

FACTSHEET

How to protect your IPR Online



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1. The key role of IPRs on businesses running online

According to Statistical latest data, the number of internet users in Latin America amounted to almost 328 million in 2015 and is projected to reach 387 million by 2019. The increasing availability of broadband technology, low-cost mobile devices and easy access to the wireless Internet have been key factors. In terms of online trade, nearly 155 million people in Latin America are expected to buy goods and services online during 2019, while retail online sales in this region have been projected to grow from 43.5 billion Euro in 2016 to 69.6 billion Euro by 2019. On a regional level, Brazil is the market leader, followed by Mexico, and Argentina. Together with the growing trend towards online shopping and purchasing, the Internet that makes geographic barriers to the distribution of goods and services almost non-existent, is an attractive business and marketing platform for any EU SMEs established in Latin America or considering its commercial expansion to this region.

With the rise and development of the Internet, using online channels has become a widespread option chosen by companies for marketing business and products. Key benefits of using this channel are the ability to reach and measure potential customers on a global level, low operating costs and quick access to different markets, among others.

Unsurprisingly, European SMEs seeking to expand their businesses towards the Latin American region consider the Internet as a preferential channel to do so. With the Internet being such an easy entrance for new products and services, it can also be used by forgers from all over the world as an instrument to sell counterfeit goods or commit any kind of Intellectual Property (IP) frauds.

Within this context, protecting your Intellectual Property Rights (IPRs) online has become almost a necessity.

IPR infringement increasingly takes place on the Internet, raising concerns on many levels, particularly to SMEs. With regards to Latin America, countries such as Argentina, Brazil, Ecuador or Mexico have been identified by the European Commission as priority countries where IP enforcement on the Internet needs close monitoring. Although some big online marketplaces such as Amazon or Alibaba have implemented their own IP Protection Platform (IPP) mechanisms (also known as complaint mechanisms) to help rightsholders take-down counterfeit products, there is still room for improvement.

2. Protecting your IPR online

When thinking about which intangible assets an online SME should protect under IPRs, a practical starting point is to distinguish between the most common operational tools for EU SMEs - Website and Domain Name- and the products and services to be offered online.

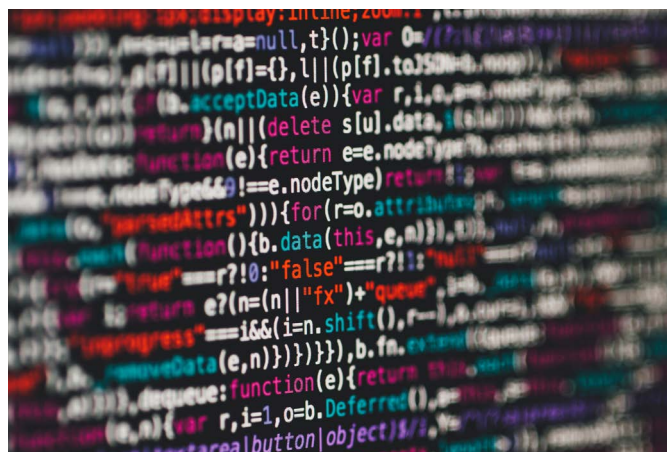
A. Tools: A website and Domain Name

Even though there are many different ways to do business online, most of them start by considering how to run it: either to use your own website or to offer your products or services through the website of a third party, such as an online marketplace (e.g. Amazon).

If you want to use your own website, you should note that this tool entails different kinds of IPRs. In general, the most significant when considering a website to operate your business online ("e-commerce website") are trademarks, copyright and trade secrets. This section will help you identify the most valuable elements of your website and it will also offer you practical recommendations on how to protect those website-related creations within the Latin America region.

Assign the proper IPR to each asset

The following table provides an overview of the most relevant IPRs for protecting your website developments and contents:



IPR	SUBJECT MATTER and EXAMPLES
Trademark	Any sign or combination of signs, that enable to distinguish the goods or services of a company from those of others Examples: The name/logo of your company, name/words/logos of technologies, products or services; 3D shapes of packaging and form of the product/device; application icons.
Copyright	Literary, musical and artistic works, sound recordings, software, data-bases, etc. Examples: Software/app source code; technical manuals, graphic interfaces, databases, product labels, website content, videogames, audio-visual works.
Trade secrets	Valuable business information which is not known to the public Examples: Sandbox programs, data-analysis methods, customers' databases, data flow charts, logic flow charts, data structures, marketing strategies, algorithms and/or communication protocols, sales techniques.
Domain Names	Name that represents and identifies your business when operating on the Internet. They are specific addresses assigned to each of the resources in the network, so they can be located or identified. Examples: ingeteam.cl; funiglobal.eu

Practical recommendations on how to protect website-related creations

When thinking about a website to operate your business online, please consider the following suggestions:

1. Identify and register at least your most important IPRs, as for instance trademarks and copyrights, before entering the target markets. In this sense, do not just focus on your oldest logos, creations or technology, but rather on those features that allow you to:

- distinguish your product or services from your competitors
- represent your company's values
- commit to innovation
- possess commercial potential

During this process, it is highly recommended to be assisted by an IP expert, who will guide you in the identification phase and will inform you about the different types of protection available in each country (since not all the Latin American countries offer utility models as a way to protect inventions).

Copyright registration

Registration of copyright works before the corresponding Intellectual Property Office is not a legal requirement for protection, but it is strongly advisable in order to obtain evidence of ownership and date of creation, which will provide you with better enforcement possibilities against copying or misappropriations.

Moreover, copyright registration in Latin American countries is reasonably cheap. The average price for registering a work in these countries amounts to €40, with Mexico and Brazil as the most expensive ones, to other countries with no registration costs such as Colombia and Paraguay, or Costa Rica with a unique fee of €3,75, regardless of the type of work.

2. Non-Disclosure Agreements (NDA) and physical security measures will make a difference in the protection of your IP assets.

When protecting confidential business information as a trade secret, take special precautions with employees, maintenance contractors, website hosts and Internet providers and consider including confidentiality clauses in their contracts or signing NDAs (see Glossary). It is very important that you ensure that only a limited number of people know the secret and that they are aware it is confidential information.

In addition, do not forget that the legal notice of your website should contain a clause about Intellectual Property so that you let others know that the content is protected.

3. Use a copyright notice and the symbol © on your website; make sure it includes the name of the copyright owner and the year of first publication.

Bear in mind that in countries like Mexico, published works are required to include a copyright notice. If not, you will not lose your copyright, but the National Copyright Institute could fine you (if you are the licensor/licensee or the responsible publisher) for copyright infringement.

4. Limit the access and use of the content published on your website. For this purpose, you may consider implementing technological protection measures (TPMs) or digital rights management systems (DRMs) on your website (see Glossary). Some examples could be not allowing copying or printing of the content, the use of encryption keys or fingerprints to access certain parts of the website, or not allowing screenshots.

5. Make sure you have requested the necessary authorizations or obtained the relevant licenses to avoid violating third parties' IPRs.

If you use materials owned by others on your website or if you include links of any kind to websites of others, it is crucial to obtain prior written authorisation from the corresponding IP owner. Otherwise you may infringe IP rights which may cause your company to incur in liabilities.

IP related licenses

No matter what kind of work you ask for permission to use (books, musical compositions, drawings, photos, etc), you should clearly outline the scope of the rights at stake. When requesting a license, do not forget to check the following aspects:

- Identify the work or IPR being licensed.
- Territory: Define the countries.
- Length: How long will the license last.
- The authentic language of the license.
- The guarantee that the work does not infringe any third-party rights.
- The terms of use: Within these, keep an eye to:
 - Specify the media or format of exploitation: digital, writing, audible, etc.
 - Right or restriction to grant sublicenses.
 - Other specific rights granted/ restrictions imposed.

An IP advisor may help you to negotiate the terms and conditions of the license agreement.

6. Choose a domain name as close as possible to your trademark registration. Using a user-friendly domain name which reflects your company's vision and matches with your trademarks would be a brilliant choice not only from a marketing perspective, but also from a legal one, since that choice can prevent conflicts with previously registered trademarks.

For more detailed information, check our guide on [Domain Names](#) or visit the WIPO 's section [here](#).



Cybersquatting: When a domain name infringes your trademark

Cybersquatting consists in registering, trafficking in, or using an Internet domain name in bad faith with intent to profit from the reputation of a trademark. Sometimes the squatter offers to sell the domain name to the legitimate owner of the trademark at a high price. Registering your trademark will not only protect it from others on the real tangible market, but it will also allow you to protect it on the Internet.

Be aware that as an alternative to judicial proceedings in the relevant country, WIPO provides a faster and cheaper means called Uniform Dispute Resolution System (UDRS) to resolve a conflict regarding registration and use of Internet domain names. In addition, both parties benefit from the decision-makers' high level of expertise.

According to WIPO's administrative procedure, Domain names that have been cybersquatted can be recovered if:

- The domain name is identical or confusingly similar to your registered trademark.
- The domain name's owner has no legitimate interests over it.
- The domain name has been registered and it is used in bad faith.

To find out the most common scenarios of lost Domain Names, visit the [WIPO UDRP](#) and the [ICANN website](#).

B. Products and Services

Once you have the tools to operate online ready, it is time to consider the products and services your company will offer on the Internet. In common with the physical market, online businesses often offer products and services based on IPRs, such as clothes, sports equipment, jewellery, high-tech products, watches, books, software, etc.

Regardless of the sector, your business can benefit from different IP tools for fostering its competitiveness. Furthermore, IPRs can also be combined to provide stronger protection over all the aspects of your creation. For example, an SME which improves a pair of trainers can protect their specific characteristics in the following way:

- Developed technologies (e.g. improved manufacturing processes or new waterproof materials): these inventions can be protected by patents, utility models or trade secrets.
- Trainers' new look: the new external appearance of the trainers can be protected via industrial design.
- Company's logos: any distinctive sign capable of identifying the business' origin of the product can be registered as a trademark.
- Special packaging: colourful drawings included over the shoebox can be protected with trademarks (e.g. trade dress), copyright and sometimes, industrial designs.

To know more about how to protect your products and services in Latin America, read our country guides on [Argentina](#), [Bolivia](#), [Brazil](#), [Colombia](#), [Costa Rica](#), [Dominican Republic](#), [Ecuador](#), [Mexico](#),

[Paraguay](#), [Uruguay](#), [Peru](#), and [Venezuela](#) or contact our [Helpline](#). It is free, fast and confidential and it is available in English, Spanish, German, French and Portuguese.

Protecting your digital products and services

The digital world provides the opportunity to develop alternative and different services and products, for instance, on-demand services delivered via mobile devices or via the Internet. This is an emerging new media market, which is being developed in parallel to the markets in the pay-tv sector and could be easily implemented in other countries.

Nonetheless, it is advisable to contact an IP expert in order to carefully design an IP strategy before expanding your business to the Latin American region. For example, if you are an EU SME willing to sell your new cooking course as an on demand service in the Mexican market, some IP aspects you should consider managing would be:

- Protecting your corporate image by trademarks and domain names.
- Watching over your Website:
 - copyright registration (as for instance, as regards photos, texts, software...).
 - implementation of TPM and DMR protection measures for your content.
 - negotiation of potential licenses involved (e.g. audio-visual content of third parties).
- Transferring of IP and image rights from teachers and authors.

3. Dealing with IPR infringement online

The primary challenge when running your business online is dealing with counterfeiting and piracy. In other words, what to do if you find out that someone else is using content from your website, offering your products on the Internet without your authorization, or both. There are many different ways to enforce your IPRs, from simple requests to cease and desist letters or all-out lawsuits. Here are the most common ones:

A. Notice and Take-Down Requests

In by far most of the countries where the Internet is a normal place of trade, sending a notice and take-down request might be the simplest and most financially savvy way for trying to remove infringing materials online. Through this mechanism, an IPR holder can ask an Internet Service Provider (see Glossary), host or another type of site-owner (from now on, 'intermediary') to remove material that is infringing their IPRs, or even remove the relevant website from the intermediary's network so as to block access to the protected material. Some intermediaries have incorporated further support by automatic monitoring of its own digital spaces, and some include a follow-up mechanism for any subsequent reappearances of that content, which is known as "stay-down" (see Glossary).

Intermediaries include search engines, social platforms and online marketplaces. This means that:

- You may want to contact the corresponding search engine, like Google or Bing where you have found the infringing material and ask them to delete the infringing website within their search results. Google's policy and submission forms are located [here](#).
- The most popular social media platforms provide similar services, like Instagram, Facebook, Twitter or YouTube, to name but a few. Once an IP owner has already sent a notice and takedown request and has got into a collaborative association with the social media platform, further complaints made by private users in relation to published content will be directed to the IP owner for verification. With the IPR owner's confirmation, the social platform would impose appropriate penalties to the infringer which normally include taking down the infringing content and, in addition, the suspension of the infringer's account. Examples of these policies can be found on [Twitter's procedures and policy](#) or [YouTube's Content ID](#) system.
- The most well-known online marketplaces have at the disposal of IPR owners specific notice and take-down procedures. Information about Alibaba's are located [here](#) and Amazon's [here](#).

Quick guide for removing counterfeits from marketplace websites

As in any other country, in Latin American countries you will find different intermediaries to whom to address your IP claim. Taking them into account, here we present the best practices you should keep in mind for your claim to be successful:

- 1. Document everything.** Start by making copies of the certificates that identify you and/or your company as well as the certificates which prove your IPR ownership. Make sure your trademarks are registered and up to date. It is much easier to stop an online infringement if your trademarks are already registered.
- 2. Investigate:** Before sending the notice and take-down request to the intermediary, make sure you have tried to gather the contact details of the company or person who is offering counterfeits of your products. Sometimes these details may be on the website offering the illegal material but in other cases you will need further investigation. In addition, it may be very useful to explore local and regional commercial websites for counterfeits as you could find information that would help to identify the infringers or even find additional spots of suspicious sales.
- 3. Send the notice and take-down request:** Send the request to the relevant intermediary using the appropriate channel. Whenever possible, use the email or form provided by the intermediary and provide as much proof as possible. In case you have any doubts as to which intermediary to address your request, you may want to send it to more than one so as to ensure the reception by the right one. With regards to the content, a notice and take-down request (see Glossary) generally includes the following information:
 - **Identification of the original IP protected products you consider have been infringed:** Here you will need the certificates of your IP rights ready in order to provide the required IPR information (e.g. in the case of a trademark, its registration number, class, goods...).
 - **Identification of the material that is infringing your IPRs and precise online location.** Focus on the most obvious infringement. In many cases, it is faster and easier to have a listing removed for copyright or trademark infringement only, even if the design and/or the patent rights are also infringed. With regards to the website location, it may be useful to provide clickable hyperlinks.
 - **Include your contact details as to be reached by the corresponding intermediary.**
- 4. Wait for next actions:** After receiving the notice, the intermediary will send your claim to the alleged infringer and give them the chance to respond. Bear in mind that skilled counterfeiters may file a counter-notice only to delay the processing of your complaint.
 - a. If there is no counter-claim and your proof suffices, the intermediary will remove the infringing link or the infringing list of products.
 - b. If there is a counter-claim you will need to get in touch with an IP expert to consider your response and further legal measures.
- 5. Keep monitoring in the future:** It is highly recommended to keep monitoring the most common e-commerce websites so that you can act promptly when infringement occurs. Consider adding a weekly/monthly reminder so that this task is not forgotten. Most of the existing notice and take-down systems remove links, but do not block the online seller from the platform until repeated complaints have taken place. Therefore, even if when an infringing link has been eliminated, new ones might frequently come back to the online platform.

B. Online Marketplaces with IP Enforcement Programs

Due to these challenges of the existing take down systems, further cooperation between governmental agencies, IP owners and big online marketplaces have come up with voluntary protection programs that might be more effective than a take-down request.

Prevalent online marketplaces such as eBay with their “Verified Rights Owner (VeRO)” program, Amazon with their “Brand Registry”, Alibaba with their “IP Protection Platform” and MercadoLibre with their “Intellectual Property Program” have established IPR protection programs, which allow IP owners to work cooperatively to enhance IP protection. These programs offer IP owners a way to report listings that they believe infringe their rights. IP owners need to sign up as members of the program and provide proof that they own the rights in question. Once the online marketplace has reviewed the necessary information and documentation, the IP owner will be issued with a user name and a password, along with instructions on how to use the program.

The advantages of these programs for an SME are:

- Saving time and money: Researching, monitoring and investigating can be very expensive if done on your own. These platforms tend to provide certain research tools to their members to better identify counterfeits;
- Increasing transparency and quality on complaint adjudication evidence. These programs normally assign an account manager to their members, who may be able to support the collection of evidence and shed light on whether a potential complaint could be successful. This might be very helpful in midpoint cases such as goods that are sold without a license and almost identical duplications; and

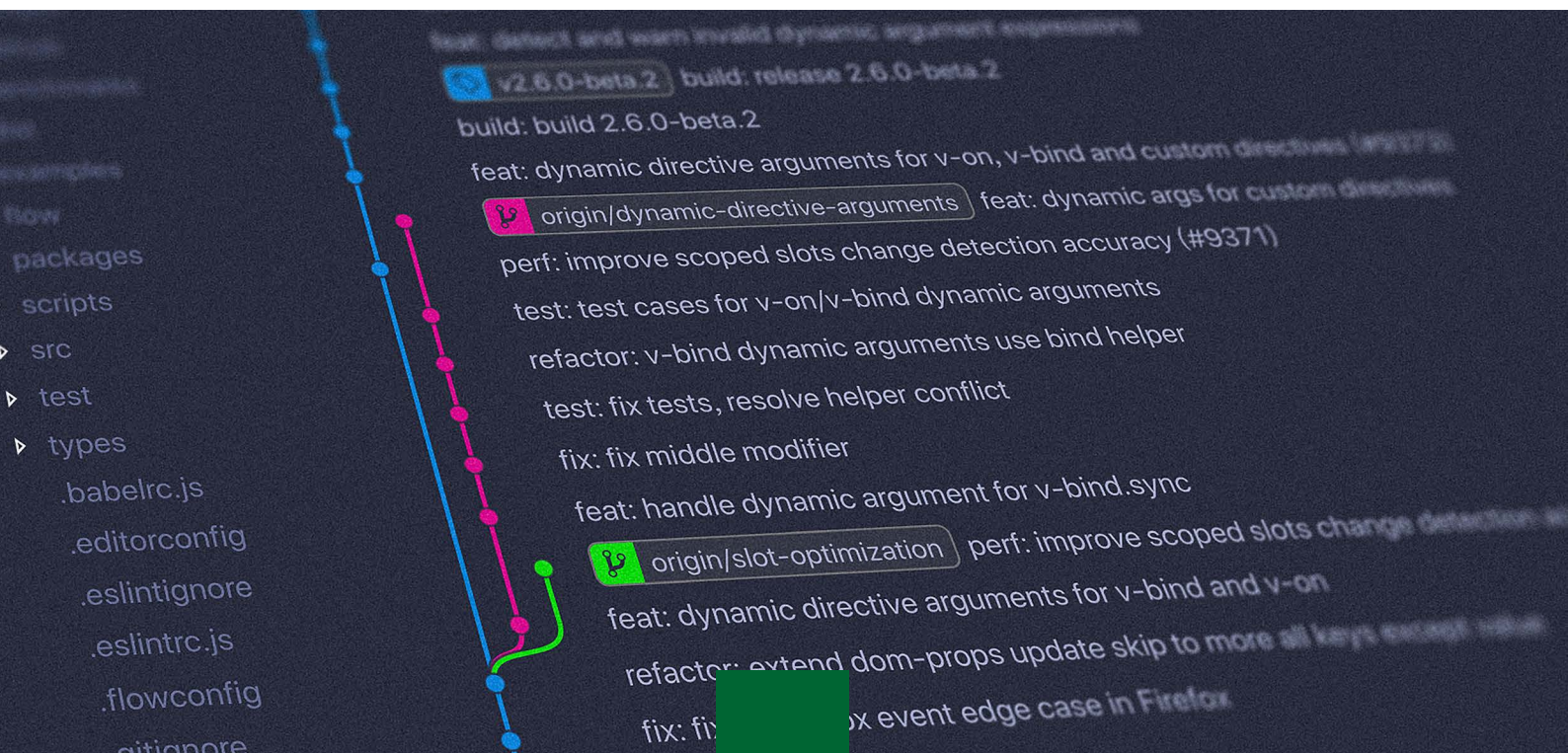
- Becoming an effective prevention measure. With the collaboration of intermediaries, the increase of complaints by IPR owners is likely to rise. Thus, the better this tool works, the less need to pursue further legal measures or eventually avoid in court litigation.

C. Further Legal Measures

If the previous measures have been unsuccessful or if the notice and take-down request has worked out, but in a short period you find new counterfeits online, you should consult with a local legal expert to enforce your IPRs.

There are different options to consider once you reach this point. Start by sending a traditional “cease and desist” letter, if you have the contact details of the company or person who seems to be infringing your IPRs online. Further measures may consist in the request of preliminary injunctions (see Glossary) for online infringement, which are available in Argentina, Chile, Mexico and Brazil. Furthermore, all Latin American countries have civil and criminal legal procedures to enforce IPRs against counterfeiting, although they tend to be very expensive and slow.

It could also be the case that you consider going against the intermediary for not having excluded the infringing online seller from the platform (also known as “stay down”). Bear in mind that the liability of online intermediaries is a very controversial topic. The general answer would be that in most Latin American countries there is no specific legislation addressing intermediaries’ liability. The only exception is the Chilean Copyright law, although online intermediaries’ liability is formally very limited, and the best result one could achieve is through a takedown request or blocking its access via a court order.

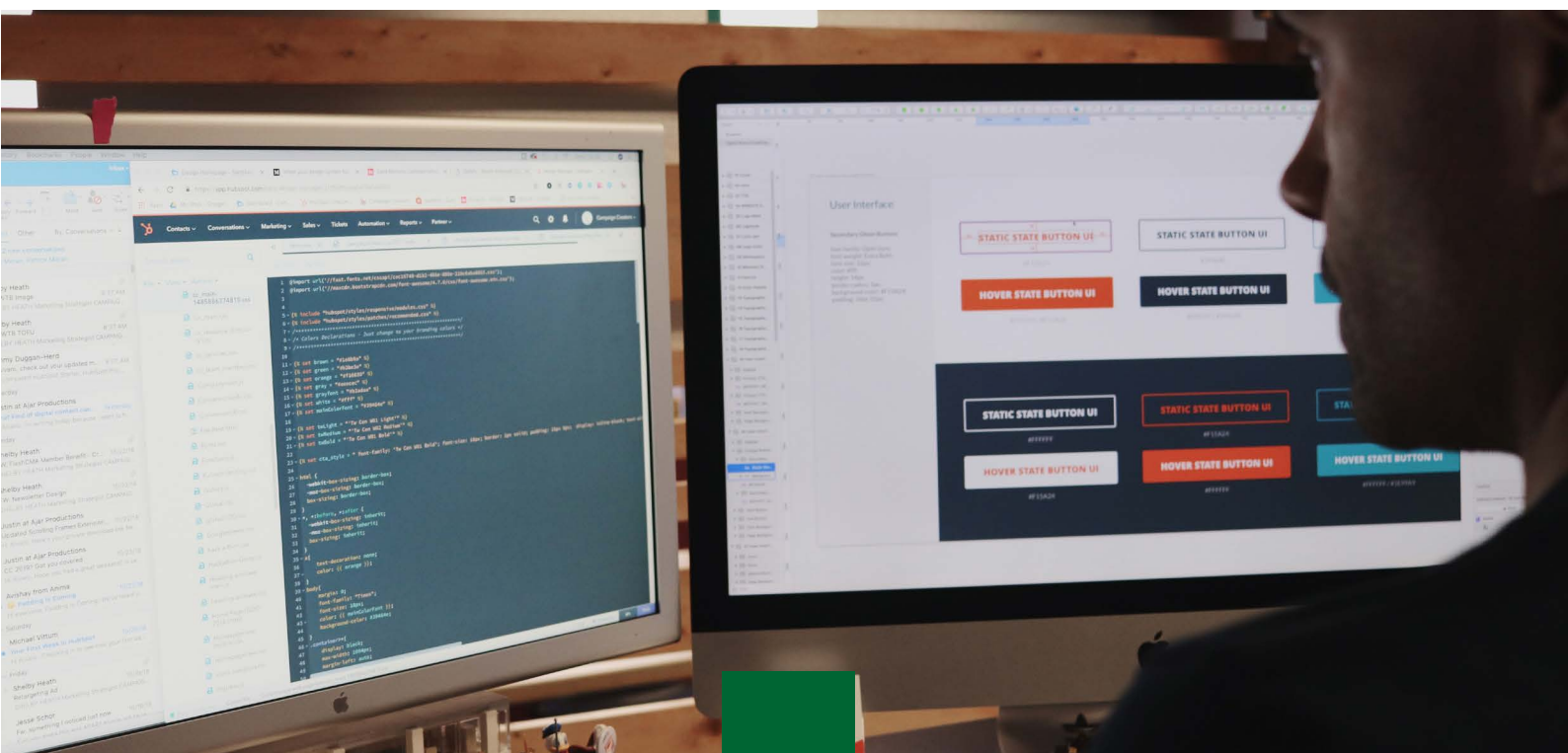


4. Glossary

- **Non-Disclosure Agreements:** Their main objective is keeping secret and undisclosed some information between two parties. Penalty clauses are also included in case of breach of confidentiality.
- **Internet Service Provider (ISP):** The organization which provides access to the Internet and related services from search, e-mail, hosting, etc. to end users; it is also known as intermediary.
- **Notice and Take-Down:** Procedure through which an IP owner can ask an ISP to remove information that is illegal or unlawful from its server or block access to it. It can also be made for information that is no longer relevant or outdated.
- **Preliminary Injunction:** Temporary measure that courts adopt in a fast-track procedure when there are special circumstances that could lead to irreversible damage.
- **Stay-Down:** Procedure through which an IP owner can ask an intermediary, once they have learned that certain information they host is being infringed, to ensure that it is not trivially re-uploaded by the same or a different user.
- **Digital Rights Management (DRM):** It is a catch-all term referring to technology limitations aimed at preventing unauthorised copies, transmission, use or access to your digital copyrighted work.
- **Technical Protection Measure (TPM):** Referred to technological limitations used to prevent access or use of copyrighted works embodied on electronic devices (i.e. Content Scrambling System –CSS– or digital watermarks).

5. Related links and additional information

- Report on the protection and enforcement of intellectual property rights in third countries, http://trade.ec.europa.eu/doclib/docs/2018/march/tradoc_156634.pdf
- L. Verbauwheide, "Intellectual Property and E-Commerce: How to Take Care of Your Business' Website", SMEs Division, WIPO: https://www.wipo.int/export/sites/www/sme/en/documents/pdf/business_website.pdf
- WIPO Domain Name Dispute Resolution Service for ccTLDs <https://www.wipo.int/amc/en/domains/cctld/>
- How to protect your website? http://www.latinamerica-ipr-helpdesk.eu/sites/default/files/fact-sheets/en_fs_how_to_protect_your_website_1.pdf
- Domain Names http://www.latinamerica-ipr-helpdesk.eu/sites/default/files/fact-sheets/en_domain_names_restyling.pdf
- Copyright in a nutshell I and II: http://www.latinamerica-ipr-helpdesk.eu/sites/default/files/fact-sheets/fs_en_copyright_in_a_nutshell_ii_final.pdf
<http://www.latinamerica-ipr-helpdesk.eu/content/copyright-nutshell-ii>
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How to Protect your IPR Online

Download Guide



The **Latin America IPR SME Helpdesk** offers **multilingual services** (English, French, German, Spanish and Portuguese¹), with free information and first-line legal advice on IP related subjects, as well as training, webinars and publications, especially designed for EU SMEs.



HELPLINE First-line advisory service on IP protection and enforcement for EU SMEs working or planning to operate in Latin America.

TRAINING Targeted trainings and webinars on IPR protection and enforcement for EU SMEs (including sector- specific approaches).

IP CONTENT State-of-the-art publications (factsheets, learning modules, videos, IP glossary, info graphics, case studies and newsletters) on the protection and enforcement of IPR in Latin America – specifically addressing IP matters from the SME business needs point of view.

AWARENESS RAISING EVENTS Participation in events attended by EU SMEs to increase the awareness of IP and of the visibility of the services provided by the Helpdesk.

IP ANALYSIS Analysis of IP challenges faced by EU SMEs in the target markets.

IP DIAGNOSTIC TOOLKIT Toolkit for self-evaluation of the IP-status of the user in terms of IP knowledge and management.

IP COST TOOL Online tool that allows the user to pre evaluate the costs related to IP management in every Latin American country covered by the Helpdesk.

¹The language offer will depend on the specific service and experts' availability.

If you have any queries on how to protect your Intellectual Property in Latinamerica contact our Helpdesk service:

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+34 96 590 9684
Working Hours: Monday - Friday 9:00 -16:30 (CEST)

If you want more information on additional free services offered by the Helpdesk contact the coordination team:

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