



European IPR Helpdesk

Fact Sheet

Defending and enforcing IP

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Introduction

Organisations are increasingly facing situations where they believe that others are using their intellectual property (IP) rights unlawfully. This is what is commonly referred to as infringement of IP rights. The following are some examples of potential infringement acts:

- Manufacturing of a patented technology without prior authorisation of its owner;
- Marketing of a similar good bearing a third party's trade mark (counterfeit product);
- Distribution of a music album CD without the copyright owner's consent (pirated good).

In such situations owners should consider taking steps to assert their IP rights. This is called enforcement, which in practical terms means compelling others to act in accordance with your proprietary rights. To this end, it is important to consider taking adequate measures in order to prevent potential infringements.

Starting from an overall understanding of the relevance of IP "from the idea to the market", the aim of this fact sheet is to point out that in order to enforce IP

rights it is vital that organisations be aware of the intangible assets they own and take steps to protect and properly manage them. In so doing, organisations having IP as an underlying business asset will be less susceptible to IP abuses. Should an IP right infringement occur it is suggested that alternative mechanisms to resolve disputes are explored and that, only when this is not a viable solution, you enforce your rights through legal proceedings.

However, as a general rule, IP rights are subject to national regulations, particularly insofar as their enforcement is concerned. Therefore, while in the European Union a lot of effort is being put into harmonising the national IP laws, it is important to bear in mind that to know with certainty what enforcement actions are available at country level, national laws need to be looked at carefully.

1. What is IP? How do I know if I need it?

IP is any form of original creation that can be bought or sold. The four main types of IP are [patents](#), [trade marks](#), [industrial designs](#) and [copyright](#). There are many simple and cost effective ways of protecting your ideas and your business. The information below shows what you need to think about from the beginning of an idea to starting a new business, and marketing and manufacturing your product or service:

New idea

When you have a new idea, it's possible to check whether your idea already exists or to identify existing technology to help deliver that idea by using patent databases.¹

Development phase

There are two main areas to consider when developing your idea:

- **Licensing-in**: you may need to [licence](#) other people's technology to help you to develop your idea, either from an academic institution or another business;
- **Partnering**: collaboration with other business or research organisations can be vital to the development phase in order to acquire technical, financial and human resources internally lacking. To this end, it is imperative to negotiate and conclude the necessary contracts before entering in such collaborations. Rules on IP and confidentiality must be included in these agreements to avoid potential pitfalls.² If you talk to anyone about any new secret, idea or collaboration, make sure that you ask them to sign a [non-disclosure agreement](#) first.

¹ For information on how to carry out a patent search using one of the most used patent databases, Espacenet, please consult the European IPR Helpdesk fact sheet on this topic available in our online [library](#).

² Helpful guides such as the UK Intellectual Property Office's Lambert Tool Kit can help with this.

IP protection (pre-market entry stage)

When you are in the development phase of developing your product, it is crucial that you consider how to protect it:

- If it would be difficult to copy the process, construction or formulation from your product itself, a **trade secret** may give you the protection you need.
- You could file for a patent to have your technology protected from your competitors. Note, you must **not** tell anyone about your idea before it is filed. So keep valuable information secret!
- If the design of your product is unique and makes you stand out from your competitors then consider **design registration**.
- Original, creative and artistic works are automatically covered by copyright.

Starting a business?

If your business is new, there are a number of elements which you may want to take into consideration:

- All EU countries have a process for registering businesses.³ However, just because you have registered your business, it doesn't mean that the IP in that name is protected – it's possible that other people may use it. Your name and brand is a valuable asset so you may want to think about protecting it by registering it as a trade mark.
- Most businesses will develop a website to promote their products and services. Many will subcontract this work to web developers so it is worth remembering that a contractor will retain the copyright on any work they do for you unless it is specifically assigned to you in the contract. The universal copyright symbol © together with the owner's name and date should be added to any of the original information on your website.⁴
- You may want to produce brochures outlining your product or service along with any technical manuals. If you write this yourself, it is automatically protected by copyright
- Raising finance can be vital to the growth of a business and the launch of a new product or service. Before talking to any investors you should ensure that they sign a non-disclosure agreement.

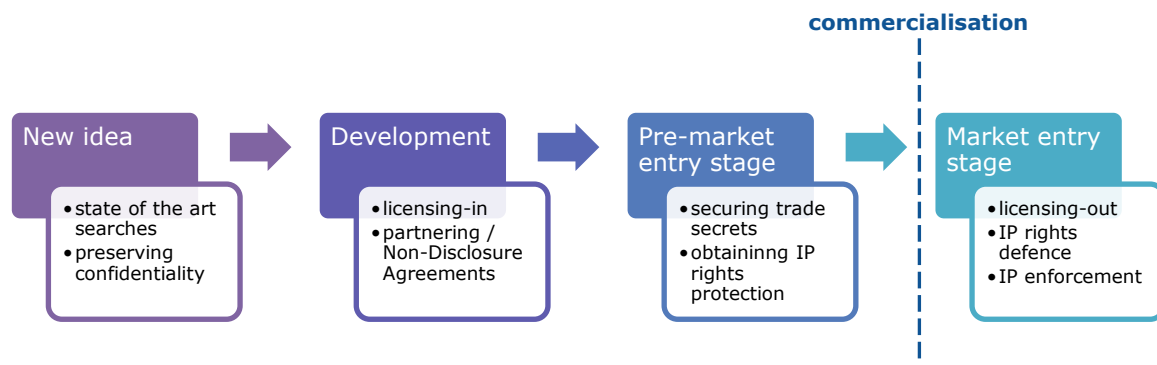
IP Protection (market entry stage)

There are different IP-related issues to consider here, particularly if you are involved in the creation of physical products:

³ More information on how to register a business are available at the European Business Register (EBR), a network of National Business Registers and Information Providers from currently 28 European countries, at <http://www.ebr.org/>.

⁴ For more information on the how to deal with IP issues when creating a website, you can read the European IPR Helpdesk fact sheet on this topic, available in the [library](#).

- You might not manufacture your products in-house, and sub-contract this out instead. If you do, protect yourself with a non-disclosure agreement so that your products cannot be copied.
- If you have a patent, you may decide to exploit it by licensing your technology to other businesses.
- Enforcing your intellectual property rights: It is best practice to constantly monitor the market, to make sure that you identify any person copying or imitating your product and stop infringements.



2. How do I register?

How you register depends on which IP right(s) you are dealing with. For some rights, it is possible to register at national, European or international level. For example, if you wish to register a trade mark, you can do this at national level with one or more European Member State. The same applies to patents and design rights. Please refer to your national authority website for further details.⁵

If you do business in the EU marketplace, you might want to apply to the Office for Harmonisation in the Internal Market (OHIM) for a Community Trade Mark which is legally enforceable and enjoys uniform protection in all 28 Member States. OHIM is also responsible for managing the Registered Design Right, which offers you a protection throughout the EU market. To have an invention protected at European level, a patent application needs to be filed at the European Patent Office (EPO). However, differently from the OHIM, the EPO grants patents having the effect of a national patent in designated countries (max. 38). Therefore, you may choose the countries where to seek protection and later decide whether to maintain it in force in some or all of them.

⁵ For more information on national authorities managing IP rights registration processes, visit Innovaccess, the European network of National Intellectual Property (IP) Offices from 30 European countries at <http://www.innovaccess.eu/map.php>.

Finally, another possibility is to seek international registration of your IP rights. The World Intellectual Property Organisation (WIPO) is the managing body for the international registration route.

There are also some rights such as copyright that, in a majority of countries, do not need to be registered (although you may need to prove things such as authorship and the date of the creation of the work). By the same token, the [unregistered community design](#) does not require a formal registration and gives you protection for 3 years automatically after the design is made available to the public.

National route

- National Intellectual Property Offices

European route

- European Patent Office
- Office for Harmonisation in the Internal Market

International route

- World Intellectual Property Organisation

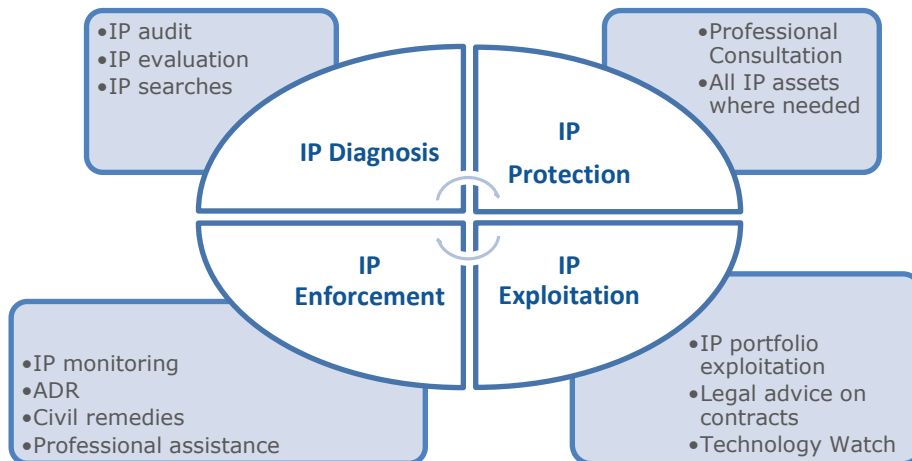
3. How can I reduce the risks of my rights being infringed?

After having secured the IP rights via the competent authorities, companies need to integrate considerations about their intangible assets within their overall business management. Indeed, proper management of IP is essential for its effective enforcement, both being part of an efficient and coherent IP policy.

In fact, it would be much less complex, and cheaper, to take measures to secure IP and avoid potential infringement than to take enforcement actions. For all these reasons, IP management is essential.

Accordingly, it would be a lot easier to enforce IP rights if they have been accurately developed and validated in the first place, if the IP is well documented and if, where appropriate, it has been registered.

Expanding on the points highlighted under section 1, the followings should be taken into account as a first line of IP defence, to reduce the risks of rights being infringed. In turn, such measures will prove to be useful for organisations to reduce the risks of infringing third parties' rights.



Keep proof of ownership⁶

As a first point, organisations should deal with ownership evidence. In fact, since IP is regularly created by employees, sub-contractors, researchers and the like, it is in the organisations' interest to make sure that they own the intangibles generated by creators *in the course of employment*.

- Establish who is the owner and make sure that the organisation retains the IP rights
- Keep a record of the invention and related files for appropriate periods of time
- Label completely and accurately all products and packaging manufactured or supplied with IP marks

Register IP rights

Organisations should be aware that in most IP infringement proceedings, alleged infringers will make a cross-claim challenging the validity of the IP title. Proving the validity of the IP right involves the identification of creators and the establishment of ownership rights.

It is therefore important to keep all records and consider registering the intangible assets as intellectual property rights, since titles as e.g. patents or utility models are not automatic and have to be granted by competent authorities.

⁶ For a better understanding of the different issues related to the ownership of IP you can read the fact sheet on "Inventorship, Authorship and Ownership", available at the [European IPR Helpdesk library](#).

Audit your IP asset

Before setting policies on IP infringement, it is important to understand the real value of the IP assets that the organisation owns. For this purpose, IP audits should be conducted to identify the organisation's IP assets and ascertain if it is worth prosecuting the IP infringed, or abandoning it as no longer meaningful to the business objectives.

Indeed, such an analysis will allow making informed decisions regarding IP protection and enforcement according to:

- The strength of the relevant IP (e.g. in the case of a patent prosecution, its validity and claim coverage);
- The remaining life of the IP;
- How the product cycle of the technology protected by the IP is affected.

Secure confidentiality

When an organisations' core intellectual asset is represented by trade secrets, it is vital to protect such confidential business information through appropriate measures to ensure that the secret is maintained.

These measures may include:

- Defining the value of confidential business information for the organisation and making employees and business partners aware of it;
- Securing facilities and marking confidential documents;
- Assigning passwords to access such information and encrypting confidential digital information;
- Including confidentiality clauses in employment and commercial contracts, etc.

Such actions are normally required by most national laws, in order to obtain a remedy to any misappropriation of this right. In fact, a trade secret violation is normally regulated under national laws, as at the moment there is no community legislation on the theft of trade secrets or breach of confidentiality.⁷

Establish FTO

IP titles do not necessarily grant the right to commercially exploit a product. Indeed, a new product may incorporate a patented technology owned by a third party. In such cases, it is crucial to define if IP rights belonging to others could be infringed if the organisation sells or manufactures a certain technology. A thorough patent search will help to evaluate such "freedom to operate" (FTO), aiming to minimise the risks of liability for infringement.

⁷ It is worth mentioning that the European Commission has proposed a directive to help protect against the theft of confidential business information. You can follow the progress made at http://ec.europa.eu/internal_market/iprenforcement/trade_secrets/index_en.htm.

It is worth mentioning that specific actions are at the disposal of IP owners to obtain a preventive declaration of non-infringement or validity of IP rights. The application can be lodged either at the national IP offices or at courts competent to decide on IP matters.⁸

Include IP clauses within commercial contracts

Written agreements can also prevent disputes over IP ownership and possible claims of infringement. To reduce the risks of potential disputes, commercial agreements, such as assignments or licences for technology and other material transfers, should be in writing and clear, mainly in terms of IP ownership.

Monitor potential infringements

Effective IP monitoring is another important step in order to decide whether to take enforcement actions. In this regards, monitoring trade fairs is a valuable defensive action as this would allow the acquisition of more evidence than that which is usually available on the infringers' website and to potentially avoid the spread of infringing goods by large scale commercialisation.

Moreover, a regular screening of IP databases⁹ is important in order to check your competitors' activity and identify possible infringements via:

- Technical description of invention (keywords)
Classification code (IPC codes or trade mark classification)
- Company (name of companies)
- Inventor (name of inventors)

4. What do I do if I think my rights have been infringed?

Know your rights and types of infringing acts

Organisations should start to consider enforcing their IP rights when third parties carry out infringing activities, namely an unlawful and unauthorised use of their intellectual assets. What is an infringement act however depends on several factors, in particular the type of the IP owned, because this will affect the right of its owner to stop others from using it.

Therefore organisations must be familiar with the IP rules applicable to the IP asset concerned and see to what extent they can enforce their rights. E.g. a patent owner can stop others from making, using, offering for sale, selling, etc. a product containing their invention and therefore third parties will generally

⁸ In the EU the OHIM is competent to receive such claims with regards to trade marks and design rights. Re patents, at the moment the European Patent Office is competent, and the Unified Patent Court will be competent for the newly established Unitary Patent. However, we suggest that you check in your country if similar actions are provided by the national IP system.

⁹ For a more information on how to perform searches in IP database you can read the fact sheets on patents and trade marks searches, available at the European IPR Helpdesk [library](#).

infringe the patent if they perform one of these activities without the owner's prior authorisation. In the case of trade marks, the owner has different rights such the right to use the mark products related to the class of goods selected by the owner. In such a case an infringement activity would be to use an identical or similar mark in relation to identical or similar products.

On the other hand, IP laws provide some exceptions and limitations to IP protection in the public interest. Assessing such exclusions from liability is also important because they are among the arguments that an alleged infringer may provide in his defence. For instance, liability is exempted in case of:

- Private use
- Prior use
- Experimental use
- Educational use
- Informational use
- Advertisement
- Indication of kind, quality, quantity, intended purpose and the like

In addition to that, the **exhaustion of rights** has to be taken into account at least within the EU. Further to this principle, when a product has been lawfully acquired and re-sold in one of the EU member states, the free circulation of such product in the common market can no longer be prohibited by the IP owner or licensees. Accordingly, the so-called parallel imports are also accepted (i.e. grey market).

Contest the right person

When organisations become aware about the unlawful use of their rights by third parties, they need to precisely identify the alleged infringers in order to eventually bring to an end to the infringing activity.

Hence, it is important to ascertain who is the person or the organisation carrying out the infringing acts, both directly or indirectly. Also, in the latter case it must be established whether the alleged co-infringer has merely induced another to commit the incriminated act, or has contributed to the infringement through conduct intended to allow the violation to take place, namely the contributory liability.

In all the above situations, the IP rights owner should contact all the persons connected with the unlawful activity and involve them in one of the enforcement actions illustrated below.

Letter of demand

There are several ways to enforce the organisation's IP rights, ranging from relatively simple measures up to complex litigation. Certainly, going to court is

one of them, but legal proceedings are costly and lengthy and therefore other preliminary tools should be used preventively.

A first way is the letter of demand, also known as cease and desist letter, which is commonly used to approach the person who is supposedly infringing the IP rights. The letter will advise the alleged infringer that a court action may be taken if the infringing activities do not stop within a certain period of time. Together with this firm intention, the letter should contain a specification about the IP rights violated and the supposed infringing actions.

It is vital to be aware that when sending the letter, IP owners should categorically avoid threatening the other party or include false statements, as this may lead to the senders' legal liability.¹⁰

Customs action

Before going to the courts, another preventive enforcement measure is the customs action.¹¹ IP owners can in fact apply a notice with the customs authorities to stop shipments of infringing goods directly at the EU border. The intervention application requests the inspection of possible infringing goods imported from or exported to third countries and, where the customs find grounds for infringements, their consequent seizure.

In brief,¹² for a customs action to be executed the application form must be submitted:

- By the IP right holder
- To the competent customs authorities
- Together with proof of IP rights
- Together with a description of the original goods
- Together with information on fake goods (if known)
- Together with a declaration to cover damages (if applicable)

An application is valid for one year, but it is possible to renew it afterwards and no fees are required upon submitting it.

¹⁰ To avoid such risks it is advisable to consult with IP legal advisers to have the letter drawn up correctly.

¹¹ These practices are regulated by Commission Regulation (EC) No. 1891/2004 of 21 October 2004, laying down provisions for the implementation of Council Regulation (EC) No 1383/2003, and by Commission Regulation (EC) 1172/2007 of 5 October 2007. All the necessary information is available at http://ec.europa.eu/taxation_customs/customs/customs_controls/counterfeit_piracy/right_holders/index_en.htm.

¹² For a practical explanation on how to apply for a Customs action, read "Customs for IP infringement", in The European IPR Helpdesk Bulletin N°9, April - June 2013, available in the [library](#).

Settling and/or litigating

When approaching an infringer unwilling to stop its unlawful activity, an organisation should decide what further action to take. In a simplified scenario, two options are possible: to settle or to litigate.

Summing up, there exists:

- private prosecution, related to both criminal and non-criminal acts (accidental and wilful infringements)
- public prosecution, which only applies to criminal acts (and usually it requires wilful infringement)
- Alternative Dispute Resolution (ADR), mostly applied for non-criminal acts.

Should organisations opt for one of these routes, it is imperative that you seek legal advice and assistance from an IP professional before taking any action.

ADR¹³

IP litigation is generally complex, long-lasting and can be costly. That is why an alternative which is increasingly appealing to organisations is that of having recourse to ADR mechanisms, to avoid going to court.

ADR refers to non-litigious methods to resolve disputes. ADR may include several mechanisms from informal settlements under the form of **negotiation**, to more formal process such as **mediation** and **arbitration**. ADR may be advantageous from the point of view of costs and of the likelihood and speed of settlements, as well as appropriate for avoiding that the organisations reputation and, hence, their relations with other organisations and costumers be damaged.

Parties may agree in advance to resolve any disputes by ADR before initiating any legal proceeding, by including ADR clauses within commercial agreements. On the other hand, a court decision may order the parties to pursue a specific form of ADR.

The most significant characteristics of ADR, particularly mediation and arbitration, are:

- Single neutral procedure
- Party autonomy
- Neutrality
- Expertise
- Confidentiality
- Definitiveness of arbitral awards and party autonomy to settle
- Enforceability of arbitral awards in court

¹³ For more information on ADR mechanisms, read the fact sheet developed in collaboration with the WIPO Arbitration and Mediation Center, available in the European IPR Helpdesk [library](#).

In a nutshell, **negotiation** refers, by definition, to a voluntary and non-binding out-of-court settlement. As with all negotiations, it is conducted by the parties, at times assisted by their lawyers. Independently of who negotiates, it is recommended that the resulting settlement agreement be drafted by a lawyer. Indeed, there are many legal aspects that need to be covered within the final document such as compensation of damages and legal costs, further disposal of infringing goods, other obligations, etc.

Mediation is a non-binding procedure in which a third party mediator assists the participants in reaching their own decision on their dispute. Mediation is a confidential procedure assuring the parties that any admissions, proposals or offers for settlement will not have any consequences beyond the mediation process. They cannot, as a general rule, be used in subsequent litigation or arbitration. Most important, the mediator has no decision authority and any settlement result is normally enforceable as a contract.

Arbitration is a process where parties submit a dispute to a tribunal of one or three arbitrators, who issue an enforceable binding decision. In this way, arbitration differs from the other ADR mechanisms. Typically, an arbitrator is not bound to follow substantive law, but may also employ concepts of equity and justice, business practice and whatever technical expertise relevant to the process. If confirmed by the court, an arbitration award is enforceable like any court judgment, but unlike a judgment rendered by a court, appeal from an arbitral award is generally not available for errors of law.

IP litigation

As already mentioned, IP litigation may be time-consuming and extremely expensive, mainly for organisations with reduced financial capabilities.

Another constrain that IP owners may encounter is that the laws concerning the enforcement of IP are not the same in every country. In the EU a few legislations¹⁴ have attempted to provide a higher level of harmonisation. In practice, however, there is much room for countries to apply laws in their own manner. It is therefore necessary to always keep in mind that national laws on enforcement must always be taken into account when dealing with such subjects.

However, if all of the attempts to find an out-of-court solution fail, IP owners may choose to bring an action to the court. Should this be the case, the first thing to do is to contact a specialised lawyer, who will assist throughout the whole process and will help with a first assessment of likelihood of success. Indeed, before litigation, the following minimum factors need to be weighed up:

- Opportunity to sue
- Likelihood of success

¹⁴ Such as the Enforcement Directive or the Customs Regulation.

- Validity of owned IP
- Available defences for the counterpart (e.g. counterclaims or exceptions)
- Proofs at one's disposal and others to be collected
- Relief and damages recoverable
- Costs to litigate
- Potential alternatives

Civil actions

IP rights can be enforced by filing a lawsuit for infringement in a national specialised civil court, where legal representation is strictly required.

Civil actions aim to stop the infringement activity, e.g. through *preliminary* and *permanent injunctions*¹⁵, and allow a *compensation* through the award of damages. The latter normally is evaluated based on any *detriment* that has been caused to the business, or to the *profits* that it would have been possible to make.

Other relief measures may be *confiscation* as well as *destruction* of illegal goods.

Concerning the costs of an IP law suit, it is advisable to anticipate an approximate budget for enforcement litigation and insuring the organisation against the financial costs linked to it. Those can be split into:

- Legal expenses including the lawyers' fees, court filing fees, fees for court hearings and other procedural steps;
- Costs of gathering specialist evidence via expert reports and witnesses;
- Costs of proving validity and ownership of IP rights.

Since IP litigation is usually transnational, costs related to translation of documents may occur and should therefore be considered.

Criminal prosecution

In some countries it is also possible to bring criminal actions for some types of infringements, with the imposition of more severe sanctions by courts such as criminal fines, confiscation, destruction and even imprisonment.

Such criminal offences will exclusively be brought to trial by public prosecutors and decided upon by criminal courts. The IP owners are nevertheless able to request the public office to act in conjunction with civil prosecution.

However, it must be noted firstly that criminal prosecutions are the exclusive competence of national jurisdictions¹⁶ and secondly that criminal infringements generally tend to involve trade marks and designs "counterfeiting", copyright

¹⁵ Other form of interim measures such as the seizure of a bank account or of real estate can be requested in anticipation of the final court decision.

¹⁶ There is no EU law on the criminal enforcement of IP rights.

“piracy”, or theft of confidential business information.¹⁷ This is because what is prosecuted here is the infringer’s intention to carry out such actions at an industrial or commercial scale for its own profit.

Key Messages:

- ✓ **Avoid being infringed at all costs**
- ✓ **Take stock of all IP owned by and essential to your organisation**
- ✓ **Register your IP rights in the countries where you do business**
- ✓ **Secure confidential business information internally and externally**
- ✓ **Be vigilant by patrolling trade fairs and monitoring the pertinent IP landscape**
- ✓ **Use customs action to stop IP infringing goods shipment**
- ✓ **Set a defensive strategy and, when spotting infringement, enforce your rights**
- ✓ **Build your case carefully: Ensure that the enforcement route that you have chosen is against the right person and in the right form**
- ✓ **Be aware of the multinational nature of IP laws**
- ✓ **Have your actions supported by an IP professional**

Useful Resources

For further information please see:

- “How to search for trade marks”
<http://www.iprhelpdesk.eu/node/1387>
- “How to search for patent information”
<http://www.iprhelpdesk.eu/node/665>
- “Intellectual Property considerations for business websites”
http://www.iprhelpdesk.eu/Intellectual_Property_considerations_for_business_websites
- “Inventorship, Authorship and Ownership”
<http://www.iprhelpdesk.eu/node/1616>
- Gómez D. and Troncoso M. “Customs for IP infringement”, in The European IPR Helpdesk Bulletin N°9, April - June 2013,
http://www.iprhelpdesk.eu/bulletin_issue_9
- “Alternative Dispute Resolution (ADR) Mechanisms”
<http://www.iprhelpdesk.eu/node/1445>

¹⁷ However, these types of offences may be differently or not at all regulated by member States.

GET IN TOUCH

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ABOUT THE EUROPEAN IPR HELPDESK

The European IPR Helpdesk aims at raising awareness of Intellectual Property (IP) and Intellectual Property Rights (IPR) by providing information, direct advice and training on IP and IPR matters to current and potential participants of EU funded projects. In addition, the European IPR Helpdesk provides IP support to EU SMEs negotiating or concluding transnational partnership agreements, especially through the Enterprise Europe Network. All services provided are free of charge.

Helpline: The Helpline service answers your IP queries within three working days. Please contact us via registration on our website – www.iprhelppdesk.eu – phone or fax.

Website: On our website you can find extensive information and helpful documents on different aspects of IPR and IP management, especially with regard to specific IP questions in the context of EU funded programmes.

Newsletter and Bulletin: Keep track of the latest news on IP and read expert articles and case studies by subscribing to our email newsletter and Bulletin.

Training: We have designed a training catalogue consisting of nine different modules. If you are interested in planning a session with us, simply send us an email at training@iprhelppdesk.eu

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