

Border Remedies – Italy

In Italy border remedies to protect IP rights are governed by Regulation (EU) no. 608/2013 and by the relative Commission Implementing Regulation (EU) no. 1352/2013.

The procedure consists of the following stages.

1) In order to obtain a border remedy to protect an IP right, the entitled party – usually the right-holder or, upon certain conditions, his licensee- must submit an application for intervention to the Italian Customs and Monopolies Agency, the seat of which is in Rome. The application must be submitted telematically using the form attached to Regulation (EU) no. 1352/2013.

The application must contain, as comprehensively as possible, details concerning the applicant and his representative, if any, the IP rights for which protection is sought and all information relating to the characteristics of the authentic goods, so as to enable the customs authorities to distinguish them from the counterfeit goods. The applicant may also include any information on the counterfeit goods of which he is already cognizant, again to facilitate the customs authorities in their identification activities. The applicant must expressly declare that he will assume liability for any damage unjustly caused by the measures requested and bear any costs incurred by the customs authorities.

2) The Customs Agency then decides whether to admit the application, wholly or partially. In the event of admission, a period not exceeding one year begins to run during which the customs authorities must take action with regard to the goods suspected of infringing the IP right indicated in the application. On expiry of this period an extension may be requested and obtained. The period of extension shall again not exceed one year.

3) Where the customs authorities identify goods suspected of infringing an IP right with regard to which an application has been admitted, in accordance with Art. 17 Regulation (EU) no. 608/2013 they suspend the release of or detain the goods, i.e. implement a border seizure. Immediately after suspending the release of or detaining the goods, the customs authorities notify both the declarant (i.e. the party who has made the customs declaration or in the name of whom said declaration has been made) or the holder (i.e. the proprietor or the party with

the power to dispose of or control the goods) of the goods which are suspected of being counterfeit, and the party who requested intervention by the authorities.

4) Under Art. 18 Regulation (EU) no. 608/2013, the customs authorities may, at their own initiative and without an application having previously been submitted, suspend the release of or detain goods suspected of infringing an IP right. In this case, the authorities, in addition to notifying the declarant or the holder of the goods of the suspension or detention, also notifies the party who would have been entitled to submit an application. This party has a term of four working days from notification within which to submit an application. Should it fail to do so, the goods are released or an end is put to their detention. If an application is submitted and admitted the procedure continues.

5) Under Art. 23 Regulation (EU) no. 608/2013, if within ten working days of notification of suspension of the release or detention of the goods, the right-holder, on the one side, confirms that the goods are counterfeit and requests their destruction and the declarant or the holder, on the other side, agree to the destruction, the customs authorities may proceed directly with destruction of the goods. However, the Italian Customs Agency considers that, notwithstanding a possible agreement between the parties to the goods being destroyed, the Agency is still obliged, in accordance with the Italian Code of Criminal Procedure, to inform the Judicial Authorities of crimes it has become aware of in relation to the counterfeit goods.

6) Should the right-holder, within the term provided, not confirm that the goods are counterfeit and not give his consent to their destruction, the goods are released or an end is put to their detention, unless the right-holder informs the authorities that he has already, in the meantime, initiated a procedure to establish the existence of an infringement of his right.

7) If, however, it is the declarant or the holder who does not agree to destruction, the customs authorities must notify the right-holder of this and the latter must, within ten working days of notification of the suspension of the release or the detention of the goods (this period may be extended by a maximum of ten working days), initiate (if he has not already done so) a procedure to determine whether his IP right has actually been infringed. If the right-holder does not inform the authorities that he has initiated such a

procedure, the goods are released or an end is put to their detention.

8) Save for particular cases provided by Art. 24 of Regulation (EU) no. 608/2013, release of the goods is suspended or the goods are detained until completion of the procedure initiated to ascertain infringement. If it is established that an IP right has been infringed, the goods will be subject to the sanctions provided for infringement. If, however, it is established that an IP right has not been infringed, the goods will be released by the customs authorities and the right-holder will be liable for any damage caused by the suspension or detention, in accordance with Art. 28 Regulation (EU) no. 608/2013.

*** **

Under the Italian Law, if IP rights are infringed the right-holder or his licensee may apply to the Courts, bringing both a civil action of infringement and criminal proceedings. Criminal proceedings may also be initiated upon notification by public officials (in particular, in this case, customs officials).

*** **

In order to combat counterfeiting more effectively, in 2004 the Italian Customs Agency launched the "Falstaff" Project, aimed at promoting the circulation of authentic goods and facilitating the identification and detention of counterfeit goods. For what concerns border remedies, the "Falstaff" Project has led to the creation of a database which, according to the website of the Agency, "is fueled by information provided by right-holders and enables comparisons to be conducted between goods suspected of infringement and the original goods. Each right-holder who requests protection of his IP right generates a form in the database in which the technical characteristics of each product may also be recorded. The written information can also be accompanied by images and a 'map' of the customs itineraries. Customs officials may consult the information thus recorded in real time in order to obtain the contact details of experts of trade associations and/or bodies which certify the quality of the goods placed under protection and avail themselves of them if necessary. The database is also

integrated with the Customs Control Circuit and allows those customs operations which present an infringement risk to be intercepted already at the customs declaration stage”.

The Agency website also states that the “Falstaff” system is used in relation to the telematic submission and registration of requests for protection and is now organized in such a way as to allow “system to system dialogue with the CO.P.I.S. (anti-COunterfeit and anti-PIracy information System) databases, developed by the European Commission for the purposes of allowing data to be exchanged between Member States and the Commission on decisions regarding applications for protection and the detention of goods”.