

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.

The Customs authorities are empowered to require security. See paragraph 5 of item 16 of Switzerland's replies to the Checklist of Issues on Enforcement.¹⁸

As an example, the amount of the security depends on the reputation of the trademark (how well-known the trademark is) on one hand and on the estimated turnover in relation to that trademark. It may range in principle between SwF20,000.- and SwF100,000.- per application.

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.

In practice, a case as foreseen by Article 53.2 has never occurred, and there is strong assumptions that it will not - or never - happen. The conditions listed in that provision are so clear and restrictive that there are enough "safeguards" preventing such situation. For example, if the time limit for the suspension of the release of the goods has expired and the applicant has not asked for provisional relief before a judicial court, the Customs authorities will release immediately the goods. In any event, the Customs authorities can decide on the release of the goods and on the amount of security. They have a general competence to intervene at the border (see our reply in items 15-19). The procedures for their intervention are laid down in administrative instructions. The case as described in Article 53.2 is not foreseen in those administrative instructions. If it were to happen, the Customs authorities would, however, be able to apply directly Article 53.2, because it is, in our opinion, "self-executing".

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.

The notification is made to the applicant and to the importer immediately per facsimile (if this is possible, i.e. if the persons may be reached through this channel) and by registered mail.

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.

See our reply in item 17, 2nd paragraph, 2nd sentence of Switzerland's replies to the Checklist of Issues on Enforcement.¹⁸

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

¹⁸ Document IP/N/6/CHE/1.

is authorized to conduct such a review and describe the procedure and cite the applicable law or regulations.

The authority competent for such review is the judge of the civil court before which the provisional measures have been initiated (see our reply in item 17, 2nd paragraph, 2nd sentence of Switzerland's replies to the Checklist of Issues on Enforcement).¹⁹ For provisional measures and the relevant provisions, see items 10, 11 and 12.1 of Switzerland's replies to the Checklist of Issues on Enforcement.¹⁹

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 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 our reply to question 47.

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.

See our reply in item 16, last paragraph, of Switzerland's replies to the Checklist of Issues on Enforcement.¹⁹

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 Switzerland 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.

Ex officio reporting of suspect consignments: for example, under the Trademark Law (Article 70), the Customs authorities are empowered to draw the attention of trademark owners, persons entitled to use a geographical indication, etc., to specific consignments where there exists a suspicion of importation or exportation of goods unlawfully bearing a trademark or a geographical indication. However, the consignments are not retained (see model letter set out in Annex 1 (in German only)).

Reporting of suspect consignments upon request: a letter is sent to the applicant (see attached model letter). Attention of the applicant is drawn to all the procedural steps required and the legal consequences if he fails to observe them (see our reply in item 7, paragraph 2 of Switzerland's replies to the Checklist of Issues on Enforcement)¹⁹ and information is requested as to the suspect consignments.

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

¹⁹ Document IP/N/6/CHE/1.

See our reply in item 18 of Switzerland's replies to the Checklist of Issues on Enforcement.²⁰

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 Switzerland 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.

See our reply in item 19 of Switzerland's replies to the Checklist of Issues on Enforcement.²⁰

53. Please identify:

- (a) 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**
- (b) the competent authority that carries out the destruction or disposal of the goods.**

See our reply in item 5.3 of Switzerland's replies to the Checklist of Issues on Enforcement²⁰ for the authority competent for the decision. The competent authority to carry out the destruction or disposal of the goods is the Customs authorities.

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 Switzerland.

A de minimis import is excluded from the border measures when there is no doubt that the imported product is only for the personal use of the passenger or for the personal use of the person who will receive the product.

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 Switzerland that fulfil that obligation and provide legal citations.

See our reply in items 21 (infringing acts) and 24 (sanctions) of Switzerland's replies to the Checklist of Issues on Enforcement.²⁰

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 offence. Please explain the provisions in the law of Switzerland that provide for such remedies, describe the circumstances in which those remedies would be imposed and provide legal citations.

See our reply in item 4, 2nd paragraph, of Switzerland's replies to the Checklist of Issues on Enforcement²⁰ dealing with sanctions other than fines and imprisonment, i.e. seizure, confiscation, disposal, destruction.

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

²⁰ Document IP/N/6/CHE/1.

any provisions in the law of Switzerland that provide for such procedures and remedies and provide legal citations.

See our reply in items 21 and 24 of Switzerland's replies to the Checklist of Issues on Enforcement²¹ for all other forms of intellectual property.

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 Switzerland comply with that obligation.

The criminal penalties have proven to be a sufficient deterrent up to now. It should be noted that the LPM and LDA, for example, are relatively recent (1992) and have taken into consideration the need to have more severe sanctions.

[Follow-up questions from the US]

1. Please provide statistical information related to civil copyright, trademark, geographical indication, industrial design, patent, integrated-circuit layout design, and trade secret enforcement for each of the years 1996 and 1997, including the number of cases filed; injunctions issued; infringing products seized; infringing equipment seized; cases resolved (including settlement); and the amount of damages awarded.

Under Article 54 of our Federal Law on the Protection of Trademarks and of Indications of Source (geographical indications) for example, the courts are bound to communicate to the Federal Institute of Intellectual Property the final decisions which result in a modification of the registration (cancellation, for example). We have therefore a collection of judicial decisions.

2. Please provide statistical information related to criminal enforcement in the area of copyright piracy and trademark infringement for each of the years 1996 and 1997, including the number of raids, prosecutions, convictions, and the amount of fines and/or jail terms (including whether the fines were paid and whether the jail term was actually served or was suspended) and any other information establishing that your criminal system operates effectively to deter copyright piracy and trademark counterfeiting.

A Contact Group between the Cantons and all the federal authorities in charge of WTO matters has been created after the ratification of the WTO Agreement. It is foreseen that it will inform the Cantons on the work done in the TRIPS Council, in particular with regard to enforcement. The report envisaged is of a more general character. It is possible to foresee information of the kind asked by the US delegation. We will produce in due course the figures once the report envisaged is completed after due consultation with the Cantons and the Federal Tribunal.

²¹ Document IP/N/6/CHE/1.

ANNEX 1

21.34 Musterbrief an den Antragsteller (Vertreter) (Ziffer 21.3212)

Einschreiben mit Rückschein
und wenn möglich auch per Fax
Antragsteller (Vertreter)

Bundesgesetz über den Schutz von Marken und Herkunftsangaben vom 28. August 1992
(MSchG, SR 232.11)

Ihr Antrag auf Hilfeleistung der Zollverwaltung betreffend

Sehr geehrte Damen und Herren

Gestützt auf Artikel 72 des Markenschutzgesetzes¹⁾ teilen wir Ihnen mit, dass wir die nachstehend beschriebene Sendung zurückbehalten haben. Die Ware wird während höchstens zehn Arbeitstagen zurückbehalten, damit Sie vorsorgliche Massnahmen gemäss Artikel 59 MSchG erwirken können. Auf Antrag kann die Zollverwaltung in begründeten Fällen die betreffenden Waren während höchstens zehn weiteren Arbeitstagen zurückbehalten. Für die Verwahrung der Ware ist eine Gebühr gemäss Verordnung über Gebühren der Zollverwaltung vom 22. August 1984 geschuldet.

Wir ersuchen Sie, uns umgehend mitzuteilen, ob Sie beabsichtigen, vorsorgliche Massnahmen zu beantragen, oder ob die Ware freizugeben ist. Sie haben die Möglichkeit die Ware beim Zollamt zu besichtigen. Ausserdem weisen wir Sie ausdrücklich darauf hin, dass Sie den durch das Zurückbehalten von Waren entstandenen Schaden zu ersetzen haben, falls vorsorgliche Massnahmen nicht angeordnet werden oder sich als unbegründet herausstellen.

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Artikelbezeichnungen gem. den Begleitpapieren:
Zeichen, Nummern, Anzahl und Art der Packstücke:
Gewicht/ev. Stückzahl:
Empfänger/Importeur (bei der Einfuhr):
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Mit freundlichen Grüssen

Das Zollamt

Keine Beilagen

Kopien an:

- Spediteur
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- OZD, Sektion Zollverfahren (per Fax 031 322 78 72)

¹⁾ Hat die Zollverwaltung aufgrund eines Antrages nach Artikel 71 den begründeten Verdacht, dass eine zur Ein- oder Ausfuhr bestimmte Ware widerrechtlich mit einer Marke oder einer Herkunftsangabe versehen ist, so teilt sie dies dem Antragsteller mit.

21.35 Musterbrief an den Markeninhaber (Ziffer 21.322)

Markeninhaber

Bundesgesetz über den Schutz von Marken und Herkunftsangaben vom 28. August 1992
(MSchG, SR 232.11)
Anzeige einer verdächtigen Sendung

Sehr geehrte Damen und Herren

Es besteht der begründete Verdacht, dass die nachstehend beschriebene Sendung widerrechtlich mit Ihrer Marke versehen wurde.

Warenbeschreibung:

Zeichen, Nummern, Anzahl und Art der Packstücke:

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bzw. Exporteur (bei der Ausfuhr):

Aufgrund der Bestimmungen im Markenschutzgesetz haben wir die Sendung freigegeben.

Mit freundlichen Grüßen

Das Zollamt

Keine Beilagen

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