Die Seite der AIPPI / La page de l'AIPPI

Border Measures and other Measures of Customs Intervention against Infringers (Q 208)

REPORT OF SWISS GROUP*

I. Analysis of current law and case law

1. Do the laws of your country provide for border measures? If so, what is the legal basis?

The following Swiss intellectual property statutes provide for border measures: Patent Act (Art. 86a to 86k), Design Act (Art. 46 to 49), Trademark Protection Act (Art. 70 to 72h), Copyright Act (Art. 75 to 77h), Semiconductors Act (Art. 12).

2. Do the laws of your country provide for other measures of customs intervention against infringers? If so, which ones and what is the legal basis?

Customs measures are not only provided for intellectual property statutes but also in certain related acts. For example, the Precious Metals Act empowers the customs authorities to seize goods that violate that act (Art. 22a), and the Act on Medicinal Products and Medical Devices holds that the customs authorities shall hold back goods that are in conflict with any of its provisions (Art. 66 § 4). These acts and provisions are part of the public law and the procedures that follow a customs seizure may differ from what is provided for in the intellectual property statutes mentioned above and discussed below.

3. Are border measures and other measures of customs intervention against infringers (collectively referred to as "border measures") only available for pirated copyright and counterfeit trademark goods or also for goods infringing other IP rights? If so, for which types of IP rights are border measures available?

Border measures are also available against: goods that violate the provisions on geographic indications, goods that infringe design rights, goods that infringe patent rights, and goods that infringe semiconductor rights.

a) Are border measures in particular available for goods infringing patents, plant variety rights, common law marks, unregistered design rights or geographic indications?

The Swiss Plant Variety Act does not provide for border measures. Common law marks and unregistered designs are not known in Swiss law and not protected as such. They may enjoy certain protection under the Unfair Competition Act, which act, however, does not provide for border measures.

b) Is actual registration required or is an application to register sufficient?

Border measures are only available where an intellectual property right is enforceable. Under Swiss law, intellectual property rights that require registration (trademarks, patents, designs and semiconductors) become enforceable only after registration. Therefore, actual registration is required for these rights.

c) Does unfair competition, passing off or the like give rise to border measures?

Unfair competition or passing off does not give rise to border measures.

4. Are border measures available for parallel imported goods?

According to case law of the Swiss Federal Supreme Court patent rights are subject to national exhaustion, whereas the principle of international exhaustion applies to trademarks and copyrights. Accordingly, border measures are available for parallel imports of patented goods but not for parallel imports of goods protected by trademarks or copyrights. Whether design rights are subject to national or international exhaustion has not been decided by the Swiss Federal Supreme Court and is discussed controversially in the literature. It is, therefore, questionable whether border measures are available in parallel import cases that involve goods protected by designs.

a) Are border measures available for goods contained in travelers' private luggage?

Border measures are available for goods contained in a traveler's private luggage.

b) Are there any other goods excluded by your border measure legislation?

The goods which are excluded by the Swiss border measure legislation are those for which the specific legislation does not provide any such possibility, e.g. plant varieties, unregistered trademarks, know-how, …

5. Who is entitled to file an application for customs action?

Typically, the owner of the IP right and the exclusive licensee of the IP right are entitled to file an application for customs action. In addition, the Trademark Protection Act entitles certain professional organizations and the Copyright Act the collecting societies to file requests for border measures.

a) Is there a centralized system for managing multiple applications for customs action through a single contact point?

Switzerland has a special unit known as "Section Procédure Douanière" (Border Measure Unit) where the applications for customs action are processed.

b) What are the conditions for border measures?

Conditions for border measures are that there are concrete indications that goods that make use of an IP right will be unlawfully imported into or exported out of Switzerland.

c) In particular, what level of evidence for alleged infringement and other information is required by customs authorities regarding the application for customs action?

The applicant has to make it plausible that these conditions are fulfilled. This "plausibility"-level of proof is lower than the level of proof required for preliminary injunctions (prima facie evidence). Within this framework the customs authorities tend to request more stringent evidence for the imminent importation or exportation and the unlawfulness of these actions but apply a rather low level of proof with regard to the question whether these goods actually make use of an IP right.

d) To which extent are customs authorities willing to receive training by the right-holder?

The Swiss customs office refuses special training by the IP right owner as they consider it unpractical. However, when an application is made, the customs will ask for as much information about the goods as possible, which they will list and for which access will be granted to all the employees through the customs authorities' intranet.

e) Do customs authorities generally require the provision of a security to protect the owner, holder or importer of the allegedly infringing goods? If so, will such security depend on the type of IP rights?

Since 1st July 2008 Switzerland no longer requires the provision of a security in all cases; the relevant Swiss IP Statutes now state that the customs authorities may (but not shall) request a security. However, the acknowledgement and signature of a declaration of commitment is required.

f) May the customs authorities take ex officio measures? If so, what is the practical relevance of ex officio action in your country?

Yes. Under all Swiss IP Statutes the customs authorities have the power to take ex officio measures. Such measures comprise notifying the IP owner of the potential infringement and retaining the respective goods for a period of three working days in order to allow the IP owner to submit a formal request for border measures.

In practice, ex officio measures play a role, for instance in the case of counterfeit famous trademarks, when an IP owner filed a request for border measures and the customs authorities then become aware of potentially infringing goods from other sources than those mentioned in the request.

g) Are customs authorities liable in case of wrongful ex officio detention?

The Swiss IP statutes hold that the person requesting border measures alone shall be liable for damages in case border measures were unjustified. They do not address state liability, and the Swiss group is not aware of any case law on whether the state may be held liable in case of a wrongful ex officio measure. In any event such liability would be limited to the time between the ex officio seizure and the receipt of a formal request for border measures, i.e. the first three working days after the seizure.

6. Are customs authorities properly equipped to identify goods which infringe patents, plant variety rights, common law marks, unregistered design rights, geographic indications or the like?

Customs authorities are not specifically equipped to examine violations of intellectual property rights that require more than a visual comparison, e.g. violations of patents or copyright-protected software. The customs authorities do not conduct a specific examination as to the violation of the IP rights. This is done by the judge who decides on the interim measures. To assist right-holders, the Swiss Federal Customs Administration (hereafter: FCA) (Oberzolldirektion = Directorate General of Customs) has an information sheet on its website which guides right-holders through the application procedure. After an application has been made, the FCA examines whether all the required information has been supplied and will contact the right-holder to request further specifications, if needed. Swiss customs officials have found that an easy-to-use checklist of features which distinguish a genuine from a fake product is particularly useful. When they control suspicious consignments, officials must swiftly judge the goods in question. Pictures provided by the right-holder illustrating typical characteristics of fake goods in comparison to original goods can facilitate this task. For example, in the case of pharmaceutical products, such illustration may detail the packaging or other specific characteristics (form, colour, signet on pill, etc.) of the pharmaceutical and/or of its counterfeit product.

In practice, requests for border measures often fail not because customs authorities are not adequately equipped and educated for assessing whether goods infringe a specific IP right, but because they are not able to identify the relevant consignments. For example, customs regulations in most cases do not require an importer to declare the brand names of the imported goods. Likewise, the ingredients or components of imported goods do not need to be named in customs declarations. For this reason brand names in most cases are ineffective criteria for identifying potentially infringing consignments, and customs authorities will not be able to identify potentially infringing consignments on the basis of the names or descriptions of allegedly infringing ingredients or components.

7. Will only the right-holder or also the owner, holder or importer of the allegedly infringing goods be notified once the customs authorities detain goods? How can the alleged infringer obtain information about the status of border measures and what information is provided by customs authorities to the alleged infringer?

The customs authorities inform either the person that applied for customs clearance, the actual possessor (e.g. the carrier) or the owner of the goods.

When the customs authorities decide to take border measures, they will automatically notify the above-mentioned persons. Informal inquiries may be made by telephone.

8. What happens after notification? Briefly describe the procedure following notification. Is the inspection of the allegedly infringing goods following notification usually carried out by the right-holder or by an expert?

Within ten working days following the notification, the right-holder or the exclusive licensee must obtain interim measures which are ordered by a judge. This ten working day period can be extended on request for a further period of ten days if this is justified by special circumstances. This possibility of extension is of particular relevance if an application for an interim measure has been filed and the measure has not been awarded in time. However, in most cases interim measures are ordered ex parte because the ten and twenty day periods rarely allow to fully hear the holder, owner or importer of the infringing goods.

During the time when the products are retained at the border, the right-holder or licensee can receive a sample of the infringing products for examination purposes. The right-holder or the exclusive licensee can also examine the infringing products at the Customs' premises. The right-holder or the licensee can ask an expert to assist them in the examination. They may also request that the interim measures provide that an expert is designated for the purpose of examining the infringing goods.

a) Does your border measure legislation provide for a simplified procedure allowing the destruction of the goods without there being any need to determine whether IP rights have been infringed? If so in which cases? Are samples of the goods preserved for evidence purposes?

In the application for border measures the applicant may request the destruction of the infringing goods. If the holder, owner or importer of the goods does not oppose their destruction within a ten day period following notification of the seizure, it is assumed as a matter of law that they consent to the destruction. They can also give their consent to the destruction of the goods at any later time during the procedure. Either way the costs of the destruction of the goods have to be borne by the applicant.

Samples of the goods are taken in custody by the Customs Administration before their destruction and are preserved for evidence purposes.

b) If proceedings must be issued to determine whether the goods infringe IP rights, are both criminal and civil proceedings available to determine infringement? What are the advantages and disadvantages of the respective proceedings?

Under Swiss law, seized goods are released if the applicant does not initiate proceedings in order to establish infringement within the above-mentioned timeframe. Both criminal and civil proceedings are available for this purpose.

The main disadvantage of criminal proceedings lies in the fact that criminal judges often are less experienced in IP matters than civil judges and that it can therefore be more difficult to convince a criminal judge to order the temporary seizure of goods within the ten or twenty working day period. On the other hand criminal proceedings may be less expensive than civil proceedings.

c) What is the impact of a nullity action seeking to invalidate IP rights on the application for customs action?

The fact that a nullity action is pending does not have a direct impact. Should the holder, owner or importer of the infringing goods raise the nullity objection as defense in the preliminary injunction pro-

ceedings, the judge will need to take this into consideration regardless of whether a nullity action is pending.

d) May customs authorities release goods suspected of infringing IP rights on provision of a security by the owner, holder or importer of such goods? If so, will such release depend on the type of IP rights?

Art. 53 § 2 TRIPS provides that the goods may be released, provided a security is given by the owner, holder or importer of the goods. This clause has been given effect in regards to the Patent Act (Art. 79 § 2).

9. If goods are found to infringe IP rights, may a right-holder oppose – exportation of infringing goods from your country; – infringing goods in transit; – placement of infringing goods in a free trade zone or free trade warehouse?

Yes, with the following exception. According to Art. 8 § 3 Patent Act, a patent owner may only prohibit transit of infringing goods through Switzerland if he could also prevent importation of these goods into the country of destination.

10. If goods are found to infringe IP rights, do the judicial or customs authorities of your country generally order the destruction of the goods or do they have the authority to dispose of the goods outside commercial channels (e.g. to charity)?

The judicial authority may decide against the of destroying of the infringing goods to dispose of the goods and outside commercial channels. The decision will however be taken at the right-holder's request.

a) May the competent authorities also order the infringer to give the names of his accomplices, upstream or downstream in the channels of production and distribution?

The judicial authority may also order the owner, holder or importer of the infringing goods to give the names of the accomplices, upstream and downstream in the channels of production and distribution.

11. May judicial or customs authorities order the applicant to pay the owner, holder or importer of goods appropriate compensation for any injury caused by wrongful detention? What is considered as appropriate compensation and does it include attorney fees or other expenses?

Yes, not only for wrongful detention but also for wrongful destruction and for the wrongful extraction of samples of the goods in question. To secure compensation for wrongful detention, the customs authorities can ask the applicant for a declaration of liability or to provide security before ordering the border measures. An order for compensation can only be issued by a judicial and not by the customs authorities. Appropriate compensation may also include participation towards the legal costs along with the cost of the work performed by the expert in order to determine the infringement.

II. Proposals for adoption of uniform rules

1. A better coordination between countries and at an international level are desirable to improve enforcement, in particular as to the possibility blocking infringing goods which are en route from one jurisdiction to another jurisdiction and to enable an applicant to file in one country with an effect in all countries. If uniform rules were to be based on the smallest common denominator between all countries, we would regard this as counterproductive.

2. Border measures should be made available to all goods which violate IP rights, property rights or unfair competition law. No goods should be excluded.

3. The level of proof should be that of suspicion. The application should not be communicated to the potential infringer.

4. The procedures should be of a judicial nature. There should be uniform rules which provide for complete compensation to be paid by the infringer to the successful applicant.

Swiss law lays the procedure following the seizure of goods completely in the hands of the IP owner. Particularly, it is the IP owner who sets the pace within the first ten to twenty working days after a seizure. The Swiss group observes that legitimate interests of the alleged infringer may not be sufficiently protected in this phase. For example, in case a machine is seized immediately before the opening of an exhibition that lasts only a few days, a release of the machine after ten or twenty days is too late. In such cases the alleged infringer would have a legitimate interest to accelerate the procedure, e.g. by being entitled to initiate legal procedures on his own. The Swiss group is of the opinion that such possibilities should be discussed.

5. The customs declaration should mention the titles of copyrighted goods and the trademarks which are on the goods. If the customs authorities notice that the indications on the customs declaration are not in line with the contents of the consignment, this should lead automatically to the detention of the goods and to the notification of the right-holder.

Zusammenfassung

Von den schweizerischen Immaterialgüterrechtsgesetzen enthalten das Patentgesetz, das Markenschutzgesetz, das Designgesetz, das Urheberrechtsgesetz und das Topografiengesetz weitgehend identische Bestimmungen über die Hilfeleistung der Zollverwaltung. Nicht vorgesehen ist eine Hilfeleistung der Zollverwaltung im Lauterkeitsrecht und im Sortenschutzgesetz. Erwähnenswert ist ferner, dass Zollmassnahmen auch in Erlassen mit häufigen Berührungspunkten zum Immaterialgüterrecht, beispielsweise im Edelmetallkontrollgesetz und im Heilmittelgesetz, vorgesehen sind. Der Bericht der Schweizer Gruppe konzentriert sich auf die erstgenannten, in Immaterialgüterrechtsgesetzen statuierten Massnahmen.

Zollmassnahmen beantragen können grundsätzlich der Rechtsinhaber und der ausschliessliche Lizenznehmer. Daneben räumt das Markenschutzgesetz dieses Recht auch gewissen Berufs- und Wirtschaftsverbänden ein, und das Urheberrechtsgesetz den Verwertungsgesellschaften. Schliesslich sind die Zollbehörden ermächtigt, Waren während einer kurzen Frist von drei Tagen aus eigenem Antrieb zurückzuhalten, falls der Verdacht besteht, dass diese Waren Schweizer Immaterialgüterrechte verletzen.

Wer Zollmassnahmen beantragt, hat konkrete Anhaltspunkte für eine bevorstehende Immaterialgüterrechtsverletzung zu nennen. Insbesondere sind die potenziell verletzenden Waren möglichst genau zu beschreiben und es ist darzulegen, inwiefern diese ein Immaterialgüterrecht verletzen. Für den Erfolg eines Begehrens entscheidend ist zudem, dass den Zollbehörden möglichst diejenigen Angaben geliefert werden, die sie benötigen, um die betreffenden Sendungen identifizieren zu können. Dies erweist sich in der Praxis häufig als eine der Hauptschwierigkeiten, weil beispielsweise die Marken einzuführender Waren in den Zolldeklarationen nur in Ausnahmefällen angegeben werden müssen.

Halten die Zollbehörden Waren auf Antrag eines Berechtigten zurück, hat dieser innert zehn (in begründeten Fällen zwanzig) Arbeitstagen vorsorgliche Massnahmen zu erwirken. Solche können vom Zivil- oder vom Strafrichter angeordnet werden. Während des Zurückbehaltens der Waren können die Zollbehörden dem Antragsteller zwecks Prüfung Proben oder Muster übergeben oder ihm die Besichtigung gestatten. In solchen Fällen sind allfällige Fabrikations- oder Geschäftsgeheimnisse des an den Waren Berechtigten angemessen zu wahren.

Die Gesetze sehen weiter vor, dass zurückgehaltene Waren auf Antrag vernichtet werden können, sofern der an den Waren Berechtigte innert zehn Tagen seit der Mitteilung an ihn der Vernichtung nicht widerspricht. Für Schäden, die dem an den Waren Berechtigten im Falle ungerechtfertigter Zollmassnahmen entstehen, haftet der Antragsteller.

Résumé

Parmi les lois de propriété intellectuelle, la loi sur les brevets, sur la protection des marques, sur le design, sur le droit d'auteur et sur les topographies de circuits intégrés contiennent des dispositions dans l'ensemble identiques sur l'intervention des douanes. Cette intervention n'est cependant pas prévue dans la loi contre la concurrence déloyale et dans celle sur les obtentions végétales. Il convient également de citer la présence de dispositions sur l'intervention des douanes dans des lois qui sont en relation étroite avec le droit de la propriété intellectuelle, à savoir, la loi sur le contrôle des

métaux précieux et celle sur les substances thérapeutiques. Le rapport du groupe suisse de l'AIPPI se concentre sur les mesures prévues dans les lois de propriété intellectuelle citées ci-dessus.

Peuvent en principe solliciter l'intervention des douanes le titulaire du droit et le preneur de licence exclusive. La loi sur la protection des marques accorde en outre cette possibilité à certaines associations professionnelles ou économiques. La loi sur le droit d'auteur accorde cette possibilité aux sociétés de gestion des droits d'auteur. Enfin, l'administration des douanes est autorisée à retenir ex officio pendant trois jours ouvrables des marchandises lorsqu'elle a le soupçon que celles-ci portent atteinte des droits de propriété intellectuelle en Suisse.

Celui qui requiert l'intervention des douanes doit évoquer des éléments concrets permettant de craindre une violation imminente de ses droits de propriété intellectuelle. Il doit en particulier décrire aussi précisément que possible les marchandises qui pourraient porter atteinte à ses droits. Le succès de la requête implique que l'administration des douanes reçoive dans toute la mesure du possible les données qui leur sont nécessaires pour identifier les envois de marchandises concernés. Ceci se révèle être en pratique souvent comme l'une des difficultés principales, dès lors que les marques des marchandises importées ne sont que rarement indiquées dans la déclaration de douane.

Si l'administration des douanes décide de retenir des marchandises à la requête de l'ayant droit, celui-ci doit dans le délai de dix jours ouvrables, prolongeables à 20 jours ouvrables s'il y a des motifs justifiés, pour obtenir un prononcé de mesures provisionnelles. Ces mesures peuvent être ordonnées soit par le juge civil, soit par le juge pénal. Pendant que les marchandises sont retenues, l'administration des douanes peut remettre au requérant des échantillons ou des modèles ou lui en autoriser l'examen. Dans ces cas, il convient de prendre les mesures adéquates afin de sauvegarder les éventuels secrets de fabrication ou commerciaux.

Les lois prévoient également que les marchandises retenues peuvent être sur requête détruites, si l'ayant droit ne s'y oppose pas dans un délai de dix jours dès la notification de la décision de retenir les marchandises. Le requérant répond enfin du dommage causé à l'ayant droit lorsque les mesures douanières s'avèrent infondées.

* Members of the working group: Corsin L. Blumenthal, Yves Bugmann, Lorenz Ehrler, Andreas Glarner, Jürg Herren, Andri Hess, Pierre-Alain Killias (chairman), Rainer Schalch.