



## **CHECKLIST OF ISSUES ON ENFORCEMENT<sup>1</sup>**

### RESPONSES FROM EUROPEAN UNION

#### **Introduction**

EU notification with regard to the updated IPR enforcement checklist (questions 15-25), updating the earlier version notified some time ago (document IP/N/6/EEC/1).

#### **Civil and Administrative Procedures and Remedies**

*(a) Civil judicial procedures and remedies*

- 1. Specify the courts which have jurisdiction over IPR infringement cases.**
  
- 2. Which persons have standing to assert IPRs? How may they be represented? Are there requirements for mandatory personal appearances before the court by the right holder?**
  
- 3. What authority do the judicial authorities have to order, at the request of an opposing party, a party to a proceeding to produce evidence which lies within its control?**
  
- 4. What means exist to identify and protect confidential information brought forward as evidence?**
  
- 5. Describe the remedies that may be ordered by the judicial authorities and criteria, legislative or jurisprudential, for their use:**
  - **injunctions;**
  - **damages, including recovery of profits, and expenses, including attorney's fees;**
  - **destruction or other disposal of infringing goods and materials/implements for their production;**
  - **any other remedies.**

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<sup>1</sup> Document [IP/C/5](#)

**6. In what circumstances, if any, do judicial authorities have the authority to order the infringer to inform the right holder of the identity of third persons involved in the production and distribution of the goods or services found to be infringing and of their channels of distribution?**

**7. Describe provisions relating to the indemnification of defendants wrongfully enjoined. To what extent are public authorities and/or officials liable in such a situation and what "remedial measures" are applicable to them?**

**8. Describe provisions governing the length and cost of proceedings. Provide any available data on the actual duration of proceedings and their cost.**

*(b) Administrative procedures and remedies*

**9. Reply to the above questions in relation to any administrative procedures on the merits and remedies that may result from these procedures.**

### **Provisional Measures**

*(a) Judicial measures*

**10. Describe the types of provisional measures that judicial authorities may order, and the legal basis for such authority.**

**11. In what circumstances may such measures be ordered *inaudita altera parte*?**

**12. Describe the main procedures for the initiation, ordering and maintenance in force of provisional measures, in particular relevant time-limits and safeguards to protect the legitimate interests of the defendant.**

**13. Describe provisions governing the length and cost of proceedings. Provide any available data on the actual duration of proceedings and their cost.**

*(b) Administrative measures*

**14. Reply to the above questions in relation to any administrative provisional measures.**

## Special Requirements Related to Border Measures

**15. Indicate for which goods it is possible to apply for the suspension by the customs authorities of the release into free circulation, in particular whether these procedures are available also in respect of goods which involve infringements of intellectual property rights other than counterfeit trademark or pirated copyright goods as defined in the TRIPS Agreement (footnote to Article 51). Specify, together with relevant criteria, any imports excluded from the application of such procedures (such as goods from another member of a customs union, goods in transit or *de minimis* imports). Do the procedures apply to imports of goods put on the market in another country by or with the consent of the right holder and to goods destined for exportation?**

Regulation (EU) No 608/2013 (the "Regulation") empowers customs authorities to detain goods suspected of infringing an intellectual property rights (IPR) conferred by EU or national law.

The IPRs covered are trademarks, designs, patents, copyright and related rights, supplementary protection certificates for medicinal products and for plant protection products, plant variety rights, geographical indications, trade names, topographies of semiconductor products and utility models.

As long as the goods are, or should have been, subject to customs supervision or customs control (e.g. they are: (a) declared for release for free circulation, export or re-export; (b) entering or leaving the customs territory of the Union; (c) placed under suspensive procedures<sup>i</sup>) the customs can detain them in case of a suspicion of IPR infringement.

On the contrary, the Regulation does not apply to: goods that have been released for free circulation under the end-use regime<sup>ii</sup>; goods of a non-commercial nature contained in travellers' personal luggage; goods that have been manufactured with the consent of the right-holder or goods manufactured, by a person duly authorized by a right-holder to manufacture a certain quantity of goods, in excess of the quantities agreed between that person and the right-holder.

**16. Provide a description of the main elements of the procedures relating to the suspension of the release of goods by customs authorities, in particular the competent authorities (Article 51), the requirements for an application (Article 52) and various requirements related to the duration of suspension (Article 55). How have Articles 53 (security or equivalent assurance), 56 (indemnification of the importer and of the owner of the goods) and 57 (right of inspection and information) been implemented?**

Each EU member State has a customs department competent to receive and process applications for actions. The IPR holder chooses whether to file a national or a Union application for action (the only conditions to be met are that the IPR holder is entitled to submit the application and that a Union application can only be submitted for Union rights).

The holder of the IPR or the person authorized to use it (as well as the representative) shall prove, at the time of the application, their status, the rights to be enforced, shall describe the goods in question in sufficient detail and provide all information relevant for customs authorities' risk analysis. They must have protected their IPR in the member State where application for action is made by means of either a national, regional or an international instrument.

The competent customs department shall notify the applicant of its decision granting or rejecting the application within 30 working days of the receipt of the application. In the event of rejection, the competent customs department shall provide reasons for its decision and include information on the appeal procedure.

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<sup>i</sup> After the adoption of the Union Customs Code with Regulation EU No 952/2013 (the "UCC"), these procedures are referred to as "special procedures" and they encompass the following situations:

- (a) transit, which shall comprise external and internal transit;
- (b) storage, which shall comprise customs warehousing and free zones;
- (c) specific use, which shall comprise temporary admission and end-use;
- (d) processing, which shall comprise inward and outward processing.

<sup>ii</sup> Art. 254 of the UCC

Goods suspected of infringing an intellectual property right may be destroyed under customs control, without the need to determine if an intellectual property right has been infringed under the law of the member State where the goods are found, when:

- the right-holder involved confirmed in writing to the customs authorities (within ten working days, or three working days in the case of perishable goods, of notification of the suspension of the release or the detention of the goods) that, in his conviction, an intellectual property right has been infringed, together with his agreement to the destruction; and
- the declarant or the holder of the goods has confirmed in writing to the customs authorities his agreement to the destruction within the same deadlines.

If the declarant or the holder of the goods does not confirm his agreement in writing nor notifies to the customs authorities his opposition to the destruction, customs authorities may deem the declarant or the holder of the goods to have confirmed his agreement to the destruction of the goods.

If the declarant or the holder of the goods explicitly opposes the destruction or if his tacit consent cannot be presumed, the customs authorities shall immediately notify the right-holder who shall initiate proceedings (within the deadlines of ten working days, or three working days in the case of perishable goods, of notification of the suspension of the release or the detention of the goods) in order to determine whether an intellectual property right has been infringed.

Where the conditions and deadlines mentioned above are not met, the customs authorities shall grant the release of the goods or put an end to their detention.

A simplified procedure for the destruction of small consignments<sup>iii</sup> has been introduced with the aim to alleviate the burden on customs authorities and right-holders in the context of booming internet sales. This procedure provides for the possibility to destroy non-perishable goods, which are suspected of being counterfeit or pirated goods and which are transported in small consignments, upon the express or presumed agreement of the sole declarant or holder of the goods without the need to involve the holder of the decision granting an application for action (the "holder of the decision"). The customs authorities shall apply this procedure if right-holders opted for it when filing their applications for action.

Where the customs authorities have been notified of the initiation of proceedings to determine whether a design, patent, utility model, topography of semiconductor product or plant variety right has been infringed, the declarant or the holder of the goods may request the customs authorities to release the goods or put an end to their detention before the completion of those proceedings. The customs authorities shall release the goods or put an end to their detention only where all of the following conditions are fulfilled:

- (a) the declarant or the holder of the goods has provided a guarantee that is of an amount sufficient to protect the interests of the holder of the IPR;
- (b) the authority competent to determine whether an IPR has been infringed has not authorized precautionary measures;
- (c) all customs formalities have been completed.

The customs authorities shall give the holder of the decision and the declarant or the holder of the goods the opportunity to inspect the goods whose release has been suspended or which have been detained.

The customs authorities may take samples that are representative of the goods. They may provide or send such samples to the holder of the decision, at the holder's request and strictly for the purposes of analysis and to facilitate the subsequent procedure in relation to counterfeit and pirated goods. Any analysis of those samples shall be carried out under the sole responsibility of the holder of the decision. The holder of the decision shall, unless circumstances do not allow, return the

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<sup>iii</sup> Art. 26 of the Regulation

samples to the customs authorities on completion of the analysis, at the latest before the goods are released or their detention is ended.

The customs authorities shall, upon request and where available to them, inform the holder of the decision of the names and addresses of the consignee, the consignor and the declarant or the holder of the goods, of the customs procedure and of the origin, provenance and destination of the goods whose release has been suspended or which have been detained.

Where a procedure duly initiated pursuant to Regulation (EU) No 608/2013 is discontinued, owing to an act or omission on the part of the holder of the decision, where samples are either not returned or are damaged and beyond use, owing to an act or omission on the part of the holder of the decision, or where the goods in question are subsequently found not to infringe an intellectual property right, the holder of the decision shall be liable towards any holder of the goods or declarant, who has suffered damage in that regard, in accordance with applicable national legislation.

**17. Describe provisions governing the length and cost of proceedings. Provide any available data on the actual duration of proceedings and their cost. How long is the validity of decisions by the competent authorities for the suspension of the release of goods into free circulation?**

The application for action is submitted at no cost for the applicant and once granted it has a validity of 1 (one) year maximum unless earlier expired due to the lack of validity of the related IPR in the meantime.

The validity of the decision granting an application for action can be extended upon request of the applicant and the list of IPRs covered can be amended; all the above free of charge for the applicant.

The customs authorities retain the right to revoke, suspend or not renew the application for action when the holder of the decision granting the application for action misuses the information provided by the customs authorities for purposes not foreseen by Regulation (EU) No 608/2013.

The procedure to detain goods suspected of infringing an IPR is the one described under question 16 above.

**18. Are competent authorities required to act upon their own initiative and, if so, in what circumstances? Are there any special provisions applicable to *ex officio* action?**

Where customs authorities suspect, on the basis of reasonable indications, that goods under their supervision infringe intellectual property rights, they may suspend the release of or detain the goods upon application for action or at their own initiative (*ex officio*). In the case of *ex officio* action, an application for action must be submitted to the competent customs department within four working days of the notification of the suspension of the release or detention of the goods in order to maintain their suspension or detention.

**19. Describe the remedies that the competent authorities have the authority to order and any criteria regulating their use.**

Regulation (EU) No 608/2013 allows customs authorities to detain goods suspected of infringing an IPR that are, or should have been, under customs supervision or control. Any other remedies that the competent authorities have the authority to order come within the competence of the member States.

### Criminal Procedures

**20. Specify the courts which have jurisdiction over criminal acts of infringement of IPRs.**

**21. In respect of which infringements of which intellectual property rights are criminal procedures and penalties available?**

**22. Which public authorities are responsible for initiating criminal proceedings? Are they required to do this on their own initiative and/or in response to complaints?**

**23. Do private persons have standing to initiate criminal proceedings and, if so, who?**

**24. Specify, by category of IPR and type of infringement where necessary, the penalties and other remedies that may be imposed:**

- **imprisonment;**
- **monetary fines;**
- **seizure, forfeiture and destruction of infringing goods and materials and implements for their production;**
- **other.**

**25. Describe provisions governing the length and any cost of proceedings. Provide any available data on the actual duration of proceedings and their cost, if any.**

Criminal matters fall within the competence of the EU member States. Article 30 of Regulation (EU) No 608/2013 (the "Regulation") provides that the member States shall ensure that the holders of decisions comply with the obligations set out in the Regulation, including, where appropriate, by laying down provisions establishing penalties and that the penalties provided for shall be effective, proportionate and dissuasive.

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