

Border Remedies – Jurisdiction Summaries

When counterfeit goods are imported and released into the market, it can be difficult to control them. Border detention measures can be a very effective way of preventing counterfeit goods from entering a jurisdiction. This report summarises the border remedies available in [] jurisdictions.

Which intellectual property rights (IPR) are enforced by Customs?	
European Union	<ul style="list-style-type: none">• trade marks and trade names;• design rights (registered and unregistered);• copyright or any related rights;• geographical indications;• patents;• supplementary protection certificates for medical products or for plant protection products;• plant variety rights;• topography of a semiconductor.
Germany	As for EU
United Kingdom	As for EU but there is no customs intervention for utility model and trade names at the UK border as there are no equivalent rights under UK law.
Ireland	As for EU
France	<ul style="list-style-type: none">• author rights;• national designs;• national registered trademarks;• patents;• plant variety;• geographical indications
Italy	As for EU

Which authority has responsibility for IPR enforcement at the border?	
EU	HM Revenue and Customs (HMRC) and Border Force (BF).
Germany	Competent customs authority
UK	HM Revenue and Customs (HMRC) and Border Force (BF).

Ireland	Revenue Commissioners
France	Customs Authorities
Italy	Italian Customs and Monopolies Agency

What is the process for applying for border protection for an IPR holder?	
EU	<ul style="list-style-type: none"> • Submit an Application for Action (AFA) which should include the details required under Article 6 of the Regulation. • Send AFA 30 working days before the infringing goods are expected to be imported or exported, or the applicant wants the monitoring period to commence.
Germany	<ul style="list-style-type: none"> • Submit a request for border seizure ('Grenzbeschlagnahmeantrag') at the "Generalzolldirektion" in Munich either as a national request under German national law (i.e. § 142a PatG, § 25a GebrMG, § 146 MarkenG) or a European request under EU-directive (VO (EU) Nr. 608/2013). The request must set out the applicant's authority to make the request as well as a description of the infringement. The applicant must also provide an undertaking to be liable for any costs incurred by the border seizure and for any possible damages of an alleged infringer caused by the seizure. • The request is valid for one year and could be extended.
UK	Same as EU but do not need to list the relevant Member States.
Ireland	<ul style="list-style-type: none"> • The applicant requests the customs authorities to take action with respect to goods suspected of infringing an intellectual property right. The request is called an "application" and there are two types of applications: • National application: an application submitted in a Member State requesting its customs authorities to take action in that Member State. • Union application: an application submitted in a Member State requesting the customs authorities of that Member State and the customs authorities of one or more other Member States to take action in their respective territories. • The application is valid for a maximum period of one year and could be extended.
France	<ul style="list-style-type: none"> • The right-holder file an application to request a surveillance by the Customs of possible further infringements of one of its IP rights;
Italy	<ul style="list-style-type: none"> • Submit an application for intervention to the Italian Customs and Monopolies Agency. The application must contain 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. The applicant may also include any information on the counterfeit goods of which he is already cognizant, in order to facilitate the customs authorities in their identification activities. The applicant must expressly

	<p>declare that he will assume liability for any damage unjustly caused by the measures requested and bear any costs incurred by the customs authorities.</p> <ul style="list-style-type: none"> • The request is valid for one year and could be extended.
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Who is liable for costs?	
EU	<p>The applicant must give an undertaking to pay all costs and liabilities incurred as a consequence of detentions made. These include:</p> <ul style="list-style-type: none"> • Storage and other handling charges; • Destruction costs. <p>The applicant will be liable for legal costs incurred by the owner of the goods and compensation if the applicant or the court confirms that the goods are not infringing or the action is discontinued owing to an act or omission on the part of the applicant.</p>
Germany	Same as EU.
UK	<p>Same as EU.</p> <p>No fee is payable for filing an AFA itself.</p>
Ireland	Same as EU.
France	Same as EU.
Italy	Same as EU.

European Union

The EU regime is governed by EU-directive (VO (EU) Nr. 608/2013) and applies to goods on their first entry into the European Union. The infringing product must be located in a seizure situation to be detained, this is normally the import of a product into the European Union. As such, the seizure situation ends when the product is delivered to the addressee. Where goods are imported into a Member State from another Member State, the national law will apply to border detention. The principle of free movement of goods within the European Union means that the cross-border trade between member states cannot be restricted. Therefore, national requests are only applicable to parallel imports which are not covered by the EU Regulation and national rights such as German utility models.

There are three requirements for the seizure of goods according to the European request:

1. The owner of the IPR must have filed a request for border seizure;
2. the specific goods must infringe an IPR; and
3. the goods must be located in a seizure situation.

Border seizure is available for a range of IP rights:

- trade marks and trade names;
- design rights (registered and unregistered);
- copyright or any related rights;
- geographical indications;
- patents;
- supplementary protection certificates for medical products or for plant protection products;
- plant variety rights;

- topography of a semiconductor.

Applicant

To apply for border seizure under the EU Regulation, an EU Application for Action (AFA) must be completed and submitted. The AFA can be submitted by:

- the right holder;
- IP collective rights management bodies;
- professional defence bodies;
- groups of producers or similar groups, inspection bodies or similar competent authorities if relying on infringement of geographical indication of origin;
- those authorised by the right holder to initiate proceedings in order to determine whether an IP right has been infringed; and
- exclusive licensees.

The applicant must prove its authorization concerning the IPR (e.g. by a registry excerpt).

Application Procedure

The AFA must be submitted to the relevant national authority – see national summaries for details. Wherever the AFA should be sent 30 working days before the infringing goods are expected to be imported or exported, or the applicant wants the monitoring period to commence. The AFA must set out in detail the suspicion of infringement. It is very important to explain the possible infringement in as much detail as possible since this is the only information which the customs authority uses to assess the infringement. Article 6 of the Regulation sets out the content which must be provided in the AFA:

- name, address and contact details along with the applicant's status ie. an IP rights holder;
- IPRs to be protected;
- documentary evidence that the holder has the relevant rights or is authorised to act on behalf of the owner;

- the relevant Member States must be listed, as well as the contact details of the IP rights holder for each Member State concerned;
- a sufficiently detailed description of the goods to enable Customs to recognise them;
- specific technical data on the authentic goods, for example markings, bar codes, and images as appropriate;
- the name and contact details of appointed legal and technical experts;
- agreement that data provided may be processed by the Commission and other Member States;
- whether there is a request to use the “small consignment” procedure (see below) and agree to cover the costs of goods destroyed under that procedure.

It is important to explain in detail the features and the scope of protection for the specific IPR in the request as well as the precise embodiment of the infringing products. The more detailed the IPR owner describes the circumstances, the better are the chances of success of the border seizure. Details to include are:

- any specific information concerning the type or pattern of fraud;
- the port or country from which the goods are consigned and their intended port of arrival in the EU;
- details identifying the consignment or packages; for example descriptions, marks and numbers, the container number, waybill or manifest details;
- the expected date of arrival or departure of the goods;
- the means of transport and the identity of the carrier, logistics operator and/or customs broker/agent involved;
- the identity (including address and postcode) of the importer or exporter and if known, their Economic Operator Registration and Identification number;
- the country or countries of production and the routes used by traffickers;
- the technical differences, if known, between the authentic and suspected infringing goods;

- the pre-tax value of the original goods on the legitimate market in the country in which the application for action is lodged;
- any other intelligence about the trade in infringing goods in order to assist in the interception of such goods.

The applicant will also be required to provide the following undertakings:

- to notify the IP Authorisation Unit (IPAU) where an IP right ceases to have effect;
- forward and update information that will enable Customs authorities to analyse and assess the risk of an IP infringement;
- to assume liability towards the holder of the goods where, following detention:
 - (a) action is discontinued due to an act or omission on the part of the applicant;
 - (b) samples are either not returned or are damaged and beyond use due to an act or omission on the part of the applicant;
 - (c) the goods in question are found not to infringe an IP right;
- to reimburse, where requested, the costs incurred by Customs authorities or other persons acting on their behalf, from the moment of detention. This includes costs associated with the storage and handling of the goods and, if appropriate, their destruction.

The request is valid for one year but could be extended. It can also be amended, for example, by adding new intellectual property rights.

Customs may choose to detain infringing goods but this is discretionary and will most likely occur if the infringement is blatant and the IP rights holder is easily identifiable. Customs has 1 working day to find and notify the presumed IP rights holder. The IP rights holder must then file a national AFA by the end of the fourth working day after detention. There is no option to extend this holding period. If an AFA is filed, the IP rights holder is provided with full information and the Standard Procedure is followed.

Procedure following detention

Customs assess infringement according to the national rules of the particular member state. The Regulation provides for a Standard Procedure and a Small Consignment Procedure.

For a seizure to qualify as a small consignment the goods must be:

1. suspected to be counterfeit (trade mark) or pirated (copyright and design);

2. perishable (i.e. deteriorate within 20 days);
3. covered by a current AFA in which the rights holder has requested use of the Small Consignment Procedure;
4. transported as a postal or express courier consignment;
5. containing 3 units or less or have a gross weight of less than 2kg.

The Standard Procedure

Customs notifies the IP rights holder within one working day of the goods being detained. The IP rights holder then has ten working days to either confirm that the goods infringe or that the goods should be released. If the IP rights holder does not respond within ten working days, the goods will be released. If the IP rights holder confirms infringement within the time period, the owner of the goods must then either oppose the detention or consent to destruction within ten working days. If the goods owner opposes destruction, Customs will notify the IP rights holder and the IP rights holder will then have ten working days, to issue court proceedings. The period for issuing proceedings can be extended on request for a further ten days. If court proceedings are not issued, the goods will be released. If court proceedings are issued, the outcome of the trial will determine whether the goods are released or destroyed by Customs.

The Small Consignment Procedure

Where a customs authority seizes goods suspected of being counterfeit or pirated in a small consignment the customs authority must notify the owner of the goods within one working day of their seizure and inform the owner that they intend to destroy the goods. The owner of the goods then has 10 working days of notification to lodge a 'Notice of Claim' opposing their destruction. The goods will be destroyed after 10 working days if the owner has agreed to their destruction or has failed to oppose destruction. Rights holders are not automatically notified of small consignment seizure and destruction. However, the right holder can request that customs provide information about the actual or estimated quantity of destroyed goods and their nature. It is advisable that right holders that have opted in to the small consignment procedure make such a request on at least an annual basis to ensure that evidence is retained to support any future civil claim. The IP rights holder may attend Customs premises to inspect goods, but a sample will only be provided for 'counterfeit' and 'pirated' goods (ie. those goods that infringe a trade mark, copyright or design). Samples of goods suspected to infringe patent rights will not normally be provided.

Costs

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 rights holder's IP, it is liable for any damages of the alleged infringer.

Germany

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. a national request according to German national law (i.e. § 142a PatG, § 25a GebrMG, § 146 MarkenG); or
- b. a European request according to an EU-directive (VO (EU) Nr. 608/2013).

The European request is applied for the import (or export, transit) of products on first entry into 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.

German request

The requirements for border seizure made under a German request are basically the same as under the EU system.

There are three requirements for the seizure of goods according to the European request. The owner of the IPR must have filed a 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 extended.

- 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.

United Kingdom

The UK national law only applies to border detention in relation to goods imported into a Member State from another Member State. The principle of free movement of goods within the European Union means that the cross-border trade between member states cannot be restricted. Therefore, national requests are only applicable to parallel imports which are not covered by the EU Regulation. UK law also allows UK customs to detain infringing grey market goods arriving into the UK from outside the European Economic Area (EEA) (or from within the EEA but which did not enter into free circulation) for trademarks and copyright if advance written notice of the consignment is given. Enforcement under UK national law does not allow border detention in respect of utility models and trade names as such rights are not recognised under UK law.

The procedure under the UK national law is the same as under the EU Regulation. The applicant must submit an Application for Action (AFA) to HM Revenue and Customs (HMRC) which should include the details required under Article 6 of the Regulation. The AFA should be sent 30 working days before the infringing goods are expected to be imported or exported, or the applicant wants the monitoring period to commence. Border Force (BF) is a law enforcement command within the Home Office responsible for carrying out the frontier interventions by Border Force officers.

Ireland

Council Regulation (EU) No. 608/2013 (the “**Regulation**”) and Commission Implementation Regulation (EU) No. 1352/2013 provide measures for Customs action against suspect counterfeit and pirated goods at points of importation into and exportation from the European Union (“**EU**”). Ireland is bound by these Regulations (as they are directly applicable under EU law) which enable Irish custom authorities to detain goods that are suspected of infringing intellectual property rights. The European Union (Customs Enforcement of Intellectual Property Rights) Regulations 2013 (S.I. No. 562 of 2013) gives the Regulation full effect in Irish law and nominates the Revenue Commissioners as the competent customs department to receive and process applications for the purposes of the Council Regulation.

The Regulation permits Customs authorities to take certain actions where goods entering the EU from non-member states are suspected of infringing intellectual property rights recognised in the EU. The following infringements are excluded from the scope of the Regulation:

- goods in free circulation in the European Community moving between Member States;
- goods of a non-commercial nature contained in travellers’ personal luggage within the limits laid down in respect of relief from Customs duty;
- goods manufactured with the consent of the holder of a right but entered for free circulation, export, re-export or for another Customs procedure without his/her consent;
- goods manufactured with the consent of the holder of a right which have been manufactured or bear a trade mark under conditions other than those agreed with the holder.

Jurisdiction

The Revenue Commissioners has jurisdiction over goods suspected of infringing an intellectual property right which 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.

Domestic Industry Requirement: The Regulation does not have an equivalent to the domestic industry requirement.

Parties: The right holder is referred to as the applicant.

Jury: There are no juries in the customs procedure.

Procedure:

On foot of an application:

The applicant requests the customs authorities to take action with respect to goods suspected of infringing an intellectual property right. The request is called an “application”.

There are two types of applications:

- National application: an application submitted in a Member State requesting its customs authorities to take action in that Member State.
- Union application: an application submitted in a Member State requesting the customs authorities of that Member State and the customs authorities of one or more other Member States to take action in their respective territories.

When granting the application the customs authorities specify the period during which they are going to take action, which shall be no more than one year. The applicant will be called the holder of the decision once customs have granted the application. The request to extend the period of validity of an application on its expiry is called “extension request”.

Both the application and the extension request must be completed using official forms and must be submitted to the competent customs authorities in accordance with the Regulation.

A small consignment procedure is also available and allows for goods in small consignments to be destroyed without the explicit agreement of the applicant in each case.

The application, when granted, is valid for a maximum period of 12 months and may be renewed annually. Applications may not extend beyond the end of the period for which the right is validly registered.

Ex officio customs action:

The intervention of the customs authorities usually takes place at the request of the right holders, though customs also may detain those goods if no request has been made beforehand, in order to give right holders the opportunity to make such a request.

When customs detain goods suspected of infringing an IPR that are not covered by a valid application, they will try to locate the person or entity entitled to submit an application. This is referred to as an *ex officio* action. Once the person or entity is notified, an application must be submitted to the competent customs department within four working days of the notification.

Burden of Proof:

Applicants are required to provide evidence of their entitlement, for example by providing certified roll extracts, register extracts or copies of the rights in question. In the case of copyrights, related rights or design rights which are not registered the right-holders have to demonstrate credibly that a claim to a right may be made (e.g. affidavit, declarations concerning the authorship, where available certificates of registration of copyrights).

If the applicant is not the owner of the rights, but a person authorised to use the rights, then the applicant must prove his or her authorisation to use the rights. This can generally be done by submitting the appropriate contracts. It is also possible to submit a separate proxy from the right-holder without the use of any special form.

Review:

A written decision by the Revenue Commissioners in relation to a customs matter covered by EU customs legislation may be appealed pursuant to Articles 44 and 45 of the Union Customs Code ([EU Regulation No. 952/2013](#)).

The basis of the appeal should be set out in writing and forwarded, together with any relevant documentation to the officer who made the decision which is the subject of the appeal. An appeal must be made within 30 days of the event giving rise to the appeal, except in exceptional circumstances.

The appeal will be processed by an officer nominated by the Revenue Commissioners of senior rank and without previous involvement in the matter under appeal. The outcome of the appeal will be furnished within 30 days from the date of lodgment, with reasons for the Revenue Commissioners' determination.

There is also provision for appealing the Revenue Commissioners' determination to the Appeal Commissioners appointed by the Minister for Finance under the Income Tax Act, 1967.

Written notice of intention to appeal must be given within 30 days of the date of notification of the determination of the initial appeal by the Revenue Commissioners. Before the hearing takes place, written submission may be made direct to the Appeal Commissioners. Equally, the Appeal Commissioners

may request further information. The Appeal Commissioners' formal determination is final unless a case is required to be stated for the opinion of the High Court

Remedies:

Right-holders or their representatives can make an application for Customs action to prevent the import or export of suspect IPR infringing goods. Once an application is granted, customs staff may:

- detain suspect infringing goods;
- contact the right holder who will confirm if the goods infringe an IPR;
- arrange for the destruction of any infringing goods (the right holder may be asked to pay destruction costs).

France

In France the Custom's enforcement regime results from two legislative sources that accumulate:

- (i) Domestic law
- (ii) European law

(i) Domestic law

The French Intellectual Property Code and the French Customs Code (*Code des Douanes*) organize two different kind of measures:

- the provisional detention of goods suspected of infringing IP rights;
- and an autonomous repression of IP infringements at the customs level.

In the French Intellectual Property Code, articles L.335-10 for author rights, L.521-14 to L.521-19 for national designs, L.716-8 to L.716-8-6 for national registered Trademarks, L.615-5-2 for patents, L.623-27-2 for Plant Varieties and L.722-5 for Geographical Indications determine the general legal regime of the provisional detention of goods suspected of infringing the above IP rights. Each time, the general framework is the following:

- the right-holder file an application to request a surveillance by the Customs of possible further infringements of one of its IP right ;
- after granting the surveillance, the Customs may report, on a case by case basis, possible and suspected infringement acts;
- if the right-holder confirms the infringement, the suspected goods are detained by the Customs during ten days;
- the right-holder must then commence Court action to keep the detention until judgement be rendered on the merit.

In addition, the French Customs Code provides an autonomous repression of certain IP infringements pursuant, in particular, to articles 38, 39, 40, 215 and 215 ter, 323, 414, 426, 428 and 437. These IP infringements are likened to the Custom offense of smuggling, enabling the Customs to seize the suspected goods and sue the alleged infringers notwithstanding the lack of any action from the right-holder.

(ii) European law

In addition to the domestic law, the European regulation n°608/2013/EC of June, 12, 2013 provides with an accumulative system of detention of goods suspected of infringing most of IP rights. The European regime is close to the domestic one, a part from a certain number of nuances, in particular with regard to the possible settlements, the destructions of the suspected goods, the goods carried by passengers in their personal luggage and the small quantities.

The European regime is exclusively applicable to goods entering or leaving the territory of the European Union (article 1.1.b of the Regulation) and, consequently, only the domestic regime can be applied to goods imported from the EU or exported within the EU. Infringement resulting from illegal parallel trade and overruns are also excluded from the protection provided by the Regulation (point 6 of the preamble) and theoretically this exclusion does not exist in French law although the French Customs appears to be extremely reluctant in this regard.

Jurisdiction

Different types of Courts may have jurisdiction depending on the subject matter of the dispute, in particular:

- I. *Tribunal d'Instance;*
- II. *Chambre civile du Tribunal de Grande Instance;*
- III. *Chambre correctionnelle du Tribunal de Grande Instance.*

Domestic industry Requirement

There is no domestic industry requirement in French law, nor in European law.

Parties

Different parties are involved, i.e.:

- The right-holder;
- The Customs;
- The owner or of the suspected goods or their Destinee and representatives, such as the declarant;
- The Attorney General.

Jury

There are no juries for these types of proceedings.

Procedure

With regard to the detention of goods, the following general framework is reminded:

- the right-holder file an application to request a surveillance by the Customs of possible further infringements of one of its IP right ;
- after granting the surveillance, the Customs may report, on a case by case basis, possible and suspected infringement acts;
- if the right-holder confirms the infringement, the suspected goods are detained by the Customs during ten days;
- the right-holder must then commence Court action to keep the detention until judgement be rendered on the merit.

In addition, notwithstanding any possible detention, the Customs may seize the suspected goods and sue the alleged infringers for smuggling, even without the right-holder and the Attorney General.

Remedies

In France the damages suffered by the civil party (the right-holder) because of infringing acts are henceforth more substantial by virtue of more favorable rules (with a possible cumulative compensation for moral damages, the restitutions of the profits of the infringer in addition to the losses suffered or, alternately, compensatory royalties fees exceeding contractual royalties).

Statutory Deposit of right holder

This option is theoretically available in both French and European laws and this, upon request of the owner of the suspected goods or their Destinee before the Court but, on a practical point of view, security deposits are rarely ordered.

Review

Different recourses are available depending again on the subject matter of the dispute and judgements rendered at the first instance stage are subject to appeal and, thereafter, only for noncompliance with the rules of law, before the *Cour de cassation* (the French Supreme Court).

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”.