RESTRICTED
MTN.GNG/NG11/W/33/Rev.2
1 February 1990
Special Distribution

Negotiating Group on Trade-Related Aspects
of Intellectual Property Rights, including
Trade in Counterfeit Goods

SYNOPTIC TABLE SETTING OUT PROPOSALS ON ENFORCEMENT AND CORRESPONDING PROVISIONS OF EXISTING INTERNATIONAL TREATIES

Prepared by the Secretariat

Revision

1. At its meeting of 11-12 May 1989, the Negotiating Group requested the secretariat to prepare synoptic tables setting out in a comparative manner the proposals tabled in the Group on enforcement of trade-related intellectual property rights and corresponding provisions of existing international treaties. The synoptic table contained in this note has been prepared in response to the request made by the Group at its meeting of 11, 12 and 14 December 1989 to the secretariat to prepare a final version of the table. It takes into account the additional specific proposals circulated by delegations since that document was prepared.

2. The various proposals and the corresponding existing international rules on enforcement do not share a common structure. In the attached synoptic table they have been structured in four main sections. Section A, General obligations, concerns proposed obligations that unless otherwise stated would apply to enforcement procedures and remedies generally, whether internal or at the border. Section B, Internal measures, concerns enforcement procedures and remedies that apply to the internal production, sale, distribution, etc. of infringing goods. Such measures would apply to the internal sale, etc. of both domestically-produced and imported goods. In some proposals, it is stated that these "internal" procedures should also be available against the importation and maybe exportation of goods. Section C, Special requirements related to border measures, concerns special provisions which have as their basic purpose providing for action against the importation (possibly exportation and transit) of infringing goods prior to their clearance through the customs authorities.

3. Previous versions of the synoptic table also included a section D which concerned proposed obligations regarding the acquisition of IPRs. Since certain participants have chosen to put forward their proposals under this matter in connection with enforcement and others in connection with the standards and principles, the suggests on this matter have been brought together in a separate synoptic table (to be issued as document MTN.GNG/NG11/W/..). They are thus not reproduced in the present note.

4. Under each main heading, a number of sub-headings have been employed. It should be noted that these headings and sub-headings do not generally appear in the proposals or in existing international treaties; they have been used solely with a view to assisting the user of the synoptic table and have no standing beyond that.

5. The synoptic table attached to this note is thus organized as follows:

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6. It should be noted that in some cases a general obligation described in Section A is amplified in Sections B and C. For example, the proposed general objective and obligations concerning the avoidance of barriers to legitimate trade in A(1) and A(10) are dealt with more specifically in some parts of Sections B and C, including B(3) (conditions on provisional measures and indemnification of defendant), B(6) (indemnification of defendant), C(2)(b) (concerning parallel imports), C(4) (requirements for initiation of procedures by IPR holders) and C(5) (conditions on detention of goods by customs), as well as in other parts of Section A, such as A(4) (assurance of equitable procedures), A(10) (national treatment), A(11) (mfn treatment/non-discrimination) and A(12) (right of judicial review).

7. The first column in each table sets out the provisions of existing international treaties corresponding to the proposals made. The following points about the scope of the information contained in this column should be borne in mind:

- Only the provisions of multilateral treaties have been included. Regional or bilateral treaties have

not been referred to.

- The information given refers to the most recent revision of the treaty in question.

- In order to enable the information to be presented synoptically, it has been necessary in many instances to present the existing provisions of international treaties in summary form. References have been included to the articles of the treaties in question where the full text of existing international standards can be found.

8. Information on provisions of existing international treaties relevant to enforcement can be found in the document prepared by the International Bureau of WIPO on the Existence, Scope and Form of Generally Internationally Accepted and Applied Standards/Norms for the Protection of Intellectual Property (MTN.GNG/NG11/W/24/Rev.1) under Section (8) of each of the parts dealing with different types of intellectual property right. This document also contains information on model legislations prepared by WIPO, the activities of WIPO and national policies and practices. Information can also be found in the note by the GATT secretariat on Provisions on Enforcement in International Agreements on Intellectual Property Rights (MTN.GNG/NG11/W/18).

9. The other three columns of the synoptic table set out the specific proposals by the United States (MTN.GNG/NG11/W/14/Rev.1), the European Communities (MTN.GNG/NG11/W/31), Japan (MTN.GNG/NG11/W/43 and Add.1), India (MTN.GNG/NG11/W/40), Canada (MTN.GNG/NG11/W/42), the Republic of Korea (MTN.GNG/NG11/W/48), Australia (MTN.GNG/NG11/W/53), Hong Kong (MTN.GNG/NG11/W/54), Brazil (MTN.GNG/NG11/W/57) and the Nordic countries (MTN.GNG/NG11/W/58). To avoid confusion, the language in these proposals has been standardized so that "signatories" refer to signatory governments of the proposed agreement and "parties" refer to private parties to an enforcement proceeding.

10. In regard to the Indian proposal, it should be noted that this is limited to internal enforcement of intellectual property rights. The Indian proposals on enforcement at the border have been presented under the agenda item on trade in counterfeit goods, in document MTN.GNG/NG11/W/41. The Canadian proposal contains two main parts: a set of basic principles; and an annex containing Canada's more detailed views on the specific issues covered in the synoptic table, submitted inter alia to assist the Negotiating Group in addressing the level of detail appropriate for enforcement provisions. The proposed basic principles are reproduced without square brackets, whereas the more detailed views are those within square brackets.

11. In addition to the three proposals listed, it is recalled that a number of other suggestions, not amenable to presentation in the synoptic table, have been made relevant to enforcement, including those presented in writing by Thailand (MTN.GNG/NG11/W/27), Switzerland (MTN.GNG/NG11/W/44) and Mexico (MTN.GNG/NG11/W/60). The proposal by Austria (MTN.GNG/NG11/W/62) is also not reflected in the table since it was received too late to be taken into account. It should also be noted that the synoptic table does not reflect suggestions made under the agenda item on trade in counterfeit goods, for example those contained in documents MTN.GNG/NG11/W/9 (Draft Agreement to Discourage the Importation of Counterfeit Goods), MTN.GNG/NG11/W/11 (by Brazil)[1], MTN.GNG/NG11/W/28 (by Mexico), MTN.GNG/NG11/W/41 (by India), Peru (MTN.GNG/NG11/W/45) and Mexico (MTN.GNG/NG11/W/60).

12. The Thai paper (W/27) urges that the following elements should be incorporated into the enforcement mechanism contemplated:

- The enforcement procedures should lead to further liberalisation. They should not themselves become barriers or means of harassment of legitimate trade or lead to excessive protection that obstructs technology transfer.

- The procedures should reflect the genuine intention and obligations of individual contracting parties to provide due process of law. However, this does not imply that harmonisation of national laws is

required.

- The procedures should afford the maximum degree of transparency.

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[1] It will, however, be noted that the content of the Brazilian suggestion, which is that countries sign the WIPO Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods, is reflected in column one of the synoptic table under "corresponding provisions of existing international treaties".

13. In its paper (W/44) the delegation of Switzerland highlighted a number of basic elements which it considered that an agreement on enforcement of IPRs should contain. These were: comprehensive coverage, including with respect to criminal sanctions; procedures both at the border and internally; application of the mfn and national treatment principles to the entire range of rules of enforcement; strict request of the general idea of equality of opportunity for foreign products on right holders; and general, though fairly ambitious rules, which could be implemented in all legal systems without introducing elements strange to them.

14. The Mexican paper (W/60) states that each country must have the essential legal self-determination for the implementation of its legislation. To that end, the negotiations must not seek to harmonise national laws but rather to establish agreed general principles to which participants must gradually adjust. In addition, enforcement measures must not be incompatible with the GATT.

15. The Austrian paper (W/62) contains a comprehensive proposal on enforcement on enforcement, covering internal procedures and remedies, and provisional measures, including measures at the border.

16. Many participants have, of course, expressed their views orally at meetings of the Group since the April 1989 TNC decision. These views are recorded in documents: MTN.GNG/NG11/12, in particular paragraphs 10-22; MTN.GNG/NG11/13, in particular paragraphs 16-32; MTN.GNG/NG11/15, in particular paragraphs 24-44; MTN.GNG/NG11/16, in particular paragraphs 65-70; and MTN.GNG/NG11/17, in particular paragraphs 51-64. be issued

17. The following are the full titles of the international treaties referred to in column one of the table:

- Paris Convention for the Protection of Industrial Property (WIPO) (1883, revised 1900, 1911, 1925, 1934, 1958 and 1967, and amended 1979);

- Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods (WIPO) (1891, revised 1911, 1925, 1934 and 1958; Additional Act 1967);

- Lisbon Agreement for the Protection of Appellations of Origin and Their International Registration (WIPO) (1958, revised 1967, and amended 1979);

- Treaty on Intellectual Property in respect of Integrated Circuits (WIPO)(1989);[2].

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[2] Not yet in force.

- Berne Convention for the Protection of Literary and Artistic Works (WIPO) (1886, completed 1896, revised 1908, completed 1914, revised 1928, 1948, 1967 and 1971, and amended 1979);

- Universal Copyright Convention (Unesco) (1952, revised 1971);

- Geneva Convention for the Protection of Producers of Phonograms against Unauthorised Duplication of their Phonograms (WIPO, in co-operation with ILO and Unesco for matters relating to their respective fields of competence) (1971);

- Brussels Convention Relating to the Distribution of Programme-Carrying Signals Transmitted by Satellite (Unesco and WIPO) (1974

A. GENERAL OBLIGATIONS(1)
OBJECTIVES AND GENERAL CONSIDERATION
SCorresponding Provisions of ExistingInternational Treaties Article 10ter of the Paris Convention requires member States to assure to nationals of other member States appropriate legal remedies effectively to repress all the acts referred to in Article 9 (concerning trademarks and trade names), Article 10 (concerning false indications of source) and Article 10bis (concerning unfair competition). infringement of IPRs. Under the Berne Convention any party to the Convention undertakes to adopt, in accordance with its constitution, the measures necessary to ensure the application of the Convention which defines, in detail the works to be protected, the rights to be granted, etc. At the time when a country deposits its instrument of ratification or accession, it must be in a position under its domestic law to give effect to the provisions of the Convention (Article 36).
Under the Universal Copyright Convention, Contracting States undertake to provide for the effective (as well as adequate) protection of the rights of authors and of other copyright proprietors (Article I).
The Phonograms Convention requires Contracting States to protect producers of phonograms against the making of duplicates without the consent of the producer and against the importation of such duplicates for the purpose of distribution to the public, and against the distribution of such duplicates to the public. The means by which the Convention is implemented are a matter for the domestic law, but they must include one or more of the following: protection by means of the grant of a copyright or other specific right; protection by means of the law relating to unfair competition, protection by means of penal sanctions (Articles 2 and 3).

United States (W/14/Rev.1)Effective economic deterrent to international trade in goods and services infringing IPRs through implementation of internal and border measures that deprive entities trading in infringing goods and services of the benefits of such activity.
Effective means of preventing and deterring
India (W/40)
Ensure that measures to enforce IPRs minimize interference with legitimate trade.
Australia (W/53)
The aim of the enforcement negotiations should be to specify the essential elements which should be available to enable legitimate holders of IPRs to enforce those rights. The specification of such elements should take account of differences in national legal systems, both internally and at customs entry points.
Measures for the enforcement of IPRs should be effective in enabling right holders to take swift action against infringement of their IPRs but should not be such that they prevent or restrict legitimate trade.
Enforcement obligations should be framed so as to achieve the objectives of:
(a) reducing distortions and impediments to international trade caused by infringement of IPRs;
(b) discouraging international trade in counterfeit and pirated goods;
(c) providing greater certainty and predictability in relation to right holders having access to enforcement procedures and remedies; and
(d) ensuring that such procedures and remedies do not themselves become barriers or unnecessary obstacles to legitimate trade.

European Communities (W/31)Provision of effective procedures to protect IPRs against any act of infringement.
Application of these procedures in such a manner as to avoid the creation of obstacles to legitimate trade.
requirements of the general rules and
There should be provision of simple, effective and adequate internal enforcement procedures to enable expeditious action against infringement and to provide relief to the owners of IPRs.
Canada (W/42)
Procedures to enforce IPRs should be effective but should not create unnecessary obstacles to legitimate trade.
[Signatories should establish measures and procedures to ensure prompt, effective and non-discriminatory enforcement of IPRs covered by this agreement. Such procedures should minimize interference with legitimate trade.]
Hong Kong (W/54)
The objectives of an agreement on minimum standards for the enforcement of IPRs should be the creation and maintenance of laws and an effective framework to deter trade in goods and services that infringe, without hindering trade in legitimate goods and services.

Japan (W/43)Signatories shall establish procedures for effective and appropriate enforcement of IPRs at domestic and border levels by means of civil law, criminal law, administrative law or a combination thereof. Enforcement measures shall be ensured by national laws in so much as they meet the disciplines which will be the outcome of this negotiation.In establishing and implementing enforcement measures, considerations shall be paid to the following points: - differences among various types of IPRs; - need to ensure that measures taken to protect IPRs do not become barriers to legitimate trade. Republic of Korea (W/48)The administrative and judicial costs of protecting certain rights vary according to the development level of administrative and judicial systems. Optimum method of protecting certain rights for a country also depends on its administrative and cultural background. Hence, the concrete enforcement procedures should be decided by individual countries. In the agreement, only the general guidelines (e.g. responsible authorities, the possibility of imprisonment and fine) which may give concrete directions for the domestic laws should be listed.Signatories should provide effective administrative and judicial procedures to prohibit the production and the trade of products infringing IPRs and to compensate for losses accrued to holders of rights concerning infringed products.Signatories should also provide concrete measures to prevent the above procedures themselves from becoming barriers to any legitimate trade.

Corresponding Provisions of ExistingInternational Treaties Brazil (W/57)
Nordics (W/58)The Brussels Convention (Satellites) requires that the measures undertaken by member States to prevent the distribution on or from their territory of programme-carrying signals be adequate (Article 2(1)).
The Treaty on Intellectual Property in

In the area of enforcement of trade-related intellectual property rights, it would be useful to proceed to the examination of means to secure the rights and to respect the obligations of parties involved in trade transactions related to the protection of intellectual property rights. For that purpose, as for the rights themselves, their enforcement would be done in the context of the national legal systems and according to

The TRIPS agreement should contain an obligation for signatories to maintain procedures for effective enforcement.
The TRIPS agreement should oblige signatories to ensure that enforcement procedures do not give rise to obstacles to legitimate trade or disguised restrictions on international trade.
The provisions should be formulated as general rules

respect of Integrated Circuits requires each Contracting Party to secure adequate measures to ensure the prevention of acts considered unlawful under the provisions of the Treaty and appropriate legal remedies where such acts have been committed (Article 3).

international agreements, where applicable.
Brazil, while holding the view that the sovereign right of States to organize their respective domestic legal systems should be represented, considers that the subject of negotiations on enforcement should be situations where international commercial operations involve, in a relevant manner, aspects of intellectual property rights as, for example, the case of trade operations subject to disputes for reasons of intellectual property.
Internal enforcement of intellectual property rights is a matter of strict competence of domestic legislations. Legal situations involving in a predominant way IPRs should be dealt with by national laws and international agreements, where applicable.

acceptable to different national legal systems. Formulations reflecting country-specific features must therefore be avoided. Signatories must, however, be prepared to amend national law, leaving their legal systems basically unchanged.
The provisions should be sufficiently detailed and specific to guarantee enforcement of the agreed level and scope of protection of IPRs and to make multilateral dispute settlement possible.

Republic of Korea (W/48)
India (W/40)
Australia (W/53)
Hong Kong (W/54)Brazil (W/57)

Administrative, judicial or both types of procedures shall be available to enforce IPRs both internally and at the border.

Canada (W/42)
See (A(13)) below and introduction, paragraph 9.
administrative or a combination thereof. In
Civil and criminal judicial procedures; administrative civil procedures.
should, however, be an important complement
See A(1) above.

Signatories shall protect IPRs by means of civil law, criminal law, administrative law or a combination thereof.
Enforcement procedures should be made
See A(13) below.
[Signatories should protect IPRs by means of civil procedures being judicial or Nordics (W/58)appropriate circumstances, criminal procedures should also apply.]
for those IPRs which can be subjected to such Civil judicial internal procedures; provisional judicial or administrative measures, both internally and at the border; criminal procedures.
While signatories should be free to decide to protect IPRs by means of civil, criminal, or administrative procedures or a combination of these, in accordance with their national legal systems, Hong Kong considers that emphasis should rest primarily on civil procedures, as they appear the most appropriate to protect private rights.

See A(1) above. available both at the border and internally. See A(1) above. Procedures for internal enforcement should constitute the main instrument for securing effective protection. Measures at the border procedures.

See A(1) above .
India (W/40) for right holders, including foreign nationals,
It shall not be expected of them to allocate
Brazil (W/57)
It is the view of the Brazilian Government that
Australia (W/53)
Nordics (W/58)

Signatories shall designate a competent body and devote sufficient resources to ensure the prompt and effective enforcement of IPRs.
Procedures shall provide adequate opportunities
Canada (W/42) It is only through their normal administrative and judicial systems that governments, particularly of developing countries, are in a position to provide for enforcement of IPRs. such rights.
additional resources establishing separate machinery for the enforcement of IPRs. See also A(1) above.
Hong Kong (W/54)
negotiations should take fully into account the
Judicial and/or administrative civil proceedings should not be administratively or legally complicated, unnecessarily costly or time consuming, or subject to unreasonable time limits.
Each signatory should be required to make public promptly all laws, regulations, judicial decisions and administrative rulings pertaining to the enforcement of IPRs in such a manner as to enable governments and traders to become acquainted with them.
for the agencies responsible for the

Procedures concerning the enforcement of IPRs shall not be unnecessarily complicated, costly or time consuming, nor shall they be subject to unreasonable time-limits.
to make use of them. The term "right holder" means the right holder himself, any other person authorized by him or persons having legal standing under national law to assert Republic of Korea (W/48)
enforcement measures which may result from the
Signatories should ensure that the procedures specific nature of IPRs, in that they constitute a matter of regulation by national legislations, as well as an integral element of the set of factors which form part of international trade transactions.
It should be accepted, as a principle, the recognition of countries' geographic, political, legal, and economic conditions, among others, under which their national enforcement system operates. In particular, the difficulties of developing countries in terms of fulfilling possible obligations should be recognized.
Possible final commitments should not result in excessive material burden enforcement of intellectual property rights in those countries.

Procedures shall not be unnecessarily complicated, costly, or time consuming, nor shall they be subject to unreasonable time-limits.See A(1) above.See A(1) above.involved in enforcing IPRs are not unnecessarily complicated, expensive, or time consuming. Procedures should provide adequate opportunities for all rights holders to make use of them. In addition, signatories should designate an enquiry point with which IPR holders may correspond to assist them to determine the existence of municipal laws and administrative procedures that govern enforcement of IPRs, or to direct them to the relevant authority that may take any enforcement action being sought.

(4) ASSURANCE OF EQUITABLE PROCEDURESCorresponding Provisions of ExistingInternational Treaties
United States (W/14/Rev.1)
European Communities (W/31)
Japan (W/43)
means to gain access to and present to information, documents, records and other
Republic of Korea (W/48)
Nordics (W/58)
Brazil (W/57)

Procedures for the enforcement of IPRs, whether they be administrative or judicial, civil or criminal must ensure due process of law including:
(i) the right to receive written notice prior to commencement of proceedings which contains information sufficient to determine the basis of the dispute;
(ii) application of the same substantive standards for determining whether an enforceable IPR exists and whether it has been infringed with respect to all products whether imported or locally produced;
(iii) prompt, fair, reasonable, and effective tunities for imported products.relevant judicial or administrative authorities statements of witnesses and
Australia (W/53) articles of evidence for the enforcement of IPRs;
(iv) determinations in writing relating to the infringement of IPRs which must be reasoned and made in a fair and open manner.
India (W/40)
The principles of natural justice and fair play shall be observed in internal enforcement procedure. There should be prior notice to the concerned parties and adequate opportunities for defence.
Standards for protection of IPRs, procedures for obtaining such rights, and dispute-settlement procedures should be transparent.The same substantive standards for determining whether an enforceable IPR exists and whether it has been infringed should be applied equally to imported products and locally produced products. For that, enforcement procedures should be made available both at the border and internally.
and are to be followed in proceedings, should

Decisions on the merits of a case shall, as a general rule, be in writing and reasoned. They shall be made without undue delay in a fair and open manner.
All parties to civil judicial procedures shall be duly entitled to substantiate their claims and to present the evidence relevant for the establishment of the facts and the determination of the validity and infringement of the IPRs concerned, as well as to exercise their rights of defence. Decisions shall only be based on such facts in respect of which parties were offered the opportunity to be heard. Administrative procedures shall conform to equivalent procedures, inter alia in order to ensure effective equality of oppor
Hong Kong (W/54)
be fair, equitable and transparent. Except in Judicial and/or administrative civil proceedings shall normally include the right to all affected parties to:
- prompt and reasonable notice of the commencement of proceedings;
- an adequate opportunity to prepare their case;
- effective means to present evidence to substantiate their claims, exercise their rights of defence and to communicate their views to the authorities;
- representation for all parties,reasoned, recorded in writing, and available to - reasoned decisions made without undue delay in a fair and open manner; and
- judicial review.Enforcement procedures should be fair and equitable to all affected parties, and be no less favourable to foreigners than to nationals. The judicial and/or administrative proceedings should run their full course, unfettered from any external interference, and operate on the basis of established facts.
Information concerning procedures that apply judicial review.be made available to IPR holders and other parties.

A person against whom procedures have been initiated shall be given ample opportunities for defense. A person who is to be subject to substantive argument on the merits of a case shall be given notice before the argument.Final judicial decision on the merits of a case shall be made in a fair and open manner. They shall be in writing and reasoned.Final decisions by courts in civil procedures shall be based only on such facts in respect of which parties were offered the opportunity to be heard. Administrative procedures shall be subject to an equivalent requirement.
Procedures for the enforcement of IPRs should the case of ex parte proceedings, adequate written notice of proceedings, adequate written notice of proceedings (including venue and time of hearing) shall be given, and should contain sufficient information to identify the basis of the dispute. A party to proceedings before a court or tribunal should be entitled to substantiate his claims, or establish his defence, by the presentation of relevant evidence. The determination of that body should be based solely on the facts in respect of which the parties were offered an opportunity to present their claims. Procedures should not be subject to unreasonable time limits, nor permi unwarranted delay. Decisions should be the public. Administrative procedures should be subject to equivalent principles.Parties to civil judicial procedures should be entitled to substantiate their claims and present evidence as well as to exercise their right of defence with regard to all relevant acts such as imports, internal production and use. Decisions should be reasoned and made without undue delay in a fair and open manner. There should also be a right to

(4) ASSURANCE OF EQUITABLE PROCEDURES (cont'd)Corresponding Provisions of ExistingInternational Treaties Canada (W/42)	Procedures for enforcement should be fair and equitable to the affected parties and transparent. [Procedures for the enforcement of IPRs should be fair, equitable and transparent. Such procedures should meet the following criteria: - Except for ex parte proceedings, parties to a dispute should have a right to receive written notice in sufficient time prior to a hearing on the merits to enable a defence or response to be prepared. Such notice should contain sufficient information to determine the basis of the dispute. - Parties to proceedings should be entitled to substantiate their claims and to present evidence relevant for the establishment of the facts and the determination of the validity and infringement of the IPRs concerned wither orally or in writing as appropriate, as well as to exercise their rights of defence. - Decisions should be based only on such facts in respect of which the parties were offered an opportunity to present their positions. - Hearings should be transparent and, unless there are reasonable grounds to the contrary, should be open to the public. - Procedures should not be subject to unreasonable time limits or unwarranted delays. - Decisions should be in writing and should normally be accompanied by written reasons for decision. - Decisions should be made without undue delay and in a fair and open manner. - Decisions should be published or otherwise available to the public.]

(5)
RIGHTS OF REPRESENTATION/PRESENTATION OF EVIDENCE
Corresponding Provisions of Existing International Treaties
the parties, but shall, to the greatest extent present evidence, in writing or orally, or reliability and fairness, such as
India (W/40)
Australia (W/53)
See A(4) above.
Brazil (W/57)

United States (W/14/Rev.1)Procedures shall not impose overly burdensome requirements concerning personal appearances by
Canada (W/42)possible, permit the parties to appear through representatives and provide a fair and reasonable opportunity for all parties to in the relevant proceedings.both, for consideration by the authorities.
Subject to procedures and conditions to ensure requirements concerning personal appearances cross-examination and disclosure of adverse information, signatories shall facilitate the acceptance of evidence, including expert testimony, and technical or test data, in order to assist in expediting and reducing costs of participating in enforcement procedures.
test data, in order to assist in expediting
Hong Kong (W/54)
requirements concerning personal appearance by

European Communities (W/31)See A(4) above.
evidence. Administrative procedures shall be
[Parties may be represented by independent counsel where such representation is customary
Republic of Korea (W/48)
Procedures should not impose overly burdensome
Nordics (W/58)by parties.
Subject to procedures and conditions to ensure reliability and fairness, such as cross-examination and disclosure of adverse information, contracting parties should facilitate the acceptance of evidence, including expert testimony, and technical or and reducing costs of participating in enforcement procedures.]

Procedures should not impose unreasonable parties.
Parties to proceedings may be represented by independent counsel where this is permitted by the municipal law of the participant. Expert testimony should be permitted. Procedures should permit cross-examination of any witness called by the opposing party.

Japan (W/43) All parties to civil judicial procedures shall be entitled to present relevant subject to an equivalent principle.See A(4) above.

(6) ACCESS TO INFORMATION
Corresponding Provisions of Existing International Treaties
affected countries, to see relevant,
Nordics (W/58)
Australia (W/53)Brazil (W/17 and 43)
Hong Kong (W/54)

United States (W/14/Rev.1) Relevant authorities shall provide opportunities for the IPR owner, other parties to the proceeding and the governments of the
Canada (W/42) non-confidential information that is used by the authorities in a procedure relating to an enforcement action, and to prepare presentations based on this information.
India (W/40)
See A(4) above.
Civil procedure law should provide the opportunity for a party to seek disclosure of relevant information prior to a hearing on the merits.

European Communities (W/31) See A(4) above.
Republic of Korea (W/48)
[Procedures should provide for the disclosure of relevant information in the possession of the adverse party prior to a hearing on the merits.]

Japan (W/43)See A(4) above. Holders of IPRs are responsible for submitting evidence when they file a lawsuit claiming an infringement of the rights.

(7) TREATMENT OF CONFIDENTIAL INFORMATIONCorresponding Provisions of ExistingInternational Treaties
United States (W/14/Rev.1)
effectively identify and protect confidential disclosure would be of significant competitive effect upon a person supplying the information confidential basis for a procedure relating to
Australia (W/53)

European Communities (W/31)Signatories shall provide a means to Canada (W/42) information. Any information which is by nature confidential (for example, because its effectively identify and protect confidential advantage to a competitor or because its disclosure would have a significantly adverse evidence.] or upon a person from whom he acquired the information or which is provided on a Hong Kong (W/54)an enforcement action) shall, upon cause shown, be treated as such by the authorities. Such information shall not be disclosed without permission of the party submitting it except pursuant to a protective order sufficient to safeguard the interest of such party.
India (W/40)

Japan (W/43)
Republic of Korea (W/48)
[Signatories should provide a means to
Brazil (W/57)information provided by any of the parties to the dispute or by others required to give
Nordics (W/58)

Civil procedure law should provide effective means to identify and protect confidential information provided by any of the parties to a dispute, or by others required to give evidence.

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(8)
FACILITATION OF THE OBTAINING OF EVIDENCE
Corresponding Provisions of ExistingInternational Treaties
their territories by establishing adequate,
notification of a competent authority before a
Canada (W/42)
India (W/40)
Australia (W/53)
proceedings to preserve the relevant evidence
If such provisional measures are in place as a

United States (W/14/Rev.1)
Signatories shall facilitate the gathering of evidence needed for an enforcement or related action in the territory of another signatory. Procedures may be carried out in other countries to obtain statements of witnesses and information, documents, records, and other articles of evidence relating to an enforcement action, including the assessment of remedies.
Signatories shall facilitate the taking of such statement and production of such materials in procedures, to be informed by the infringer, timely and efficient procedures. Such procedures shall permit such evidence to be taken in any manner not prohibited by national law. A signatory may require prior statement is taken or materials produced. Signatories should provide for ex parte Signatories shall make available ex parte proceedings to preserve evidence and take other actions urgently required provided that the parties shall be provided subsequent notice of the action and the right to participate in an administrative or judicial procedure providing due process of law.
Provisional measures should be available for IPR holders to take prompt action, upon request, through administrative or judicial persons involved in the production and the with regard to any alleged infringement.
that this be treated as confidential result of an ex parte proceeding, a hearing of all parties should be held as soon as possible for the purpose of deciding whether to confirm, modify or revoke the provisional measures.

European Communities (W/31)
Signatories shall provide for judicial procedures for the adoption, upon request by a right holder, of prompt and effective provisional measures to preserve the relevant evidence with regard to the alleged infringement.
Unless this would be out of proportion to the importance of the infringement, the right holder shall be entitled, in civil judicial
Republic of Korea (W/48)upon request, of the identity of the persons involved in the production and the channels of distribution of the infringing goods or services. Hong Kong (W/54)
[Signatories should provide for ex parte judicial procedures to preserve evidence. Applicants may be required to post security or to provide equivalent assurance before obtaining such an order. Parties adversely affected should promptly be given notice of the subsequent proceedings for which the evidence was obtained.grounds to the contrary, the right holder Generally, such measures should include the following provisions:identity of persons involved in the Unless there are reasonable grounds to the contrary, the right holder should be entitled in civil proceedings to be informed by the infringer on request, of the identity of the Brazil (W/57)channels of distribution of infringing goods or services. A court or tribunal may order Nordics (W/58)information by the party obtaining it but it may be used in proceedings against other infringers.]

Japan (W/43) Signatories shall provide for appropriate civil judicial measures to preserve relevant evidence. Notwithstanding the general principles concerning procedure, such measures may, in appropriate cases, be taken without prior notice to an adversary. Administrative procedures shall be subject to equivalent principles.See A(6) above.
proceedings in civil disputes to preserve evidence relevant to the alleged infringement, subject to the right holder being required to give appropriate securities to protect persons who may be wrongly prejudiced. Persons adversely affected should be given prompt notice of subsequent proceedings for which the evidence was preserved. Unless there are reasonable should be entitled to be informed by the alleged infringer, on request, of the production of the infringing goods or services and their channels of distribution.

(9) CONSEQUENCES OF FAILURE TO PROVIDE INFORMATION Corresponding Provisions of ExistingInternational Treaties
a government refuses to, or otherwise does not
the procedure relating to an enforcement
India (W/40)
Nordics (W/58)Australia (W/53)
Hong Kong (W/54)

United States (W/14/Rev.1) In cases in which a party to the proceeding or
Canada (W/42) provide, necessary information within a reasonable period, or significantly impedes provide necessary information within a action, preliminary and final determinations, affirmative or negative, may be made on the basis of evidence presented by the opposing party.

European Communities (W/31)
Republic of Korea (W/48)
[Where a party to a proceeding refuses to
Brazil (W/57)reasonable period or fails to take the necessary steps required to further the proceedings, preliminary and final determinations, affirmative or negative, may be made on the basis of evidence previously presented.]

Japan (W/43)

(10) AVOIDANCE OF BARRIERS TO LEGITIMATE TRADECorresponding Provisions of Existing International Treaties
India (W/40) Canada (W/42)
Australia (W/53)
in circumstances where IPR holders have not
Hong Kong (W/54)

United States (W/14/Rev.1)
Safeguards against arbitrary action or abuse of procedures must be included.
Signatories shall ensure that procedures to enforce IPRs minimize interference with legitimate trade.
Parties shall make remedies available to provide indemnification in appropriate cases of persons wrongfully enjoined or restrained.
See also A(4), (11), (12) and (14), B(3)(b) and (c), and C(5).
See B(3)(d) below.
legitimate trade. In particular, any alleged
Appropriate safeguards should be provided for persons who have been subjected to abuse or wrongful use of enforcement measures. Such measures may include:
- provisions for adequate compensation of any injury suffered because of an abuse or wrongful use of enforcement measures;
- provisions for IPR holders to compensate importers for goods wrongfully detained at their request;
- provisions allowing release of detained goods
taken timely appropriate steps to have a decision taken by the appropriate authorities on the merits of the case.
See also A(4), (11) and (12), B(3)(b) and (c), and C(1).
Procedures and remedies applied by a signatory for the purpose of enforcing IPRs should not constitute a means of arbitrary, unjustifiable or disguised restriction on international trade.
See also A(4), (11), (12) and (14), B(3)(b) and (c), and (6), and (C)(2) and (4).

European Communities (W/31)
Procedures and remedies applied by a signatory for the purpose of enforcing IPRs shall not constitute a means of arbitrary or unjustifiable discrimination between nationals of other signatories, or a disguised restriction to international trade.
Signatories shall provide for safeguards against the abuse of enforcement procedures and for compensation of the injury suffered by a party which has been subject to such abuse.
See also A(4) and (11), (12) and (14), B(3)(b), (c) and (d), and (6), and C(2), (4) and (5).
Republic of Korea (W/48)
[Enforcement procedures should be implemented in a manner to minimize interference with include the following:infringement or other violation of an IPR relating to the importation of goods or services originating in the territory of another party should be adjudicated through proceedings no less favourable than those applicable to goods or services in the domestic territory.
Complainants in actions where imported goods are concerned should not have the option to initiate proceedings in judicial or administrative forums if comparable options do not exist for complainants in disputes involving domestically produced goods and services.] Brazil (W/57) See also A(11) and A(12) below.
Nordics (W/58)
trade interests and trade distortions.

Japan (W/43) Parties shall be entitled to claim compensation of the damage caused by an abuse of enforcement procedures.Signatories may provide for that where a government official, while discharging an official duty of the State, causes damage in the course of enforcement procedures related to the IPR protection, the State may be held liable for the compensation.See also A(4), (11), (12) and (14), B(3)(b), (c) and (d) and C(2), (4), (5) and (6).
Measures to prohibit the indemnification procedures which themselves can become barriers to any legitimate trade should - limitations on the settlement period;- requirements that the complainant place money on deposit; - requirements providing sufficient compensation when defendants are acquitted;- provisions for the defendant to appeal judgements.
See also A(4) and C(5) below. Border measures should not be used in a way to constitute barriers to prejudice legitimate trade. Local authorities may request the fulfilment of certain requisites in order to prevent abusive recourse to such measures. It is recognized that the undue or abusive use of IPRs may damage legitimate See also A(11) and (12) and C(3)(a).

(11) NATIONAL TREATMENT

Corresponding Provisions of ExistingInternational Treaties The Paris Convention obliges each of its member States to grant to nationals of the other member States, as well as nationals of non-member States who are domiciled or who have real and effective industrial or commercial establishments in the territory of one of the other member States, the same legal remedies for infringement of industrial property rights as those it grants to its own nationals, possibly subject to the provisions of national law relating to judicial and administrative procedure and to jurisdiction (Articles 2 and 3). Australia (W/53)Provisions requiring contracting parties to grant national treatment to nationals of other contracting parties (and certain other persons) are also contained in the Berne Convention (Articles 3 to 5), Universal Copyright Convention (Article II), Rome Convention (Articles 2, 4, 5 and 6) and Treaty on Intellectual Property in Respect of Integrated Circuits (Article 5). The latter Treaty allows for an exception as far as any obligations to appoint an agent or to designate an address for service are concerned or as far as the special rules applicable to foreigners in court proceedings are concerned.

The General Agreement requires that the products of the territory of any contracting party imported into the territory of any other contracting party shall be accorded treatment no less favourable than that accorded to like products of national origin in respect of all laws, regulations and requirements affecting their internal sale, offering for sale, purchase, transportation, distribution or use (Article III:4). However, a general exception allows any contracting party to adopt or enforce measures necessary to secure compliance with laws or regulations which are not inconsistent with the provisions of the General Agreement, including those related to the protection of patents, trademarks and copyrights, and the prevention of deceptive practices, subject to the requirements that such measures are not supplied in a manner which would constitute a means of arbitrary or unjustifiable discrimination between countries where the same conditions prevail or a disguised restriction on trade (Article XX(d)).

United States (W/14/Rev.1)The complex question of national treatment will need to be addressed.

See also A(4) above.

India (W/40)

The procedures for internal enforcement shall provide for national treatment to foreign owners of IPRs. Enforcement obligations should embody the GATT principle of national treatment, which should oblige signatories to give persons of other signatories and/or their products treatment no less favourable than that granted to their own persons and/or their products in like circumstances in terms of laws, regulations and administrative practices.

Hong Kong (W/54)

Procedures and remedies provided by a signatory for enforceing IPRs relating to persons, goods and services of all other signatories should be no less favourable than those provided to its own persons, goods or services.

European Communities (W/49)The provision on national treatment in the agreement on TRIPS should provide that the protection of IPRs of foreigners be no less favourable than that provided to nationals. It should apply, inter alia, with regard to the procedures and remedies, laid down in the agreement, concerning the enforcement of IPRs.

Republic of Korea (W/48)

See A(4) above.

Brazil (W/57)

The application of border measures should observe the principles of national treatment.

Nordics (W/58)

Protection and enforcement of IPRs covered by the agreement should be equivalent in effect irrespective of whether the right holder is a national or from another signatory and irrespective of whether the goods or services concerned are domestically produced or imported. Certain exceptions will be needed relating to e.g. jurisdiction and appointment of an agent.

Japan (W/43) It is important that the national treatment principle be applied also to the enforcement of IPRs. Canada (W/42)Procedures and remedies for enforcing IPRs provided to persons, goods and services of all other parties should be no less favourable than those provided to its own persons, goods or services, i.e. national treatment. [Signatories should provide procedures and remedies for enforcing IPRs to persons, goods or services of the other signatories, no less favourable than those accorded to its own persons, goods or services.]

(12) MOST-FAVOURED-NATION TREATMENT/NON-DISCRIMINATIONCorresponding Provisions of Existing International Treaties

The General Agreement requires that with respect to all rules and formalities in connection with importation

United States (W/14/Rev.1)

This complex question will need to be addressed.

India (W/40)

Australia (W/53)

Enforcement obligations should embody the GATT

European Communities (W/49)

Signatories should not protect or enforce IPRs in a manner which could constitute a means of arbitrary or unjustifiable discrimination between nationals of other signatories, or a disguised restriction to international

Japan (W/43) It is important that this principle be applied also to the enforcement of IPRs.

Republic of Korea (W/48) Nordics (W/58)

Signatories would be obliged to extend to all nationals, goods and services of other signatories any benefits accorded to nationals, goods and services of any other

and exportation, and with respect to all matters referred to in paragraphs 2 and 4 of Article III, any advantage, favour, privilege or immunity granted by any contracting party to any product originating in or destined for any other country shall be accorded immediately and unconditionally to the like product originating in or destined for the territories of all other contracting parties (Article I:1). However, a general exception allows any contracting party to adopt or enforce measures necessary to secure compliance with laws or regulations which are not inconsistent with the provisions of the General Agreement, including those related to the protection of patents, trademarks and copyrights, and the prevention of deceptive practices, subject to the requirement that such measures are not applied in a manner which would constitute a means of arbitrary or unjustifiable discrimination between countries where the same conditions prevail or a disguised restriction on trade (Article XX(d)).

principle of non-discrimination/mfn, which should oblige signatories to accord to persons of other signatories any advantage relating to the enforcement of IPRs granted to the persons of any other country. The agreement should specify non-discrimination as either prospective or retrospective from its entry into force, and the agreed option should apply to all signatories and all IPRs covered by the agreement. Provision may need to be made for certain well-defined exceptions to the mfn principle to be specified in the agreement.

Hong Kong (W/54)

Procedures and remedies provided by a signatory for enforcing IPRs relating to persons, goods or services of another signatory should be equally applicable to persons, goods or services of all other signatories.

trade, or which could nullify or impair benefits resulting from the TRIPS agreement.

Canada (W/42)

Procedures and remedies for enforcing IPRs provided to persons, goods or services of one signatory to a TRIPS agreement, should be equally applicable to the persons, goods or services of any other signatory to the agreement, i.e. unconditional mfn/non-discriminatory treatment.

[Signatories should provide procedures and remedies for enforcing IPRs to persons, goods or services of all other parties, equally applicable to the persons, goods or services of any party.]

Brazil (W/57)

The application of border measures should observe the principle of non-discrimination.

country as regards the specific commitments made in the agreement. Certain exceptions will be needed for bilateral or other international arrangements on legal co-operation. Arbitrary or unjustifiable discrimination between nationals, goods and services of other signatories would not be allowed.

(13) REMEDIES AND SANCTIONS

Corresponding Provisions of Existing International Treaties

See A(1) above.

provide procedures to enforce rights against infringements.

in appropriate cases the user of an infringing

India (W/40)

include administrative and civil remedies and, effectively stop or prevent the infringement

Australia (W/53)

United States (W/14/Rev.1)

Enforcement measures and sanctions must effectively deter infringing activity. Thus, signatories should undertake obligations to compensation of the injury caused by the entities engaged in infringing activities and to provide appropriate remedies. In appropriate cases, this must include criminal sanctions.

Hong Kong (W/54)Sanctions and remedies shall be available against the producer, seller, distributor and

Canada (W/42) good or service. Remedies against signatories, however, may be limited to payment of compensation to the owner of the IPR.

Criminal sanctions and penalties for trademark

Relief resulting from internal procedures shall also need to be provided for. in appropriate cases, penalties under criminal law. Nordics (W/58)

compensation for the injury caused by the

See B(4) and B(5) below.

European Communities (W/31)

Signatories shall provide for remedies which effectively stop or prevent the infringement of IPRs, entitle the right holder to claim

Republic of Korea (W/48)infringement, and which consist of other measures which, while corresponding to the importance of the infringement in question, constitute an effective deterrent to further

remedies and sanctions that stop or prevent the

There should be judicial and/or administrative civil remedies which effectively stop or prevent the infringement of IPRs, and entitle the rights holders to claim compensation for the injury caused by the infringement. import or export of such goods.counterfeiting and copyright piracy if committed wilfully and for commercial purposes

Brazil (W/57)

[Signatories should provide for remedies whichof IPRs, and entitle the right holder to See B(4) and B(5) below.infringement. In appropriate cases, damages should be available to deprive the infringer of any profit and to deter further infringement. Signatories should provide criminal remedies at least for trademark counterfeiting and copyright piracy if done in a wilful and commercial manner.]

Japan (W/43) See B(4), B(5) and C(8) below. See B(4) and B(5) below. Signatories should provide for effective infringement of IPRs, and entitle the right holder to compensation for injury suffered by infringement. Signatories should provide criminal sanctions against wilful trademark counterfeiting and copyright piracy committed for commercial purposes, including the wilful

(14) RIGHT OF JUDICIAL REVIEW/APPEALCorresponding Provisions of Existing International Treaties
arising in connection with the obtaining,
Canada (W/42)
India (W/40)
Hong Kong (W/54)
decisions on the merits of a case. A court of entitled to review issues of rationality and

United States (W/14/Rev.1)
Signatories shall provide the right of judicial review of initial judicial decisions on the merits of a case and final administrative decisions on the merits of a case in disputes
maintaining or enforcing of IPRs. See A(10) above.
[Signatories should provide the right of
Internal enforcement procedures shall provide for appeal against the initial judicial order and for judicial review of administrative orders.
entitled to review issues of procedural
Signatories should provide for a means of appeal against judicial or administrative
Australia (W/53)appeal should be entitled to consider and review all legal issues raised before or considered by the court of first instance or administrative body, and should also be Brazil (W/57)procedural fairness.

European Communities (W/31)
Final administrative decisions on the merits of a case concerning the protection of an IPR shall be subject to the right of appeal in a court of law.
Republic of Korea (W/48)
appeal to a court of law of initial judicial decisions on the merits of a case and final administrative decisions on the merits of a case. The court of appeal should be entitled to consider and review all legal issues raised before or considered by the previous court or administrative tribunal and should also be fairness.]

See A(4) above.

Japan (W/43) Final administrative disposition shall be subject to the right of judicial review. Nordics (W/58)See A(4) above.

B. INTERNAL MEASURES(1)
COVERAGECorresponding Provisions of Existing International Treaties
The enforcement provisions of the Paris Convention concern goods unlawfully bearing a trademark or trade name or in connection with which a false indication of the source of the goods or the identity of the producer, manufacturer or merchant has been directly or indirectly used. Remedies are provided for applying within the country as well as on importation. Goods in transit are specifically excluded from any obligation to effect seizure (Articles 9, 10 and 10ter). Acts of unfair competition are also covered byenforcement provisions of the Paris Convention(Articles 10bis and 10ter).infringement of any other IPR, in particular The Madrid Areement (Indications of Source) concerns goods having a false or deceptive indication by which one of the member States, or a place situated therein, is directly or indirectly indicated as being the country or place of origin. Remedies are provided for applying within the country as well as on importation; goods in transit are excluded from any obligation to effect seizure (Articles 1 and 2).
The Berne Convention provisions on enforcement concern the seizure of infringing copies of protected works. The remedy provided for applies in the country, in respect of infringing copies both produced in the country and imported (including from countries where the work is not protected or has ceased to be protected) (Article 16). Musical recordings made under a compulsory licence granted by a member State are liable to seizure if imported without permission into another member State (Article 13(3)).

United States (W/14/Rev.1)
Civil procedures to enforce IPRs should apply at the point of production and commercial transactions, e.g., point of sale, offer for sale, lease, distribution, etc. as well as at the border
Criminal procedures shall be available for at least trademark counterfeiting and copyright infringement which are wilful and commercial.
India (W/40)
IPR infringements generally.
Republic of Korea (W/48) Enforcement internally.
Australia (W/53)
Appropriate judicial and/or administrative civil remedies should be provided to stop or prevent the infringement of IPRs and to deter further infringement.
Criminal sanctions and penalties, in addition to civil remedies, should be provided in cases of deliberate trademark counterfeiting and copyright piracy on a commercial scale.
Nordics (W/58)
The provisions on enforcement should cover those IPRs which are included in the agreement.

European Communities (W/31)
Signatories shall provide for civil judicial procedures concerning the enforcement of any IPR internally and with regard to imports and exports.
Signatories may provide for administrative procedures concerning the enforcement of IPRs.
Signatories shall provide for criminal procedures and penalties to be applied in cases of wilful infringements of trademarks and copyright on a commercial scale.
Signatories may provide for criminal procedures and penalties to be applied in cases of where it is committed wilfully and on a commercial scale.
Canada (W/42)
See A(1) and A(13) above.
Hong Kong (W/54)
Signatories should provide for civil judicial procedures concerning the enforcement of any IPR internally and with regard to import and export, but without obligation to include goods in transit. Signatories may provide for administrative procedures concerning the enforcement of IPRs.

Japan(W/43) Infringements of patents, trademarks, designs, copyright, neighbouring rights and semi-conductor integrated circuits layout rights. Acts of infringement of these rights shall constitute criminal acts. Civil judicial procedures shall be provided for the internal enforcement of rights and with regard to imports.Signatories may establish administrative procedures for the enforcement of IPRs. Production of, and trade in products, infringing IPRs.
Brazil (W/57)Brazil, while holding the view that the sovereign right of States to organize their respective domestic legal systems should be represented, considers that the subject of negotiations on enforcement should be situations where international commercial operations involve, in a relevant manner, aspects of intellectual property rights as, for example, the case of trade operations subject to disputes for reasons of intellectual property.Internal enforcement of intellectual property rights is a matter of strict competence of domestic legislations. Legal situations involving in a predominant way IPRs should be dealt with by national laws and international agreements, where applicable.

(2) STANDING TO INITIATE PROCEDURESCorresponding Provisions of Existing International Treaties

Article 9 of the Paris Convention states that seizure of goods unlawfully bearing a trademark or trade name shall take place at the request of the public prosecutor, or any other competent authority, or any interested party, whether a natural person or a legal entity, in conformity with the domestic legislation of each country. Article 10, which applies the provisions of Article 9 to false indications of source, states that any producer, manufacturer, or merchant, whether a natural person or a legal entity, engaged in the production or manufacture of or trade in such goods and established either in the locality falsely indicated as the source, or in the region where such locality is situated, or in the country falsely indicated, or in the country where the false indication of source is used, shall in any case be deemed an interested party.

Article 10ter obliges member States to provide measures to permit federations and associations representing interested industrialists, producers, or merchants, provided that the existence of such federations and associations is not contrary to the laws of their countries, to take action in the courts or before the administrative authorities, with a view to the repression of the acts referred to in Articles 9 and 10, and also acts of unfair competition referred to in Article 10bis, in so far as the law of the country in which protection is claimed allows such action by federations and associations of that country.

The Berne Convention establishes a presumption of authorship; the author must, in the absence of proof to the contrary, be regarded as such, and consequently be entitled to institute infringement proceedings in the countries of the Union, if his name appears on the work in a usual manner; film producers whose names appear on films enjoy a similar presumption (Article 15).

Under the Lisbon Agreement, legal action required for ensuring the protection of appellations of origin may be taken in each of the member States under the provisions of the national legislation either at the instance of the competent Office or at the request of the public prosecutor, or by any interested party, whether a natural person or a legal entity, whether public or private (Article 8).

For Madrid Agreement (Indications of Source), see Section C(3) below.

United States (W/14/Rev.1)

Procedures must be available to owners of IPRs and other persons authorized by the owner and having legal standing to determine the validity and enforceability of IPRs for the assertion of such rights against any legal or juridical person or governmental entity.

Governments should initiate procedures ex officio where effective enforcement requires such action.

India (W/40)

Seeking recourse to the remedies that may be available under the national law is primarily the responsibility of the owner of IPRs. It is for him to set in motion the enforcement machinery and this responsibility cannot be shifted to the government.

Australia (W/53)

Procedures should be available to IPR holders (and any other person duly authorized by such holders) to initiate judicial and/or administrative civil proceedings.

European Communities (W/31)

Right holders. The term "right holder" means the right holder himself, any other person authorized by him or persons having legal standing under national law to assert such rights.

Canada (W/42)

[Procedures should be available to owners of IPRs and to any other person duly authorized by such owner to exercise and enforce such rights.]

Hong Kong (W/54)

Procedures should be available to the right holder of IPRs.

"Right holder" in this paper means the right holder himself, or any other person having legal standing under the national law of the participant country to assert such rights.

Brazil (W/57)

Japan (W/43) IPR holders.

Republic of Korea (W/48)See A(6) above.

Nordics (W/58)

(3) PROVISIONAL MEASURES (contd.) (b) GENERAL CONDITIONSCorresponding Provisions of Existing International Treaties

For Madrid Agreement (Indications of Source), see Section C below.

where, notwithstanding a request by the

India (W/40)

Australia (W/53)

Nordics (W/58)

To prevent abuse, the plaintiff should be unjustified.

defendant should be given the possibility to

United States (W/14/Rev.1)

In order to prevent abuse of interim procedures, signatories may require a rights owner to provide security up to an amount sufficient to hold the authorities and importer harmless from loss or damage resulting from detention where the goods are subsequently determined not to be infringing. However, such securities shall not unreasonably deter recourse to such procedures. Canada (W/42)

on the merits of the case are not initiated unless determined otherwise by the court.

Provisional measures should be revoked or lapsed if proceedings are not commenced within a reasonable time.

Republic of Korea (W/48)required to furnish both evidence with regard to the infringement and adequate security for compensation to the defendant in case the provisional measure turns out to be Hong Kong (W/54)

If a provisional measure is taken by an authority other than a judicial authority, the the right holder and that his right is being have the provisional measure submitted to judicial review.

A decision allowing for a provisional measure should specify the period of duration of the measure. The measures should lapse if within the expiry of such a period the plaintiff has not obtained a prolongation or has not initiated or fulfilled legal proceedings.

European Communities (W/31)

The applicant shall be required either to provide any reasonably available evidence so as to permit the authority to establish with a sufficient degree of certainty that he is the right holder and that his right is being infringed or that such infringement is imminent, or to provide security sufficient to prevent abuse. Provisional measures shall be revoked or lapse defendant, proceedings leading to a decision [The applicant should be required to provide within a period of one month after the notification of the provisional measures, sufficient degree of certainty that he is the Where provisional measures are to be carried out by customs authorities, the applicant may be required to supply any other information necessary for the identification of the goods concerned.lapse where, notwithstanding a request by the

on the merits of the case are not commenced

See A(6) and A(10) above.

applicant does not pursue a decision on the

The applicant should be required to act in good faith and to provide evidence that he is Brazil (W/57)infringed. The applicant should be required to provide adequate security. Provisional measures should be revoked or lapse where the applicant does not pursue a decision on the merits in an expeditious manner.

Japan (W/43) The applicant shall provide reasons established to a sufficient degree of certainty when requesting such measures.Signatories may provide that the applicant furnish sufficient security in place of providing reasons established to a sufficient degree of certainty.any reasonably available evidence so as to permit the authority to establish with a right holder or other authorized person and that there is an arguable case that his right is being infringed. The applicant may be required to provide security to prevent abuse.Provisional measures should be revoked or defendant, proceedings leading to a decision within a reasonable period of time.Signatories may also provide that provisional measures may be revoked or lapse where the merits in an expeditious manner.]

(3) PROVISIONAL MEASURES (contd.) (c) ADDITIONAL CONDITIONS ON EX PARTE PROCEEDINGSCorresponding Provisions of Existing International Treaties
India (W/40)
Australia (W/53)
result of an ex parte proceeding, a hearing of
Brazil (W/57)Nordics (W/58)
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United States (W/14/Rev.1)
Parties shall be provided subsequent notice of the action and the right to participate in an administrative or judicial procedure providing due process of law.
revoked or confirmed.
Canada (W/42)
If provisional measures are in place as a ex parte, an oral hearing should take place all parties should be held as soon as possible for the purpose of deciding whether to confirm, modify or revoke the provisional measures.
confirmed.
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European Communities (W/31)
Where provisional measures are adopted inaudita altera parte, an oral hearing shall take place upon request of the defendant within a reasonable period after the notification of the measures, with a view to deciding whether these measures shall be the decision or dispostion in question.
Republic of Korea (W/48)
[Where provisional measures are adopted
Hong Kong (W/54) upon the request of the defendant within a reasonable period after the notification of the measures to decide whether the measures should be revoked, modified, or confirmed.]
those measures should be revoked, modified or
If a provisional measure has been taken inaudita altera parte, the defendant should be given the right to full review.

Japan (W/43) Where provisional measures are adopted without prior notice to the adversary, the decision or the disposition adopted shall be notified to the adversary and he shall be given, upon request, an occasion to be heard so as to decide whether to revoke or confirm If provisional measures are available ex parte, signatories should provide that a hearing take place within a reasonable period after the notification of the measures, to decide whether

(3) PROVISIONAL MEASURES (contd.) (d) INDEMNIFICATION OF DEFENDANT AND OTHERSCorresponding Provisions of ExistingInternational Treaties
India (W/40)
to be wrong.Republic of Korea (W/48)
Australia (W/53)
such abuse. In appropriate cases, contracting
Hong Kong (W/54)
Brazil (W/57)
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United States (W/14/Rev.1)
See A(10) above.
found that there has been no infringement or
Compensation should be provided to persons suffering damage from provisional orders based on the assumption that they were infringing IPRs, if the assumption is subsequently found
Canada (W/42)
safeguards against the abuse of enforcement
See A(10) above. Nordics (W/58)
parties wrongfully enjoined or restrained.]
See B(6) below.
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European Communities (W/31)
Where the provisional measures are revoked or where they lapse due to any action or omission by the applicant or where it is subsequently infringement shall be entitled to claim threat of infringement of an IPR, the defendant shall be entitled to claim from the applicant adequate compensation of any injury caused by these measures.
[Contracting parties should provide for See A(10) above. procedures and for compensation of the injury suffered by a party which has been subject to parties should provide for indemnification of See B(3)(b) above.

Japan (W/43) Parties who have not infringed any IPR but nonetheless have been the subject of provisional measures on the false ground of compensation for the damage caused by such measures. Participants shall provide for the provision of security with a view to compensating such a damage.

(4) CIVIL REMEDIES FOR INFRINGEMENT (a) GENERALCorresponding Provisions of ExistingInternational Treaties
India (W/40)
Australia (W/53)Republic of Korea (W/48)
Nordics (W/58)Brazil (W/57)
(b) INJUNCTIONS
Corresponding Provisions of ExistingInternational Treaties
India (W/40)defendant has acted with intent or negligence,
Australia (W/53)
occurring or continuing.
Brazil (W/57)
Hong Kong (W/54)

United States (W/14/Rev.1)
See A(13) above.
Canada (W/42)
See A(13) above.
Hong Kong (W/54)Appropriate judicial and/or administrative civil remedies should be provided to IPR holders in order to effectively stop or prevent the infringement of their IPRs, and to deter further infringement.
United States (W/14/Rev.1)
Final injunctions must be available.
upon request and irrespective of whether the
Republic of Korea (W/48)
refrained from or discontinued.
Injunctions to prevent infringement from
Canada (W/42)
infringement of an IPR.

European Communities (W/31)
See A(13) above.
to the type of the right and the seriousness
See A(13) above.
In addition to the remedies below, signatories should provide the IPR holder with the power to restrain commercial dealing in infringing goods, including import or export.

European Communities (W/31)
Where the judicial authorities are satisfied that an infringement of an IPR has been or is about to be committed they shall be entitled, to issue an order that the infringement be Orders to cease infringing activities.
Nordics (W/58)
[Final injunctions should be available.]with the authority to issue an order for the
Final injunctions.

Japan (W/43) IPR holders shall be provided with at least the following civil judicial remedies. Remedies shall be adequately ensured according of the infringement in question. Administrative procedures shall be subject to equivalent principles.In addition to the civil remedies referred to below, measures for recovery of goodwill shall be included. Japan (W/17 and 43) Stopping or preventing of the infringement of IPRs. The judicial authorities should be provided discontinuation of an act involving

(4) CIVIL REMEDIES FOR INFRINGEMENT

(contd.) (c) SEIZURE, FORFEITURE, DESTRUCTIONCorresponding Provisions of ExistingInternational Treaties

Articles 9 and 10 of the Paris Convention provide for remedies in respect of goods unlawfully bearing trademarks or trade names or in connection with which a false indicationof source has been directly or indirectly used. Certain of these remedies concern action at the border; for details see Section C (8) below. Other remedies concern action in the country. The goods in question must be seized in the country, whether it is the country in which the unlawful affixation took place or country into which the goods have been imported. If the country's legislation does not permit such seizure, then, until such time as the legislation is modified accordingly, these measures shall be replaced by the actions and remedies available in such cases to nationals under the law of that country.

The Madrid Agreement (Indications of Source) contains a similar hierarchy of remedies, with the additional requirement that, in the absence of special sanctions ensuring the prevention of false or misleading indications of source, the sanctions provided by the corresponding stipulations of the laws relating to trademarks or trade names shall be applicable (Article 1).

The remedy provided for in the Berne Convention is liability to seizure (Articles 13(3) and 16).

United States (W/14/Rev.1)

Remedies for infringement of IPRs shall include seizure, forfeiture, destruction, and removal from commercial channels of infringing goods, or other effective action as may be appropriate.

India (W/40)

Canada (W/42)

[Remedies for the infringement of IPRs should include the possibility of seizure, forfeiture, destruction and removal from commercial channels of infringing goods. Remedies should also include the possibility of seizure, forfeiture or destruction of any device specifically used for the production of infringing goods.]

Australia (W/53)

Seizure, forfeiture and in approriate cases destruction of infringing goods.

Brazil (W/57)

European Communities (W/31)

Where an IPR has been found to be infringed, the right holder can, in accordance with the relevant provisions of national law and where this would not be out of proportion to the infringement in question, for example in cases of deliberate and flagrant infringements of an IPR, request that the infringing goods, including materials and implements predominantly used in their creation, be, without compensation of any sort, forfeited, and destroyed or disposed of outside the channels of commerce in such a manner as to minimize any harm caused to him, or that, as applicable, any other measures be taken having the effect of effectively depriving those responsible for the infringement of the economic benefits of their activity and constituting an effective deterrent to further activities of the same kind.

Hong Kong (W/54)

The possibility of seizure, forfeiture or destruction of infringing goods.

Japan (W/43) Remedies to stop or prevent the infringement of IPRs shall include such measures as destruction of things which have constituted the infringement and removal of facilities which were used for the infringement.

Republic of Korea (W/48) Nordics (W/58)The judicial authorities should be provided with the authority to issue an order for forfeiture and destruction of infringing goods when deemed necessary.

(4) CIVIL REMEDIES FOR INFRINGEMENT (contd.) (d) DAMAGES AND RECOVERY OF COSTSCorresponding Provisions of ExistingInternational Treaties
India (W/40)
Canada (W/42)
involving counterfeiting or piracy or
previously held on the merits to infringe an
Australia (W/53)
Brazil (W/57)

United States (W/14/Rev.1)
Monetary awards adequate to compensate fully owners of IPRs must be available. In appropriate cases, this should include provision of statutory damages.
particular, consist of the restitution as far
in appropriate cases of the profits resulting
[In addition to the damages provided in A(13), right holders should be entitled to recover costs reasonably incurred in the proceedings
proceedings where the relevant good has been
Hong Kong (W/54) IPR.]
Appropriate and adequate compensation, including damages or an account of profits.

European Communities (W/31)
The right holder shall be entitled to obtain from the infringer adequate compensation of the injury he has suffered because of a deliberate or negligent infringement of his IPR and to recover the costs reasonably incurred in the proceedings. The compensation may, in the rights, as the amount of such damage.as possible of the situation as it existed prior to the infringement and of the recovery
Republic of Korea (W/48)from the infringement. In appropriate cases recovery of profits may be granted even where the infringer has not acted intentionally or negligently. Nordics (W/58)
In cases of infringement the right holder
Damages to compensate the right holder for any injury caused by infringing activity. should be given to the right holder.The possibility of an account for profits made from infringing activity.
The possibility of recovery of costs reasonably incurred in the course of proceedings.

Japan (W/43) Signatories may provide for provisions in which the amount of profit gained by the infringer shall be presumed to be the amount of damage sustained by the right holder, or in which the right holder may claim the amount of money normally obtainable for the working of Damage claims. should be entitled to remuneration for the exploitation. In cases of wilful or negligent infringement adequate compensation

(5) CRIMINAL SANCTIONSCorresponding provisions of existinginternational treaties
Canada (W/42) India (W/40)
Republic of Korea (W/48)
implements used for their production, and include the possibility of imprisonment and
Australia (W/53)
copyright piracy on a commercial scale.
MTN.GNG/NG11/W/33/Rev.2Page 60

United States (W/14/Rev.1)
Criminal remedies shall include seizure of infringing goods, materials and implements used in their creation, and forfeiture of such articles, imprisonment, and monetary fines.
establish provisions for criminal sanctions,
See A(1) above.
counterfeit and priated goods and any plate,
Criminal sanctions include the following:
- seizure of infringing goods, materials and
Hong Kong (W/54) forfeiture of such articles;
- imprisonment of and monetary fines imposed upon the infringer. Nordics (W/58)
possibility of seizure and forfeiture of
Criminal sanctions and penalties, in addition to civil remedies, should be provided in cases of deliberate trademark counterfeiting and Brazil (W/57)

European Communities (W/31)
Such remedies shall include imprisonment and monetary fines sufficient to provide an effective deterrent.
including imprisonment or fine, against such [Criminal remedies with respect to counterfeit and pirated goods should include imprisonment and monetary fines.
They should also include the possibility of seizure and forfeiture of third party, such provision shall provide for cast, mold or similar device used in their creation.]
act, goods arising from or acquired by such
Signatories should provide criminal sanctions in respect of counterfeiting or wilful acts of commercial copyright piracy, which should monetary fines. There should be the In cases of wilful infringement IPRs counterfeit and pirated goods and any device specifically used for their production.

Japan (W/43) Signatories shall regard the act of the infringement of patents, trademarks, designs, copyright, neighbouring rights, semi-conductor integrated circuit layout right as constituting criminal act and shall act. Where deemed necessary and so long as it does not infringe the legitimate interest of a a confiscation of goods which have constituted a criminal act infringing intellectual property rights, goods which were used or intended to be used for such an an act or goods acquired as a reward of such an act. criminal procedures and sanctions should apply.

C. SPECIAL REQUIREMENTS RELATED TO BORDER MEASURES(1)

GENERAL REQUIREMENTCorresponding Provisions of ExistingInternational Treaties

procedures to enforce IPRs against imported release into free circulation of such goods.

India (W/40)

Canada (W/42) Australia (W/53)

provided by this section. Signatories may

United States (W/14/Rev.1)

Signatories shall provide means to initiate according to which a right holder, who has infringing goods before they are released from the jurisdiction of the customs authorities. It is left to each signatory to determine if the means are judicial or administrative in nature.

Hong Kong (W/54)

For members of a customs union, the term

(See proposal on trade in counterfeit goods (MTN.GNG/NG11/W/41).)

There should be interim procedures: (a) to allow the courts to direct customs authorities to detain counterfeit or pirated goods, or (b) to allow interim detention by customs of such items, subject to appropriate safeguards. Such measures should not be applied in a manner which would constitute a disguised restriction on international trade.

[Signatories should provide for interim judicial measures to allow the courts to direct customs authorities to detain counterfeit or pirated goods or they should provide for interim detention by customs as

Brazil (W/57)also provide for the detention or prohibition of other types of infringing goods.

Any procedure to allow customs authorities to detain or prohibit any type of infringing good without a court order should conform to the rules set out in this section.

Where signatories allow the right holder to initiate detention, they should establish procedures according to which a right holder may lodge an application in writing with competent authorities for the suspension by the customs of the release into free circulation of suspected counterfeit or pirated goods.]

European Communities (W/31)

Signatories shall establish procedures

Republic of Korea (W/48)valid grounds for suspecting that the importation of counterfeit goods is contemplated, may lodge an application in writing with the competent authorities for the suspension by the customs authorities of the

Signatories should provide administrative "border" is understood to apply to their border to countries or areas which are not part of the union, and the term "territory" is understood as the customs territory of the union.

Nordics (W/58)

Judicial and/or administrative procedures should be available for an intellectual property right holder to initiate action for competent authorities to detain counterfeit and pirated goods imported on a commercial scale and prima facie infringing the right holder's trademark or copyright. Such procedures should be subject to appropriate safeguards to ensure that such action does not constitute an impediment to legitimate trade or an abuse of enforcement measures.

Border measures for the enforcement of IPRs should be made available for the interested parties in cases where alleged infringement or abusive use of rights cause damage to their trade interests or create distortions to international trade.

Japan (W/43/Add.1) Enforcement procedures should be made available at the border. procedures for customs authorities to detain or prohibit counterfeit or pirated goods at the instigation of the right holder.Border measures should be seen as a specific form of provisional measures. Accordingly, the Nordic position on provisional measures as outlined above also applies to border measures. Signatories should be obliged to provide for and maintain procedures whereby a right holder can apply to a competent authority to have the customs authorities suspend customs clearance of imported counterfeit or pirated goods.See B(3)(a) above.

(2) COVERAGE (a) OF IPRS Corresponding Provisions of ExistingInternational Treaties
Paris Convention: Goods unlawfully bearing protected trademarks or trade names or in connection with which a false indication of the source of the goods or the identity of the producer, manufacturer or merchant has been directly or indirectly used (Articles 9(1) and 10(1)).
Madrid Agreement (Indications of Source): Goods having a false or deceptive indication by which one of the member States, or a place therein, is directly or indirectly indicated as being the country or place of origin (Article 1).
importation.]
Brazil (W/57)

United States (W/14/Rev.1)
All IPRs.

India (W/40)
Canada (W/42)
[Counterfeit trademark goods and pirated copyright goods.
DefinitionsCOUNTERFEIT GOODS should mean: any goods, including packaging, bearing without authorisation a trademark which is identical to the trademark validly registered in respect of such goods, or which cannot be distinguished in its essential aspects from such a trademark and which thereby infringes the rights of the owner of the trademark in question under the legislation of the country of importation. PIRATED GOODS should mean:any goods which are copies made without the consent of the rights holder or person duly authorised by him in the country of production and which are made directly or indirectly from an article where the making of that copy constitutes an infringement of a copyright under legislation in the country of Australia (W/53)
packaging, bearing without authorisation a
IPRs.

European Communities (W/31)
Counterfeit goods which for the purpose of this section are understood to be those bearing without authorization a trademark which is identical to a trademark validly registered in respect of such goods in or for the signatory in the territory of which the goods are declared for importation, or which cannot be distinguished in its essential aspects from such a trademark. - Signatories may establish procedures concerning any goods which, prima facie, infringe any other IPR. - As the negotiations progress, the Community will, in addition to its present suggestions, wish to examine the possibility of going beyond the proposed minimum requirement for intervention by customs authorities, in particular in order to explore the possibility of introducing a commitment that parties adopt procedures in accordance with which customs authorities could detain goods infringing any IPR. In implementing such a commitment, allowance would be made for differences in national legal systems, including the relationship between courts and customs, as well as differences between IPRs.
See also MTN.GNG/NG11/17, paragraph 62.
infringing other type of IPRs.
Counterfeit goods, meaning any goods, including
Nordics (W/58)trademark which is identical to the trademark validly registered in respect of such goods, or which cannot be distinguished in its essential aspects from such a trademark and which thereby infringes the rights of the owner of the trademark in question under the legislation of the country of importation.
Pirated goods, meaning any goods which are copies made without the consent of the rights holder or person duly authorized by him in the country of production and which are made directly or indirectly from any article where the making of that copy constitutes an infringement of a copyright under legislation in the country of importation.

Japan (W/43/Add.1) To be determined.
Republic of Korea (W/48) Hong Kong (W/54)Counterfeit goods for the purposes of border measures should mean any goods, including packaging, bearing without authorisation a mark which resembles or nearly resembles a registered trade mark as to be calculated to deceive in respect of such goods.
Pirated goods for the purpose of border measures should mean any goods which are copies made without the consent of the right holder or person duly authorised by him in the country of production, and which are made directly or indirectly from an article where the making of that copy constitutes an infringement of copyright under the legislation of the country of importation.As negotiation progresses, it may be necessary to examine the possibility of introducing procedures in accordance with which customes authorities could detain goods Counterfeit or pirated goods.

(2) COVERAGE (contd.) (b) OF ACTS INVOLVING THOSE IPRSCorresponding Provisions of ExistingInternational Treaties The Paris Convention and Madrid Agreement (Indications of Source) provide for the application of measures against importation. Goods in transit are excluded from any obligation to effect seizure.
The Phonograms Convention provides for protection against the importation of duplicates of phonograms made without the consent of the producer if it is done for the purpose of distribution to the public (Article 2).
Importations on a commercial scale and
Hong Kong (W/54)
Brazil (W/57)
international trade.
Nordics (W/58)

United States (W/14/Rev.1) Importation of infringing goods.
Procedures shall also apply to goods in transit provided that they cover goods infringing an IPR of the country through which the goods were being shipped.
India (W/40)
Australia (W/53)
customs authorities of the release of prima facie infringing a right holder's trademark or copyright.
quantities of goods of a non-commercial nature
Where alleged infringement or abusive use of rights causes damage to the trade interests of interested parties or creates distortions to
Canada (W/42)
pirated copyright goods.
Imports.

European Communities (W/31)
Importation of counterfeit goods.
Where goods have been put on the domestic market or the market of a third country with the consent of the right holder, the fact that he has not agreed that the goods are imported or reimported, or that they are imported under conditions other than those agreed by him, shall not be sufficient reason for direct border intervention.
Signatories may provide for corresponding procedures concerning the suspension by the
Republic of Korea (W/48) counterfeit goods destined for exportation from their territory.The provisions shall not apply to small The restricted acts of importation or contained in travellers' personal luggage or sent in small consignments.

[Importation of counterfeit trademark goods or nature, for example, goods in travellers'
For greater certainty, contracting parties may, but are not required to, have border measures for goods that have been put on the domestic market or the market of a third country with the consent of the right holder.
The provisions should not apply to small quantities of goods of a noncommercial nature contained, for example, in travellers' personal luggage.]

Japan (W/43/Add.1)
Importations of goods in respect of which judgement could easily be made as to whether or not they infringe intellectual property rights.The provisions shall not apply to those goods which are considered to serve only for personal usage of the importer and other small quantities of goods of a non-commercial nature recognized as import for non-business purpose.exportation need not necessarily include goods that have been put on to the domestic market of a third country with the consent of the right holder.The provisions should not apply to small quantities of goods of a non-commercial personal luggage. Border measures should not apply to goods in transit.

(3) STANDING TO INITIATE PROCEDURESCorresponding Provisions of ExistingInternational Treaties
For Paris Convention, see Section B (2) above.
Under the Madrid Agreement (Indications of Source), seizure takes place at the instance of the customs authorities, which must immediately inform the interested party, whether an individual person or a legal entity, in order that such party may, if he sodesires, take appropriate steps in connection with the seizure effected as a conservatory measure. However, the public prosecutor or any other competent authority may demand seizure either at the request of the injured party or ex officio; the procedure will then follow its normal course (Article 2(1)).
Brazil (W/57)
Hong Kong (W/54)

United States (W/14/Rev.1)
Owners of IPRs and other persons authorized by the owner and having legal standing.
Seizure of goods at the border by competent authorities may be either ex officio, sua sponte or at the request of the rights holder when the competent authorities are satisfied that imported goods infringe an IPR.
India (W/40)
Australia (W/53)
IPR holders.
the release of goods where they have a
Interested parties.

European Communities (W/31)
Right holders (see B(2) above).
Signatories may require customs authorities to act upon their own initiative and to suspend the release of goods falling under (2) above where they have acquired a sufficient degree of certainty that an IPR is being infringed. In this case, the customs authorities may at any time seek from the right holder any information that may assist them to exercise these powers.
Canada (W/42)
[See above, C(1), re. right holders.
Signatories may require customs authorities to act upon their own initiative and to suspend sufficient degree of certainty that an IPR is being infringed.
Such detention should be subject to the same conditions, mutatis mutandis, as set out in C(5) below.]
Right holders (see B(2) above).

Japan (W/43/Add.1) Right holders of IPRs. Participants may provide for provisions which allow the competent authorities to initiate ex officio procedure for the suspension of importation of goods which is recognised as infringing an intellectual property right, when they have sufficient grounds to believe that such goods infringe IRPs.
Republic of Korea (W/48) Nordics (W/58)Right holders.

(4) REQUIREMENTS FOR INITIATION OF PROCEDURES BY IPR HOLDERS (a) APPLICATION Corresponding Provisions of ExistingInternational Treaties

Articles 9 and 10 of the Paris Convention provide for seizure at the request of an interested party. The Madrid Agreement (Indications of Source), while providing that the public prosecutor or any other competent authority may demand seizure either ex officio or at the request of the injured party, does not provide for seizure to take place at the request of an interested party (Article 2(1)).Brazil (W/57)
use of IPRs, the following should be observed:
interested party in the country where the
country where the infringement or the abusive
in cases where prior or immediate retention of

United States (W/14/Rev.1)
A party initiating the procedures must address himself to an authority which must be designated for this purpose by each signatory.

India (W/40)
See above, C(1), paragraph 1.
In cases where there is infringement or abusive
Australia (W/53)(i) exhaustion of all internal
procedures and measures immediately available to the
Hong Kong (W/54) violation has occurred in order to
obtain recognition of allegedly infringed rights, as well
as possible compensation; (ii) the party allegedly
affected either by the infringement or the abusive use
of IPRs should send prior notification to the relevant
authority of the Nordics (W/58)use has
been produced, in order to enable such competent
authority to take the necessary action for the solution
of the dispute; (iii)
goods by the customs authorities may occur, the
notification to be provided by the interested party
should contain the fullest possible evidence of
infringement or abusive act. Local authorities may
impose additional requirements, in cases where there
is suspicion of creating unjustified obstacle to
legitimate trade.

European Communities (W/31)
A right holder, who has valid grounds for suspecting that the importation of counterfeit goods is contemplated, may lodge an application in writing with the competent authorities.

Canada (W/42)

the requirements of the criteria, decide
applicant of the decision. The competent
A right holder who wishes to initiate seizure by the
customs authorities should make an application.
shall be given sufficient opportunity to
Application by right holder to competent authority.
Republic of Korea (W/48)

Japan (W/43/Add.1) A right holder of an IPR, who suspects that importation of goods infringing the right is being contemplated, may lodge an application in writing with the competent authorities for the suspension of importation of goods.Signatories shall establish and make public in advance, criteria on which acceptance or refusal of the application shall be decided.The competent authorities shall, upon examining whether application form fulfils whether the application in question is accepted or not, and shall inform the authorities shall, in principle, accept all applications which fulfil the requirements of the criteria.In cases where the competent authorities do not accept the application, the applicant defend his cause.

(4) REQUIREMENTS FOR INITIATION OF PROCEDURES BY IPR HOLDERS (contd.) (b) INFORMATION TO BE PROVIDEDCorresponding Provisions of Existing International Treaties

India (W/40)
Canada (W42)
that the applicant is the right holder or duly
act in full knowledge of the facts, and a
authorities. The applicant may also be
Australia (W/53)
Brazil (W/57)

United States (W/14/Rev.1)
The person initiating the procedures shall be required to present adequate evidence of the right to protection in accordance with the relevant laws of the country of importation.
description of the goods to enable them to be
any other information necessary for the
[The application should be accompanied by proof for which the customs authorities are requested authorised person. It should contain all pertinent information available to the applicant to enable the competent authority to Hong Kong
(W/54)sufficiently detailed description of the goods to enable these to be recognised by the customs that the applicant is the right holder. It required to supply any other information available to him necessary for the identification of the goods concerned.]
recognised.
See C(4)(a) above.

European Communities (W/31)
The application must be accompanied by proof that the applicant is the right holder. It must contain all pertinent information available to the applicant to enable the competent authority to act in full knowledge of the facts, and a sufficiently detailed action, and sufficiently detailed explanation recognized by the customs authorities. The applicant may also be required to supply actually infringing an IPR.identification of the goods concerned. The application must specify the length of period
Republic of Korea (W/48)to take action.
claiming an infringement of the rights.
The application must be accompanied by proof
Nordics (W/58)should contain all pertinent
information available to the applicant to enable the customs authorities to act with full knowledge of the facts, and a sufficiently detailed description of the goods to enable them to be

Japan (W/43/Add.1) The applicant shall at least be required to provide in its application form material which gives valid grounds to judge that the applicant is the genuine right holder, specific length of period during which the competent authorities are requested to take which enables the competent authorities to judge whether the goods in question are Holders of IPRs are responsible for submitting evidence when they file a lawsuit See B(3)(b) above.

(4) REQUIREMENTS FOR INITIATION OF PROCEDURES BY IPR HOLDERS (contd.) (c) PROVISION OF SECURITYCorresponding Provisions of ExistingInternational Treaties

securities shall not unreasonably deter

India (W/40)

United States (W/14/Rev.1)

In order to prevent abuse of border enforcement measures, signatories may require a rights owner to provide security up to an amount sufficient to hold the authorities and importer harmless from loss or damage resulting from detention where the goods are subsequently determined not to be infringing. However, such

Canada (W/42) recourse to such procedures.

hold the authorities and importer harmless

Australia (W/53)

Brazil (W/57)

See C(4)(a) above.

European Communities (W/31)

Signatories may require a right holder who has lodged an application to provide a security. Such a security or equivalent assurance shall be required in the context of procedures other than those relating to counterfeit goods.

[Signatories may require a right holder to provide security up to an amount sufficient to

Hong Kong (W/54) from loss or damage resulting from detention where the goods are subsequently determined not to be infringing or where the right holder, after being informed of the detention, does not promptly inform the customs authorities that he does not intend to refer the matter to the competent authority for a decision on the merits or provisional measures. However, such securities shall not unreasonably deter recourse to such procedures. Right holders should be liable to indemnify importers for goods wrongfully detained at their request regardless of whether the right holder has provided a security.]

Japan (W/43/Add.1)Signatories may establish provisions in which competent authorities require the applicant to provide a security when lodging such an application.

Republic of Korea (W/48)See A(10) above. Signatories may require the right holder who has lodged an application with the customs authorities to provide security or equivalent assurance.

Nordics (W/58) See B(3)(b) above.

(5) CONDITIONS ON DETENTION OF GOODS

Corresponding Provisions of ExistingInternational Treaties

The Madrid Agreement (Indications of Source) requires that, where seizure takes place at the instance of customs authorities, they must immediately inform the interested party, whether an individual person or legal entity, in order that such party may, if he so desires, take appropriate steps in connection with the seizure effected as a conservatory measure. If seizure is demanded by the public prosecutor or any other competent authority, the Madrid Agreement provides that the procedure will then follow its normal course (Article 2(1)).

authorities on the merits of the case.

Nordics (W/58)

competent to take decisions on the merits of

Hong Kong (W/54)

United States (W/14/Rev.1)

When the competent authorities have reason to believe imported goods may be infringing, they shall detain such goods pending a determination whether the goods are infringing.

India (W/40)

Australia (W/53)

Provisions may be made allowing release of detained goods in circumstances where IPR holders have not taken timely appropriate steps to have a decision taken by the appropriate Canada (W/42)

Brazil (W/57)

See C(4)(a) above.

the authority competent to take a decision on

In addition to the safeguards against abuse contained in the general provisions on provisional measures (see B(3)(b) and (c) above), a border measure should lapse if the right holder has neither initiated legal proceedings with a judicial authority Unless a court of appeal has made a decision the case, nor has obtained a prolongation of the border measure or another provisional measure from a judicial authority, within two weeks after he has been informed that the customs clearance of particular goods has been suspended.

European Communities (W/31)

If, within two weeks following the notification of the suspension of the release of goods in response to an application by a right holder, the customs authorities have not been informed that the matter has been referred to the authority competent to take a decision on the merits of the case, or that the duly empowered authority has taken provisional measures, the goods shall be released, provided that all other conditions for importation or exportation have been complied with. In exceptional cases, the above time-limit may be extended by another two weeks.

administrative bodies and other parties

[If, within a reasonable time as set by legislation following the notification of the suspension of the release of goods in response to an application by a right holder, the customs authorities have not been informed either that the matter has been referred to this case, the importer shall be given the merits of the case or that the duly empowered authority has taken provisional measures, the goods should be released, provided that all other conditions for importation or exportation have been complied with.

Republic of Korea (W/48)affirming detention, seizure or prohibition by customs, goods should be released if any internal court or authority acting upon similar facts decides that the products are not infringing.]

Japan (W/43/Add.1) In cases where the competent authorities do accept the application, they shall, in the discharge of their duties, pay due attention in respect of the content of the application and, upon arrival of the goods recognized as the subject matter of the application, shall suspect their importation if such goods are judged to be actually infringing the IPR in question.In cases where the competent authorities cannot judge whether the goods in question infringe the IPR or not within a reasonable period of time, even after the audience from the two parties and the inquiry from the concerned, the competent authorities may release the goods from suspension and permit their importation.When the competent authorities have suspended importation of goods, they shall notify both the importer and applicant of such fact. In sufficient opportunity to defend his cause. The content of the notification shall be as comprehensive and detailed as possible, within the limits allowed by the national law.Since the arbitrary descretion of customs offices may hinder legitimate trade, it is necessary to make explicit the customs offices' authority and responsibilities.See also A(10) above.

(6) PROCEDURES AFTER DETENTION OF GOODSCorresponding Provisions of ExistingInternational Treaties

India (W/40)

Republic of Korea (W/48)

Australia (W/53)Canada (W/42)

Brazil (W/57)Hong Kong (W/54)

Nordics (W/58)

(7) RELEASE OF INFORMATION CONCERNING OTHER PARTIES TO THE TRANSACTION

Corresponding Provisions of Existing International Treaties

India (W/40)

Australia (W/53)

Brazil (W/57)Canada (W/42)

United States (W/14/Rev.1)

confidential information, the right holder

authorities in order to substantiate his

concerned for opinion. Audience shall be

In cases of ex officio initiation of

Without prejudice to the protection of

United States (W/14/Rev.1)

national law, the customs authorities shall

importer, consignee and of the quantity of the

European Communities (W/31)

Without prejudice to the protection of goods recognized as the subject matter of the shall be given sufficient opportunity to inspect any product detained by the customs explanation of both the importer and the claims.

official view or advice or other parties

request the right holder to provide necessary confidential information, the right holder should be given sufficient opportunity to inspect any product detained by the customs authorities in order to substantiate his claims.

European Communities (W/31)

Unless this would be contrary to provisions of

Republic of Korea (W/48)inform the right holder, upon request, of the names and addresses of the consignor, Hong Kong (W/54)goods in question.

Nordics (W/58)

Japan (W/43/Add.1) In case of difficulty in judging whether the application infringe an IPR, the competent authorities shall give audience to the applicant, and may, as necessary, inquire administrative bodies concerned for their conducted following due procedures. procedures, the competent authorities may information. The participants shall establish procedures comparable to those stipulated above and at C(5) above, second and third indents.

Japan (W/17, 43 and 43/Add.1)

(8) REMEDY Corresponding Provisions of ExistingInternational Treaties

In regard to goods unlawfully bearing protected trademarks or trade names or in connection with which a false indication of source has been directly or indirectly used, the Paris Convention contains an obligation to seize them on importation if a country's legislation permits such seizure. If this is not the case, the country in question must replace this by prohibition of importation or seizure inside the country. However, the Paris Convention allows that even these replacement measures might not exist and, if this is the case, until such time as the legislation of a country is modified accordingly, these replacement measures shall be substituted by the actions and remedies available in such cases to nationals under the law of such country (Articles 9 and 10).

The Madrid Agreement (Indications of Source) contains a similar hierarchy of remedies, with the additional requirement that in the absence of any special sanctions ensuring the prevention of false or misleading indications of source, the sanctions provided by the corresponding stipulations of the laws relating to marks or trade names shall be applicable (Article 1).

United States (W/14/Rev.1)

See B(4) above.

India (W/40)

Canada (W/42)

See B(4) above.

Australia (W/53)

Detention of goods.

Nordics (W/58)

See C(1) and B(4) above.

European Communities (W/31)

Where the action is initiated by an application from a right holder: Without prejudice to the other rights of action open to the right holder, and subject to the right of the defendant to lodge an appeal to the judicial authorities, the competent authorities shall, as a general rule and in accordance with the relevant provisions of national law, and where this would not be out of proportion to the infringement in question, provide for the forfeiture of the infringing goods and destroy them or dispose of them outside the channels of commerce in such a way as to minimize harm to the right holder without compensation of any sort. They may in respect of such goods take any other measures having the effect of effectively depriving those responsible for the infringement of the economic benefits of their activity and constituting an effective deterrent to further activities of the same kind. Other than in exceptional cases, with regard to counterfeit goods the simple removal of the trademarks affixed without authorization shall not be regarded as having such effect. The authorities shall not order the re-exportation of the goods in an unaltered state or subject them to a different customs procedure.

Where the action is initiated by customs on their own initiative: Without prejudice to the other rights of action open to the right holder and subject to the right of the defendant to lodge an appeal to the competent judicial authorities, signatories shall, where this would not be out of proportion to the infringement in question, for example in cases of deliberate and flagrant infringements, provide for the forfeiture of the goods thus detained by the customs authorities and for their destruction or disposal outside the channels of commerce in such a manner as to minimize harm to the right holder.

Japan (W/43/Add.1) The competent authorities shall, in principle, forfeit and destroy goods recognized as infringing an IPR or take other effective measures deemed to be appropriate.

Republic of Korea (W/48)

Hong Kong (W/54)Signatories should provide remedies which, in the event of a successful criminal prosecution, should enable a court to order, where appropriate, forfeiture and destruction of the infringing goods, or their transfer to the IPR holder, or the removal or erasure of the offending feature of the infringing goods. These remedies are in addition to penalties of imprisonment or fine that may be ordered by a court.

Brazil (W/57)