

COMMISSION REGULATION (EC) NO 1891/2004 OF 21 OCTOBER 2004 (EE L 328/30.10.2004) LAYING DOWN PROVISIONS FOR THE IMPLEMENTATION OF COUNCIL REGULATION (EC) NO 1383/2003 CONCERNING CUSTOMS ACTION AGAINST GOODS SUSPECTED OF INFRINGING CERTAIN INTELLECTUAL PROPERTY RIGHTS AND THE MEASURES TO BE TAKEN AGAINST GOODS FOUND TO HAVE INFRINGED SUCH RIGHTS
(OJ L 328, 30.10.2004, p. 16–49)

THE COMMISSION OF THE EUROPEAN COMMUNITIES,

Having regard to the Treaty establishing the European Community,

Having regard to Council Regulation (EC) No 1383/2003 of 22 July 2003 concerning customs action against goods suspected of infringing certain intellectual property rights and the measures to be taken against goods found to have infringed such rights (1), and in particular Article 20 thereof,

Whereas:

(1) Regulation (EC) No 1383/2003 introduced common rules with a view to prohibiting the entry, release for free circulation, exit, export, re-export or entry for a suspensive procedure of counterfeit and pirated goods, and to dealing effectively with the illegal marketing of such goods without impeding the freedom of legitimate trade.

(2) Since Regulation (EC) No 1383/2003 replaced Council Regulation (EC) No 3295/94 of 22 December 1994 laying down measures concerning the entry into the Community and the export and re-export from the Community of goods infringing certain intellectual property rights (2), it is also necessary to replace Commission Regulation (EC) No 1367/95 (3), which laid down provisions for the implementation of Regulation (EC) No 3295/94.

(3) For the different types of intellectual property rights, it is necessary to define the natural and legal persons who may represent the holder of a right or any other person authorised to use the right.

(4) It is necessary to specify the nature of the proof of ownership of intellectual property required under the second subparagraph of Article 5(5) of Regulation (EC) No 1383/2003.

(5) In order to harmonise and standardise the content and format of applications for action under Article 5(1) and (4) of Regulation (EC) No 1383/2003 and the information to be entered on the application form, a standardised version of the form should be established. The language requirements for applications for action under Article 5(4) of the Regulation should also be laid down.

(6) The type of information to be included in applications for action should be specified in order to enable the customs authorities to recognise more readily goods that may infringe an intellectual property right.

(7) It is necessary to define the type of right-holder liability declaration which must accompany the application for action.

(8) In the interests of legal certainty, it is necessary to specify when the time periods laid down in Article 13 of Regulation (EC) No 1383/2003 commence.

(9) Procedures should be laid down for the exchange of information between Member States and the Commission, so that it is possible, on the one hand, for the Commission to monitor the effective application of the procedure laid down by Regulation (EC) No 1383/2003, to draw up in due course the report referred to in Article 23 thereof and to try to quantify and describe patterns of fraud, and, on the other hand, for the Member States to introduce appropriate risk analysis.

(10) This Regulation should apply from the same date as Regulation (EC) No 1383/2003.

(11) The measures provided for in this Regulation are in accordance with the opinion of the Customs Code Committee,

HAS ADOPTED THIS REGULATION:

ARTICLE 1

For the purposes of Article 2(2)(b) of Regulation (EC) No 1383/2003, hereinafter "the basic Regulation", the right-holder or any other person authorised to use the right may be represented by natural or legal persons.

The persons referred to in the first paragraph shall include collecting societies which have as their sole or principal purpose the management or administration of copyrights or related rights; groups or representatives who have lodged a registration application for a protected designation of origin or a protected geographical indication; and plant breeders.

ARTICLE 2

1. If an application for action within the meaning of Article 5(1) of the basic Regulation is lodged by the right-holder himself, the proof required under the second subparagraph of Article 5(5) shall be as follows:

(a) in the case of a right that is registered or for which an application has been lodged, proof of registration with the relevant office or proof that the application has been lodged;

(b) in the case of a copyright, related right or design right which is not registered or for which an application has not been lodged, any evidence of authorship or of the applicant's status as original holder.

A copy of registration from the database of a national or international office may be considered to be proof for the purposes of point (a) of the first subparagraph.

For protected designations of origin and protected geographical indications, the proof referred to in point (a) of the first subparagraph shall, in addition, consist in proof that the right-holder is the producer or group and proof that the designation or indication has been registered. This subparagraph shall apply *mutatis mutandis* to wines and spirits.

2. Where the application for action is lodged by any other person authorised to use one of the rights referred to in Article 2(1) of the basic Regulation, proof shall, in addition to the proof required under paragraph 1 of this Article, consist in the document by virtue of which the person is authorised to use the right in question.

3. Where the application for action is lodged by a representative of the right-holder or of any other person authorised to use one of the rights referred to in Article 2(2) of the basic Regulation, proof shall, in addition to the proof referred to in paragraph 1 of this Article, consist in his authorisation to act.

A representative, as referred to in the first subparagraph, must produce the declaration required pursuant to Article 6 of the basic Regulation, signed by the persons referred to in paragraphs 1 and 2 of this Article, or a document authorising him to bear any costs arising from customs action on their behalf in accordance with Article 6 of the basic Regulation.

ARTICLE 3

1. The documents on which applications for action are made pursuant to Article 5(1) and (4) of the basic Regulation, the decisions referred to in Article 5(7) and (8) and the declaration required pursuant to Article 6 of the basic Regulation must conform with the forms set out in the Annexes to this Regulation.

The forms shall be completed by electronic or mechanical means, or legibly by hand. Handwritten forms shall be completed in ink and in block capitals. Whatever method is used, forms shall contain no erasures, overwritten words or other alterations. Where the form is filled in electronically, it shall be made available to the applicant in digital form on one or more public sites that are directly accessible by computer. It may subsequently be reproduced on private printing equipment.

Where additional sheets are attached, as referred to in boxes 8, 9, 10 and 11 of the form on which the application for action provided for in Article 5(1) is to be made out, or in boxes 7,

8, 9 and 10 of the form on which the request for action provided for in Article 5(4) is to be made out, they shall be deemed to be an integral part of the form.

2. Forms for applications for action under Article 5(4) of the basic Regulation shall be printed and completed in one of the official languages of the Community designated by the competent authorities of the Member State in which the application for action has to be submitted, together with any translations that may be required.

3. The form shall be made up of two copies:

(a) the copy for the Member State in which the application is lodged, marked "1";

(b) the copy for the right-holder, marked "2".

The application forms, duly completed and signed, accompanied by one extract of the form for each Member State indicated in box 6 of the form, as well as the documentary proof referred to in boxes 8, 9 and 10, shall be presented to the competent customs department, which, after accepting the form, shall retain it for at least one year longer than its legal period of validity.

If the extract of a decision granting an application for action is addressed to one or more Member States pursuant to Article 5(4) of the basic Regulation, the Member State which receives the extract shall complete without delay the "acknowledgement of receipt" section of the form by indicating the date of receipt and shall return a copy of the extract to the competent authority indicated in box 2 of the form.

So long as his application for Community action remains valid, the right-holder may, in the Member State where the application was originally lodged, enter a request for action to be taken in another Member State not previously mentioned. In such cases, the period of validity of the new application shall be the period remaining under the original application, and it may be renewed in accordance with the conditions applying to the original application.

ARTICLE 4

For the purposes of Article 5(6) of the basic Regulation, the place of manufacture or production, the distribution network or names of licensees and other information may be requested by the department responsible for receiving and processing applications for action in order to facilitate the technical analysis of the products concerned.

ARTICLE 5

If an application for action is lodged in accordance with Article 4(1) of the basic Regulation before expiry of the time limit of three working days and accepted by the customs service

designated for that purpose, the time limits referred to in Articles 11 and 13 of that Regulation shall be counted only from the day after the application is received.

If the customs service informs the declarant or holder of goods that the goods are suspected of infringing an intellectual property right and that, pursuant to Article 4(1) of the basic Regulation, they have been detained, or their release suspended, the time limit of three working days shall be counted only from the time the right-holder is notified.

ARTICLE 6

In the case of perishable goods, the procedure for suspension of release or for detention of the goods shall be initiated primarily in respect of products for which an application for action has already been lodged.

ARTICLE 7

1. Where Article 11(2) of the basic Regulation applies, the right-holder shall notify the customs authority that proceedings have been initiated to determine whether, under national law, an intellectual property right has been infringed. Except in the case of perishable goods, if insufficient time remains to apply for such proceedings before the expiry of the time-limit laid down in the first subparagraph of Article 13(1) of the basic Regulation, the situation may be deemed an appropriate case within the meaning of the second subparagraph of that provision.

2. If an extension of ten working days has already been granted under Article 11 of the basic Regulation, no further extension may be granted under Article 13 thereof.

ARTICLE 8

1. Each Member State shall inform the Commission as soon as possible of the competent customs department, referred to in Article 5(2) of the basic Regulation, responsible for receiving and processing applications for action from right-holders.

2. At the end of each calendar year, each Member State shall send the Commission a list of all the written applications for action under Article 5(1) and (4) of the basic Regulation, giving the name and details of each right-holder, the type of right for which each application was submitted, and a summary description of each product concerned. The applications that have not been granted shall be included in that list.

3. In the month following the end of each quarter, each Member State shall send the Commission a list, by product type, giving detailed information on the cases in which the

release of goods has been suspended or goods have been detained. The information shall include the following details:

(a) the name of the right-holder; a description of the goods; if known, the origin, provenance and destination of the goods; the name of the intellectual property right infringed;

(b) for each item, the quantity of goods whose release was suspended or which were detained; their customs status; the type of intellectual property right infringed; the means of transport used;

(c) whether commercial or passenger traffic was involved and whether the procedure was initiated ex officio or as the result of an application for action.

4. The Member States may send the Commission information concerning the real or estimated value of the goods for which release has been suspended or which have been detained.

5. At the end of every year, the Commission shall, in an appropriate manner, communicate to all Member States such information as it receives pursuant to paragraphs 1 to 4.

6. The Commission shall publish the list of departments within the customs authority, as referred to in Article 5(2) of the basic Regulation, in the C series of the Official Journal of the European Union.

ARTICLE 9

Applications for action lodged before 1 July 2004 shall remain valid until their legal expiry date and shall not be renewed. However, they must be accompanied by the declaration required under Article 6 of the basic Regulation, the model for which is set out in the Annexes to this Regulation. The declaration shall release any deposit and fee payable in the Member States.

Where proceedings brought before the competent authority on a matter of substance before 1 July 2004 are still under way on that date, the deposit shall not be released before the close of those proceedings.

ARTICLE 10

Regulation (EC) No 1367/95 is repealed. References to the repealed Regulation shall be construed as references to this Regulation.

ARTICLE 11

This Regulation shall enter into force on the day of its publication in the Official Journal of the European Union.

It shall apply from 1 July 2004.

This Regulation shall be binding in its entirety and directly applicable in all Member States.

(1) OJ L 196, 2.8.2003, p. 7.

(2) OJ L 341, 30.12.1994, p. 8. Regulation as last amended by Regulation (EC) No 806/2003 (OJ L 122, 16.5.2003, p. 1).

(3) OJ L 133, 17.6.1995, p. 2. Regulation as last amended by the 2003 Act of Accession.