

# The Patent Lawyer

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## Conflicting applications to claimed designs

John XIA, Partner and Patent Attorney at Corner Stone & Partners, questions whether an invention or utility model patent application can serve as a conflicting application to a claimed design.

### An interview with Deminor

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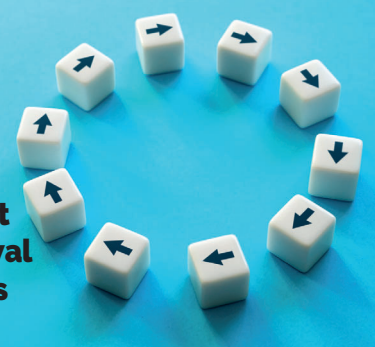
### Revolutionizing IP protection

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### Patent renewal trends

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# In focus: border seizure

**Dr. Christian Thomas, Attorney at Law and Partner at Kuhnen & Wacker, details how border seizures can be utilized as an effective instrument against imitators and counterfeiters.**

**B**order seizure is a legal instrument that many companies do not even have on their radar, or only to an insufficient extent. Yet border seizure is basically free of charge and can help to clear the European market of counterfeiters and pirated products in an effective and cost-saving way. This can be immensely important, as counterfeit products not only cause economic damage to original manufacturers, but can also sometimes be dangerous to consumers. There are many practical examples, although there is certainly a particular potential danger with regard to counterfeit baby

food, faulty components (such as brakes), or even medicines. The legislator has recognized that it is often very difficult for the original manufacturers to identify the producers of such counterfeits and thus provides the possibility of border seizure by customs authorities as an additional tool.

Ultimately, therefore, with an effectively filed application, the state and European authorities can be "used" to protect one's own IP portfolio (for example, consisting of trademarks, designs and/or patents) and to prevent the import and export of IP infringing goods already at the external borders of the EU or Germany. German customs authorities in particular have proven effective in this regard in recent years. In 2021, nearly 25,000 cases of goods were seized by German customs, which had a total value of over EUR 310 million. In most cases, the seized goods come from the Far East, especially China, but also from African countries and Turkey (see [www.zoll.de](http://www.zoll.de)). With regard to the goods concerned, it is interesting to note that in addition to clothing, cigarettes, bags, and electronic components, more and more complex imitations from the mechanical engineering and pharmaceutical industries are also being intercepted by customs officials.

## The application for border seizure and its requirements

In most cases, the customs authorities only act upon application. In individual cases, however, they may also act *ex officio*. The normal case, however, is action upon



application. The application itself is free of charge and is made for one year at a time. It is therefore not necessary to file a separate application for each individual case. If the property rights continue to exist, this can also be extended as often as desired.

In the case of an application for border seizure, a distinction must be made between a national border seizure application and a Union application. The EU-wide border seizure is basically determined by Community law (Regulation (EC) No. 608/2013). This covers all imports and exports of goods from third-party countries into the EU. In addition, the national border seizure procedure is supplemented by national regulations for the intra-European movement of goods. Both approaches (national law and EU law) stand side by side and ultimately allow German customs to take action on imports into Germany, i.e., on intra-European imports, as well as on imports from third countries into the EU as a whole. In border seizure proceedings at EU level, goods suspected of infringing intellectual property rights that claim EU-wide effect can be seized. These include Community trademarks, Community designs, internationally registered trademarks and designs designating the EU, and geographical indications. The border seizure covers goods

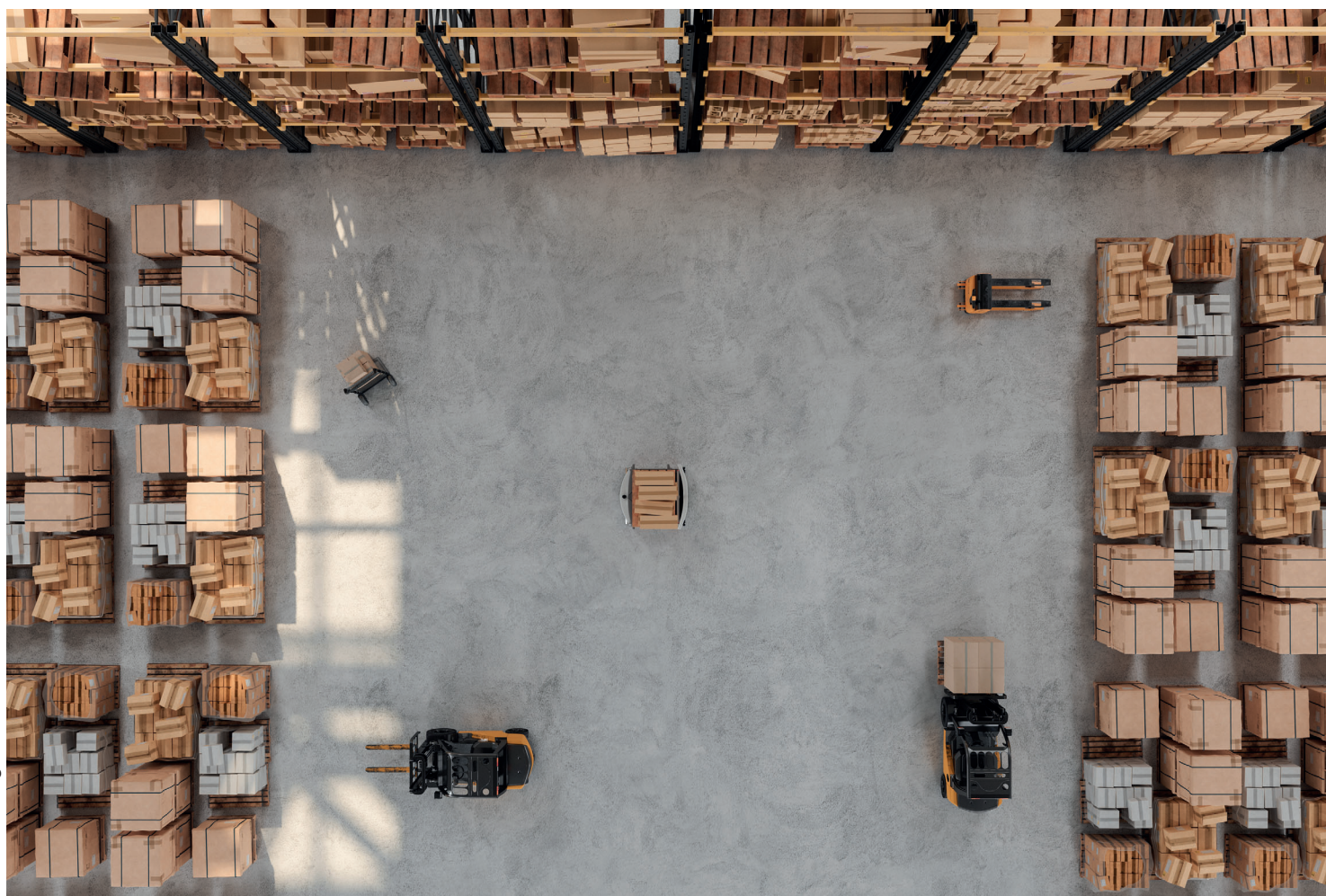
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imported into the EU, goods exported from the EU, or goods declared for re-export.

The application to be submitted electronically must contain, in addition to proof of the IP rights to be covered, proof of the applicant's authorization and information on the possible contact persons. In addition, supplementary information should be provided on the product group concerned and the original products. The customs authorities should also be provided with information on common supply routes and typical characteristics of counterfeits. Ideally, therefore, the customs authorities will be provided with a kind of “guide” that will enable the authorities to distinguish original goods from counterfeits as easily as possible and also to know in advance whether original products are being supplied to the EU at all from a certain region of the world. The prerequisite for border seizure by the customs authorities is the existence of a suspicion of an infringement of property rights. It is not necessary that an infringement of property rights actually exists.

### **Procedure in the event of action by the authorities**

If the customs authorities suspect an infringement of property rights during the inspection of cross-



border goods traffic, the respective goods are detained. At the same time, an information letter is sent to the applicant, informing them of the origin and nature of the goods as well as the parties involved (sender, recipient, forwarder, etc.).

The applicant then has the possibility, within the framework of a Union application, to notify the customs authorities of the infringement of the IP right within 10 days of receiving the notification of the border seizure and to initiate legal proceedings. The court proceedings may be either interim injunction proceedings or "normal" substantive proceedings. In the case of perishable goods, the applicant only has a period of three working days, which cannot be extended.

As an alternative to proof of an initiated procedure, the applicant may file an application for "simplified destruction" of the goods. In this case, the goods will be destroyed by the customs authorities if the declarant or owner of the goods has either positively agreed to the destruction or has not objected to the destruction within the above-mentioned period (10 days). The destruction shall be carried out at the expense and responsibility of the applicant.

If the declarant or owner of the goods objects to the seizure, the goods shall be destroyed only on the basis of a court decision.

### Other legal consequences and summary

In addition to the border seizure and destruction described above, the claimant may in principle also demand reimbursement of the costs incurred by them (for example, attorney's fees). In addition, they may be entitled to claims for damages, injunctive relief (e.g., preliminary injunction), and disclosure. In Germany in particular, the possibility of applying for an injunction is a fast and cost-intensive means. However, this can usually only be used to enforce a cease-and-desist order (and not information and/or damages). The German courts issue a temporary injunction within four weeks of becoming aware of the infringement. In most cases, such a preliminary injunction is issued or rejected within a few days of the application being filed, so that as a rights holder you very quickly gain certainty as to whether or not your claims will go through. Since this is a provisional decision, the infringer must then either recognize the preliminary injunction as final, or the rights holder must then file a "normal" lawsuit if necessary.

As far as the assertion of claims for information and damages is concerned, it is generally possible to file an action on the merits. In Germany, proceedings on the merits of a case take between six and 12 months in the first instance (as a general rule). In addition, the losing party generally has the option of filing an appeal. The filing of a main

## Résumé

**Christian Thomas** joined KUHNNEN & WACKER in 2005 and became a partner in 2011.

Having studied law at the Ludwig Maximilian University (LMU) in Munich, Dr Thomas joined the Munich Bar Association in 2005 and obtained a PhD from the University of Salzburg, Austria, in 2009.

As head of the legal department of KUHNNEN & WACKER, he has filed several thousand EU trademark and EU design applications and is deeply committed to obtaining and enforcing IP protection for his international clients.

Before joining KUHNNEN & WACKER in 2005, he worked for a law firm in Australia, which added to his multifaceted background. He is a regular speaker at seminars about trademark and design, frequently writes on IP-related matters, and is a lecturer for commercial law and IP rights at the University of Applied Sciences, Munich. He is proficient in German and English.



Dr. Christian Thomas

action is, of course, only necessary if the opposing party does not meet these claims on a voluntary basis. Practice and our experience have shown that, especially in proceedings in the area of border seizure, further judicial measures are often unnecessary, and the violators often submit without further resistance. This is probably also due to the fact that official authorities are involved and the violators fear having to bear further consequences and are grateful for a quick and uncomplicated settlement.

An increasing number of infringements of industrial property rights can also be expected in the future. The increase in seizure cases in recent years clearly shows the topicality of the problem, but also the increasing effectiveness of the German and European customs authorities. In order to further improve efficiency in this area, in addition to raising the awareness of customs officers, the expansion of cooperation between economic operators and customs authorities is of great importance and desirable. It is therefore to be hoped that in the course of the coming years the number of applications for border seizure will increase and more and more economic operators will make use of this possibility in order to protect their own economic goods. Ultimately, every successful case of seizure means that jobs are secured and the quality of branded goods is guaranteed.

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