

Public consultation on the evaluation and modernisation of the legal framework for the enforcement of intellectual property rights: Judiciary and Legal Profession

Fields marked with * are mandatory.

Objectives and General information

The views expressed in this public consultation document may not be interpreted as stating an official position of the European Commission.

You are invited to read the privacy statement^[1] for information on how your personal data and contribution will be dealt with.

Please complete this section of the public consultation before moving to other sections.

Respondents with disabilities can request the questionnaire in .docx format and send their replies in email to the following address: GROW-IPRCONSULTATION@ec.europa.eu.

If you are an association representing several other organisations and intend to gather the views of your members by circulating the questionnaire to them, please send us a request in email and we will send you the questionnaire in .docx format. However, we ask you to introduce the aggregated answers into EU Survey. In such cases we will not consider answers submitted in other channels than EU Survey.

If you want to submit position papers or other information in addition to the information you share with the Commission in EU Survey, please send them to GROW-IPRCONSULTATION@ec.europa.eu and make reference to the "Case Id" displayed after you have concluded the online questionnaire. This helps the Commission to properly identify your contribution.

Given the volume of this consultation, you may wish to download a PDF version before responding to the survey online.

[1] Add link.

*** Please enter your name/organisation and contact details (address, e-mail, website, phone)**

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London
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www.cipa.org.uk
02074059450

*** Is your organisation registered in the Transparency Register of the European Commission and the European Parliament?**

In the interests of transparency, organisations (including, for example, NGOs, trade associations and commercial enterprises) are invited to provide the public with relevant information about themselves by registering in the Interest Representative Register and subscribing to its Code of Conduct

If you are a registered organisation, please indicate your Register ID number. Your contribution will then be considered as representing the views of your organisation

If your organisation is not registered, you have the opportunity to [register now](#). Then return to this page to submit your contribution as a registered organisation.

Submissions from organisations that choose not to register will be treated as 'individual contributions' unless they are recognized as representative stakeholders via relevant Treaty Provisions.

- ☒ Yes
☐ No
☐ Non-applicable

*** Register ID number**

24367095563-62

*** In the interests of transparency, your contribution will be published on the Commission's website. How do you want it to appear?**

- ☒ Under the name supplied? (I consent to the publication of all the information in my contribution, and I declare that none of it is subject to copyright restrictions that would prevent publication.)
☐ Anonymously? (I consent to the publication of all the information in my contribution except my name/the name of my organisation, and I declare that none of it is subject to copyright restrictions that would prevent publication).
☐ No publication - your answer will not be published and in principle will not be considered.

"Please note that your answers may be subject to a request for public access to documents under Regulation (EC) No 1049/2001."

A. Identification

*** You are a**

- ☐ Judge sitting at a specialised IP court
- ☐ Judge sitting at a specialised IP chamber in the general civil/commercial court
- ☐ IP-specialised single judge
- ☐ Judge sitting in the general civil/commercial court, reviewing IP cases
- ☐ Association representing the judiciary
- ☐ Legal counsellor
- ☒ Association representing the legal profession
- ☐ Legal academic
- ☐ Other

*** Please indicate your country of profession:**

- | | | |
|---|-----------------------------------|--------------------------------------|
| ☐ Austria | ☐ Belgium | ☐ Bulgaria |
| ☐ Cyprus | ☐ Croatia | ☐ Czech Republic |
| ☐ Denmark | ☐ Estonia | ☐ Finland |
| ☐ France | ☐ Germany | ☐ Greece |
| ☐ Hungary | ☐ Ireland | ☐ Italy |
| ☐ Latvia | ☐ Lithuania | ☐ Luxembourg |
| ☐ Malta | ☐ Netherlands | ☐ Poland |
| ☐ Portugal | ☐ Romania | ☐ Slovakia |
| ☐ Slovenia | ☐ Spain | ☐ Sweden |
| ☒ United Kingdom | ☐ Other | |

B. Your views and opinion on the scale of IPR infringements and general issues of IP litigation

*** To your knowledge and experience, are IPR-infringements cases taking a considerable part of the overall civil/commercial litigations in your country?**

- ☒ Yes
- ☐ No
- ☐ Don't know

Please specify:

1500 character(s) maximum

Please explain:

We are not sure what is meant by "considerable". It is significant however, as we have the Patents Court and the Intellectual Property Enterprise Court ("IPEC") with several specialist judges, and further specialist judges in the Chancery Division to hear trade mark and copyright cases.

What is approximately the percentage of IP cases of the overall civil/commercial litigation in your country?

 %

*** Do you think that IP rightholders are frequently using litigation as a means of protecting their IPRs?**

- ☐ Yes
☒ No
☐ Don't know

*** In your opinion, what is the reason for this?**

- ☐ The costs for litigation and legal representation are too high
☐ Civil court proceedings take too long
☐ Procedures are too complex
☐ The outcome of litigation is not predictable
☐ Alternative dispute resolution mechanisms can achieve better results in terms of time and money
☐ There are other means available to protect IPR (notice-and-action procedures, voluntary cooperation with intermediaries, etc.)
☒ Other

Please specify:

500 character(s) maximum

What does "frequently" mean? Most IP rightholders do not use litigation, but a significant amount of IP litigation takes place. Not all IP infringement calls for the same response. IP rights are commercial rights. If there is no business case to deal with an infringement, then there is no need to incur the costs. All above answers may be applicable - it just depends on the case. We comment on the above reasons in more detail in the comment section at the end of this survey.

*** In your experience, do SMEs litigate to protect their IPR?**

"SME"

According to Commission Recommendation of 6 May 2003 concerning the definition of micro, small and medium-sized enterprises, 2003/361/EC: enterprises which employ fewer than 250 persons and which have an annual turnover not exceeding EUR 50 million, and/or an annual balance sheet total not exceeding EUR 43 million (http://ec.europa.eu/growth/smes/business-friendly-environment/sme-definition/index_en.htm).

- ☐ Yes
☒ No
☐ Don't know

*** In your opinion, what is the reason for this?**

- ☐ The costs for litigation and legal representation are too high
- ☐ Civil court proceedings take too long
- ☐ Procedures are too complex
- ☐ The outcome of litigation is not predictable
- ☐ Alternative dispute resolution mechanisms can achieve better results in terms of time and money
- ☐ There are other means available to protect IPR (notice-and-action procedures, voluntary cooperation with intermediaries, etc.)
- ☒ Other

Please specify:

500 character(s) maximum

Some SMEs will litigate depending on the nature of the problem and if they do, they will often use the IPEC Small Claims Track. They need to see the business case for doing so. Litigation takes key business people away from running their business. There is always a risk assessment to be performed and a cost/benefit analysis. Most SMEs are afraid of unpredictable costs for litigation, do not understand the procedures and are reluctant to litigate when having to deal with different jurisdictions.

C. Functioning of key provisions of Directive 2004/48/EC on the enforcement of intellectual property rights

This section aims to provide the Commission with stakeholder' views, opinions and information about the functioning of the overall enforcement framework and of key provisions of IPRED.

C.1. Overall functioning of the enforcement framework

In which Member State(s) do you litigate most?

at most 3 choice(s)

- | | | |
|---|--------------------------------------|---|
| ☐ Austria | ☐ Belgium | ☐ Bulgaria |
| ☐ Cyprus | ☐ Croatia | ☐ Czech Republic |
| ☐ Denmark | ☐ Estonia | ☐ Finland |
| ☐ France | ☐ Germany | ☐ Greece |
| ☐ Hungary | ☐ Ireland | ☐ Italy |
| ☐ Latvia | ☐ Lithuania | ☐ Luxembourg |
| ☐ Malta | ☐ Netherlands | ☐ Poland |
| ☐ Portugal | ☐ Romania | ☐ Slovakia |
| ☐ Slovenia | ☐ Spain | ☐ Sweden |
| ☐ United Kingdom | | |

For these jurisdictions please provide your overall experience and satisfaction with the legal framework for civil enforcement of IPR (please indicate Member State concerned first)?

	Overall experience and satisfaction
Member State 1:	
Member State 2:	
Member State 3:	

Do you think that the existing rules – as provided by the Directive and implemented at national level – have helped effectively in protecting IP and preventing IPR infringements?

- ☐ Yes
☐ No
☒ Partly
☐ No opinion

Please explain:

1500 character(s) maximum

The Directive does not help prevent infringement. The question should be whether the Directive makes it easier to obtain a remedy when there has been infringement. This depends on how it has been implemented into the national laws of each member state. The UK did not need to make significant changes to its national laws as many of the provisions of the Directive already formed part of the IP regime.

C.2. Measures, procedures and remedies provided for by IPRED

Responses to this section should be based on the overall experience with the measures, procedures and remedies provided for by IPRED as implemented and applied at national level. If appropriate please specify in your response, to the extent possible, particular national issues or practices and the jurisdiction concerned.

C.2.1 Evidence (Articles 6 and 7)

*** Would you consider that the measures provided by IPRED are effective means for presenting, obtaining and preserving evidence?**

- ☐ Yes
☒ No
☐ No opinion

*** Please explain:**

1500 character(s) maximum

Please explain:

We mean "yes" - but only get this box when we say "no". No changes should be made to the IPRED. The measures are effective in themselves. The problem concerns how national procedures work. In some jurisdictions, evidence has to be presented in court by a court official. In those countries it may be easier to obtain an order for a court official to enter a potential Defendant's premises and seize products or documents. In other jurisdictions there are no such officials. The work must then be done by the Claimant and the procedures may have evolved to stop the Claimant from abusing the system. This can make the procedure cumbersome and expensive and set higher hurdles to obtain pre-action orders.

*** In view of your experience with the implementation and application of the rules for having access to and preserving evidence do you see a need to adjust the application of that measure, in particular with regard to preserving evidence in the digital environment and in cross-border cases?**

- ☒ Yes
☐ No
☐ No opinion

*** Please explain:**

1500 character(s) maximum

We mean "no" - but only get this box when we say "yes". No changes to the IPRED are necessary. It would be good to have more transparency as to how the implementation varies between different jurisdictions and discussions on where these systems work and where they fail. It would also be helpful if evidence that is acceptable in one jurisdiction could also be admissible in other jurisdictions. However, these issues can be tackled without amending the IPRED and these changes go way beyond intellectual property law and probably are not matters to be dealt with in the IPRED.

C.2.2. Right of information (Article 8)

What are the requirements for a request for information to be proportionate and justified when exercising the right of information against an infringer?

1500 character(s) maximum

We understand that the UK IPO will be responding to this on behalf of the UK.

What are the requirements for a request for information to be proportionate and justified when exercising this right of information against another person (e.g. an intermediary)?

1500 character(s) maximum

We understand that the UK IPO will be responding to this on behalf of the UK.

How do you define "commercial scale" in your jurisdiction?

1500 character(s) maximum

This is not a recognised term in the UK. In any case, for many IP rights, there is an exemption from infringement where the act is for personal use - e.g. a patent is not infringed if the relevant act in relation to the invention or process was for personal, non-commercial use. Any infringement takes place when the patent is commercially exploited without the consent of the patent owner, and is not otherwise exempt.

What is the scope of the assessment of the admissibility and the merits of a request for information?

1500 character(s) maximum

We understand that the UK IPO will be responding to this on behalf of the UK.

What is the burden of proof and evidence required to demonstrate the existence of an infringement?

1500 character(s) maximum

There is no bailiff or court appointed official to deal with this in the UK. Unless the other side admits to the infringement, a witness will need to give evidence and be cross examined. Supporting documents can be used. The judge will decide the case on the balance of probabilities.

What are the procedural safeguards in your jurisdiction to ensure the proportionate use, the relevance of the information for the identification of an infringer and the accuracy and correctness of the identification of the infringer, in particular when information is to be provided by a third person, for example an intermediary service provider, for such purposes?

1500 character(s) maximum

We understand that the UK IPO will be responding to this on behalf of the UK.

In your experience, what are the main reasons for not obtaining the requested information?

	Very relevant	Relevant	Less relevant	Not relevant
Unjustified/disproportionate request	☐	☐	☐	☐
Protection of confidentiality of information	☐	☐	☐	☐
Right to respect for private life and/or right to protection of personal data	☐	☐	☐	☐
Information not available (anymore)	☐	☐	☐	☐
Information provided in the request inaccurate	☐	☐	☐	☐
Other	☐	☐	☐	☐

*** In view of your experience with the application of the right of information do you think that the existing rules have helped effectively in protecting IP and preventing IPR infringements?**

- ☐ Yes
☒ No
☐ No opinion

Please explain:

1500 character(s) maximum

The UK had effective rules before the IPRED. Other EU policies have made IP rights harder to enforce. For example the ability of an owner of a website through which trade takes place, to remain anonymous makes it much harder to find infringers and start enforcement proceedings.

*** Do you consider the application of the rules on the right of information to be clear and unambiguous, in particular with regard to requests for information held by intermediaries?**

- ☐ Yes
☐ No
☒ No opinion

*** In view of your experience with the application of the right of information do you see a need to adjust the provisions for the application of that measure?**

- ☐ Yes
☐ No
☒ No opinion

*** Do you see a need to clarify the criteria used to reconcile the requirements of the right to respect for private life/right to protection of personal data on the one hand and the right to effective remedy on the other hand when assessing requests for disclosure of personal data for the purpose of initiating judicial proceedings?**

- ☒ Yes
☐ No
☐ No opinion

Please explain:

1500 character(s) maximum

Currently the right to privacy and personal data seems to go too far. If there is infringement, then identification should be easier, as there is a right to protect property too. If commercial activity is taking place through a website, then it is important that the entity, person or people behind it are easily identified – not just by IP rights holders, but also by customers, tax authorities and law enforcement.

C.2.3. Procedures and courts, damages and legal costs (Articles 3, 13 and 14)

In your experience, what are the reasons for taking infringer to court?

	Very relevant	Relevant	Less relevant	Not relevant
Damages	☐	☒	☐	☐
Provisional and precautionary measures	☐	☒	☐	☐
Injunctions	☒	☐	☐	☐

Other	☐	☒	☐	☐
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Please specify:

500 character(s) maximum

This varies depending on the IP right. We have answered what is more relevant for patents. Other reasons include where there is an obligation to take proceedings under a licence, or to show the market that the IP right owner will enforce their rights.

*** Do you encounter specific problems when dealing with legal actions in a cross-border situation (applicant or defendant incorporated or resident in another EU Member State)?**

- ☒ Yes
☐ No

*** Please explain:**

1500 character(s) maximum

Different Member States have different regimes. It is often necessary to instruct a lawyer in another jurisdiction to assist and to ensure that assumptions as to how to run a case in your own jurisdiction, do not lead to errors when working in another jurisdiction. There will be hidden nuances as to how the law and procedure works. In a recent UPC mock trial, it became apparent that there are very different approaches as to how an injunction should be worded. Using wording suitable in a different jurisdiction would not have achieved the right result.

In your jurisdiction the award of damages as a compensation for the prejudice suffered as a result of an infringement can include?

	Yes	No
Lost profit	☒	☐
Unfair profits	☒	☐
Moral prejudice	☐	☒
Lump sum	☒	☐
Other	☒	☐

Please specify:

500 character(s) maximum

Damages in English law are compensatory for loss suffered, not punishment on Defendant. The alternative is to seek an order to recover profits made by Defendant. Claimant must prove the damage caused by sale of infringing product. If Claimant cannot show that a sale was lost, then it is likely to receive a reasonable royalty, rather than lost profit. Other damages may be

recovered if they can be attributed to the infringer's actions. Additional damages for "flagrancy" are available in copyright.

*** In your jurisdiction damages are usually granted in full?**

- ☐ Yes
☒ No
☐ Don't know

*** What are the main reasons for not granting damages in full?**

- ☐ Limitations in law
☐ Unjustified request / lack of evidence
☒ Other

Please specify:

1500 character(s) maximum

The question about whether damages are granted in full is not clear. The Claimant may not assert any sum they like is due in damages and expect that to be paid. They must prove that the sum sought is the correct amount which is due. The judge assesses the damages and awards the sum assessed. However, many IP cases are split between a trial on liability and a trial on quantum. Once liability has been found and an injunction granted, parties frequently settle the monetary element.

Main reasons for not granting damages in full:

- Limitations in law
- Unjustified request/ lack of evidence
- Other

Other:

The Claimant must prove what sum is due. If they are not able to provide evidence to support their case, then they will not be awarded the sum they seek.

There is a six year limitation period and damages occurring more than six years before the claim began will probably not be recovered.

If the Defendant does not have any money, the Claimant is unlikely to receive any money.

We would also like to point out that historically, the UK has always distinguished between the damage made to the Claimant and the profit made by the Defendant. The Claimant elected which of the two was to be recovered. The Enforcement Directive has mixed these two separate forms of compensation together.

*** Is it possible in your jurisdiction for the right holder to claim damages from a third party who actively and knowingly facilitates infringements of IPRs?**

- ☒ Yes
☐ No
☐ Don't know

Please specify:

1500 character(s) maximum

The rights holder will need to prove elements of Joint Tortfeasorship in order to make the third party liable for the infringement. We are aware that these rules vary across Europe.

*** Overall, in view of your experience with the application of the rules for setting damages do you think that the existing rules have helped effectively in protecting IP and preventing IPR infringements?**

- ☐ Yes
☒ No
☐ No opinion

Please explain:

1500 character(s) maximum

The UK had an effective regime for recovery of damages. So we do not feel that the IPRED has improved the situation. We also do not feel that the IPRED prevents IP infringement. In the UK, what has assisted IP Rights owners to recover damages when infringement has occurred has been the improvement in court process, in particular the more streamline procedures in the IPEC and the costs capping regime. The IPEC has now had far more damages cases in the last few years, than the Patents Court. So companies are now litigating these instead of settling.

*** In view of your experience with the application of the rules for the calculation of damages do you see a need to adjust the application of that measure?**

- ☒ Yes
☐ No
☐ No opinion

Please explain:

1500 character(s) maximum

We chose the 'Yes' answer so that we could include additional notes. Our answer to the question is in fact 'No'. There is no need to amend the IPRED. However, there should be more clarity and explanation by the CJEU, as to how the judges in different jurisdictions apply the rules and decide how to calculate damages. These decisions will come in due course. Changing the rules might negate explanations already given by the CJEU and create further uncertainty.

In your jurisdiction the reimbursement of legal costs incurred by the successful party can cover?

	Yes	No

Court fees for instituting proceedings	☒	☐
Other court fees	☒	☐
External expert(s) costs	☒	☐
In-house costs	☒	☐
Attorney's charge	☒	☐
Additional attorney's fees	☒	☐
Other	☐	☐

*** Are there any limitations on the recoverability of legal costs stipulated in the legislation/established by case law in your jurisdiction?**

- ☒ Yes
☐ No
☐ Don't know

Please explain:

1500 character(s) maximum

There is a cost recovery regime in the UK which sets what sort of costs can be recovered. Generally, costs recovery is dependent on two factors: reasonably incurred costs, and reasonable in amount. In the IPEC, the costs are capped by stage of the litigation and then the overall amount of costs to be recovered is capped at £50,000 (+ Court fees, appeal fees and some other matters such as interest and VAT). Costs may either be summarily assessed or subject to detailed review (known as taxation).

A party must be able to prove what costs they incurred and for what actions, so this leads to detailed record keeping. Failure to keep proper records, can lead to cost claims being refused.

*** In view of your experience with the application of the rules for the reimbursement of legal costs do you think that the existing rules have helped effectively in protecting IP and preventing IPR infringements?**

- ☐ Yes
☒ No
☐ No opinion

Please explain:

1500 character(s) maximum

We do not think that the IPRED prevents IP infringement. It merely deals with the remedies which can be obtained once infringement has occurred. The IPRED has not changed the position in the UK. Inherent complexities and uncertainty in IP litigation is more likely to result in settlement than anything in the IPRED.

* In view of your experience with the application of the rules for the reimbursement of legal costs do you see a need to adjust the application of that measure?

- ☒ Yes
☐ No
☐ No opinion

* Please explain:

1500 character(s) maximum

We mean "no" - but only get this box when we say "yes".

There is no need to amend the IPRED. The way in which cost recovery works is a matter of national implementation.

Additionally, it should be noted that the UK cost recovery system, where the losing party pays the costs, seems to deter patent trolls.

C.2.4. Provisional and precautionary measures and injunctions (Articles 9 and 11)

* From your experience what kind of provisional measures and injunctions are most frequently requested?

- ☐ Provisional measures against an infringer
☒ Injunction against an infringer
☐ Provisional measures against an intermediary
☐ Injunction against an intermediary
☐ Don't know

* What is usually the geographical scope of the provisional measures and injunction requested?

- ☒ Domestic
☐ Another EU jurisdiction
☐ Non-EU jurisdiction
☐ Multi-jurisdictional
☐ Don't know

From your experience what are the reasons for applying for a provisional and precautionary measures?

	Very relevant	Relevant	Less relevant	Not relevant
Prevent an imminent infringement	☐	☐	☐	☐
Forbid the continuation of an alleged infringement	☐	☐	☐	☐
Lodging of guarantees	☐	☐	☐	☐

Seizure or delivery up of the goods suspected of infringing an IPR	☐	☐	☐	☐
Blocking alleged infringer's bank accounts and other assets	☐	☐	☐	☐
Precautionary seizure of other movable and immovable property of the alleged infringer	☐	☐	☐	☐
Other	☒	☐	☐	☐

Please specify:

500 character(s) maximum

It is rare in patent actions to seek provisional injunction: they are relevant in pharmaceutical cases where substantial damage will be caused, e.g if a new drug launch will erode Claimant's price and it will not be restored later. An injunction request can be used to obtain security for damages or to get a speedy trial. Provisional measures are also used where Defendant might be dishonest or destroy relevant documents/products, or a third party must provide information before a claim starts.

What are the reasons for not obtaining provisional and precautionary measures against an infringer?

	Very relevant	Relevant	Less relevant	Not relevant
Insufficient evidence	☐	☐	☐	☐
Measure requested disproportionate	☐	☐	☐	☐
No likelihood of success on the merits of the case	☐	☐	☐	☐
Protection of confidentiality of information	☐	☐	☐	☐
Request for a security or an equivalent assurance	☐	☐	☐	☐
Right to respect for private life and/or right to protection of personal data	☐	☐	☐	☐
No commercial scale infringement	☐	☐	☐	☐
Infringer established in another jurisdiction	☐	☐	☐	☐

Other	☒	☐	☐	☐
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Please specify:

500 character(s) maximum

Granting provisional measures can damage Defendant unnecessarily. If there has been wrongful granting of the provisional measures because no infringement was proved then Defendant might be entitled to damages from Claimant. Claimant must usually provide an undertaking to pay those damages and may need to provide security. This risk can put Claimant off from seeking provisional measures. Safeguarding measures can make process expensive for Claimant. Damages may be an adequate remedy.

Against which type of intermediary provisional and precautionary measures and injunctions are most frequently requested?

For the purpose of this consultation:

"Advertising service provider"Advertising agencies, advertising broker

"Contract manufacturing service provider"Contract manufacturing is an outsourcing of certain production activities previously performed by the manufacturer to a third-party. This may concern certain components for the product or the assembly of the whole product.

"Business-to-business data storage provider"Data storage space and related management services for commercial user.

"Business-to-consumer data storage provider"File-storing or file-sharing services for personal media files and data

"Content hosting platform"Platforms providing to the user access to audio and video files, images or text documents.

"Press and media company"Newspaper, broadcaster

- | | |
|---|---|
| ☐ Advertising service provider | ☐ Contract manufacturing service provider |
| ☐ Business-to-business data storage provider | ☐ Business-to-consumer data storage provider |
| ☐ Content hosting platform | ☐ Domain name registrar |
| ☐ Domain name registry | ☐ DNS hosting service provider |
| ☐ Internet Access Provider | ☐ Mobile apps marketplace |
| ☐ Press and media company | ☐ Online marketplace |
| ☐ Payment service provider | ☐ Retailer |
| ☐ Search engine | ☐ Social media platform |
| ☐ Transport and logistics company | ☐ Wholesaler |
| ☐ Other | |

* In your jurisdiction does the availability of provisional and precautionary measures against an intermediary depend on whether or not the infringer has been identified?

- ☐ Yes
☐ No
☒ Don't know

* Is it possible in your jurisdiction to obtain provisional and precautionary measures against any intermediary or is such a measure subject to an active involvement (responsibility/liability) of the intermediary in the infringement?

- ☐ Any intermediary

- ☐ Only intermediaries actively involved in the infringement
- ☒ Don't know

In your experience, what are the reasons for not obtaining provisional and precautionary measures against an intermediary?

	Very relevant	Relevant	Less relevant	Not relevant
Insufficient evidence	☐	☐	☐	☐
Measure requested disproportionate	☐	☐	☐	☐
No sufficient link between the intermediary and the infringement	☐	☐	☐	☐
No likelihood of success on the merits of the case	☐	☐	☐	☐
Protection of confidentiality of information	☐	☐	☐	☐
Request for a security or an equivalent assurance	☐	☐	☐	☐
Right to respect for private life and/or right to protection of personal data	☐	☐	☐	☐
No commercial scale infringement	☐	☐	☐	☐
Intermediary established in another jurisdiction	☐	☐	☐	☐
Other	☐	☐	☐	☐

*** Are you aware of problems in cases of application for provisional and precautionary measures in a cross-border situation (for example infringer or intermediary established in another Member State)?**

- ☐ Yes
- ☒ No

*** Are you aware of problems when executing provisional and precautionary measures in a cross-border situation (judicial authority in another jurisdiction and infringer or intermediary established in your jurisdiction)?**

- ☐ Yes
- ☒ No

*** In your jurisdiction can an injunction against an infringer be issued only to stop an actual infringement or also to prevent further infringements in the future?**

- ☐ Only actual infringement

- ☒ Also further infringements in the future
- ☐ Don't know

***How do you define "further infringements"?**

1500 character(s) maximum

The wording of an injunction is: "...not otherwise to infringe". If the infringer wants to modify the product, then they should check this is not an infringement. If it is, then they may be in contempt of court and could go to prison or be fined.

"Further infringement" refer to any acts that would infringe.

What are the reasons for not obtaining an injunction against an infringer?

	Very relevant	Relevant	Less relevant	Not relevant
Insufficient evidence	☒	☐	☐	☐
Measure requested disproportionate	☐	☐	☐	☐
Protection of confidentiality of information	☐	☐	☐	☐
Right to respect for private life and/or right to protection of personal data	☐	☐	☐	☐
No commercial scale infringement	☐	☐	☐	☐
Infringer established in another jurisdiction	☐	☐	☐	☐
Other	☒	☐	☐	☐

Please specify:

500 character(s) maximum

No injunction will be granted if the IP rights holder fails to show that there was infringement.

What are the reasons for applying for an injunction against an intermediary with regard to a third party using its services infringing an IPR?

between 11 and 11 answered rows

	Very relevant	Relevant	Less relevant	Not relevant
Block access to infringing content online	☐	☐	☐	☒
Stay down of infringing content online	☐	☐	☐	☒

Adopt technical measures such as filtering	☐	☐	☐	☒
De-indexing infringing websites	☐	☐	☐	☒
Permanent termination of domain	☐	☐	☐	☒
Permanent termination of subscriber account	☐	☐	☐	☒
Discontinue providing payment services	☐	☐	☐	☒
Discontinue providing advertising services	☐	☐	☐	☒
Discontinue providing transport services	☐	☐	☐	☒
Discontinue manufacturing of infringing products	☐	☐	☐	☒
Termination of lease for commercial premises	☐	☐	☐	☐
Other	☒	☐	☐	☐

Please specify:

500 character(s) maximum

We are not in a position to answer questions about intermediaries. We had to tick a few boxes as it would not otherwise let us submit our survey response. Please disregard our answers to this question.

*** Is it possible in your jurisdiction to obtain an injunction against any intermediary or is an injunction subject to an active involvement (responsibility/liability) of the intermediary in the infringement?**

- ☐ Any intermediary
☐ Only intermediaries actively involved in the infringement
☒ Don't know

*** In your jurisdiction can an injunction against an intermediary be issued only to stop an actual infringement or also to prevent further infringements in the future?**

- ☐ Only actual infringement
☐ Also further infringements in the future
☒ Don't know

*** Is it possible in your jurisdiction to obtain an injunction against an internet intermediary forbidding the continued access to the material that is allegedly infringing IPR when that injunction does not specify the exact measures which that access provider must take?**

- ☐ Yes
☐ No
☒ Don't know

To your knowledge what are the reasons for not obtaining an injunction against an intermediary?

	Very relevant	Relevant	Less relevant	Not relevant

Insufficient evidence	☐	☐	☐	☐
No sufficient link between the intermediary and the infringement	☐	☐	☐	☐
Measure requested disproportionate	☐	☐	☐	☐
Protection of confidentiality of information	☐	☐	☐	☐
Right to respect for private life and/or right to protection of personal data	☐	☐	☐	☐
No commercial scale infringement	☐	☐	☐	☐
Intermediary established in another jurisdiction	☐	☐	☐	☐
Other	☐	☐	☐	☐

*** Are you aware of problems in cases of application for an injunction in a cross-border situation (for example infringer or intermediary established in another Member State)?**

- ☐ Yes
☒ No

*** Are you aware of problems when executing an injunction in a cross-border situation (judicial authority in another jurisdiction and infringer or intermediary established in your jurisdiction)?**

- ☐ Yes
☒ No

*** In view of your experience with the application of the rules for provisional and precautionary measures and injunctions do you see a need to adjust the application of these measures?**

- ☐ Yes
☒ No
☐ No opinion

*** Should the Directive explicitly establish that all types of intermediaries can be enjoined?**

- ☐ Yes
☒ No
☐ No opinion

Please explain:

1500 character(s) maximum

The Commission should be very careful before imposing more regulatory duties on intermediaries. Also, care should be taken to define who an intermediary is. There needs to be a careful balance. Increasing regulatory burdens can result in more costs to consumers and damage to the economy as a whole. All IP rights holders are also potential infringers of competitor IPRs. By definition, each company is therefore seeking to avoid more IPRs than it holds. This is a regulatory burden. So all measures need to balance the interests of all parties - including the right of consumers not to be overcharged by monopoly owners.

*** Should the Directive explicitly establish that no specific liability or responsibility (violation of any duty of care) of the intermediary is required to issue an injunction?**

- ☐ Yes
☐ No
☒ No opinion

*** Should the Directive explicitly establish that national courts must be allowed to order intermediaries to take measures aimed not only at bringing to an end infringements already committed against IPR using their services, but also at preventing further infringements?**

- ☐ Yes
☐ No
☒ No opinion

*** In that respect should the Directive establish criteria on how preventing further infringements is to be undertaken (in the on-line context without establishing a general monitoring obligation under the E-Commerce Directive)?**

- ☐ Yes
☐ No
☒ No opinion

*** Do you see a need for criteria defining the proportionality of an injunction?**

- ☐ Yes
☒ No
☐ No opinion

Please explain:

1500 character(s) maximum

A patent, trade mark or design right carries a right to exclusivity. Injunctions should not be subject to strict proportionality definitions as this would fundamentally undermine the nature of these IP rights and deal with each specific case. Additionally, while there is no "unfair" competition law in the UK, there are compulsory licencing mechanisms in place in patent law which balance monopoly rights.

*** Do you see a need for a definition of the term "intermediary" in the Directive?**

☐

- Yes
- ☐ No
- ☒ No opinion

*** Do you see a need for a clarification on how to balance the effective implementation of a measure and the right to freedom of information of users in case of a provisional measure or injunction prohibiting an internet service provider from allowing its customers access to allegedly IPR infringing material without specifying the measures which that service provider must take?**

- ☐ Yes
- ☒ No
- ☐ No opinion

Please explain:

1500 character(s) maximum

This is only relevant to copyright and does not apply to patents, trade marks or design rights. There should be either no change, or if changes are to be made, they should apply only to copyright and not all IP rights. Copyright is currently the least harmonised IP right in the EU. It would be better to amend the copyright law to say what should or should not be enjoined than to amend the IPRED.

*** Do you see a need for other amendments to the provisions on provisional and precautionary measures and on injunctions?**

- ☒ Yes
- ☐ No
- ☐ No opinion

Please explain:

1500 character(s) maximum

We mean "no" - but only get this box when we say "yes". No changes are needed. It is important that there should be a balance between the proper enforcement of IP rights and protection for defendants where IP rights are asserted for an unjustified commercial advantage. IP rights are so varied that whilst easier enforcement for a clear cut case of infringement for blatant counterfeiting and piracy might be appropriate, this is not appropriate across the board. Notwithstanding our view that there should be no change to the IPRED, if the Commission was minded to make any changes to provisions relating to injunctions in response to other respondents, these should be restricted to those specific instances, both of which need clear definitions. Only certain types of IP infringement amount to counterfeiting or piracy.

C.2.5. Publication of judicial decisions

*** In your experience, do parties request in legal proceedings instituted for infringement of an**

IPR the decision to be published in full or in part?

- ☒ Yes
☐ No
☐ Don't know

Please explain:

1500 character(s) maximum

This question is ambiguous. Article 15 of IPRED allows for the publication of judicial decisions at the request of the applicant and the expense of the infringer. This is not compulsory.

Whilst it may sometimes be appropriate for the Defendant to advertise its wrong doing, there may also be a need to for the Claimant to advertise that the Defendant is not, after all an infringer - see Apple v Samsung.

Far more importantly, we see the need for judgements and court orders to be published for the information of all. This should not rely on the Claimant seeking an order or the Defendant having to pay. We suggest that all decisions should be collected and published on an international database. Many UK judgements can be found on BAILII. Whereas it can be difficult to find judgements in some jurisdictions or they may only be available through private databases. We understand that the EUIPO is to begin to collect certain decisions. Improving this does not require amendment of the IPRED.

*** Are judicial decisions related to the enforcement of intellectual property rights publicly available in your jurisdiction?**

- ☒ Yes
☐ No
☐ Don't know

Please provide detail and reference:

1500 character(s) maximum

Many, but not all decisions are available. Some are available on the court website, e.g the Supreme Court. Others need to be reported by a law report or sent to Bailii to be available. It should be a requirement on Member States to publish the public parts of their judgments and orders - in all cases, not just IP.

*** Do you see a need for / added value in a more systematic dissemination of the information concerning the decision in legal proceedings instituted for infringement of an IPR?**

- ☒ Yes
☐ No
☐ No opinion

Please explain:

1500 character(s) maximum

This would be beneficial to rights holders, as well as legal representatives looking for this information.

C.6. Other issues

Do you think that the existing rules strike the right balance between the need to effectively protect IPR and preventing IPR infringements and the need to protect fundamental rights including the right to respect for private life, the right to protection of personal data, the freedom to conduct a business as well as the freedom of information?

- ☐ Yes
☒ No
☐ No opinion

*** Please explain:**

1500 character(s) maximum

The Directive is good, but aspects of EU privacy law are not joined-up. Other initiatives, such as those which allow those operating commercial businesses to hide the ownership of the website militate against protection of IP rights.

*** Are there any other provisions of the Directive which, in your view, would need to be improved?**

- ☐ Yes
☒ No
☐ No opinion

D. Issues outside the scope of the current legal framework

D.1. Specialised courts

*** Do you have in your jurisdiction dedicated courts, courts' chamber or judges specialised in IP matters?**

- ☒ Yes
☐ No
☐ Don't know

*** Which rights were covered by the competence of the court?**

- | | |
|---|---|
| ☒ Copyright | ☒ Community trademark rights |
| ☒ Community design rights | ☒ Rights related to copyright |
| ☒ National trademark rights | ☒ National design rights |
| ☒ Patent rights (including rights derived from supplementary protection certificates) | ☒ Geographical indications |
| ☒ | ☒ |

Rights of the creator of the topographies of a semiconductor product

☒ Sui generis right of a database maker

☐ Utility model rights

☐ Don't know

Plant variety rights

☒ Trade names (in so far as these are protected as exclusive property rights in the national law concerned)

☐ Other

*** Does legal action at a court specialised in IPR matters provide an added value compared to legal actions at other courts?**

☐ Yes

☒ No

☐ No opinion

Please explain:

1500 character(s) maximum

We mean "yes" - but only get this box when we say "no". Yes it is beneficial. It is beneficial to have specialist judges in IP matters. This can cut down on the length of the trial, which saves costs. Also decisions are more likely to be correct. Note that IP is not the only area of law to benefit from specialist courts and there are others, such as the Companies Court, the Family Court and the Admiralty Court.

D.2. Alternative procedures

*** In your view and with regard to civil litigation in the area of IPR enforcement do any of the following procedures provide an added value or alternative to court proceedings worth considering?**

at most 7 choice(s)

☒ Fast track procedure

☒ Arbitration

☒ Mediation

☒ Fact-finding procedures

☒ Online dispute resolution

☒ Cease and desist procedures

☒ Other

Please specify:

500 character(s) maximum

Mediation and expert determination can help in some cases to reach a binding agreement more quickly, if there are no delaying tactics by the parties. Arbitration can help with cross jurisdiction matters.

D.3. Other issues outside the scope of the current legal framework

*** Do you identify any other issue outside the scope of the current legal framework that should be considered in view of the intention to modernise the enforcement of IPR?**

- ☒ Yes
☐ No
☐ No opinion

*** Please specify:**

3000 character(s) maximum

The current IPRED framework should not be modified.

The operations of different European Union trade mark and design courts should be compared and contrasted.

There should be more joined up thinking about what is going on commercially, especially in regards to finding the identity of the people behind trading websites. This is also important for money laundering considerations.

The UPC will be opening soon. Mock trials that have taken place have shown differences in national procedures and practices. It will be interesting to look into this and develop potential guidance on bringing these procedures and practices together, getting the industry involved in the discussion from the beginning.

Harmonisation is useful, but it is important to have the agility to constantly review and improve legal proceedings.

E. Other comments

*** Do you have any other comments?**

- ☒ Yes
☐ No

*** Please specify:**

3000 character(s) maximum

Below is the rest of our answer for B.4 and the question: Do you think that IP rightholders are frequently using litigation as a means of protecting their IPRs? In your opinion, what is the reason for this?

Costs: In the UK, the winning party has his costs paid by the losing party, although costs that can be received from the losing party in the IPEC are capped. The risk of paying the losing party's costs, as well as their own, may discourage some parties from litigating, particularly if they have weak cases.
Complex procedures: Procedures are complex, but this is somewhat inevitable - first the existence or validity of the right and its ownership must be established, then the infringement must be established. The procedure for the assessment of damages is a still further complexity. Much can turn on the

facts presented to the court.

ADR: Some ADR methods may achieve better results, because, for example, a mediator may explore creative solutions beyond the jurisdiction of the court, but this depends on what is being asked for. Arbitration can be more successful for international disputes as it can be easier to enforce an arbitration award than a court order internationally. For complex cases such as those related to the determination of FRAND arbitration may be a good solution provided most of the terms have been already agreed by the parties. However, ADR does not generally provide Claimants with an injunction.

Length of proceedings: The small claims tracks of the IPEC has proved successful in allowing people to bring claims which would otherwise not have been brought. There has been pressure for proceedings to be quick, and the IPEC has assisted in that. Quick proceedings are often victims of their success, as it then encourages more people to use it and creates more work for the court and in the long term, can result in longer times to get to trial.

Predictability: If the outcome was predictable, parties would tend to settle in the UK rather than go to trial. The cases which tend to be argued are worth more and there is likely to be more chance of the judge having to make a finely balanced decision.

Other comments about the consultation:

Some questions are not worded to reflect the real issues. Also, in order to provide comments, we have had to give the wrong answer first, and then correct that in the narrative answer. The survey, whilst worded in relation to all IP rights actually appears to be focused on the digital space and does not seem to take into account patents, trade marks and designs.

Useful links

Enforcement of intellectual property rights

(http://ec.europa.eu/growth/industry/intellectual-property/enforcement/index_en.htm)

The Single Market Strategy (http://europa.eu/rapid/press-release_MEMO-15-5910_en.htm)

The Digital Single Market Strategy (http://europa.eu/rapid/press-release_MEMO-15-4920_en.htm)

Background Documents

[DE] Datenschutzerklärung (/eusurvey/files/6b3f6f9f-fbbc-41a1-8f2c-b9a758dd5b45)

[DE] Hintergrund (/eusurvey/files/d4a4dfac-6727-4f34-b5b9-fd9a4a35415d)

[EN] Background information (/eusurvey/files/d7d4225a-b4d3-4b88-ba51-ac199c2c5fbd)

[EN] Privacy statement (/eusurvey/files/bdb37dfc-4bb6-4b76-8e30-e29507d2b92d)

[ES] Antecedentes (/eusurvey/files/96ab9918-056e-49f8-bd56-025d50e98d74)

[ES] Declaración de confidencialidad (/eusurvey/files/0008481f-5985-434e-acee-a29247d96246)

[FR] Contexte (/eusurvey/files/e5215029-8bbc-4cd4-ad61-46a9ac967711)

[FR] Déclaration relative la protection de la vie privée (/eusurvey/files/ae799bbe-6492-42e9-b9df-8a619da5bcd1)

[IT] Contesto (/eusurvey/files/7079e177-0398-489c-9ed3-8c1ffc5141c9)

[IT] Informativa sulla privacy (/eusurvey/files/66f8f74e-5e5f-40a9-ac30-230b52dc12d6)

[PL] Kontekst (/eusurvey/files/b243ed40-dd6d-411b-8b9c-00d1c533b87a)

[PL] Oświadczenie o ochronie prywatności (/eusurvey/files/1894672a-bff5-4032-bb88-5b5fe3cbb697)

Contact

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