

Follow us



Anti-counterfeiting measures at the EU border – Applications for action by EU Customs

New EU legislation entered into force in January 2014 that outlines procedures Customs in the EU are expected to take in relation to suspected and confirmed infringing goods.

New EU legislation entered into force in January 2014 that outlines procedures Customs in the EU are expected to take in relation to suspected and confirmed infringing goods. It also details the requirements for IP rights holders when filing an Application for Action (AFA) (discussed below).

The new legislation improves the position of IP rights holders when tackling infringing goods and addresses the increase of very small shipments of goods being bought online.

Application for Action

An Application for Action (AFA) puts your IP rights on record directly with Customs offices in the EU Member States. It acts as an instruction that Customs detain shipments of goods entering or leaving the European Union where there is a reasonable suspicion on the part of Customs that the goods infringe your Intellectual Property (IP) rights.

It is possible to cover a wide variety of IP rights in an AFA, including but not limited to patents, trade mark registrations and design registrations.

When goods are detained, IP rights holders have 10 working days (extendible by another 10 working days in certain circumstances) to assess whether the goods do infringe an IP right and if so give consent for destruction, or other type of abandonment, of the goods. In the case of

perishable goods, the period of detention is restricted to 3 working days.

Customs will also notify the Declarant or Holder of the goods, being the party declaring the goods for import or export or the party the goods are being sent to. The Declarant or Holder has 10 working days in which to consent or object to the destruction of the goods. Unless the Declarant or Holder explicitly objects to destruction of the goods, the goods will be destroyed provided the IP rights holder has consented to destruction. Customs do not require explicit agreement of the Declarant or Holder to destroy the goods; absence of a response from the Declarant or Holder within the required time is deemed implied consent.

If the Declarant or Holder explicitly objects to destruction of the goods, the IP rights holder will need to bring court proceedings to determine that there has been an infringement and obtain destruction of the goods.

What happens without an AFA?

Where Customs seize goods for which there is no AFA covering the respective IP right, Customs has just one working day to identify a likely IP rights holder otherwise the goods are released to the Declarant or Holder. If an IP rights holder is identified and wants to try to have those goods destroyed, it has four working days to submit an 'ex officio' AFA, before Customs have to release the goods. An ex officio AFA only covers that one particular seizure.

Not only are the deadlines therefore tighter for both the IP rights holder and Customs offices where there is no AFA in place, it is time consuming and incurs unnecessary cost to put together and file individual ex officio applications each time you want to prevent infringing goods being released.

A granted AFA also provides a higher level of certainty that infringing goods will actually be detected by Customs. In our experience it is better to be actively aware of the extent and type of infringing products coming into and exiting the EU.

Other benefits of an AFA

■ AN AFA will not only contain details of your IP rights, but also information to allow Customs to identify infringing goods. This information is made available to all involved Member States via a newly launched database, and helps not only to stop circulation of infringing goods but also to avoid Customs inadvertently seizing shipments of your genuine goods, which could in some instances have serious commercial implications for your business.

■ Upon detection of suspected infringing goods, Customs provide the IP rights holder with contact and address details of the parties involved in the shipment, which is useful intelligence for identifying trends in trade routes of infringing and parallel import goods. This has helped our clients' form their internal policies on anti-counterfeiting.

■ IP rights holders' powers for use of this information have been extended under the new legislation and it can now be used to, amongst other things, bring various types of proceedings, conduct investigations into and obtain undertakings from the Declarant or Holder.

■ Customs will usually provide a sample of the suspected infringing goods to the rights owner. Our clients always find it valuable to have the opportunity to examine the relative quality and features of infringing goods coming into or exiting the EU, which assists them in improving awareness provided to their customers and other Customs offices as to how to spot when a seemingly genuine product is actually an infringing one.

■ Upon request by an IP rights holder in an AFA, Customs can automatically destroy small shipments (a postal shipment weighing less than 2kg or comprised of three units or fewer) without obtaining specific instructions from the IP rights holder. This can reduce time and money spent by you in assessing small seizures and responding to Customs.

■ An AFA can be submitted to Customs offices in the whole of the EU or just certain countries. Regardless of the number of countries where action is requested, only a single application is required.

■ There are no official fees for filing, or renewing, an AFA. Some costs will be incurred in putting together the AFA and in dealing with any seizures arising from the AFA.

■ A granted AFA lasts for a year and can be renewed by filing a simple request. An AFA can also be updated after it is granted to reflect any changes in how your IP is used in relation to your products.

What do we need to file an AFA?

As well as details of the IP rights to be covered by an AFA, we need as much of the following information as possible:

■ information on how to distinguish infringing and genuine goods,

■ details of places of manufacture and distribution and importation routes of genuine goods,

■ details of any entities that have been known to import infringing goods in the past,

■ details of entities authorised to import and distribute genuine goods.

How can A.A. Thornton & Co. help?

At A.A. Thornton & Co. our trade mark attorneys are qualified to advise on all aspects of trade mark law. The services of our trade mark attorneys include:

■ Advising on your choice of trade marks and their registrability

- Trade Mark Audits and IP portfolio management
- Due diligence of trade mark rights
- Searches, investigations and advice on filing strategies
- Preparing, filing and prosecuting national, EU or international trade mark applications
- Facilitating registration of trade marks overseas
- Managing renewals of trade marks
- Trade mark watches to identify competitors' applications and registrations
- Handling oppositions, cancellations and appeals
- Negotiating amicable settlements and co-existence agreements
- Negotiating and drafting licence agreements and assignments
- Advising on infringement of trade mark registrations and attacks on validity
- Liaising with solicitors and barristers in the enforcement or defence of registered and common law rights

Contact

For more information please contact **Louise Foster** via email at lf@aaThornton.com or your usual A.A Thornton & Co. advisor.

For general information please visit: www.aathornton.com

Partners

Vanessa Lawrence
vabl@aathornton.com

Ian Gill
isg@aathornton.com

Martin Hedges
mnh@aathornton.com

Craig Turner
crt@aathornton.com

Rachel Havard
rsh@aathornton.com

Adrian Bennett
arb@aathornton.com

Mike Jennings
mjj@aathornton.com

Emily Cottrill
eehc@aathornton.com

Lawrence King
llk@aathornton.com

Associates

Nick South
ngs@aathornton.com

Heather Donald
hrd@aathornton.com

Sarah Darby
smd@aathornton.com