



Border seizure

There are several German laws that explicitly prohibit the importation of products that infringe an intellectual property right (i.e. patent, trademark, design, copyright, or the like). Accordingly, the owner of an intellectual property right (in the following: IPR owner) is entitled to prevent such importation. The legal vehicle for the prevention is a request for border seizure ('Grenzbeschlagnahmeantrag') that must be sent to the competent customs authority. After the approval of such a request the customs authority is entitled to seize infringing products.

There are two different application methods for filing a request for border seizure. It is possible to file a national request according to German national law (i.e. § 142a PatG, § 25a GebrMG, § 146 MarkenG) and it is possible to file a European request according to an EU-directive (VO (EU) Nr. 608/2013).

The European request is prior applicable for the import (or export, transit) of products to the European Union. The national German request is therefore formally only applicable for cross-border trade between member states of the European Union or for parallel imports. Furthermore, the national request is applicable in cases relating to a German utility model. As a result of the free movement of goods within the European Union, the cross-border trade between member states is generally not controlled. Therefore, the national request is basically only applicable in cases relating to German utility models.

1. European request

There are three requirements for the seizure of goods according to the European request. The owner of the IPR must have filed an request for border seizure, the specific goods must infringe an IPR and the goods must be located in a seizure situation.

a)

The IPR owner must file the request at the "Generalzolldirektion" in Munich. A licensee is also entitled to file the request. The applicant must prove its authorization concerning the IPR (e.g. by a registry excerpt).



The applicant has further to explain the suspicion of an infringement. It is very important to explain the possible infringement as detailed as possible because the customs authority assesses the infringement only on the basis of the information in the request.

Finally, the applicant must provide a formal obligation to be liable for any costs incurred by the border seizure and to be liable for any possible damages of an alleged infringer caused by the seizure.

The request is valid for one year and could be prolonged.

b)

The question of infringement must be assessed according to the national rules of the particular member state.

It is important to explain in detail the features and the scope of protection for the specific IPR in the request. It is also necessary to explain to the customs authority the precise embodiment of the infringing products, in particular, distinctive marks of the products or the packaging. Furthermore, the IPR owner could explain in detail the typical import routes or means of transport for the infringing products. The more detailed the IPR owner describes the circumstances, the better are the chances of success of the border seizure.

c)

Finally, it is necessary that the infringing product is located in a seizure situation. That means that the customs authority has the possibility of customs authority access. The normal seizure situation is the import of a product into the territory of the European Union. Thus, the seizure situation ends when the product is delivered to the addressee.

d)

If the customs authority actually finds a presumably infringing product, the process of border seizure begins. In the first step the customs authority suspends the delivery of the goods to the addressee (i.e. border seizure). After that, the customs authority informs the parties about the suspension and asks on the one hand the IPR owner to confirm the infringement and on the other hand the alleged infringer to declare its consent to the destruction of the



goods. If the IPR owner confirms the infringement and the alleged infringer does not declare its consent with the destruction, it is the obligation of the IPR owner to initiate proceedings about the infringement against the alleged infringer. It is only obligated to prove the initiation of such proceedings. The border seizure remains valid for the duration of the proceedings.

e)

The applicant is liable for any cost incurred by the border seizure. It has to reimburse all costs concerning the seizure, storage and destruction of the goods to the customs authority. If the seized goods actually infringe the IPR owner's rights, it has a claim for damages against the infringer. This claim also covers the occurred costs during the border seizure.

If the seized goods do not infringe IPR owner's rights, it is liable for any damages of the alleged infringer.

2. German request

The requirements for the border seizure according to a German request are basically the same. The main difference is that the IPR owner must provide sufficient security for possible costs. Furthermore, the customs authority only acts in case of an obvious infringement. Finally, the IPR owner must provide a court decision (preliminary injunction) within 2 weeks to achieve a further seizure of the goods.