

§ 32:21 Infringement—Customs actions

Pursuant to the EU Regulation concerning customs enforcement of intellectual property rights (the “EU Customs Regulation”),¹ Dutch customs authorities can act against goods suspected of infringing intellectual property rights, including but not limited to patent rights and SPC’s, copyrights, trade marks, designs, and trade names² (article 2(1) of the EU Customs Regulation).

Under the procedure as outlined in the Regulation, customs authorities can—upon prior request or at their own initiative—detain goods with a trade character³ that physically entered the Dutch territory and that are counterfeit or suspected to infringe intellectual property rights in force in The Netherlands. Goods possibly subject to illegal parallel trade fall outside of the scope of the Regulation (article 1(5) of the EU Customs Regulation). Furthermore, customs authorities cannot act against goods in transit, that have not been put into free circulation in the EU and have a final destination in a third country. There is an exception if there are concrete indications that the goods will be fraudulently directed to EU consumers.⁴

A request for detainment by customs is submitted with the use of a special application form (article 6 of the EU Customs Regulation). The Regulation distinguishes national and EU requests. With a national request, the customs authorities of one EU member state are requested to act in the respective member state. An EU request concerns a request to custom authorities of several member states, but it is submitted to customs authorities of one member state (article 2(10) and (11) of the EU Customs Regulation). EU requests can only be submitted based on unitary intellectual property rights (*see* article 4 EU Customs Regulation). Pursuant to article 3 of the regulation, requests can be submitted by intellectual property rights owners. Licensees are entitled to submit a national request if they have formally obtained the right from the rights owner to initiate infringement proceedings. Only holders of an exclusive license, valid in two or more member states, may submit an EU request. Customs detainment of the goods is for a limited period and will be followed by:

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¹Regulation (EU) 608/2013 of the European Parliament and the Council 12 June 2013 concerning customs enforcement of intellectual property rights and repealing Council Regulation (EC) 1383/2003.

²This applies only insofar as trade names are protected as an exclusive intellectual property right by national or EU law.

³Goods without a trade character and being stored in the personal baggage of a traveller are excluded from the possibility of customs detainment (article 1 (4), EU Customs Regulation).

⁴European Court of Justice, 11 November 2006, C-281/05, ECLI:EU:C:2006:709 (Montex/Diesel); European Court of Justice, 1 December 2011, C-446/09, ECLI:EU:C:2011:796 (Philips and Nokia).

1. Destruction of the goods, if the rights owner has timely declared in writing that the goods are infringing its rights and the owner of the goods has explicitly or tacitly agreed with requested destruction (article 23(1) of the EU Customs Regulation);
2. Further detainment of the goods if the owner of the goods has not agreed with destruction of the goods and the rights owner has timely initiated civil infringement proceedings (article 23(3) and (4) of the EU Customs Regulation); or
3. Lifting of the detainment and release of the goods to the owner, if the rights owner has not timely declared that the goods are infringing its rights or has not timely initiated infringement proceedings (article 23(5) EU of the Customs regulation).

With regard to further detainment, article 24 of the EU Customs Regulation provides for the possibility, upon request of the owner of the goods, to prematurely lift the customs detainment of goods suspected of infringing patent rights, design rights, topography of semiconductor products, or plant varieties rights.⁵ The request will be granted by customs if the owner of the goods has provided sufficient security, the authority that rules regarding the infringement (the judge) has not given a permission to undertake prejudgment measures against the goods, and all customs formalities are met.

⁵Utility models are mentioned in article 24 (1) EU Customs Regulation. However, utility models are not protected in The Netherlands as an intellectual property right.