

UFI Recommendations for the Protection of Intellectual Property Rights at Exhibitions



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INTRODUCTION

An exhibition, as the entire marketplace of an industry sector, is the perfect location for product and service counterfeiters to undertake illegal practices. But exhibitions also contribute in the fight against these practices as they represent an easy way for manufacturers and service providers to identify counterfeited products and services, and potential threats. Exhibitions provide excellent opportunities to obtain information on competitors and to discover the existence of new products and services, hence pinpointing potential **IPR** infringements at the initial stage prior to large scale manufacturing and commercialisation.

One of the missions of **UFI, The Global Association of the Exhibition Industry**, is to help its members and the exhibition industry in defending business interests, whilst promoting the exhibition media as the most powerful marketing, sales and communications tool. In this respect, **UFI** has drawn up recommendations to be used by any exhibition organizer to assist their clients – the exhibitors and the visitors – in the protection of their **Intellectual Property Rights** and in the defence of these rights if infringed or endangered. This document has been elaborated to provide guidance on the necessary measures to be taken for effective IPR protection and enforcement during trade fairs. The scope is worldwide and hence covers generalities which are applicable in most countries. More in-depth or more rigorous actions which may differ from country to country can be undertaken if deemed necessary.



TERMINOLOGY AND BASIC INFORMATION

Piracy and **counterfeiting** are more or less equivalent terms. They consist in the illegal reproduction or imitation of products/services which **infringes** intellectual property rights.

Intellectual Property (IP) is divided into two categories:

- ✚ Industrial Property, which includes trademarks, patents, utility models and designs;
- ✚ Copyright and neighbouring rights, which includes literary and artistic works such as novels, poems and plays, films, musical works, artistic works such as drawings, paintings, photographs and sculptures, and architectural designs.

Trademarks (or its commercial equivalent brands)

A trademark identifies and distinguishes the products or services of a company from those of its competitors. Several types of trademarks exist: e.g. word marks, device marks (logos), three dimensional marks, colour marks or combinations thereof.

The protection of a trademark provides the holder with its exclusive right of use and the potential to defend against the use and registration of identical or similar trademarks which could cause confusion in the public eye.

The protection of a trademark is generally for a 10 year period and can be renewed.

The protection of a trademark is effective on a territorial level (i.e. the exclusive right exists only in the countries in which the trademark has been registered). A single protection is possible for the entire European Union (currently 27 member states).

Patents

Patents cover inventions and protect the (technical) characteristics of a product or a process. The patent owner can therefore prevent a third party from exploiting the invention. He may use the invention provided the product or process contains no features covered by another patent. Otherwise, the parties involved should consider cross-licensing their rights.

The duration of a patent is generally 20 years and is subject to fee payment (usually annual). It is also possible to renew the patent.

The protection offered by a patent is effective on a territorial level. A single procedure is available in Europe (currently allowing protection for up to 37 countries) through one examination in one language.

The requirements for the granting of a patent are:

- novelty,
- inventiveness or non obviousness,
- susceptible of industrial application or usefulness.

In most countries, there must be a non-obvious technical contribution to the state-of-the-art. The state-of-the-art is formed by everything already known to the public before the filing of a patent application (even disclosures by the patent applicant himself).

Special Warning

Because of the “novelty” requirement, it is crucial that a patent is applied before the product or process is made available for the first time to the public, for example, at an exhibition...

Utility Models, Petty Patents and Other Types of Patents

The utility model and petty patent are also rights which genuinely protect an invention. The requirements for utility models and petty patents are usually the same as those for patents. In most cases, there is no detailed examination as to the validity of such rights. For this reason, a utility model can be obtained quickly, easily and cost-effectively. The duration is shorter than for a

regular patent, and the protection may be narrower in some countries. Other types of “patents” exist in some countries, such as plant patents or plant variety protection to protect a new variety of plants.

Designs

A design protects the appearance of the whole or a part of an industrial or handicraft product determined, in particular, by the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation, provided this appearance was **new** and had a so-called **individual character** at the time of filing the application. A design can be two-dimensional or three-dimensional.

Special Warning

As for patents, and because of the “novelty” requirement, it is important that design protection is applied for before an exhibition, i.e. before it is presented for the first time to the public.

The duration of protection varies from country to country. In the European Union for example, a registered design is valid during 5 years, and can be renewed for up to a maximum of 25 years.

The protection of a design is effective on a territorial level. A single protection is possible for the whole European Union (currently 27 member states).

Copyright

A copyright protects original creations, such as literary and artistic material, music, films, sound recordings and broadcasts, including software and multimedia.

In the US, it is recommended to file a copyright. In most other countries, it is not possible to do so.

Like any property, IP can be rented (**licensed**) or sold (**assigned**).

Due to the complexity of the IP registration procedure, the use of the services of IPR professionals is highly recommended.

In some countries, unregistered designs and trademarks (but not patents) may be protected, but usually for a much shorter and narrower protection.

Claims arising from the law against unfair competition may apply even if the copied product is not protected by the above-mentioned property rights, but only under special circumstances, i.e. when the imitation is slavish.

Trademarks, patents and designs registered in one country are not protected in other countries. For example, US trademarks, patents and design rights alone do not provide protection in the countries of the European Union and vice-versa. In the same way, the IP acquisition or registration procedure may differ from one country to another. In particular, IP acquisition in the USA differs substantially from most other countries.

Whilst acquisition and protection of IPR may not be similar from one country to another, international agreements to harmonize some of the main aspects of the IP laws have been adhered to by most countries. The most important agreement in this regard is TRIPS (Agreement on Trade-Related Aspects of Intellectual Property Rights) enacted by the World Trade Organization.

The owner of an IP right can enforce that right through different actions – warning/request to discontinue use letters to infringers; customs actions; court actions; dispute-settling by mediation and arbitration. The collection of proof (in that case and in many countries, a “descriptive seizure”

procedure or (“Anton Piller” order) enables the IP right owner to obtain the decision through the Courts to send a neutral expert to the premises (offices, exhibitions) of an alleged infringer in order to describe the alleged infringement and seize evidence.

In conformity with the laws of many countries, the exhibition organizers are usually not legally authorised to take action against infringements. Only the exhibitors (IP right owners), or their lawyers, can take effective action against infringers (pirates or counterfeiters).

An effective method of preventing the exhibiting of plagiarised copies before a fair opens is border seizure by the customs authorities. Customs offices check merchandise that is being imported or exported or is in transit to see whether it contains products that infringe protected rights. Their work is not limited to inspections at border stations but also includes, as part of industrial property protection, monitoring and inspection at border customs offices, inland customs offices and free ports or by mobile control units. On receipt of an application showing the right of a brand manufacturer, customs authorities can stop suspicious consignments, examine them, take samples, destroy counterfeits and supply information to the brand manufacturer.

During the trade fair, an exhibitor can take the following measures with the help of his lawyer:

- ✚ Declaration to cease and desist: The “copier” signs an undertaking that he will no longer offer the copied products for sale and will pay a fine in the event of a further infringement.
- ✚ Preliminary Injunction: The holder of the patent or design right obtains a temporary court injunction prohibiting the “copier” from selling and exhibiting certain products.



LIST OF RECOMMENDATIONS

UFI advises exhibition professionals to undertake different actions, in order to guarantee that a fair business environment is ensured during tradeshows. Below is a list of recommendations of actions and measures that should be taken by organizers to inform, protect and assist their exhibitors in acting against brand and product piracy:

1. Before the event, organizers should provide exhibitors with information on IPR protection via a specific brochure to be sent out with the registration/participation forms, on the organizer's website, in the exhibitors' manual, or in the tradeshow's General Terms and Conditions. This information should contain advice to exhibitors, such as:
 - ✚ Exhibitors should protect and register trademarks, patents or designs before the tradeshow starts, to obtain a valid right (*an exhibition destroys novelty*) and to be able to make use of all the forms of legal protection, in general and during the event.
 - ✚ For that purpose, the consulting and advice of a specialized patent and trademark attorney regarding registration alternatives, requirements, procedures and maintenance is highly recommended.
 - ✚ Contact details of the person responsible for IPR issues within the organizing company should be provided, as well as the contact details of local/national IPR organizations, customs authorities and patent and trademark attorneys.
 - ✚ Before the exhibition, an exhibitor who believes that another exhibitor will infringe his rights should make an appropriate application to the customs authorities (when applicable), who can then stop suspicious consignments, investigate them, take samples, and destroy copies.
 - ✚ Exhibitors should bring to the trade fair original documents or certified copies of their patent or trademark rights, so that a possible infringement may be established during the event. Any verdict already obtained against an exhibiting pirate should also be included.
2. Furthermore, in order to assist exhibitors to address IPR complaints or infringements during trade fairs, organizers should offer a list of local IP attorneys willing to represent exhibitors who wish to pursue legal action against an alleged infringer.
3. Organizers should provide on-site or on-call experts (IP attorneys, customs authorities) to be available during the event, so as to offer legal advice to those affected by an IPR infringement to identify any counterfeit products during the trade fair.
4. Organizers should be able to provide a neutral arbitration, arbitrator, or judge to help determine if there is a violation or to resolve IPR disputes during the trade fair.
5. Organizers should provide interpreters to facilitate communication in the case of disputes with foreign exhibitors.
6. When appropriate and if possible, organizers should provide an on-site office, a special stand or a point of contact, to deal with any IPR requests or complaints for the entire duration of the trade fair.
7. In order to protect exhibitors from counterfeiting or IPR infringement practices during trade fairs, exhibitors should be encouraged to indicate that their products or services are protected by IP rights, where applicable.

USEFUL LINKS

- **WIPO (World Intellectual Property Organisation)**
<http://www.wipo.int>
(Contains comprehensive information on international trade marks and their protection.)
- **OHIM (Office for Harmonisation in the Internal Market – Trade Marks, Designs and Models)**
<http://oami.europa.eu/>
(Contains important information on EU trade marks and their protection.
For anti-counterfeiting safeguards: <http://oami.eu.int/it/aspects/piracy.htm>)
- **EPO (European Patent Office)**
<http://www.european-patent-office.org/>
(The EPO provides a uniform application procedure for individual inventors and companies seeking patent protection in up to 37 European countries.)
- **European Commission: Customs Matters**
http://ec.europa.eu/taxation_customs/customs/index_en.htm
(Contains all the new developments and solutions to problems relating to customs, with detailed information on counterfeiting)
- **REACT (European Anti-Counterfeiting Network)**
<http://www.snbreact.nl>
(Aims at fighting counterfeit trade by providing a full package of legal and practical services to its members)
- **STOP (U.S. Commerce Department's Strategy Targeting Organized Piracy)**
<http://www.stopfakes.gov>
(Information on IPR protection in the USA and overseas)
- **United States Patent and Trademark Office**
<http://www.uspto.org>
- **The China Patent Trademark Office**
<http://www.chinatradeoffice.com/about/laws2.jsp>
- **Japan Patent Office**
<http://www.jpo.go.jp>
- **The Korean Patent Office**
<http://www.kipo.go.kr/>
- <http://www.ip-links.de>
(Links to Intellectual Property offices in several countries, and related organizations, databases, publications and guidelines).



UFI would like to acknowledge and thank the contribution of GEVERS in reviewing this document.

GEVERS - Patent, Trademark and Design Attorneys
<http://www.gevers.com>



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