

The Pro IP Act of 2008 - - Prioritizing Resources and Organization for Intellectual Property Act of 2008

The Pro IP Act of 2008 (Prioritizing Resources and Organization for Intellectual Property Act of 2008, Public Law No: 110-403) came into effect on October 13, 2008. The key provisions of the Pro IP Act, related to commercial businesses and enforcement of copyright and trademark laws are discussed herein. Changes to the criminal justice system are briefly discussed.

Title I of the Act relates to enhancements to civil intellectual property (IP) laws. The Act amends the Copyright Act, 17 U.S.C. 411, and adds new section 411(b)(1) which permits copyright owners to enforce their copyrights notwithstanding harmless errors in their copyright registrations for “inaccurate information.” The safe harbor applies to “(A) the inaccurate information [that] was included on the application for copyright registration with knowledge that it was inaccurate; and (B) the inaccuracy of the information, if known, would have caused the Register of Copyrights to refuse registration.” If inadvertent errors are made in the copyright registration, these errors, most likely, will not bar enforcement if the copyright owner can prove access to the original work and substantial similarity between the original and the defendant’s copy. If “inaccurate information” is alleged, “the court shall request the Register of Copyrights to advise the court whether the inaccurate information, if known, would have caused the Register of Copyrights to refuse registration.” 17 U.S.C. 411(b)(2).

Further, the Act makes the import and export of copyrighted materials an act of infringement. 17 U.S.C. 602(a). The Act also amends federal copyright law to provide that copyright registration requirements apply to civil (not criminal) infringement actions and allows a court, while an infringement action is pending, to impound records documenting the manufacture, sale, or receipt of related things, requiring a protective order to ensure that confidential, private, proprietary, or privileged information is not improperly disclosed or used.

The Pro IP Act also amends the Trademark Act, 15 U.S.C. 1117(b), (Lanham Act Section 35(b)), and revises the treble damages provisions and double statutory damages in counterfeiting cases. The Act extends its damages provisions to those intentionally using the counterfeit and those providing goods or services used in the counterfeit operation. “[T]he court shall, unless the court finds extenuating circumstances, enter judgment for three times such profits or damages, whichever amount is greater, together with a reasonable attorney's fee, if the violation consists of – (1) intentionally using a mark or designation, knowing such mark or designation is a counterfeit mark (as defined in section 34(d) of this Act), in connection with the sale, offering for sale, or distribution of goods or services; or (2) providing goods or services necessary to the commission of a violation specified in paragraph (1), with the intent that the recipient of the goods or services would put the goods or services to use in committing the violation.”

The Act doubles statutory damage minimums and maximums for the use of counterfeit trademarks to not less than \$1,000 per counterfeit mark or more than \$200,000 per mark and, for willful violations, not more than \$2,000,000 per mark.

The remainder of the PRO IP Act enhances criminal intellectual property laws for

intentionally trafficking in counterfeit goods or services, prohibits the transshipment or exportation of counterfeit goods or services under the Copyright Act and the Federal Trademark Act (Lanham Act). The Act also directs the President to appoint an Intellectual Property Enforcement Coordinator (IPEC) to (1) reduce counterfeit and infringing goods in the domestic and international supply chain; (2) identify and addressing structural weaknesses, systemic flaws, or other unjustified impediments to effective enforcement; (3) ensure that information is identified and shared among the relevant departments and agencies; (4) disrupt and eliminating domestic and international counterfeiting and infringement networks; and (5) provide training and technical assistance to foreign governments to enhance those governments' enforcement of counterfeiting and infringement laws.