

authorities able to adopt such measures and identify the period within which such proceedings must be initiated.

Provisional measures ordered *ex parte* must be returned to the court for confirmation, revocation or modification after hearing both parties. An early return date is provided. Such orders may be further modified by the judge upon further hearing in the case of changed circumstances. Interlocutory matters (ie, orders made prior to final hearing and determination) may be appealed. In the case of the Federal Court of Australia, under the Federal Court Act, an appeal against such an order may only be made with the leave of the court. Appeals can only be made on a question of law, rather than on the discretion, if properly exercised, of the court which granted the injunction.

34. Article 50.5 requires that competent authorities be authorized to require applicants to supply other information necessary for the identification of goods concerned by the authority that will execute the provisional measures. Please describe briefly what other information may be required by the authorities and cite the legal authority establishing the basis for this supplemental information.

Many injunctions do not require specific action by other than the defendant. Anton Piller orders and Mareva injunctions are normally carried out by plaintiff's solicitor with the authority of the court. Customs authorities may require intelligence information to identify relevant shipments and goods. In seizing goods police may ask the alleged owners of the intellectual property to identify the goods alleged to be infringing.

35. Articles 50.6 and 50.8 provide that if proceedings leading to a decision on the merits are not initiated within a reasonable time, provisional remedies granted by competent authorities shall be revoked or otherwise cease to have effect, at the request of the defendant. Please identify the relevant provisions in the law of Australia authorizing the revocation or cessation of provisional measures if review proceedings are not initiated within a reasonable time and specify what constitutes a "reasonable time period" to initiate proceedings.

See the response to questions 10, 16 of the Checklist of Issues on Enforcement.³² The normal rules of the courts are applied in relation to undue delay by a plaintiff.

36. Articles 50.7 and 50.8 provide that judicial and administrative authorities shall have the authority to order the applicant to provide the defendant appropriate compensation for any injury caused by the adoption of provisional measures when said measures are revoked, have lapsed, or when it has been determined that there has been no infringement or threat of infringement. Please describe how the competent authorities determine "appropriate compensation".

See the response to questions 10, 16 of the Checklist of Issues on Enforcement.³² The same rules are applied to determine the loss of the defendant as are applied to damages for a plaintiff. In some cases this loss is able to be quantified by reference to the sale value of the goods and in others, not. Each case is dealt with on its merits having regard to the type of information that can be gleaned about the value of the goods, the nature of the market, the effect of the proceedings in meeting customer expectations and precedents when dealing with similar cases.

(vii) Special Requirements Related to Border Measures

37. Article 51 of the TRIPS Agreement requires that countries adopt procedures that enable right holders to request suspension of the importation of counterfeit trademarked goods and pirated copyrighted works. Please identify the competent authority in Australia authorized to

³² Document IP/N/6/AUS/1.

accept applications for a request to suspend release of suspected infringing goods and cite the relevant law or regulation governing such authority.

The Australian Customs Service (ACS) is the relevant body for border seizures pursuant to the provisions of the *Copyright Act 1968* and the *Trade Marks Act 1996*. See also the response to question 15 of the Checklist of Issues on Enforcement.³³

38. Please describe the procedures a right holder must follow to obtain border protection by the competent authorities, e.g., if there is a formal application that must be submitted to the competent authority, judicial or administrative, and the information required in the request for suspension and cite the law or regulations providing such procedures.

See the response to question 16 of the Checklist of Issues on Enforcement.³³ See also the copy of the Australian Customs Service guide (reproduced in Annex 1).

39. Please explain whether procedures, permissible under Article 51 of the TRIPS Agreement, are available to stop the export of goods suspected of infringing copyrights and/or trademarks.

See the response to question 15 of the Checklist of Issues on Enforcement.³³ Use of a trademark in relation to goods and/or services that are to be exported from Australia constitutes use of the trademark for the purposes of the Trade Marks Act. There are no special procedures for seizing such goods, as there are for imported goods. The trademark owner must take legal action against any infringer.

40. Article 52 of the TRIPS Agreement requires that rights holders wishing to stop importation of counterfeit trademarked goods or pirated copyrighted works present evidence to the competent authorities that there is prima facie infringement of their trademark or copyright. Please explain what evidence will constitute prima facie infringement in Australia.

See the response to question 16 of the Checklist of Issues on Enforcement.³³ The objector gives notice to the CEO of Customs objecting to the importation of goods that infringe the trademark. Where infringing trademarked goods are to be seized, the CEO of Customs (or his/her delegate) has to form the opinion that a sign on the imported goods is substantially identical with / deceptively similar to a notified trademark. Then, the CEO of Customs must seize the goods, unless the CEO of Customs is satisfied that there are *no* reasonable grounds for believing that the notified trademark is infringed by the goods.

41. Article 52 also requires that the right holder provide a "sufficiently detailed description of the goods" to be stopped. Please explain what is required of the right holder in Australia for a description to be "sufficiently detailed".

See the response to question 16 of the Checklist of Issues on Enforcement.³³ There must be a sufficiently detailed description of the suspect copies to make them as readily recognisable by the Australian Customs Service as possible. Where appropriate, a sample of the infringing copy or a photograph or other likeness is required. This is a practical question that is not dealt with in the legislation.

42. Article 52 requires that the competent authorities notify the right holder that his application is accepted within a reasonable time. Please explain within what period of time the competent authority responds to a request for suspension of release of goods and, if the application is accepted, the length of time during which enforcement action will be taken.

³³ Document IP/N/6/AUS/1.

See the response to question 16 of the Checklist of Issues on Enforcement.³⁴

43. Article 53.1 requires that the competent authorities have the authority to secure from an applicant a security or equivalent assurance sufficient to protect a defendant and to prevent abuse. Please verify that the competent authorities identified above are empowered to require security or equivalent assurance and provide citations to the provisions of law or regulation that grant them that authority.

See the response to question 7 of the Checklist of Issues on Enforcement.³⁴

44. Article 53.2 provides that the owner, importer, or consignee of goods involving industrial designs, patents, layout-designs or undisclosed information that have been suspended by customs authorities should be able, in certain circumstances, to have such goods released on payment of security sufficient to protect the right holder from infringement. Please identify what forms of intellectual property, if any, are subject to provisions of Article 53.2 and cite to the relevant provisions of law or regulations.

Not applicable.

45. Article 54 requires that the importer and the applicant be notified promptly of the suspension or release of goods. Please specify the period within which the competent authority to issue a notice that the release of goods has been suspended.

There are no legislative time limits other than a requirement that the objector and the importer be notified as soon as is practicable, of a seizure.

46. Article 55 makes it clear that the right holder applying for suspension of infringing goods must initiate a proceeding on the merits in an appropriate forum within a reasonable period of time or the goods will be released. Please identify the fora in which an applicant/party may initiate proceedings on the merits that will allow customs authorities to hold the goods beyond ten working days.

The Federal Court and State and Territory Supreme Courts have jurisdiction, and in the case of copyright, State and Territory lower courts also have jurisdiction.

47. Article 55 provides that a review is to take place within a reasonable time at the request of the defending party to determine if the suspension measures should be modified, revoked or confirmed pending the outcome of the proceeding on the merits. Please identify the forum that is authorized to conduct such a review and describe the procedure and cite the applicable law or regulations.

Unless court action is taken and notified to the Australian Customs Service it must release the goods after the relevant 10 or 20 day period. Unless, where a matter has been taken to court, the court orders that the goods not be released (an injunction) within 3 weeks of the commencement of the action, the ACS must release the goods to the importer. The normal processes of the courts may be utilised to review or modify an order. See the response to question 16 of the Checklist of Issues on Enforcement.³⁴

48. Article 56 requires that the authorities be able to require the applicant to compensate the defending party for any injury caused if the detention of goods was unfounded. Please identify the authorities that can order the applicant to pay the importer, consignee or owner

³⁴ Document IP/N/6/AUS/1.

compensation for injury caused by wrongful detention or through the detention of goods released pursuant to Article 55 and cite to the applicable law or regulations.

See the response to question 16 of the Checklist of Issues on Enforcement.³⁵

49. Article 57 requires that the competent authorities be able to authorize the right holder to inspect the detained goods in order to substantiate the claims. Please explain how right holders are provided an opportunity to inspect suspect goods that have been detained by customs authorities.

Under the Copyright Act, both the objector and the importer are permitted to inspect the seized copies and to take samples (see Division 7 of Part V of the Act). Inspection and the taking of samples is not dealt with legislatively in relation to trademarks.

50. Article 57 also requires that, where the decision on the merits favours the right holder, the competent authorities also may be given authority to give the right holder information regarding the importer, consignee or consignor. If competent authorities in Australia can provide information regarding the importer, consignee or consignor to the right holder, please explain how information regarding names and addresses of consignors, importers and consignees and quantities of goods are provided to the applicant after a positive decision of infringement is made, e.g., authorities automatically providing information or by submission of a written request from the right holder, etc. Please cite to the law or regulations providing such authority.

See the response to question 6 of the Checklist of Issues on Enforcement.³⁵ An amendment of the Copyright Act is currently before the Parliament that would expressly empower the giving of information to the objector relating to the identify and location of the importer.

51. Article 58 specifies procedures to be followed where the competent authorities can act ex officio. Please explain whether the competent authorities in Australia are empowered to act ex officio and, if so, please identify the intellectual property areas subject to ex officio action.

The ACS is not empowered to act *ex officio*.

52. Article 59 identifies the remedies that are to be available, including destruction or disposal of infringing goods outside the stream of commerce. Please explain what the law in Australia permits regarding the disposition of infringing goods, i.e., does the law allow for destruction, disposal or both. Please cite to the law or regulations providing such authority.

For seized goods see the *Trade Marks Act 1995* s.139 in the case forfeiture under s.135 (voluntary surrender of the goods by importer) or court order under s.137 - disposal as the Comptroller-General of Customs directs. See the *Copyright Act 1968* to the similar effect in ss. 135AE and 135AI. See also the response to question 19 of the Checklist of Issues on Enforcement.³⁵

53. Please identify:

- the competent authority that decides the disposition of the goods, i.e., whether the goods will be destroyed or disposed of outside the stream of commerce; and
- the competent authority that carries out the destruction or disposal of the goods.

³⁵ Document IP/N/6/AUS/1.

In the case of border seizures the competent authority is the Comptroller-General of Customs as to which see the previous answer. In relation to an order under s.133(4) of the Copyright Act for seizure of infringing implements, where a criminal action has been brought before the court, the court determines the manner in which the infringing material will be treated.

54. Article 60 permits Members to exclude from the provisions for border enforcement small quantities of goods of a non-commercial nature carried by passengers or sent in small consignments. Please describe what constitutes a *de minimis* import that is excluded from the border measures under the law of Australia.

See the response to question 15 of the Checklist of Issues on Enforcement.³⁶

Under the Copyright Act and the Trade Marks Act, copies imported for personal use only are not subject to seizure.

(viii) *Criminal Procedures*

55. Article 61 of the TRIPS Agreement requires that Members have criminal procedures and penalties, including imprisonment and/or monetary fines sufficient to act as a deterrent, at least for cases of wilful trademark counterfeiting and copyright infringement on a commercial scale. Please describe the provisions in the law of Australia that fulfil that obligation and provide legal citations.

See the response to question 21 and 24 of the Checklist of Issues on Enforcement.³⁶ Copyright Act ss.132, 133; Trade Marks Act ss.145 - 158.

56. Article 61 also requires that remedies in appropriate cases include the seizure, forfeiture and destruction of infringing goods and any materials and implements the predominant use of which has been the commission of the offense. Please explain the provisions in the law of Australia that provide for such remedies, describe the circumstances in which those remedies would be imposed and provide legal citations.

There is provision in the Copyright Act for delivery up of infringing copies or of items used or intended to be used for making infringing copies, in the case of a criminal prosecution - regardless of whether the offence is made out (s.133(4)). See also the response to question 24 of the Checklist of Issues on Enforcement.³⁶

57. Article 61 also indicates that Members may provide for criminal procedures and penalties in cases of wilful infringement of other forms of intellectual property. Please describe any provisions in the law of Australia that provide for such procedures and remedies and provide legal citations.

Criminal sanctions are not provided in the case of infringement of intellectual property other than copyright and trademarks.

58. Article 61 requires that criminal penalties be sufficient to provide a deterrent at least for wilful trademark counterfeiting and copyright piracy. Please explain how the penalties provided under the laws of Australia comply with that obligation.

The penalties are set at a sufficiently high level to have a deterrent effect. See the response to question 24 of the Checklist of Issues on Enforcement.³⁶

³⁶ Document IP/N/6/AUS/1.



AUSTRALIAN CUSTOMS SERVICE

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for the enforcement of

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