

## **Protect Your Trademark or Copyright from Imitation Imports**

*Customs and Border Protection Issues Revised Guidance on  
The Enforcement of Intellectual Property Rights*

### **Summary of Revised Guidelines**

United States Customs and Border Protection ("CBP") is authorized to exclude from entry, detain and/or seize goods that infringe U.S. intellectual property rights. U.S. registered trademarks and copyrights must be recorded with CBP in order to receive full CBP protection. Goods that infringe U.S. patents are enforced by CBP only pursuant to an order by the U.S. International Trade Commission ("ITC") after a determination has been made under Section 337 of the Tariff Act of 1930, as amended.

### **Trademarks and Copyrights**

Under customs law, there is a distinction between "counterfeit" or "clearly piratical" goods and "confusingly similar" or "possibly piratical" goods.

- Counterfeit and clearly piratical goods are subject to seizure, forfeiture, and destruction.
- Confusingly similar and possibly piratical goods are subject to detention pending further investigations and determinations by CBP. These goods may continue to be imported so long as the confusingly similar mark is removed.

### **Gray Market Goods**

Gray market goods are genuine products bearing a trademark that has been approved by the trademark owner for use in a foreign country, but not authorized for import into the United States. Gray market goods are protected, and therefore detained and subject to potential seizure and forfeiture, only if:

- a. The trademark or trade name is registered with CPB, and
- b. The foreign and U.S. trademark holders are not the same person; or  
The foreign and U.S. trademark owners are not under common ownership and control.

### **Lever Rule Protection**

Goods bearing a genuine trademark and that do not qualify for gray market protection may be entitled to protection if it can be established that the foreign goods are "physically and materially" different from the goods produced for the U.S. market and such distinction is presented in advance to CBP. These goods will be permitted entry so long as they are labeled to indicate that they are materially and physically different and are not authorized for importation by the U.S. trademark owner.

## **Disclosure of Information**

CBP will disclose certain origin, descriptive and shipping information to the U.S. intellectual property right owner regarding the importation of products suspected to be infringing. The manufacturer, exporter and importer information is communicated only in the case of the importation of counterfeit or clearly piratical goods.

## **Patents and Exclusion Orders**

CBP does not determine patent infringement. CBP will enforce general and specific exclusion orders issued by the ITC pursuant to an investigation under Section 337 of the Tariff Act of 1930, as amended. Once an order has been issued by the ITC, shipments of merchandise violative of the order will be subject to seizure. CBP enforces patents only if they are covered by an ITC exclusion order.

## **Thompson Coburn LLP's Import / Intellectual Property Rights Services**

Attorneys at Thompson Coburn LLP have experience working with the Intellectual Property Rights branches at both CBP and Immigration and Customs Enforcement ("ICE") and would be happy to help you get the proper level of enforcement by CBP.

- We can assist with the registration, prosecution and enforcement of trademarks, patents and copyrights.
- We can assist clients with recording their trademarks or copyrights with CBP.
- We can help determine whether goods qualify for gray market protection.
- We can provide guidance to clients who have been informed by CBP that goods violative of their trademark or copyright have been detained or seized.
- We can help clients whose goods have been wrongfully detained by CBP to work with CBP on achieving release of the goods.
- We can assist clients in obtaining an exclusion order from ITC where imports violative of your patents are causing injury to your business.

For further information on CBP's enforcement of intellectual property rights, please contact:

<a href="#">Robert Shapiro</a>	202.585.6926	<a href="mailto:rshapiro@thompsoncoburn.com">rshapiro@thompsoncoburn.com</a>
<a href="#">John Harrop</a>	202.585.6979	<a href="mailto:jharrop@thompsoncoburn.com">jharrop@thompsoncoburn.com</a>
<a href="#">Thomas Polcyn</a>	314.552.6331	<a href="mailto:tpolcyn@thompsoncoburn.com">tpolcyn@thompsoncoburn.com</a>
<a href="#">Paul Maddock</a>	314.552.6546	<a href="mailto:pmaddock@thompsoncoburn.com">pmaddock@thompsoncoburn.com</a>

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