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New Regulation on Customs Enforcement May Come into Force Soon – Patent Rights Will be Strengthened

Thorsten Bausch (Hoffmann Eitle) · Monday, February 18th, 2013

For some years the European Commission has been drafting a new “Regulation Concerning Customs Enforcement of Intellectual Property Rights” replacing present Regulation EC/1383/2003. It now appears that legislative procedure is almost complete. The Internal Market Committee of the European Parliament and the Permanent Representatives Committee of the Council have recently adopted a compromise text. After the Council of Ministers adopts the text, the European Parliament will most likely also adopt it in March without amendments and the new Regulation can then come into force. This should be in April or May of this year.

The proposed amendment with regard to a right to be heard in patent, supplementary protection certificate or plant variety right matters (we reported about this in a [previous contribution](#)) has been dropped. The lawmakers seem to have recognized that such a provision would not have been practical.

Rather than limiting the rights of patent proprietor as originally planned, the compromise text provides that “simplified proceedings” for the destruction of goods without prior court proceedings are now being stipulated as an imperative measure for all Member States with regard to all IP rights covered by the Regulation, including patents, SPCs and plant variety rights.

Simplified proceedings to be applied upon request of the right-holder are such in which the customs authorities may assume the declarant/proprietor of the goods has agreed to destruction if said party does not object within a fixed time limit to destruction. Under the present Regulation, the provision of simplified proceedings will only then be applicable in a Member State if said measure has been implemented into the national laws. Up until now, the Member States have not consistently implemented simplified proceedings, in particular quite often it was implemented only for breaches of trademark law and copyrights.

The compromise text further sets out procedures with regard to goods in transit and allows customs authorities to take action on small consignments without contacting the right-holder. The following is an overview of the relatively minor amendments of the compromise reached:

1. Goods in Transit

- Customs must carry out “applicable controls” and “reasonable identification measures” on goods in transit in the customs territory of the European Union on the basis of a risk analysis in order to

prevent infringement of IP rights protected in the EU. The customs authorities must also cooperate with third countries when enforcing such IP rights.

- When pharmaceuticals are in transit, customs authorities will only then be able to intervene if the customs authorities believe there is the risk that these will be redirected to the internal market. (This is one of the measures instituted so as to promote access to pharmaceuticals in developing countries. In the past when there had been suspicion of patent infringement by pharmaceuticals being shipped, for instance, from India via the EU to Brazil the pharmaceuticals were then seized by the EU customs authorities).
- The Commission and the Member States can transfer information as to possible infringements of rights to the customs authorities in third countries, particularly when suspected goods in transit have their origin or their destination in the respective third country.

2. Simplified Proceedings

Simplified proceedings regarding destruction of certain goods (without court proceedings) will be introduced as an obligatory measure in all Member States and its scope of application will be extended to all intellectual property rights.

3. Small Consignments

Special proceedings are being introduced for small commercial consignments that contain counterfeit goods or goods that have been illegally produced in order to counteract the rapid increase of sales over the Internet. These special proceedings for small consignments will allow the destruction of said illegal goods without the explicit renewed consent of the right-holder if said right-holder has already provided customs with general permission in its application. The customs authorities will be able to demand reimbursement of the costs for the proceedings from the applicant/right-holder should this become necessary. A postal item or an item sent by express mail that contains a maximum of three separate units and a maximum of three kilos shall be considered to be a small consignment. The Commission will be able to change this definition at a later date should it prove not to be practical in practice.

4. Reimbursement of Costs

Customs may demand reimbursement of the costs from the applicant. However, the applicant can also sue in a court of law for damages from the infringer or other persons that may be held liable under the national laws. Irrespective of the individual national laws, this could also be the mediator, such as the carrier company.

5. Disposal within the Customs Territory

Customs authorities may now authorize that such goods that have been released for destruction may be moved under the supervision of the customs authorities between various locations within the customs territory of the European Union. Customs may also allow that such goods may be put into “free circulation” for disposal or for purposes of education.

6. COPIS Databank

The COPIS databank is being planned for the central storage of applications. Responsibility for

control, administration and data security shall be established. The principle of “specific purpose” shall apply to the exchange of information, i.e. data may only be used for the purpose for which the databank was established.

Anja Petersen-Padberg

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