



THE UNIVERSITY OF
WESTERN AUSTRALIA
Achieving International Excellence

Enforcement

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Outline

- TRIPS Agreement
- EU Draft Criminal Enforcement Directive
- EU Civil Enforcement Directive
- EU Customs Regulation

International Enforcement Regime- TRIPS Agreement

PART III ENFORCEMENT OF INTELLECTUAL PROPERTY RIGHTS

1. General Obligations (Art.41)
2. Civil and Administrative Procedures and Remedies (Arts 42-49)
3. Provisional Measures (Art 50)
4. Special Requirements Related to Border Measures (Arts 51-60)
5. Criminal Procedures (Art 61)

General Obligations Art 41

1. Members shall ensure that enforcement procedures as specified in this Part are available under their law so as to permit **effective action** against any act of infringement of intellectual property rights covered by this Agreement, including expeditious remedies to prevent infringements and remedies which constitute a deterrent to further infringements.

41.2. Procedures concerning the enforcement of intellectual property rights shall be **fair and equitable**.

They shall not be unnecessarily complicated or costly, or entail unreasonable time-limits or unwarranted delays.

41.3. Decisions on the merits of a case shall preferably be in writing and reasoned. They shall be made available at least to the parties to the proceeding without undue delay. Decisions on the merits of a case shall be based only on evidence in respect of which **parties were offered the opportunity to be heard.**

41.4 Parties to a proceeding shall have an opportunity for **review** by a judicial authority of final administrative decisions and, subject to jurisdictional provisions in a Member's law concerning the importance of a case, of at least the legal aspects of initial judicial decisions on the merits of a case.

However, there shall be no obligation to provide an opportunity for review of acquittals in criminal cases.

Civil and Administrative Procedures and Remedies (Arts 42-49)

Art 42-fair and equitable procedures

Art 43-evidence

Art. 44- injunctions

Art 45- damages

Art 46- other remedies

Art 47-right of information

Art 48- indemnification of the defendant

Art 49- administrative remedies

Article 43 Evidence

1. The judicial authorities shall have the authority, where a party has presented reasonably available evidence sufficient to support its claims and has specified evidence relevant to substantiation of its claims which lies in the control of the opposing party, to order that this evidence be produced by the opposing party, subject in appropriate cases to conditions which ensure the protection of confidential information.

Article 44 Injunctions

1. The judicial authorities shall have the authority to order a party to **desist** from an infringement, *inter alia* to prevent the entry into the channels of commerce in their jurisdiction of imported goods that involve the infringement of an intellectual property right, immediately after customs clearance of such goods.

Members are not obliged to accord such authority in respect of protected subject matter acquired or ordered by a person prior to knowing or having **reasonable grounds to know** that dealing in such subject matter would entail the infringement of an intellectual property right.

Article 45 Damages

1. The judicial authorities shall have the authority to order the infringer to pay the right holder damages adequate to **compensate** for the injury the right holder has suffered because of an infringement of that person's intellectual property right by an infringer who knowingly, or with reasonable grounds to know, engaged in infringing activity.
2. The judicial authorities shall also have the authority to order the infringer to pay the right holder expenses, which may include appropriate attorney's fees. In appropriate cases, Members may authorize the judicial authorities to order recovery of profits and/or payment of pre-established damages even where the infringer did not knowingly, or with reasonable grounds to know, engage in infringing activity.

Article 47 Right of Information

Members may provide that the judicial authorities shall have the authority, unless this would be out of proportion to the seriousness of the infringement, to **order the infringer to inform** the right holder of the identity of third persons involved in the production and distribution of the infringing goods or services and of their channels of distribution.

Article 48

Indemnification of the Defendant

1. The judicial authorities shall have the authority to order a party at whose request measures were taken and who has abused enforcement procedures to provide to a party wrongfully enjoined or restrained adequate compensation for the injury suffered because of such abuse. The judicial authorities shall also have the authority to order the applicant to pay the defendant expenses, which may include appropriate attorney's fees.
2. In respect of the administration of any law pertaining to the protection or enforcement of intellectual property rights, Members shall only exempt both public authorities and officials from liability to appropriate remedial measures where actions are taken or intended in good faith in the course of the administration of that law.

Provisional Measures, *Article 50*

1. The judicial authorities shall have the authority to order prompt and effective provisional measures:
 - (a) **to prevent** an infringement of any intellectual property right from occurring, and in particular to prevent the entry into the channels of commerce in their jurisdiction of goods, including imported goods immediately after customs clearance;
 - (b) **to preserve relevant evidence** in regard to the alleged infringement.
2. The judicial authorities shall have the authority to adopt provisional measures *inaudita altera parte* where appropriate, in particular where any delay is likely to cause irreparable harm to the right holder, or where there is a demonstrable risk of evidence being destroyed.

Criminal Enforcement Art. 61

Members shall provide for criminal procedures and penalties to be applied at least in cases of **wilful trademark counterfeiting or copyright piracy** on a commercial scale.

Remedies available shall include imprisonment and/or monetary fines sufficient to provide a **deterrent**, consistently with the level of penalties applied for crimes of a corresponding gravity. In appropriate cases, remedies available shall also include the seizure, forfeiture and destruction of the infringing goods and of any materials and implements the predominant use of which has been in the commission of the offence.

Brussels, 12.7.2005
COM(2005)276 final

2005/0127(COD)
2005/0128(CNS)

Proposal for a

EUROPEAN PARLIAMENT AND COUNCIL DIRECTIVE

on criminal measures aimed at ensuring the enforcement of intellectual property rights

Article 2 Level of penalties

1. Each Member State shall take the measures necessary to ensure that, when committed by natural persons, the offences referred to in Article 3 of Directive/.../EC are punishable by a maximum sentence of at least four years' imprisonment when committed under the aegis of a criminal organisation within the meaning of Framework Decision on the fight against organised crime, or where they carry a health or safety risk.

Article 3, Extended powers of confiscation

The Member States shall take the measures needed to allow the total or partial confiscation of goods belonging to convicted natural or legal persons in accordance with Article 3 of Framework Decision 2005/212/JHA of 24 February 2005 on Confiscation of Crime-Related Proceeds, Instrumentalities and Property, at least where the offences are committed under the aegis of a criminal organisation, within the meaning of Framework Decision on the fight against organised crime, or where they carry a health or safety risk.

Brussels, 12.7.2005
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on criminal measures aimed at ensuring the enforcement of intellectual property rights

Article 3 Offences

Member States shall ensure that all intentional infringements of an intellectual property right on a commercial scale, and **attempting, aiding or abetting and inciting** such infringements, are treated as criminal offences.

- July 2006, the Dutch Parliament wrote a letter to EU Commissioner Frattini stating that the subject-matter of the proposed directive definitely falls outside the European Community's competence (as defined in the EU treaties).
- The inclusion of aiding, abetting or inciting (Article 3) puts businesses at unnecessary risk of criminal liability.
- According to the Foundation for a Free Information Infrastructure it was impossible not to violate software patents and the directive threatened most of Europe's software developers with imprisonment

Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights

(3) without effective means of enforcing intellectual property rights, innovation and creativity are discouraged and investment diminished.

It is therefore necessary to ensure that the substantive law on intellectual property... is applied effectively in the Community.

In this respect, the means of enforcing intellectual property rights are of paramount importance for the success of the internal market.

(4) At international level, all Member States, as well as the Community itself as regards matters within its competence, are bound by the Agreement on trade-related aspects of intellectual property (the TRIPS Agreement), approved, as part of the multilateral negotiations of the Uruguay Round, by Council Decision 94/800/EC and concluded in the framework of the World Trade Organisation.

- (5) The TRIPS Agreement contains, in particular, provisions on the means of enforcing intellectual property rights, which are common standards applicable at international level and implemented in all Member States.
- (7) It emerges from the consultations held by the Commission on this question that, in the Member States, and despite the TRIPS Agreement, there are still major disparities as regards the means of enforcing intellectual property rights.

Article 1, Subject matter

- This Directive concerns the measures, procedures and remedies necessary to ensure the enforcement of intellectual property rights. For the purposes of this Directive, the term ‘intellectual property rights’ includes industrial property rights.

Article 2, Scope

3. This Directive shall not affect:

....

(b) Member States' international obligations and notably the TRIPS Agreement, including those relating to **criminal** procedures and penalties;

(c) any national provisions in Member States relating to **criminal** procedures or penalties in respect of infringement of intellectual property rights.

Article 3, General obligation

1. Member States shall provide for the measures, procedures and remedies necessary to ensure the enforcement of the intellectual property rights covered by this Directive. Those measures, procedures and remedies shall be **fair and equitable** and shall **not** be **unnecessarily complicated or costly**, or entail unreasonable time-limits or unwarranted delays.
2. Those measures, procedures and remedies shall also be **effective, proportionate and dissuasive** and shall be applied in such a manner as to avoid the creation of barriers to legitimate trade and to provide for safeguards against their abuse.

Article 4, Persons entitled to apply for the application of the measures, procedures and remedies

- (a) the holders of intellectual property rights
- (b) all other persons authorised to use those rights, in particular licensees
- (c) intellectual property collective rights-management bodies
- (d) professional defence bodies

Article 5, Presumption of authorship or ownership

For the purposes of applying the measures, procedures and remedies provided for in this Directive,

(a) for the author of a literary or artistic work, in the absence of proof to the contrary, to be regarded as such, and consequently to be entitled to institute infringement proceedings, it shall be sufficient for his/her name to appear on the work in the usual manner.

Article 6, Evidence

(a) Member States shall ensure that, on application by a party which has presented **reasonably available evidence** sufficient to support its claims, and has, in substantiating those claims, specified evidence which lies in the control of the opposing party, the competent judicial authorities may order that such evidence be presented by the **opposing party**, subject to the protection of confidential information.

Member States may provide that a **reasonable sample** of a substantial number of copies of a work or any other protected object be considered by the competent judicial authorities to constitute reasonable evidence.

Article 6, Evidence

(b) Under the same conditions, in the case of an **infringement committed on a commercial scale** Member States shall take such measures as are necessary to enable the competent judicial authorities to order, where appropriate, on application by a party, the **communication of banking, financial or commercial documents under the control of the opposing party**, subject to the protection of confidential information

Article 7, Measures for preserving evidence

(a) Member States shall ensure that, even **before** the commencement of proceedings on the merits of the case, the competent judicial authorities may, on application by a party who has presented reasonably available evidence to support his/her claims that his/her IP right has been infringed or is about to be infringed, order prompt and effective provisional measures to **preserve relevant evidence** in respect of the alleged infringement. Such measures may include the detailed description, with or without the taking of samples, or the physical seizure of the infringing goods, and, in appropriate cases, the materials and implements used in the production and/or distribution of these goods and the documents relating thereto. Those measures shall be taken, **if necessary without the other party having been heard**, in particular where any delay is likely to cause irreparable harm to the right holder or where there is a demonstrable risk of evidence being destroyed.

Article 7, Measures for preserving evidence

(a) Where measures to preserve evidence are adopted without the other party having been heard, the parties affected shall be **given notice**, without delay after the execution of the measures at the latest.

A **review**, including a right to be heard, shall take place upon request of the parties affected with a view to deciding, within a reasonable period after the notification of the measures, whether the measures shall be modified, revoked or confirmed.

2. Member States shall ensure that the measures to preserve evidence may be subject to the lodging by the applicant of adequate **security** or an equivalent assurance intended to ensure compensation for any prejudice suffered by the defendant ...

Article 7, Measures for preserving evidence

3. Member States shall ensure that the measures to preserve evidence are revoked or otherwise cease to have effect, upon request of the defendant, without prejudice to the damages which may be claimed, if the applicant does not **institute, within a reasonable period,** proceedings leading to a decision on the merits of the case before the competent judicial authority, the period to be determined by the judicial authority ordering the measures where the law of a Member State so permits or, in the absence of such determination, within a period not exceeding 20 working days or 31 calendar days, whichever is the longer.

Article 7, Measures for preserving evidence

4. Where the measures to preserve evidence are revoked, or where they lapse due to any act or omission by the applicant, or where it is subsequently found that there has been no infringement or threat of infringement of an intellectual property right, the judicial authorities shall have the authority to order the applicant, upon request of the defendant, to provide the defendant appropriate **compensation** for any injury caused by those measures.

Article 8, Right of information

1. Member States shall ensure that, in the context of proceedings concerning an infringement of an IP right and in response to a justified and proportionate request of the claimant, the competent judicial authorities may order that information on the origin and distribution networks of the goods or services which infringe an IP right be provided by the infringer and/or any other person who:

- (a) was found in possession of the infringing goods on a commercial scale;
- (b) was found to be using the infringing services on a commercial scale;
- (c) was found to be providing on a commercial scale services used in infringing activities; or
- (d) was indicated by the person referred to in point (a), (b) or (c) as being involved

Article 8, Right of information

2. The information referred to in paragraph 1 shall, as appropriate, comprise:

- (a) the names and addresses of the producers, manufacturers, distributors, suppliers and other previous holders of the goods or services, as well as the intended wholesalers and retailers;
- (b) information on the quantities produced, manufactured, delivered, received or ordered, as well as the price obtained for the goods or services in question.

Right of Information

- Lithuania Law on Copyright and Related Rights 2014

Article 79 Right of Information

1. (...) the court may ... order that information on the origin and distribution networks of copies of the works, other objects of the rights protected under this Law, goods or services which infringe copyright ... be immediately provided by the person...

Article 9, Provisional and precautionary measures

1. Member States shall ensure that the judicial authorities may, at the request of the applicant:
 - (a) issue against the alleged infringer an interlocutory injunction intended to **prevent** any imminent infringement of an intellectual property right...
 - (b) order the seizure or delivery up of the goods suspected of infringing an intellectual property right so as to prevent their entry into or movement within the channels of commerce.

Article 9, Provisional and precautionary measures

2. In the case of an infringement committed on a commercial scale, the Member States shall ensure that, if the injured party demonstrates circumstances likely to endanger the recovery of damages, the judicial authorities may order the **precautionary seizure** of the movable and immovable property of the alleged infringer, including the blocking of his/her bank accounts and other assets.

Article 9, Provisional and precautionary measures

3. The judicial authorities shall, in respect of the measures referred to in paragraphs 1 and 2, have the authority to require the applicant to provide any reasonably available evidence in order to satisfy themselves with a sufficient degree of certainty that the applicant is the rightholder and that the applicant's right is being infringed, or that such infringement is imminent.

Article 9, Provisional and precautionary measures

4. Member States shall ensure that the provisional measures referred to in paragraphs 1 and 2 may, in appropriate cases, be taken **without the defendant** having been heard, in particular where any delay would cause irreparable harm to the rightholder.

In that event, the parties shall be so informed without delay after the execution of the measures at the latest.

A review, including a right to be heard, shall take place upon request of the defendant

Article 10, Corrective measures

1. Without prejudice to any damages due to the rightholder by reason of the infringement, and without compensation of any sort, Member States shall ensure that the competent judicial authorities may order, at the request of the applicant, that appropriate measures be taken with regard to goods that they have found to be infringing an IP right and, in appropriate cases, with regard to materials and implements principally used in the creation or manufacture of those goods.

Such measures shall include:

- (a) recall from the channels of commerce;
- (b) definitive removal from the channels of commerce;
- (c) destruction.

Article 10, Corrective measures

2. The judicial authorities shall order that those measures be carried out at the expense of the infringer, unless particular reasons are invoked for not doing so.
3. In considering a request for corrective measures, the need for proportionality between the seriousness of the infringement and the remedies ordered as well as the interests of third parties shall be taken into account.

Article 11, Injunctions

Member States shall ensure that, where a judicial decision is taken finding an infringement of an intellectual property right, the judicial authorities may issue against the infringer an injunction aimed at prohibiting the continuation of the infringement.

Where provided for by national law, non-compliance with an injunction shall, where appropriate, be subject to a recurring penalty payment, with a view to ensuring compliance.

Member States shall also ensure that rightholders are in a position to apply for an injunction against persons whose services are used by a third party to infringe an intellectual property right.

Article 12, Alternative measures

Member States may provide that, in appropriate cases and at the request of the person liable to be subject to the measures provided for in this section, the competent judicial authorities may order **pecuniary compensation** to be paid to the injured party instead of applying the measures provided for in this section if that person acted **unintentionally and without negligence**, if execution of the measures in question would cause him/her disproportionate harm and if pecuniary compensation to the injured party appears reasonably satisfactory.

Article 13, Damages

1. Member States shall ensure that the competent judicial authorities, on application of the injured party, order the infringer who knowingly, or with reasonable grounds to know, engaged in an infringing activity, to pay the rightholder damages appropriate to the **actual prejudice** suffered by him/her as a result of the infringement.

Article 13, Damages

1. When the judicial authorities set the damages:
 - (a) they shall take into account all appropriate aspects, such as the negative economic consequences, including lost profits, which the injured party has suffered, any **unfair profits** made by the infringer and, in appropriate cases, elements other than economic factors, such as the **moral prejudice** caused to the rightholder by the infringement;

Article 13, Damages

1. When the judicial authorities set the damages:
(b) as an alternative to (a), they may, in appropriate cases, set the damages as a lump sum on the basis of elements such as at least the **amount of royalties or fees** which would have been due if the infringer had requested authorisation to use the intellectual property right in question.

Article 13, Damages

2. Where the infringer did not knowingly, or with reasonable grounds know, engage in infringing activity, Member States may lay down that the judicial authorities may order the recovery of **profits** or the payment of damages, which may be pre-established.

Can punitive damages be imposed?

- Request for a preliminary ruling from the Sąd Najwyższy (Poland) lodged on 14 July 2015 — Stowarzyszenie ‘Oławska Telewizja Kablowa’, Oława v Stowarzyszenie Filmowców Polskich, Warsaw (Case C-367/15)
- whether Article 13 of the Enforcement Directive must be interpreted as precluding national legislation which provides for the possibility of demanding payment of a sum corresponding to twice the appropriate fee

Can punitive damages be imposed?

- Having recalled both Recitals 3 and 10 in the preamble to the Enforcement Directive, the Court stated that the Enforcement Directive lays down a minimum standard concerning the enforcement of intellectual property rights and does not prevent the Member States from laying down measures that are more protective.
- "the fact that Directive 2004/48 does not entail an obligation on the Member States to provide for 'punitive' damages cannot be interpreted as a prohibition on introducing such a measure."

Article 14, Legal costs

Member States shall ensure that reasonable and proportionate legal costs and other expenses incurred by the successful party shall, as a general rule, be borne by the unsuccessful party, unless equity does not allow this.

Article 15, Publication of judicial decisions

- Member States shall ensure that, in legal proceedings instituted for infringement of an intellectual property right, the judicial authorities may order, at the request of the applicant and at the expense of the infringer, appropriate measures for the dissemination of the information concerning the decision, including displaying the decision and publishing it in full or in part. Member States may provide for other additional publicity measures which are appropriate to the particular circumstances, including prominent advertising.

**REGULATION (EU) No 608/2013 OF THE
EUROPEAN PARLIAMENT AND OF THE
COUNCIL**

of 12 June 2013

**concerning customs enforcement of
intellectual property rights and repealing
Council Regulation (EC) No 1383/2003**

Regulation (EU) No 608/2013

- implements TRIPS border control obligations
- Reg. 608/2013 (replacing 1383/2003 from 1 Jan 2014) concerning customs enforcement of IPR
- Procedures concerning goods suspected of infringing certain IPR and the measures to be taken against goods found to have infringed such rights

***Article 1* Subject matter and scope**

1. This Regulation sets out the conditions and procedures for action by the customs authorities where goods suspected of infringing an intellectual property right are, or should have been, subject to customs supervision or customs control within the customs territory of the Union in accordance with Council Regulation (EEC) No 2913/92 of 12 October 1992 establishing the Community Customs Code , particularly goods in the following situations:
 - (a) when declared for release for free circulation, export or re- export;
 - (b) when entering or leaving the customs territory of the Union;
 - (c) when placed under a suspensive procedure or in a free zone or free warehouse.

Article 2 **Definitions**

- (1) 'intellectual property right' means:
 - (a) a trade mark;
 - (b) a design;
 - (c) a copyright or any related right as provided for by national or Union law;
 - (d) a geographical indication;
 - (e) a patent as provided for by national or Union law;
 - (h) a Community plant variety right as provided for in Council Regulation (EC) No 2100/94 of 27 July 1994 on Community plant variety rights
 - (l) a trade name in so far as it is protected as an exclusive intellectual property right by national or Union law;

- (4) 'geographical indication' means:
- (a) a geographical indication or designation of origin protected for agricultural products and foodstuff as provided for in Regulation (EU) No 1151/2012 of the European Parliament and of the Council of 21 November 2012 on quality schemes for agricultural products and foodstuffs (1);
 - (b) a designation of origin or geographical indication for wine
 - (c) a geographical designation for aromatised drinks based on wine products
 - (d) a geographical indication of spirit drinks
 - (e) a geographical indication for products not falling under points (a) to (d) in so far as it is established as an exclusive intellectual property right by national or Union law;
 - (f) a geographical indication as provided for in Agreements between the Union and third countries and as such listed in those Agreements;

(5) 'counterfeit goods' means:

- (a) goods which are the subject of an act infringing a trade mark in the Member State where they are found and bear without authorisation a sign which is identical to the trade mark validly registered in respect of the same type of goods, or which cannot be distinguished in its essential aspects from such a trade mark;
- (b) goods which are the subject of an act infringing a geographical indication in the Member State where they are found and, bear or are described by, a name or term protected in respect of that geographical indication;

Article 3

Entitlement to submit an application

The following persons and entities shall, to the extent they are entitled to initiate proceedings, in order to determine whether an intellectual property right has been infringed, in the Member State or Member States where the customs authorities are requested to take action, be entitled to submit:

- (1) a national or a Union application:
 - (a) right-holders;
 - (d) groups of producers provided for in Union law governing geographical indications representing producers of products with a geographical indication or representatives of such groups, in particular Regulations (EEC) No 1601/91 and (EC) No 110/2008 and operators entitled to use a geographical indication as well as inspection bodies or authorities competent for such a geographical indication;

Article 4 **Intellectual property rights covered by Union applications**

A Union application may be submitted only with respect to intellectual property rights based on Union law producing effects throughout the Union.

Article 5 **Submission of applications**

1. Each Member State shall designate the customs department competent to receive and process applications ('competent customs department'). The Member State shall inform the Commission accordingly and the Commission shall make public a list of competent customs departments designated by the Member States.
2. Applications shall be submitted to the competent customs department. The applications shall be completed using the form referred to in Article 6 and shall contain the information required therein.

Application requesting that customs authorities take action with respect to goods suspected of infringing an IPR (Art.6)

EUROPEAN UNION – APPLICATION FOR ACTION

COPY FOR THE COMPETENT CUSTOMS DEPARTMENT	1	1. Applicant Name (*): Address (*): Town (*): Postal Code: Country (*): EORI-No: TIN No: National registration No: Telephone: (+) Mobile: (+) Fax: (+) Email: Website:	For official use Date of receipt Registration number of application
			INTELLECTUAL PROPERTY RIGHTS APPLICATION FOR ACTION BY CUSTOMS AUTHORITIES under Article 6 of Regulation (EU) No 608/2013
			2 (*). Union application <input type="checkbox"/> National application <input type="checkbox"/>
		3 (*). Status of applicant <input type="checkbox"/> Right-holder <input type="checkbox"/> Person or entity authorised to use the IP right <input type="checkbox"/> IP collective rights management body <input type="checkbox"/> Professional defence body	<input type="checkbox"/> Group of producers of products with a Geographical Indication or representative of such group <input type="checkbox"/> Operator entitled to use a Geographical Indication <input type="checkbox"/> Inspection body or authority competent for a Geographical Indication <input type="checkbox"/> Exclusive license holder covering two or more Member States
		4. Representative submitting the application in the name of the applicant: Company: Name (*): Address (*): Town (*): Postal Code: Country (*): Telephone: (+) Mobile: (+) Fax: (+)	<input type="checkbox"/> Evidence of the representatives power to act is enclosed
	1	5 (*). Type of right to which the application refers <input type="checkbox"/> National trademark (NTM) <input type="checkbox"/> Community trademark (CTM) <input type="checkbox"/> International registered trademark (ITM) <input type="checkbox"/> Registered national design (ND) <input type="checkbox"/> Registered Community design (CDR) <input type="checkbox"/> Unregistered Community design (CDU) <input type="checkbox"/> International registered design (ICD) <input type="checkbox"/> Copyright and related right (NCPR) <input type="checkbox"/> Trade name (NTN)	Geographical Indication/Designation of origin: <input type="checkbox"/> for agricultural products and foodstuff (CGIP) <input type="checkbox"/> for wine (CGIW) <input type="checkbox"/> for aromatised drinks based on wine products (CGIA) <input type="checkbox"/> for spirit drinks (CGIS) <input type="checkbox"/> for other products (NGI) <input type="checkbox"/> as listed in Agreements between the Union and third countries (CGIL) Plant variety right: <input type="checkbox"/> national (NPVR)

Art 6 Application Form

3. The Commission shall ensure that the following information is required of the applicant in the application form:
 - (a) details concerning the applicant;
 - (b) the status, within the meaning of Article 3, of the applicant;
 - (c) documents providing evidence to satisfy the competent customs department that the applicant is entitled to submit the application;
 - (d) Details and evidence of a person's powers to act as representative,...
 - (e) the intellectual property right or rights to be enforced;
 - (f) in the case of a Union application, the Member States in which customs action is requested;
 - (g) specific and technical data on the authentic goods, including markings such as bar-coding and images where appropriate;
 - (h) the information needed to enable the customs authorities to readily identify the goods in question;
 - (i) information relevant to the customs authorities' analysis and assessment of the risk of infringement of the intellectual property right or the intellectual property rights concerned, such as the authorised distributors;

***Article 9* Notification of decisions granting or rejecting applications**

1. 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.

***Article 9* Notification of decisions granting or rejecting applications**

2. If the applicant has been notified of the suspension of the release or the detention of the goods by the customs authorities before the submission of an application, the competent customs department shall notify the applicant of its decision granting or rejecting the application within two working days of the receipt of the application.

ACTION BY THE CUSTOMS AUTHORITIES

***Article 17* Suspension of the release or detention of the goods following the grant of an application**

1. Where the customs authorities identify goods **suspected of infringing an intellectual property right** covered by a decision granting an application, they shall suspend the release of the goods or detain them.

ACTION BY THE CUSTOMS AUTHORITIES

***Article 17* Suspension of the release or detention of the goods following the grant of an application**

2. Before suspending the release of or detaining the goods, the customs authorities may ask the holder of the decision to provide them with any relevant information with respect to the goods. The customs authorities may also provide the holder of the decision with information about the actual or estimated quantity of goods, their actual or presumed nature and images thereof, as appropriate.

***Article 19* Inspection and sampling of goods whose release has been suspended or which have been detained**

1. 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.
2. 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.

Article 21 Permitted use of certain information by the holder of the decision

Where the holder of the decision has received the information referred to in Article 17(4), Article 18(5), Article 19 or Article 26(8), he may disclose or use that information only for the following purposes:

- (a) to initiate proceedings to determine whether an intellectual property right has been infringed and in the course of such proceedings;
- (b) in connection with criminal investigations related to the infringement of an intellectual property right and undertaken by public authorities in the Member State where the goods are found;
- (c) to initiate criminal proceedings and in the course of such proceedings;
- (d) to seek compensation from the infringer or other persons;
- (e) to agree with the declarant or the holder of the goods that the goods be destroyed in accordance with Article 23(1);
- (f) to agree with the declarant or the holder of the goods of the amount of the guarantee referred to in point (a) of Article 24(2).

Article 23 **Destruction of goods and initiation of proceedings**

1. Goods suspected of infringing an intellectual property right may be destroyed under customs control, without there being any need to determine whether an intellectual property right has been infringed under the law of the Member State where the goods are found, where all of the following conditions are fulfilled:
 - (a) the holder of the decision has confirmed in writing to the customs authorities, within 10 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;

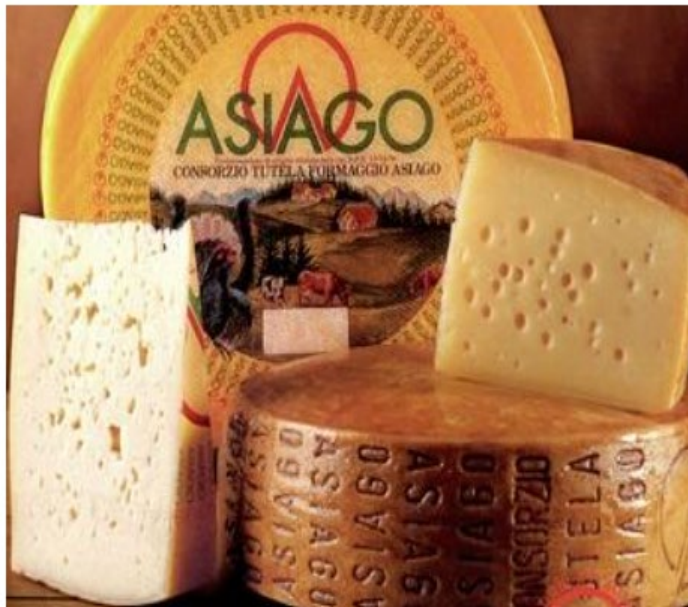
Article 28

Liability of the holder of the decision

Where a procedure duly initiated pursuant to this Regulation is discontinued owing to an act or omission on the part of the holder of the decision, where samples taken pursuant to Article 19(2) 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 specific applicable legislation.

Examples

The real Made in Italy Asiago Cheese



And the American one



INTELLECTUAL PROPERTY ENFORCEMENT

A Commentary on the Anti-Counterfeiting Trade Agreement

Professor Blakeney has written a detailed work on the current state of international enforcement of intellectual property rights. Using the book ground to, and the negotiation of, the Anti-Counterfeiting Trade Agreement, as well as the provisions of the ACTA itself, the book is a mine of information and analysis. Professor Blakeney's long experience of work on the law and practice of IP enforcement as a rights holder, an administrator, and as an academic and researcher, are woven to some effect into this all-encompassing work.

— John Anderson, Global Anti-Counterfeiting Network

This important book is the first detailed analytical treatment of the Anti-Counterfeiting Trade Agreement (ACTA) and its impact on intellectual property enforcement. The ACTA had been formulated to deal with the burgeoning growth in the trade in counterfeit and pirate products which was estimated to have increased ten-fold since the promulgation of the TRIPS Agreement in 1994. The book clarifies how the ACTA supplements the enforcement provisions of the TRIPS Agreement, namely by expanding the reach of border protection to infringing goods in transit, providing greater detail of the implementation of civil enforcement, and providing for the confiscation of the proceeds of intellectual property crimes. As the book illustrates, a significant additional innovation is the introduction of provisions dealing with enforcement of intellectual property rights in the digital environment.

This book will strongly appeal to intellectual property rights policymakers at the World Trade Organization and World Intellectual Property Organisation, legal practitioners, academics and students.

Michael Blakeney is at The University of Western Australia and Visiting Professor at Queen Mary University of London, UK.

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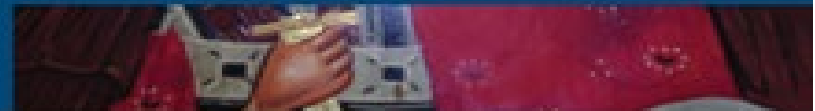


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