

# Anti-counterfeiting

Counterfeit goods present significant and growing challenges for rights holders in the global economy. According to European Commission reports, customs once seized goods valued at over EUR 768 million at the borders of the EU in a single year. Counterfeits cover a range of product types, such as clothes, shoes, medicines, cigarettes, packaging materials, toys, batteries, washing powders and insecticides. Most counterfeit goods come from Asian countries; however, more and more counterfeits are manufactured in the EU, which makes the costs of transport lower and products more difficult to detect. Counterfeit goods not only infringe intellectual property rights, but often pose a significant health threat to consumers. Counterfeiting affects a wide range of industries, from food to pharmaceutical companies. Therefore, regardless of whether you are a small or large company, you should consider setting up a corporate IP protection program to protect your trademarks, designs, patents, and copyrights, as well as other intellectual property rights, from counterfeiters.

## How do I prevent my products from being counterfeited?

Firstly, you should not wait until you have a counterfeiting problem before you start thinking about protecting your IP rights. As a business owner, you can pre-emptively undertake a variety of actions, such as: registering your IP rights, recording your IP rights with national customs authorities, supporting law enforcement authorities in the seizure and destruction of counterfeit goods, and commencing proceedings before civil and/or criminal courts.

## Customs and border protection

Any rights holder that is concerned about imports or exports of infringing goods should record, by submitting an application for action, their intellectual property rights with customs authorities – in Poland this takes place via the Customs Chamber in Warsaw.

## What is an application for action?

An application for action is a request made to the customs authorities to take action at the border with respect to goods suspected of infringing an intellectual property right. This is one of the most effective and affordable ways to fight against counterfeit goods at the border. There are no official fees for the application. Please note that you may file either a European Union or national application.

The protection afforded by the application for action lasts for one year. However, it can be extended for an additional year. If, during the term of protection, customs contests the originality of some goods, either their release into circulation will be suspended or they will be detained. Accordingly, customs will notify the rights holder (or their representative).

## What actions may be taken after receiving a notification concerning seizure of the suspected goods at the border?

The rights holder, or their representative, within the set deadline may:

- notify customs of the institution of proceedings (criminal or civil) intended to establish whether exclusive rights have been infringed; or
- submit documents that are required for destruction of the seized goods.

The destruction of goods detained at the border means that there is no necessity of establishing whether an infringement of exclusive rights has occurred before the court.

## What actions may be taken after receiving notification concerning the seizure of suspected goods inside the country?

When goods suspected of being counterfeit are seized by the police or the customs within the territory of Poland, criminal or civil proceedings may be initiated. As a rule, the rights holder is required to initiate these proceedings.

## What are the potential legal consequences of selling counterfeit goods?

Pursuant to criminal law, the infringer may be liable to a fine, limitation of freedom or imprisonment. In addition, the infringer may also be subject to civil liability. The rights holder may *inter alia* demand that the individual or company that violated their exclusive rights cease the actions infringing their rights and surrender the unlawfully obtained profits. In case of infringement caused by fault, the rights holder may claim for redress of the damage.

**The JWP Anti-Counterfeiting Team** has many years of experience in advising clients on implementing anti-counterfeiting strategies both in Poland and internationally. Our Team includes lawyers and patent attorneys that have the right technical knowledge to ensure that clients' rights (including, *inter alia*, trademarks, designs, patents, and copyrights) are appropriately secured. We are active members of the International Trademark Association (INTA), European Communities Trade Mark Association (including ECTA AntiCounterfeiting Committee), International Association for the Protection of Intellectual Property (AIPPI), Association of European Trade Mark Owners (MARQUES) and International Federation of Intellectual Property Attorneys (FICPI).

We advise clients from various industries, including from the pharmaceutical, technology, fashion, alcohol, publishing, toy, and cosmetics sectors.

Our attorneys have successfully represented clients in many cases against individuals and companies that have imported or distributed counterfeits. Their efforts have resulted in the seizure and destruction of thousands of counterfeits. In order to achieve these results, our attorneys work closely with customs authorities, police officers, prosecutors, private investigators, and local representatives in various jurisdictions. Our legal actions have also resulted in many favorable financial settlements for our clients.

## The JWP Anti-Counterfeiting Team offers the following services:

### Strategy:

- IP portfolio analysis;
- Advising on IP protection programs;
- Developing an integrated strategy against counterfeiters.

### Monitoring:

- Monitoring auction sites and online shops;
- Monitoring websites indicated by the client;
- Monitoring brick-and-mortar stores, markets;
- Organizing test purchases.

### Customs protection:

- Preparing and filing applications for action in Poland and other EU countries;
- Cooperating with representatives in various jurisdictions;
- Supervising protection expiry dates;
- Preparing and filing extension requests;
- Reporting on the seizures of goods at the border;
- Examining seized goods.

### Enforcement:

- Supporting the notice and takedown procedures;
- Preparing cease and desist letters;
- Negotiating in order to settle disputes amicably;
- Preparing settlement agreements;
- Preparing and filing requests for the destruction of seized goods;
- Organizing the transportation and destruction of seized goods;
- Obtaining interim injunctions;
- Conducting civil and criminal litigations before all national courts;
- Enforcement of receivables adjudged by courts.

## Training:

- Organizing informative meetings for customs and police officers;
- Organizing training and teleconferences about anticounterfeiting measures in Poland and the EU.

## JWP online database:

- Online access to cases.

## ■ Experts



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