often have incomplete or no records showing how many counterfeited or pirated copies were manufactured, offered or distributed.

24. A few responses pointed out that in some cases, there was no real deterrent in terms of monetary sanctions to effectively deal with flagrant cases of organized counterfeiting or piracy. In such cases, compensating the right holder only for direct economic injury or

financial loss was insufficient to remedy the total harm caused, to punish the infringers or to constitute an adequate deterrent. The fact that rightholders often cannot recover the costs of their legal actions deters rightholders from attempting to enforce their rights. Attorneys' fees and costs of investigation and litigation often exceed the amount of damages awarded by the courts. Some responses decried that while most Member States permit the rightholder to apply for the recovery of fees and costs from an infringer, the amounts awarded and recovered rarely cover the amounts spent.

H. Evidentiary Rules

25. Some responses underscored that in some Member States, the rules of procedure, and the burden of proving the ownership and subsistence of rights, were unreasonably burdensome and effectively hindered rightholders from taking legal actions. Rightholders cannot always rely on reasonable samples as a method of proving that goods in seized shipments are counterfeited or pirated. When seizures involve large amounts of infringing items, it is highly expensive and burdensome for the rightholder to prove that each and every item among these seized goods is infringing. To aggravate the matter, law enforcement authorities often are unsure about the extent to which they can share information and evidence with the private sector, professionals, or relevant organizations. These uncertainties also prevent law enforcement from benefiting from the extensive resources and significant technical expertise that rightholders can offer. On the other hand, rightholders are unable to get from the infringers information about the sources of supply and distribution chain. Only a few Member States provide for the necessary right to information which ensures that rightholders can secure crucial information about the manufacture and distribution of counterfeit or pirated goods.

26. Most counterfeiting and piracy takes place behind closed doors. Law enforcement authorities and rightholders alike thus must often rely on informants for much of the initial information that leads to the identification of an infringer and subsequent gathering of direct evidence of infringement. These informants are understandably reluctant to be identified, to appear in court or to sign sworn affidavits. Providing information of infringement could endanger their career prospects or even their personal safety. It was pointed out that some Member States require sworn statements from named informants with direct information about infringement before a court will issue search or seizure orders for the actual evidence of the infringement. Such high evidentiary thresholds can discourage individuals from providing information about criminal conduct of which they are aware.

27. Some responses described the need for workable legal presumptions in court proceedings. This problem has become particularly acute now that hundreds of thousands of different infringing optical discs (CDs, CD-ROMs, VCDs, DVDs) are regularly seized in raids on intellectual property counterfeiters and pirates. Requiring detailed and complicated proof of copyright and copyright ownership for each disc, track or program, can cause unwarranted loss of time, effort and money by the rightholder, and further congestion of the judicial system as a whole.

I. Lack of Alternative Dispute Resolution Systems

28. Alternative dispute resolution mechanisms can provide the opportunity for more rapid and less costly results in an area where time is normally of the essence. Responses

underscores that such alternative dispute resolution systems are either not in place or, if so, they are often poorly developed and of no particular use.

J. Border Enforcement

29. Responses asserted that for effective enforcement at the border, the challenge is to find the proper balance between necessary inspections of the flow of goods between Member States by Customs on the one hand, and the danger to obstruct this flow by the same inspections, creating a barrier to free trade, on the other hand. Less inspections can result in a better flow of goods but, at the same time, increase the risk of more counterfeit goods or pirated copyright works entering the channels of commerce. Regarding border enforcement, the following items were noted as difficulties which are experienced in the majority of Member States:

(a) The lack of cooperation from rightholders following *ex officio* action

30. Frequently, customs officials, in their *ex officio* capacity, stop goods likely to be infringing; afterwards, they have difficulty in tracing down the rightholder or, where they do inform the rightholder about the *ex officio* action, he either fails to authenticate the infringing goods or, alternatively, he omits to file an application for seizure or to institute proceedings against the infringing goods. Without cooperation from the rightholder, there is a risk that the infringing goods will simply be re-sold, re-labelled or re-exported. Responses indicated that for *ex officio* action to be effective, rightholders should render the required assistance to customs officials, provide the necessary evidence and commence proceedings within the prescribed period.

(b) Lack of human resources, technical equipment and storage space for confiscated goods

31. A number of responses noted that Member States have limited funding to establish well staffed customs units. They lack computer-aided information systems, and financing for technical equipment to create linkages with databases within information on rightholders, for transport and for storage space to house confiscated goods. A concept known as “constructive seizure” of contraband is often used due to a lack of official storage facilities. This allows the infringer to retain custody of the goods pending trial or the outcome of an administrative case. Often the goods are distributed anyway, causing harm to the rightholder and possibly to the public, as well as losing evidence of both the infringement and of the volume of merchandise, which is necessary to calculate damages.

(c) Infringing items are too often placed back in circulation

32. Some responses observed that infringing goods were often re-exported, returned to the importer upon payment of a small fine, or auctioned to the public by the seizing authority, sometimes without the obliteration of the offending marks.

(d) Requirements for excessive security bonds in provisional remedies

33. A few responses noted that the authorities require rightholders to post unreasonable or repeated security bonds in relation to the targeted shipment. In situations where there are

multiple seized shipments, this can be cost-prohibitive and can deter recourse to border measures.

(e) No legal basis for *ex officio* action

34. It was mentioned that some Member States do not have, as yet, the required legal basis to permit *ex officio* action by customs officials.

K. Criminal Action

(a) Instituting a criminal action

35. Several responses detailed that in most Member States, criminal actions have to be instituted by the rightholder. Without such intervention by the rightholder, it is not possible to obtain criminal prosecutions or destruction orders. Where, however, the legislature in a Member State has designated offenses involving intellectual property rights as semi-public, in view of the fact that public as well as private interests are often involved, the criminal prosecution may be instituted without the immediate intervention of the rightholder. It was urged that, in order to permit *ex officio* prosecution, the unlawful infringing practices should be contrary to the public interest, or against the interests of two or more persons; and in all other cases, there would have to be a complaint filed by the aggrieved owner. Officers would have to decide whether there is *prima facie* evidence upon which they could act *ex officio*.

(b) Criminal penalties do not provide effective deterrence

36. Many of the responses stated that statutory maximum penalties, and the penalties imposed by courts in practice, are rarely high enough to have a deterrent impact on the actual infringers or on persons that contemplate engaging in infringing activities. Furthermore, the lack of statutory minimum penalties can leave courts with too much discretion, and can lead to unacceptably lenient sanctions. Some responses observed that there is a lack of harmonized penalties for the various intellectual property offences, including a lack of destruction orders and consistent judgments within Member States.

(c) Law enforcement authorities do not have adequate investigatory and coercive powers

37. It was pointed out that the powers available to law enforcement authorities are often dependent on the level of minimum and/or maximum penalties for the offence under investigation. For instance, search warrants are sometimes only granted to investigate offenses where the maximum penalty is a prison term of five years or longer. Moreover, law enforcement authorities might be empowered to arrest suspected infringers only if they are suspected to have committed offences that carry a maximum penalty over and above a certain level, for example, a five-year or longer prison term.

(d) Lack of training and awareness

38. Some of the responses claimed that in many Member States, there was a general lack of knowledge on the part of rightholders, especially concerning the initiation of criminal actions, and as well on the side of investigators and criminal prosecutors. Even special intellectual property infringement prevention units were sometimes not sufficiently trained;

and prosecutors sometimes lacked the experience to draft intellectual property charges, present the evidence and convince the courts about the seriousness of intellectual property crimes in order to secure deterrent penalties, and seizing and/or destruction orders.

L. Information

(a) Legal procedures to obtain information from or about the infringers are missing

39. Counterfeiters and pirates deliberately organize their activities so as to minimize the risk that those ultimately responsible for the whole operation will be detected. Responses point out that, therefore, unless the entire distribution chain and sources of supply are identified and targeted, enforcement actions will only have a limited effect. The ability to obtain information necessary to detect and detain all actors in the distribution chain, and to identify the sources of supply of illegal goods, is key if counterfeiting and piracy are to be fought effectively. Such information is obtainable if the infringer is compelled by law to disclose it to right holders or to the proper authorities.

(b) The potential of court rulings in raising public awareness is not being used

40. Publication of judgements in counterfeiting and piracy cases can act as a deterrent for potential infringers, can provide valuable information to the general public about intellectual property rights, and can raise awareness about the nature and extent of counterfeiting and piracy. Responses note, however, that courts in many Member States do not currently have specific authority to order the publication of judgements.

M. Regulation of Optical Media Manufacturing

41. It was asserted that "Optical disc" piracy, the unauthorized production of CDs, CD-ROMs, VCDs and DVDs, is a dangerous form of piracy that is reaching epidemic proportions. Current global manufacturing capacity is estimated at 23 billion optical discs a year. It was underscored that this is 11 billion discs more than the demand for legitimate products. Much of this overcapacity is directed towards the manufacture of illegitimate products. In some cases, optical disc piracy is conducted by sophisticated, large-scale enterprises, often associated with an organized criminal element. The pirate production may take place in facilities that are established specifically for the purpose of mastering and replicating pirate products. In some instances, however, optical disc plants that are otherwise primarily involved in legitimate production can be involved in the manufacture of pirated discs, either unwittingly, negligently or even with full knowledge of the illegal nature of the discs being produced. The fact that right holders often have great difficulty identifying the source of the pirated discs makes it extremely tempting for even otherwise legitimate plants to accept orders from pirates. Piracy in legitimate plants can also be the result of reckless corporate culture or weak internal governance that allow manufacturing plants to accept orders from pirate operators.

III. IDENTIFY EFFECTIVE OR BEST PRACTICES FOR ENFORCEMENT OF INDUSTRIAL PROPERTY IN MEMBER STATES, INCLUDING EFFECTIVE PRACTICES FOR IMPLEMENTATION OF THE PROVISIONS OF THE TRIPS AGREEMENT ON ENFORCEMENT OF INDUSTRIAL PROPERTY¹², IN PARTICULAR, LESS COSTLY AND TIME-CONSUMING PRACTICES FOR EFFECTIVELY ENFORCING RIGHTS

A. National Cooperation and Coordination

42. The responses were clear that the fight against counterfeiting and piracy would have much greater chances for success if it is a coordinated one, involving all the relevant stakeholders, and dealing with all the various intellectual property rights. It was noted that a number of Member States are involved in initiatives to establish and maintain national cooperation between all the relevant stakeholders as well as the relevant government agencies. Many Member States have established, under the leadership of the national intellectual property offices, coordinating or task force units involving, *inter alia*, the various relevant ministries and agencies, such as customs, police and justice. Also involved are members of such bodies as associations of right holders, copyright societies, medicines control agencies and trading standard authorities, as well as leading manufacturing, retail and consumer organizations. These units sometimes have specialized smaller committees, dealing with more specialized intellectual property issues such as the drafting of new legislation and the development of frameworks for cooperation on enforcement action against intellectual property crimes.

43. The aims of such cooperation were noted as, *inter alia*, to coordinate enforcement activities; to develop greater expertise among customs officers at all points of import and export; to improve liaison procedures with all national agencies involved in enforcement; to enhance contacts with right holders and their representative organizations; to establish benchmarks with specialist anti-counterfeiting units in other Customs administrations; and to participate in public awareness campaigns. Exchanges of officials have produced good results, allowing them to measure their performance and structure against specialist units that operate in other Member States. Through regular consultations, right holders have been encouraged to contribute to the training of customs staff in the identification of counterfeit and pirated goods, and in intelligence reporting from their own sources to assist officers in identifying consignments of counterfeit or pirated goods.

B. Intellectual Property Offices as Contact Points and Information Providers

44. For effective *ex officio* and normal actions, these security forces and customs authorities must have access to information concerning the right holders. In order to achieve this, the contact points, in a number of Member States, have been established as the national intellectual property offices, which under the right circumstances, can provide useful and fast information on right holders and rights. In some Member States, the intellectual property office plays a pivotal role in the drafting of clear instructions to enforcement officials on how to proceed in these cases and do studies and compile useful reports to assist in this aim. The

¹² Subsequent to the Summary by the Chair, WIPO document ACE/IP/01/3-ACMEC/3, the Request for Information was not limited to issues of industrial property, but dealt horizontally with issues relating to copyright and related rights.

intellectual property office has been called upon to give binding or non-binding reports, and other relevant information, to assist the courts.

C. International Cooperation

45. Cooperation at the international level was underscored in several of the responses, mainly to optimize the use of available resources and to integrate the efforts undertaken by the different actors into a strategic action plan.

46. In some Member States, cooperation with international intergovernmental organizations was seen as already having resulted in the creation of bilateral cooperation and support programs in the field of enforcement. To assist developing Member States, it was suggested that industrialized Member States be requested to create an international computer network covering the ownership of merchandise that passes through customs. The creation of such an information exchange network would be useful in the sense that the same intellectual property rights could be registered in many different countries and could be affected by the same types of infringements. Information networks could consequently be useful for the exchange of information on infringement cases.

D. Public Awareness and Cooperation

47. It was suggested that an important strategy in the fight against counterfeiting and piracy could be to involve the public more effectively through the establishment of hotlines where the public can report crime anonymously. This should be preceded by, or go hand in hand with, national anti-counterfeiting and anti-piracy campaigns. Posters and leaflets could be used that indicate pictorially the link between intellectual property crime and job losses, public sector funding cuts and the debilitating effects of organized crime; they could also emphasize the dangerous effects which some fake goods and products may have.

E. Right Holder Cooperation

48. Some responses made mention of the fact that in some Member States, right holders were made aware of their enforcement options through, *inter alia*, useful websites, which included information on how to deal with criminal and civil enforcement, information on insurance concerning litigation, and the use of security packaging, identifiers and other technical means to protect their intellectual property rights. Right holders have been encouraged to resolve civil disputes out of court in order to curtail the high cost of litigation; to enforce their rights in all applicable countries, including those with micro-economies; and to cooperate in official training and awareness programs.

F. Judicial Procedure

49. Apart from implementing, in full, the enforcement provisions contained in Part III of the TRIPS Agreement, several of the responses acknowledged that the following procedures in certain Member States have delivered useful and efficient results:

(a) Provisional measures

50. Judicial authorities need to be able to order prompt provisional measures to preserve evidence and to prevent infringements. If counterfeiters and pirates are caught by surprise,

there is a better chance to find and preserve the necessary evidence. Thus, to ensure effective enforcement, Member States should authorize the judicial authorities to provide for *ex parte* search orders and/or seizure orders, in both civil and criminal cases. The applications for *ex parte* orders should be acted upon and executed within a short time period and security requirements should not unreasonably deter recourse to these procedures.

51. It was noted that in some jurisdictions, the right holders apply *ex parte* for an order¹³ to enter the premises of the alleged infringer in order to attach and preserve evidence. This can be done on short notice, but right holders have to substantiate their claims and may have to provide security. Similarly, the appropriate authorities should have the right to order the seizure of suspected infringing goods and other relevant evidence as soon as there is reason to suspect that rights are being or are about to be infringed. The ability to seize or preserve should cover not only the infringing articles themselves, but also the equipment and other materials used in the infringing operation, including the production and distribution aspects. This is needed to ensure that right holders have an appropriate opportunity to prove the true extent of the infringing activity.

52. A few responses suggested that in order to assure funds to satisfy compensation awards and judgments, the freezing of the defendant's bank account(s) and other assets may be ordered¹⁴ pending the court's consideration of the merits of the case. *Ex parte* asset-freeze orders, available in appropriate cases and enforceable internationally, could give right holders an opportunity to ensure that infringers' profits are confiscated and that monetary damages are recoverable. Financial institutions might be obligated to freeze and disclose information on relevant assets held in their accounts.

53. Some responses proposed that consideration be given, where this could be consistent with the law of evidence, that certain evidence, provided by persons such as hotline operators and qualified lawyers, could be a sufficient, or minimal, basis for courts to evaluate an application for provisional measures. This could encourage individuals to come forward and provide information regarding infringements of intellectual property rights sufficiently detailed and reliable to warrant issuance of these search order or other provisional measures; judges, of course, should retain discretion to determine whether the evidence provided is credible and sufficient. First-hand witnesses to intellectual property infringements are often afraid to come forward, fearing retaliation by defendants as well as loss of future employment prospects, social standing or professional reputation. In most instances, such witnesses will only come forward if they can be assured that their identities will be protected.

(b) Damages

54. The responses urged that it is of paramount importance in cases involving infringements of intellectual property rights that courts be empowered to award damages that both compensate the right holders and deter potential infringers from engaging in illegal activities. National law therefore should contain rules on the calculation of damages that allow courts to award such damages as to create a deterrent, and adequately compensate right holders. The assessment of damages should result in complete indemnification of the injured right holder. Right holders could have the right to receive all profits from the infringement, i.e., the fruit of

¹³ Often referred to as "Anton Pillar" orders.

¹⁴ Often referred to as "Mareva" injunctions.

stolen creativity. And the measure of damages should not provide an economic incentive for counterfeiting and piracy.

55. Pre-established or statutory damages were reviewed as offering an alternative and perhaps more effective way to compensate right holders and thereby provide them with an expedient and economical way to prove and recover the damages suffered through counterfeiting and piracy. It was suggested that such statutory damages be awarded, even where infringers did not knowingly, or with reasonable ground to know, engage in infringing activity. Exemplary damages, on the other hand, were thought necessary to deter infringers in cases of flagrant counterfeiting and piracy. Additional damages in the form of aggravated or exemplary damages, or both, are also needed to ensure that a court can award damages that provide an appropriate deterrent. It was also recommended that penal sums be fixed as conditional damages, in cases of non-compliance with the court's order.

(c) Evidentiary rules

56. It was noted that in some Member States, the rules of civil procedure have been amended to include a rebuttable presumption, that the judicial authorities shall presume that a person who has infringed an intellectual property right had reasonable ground to know he was infringing such right.

57. Some responses suggested that, in order to speed up the justice system and to avoid unnecessary and costly proceedings, Member States could make it easier to bring cases to a conclusion by allowing for reasonable presumptions, for example, in respect of ownership and subsistence of rights; this could be applicable in both civil and criminal proceedings. The presumptions should be rebuttable, where the defendant were able to provide concrete proof to the contrary. Furthermore, even where these matters were validly in dispute, parties could be entitled to present proof of rights by way of registration certificates, or by affidavit. It was proposed that in copyright matters, for example, the physical person or legal entity whose name was indicated as the author, producer, performer or publisher of the work, in the usual manner should, in the absence of proof to the contrary, be presumed to be the lawful right holder of the work. Similarly, it should be easy for the party that claimed to have a copyright license to actually produce a true copy of the license agreement, and thereby to prove his entitlement to use the intellectual property in question. For reasons of judicial economy, courts should obligate the person claiming to have a license to produce a copy of the agreement.

58. Some responses suggested that sampling could be accepted as a method of providing credible evidence of the infringing nature of goods in large seizures. This method has already been widely recognized in the customs field. Where an adequate sample of seized copies (for example, 10%) proved to be infringing, it could be regarded as *prima facie* evidence that the remainder of a seized inventory is also infringing, thereby creating judicial economy.

(d) Surrender of profits and destruction of goods and/or implements

59. Many responses underscored that courts should order the surrender of profits and for the destruction of infringing goods and/or implements used in the manufacturing thereof, should be issued where the defendant has acted in bad faith. All such forfeiture and destruction should be without compensation to the defendant. Some felt that judicial authorities should

also have the authority to order the closure of commercial outlets and manufacturing plants that have been used to manufacture or distribute counterfeit or pirate products.

(e) Recall of infringing goods and list of customers

60. It was suggested that judicial procedures may also be adopted whereby offending goods that have been placed on the market are recalled at the infringer's expense, as long as they were not sold to consumers.

(f) Legal costs

61. Most responses supported the principle that in order to discourage counterfeiting and piracy, the full recovery of legal costs, including attorney's fees, investigatory costs, and litigation costs, should be a matter of right for aggrieved right holders.

(g) Nullification of fraudulently acquired intellectual property rights

62. Some responses stated that it should be possible for the judicial authorities to nullify or cancel intellectual property rights which were acquired or applied for fraudulently or in bad faith.

G. Border Measures

63. The responses generally agreed that Customs authorities play an important role in preventing infringing goods from entering into commercial channels. It was mentioned that enhanced Customs control practices have, in some Member States, led to a considerable increase both in the number of interventions and in the number of objects intercepted by Customs administrations.

64. Concerning the amount of security, it was suggested that such a amount be timely refunded following the successful completion of proceedings. Also, other responses suggested that Customs authorities should permit right holders to post a single, continuous security bond, of a predetermined amount, that would "secure" all enforcement actions; that right holders should not be charged for the detention of infringing goods; and that goods found to be infringing should not be re-exported, but destroyed in order to prevent the goods from entering other channels of commerce.

H. Criminal Procedures

65. The responses generally supported the notion that it is important that Member States grant police and other law enforcement authorities appropriate power to initiate criminal proceedings, including in cases of deliberate infringement, of a professional or corporate character, in large, commercial scale infringements, and especially where there is a substantial danger to the economy, or to the public health and public security.

66. Several responses stressed that the statutory minimum fines for criminal infringements should be set at a level that provided a true deterrent against further infringements. Moreover, there could be continuous monitoring of the level of fines actually imposed. Where necessary, authorities could discuss sentencing guidelines to ensure that fines imposed by the

judiciary acted to remove all gain from the infringer and actually served to deter further infringements.

67. It was observed that whenever law enforcement authorities' investigatory powers were dependent on the level of minimum/maximum penalties available for criminal infringements, criminal penalties should be set at a level that ensures that law enforcement authorities have adequate power to at least investigate infringements. It was stressed that penalties should be set at a level that ensures that criminal infringements are arrestable offences.

I. Information

68. Some responses commented that the availability of a "right to information" would be a valuable instrument in the fight against counterfeiting and piracy, and that it would enable rightholders to identify the key persons involved in infringing activities, as counterfeiters and pirates can often move their production sites and change their distribution channels quickly. These provisions could enable the rightholder to receive information about the infringing goods as well as about persons involved in the infringements. These provisions could be accompanied by adequate sanctions for non-disclosure, giving false information or other non-compliance with the court's orders.

J. Publication of Court Decisions

69. Several responses suggested that, in order to better protect the public, and to raise awareness of the value of intellectual property rights, judicial authorities should have the power to order the official publication of court decisions, particularly those with a deterrent effect.

K. Specialized Courts, Training and Intellectual Property Reference Library

70. A large number of the responses favored either establishing specialized intellectual property courts or, alternatively, that consideration be given by governments to train a number of judges to deal with intellectual property cases; taking this approach could assist in the adjudication of complex intellectual property matters, as well as possibly being useful in obtaining well-calculated damage awards. To assist in particular developing countries with limited experience and resources in intellectual property matters, several responses suggested that it could also be useful to establish intellectual property reference libraries with reading material and case law from different jurisdictions.

71. Some responses commented on the difficulties involved in working out compensation for infringements of patent rights and the difficulties inherent in the application of the reversal of the burden of proof where there is *prima facie* evidence of the defendant's infringement of patent rights, regardless of whether or not process patents resulting in a new product are involved. The problems of protecting data in the market approval file on pharmaceutical products were also noted. It was suggested that what may be considered is the adoption of a system of information on the status of patents for active ingredients, or alternatively, a system whereby patents and marketing approval are linked, and that free access be given to the non-confidential data, in the file.

L. Accelerated Procedures

72. A number of responses urged that, in order to relieve the courts and their congestion, that accelerated cost-reducing procedures could be considered. For example, after the customs authorities have seized the goods, the applicant or the person who is entitled should have the possibility to file a written objection within a short time limit. If no objection is filed, the goods would be destroyed or taken from the market in a different way. If an objection is raised, these seized goods would be handed over to the right holder, if the applicant cannot prove that he has brought an action with the competent court within a time limit of, e.g., 10 or 20 days. It was also suggested that alternatively, intellectual property cases could be dealt with in interim, informal procedures, which could be held on a very short notice and following which the infringement might be stopped immediately. This abbreviated procedure could be followed by proceedings on the merits. The right holder could make a reasonable case for having a urgent interest and he should do so within a reasonable time after the discovery of the infringements; otherwise, he should start proceedings on the merits.

M. Mediation and Arbitration

73. Some of the responses stated that greater use should be made of mediation and arbitration procedures to resolve disputes as an alternative to legal proceedings. Under such a scenario, attention would have to be given to the role of alternative dispute resolution procedures and pre-action protocol that, *inter alia*, encourage the exchange of information in order to encourage the settlement of disputes at an early stage.

N. Issue of Jurisdiction

74. It was suggested that worldwide conventions on international jurisdiction in regard to intellectual property litigation, as is currently being prepared by, *inter alia*, the Hague Conference, need to be concluded.

O. Infringing Goods at Exhibitions

75. One Member State commented that it has established guidelines for organizers of exhibitions and trade shows to prevent intellectual property infringements, including how to deal with infringing goods and how to more quickly resolve disputes involving intellectual property rights. Under these guidelines, the right holder alleges infringement before an established panel, which immediately investigates the allegation(s). This procedure could represent a non-costly, effective way of dealing with alleged infringements at exhibitions and trade shows, and possibly in other situations.

P. Regulation of Optical Media Manufacturing

76. It was noted that optical disc regulation offers a cost-effective way to tackle the piracy problem in this medium at the source. Unlike most enforcement measures, the response noted that optical disc laws work proactively against infringements of intellectual property rights. Properly implemented, these rules can make it much more difficult for rogue elements to manufacture pirated optical discs, and do so without placing undue regulatory burdens on legitimate plants. Optical disc legislation can also help insure that the capacity of legitimate plants is not used by criminals to manufacture pirated products.

77. It was proposed that the manufacture of all optical discs, including the manufacture of master discs and stampers used to mould the discs, should be subject to a license from a competent authority. The same response also suggested that the manufacturers of optical discs should be obligated to maintain complete and accurate records, which would enable right holders and public authorities to trace the person or entity that ordered the infringing discs, and that right holders should have easy access to these records, enabling them to start proceedings against these infringers.

78. It was also stressed that manufacturers should be obligated to apply identification codes on all optical discs, including master discs and stampers, which enable the tracing of the source of a product and provide a deterrent against piracy. It was noted that the industry standard for this identifier has become the Source Identification Code ('SID Code'), which was introduced on a voluntary basis in 1993 and is now generally accepted as the worldwide standard for unique identifiers. Furthermore, the applicable regulations should incorporate provisions allowing competent authorities to monitor the traffic in key raw materials, especially in optical grade polycarbonate, and manufacturing equipment, as important tools in tracing pirate manufacture of optical discs.

IV. INTERNET ENFORCEMENT ISSUES

79. Several responses noted that the sheer scale of the Internet problem (i.e., illegal downloading, peer-to-peer file sharing, global dimension, etc.) means that meaningful enforcement of intellectual property rights on the Internet cannot rely primarily on traditional civil or criminal enforcement mechanisms. Rather, the responses felt that right holders must be able to solely rely on take-down and/or blocking of infringing material by the Internet service provider(s) upon notice from the right holder(s). In certain limited cases, these notice and takedown procedures are supplemented by civil and criminal enforcement actions, both as a specific deterrent against a particularly problematic pirate, and as a general deterrent to others who would otherwise be tempted to engage in such activities. The success of these enforcement efforts rests largely on the ability to determine the true name and contact details of the pirate, information that rests almost entirely with publicly accessible Domain Name databases (WHOIS) or with the Internet service providers. Without access to contact details, the task of assigning responsibility for illegal activities on the Internet is virtually impossible. The responses which discussed this issue all felt that timely and unfettered access to this information is thus absolutely essential if right holders are to be able to enforce their rights on the Internet.

80. Responses commented that the evidentiary standards for proving the amount of actual damages involved in an Internet infringement are unworkable. In most cases, it is very hard, if not impossible, to show just how many copies have been made available and even harder to provide evidence on the amount of downloads made from the illegal server.

81. Some responses observed that some laws provide adequate sanctions only if crimes are committed on "a commercial scale" or if made for "profit making purposes." This issue raises two related problems. First, commercial enterprises sometimes engage in infringement on a large scale that does not involve sales of the infringing product to third parties but nonetheless results in increased profits and other financial benefits to the pirate company. The second problem arises in the context of mass distribution of intellectual property based materials over the Internet. New forms of infringement, including those committed by or

through on-line file sharing services, have arisen which are as destructive to the value of copyright as any conventional pirate business, but do not necessarily conform to old notions of commercial activity, or infringements for profit.

82. These responses urged that Member States should provide that, at least in cases involving significant willful infringements, such as the unauthorized posting of protected materials on the Internet, are deemed to be piracy on a commercial scale, and treated as such, even though the actor/pirate receives no financial gain, nor demands the same. A response went further, and suggested that Member States should provide criminal penalties for the possession of infringing copies for the purposes of distribution or otherwise offering to the public, and unauthorized copying by persons inside corporate, government or similar institutions in connection with the institution's activities.

83. Some responses commented that, with regard to the Internet, it has become increasingly difficult to identify when and where an infringement took place and by whom it was committed. Even when an infringement has been identified, one faces the question of applicable law, jurisdiction and damages in terms of pursuing enforcement of intellectual property rights. These responses stressed that although there are no international, harmonized rules in this respect, the issues of applicable law, jurisdiction and damages were critical in considering copyright enforcement issues on the Internet.

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