

ExCo Buenos Aires 2009
ADOPTED Resolution
October 14, 2009

Resolution

Question Q208

Border measures and other means of customs intervention against infringers

AIPPI

Noting that:

- 1) AIPPI has studied aspects of measures of customs intervention against infringers in previous questions, leading in particular to:
 - a) The resolution of the Congress of London in 1986 – Question Q86, Yearbook 1986/VIII, pages 204 - 206, entitled 'Measures against Counterfeiting of Branded Goods' (***London Anti-Counterfeiting Resolution***); and
 - b) The resolution of the Council of Presidents of Lisbon in 1993 – Question Q122, Yearbook 1993/II, page 248 entitled 'Customs Seizure' (***Lisbon Customs Seizure Resolution***).
- 2) The London Anti-Counterfeiting Resolution recognized the losses sustained by those businesses whose products are subject to counterfeiting and adopted the recommendation that international cooperation in the field of police action and customs action should be strengthened with a view to eliminating international trade in counterfeit goods (N°4b).
- 3) The Lisbon Customs Seizure Resolution supported the establishment of a system for the seizure by customs authorities of counterfeit and pirated goods which infringe trademarks, copyrights and related rights (N°1). AIPPI further expressed the opinion that in any such system the rights of any person whose goods have been wrongly seized should be adequately protected by requiring the owner of the relevant IP right to indemnify that person (N°2). Finally, AIPPI considered that such a system should be extended to other IP rights (including industrial designs) if it is clear that there is infringement of such rights (N°3).

Observing and considering that:

- 1) Border measures are now generally available for pirated copyright goods and counterfeit trademark goods. In many countries, such measures are also available in cases of infringement of design rights, patents and other IP rights.
- 2) The level of evidence for alleged infringement that is required by customs authorities in order to invoke border measures varies widely among countries.

- 3) Particularly in the case of patent infringement, customs authorities may lack necessary technical expertise and they may not properly be equipped to carry out an initial assessment of IP infringement.
- 4) For most countries, in the context of border measures, specialized courts or administrative bodies are only involved in determining infringement following a detention of suspected infringing goods, if at all.
- 5) In a number of countries, customs authorities may release goods suspected of infringing IP rights, particularly in cases involving patents, on the provision of security by the owner, consignee or importer of such goods.
- 6) Generally across national jurisdictions, the owner, consignee or importer of the allegedly infringing goods is at least to some extent protected by a requirement for the provision of security or an undertaking as to indemnification by the IP rights owner.
- 7) There are currently no uniform rules or shared best practices for customs authorities, and there remains an insufficient level of coordination between or among countries at an international level, in the area of border measures.

Resolves that:

- 1) The London Anti-Counterfeiting Resolution is hereby reaffirmed.
- 2) The Lisbon Customs Seizure Resolution is hereby reaffirmed.
- 3) Border measures should be available in respect of all IP rights as recognized under the laws of the relevant national or regional jurisdictions.
- 4) Border measures should be available for all forms of IP right infringements as recognized under the laws of the relevant national or regional jurisdictions.
- 5) Any interested party deriving exploitation rights from the IP owner under the applicable national or regional law (such as a licensee, distributor or commercial agent) should be entitled to seek relief by way of border measures to the extent that such party has standing to enforce the relevant IP right under the national or regional law or upon authorization of the IP owner.
- 6) Upon identification of goods suspected of infringing IP rights, the customs authorities shall be entitled to temporarily hold the goods to allow for a preliminary assessment of infringement by competent courts or competent administrative bodies to be obtained prior to the final detention of the goods by such authorities.
- 7) Customs authorities should require the provision of a security or an undertaking of indemnification by the IP owner or other interested party prior to invoking border measures, unless those measures are initiated ex officio.
- 8) Absent a preliminary assessment or other court decision finding for infringement, customs authorities should release goods suspected of infringing IP rights, particularly those suspected of infringing patent rights, on the provision of security or an undertaking of indemnification by the owner, consignee or importer of such goods.
 - a) In cases of urgency, an immediate release of such goods should be obtainable provided that security is provided which corresponds to the actual value of the genuine goods; and

- b) In addition, the release of such goods should be obtainable in all other cases where security is provided in an amount sufficient to protect the interests of the IP owner or other interested party. A security deposited in accordance with 8a) should be adjusted to the amount computed in accordance with 8b), once so determined.
- 9) Detained goods should be released by customs authorities upon request of the owner, consignee or importer of the goods, and any posted security returned to the owner, consignee or importer of the goods, if legal proceedings regarding infringement are not commenced by the IP owner or other interested party within a reasonable period of time.
- 10) In the event legal proceedings are commenced, but there is a final decision by a court that there is no infringement of an IP right, the owner, consignee or importer of the detained goods shall be entitled to appropriate compensation for the wrongful detention.
- 11) To allow for the development of uniform rules and shared best practices for customs authorities, and to facilitate the efficient enforcement of IP rights, a centralized system for managing multiple applications for customs measures through a single contact point should be encouraged on an international basis.