

# Kluwer Patent Blog

## Is "transit" an act of patent infringement?

Miquel Montaña (Clifford Chance) · Thursday, April 4th, 2013

One of the topics hotly discussed within the intellectual property family over the last few years is whether or not “transit” is an act of infringement. Since, unlike patent law, trademark law is already harmonised at the EU level, many cases have reached the ECJ, which has generated a saga of judgments that does not appear to have satisfied anybody. In response to the criticism attracted by the last judgment of this saga (judgment dated 1 December 2011 in joined cases C-446/09 (Philips) and C-495/09 (Nokia), the European Commission has decided to include “transit” among the acts that the trademark owner is entitled to prohibit.

In particular, in its “Proposal for a Regulation of the European Parliament and of the Council amending Council Regulation (EC) No 207/2009 on the Community Trademark”, published on 27 March 2013, the Commission has highlighted that:

*“According to the court of Justice in the Philips/Nokia judgment, the entry, presence and movement of non-EU goods in the customs territory of the EU under a suspensive procedure does, under the existing ecquis, not infringe intellectual property rights as conferred by substantive law of the union and its Member States. Such goods can only be classified as counterfeit once there is proof that they are subject of a commercial act directed at EU consumers, such as sale, offer for sale or advertising. The implications of the Philips/Nokia judgment have met with strong criticism from stakeholders as placing an inappropriately high burden of proofs on rights holders, and hindering the fight against counterfeiting. It is evident that there is an urgent need to have in place a European legal framework enabling a more effective fight against the counterfeiting of goods as a fast-growing activity. It is therefore proposed to fill the existing gap by entitling right holders to prevent third parties from bringing goods, from third countries, bearing without authorization a trade mark which is essentially identical to the trade mark registered in respect of those goods, into customs territory of the Union, regardless of whether they are released for free circulation.”*

Therefore, the Commission has inserted paragraph 5 in Article 9 of the proposal, with the following language:

*“The proprietor of a European trade mark shall also be entitled to prevent all third parties from bringing goods, in the context of commercial activity, into the customs territory of the Union without being released for free circulation there, where such goods, including packaging, come from third countries and bear without authorization a trade mark which is identical to the European trade mark registered in respect of such goods, or which cannot be distinguished in its essential aspects from that trade mark.”*

If the proposal goes through, at the end it will become clear that “transit” is an act of trademark infringement, which will bring legal certainty and will make the life of customs officers much easier.

But the question will still remain: is “transit” an act of patent infringement? In its judgment of 12 June 2001, the Court of Appeal of Barcelona (Section 15) gave a positive answer to this question interpreting the Patent Act of 1986 in the broader context of the 1988 Trademark Act, which specifically contemplated “transit” as an act of trademark infringement. If the aforementioned proposal is finally approved, it will be interesting to see if in future cases Courts transit through the same path.

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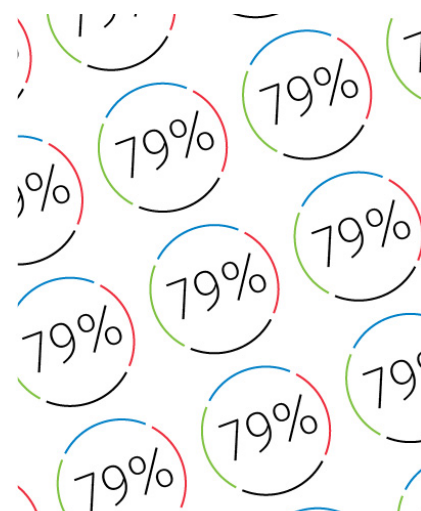
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