



## **Topic 9 – Border Measures**

*National Workshop – Enforcement of IPRs for Law  
Enforcement Agencies*

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# Role of Customs Authorities

- Controlling the movement of goods, people and conveyances across borders
- Trade → TRIPS recognizes the importance of effective IPR border measures
- Customs officials have a unique understanding of international trade
- Customs has special techniques and tools available to combat cross border infringements, incl. IP infringements
- Customs community is organized internationally (WCO) and has a culture of cooperation and mutual assistance
- Capability to participate in regional/international operations coordinated by WCO and/or INTERPOL

# Relevant competencies of a Customs official

- Document interpretation
- Profiling
- Information and intelligence analysis → Risk Analysis
- Use of information technology
- Goods inspection, incl. X-ray examination
- Interview and questioning



# Why Border Measures?

- Problem: Once imported, and entered chain of commerce, keeping track of infringing goods is difficult and enforcement impossible
- Solution: Prevent entry into the market by permitting suspension of the release of the goods at point of entry
- TRIPS, Articles 51-60

# Main Provisions

- **Article 51:** The **principle** - right holders who have valid grounds for suspecting that importation of counterfeit trademark or pirated copyright goods may take place may **apply** for the suspension by the customs authorities of the release of the goods into free circulation
- **Article 58:** **optional - ex officio procedure** permitting customs to act upon their own initiative by suspending the release of goods in respect of which they have acquired *prima facie* evidence that an IP right is being infringed

# Object of suspension

- To give rights holder and/or authorities time to establish whether or not the goods infringe an IPR
- And to obtain a court order based on the merits of the claim



# Article 51

- Subject: Suspension of release of alleged infringing goods.
- Only against the **importation** of **alleged counterfeit trademark goods** or **pirated copyright goods**...
- ... but Member States may go further :
  - goods involving infringement of other IPRs
  - goods to be exported.

# Article 51

## footnote 14

- **counterfeit trademark goods** shall mean any goods, including packaging, **bearing without authorization a trademark** which is validly registered in respect of such goods, **or which cannot be distinguished in its essential aspects from such a trademark**, and which thereby infringes the rights of the owner of the trademark in question [...] // trademark counterfeiting ≠ trademark infringement
- “**pirated copyright goods** shall mean any goods which are **copies made without the consent** of the right holder or person duly authorized by the right holder [...] and which are made directly or wipoindirectly from an article where the making of that **copy** would have constituted an **infringement of a copyright or a related right** [...] // copyright piracy ≠ copyright infringement

=>

- **counterfeit trademark goods** // trademark counterfeiting ≠ trademark infringement
- **pirated copyright goods** // copyright piracy ≠ copyright infringement

(WTO Panel, “China – Measures affecting the protection and enforcement of IPRs” (WT/DS362/R), par. 7.520)



# How does it work?

- Application to *Competent Authorities (CA)* by the right holder with sufficient evidence of a *prima facie* infringement in the country of importation (Art. 52)
- CA decide to accept the application or not, and inform the applicant (Art. 52)
- CA may require a security or equivalent assurance: protection against abuse of right (Art. 53.1)

# How does it work?

- Effective suspension of release of goods by Customs => notification to the applicant and the importer (Art. 54)
- Effective suspension of release of goods = for a determined period of time: 10 (+ 10) working days for applicant to initiate a procedure on the merits or for the duly empowered authority to take provisional measures (Art. 55)

# Right of Inspection and Information (Art. 57)

- The right holder has sufficient opportunity inspect the detained goods to substantiate his claims
- The importer has the same opportunity to have the goods inspected
- Where a positive determination has been made on the merits, Customs may inform the right holder of
  - the names and addresses of the consignor, the importer and the consignee and
  - of the quantity of goods

# Right of Review (Art. 55)

- If proceedings on the merits of the case have been initiated
  - a review must take place upon request of the defendant to decide
  - within a reasonable period
  - whether they must be modified, revoked or confirmed

# How does it work?

- Effective suspension of release of goods = for a determined period of time: 10 (+ 10) working days for applicant to initiate a procedure on the merits or for the duly empowered authority to take provisional measures (Art. 55)
  - *Quid perishable goods?*
- If not => release of the goods
- *Specificity: Simplified Procedure (e.g.: EU Customs Regulation 608/2013, Art. 23)*

# Remedies (Art. 59)

- Destruction or
- disposal outside the channels of commerce to avoid any harm caused to the right holder
  - of infringing goods
  - without compensation

# Counterfeit trademark goods

- May not allow the re-exportation of the infringing goods
- in an unaltered state
- or subject them to a different customs procedure
- other than in exceptional circumstances

# Specificities

- *Optional: Ex Officio Action* by CA, without application from the right holder (Art. 58)
  - Customs may seek from the right holder any information that may assist them to exercise powers
  - Customs must promptly notify the importer and the right holder of the suspension
- *Optional: De Minimis Imports* (Art. 60) re. small goods of a non-commercial nature contained in traveller's personal luggage or sent in small consignments
  - e.g., *EU Customs Reg. 608/2013, Art. 1(4)*



# Thank you for your attention!



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