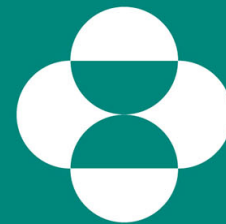


PARALLEL IMPORTS – THE BUSINESS PERSPECTIVE

ECTA Round Table

October 27, 2017

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MSD

INVENTING FOR LIFE

AGENDA

1. Background
2. Developments after Interpretive Decision No. 1 of April 26, 2012
3. Future

Background

- Case C-355/96 *Silhouette International Schmied* - 1998
- Cases C-414/99 to C-416/99 *Zino Davidoff and Levi Strauss* – 2001; Case C-244/00 *Van Doren + Q* – 2003; Case C-16/03 *Peak Holding* - 2004
- Case C-405/03 *Class International* – 2005
- Case C-449/09 *Canon* - 2010

Developments after Interpretive Decision No. 1 of April 26, 2012

- Cases C-446/09 and C-495/09 *Nokia/Philips* – Dec. 1, 2011



Developments after Interpretive Decision No. 1 of April 26, 2012

- Cases C-446/09 and C-495/09 *Nokia/Philips* – Dec. 1, 2011

“Goods coming from a non-Member State which are imitations of goods protected in the EU by a trade mark right or copies of goods protected in the EU by copyright, a related right or a design cannot be classified as ‘counterfeit goods’ or ‘pirated goods’ within the meaning of those regulations merely on the basis of the fact that they are brought into the customs territory of the EU under a suspensive procedure.”

Developments after Interpretive Decision No. 1 of April 26, 2012

- Regulation (EU) No. 608/2013 (replacing Regulation (EC) No. 1383/2003)
- Scope extended to cover more types of infringement, namely all possible trademark infringements and not only counterfeit goods as in previous Regulations; and
- Simplified procedure for destruction became the mandatory standard procedure.

Developments after Interpretive Decision No. 1 of April 26, 2012

- Case C-379/14 *Top Logistics* – July 16, 2015

Damages are possible if:

- released from duty suspension by payment of the duties; and
- are introduced into the customs territory without the consent of the trade mark rightsholder

Developments after Interpretive Decision No. 1 of April 26, 2012

- Regulation (EU) No. 2015/2424 & Directive 2015/2436/EC – Dec. 16, 2015



Developments after Interpretive Decision No. 1 of April 26, 2012

- Regulation (EU) No. 2015/2424 (Art. 9.4) & Directive 2015/2436/EC (Art. 10.4) – Dec. 16, 2015

“Without prejudice to the rights of proprietors acquired before the filing date or the priority date of the registered trade mark, the proprietor of that registered trade mark shall also be entitled to prevent all third parties from bringing goods, in the course of trade, into the member state where the trade mark is registered, without being released for free circulation there, where such goods, including the packaging thereof, come from third countries and bear without authorisation a trademark which is identical with the trade mark registered in respect of such goods, or which cannot be distinguished in its essential aspects from that trade mark.”

Developments after Interpretive Decision No. 1 of April 26, 2012

- Regulation (EU) No. 2015/2424 (Art. 9.4) & Directive 2015/2436/EC (Art. 10.4)– Dec. 16, 2015



Developments after Interpretive Decision No. 1 of April 26, 2012

- Regulation (EU) No. 2015/2424 (Art. 9.4) & Directive 2015/2436/EC (Art. 10.4) – Dec. 16, 2015

“The entitlement of the trade mark proprietor pursuant to the first paragraph shall lapse if, during the proceedings to determine whether the registered trademark has been infringed, initiated in accordance with Regulation (EU) No. 608/2013, evidence is provided by the declarant or the holder of the goods that the proprietor of the registered trade mark is not entitled to prohibit the placing of the goods on the market in the country of final destination.”

Future

