



European IPR Helpdesk

Fact Sheet

Intellectual property relevance in internationalisation

February 2018¹

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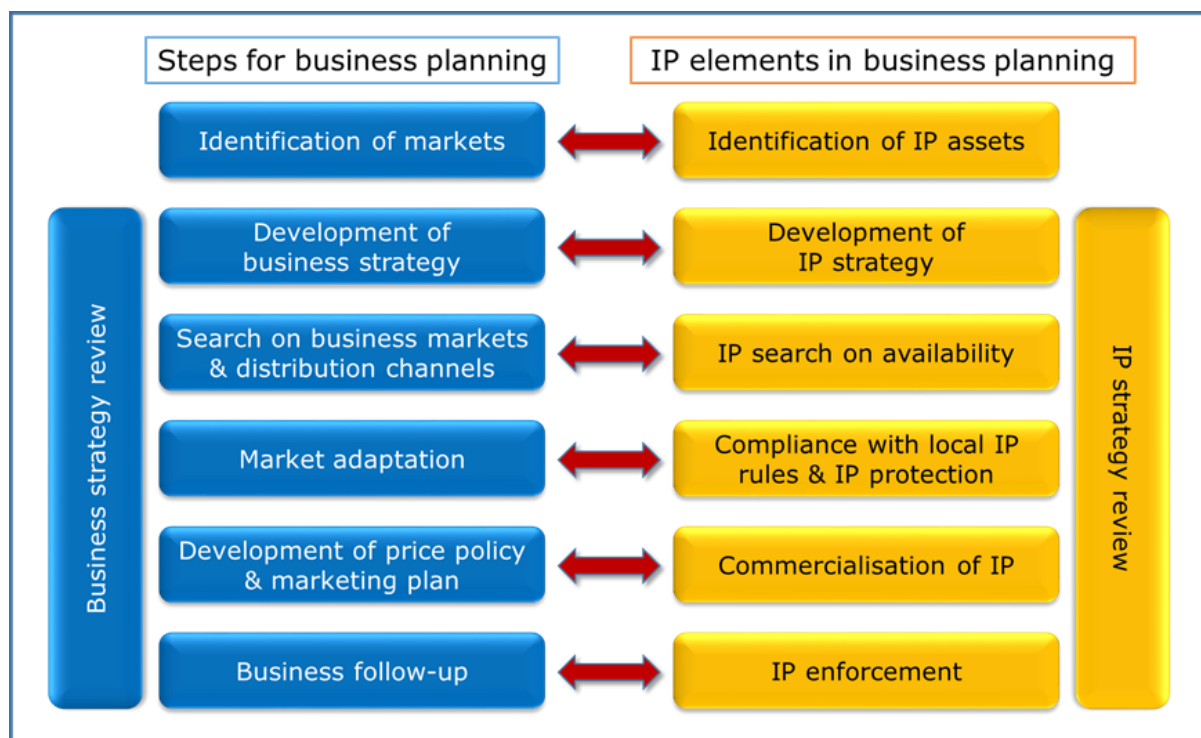
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Introduction

In order to sustain competitiveness in global market within the new world of international alliances and networks, companies are extending their business activities at international level, now more than ever. While on one hand, this integration strengthens the companies' position within the network of borderless trading, on the other hand this extension makes the companies to reconsider their business approaches and tools.

If a company is willing to enter into new foreign markets, that is so-called **internationalisation** process, its business strategy should be shaped in a flexible way allowing adaptation to new business and competition environment. This Fact Sheet will show you how to deal with intellectual property (IP) matters in internationalisation process and which main steps should be taken to efficiently manage intellectual property rights (IPR), when entering into foreign markets.

The following diagram shows the relevance of IP and IPR in each and every step of doing business internationally from identification of markets to business follow-up. With this Fact Sheet, we will draw a frame to guide you through the internationalisation process with some suggestions and practical information on existing IP related tools.



1. Identification of IP assets

As simple as it is: if you do not identify it, you cannot manage it!

In internationalisation process, the identification of markets is the primary step to undertake in order to be aware of what a company has in hands and what its potential is. Likewise, for IP matters, the first core step before entering new markets is the identification of the IP assets composing the company portfolio.

Such identification step allows companies to draw a concrete mapping, not only of the IP assets they already own, but of those they need to acquire. This step will also reveal the company's used and unused IP assets together with the opportunity of adapting their use for different business purposes.

Therefore, before entering into any internationalisation action, it is crucial that all IP values within the company are identified, listed, named and analysed, in a systematic way.



Be careful, any failure in identifying IP may cause serious harms, when entering into foreign markets.

A good way of identifying the IP assets is conducting an **IP audit**, which is a review of the company's IP assets, disclosing their use, values and their legal status. It also reveals the importance of each asset and analyses a possible better use of IP within the company.

More often, companies are performing **IP due diligence**², which is indeed a type of narrower scope exercise than the IP audit, allowing the identification and analyse of their IP portfolio. In this context, developing an **IP map** - a document identifying intangibles and retracing their ownership - may also be used as an instrument for helping the businesses to identify their IP assets and ascertain the existence of third party rights.

As a result of the identification step, the IP assets will most probably fall into the following main categories: patents, trade marks, designs, copyrights, domain names and trade secrets³.

² For more information about IP due diligence and how it is carried out, please refer to the European IPR Helpdesk Fact Sheet on "[IP due diligence: assessing value and risks of intangibles](#)".

³ Although there are other types of IPR namely, utility models (*aka* petty or petit patents), geographical indications and integrated circuits, the mentioned IP assets are the most known and exploited ones.



Patent: Protects inventions, provided that they are new, involve an inventive step and are capable of industrial application.

Trade mark: Protects signs, used to distinguish products and services from those of others.

Design: Protects novel ornamental or aesthetic characteristics of products.

Copyright: Protects creative works of expression.

Domain Name: A name used to identify a particular website or webpage.

Trade Secret: Confidential business information, providing an enterprise a competitive advantage against others.

2. Development of IP strategy

Today, intellectual assets constitute far more value than tangible ones in market portfolios of companies⁴. Hence, building up strategies for management of IP assets is of great importance when developing business strategies for internationalisation.

The **IP strategy** is part of the overall business strategy and states how to use IP to achieve success in terms of business. It is focused on whether and how IP protection would strengthen the ability of entrepreneurs to achieve their goals. Therefore, the IP strategy should be a part of the business strategy.

A sound and elaborated IP strategy helps companies to maximise value creation through IP exploitation, which also supports market growth.

There are two general types of IP strategies, namely (i) offensive strategy and (ii) defensive strategy.

2.1. Offensive strategy

In the offensive strategy, the main goal is **to protect the owned IPR and to acquire external IPR**, where possible. This strategy gives an advantage over competitors by acquisition or grant of licences and allows companies to:

- Acquire or warrant essential rights
- Create obstacles to competitors by:
 - Requiring them to pay compensation in case of any unauthorised use of exclusive rights.
 - Forcing them to get a licence if no concurrent/alternative technology exists or is available in the market.
 - Requiring them to perform additional R&D.

⁴ [Annual Study of Intangible Asset Market Value, Ocean Tomo LLC.](#)

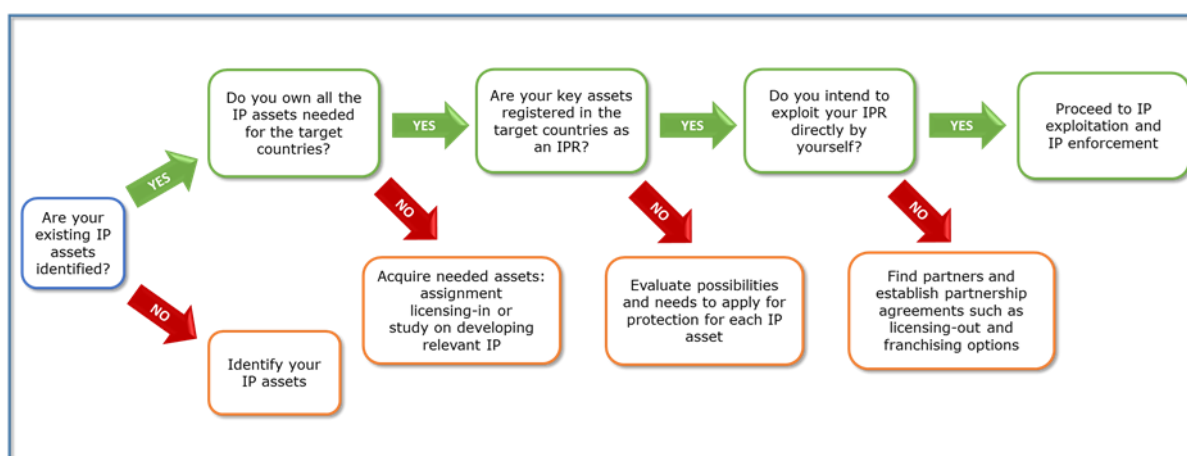
2.2. Defensive strategy

The main objective of the defensive strategy is **to eliminate or reduce risks** by preventing competitors from exploiting the company's creations.

In terms of IP the defensive strategy implementation might include among others:

- Obtain licences to exploit any blocking IP⁵.
- Design around the blocking IP.
- Oppose the rights of the blocking IP.
- Develop or acquire an IP portfolio for cross-licensing purposes.
- Get an IP insurance.

The following scheme shows a few questions that companies should ask themselves while building their IP strategies.



Indeed, as the answers to these questions can differ from one product/process/service or country to another, a far-reaching IP strategy shall address both offensive and defensive strategies, but the correct balance between these two is a complex issue that depends on the company's business targets in international markets.



The IP strategy must be a part of the business strategy, working in line with the market plans.

Keep in mind that the IP strategy is a living document which should be reviewed regularly to be adjusted according to new conditions and unforeseen business situations.

3. IP search on availability

Patents, trade marks and designs are territorial rights. In other words, they are only valid in the country or region in which they have been filed and granted.

⁵ Blocking IP: Intellectual assets, which are strategically used as a barrier to pre-empt competitors from getting their IP granted and entering into markets and technologies.



Trade mark, patent and design rights are obtained through registration and therefore recorded in public registers. It is consequently possible to perform IP searches for such rights in the relevant dedicated databases.

Therefore, before investing resources in internationalisation activities and prior to enter foreign markets, it must be verified that IP assets can be used in these markets without causing any conflict with other parties. Should this be the case, there is not only a risk of losing money, but also a risk of losing the company's reputation. Indeed, if it comes out that it is infringing other parties' IP rights, the company's business credibility (arising from the great success in other markets) may suddenly be destroyed just because an availability search⁶ has not been carried out.

Furthermore, when entering into new markets, IP searching activities can also help companies to identify potential competitors and infringers.

3.1. Trade mark searches

Availability search for trade marks should be carried out in registers covering the territories of interest to check whether an identical and/or similar trade mark (or other sign used in course of trade) already exists for the same or similar products and services. Searches are possible in national and/or international registers (such as [eSearchPlus](#) or [TMview](#) from the European Union Intellectual Property Office (EUIPO), or [Madrid Monitor](#) from WIPO).

3.2. Patent searches

When seeking patent protection in new countries, patent searches should be undertaken for the concerned territories, using relevant databases (such as national databases, [Espacenet](#) from EPO, [Patentscope](#) from the World Intellectual Property Organization (WIPO)).

3.3. Design searches

Apart from national registers, it is possible to search for similar and identical designs through EUIPO's [DesignView](#) database, where you can access to the Registered Community Designs (RCD) register together with a number of national registers. [The Hague Express Database](#) from WIPO provides access to international registrations.

4. Adaptation to local specificities and IP protection

Protecting IPR provides significant benefits for the companies in internationalisation process. As IPR are territorial rights, companies should

⁶ For further information on IP searches, consult the European IPR Helpdesk Fact Sheets on the matter, available in our [library](#).

consider protecting their intellectual assets in each territory they are planning to enter and have business activities in.

However, while seeking protection in different countries, apart from the huge registration costs, possible non-equalities on the local rules and IP protection procedures specificities must be taken into account. Moreover, possible differences in the perception of your product and the related IPR in a specific market may also interfere on your market success. For example, an invention, which is to be exploited as the main basis for a company's internationalisation activities, may be contrary to the public morality in one of the countries. Likewise, a trade mark, which a company decides to use to create the main communication between the product and the clients may have a negative perception in a specific country or society because of a specific traditional, historical or cultural implication.

Therefore, companies in internationalisation process are strongly advised to consider local specificities, adapt their IP and marketing strategies to specific markets, if needed, and seek available international application/registration systems in order to save money and ease the management of their IP portfolio.

4.1. Legal aspects

In the EU the IP protection rules are to some extent harmonised. Their interpretation however may vary and it is indeed best practice to be aware about the legal specificities in the relevant countries. Thus, seeking professional advice from a local IP attorney or lawyer is always suggested.

4.2. Language and cultural issues

When entering into foreign markets, one of the key points to be considered for business success is the meaning/transliteration of the trade mark in the local language, and its registrability. Indeed, the trade marks should not necessarily be kept the same as in other countries. Failing to give importance to this fact may cause irrecoverable errors not only in the IP applications but also in the whole marketing strategy in a specific country.

4.3. IP protection

4.3.1. Trade mark protection routes

National protection: it is sought through the national IP offices of each country and applicants needs to follow national rules and procedures.

The European Union trade mark (EUTM)⁷ system: it is administered by EUIPO and offers protection throughout the European Union (EU). The applicant pays one set of fees and follows a single registration and examination procedure in one language for all EU Members States.

⁷ For further information on European Union trade mark protection, consult [EUIPO's website](#).

International trade mark registration via the Madrid System⁸: it is administered by WIPO and more than 90 countries are part of it. The applicant pays one set of fees and follows a single international registration procedure in one language before WIPO. However, the scope of protection of the international registration will be determined after examination of the application by the IP offices of the designated countries under the relevant national trade mark law⁹.

4.3.2. Patent protection routes

National protection: patents are applied for and granted by the national IP offices of each country, where the protection is sought, following national rules and procedures.

European patent (EP)¹⁰: it is applied before the European Patent Office (EPO) following the rules of the European Patent Convention. The applicant pays one set of fees and follows a single grant procedure in one language. The European patent is not a uniform title. A successful European patent application will instead result in the grant of a bundle of national patents, following a validation phase at national level, in each of the countries designated in the European patent application.

European patent with unitary effect (unitary patent)¹¹: it will be granted by the EPO under the rules and procedures of the European Patent Convention. In order to obtain a unitary effect within the EU territory (with the exception of Spain, Poland and Croatia), patent holders need to file a request at the EPO within one month of the date of publication of the European patent grant¹².

International patent application under the Patent Cooperation Treaty (PCT)¹³: it is administered by WIPO. Applicants pay one set of fees and follow a single procedure for all PCT Contracting States during the application and international phase. Applicants, then, enter into and follow the national phases directly before the national or regional patent offices of the countries in which they want to obtain patent protection.

4.3.3. Design protection routes

National Protection: applications for design registration are filed throughout the national IP offices of each country, where the protection is sought, and the national rules need to be followed.

⁸ For further information on the Madrid System, consult [WIPO's website](#).

⁹ A trade mark can be subject to an international registration via the Madrid System only if it has already been applied or registered at national level or as a European Union trade mark.

¹⁰ For further information on EP and member states, consult [EPO's website](#).

¹¹ For further information on the unitary patent, please consult the [EPO webpage](#).

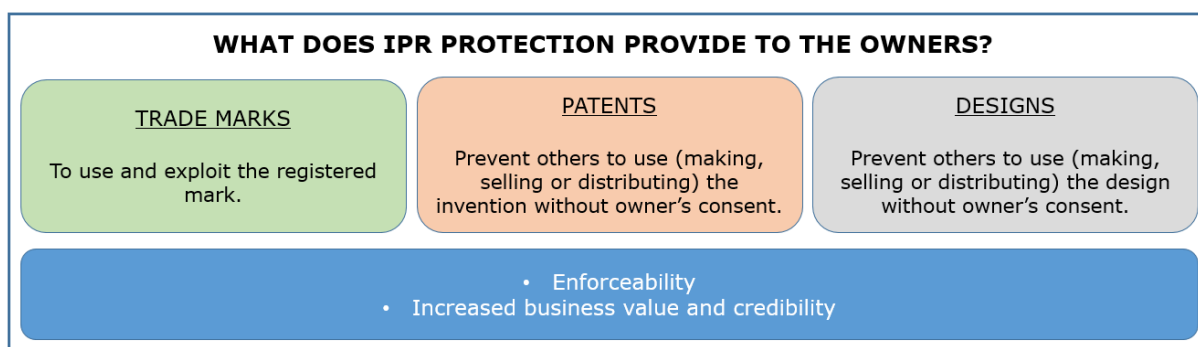
¹² The unitary patent may be requested from the date of the entry into force of the Agreement on a Unified Patent Court. It will need to be ratified by at least 13 states, including France, Germany and the UK to enter into force. For further information on the status of the ratification, consult the [Council of the EU's website](#).

¹³ For further information on the PCT System and Contracting States, consult [WIPO's website](#).

Registered Community design (RCD)¹⁴ is administrated by EUIPO. Applicants file their request to EUIPO or the national IP offices of EU Member States, pays one set of fees and follows a single registration procedure in one language to have a registered Community design within the entire EU.

Unregistered Community design (UCD) is another type of protection, which does not need official registration, given for a shorter period than a registered Community design. The protection starts from the date on which the design was first made available to the public within the territory of the EU. This type of protection generally applies to the products that have short market life. However, it must be noted that the legal protection conferred by a registered Community design is stronger and the design rights are more easily enforceable.

International design registration via the Hague System¹⁵ is administrated by WIPO. The applicant pays of one set of fees and follows a single registration procedure in one language to get a design protection within the designated countries.



At a glance: International IP application and registration routes¹⁶

¹⁴ For further information on Community design protection, consult [EUIPO's website](#).

¹⁵ The Hague System cannot be used to protect an industrial design in a country which is not party to the Hague Agreement, or which is not a Member State of an intergovernmental organisation party to the Hague Agreement. Further information on Hague System a list of the Hague Agreement members is available [here](#).

¹⁶ The European patent with unitary effect (the so-called "unitary patent") is not included in the table as it is not yet in force at the time of publication of this Fact Sheet.

	TRADE MARK	PATENT	DESIGN
Individual routes	<p>Advantages</p> <ul style="list-style-type: none"> ✓ Reasonable cost ✓ Ease of management if applied for a limited number of countries <p>Drawbacks</p> <ul style="list-style-type: none"> ✓ Can be costly if applied in several countries ✓ Difficult to follow many procedures ✓ Need to appoint an attorney in each country 		
Regional routes	<p>Advantages</p> <p>EU trade mark</p> <ul style="list-style-type: none"> ✓ One registration procedure for all EU Member States. ✓ Ease of management. ✓ Low costs. ✓ No requirement for/ dependency on home application. <p>Drawbacks</p> <ul style="list-style-type: none"> ✓ Even if a ground for rejection or cancellation applies in just one EU Member State, the trade mark will fail entirely. 	<p>Advantages</p> <p>European patent</p> <ul style="list-style-type: none"> ✓ One registration procedure in more than 35 EPO member states. ✓ Ease of management. ✓ Low costs. <p>Drawbacks</p> <ul style="list-style-type: none"> ✓ EP attorney needed when not domiciled in an EPO member state. 	<p>Advantages</p> <p>Registered Community Design</p> <ul style="list-style-type: none"> ✓ One registration procedure for all EU Member States. ✓ Ease of management. ✓ Low costs. ✓ No requirement for/dependency on home application. <p>Drawbacks</p> <ul style="list-style-type: none"> ✓ Even if a ground for rejection or cancellation applies in just one EU Member State, the design will fail entirely.
International routes	<p>Advantages</p> <p>via Madrid System</p> <ul style="list-style-type: none"> ✓ One application procedure for more than 115 countries. ✓ Ease of management. ✓ Country selection possible. ✓ Low costs. ✓ Refusal in a country has no effect on others. <p>Drawbacks</p> <ul style="list-style-type: none"> ✓ Requirement for/ dependent on previous home application. ✓ National laws apply. 	<p>Advantages</p> <p>Patent Cooperation Treaty</p> <ul style="list-style-type: none"> ✓ One application procedure for more than 150 PCT states. ✓ Ease of management during the application stage. ✓ Possibility for deferment of costs and proceedings for 30+ months. ✓ Possibility to have EP via Euro-PCT. <p>Drawbacks</p> <ul style="list-style-type: none"> ✓ Just an application procedure, need to enter country phases for further proceedings. ✓ Local patent attorney needed, when not domiciled in a PCT state. 	<p>Advantages</p> <p>via Hague System</p> <ul style="list-style-type: none"> ✓ One registration procedure for more than 65 countries depending on the applicant's entitlement. ✓ Ease of management. <p>Drawbacks</p> <ul style="list-style-type: none"> ✓ Applications not open to everyone, must have a domicile/nationality in a Contracting Party.

4.3.4. When to apply?

Timing is always a crucial point when applying for an IP protection as it may often be difficult to determine when to initiate the application process¹⁷.

The following examples will provide some guidelines on the legal considerations, when determining the right time for application.

For example, **applying too early for a patent application** in every country can make you take the financial burdensome at an “unnecessarily early” stage of commercialisation. Especially translation and maintenance costs can cover huge amount of the company’s total IP budget. One of the ways to decrease such expenses can be filing a PCT application, which delays entering into the national phases up to 30 months or more. Another option can be filing an EP application, which allows managing the patent application process in a centralised manner until the grant decision of the EPO.

On the other hand, **applying for a patent, trade mark or design too late** may be detrimental for the company’s chances to obtain protection, since a very simple principle applies for many countries including the EU Member States: the one who applies first, obtains the protection -if all conditions are fulfilled.

Besides, **late application for IPR** may lead losing also priority rights, which are obtained through the first filing of an IP application. That is, if priority of an earlier application is claimed when filing subsequent IPR applications for the same IPR in other countries, the latter applications will be deemed as filed on the same date of the earlier application. But, in order to benefit from this right, a strict deadline for

¹⁷ Copyright protection does not require registration formalities for signatory countries of the Bern Convention. For further information, consult the [Bern Convention](#).

claiming priority must be met, which is 12 months for patents and 6 months for designs and trade marks from the date of first filing.

Taking IP application steps slowly may also cause the companies to no longer meet with novelty requirements. As a principle, the disclosure of an invention or design could impede the mandatory novelty requirement. Indeed, a new invention or design must not be disclosed before applying for protection. However, disclosures do not ruin novelty, if they fall within a certain time limit (the so-called “grace period” that can be up to 12 months for inventions and designs), and under certain conditions.

Along with the above mentioned time constraints, set by the IPR regulations, limitations arising from the companies’ business activities and priorities (such as the product launch date, selected route of protection, financial availability, target countries etc.) need also assessment when determining the right time to apply for IP protection. Therefore, although there is no single answer for when to file an IPR application, each of these elements play different roles on determining the right time for application.

4.4. Exhaustion of IPR in international markets

The exhaustion principle (also referred to as “first sale doctrine”) is a specific limit to IPR to prevent monopoly regime and to preserve the nature of trade. Indeed and unless otherwise specified by law, once a product protected by IPR has been marketed either by the IPR owner or by third parties with his consent, the IPR on this given product can no longer be exercised by the owner, as they are “exhausted”. In practice this means that any subsequent acts of resale or other forms of commercial use by third parties cannot be opposed by the owner of the IPR.

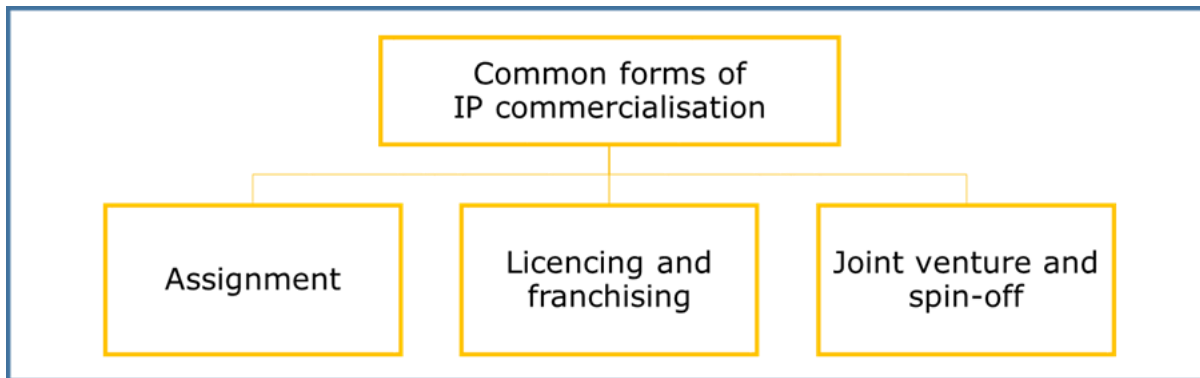
It is in fact the exhaustion principle which explains why when buying and reselling a particular branded product (shoes, clothes) consumers do not need to ask the consent of trade mark holder. The exhaustion principle never applies to the intellectual property rights as a whole but only to the physical object sold for which indeed restrictions to commercialisation linked to intellectual property rights cease to apply.

Ascertaining whether a particular situation of marketing a product abroad leads to exhaustion is a complex issue that depends on the concept of exhaustion of IPR applicable in each jurisdiction. There are different concepts of exhaustion such as national, regional and international and the conditions and extensions are mostly depending on national IP rules. Within the EU, the concept of regional extension is accepted, which means that the first sale of IP protected product in any of the EU countries (including European Economic Area countries) by the IP owner, or by a third party with his consent exhausts all IPR over the specific product within all EU territory.

5. Commercialisation of IP

The process of bringing IP to the market is termed as IP commercialisation and business activities makes IP an indispensable component for business development in foreign markets.

There are several ways for launching a protected IP on the market. The most common ones are summarised in the following diagram:



Since there is a strong link between successful commercialisation of IP and success of the business, the companies should give utmost importance to secure the IP before and during the commercialisation process.

Selection of the most suitable form of commercialisation depends on the nature of business, business strategies and targets, financial and intellectual capacity of the business and development of business partnerships.

Licensing, for example, can be one of the most attractive ways for commercialising IP, if a company:

- Wishes to enter or expand into an unknown market: a licensor may benefit from licensee's network and market knowledge (licencing-out).
- Wishes to improve the quality of the products or services or providing new products or services to the clients: a licensee, may benefit from licensor's technology, renown or good reputation (licencing-in).
- Wishes to develop commercial partnerships by exchanging IP to create a win-win situation (cross-licencing).



Licensing is one of the most effective ways to exploit and commercialise IP providing businesses a powerful presence in a local market unknown to them.

Nevertheless, an important step before entering into international IP commercialisation activities is setting up confidentiality contracts in order to secure the exchange of confidential information, including IP.

Confidentiality contracts are aimed to preserve the secrecy of confidential information within the company and towards external business partners.

Confidentiality agreements within the company are commonly signed between employer and employee, to prevent any leakage of confidential information released to the employee in the context of the execution of its work activities. Confidentiality provisions may also be part of an employment contract.

Confidentiality agreements are also used in the context of business negotiations where confidential information needs to be exchanged. A confidentiality agreement should define exactly the information or ideas to be kept confidential and set out the purpose for which the information is disclosed and thus to restrict its further use. Furthermore, it will be legally binding only if signed before any confidential information is shared.

In commercialisation phase, IP should be the subject of every technology transfer/IP related contracts such as licensing agreements, assignment agreements, joint-venture agreements etc. to secure and regulate the relationship between the parties regarding IP.

6. IP enforcement

Surviving at international markets can only be possible as long as the IP owners enforce their rights effectively. Taking effective actions against infringers and recovering the losses incurred from infringement are key points for success in business, as the value of IP rights is directly related to the ability of the owner to enforce them. Therefore, it is always best to integrate an efficient IP monitoring system as a part of the IP strategy and to appoint an experienced attorney or lawyer in the corresponding market¹⁸.

For licensing agreements, for example, it is always suggested to clearly set out in the contract who has the responsibility for taking actions against possible infringements (licensee or licensor) and what mechanisms will be run in that case. Generally in such agreements, as licensors enter foreign markets with experienced licensees, the market monitoring and initial enforcement steps are taken by the licensees (such as sending cease and desist letter, getting into contact with the infringing party...) in close contact with licensor. Further actions, however, can be taken by the licensor with the advice of licensee, when needed.

It should not be forgotten that enforcement actions differ from country to country and thus reviewing the options on legal procedures against infringements or for preventing the unlawful use of IP is strongly recommended. For example, Alternative Dispute Resolution (ADR) mechanisms can also be kept in mind as a time and cost efficient mean for the resolution of disputes out of courts¹⁹.

¹⁸ For further information on IP enforcement, please consult the European IPR Helpdesk Fact Sheet on "[Defending and enforcing IP](#)".

¹⁹ For further information on ADR mechanisms, please consult the European IPR Helpdesk Fact Sheet, prepared in collaboration with the WIPO Arbitration and Mediation Center, on "[Alternative Dispute Resolution \(ADR\) mechanisms](#)".



Find below some advice regarding enforcement actions for businesses entering into foreign markets:

- ✓ Take all possible measures to secure your IP and avoid potential infringement, rather than to taking enforcement actions. This will possibly be much less complex, and less costly.
- ✓ Carefully review legal alternatives to be followed when an infringement occurs in the foreign country depending on the infringement case. In certain countries criminal actions would be more effective, while in other countries arbitration and mediation options would be less costly and a quicker way to solve the issue.
- ✓ Always seek advice from an IP professional in that country, if you do not have enough capacities.
- ✓ In IP agreements, clearly designate the person responsible for IP market watch and enforcement actions.
- ✓ Co-ordinate with other IP right holders and join your forces to reduce the costs.
- ✓ Build connections with local enforcement authorities.
- ✓ Act as quick as possible.

Useful Resources

For further information, also see:

- Fact Sheet on "[IP due diligence: assessing value and risks of intangibles](#)"
- Fact Sheet on "[How to search for trade marks](#)"
- Fact Sheet on "[How to search for patent information](#)"
- Set of Fact Sheets on "[Commercialising Intellectual Property](#)"
- Fact Sheet on "[How to manage confidential business information](#)"
- Fact Sheet on "[Non-disclosure agreement: a business tool](#)"
- Fact Sheet on "[Defending and enforcing IP](#)"
- Fact Sheet on "[Alternative Dispute Resolution Mechanisms](#)"
- South-East Asia IPR SME Helpdesk's Fact Sheet on "[Top 20 IP Considerations when entering a new market](#)"

GET IN TOUCH

For comments, suggestions or further information, please contact

European IPR Helpdesk
c/o infeurope S.A.
62, rue Charles Martel
L-2134, Luxembourg

Email: service@iprhelppdesk.eu

Phone: +352 25 22 33 - 333

Fax: +352 25 22 33 - 334



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ABOUT THE EUROPEAN IPR HELPDESK

The European IPR Helpdesk aims at raising awareness of Intellectual Property (IP) and IPR (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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