**IP CRIMINAL ENFORCEMENT**

21.01  In the UK, a number of criminal sanctions exist in the fields of copyright, performers’ rights, registered trade marks, and registered designs. There are no criminal offences relating to patents or unregistered designs. Criminal offences tend to be predicated on knowledge of the infringement (or reason to believe) on the part of the infringer, and tend to relate to activities committed in the course of a business. However, there are also some offences which are committed other than in the course of a business.

21.02 Unlike in relation to civil enforcement (where infringement must be proved on the balance of probabilities), for IP criminal sanctions the offence must be proved to the criminal standard of proof (ie beyond reasonable doubt). Rightholders may wish to bring private prosecutions; alternatively, action may be taken by the police or, in appropriate cases, Trading Standards. Police capabilities include the City of London Police Intellectual Property Crime Unit, established in 2013.[[1]](#footnote-1) The UK IPO publishes guidance on IP crime for consumers and businesses.[[2]](#footnote-2) The UK IPO also publishes data and reports relating to IP crime.[[3]](#footnote-3)

**Copyright**

21.03  Copyright criminal offences include:

* making for sale or hire, importing into the UK (other than for private and domestic use) or in the course of a business possessing with a view to committing an infringing act, selling or letting for hire, offering or exposing for sale or hire, exhibiting in public or distributing an article which is, and which the infringer knows or has reason to believe is, an infringing copy of a copyright work, or otherwise than in the course of a business distributing such an article to such an extent as to affect prejudicially the owner of the copyright;[[4]](#footnote-4)
* making articles that are specifically designed or adapted for making infringing copies of copyright material or having such an article in one’s possession, knowing or having reason to believe that it is to be used to make infringing copies for sale or hire or for use in the course of a business;[[5]](#footnote-5)
* in certain circumstances, communicating a work to the public.[[6]](#footnote-6)

There are also further criminal offences including offences relating to unauthorised performances of certain works in public and the unauthorised playing or showing in public of a sound recording or film;[[7]](#footnote-7) unauthorised decoders;[[8]](#footnote-8) and devices, products, or components which are primarily designed, produced, or adapted for the purpose of enabling or facilitating the circumvention of effective technological measures.[[9]](#footnote-9)

**Performers’ rights**

21.04  In relation to performers’ rights, the following criminal sanctions exist:

* without sufficient consent, making for sale or hire, importing into the UK (other than for private and domestic use) or in the course of a business possessing with a view to committing a relevant infringing act, selling or letting for hire, offering or exposing for sale or hire or distributing a recording which is, and which the infringer knows or has reason to believe is, an illicit recording;[[10]](#footnote-10)
* in certain cases where a performer’s making available right is infringed;[[11]](#footnote-11) and
* causing a recording of a performance made without sufficient consent to be shown or played in public, or communicated to the public, thereby infringing any performers’ rights, if the infringer knows or has reason to believe that those rights are thereby infringed.[[12]](#footnote-12)

**Trade marks**

21.05  Under section 92 of the Trade Marks Act 1994, various criminal sanctions are available in relation to registered trade marks. These include where:

* a person applies a sign identical to, or likely to be mistaken for, a registered trade mark without the consent of the owner to goods or their packaging, or sells or lets for hire, offers or exposes for sale or hire or distributes such goods or packaging, or has in his possession, custody or control in the course of a business any such goods with a view to these acts;
* with view to gain or intent to cause loss to another.[[13]](#footnote-13)

Note that the statutory language used here is different to the statutory language used at section 10 TMA 1994 in relation to civil trade mark infringement. It is a defence for a person charged with an offence under section 92 TMA 1994 to show that they believed on reasonable grounds that use of the sign was not an infringement of the registered trade mark.[[14]](#footnote-14)

21.06  An interesting question concerning criminal liability fell to be decided by the House of Lords in *R v Johnstone*.[[15]](#footnote-15) Johnstone had been making and disseminating CDs containing copies of bootleg recordings containing the name of the performer which had been registered as a trade mark. Johnstone was charged under section 92(1) TMA 1994 for falsely applying and using a trade mark. It was argued that, to be liable, civil infringement had first to be established which was not so in the instant case as the performers’ names had not been used as indications of origin but merely to identify the artists. The House of Lords found this argument to be correct: as a matter of principle if a name of an artist was used exclusively as an indication of the name of the performer in connection with the performance, this was merely descriptive and not an indication of the trade origin. Johnstone was therefore not guilty of this offence. A different defence was raised in *R v Boulter (Gary)*.[[16]](#footnote-16) The applicant was charged with selling counterfeit and pirated music CDs bearing the logos of EMI and other recording companies. He raised the defence that the CDs that bore the trade marks were of such poor quality that no one would think that its trade origin was that of the trade mark owners. In other words, there would be no confusion. The Court of Appeal ruled that no confusion was needed to be guilty of the offence in section 92 because the issue was identity, and not similarity, of the marks. Regardless of how badly the marks were copied, they were identical to those registered to the recording companies, and used on identical goods. A counterfeiter could not avoid criminal liability by claiming that the goods are ‘genuine fakes’.[[17]](#footnote-17)

**Registered designs**

21.07  The Intellectual Property Act 2014 introduced criminal penalties in relation to UK registered designs. It is, in particular, an offence if in the course of a business, without consent, a person intentionally copies a registered design so as to make a product exactly to that design, or with features that differ only in immaterial details, knowing, or having reason to believe, that the design is a registered design.[[18]](#footnote-18) It had originally been proposed that it should be sufficient for criminal infringement that the infringing product was made exactly or substantially to the design, but this was amended to the current, more stringent requirements (more akin to the ‘novelty’ test in registered design law rather than the wider civil infringement test of the same ‘overall impression’) during the legislative passage of the 2014 Act. It is a defence for the alleged infringer to show inter alia that he reasonably believed that the registration of the design was invalid, did not infringe or that he reasonably believed that he did not infringe.[[19]](#footnote-19)

1. See <https://www.cityoflondon.police.uk/police-forces/city-of-london-police/areas/city-of-london/about-us/about-us/pipcu/>. [↑](#footnote-ref-1)
2. UK IPO, ‘IP crime and enforcement for consumers’, 2017 (<https://www.gov.uk/government/publications/ip-crime-and-enforcement-for-consumers>); UK IPO, ‘IP crime and enforcement for businesses’, updated 2023 (<https://www.gov.uk/government/publications/ip-crime-and-enforcement-for-businesses>). [↑](#footnote-ref-2)
3. For example, UK IPO, ‘Trading Standards successes 2021–2022’, 2022 (<https://www.gov.uk/government/publications/trading-standards-successes-2021-to-2022/trading-standards-successes-2021-2022>); UK IPO, ‘Annual IP crime and enforcement report: 2020 to 2021’, 2021 (<https://www.gov.uk/government/publications/annual-ip-crime-and-enforcement-report-2020-to-2021>). [↑](#footnote-ref-3)
4. CDPA 1988, s 107(1). [↑](#footnote-ref-4)
5. CDPA 1988, s 107(2). [↑](#footnote-ref-5)
6. CDPA 1988, s 107(2A). [↑](#footnote-ref-6)
7. CDPA 1988, s 107(3). [↑](#footnote-ref-7)
8. CDPA 1988, s 297A. [↑](#footnote-ref-8)
9. CDPA 1988, s 296ZB. [↑](#footnote-ref-9)
10. CDPA 1988, s 198(1). [↑](#footnote-ref-10)
11. CDPA 1988, s 198(1A). [↑](#footnote-ref-11)
12. CDPA 1988, s 198(2). [↑](#footnote-ref-12)
13. TMA 1994, s 92(1). [↑](#footnote-ref-13)
14. TMA 1994, s 92(5). [↑](#footnote-ref-14)
15. [2003] UKHL 28, [2003] 3 All ER 884. [↑](#footnote-ref-15)
16. [2008] EWCA Crim 2375, [2009] ETMR 6. [↑](#footnote-ref-16)
17. *R v Boulter*, para 9. [↑](#footnote-ref-17)
18. RDA 1949, s 35ZA(1). [↑](#footnote-ref-18)
19. RDA 1949, s 35ZA(4) and (5). [↑](#footnote-ref-19)