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OPERATION OF THE NEW PROVISIONS OF THE 'TRADE  
MARK PACKAGE' ON GOODS IN TRANSIT WITH  
REFERENCE TO THE EC NOTICE ON THE CUSTOMS  
ENFORCEMENT OF IPR CONCERNING GOODS IN TRANSIT

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## / 1. INTRODUCTION: THE COMMISSION NOTICE

- Commission notice on the customs enforcement of IPR concerning goods brought into the customs territory of the Union without being released for free circulation including goods in transit [2016] OJ C244/4
- Addressed to the MS's customs administrations
- Replaces the February 2012 Guidelines
- Not legally binding





## / 2. ENTRY INTO EFFECT OF THE NEW PROVISIONS

- Article 9(4) EUTMR: 23 March 2016
- Article 10(4) NTMD: to be implemented by 14 January 2019





### / 3. A TRADE MARK 'WHICH IS IDENTICAL OR CANNOT BE DISTINGUISHED IN ITS ESSENTIAL ASPECTS'

#### ➤ 'Identical'

- CJEU, Case C-291/00 *LTJ Diffusion*
  - *"a sign which either reproduces, without any modification or addition, all the elements constituting the protected trade mark or which, viewed as a whole, contains differences so insignificant that they may go unnoticed by an average consumer"*

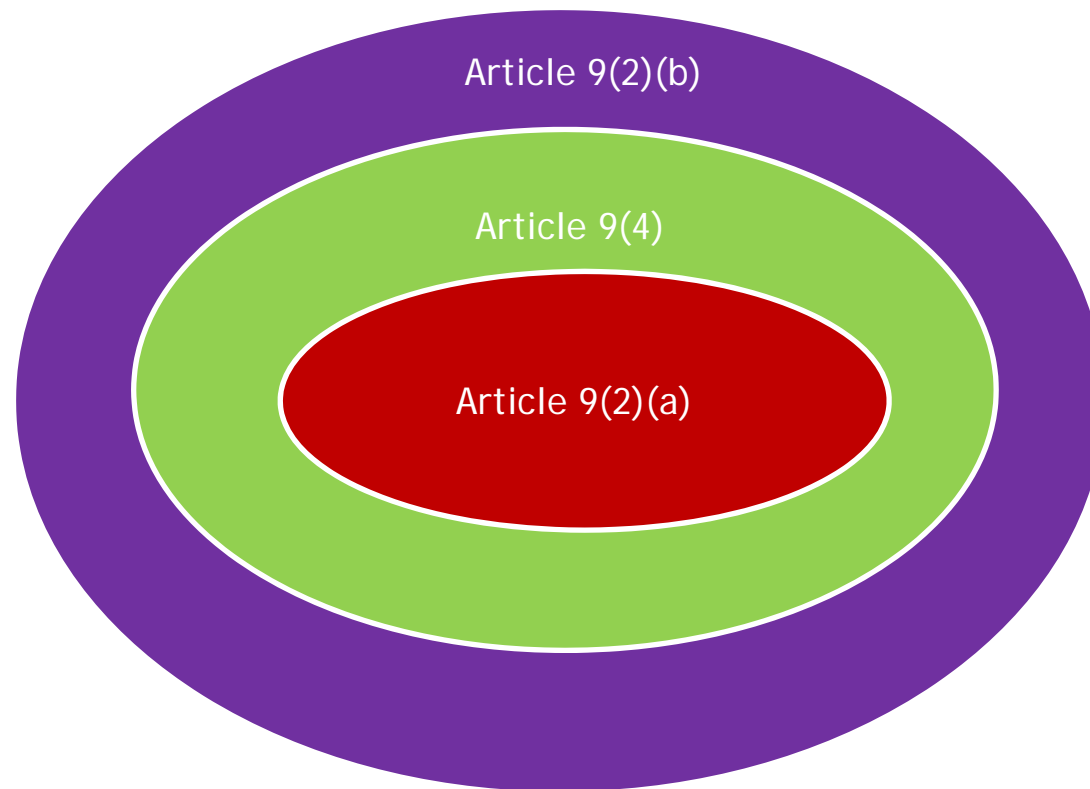
#### ➤ 'Which cannot be distinguished in its essential aspects'

- Even if the sign would contain differences which would *not* go unnoticed by an average consumer





Scope of trade mark protection as regards the degree of similarity between the signs at issue:





## / 4. 'ENTITLED TO PROHIBIT THE PLACING OF THE GOODS ON THE MARKET IN THE COUNTRY OF FINAL DESTINATION'

- Requires trade mark protection in the country of destination?
  - Article 9(4) EUTMR & Article 10(4) NTMD: unclear
  - EC Notice: yes
  - Legislator's intent:
    - *Ubi lex voluit, dixit; ubi noluit, tacuit?*
    - Recitals 17 EUTMR & 23 NTMD: strike a balance between 'the need to ensure the effective enforcement of trade mark rights' and 'the necessity to avoid hampering the free flow of trade in legitimate goods'





#### / 4. 'ENTITLED TO PROHIBIT THE PLACING OF THE GOODS ON THE MARKET IN THE COUNTRY OF FINAL DESTINATION' (CONT'D)

- Onus of proof >< Articles V and XX(d) of GATT ?
  - Positive fact: country of final destination
  - Negative fact: lack of protection there
  - ⇒ Disguised restriction on legitimate trade in the sense of Article XX?

#### ➤ *Registered and unregistered* trade marks?

- Cf. Art. 6bis Paris Convention, common law rights in a trade mark acquired through use, pending applications,...
- Expression 'validly registered' in draft compromise text tabled by the EP was eventually deleted





## / 5. ARTICLE 17(2) OF REGULATION 608/2013

- Possibility for Customs, before detaining the shipment, to request any information about the goods
  - Also lists of trade marks in non-EU countries?
    - Max Planck Institute 2010: RO should provide proof of IPR in AFAs 'for all pertinent jurisdictions'







## / 5. ARTICLE 17(2) OF REGULATION 608/2013 (CONT'D)

### PRO:

- Avoid impediments to legitimate trade
- Resources

### CONTRA:

- Impracticable
- 'about the goods'?
- How about *unregistered* trade marks?
- Inconsistent with Articles 9(4) EUTMR/10(4) NTMD
- Inconsistent with Article 6 of Regulation 608/2013





## / 6. MEDICINES

- customs should 'take all reasonable care to ensure that legitimate legally traded medicines, whether or not generic, can be routed through the customs territory of the Union'
- 'Legitimate legally traded medicines' includes, *inter alia*, 'medicines in mere transit through the EU territory, covered by a patent right applicable to such medicines in the EU territory, without adequate evidence of a substantial likelihood of diversion of such medicines onto the EU market'
  - Scope of recital 11 of Regulation 608/2013?





## / 6. MEDICINES (CONT'D)

- 'customs authorities should take full precautions to avoid any detention of medicines under Regulation (EU) No 608/2013, unless they are intended for the EU market or unless those goods bear a trade mark suspected of being identical or essentially identical to the protected trade mark'





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