Partnering with CBP to Maximize Trademark Protection

By C.J. Erickson, Esq.

Cowan, Liebowitz & Latman
1133 Avenue of the Americas
New York, NY 10036
212 790-9200 💕💕 www.cll.com
Import Procedures

- Imported products are subject to review and inspection by U.S. Customs and Border Protection (CBP)

- CBP is responsible for enforcing laws and regulations of 40 other agencies

- CBP review is one of the most significant tools trademark owners can use to combat unauthorized imports
Customs IPR Protection

■ CBP devotes substantial resources to protecting intellectual property rights

■ CBP is vested with the authority to:
  ◆ Exclude goods from entry
  ◆ Detain merchandise
  ◆ Seize merchandise
  ◆ Forfeit counterfeit goods
CBP Enforcement Strategy

- Customs policy is a two-tiered enforcement approach
  - Recordation of a registered trademark
  - Open and on-going communication with trademark owners
On-line Recordation System

- Eliminates paperwork
- $190/per mark/per class
- Basic Information required
E-Recordation System

- Eliminates paperwork
- Allows for payment by credit card
- Information required:
  - Identity of trademark owner
  - Registration number of the mark
  - Class of goods
  - Names of licensees and authorized users
  - Foreign ownership or use of the mark
  - Identity of parent companies
  - Subsidiaries or other foreign or domestic entities under common ownership or control with trademark owners
Supplemental Information

- The 2nd tier of CBP’s IPR enforcement is open communication between trademark owner and CBP IPR branch.
- CBP refers to this tier as the “application process”.
  - Continuing and evolving practice based on:
    - Product developments
    - New technology and information gathered over time
    - New legal decisions and legislation
Goal

- Trademark owners should provide CBP with enough details so field officers will be able to determine whether an imported product is authentic and admissible.
- May be presented in oral, written and electronic format.
- Should address legitimate and infringing products.
Real or Counterfeit?
Authentic LUGZ have:

Black detailed tongue label

Counterfeit LUGZ have:

Generic white tongue label
Protected Mark Features:

- Location of mark on product
- Product quality and overall appearance
- Trim features such as zippers, buttons and snaps
- Authorized territories, factories, licensees and importers
- Sample labels and tags
Use new materials and technologies to make counterfeiting more difficult and detectable

- Holograms
- Electromagnetic tags
- Subsurface laser marking
- Fiber and thread technology
- Assign codes to each item
- Micro-text
Non-traditional IP Protection

- Configuration marks
Disclosure of Information to Trademark Owners

- Customs regulations provide for disclosure of certain information on detained or seized goods
- Quantity of information is based on the nature of the violation
In seizure cases, CBP will disclose to the trademark owner the following information:

- Date of importation
- Port of entry
- Description of merchandise
- Quantity
- Name and address of manufacturer
- Country of origin
- Name and address of exporter
- Name and address of importer
- Trademark owner is entitled to samples of seized and detained merchandise for examination and testing

- May require posting of a bond
  - Useful in civil prosecution
  - May reveal sources in violation of distribution agreements
Conclusion

- Trademark owners are entitled to significant protection from CBP at minimal cost but need to be pro-active.
- Registered trademarks should be recorded with Customs to ensure maximum benefits under relevant statutes and regulations.
- Proper recordation should be part of any IPR plan to:
  - safeguard against unauthorized imports
  - Strengthen license and distribution agreements
  - Establish a strong basis for civil and criminal actions against suspected infringers.