Protect Your Brand: U.S. Customs and Border Protection as Part of Your IP Enforcement Team

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Intellectual property rights holders are constantly seeking creative ways to protect their brands, including preventing counterfeit products from entering the marketplace. There are the traditional methods – such as federal trademark registration with the United States Patent and Trademark Office – that are well-known to most companies. However, many companies are less familiar with the high-value, low-cost enforcement tools available through a Customs Recordation filing with United States Customs and Border Protection.

United States Customs and Border Protection (CBP) can be a vital partner in your company’s efforts to enforce its trademarks and copyrights, and to stop counterfeit imports. Intellectual property enforcement is currently a “Priority Trade Issue” for CBP, and the increased focus on such enforcement is highly beneficial to companies who can then leverage CBP’s database and workforce to identify and stop counterfeit product imports. CBP uses the information contained in its database of recorded trademarks and copyrights in order to target and seize imports of counterfeit and pirated goods at various U.S. ports of entry. In FY 2019, CBP seized more than 27,000 shipments containing counterfeit goods, enforcing over 18,500 active recordations\(^1\). Notably, CBP rarely takes action to detain or seize goods displaying\(\ldots\)
trademarks or copyrights that are not recorded; therefore, it is critical to include CBP recordation as part of your enforcement strategy.

To qualify for CBP recordation, a trademark or copyright must be federally registered. All filings are submitted online, and the majority of CBP recordation filings are for registered trademarks.

Some information needed for the CBP filing includes:

- the name, address and entity information for the trademark owner;
- the registration number for the trademark, and images showing the goods;
- the place of manufacture of the goods bearing the trademark;
- the identity of any company under common ownership or control that is using the trademark abroad; and
- any foreign entities licensed or authorized to use the trademark.  

The filing cost is only $190 per International Class of goods, which makes it an excellent value. Moreover, the recordation can be renewed concurrently once the trademark registration is renewed.

After recordation is complete, CBP can then use the information in its database when reviewing shipments of imported products. Only products bearing a genuine trademark, applied by an authorized party, may be imported. Thus, if an imported product is suspected to be a counterfeit, CBP will notify the trademark owner and detain the shipment for up to 30 days. Often, CBP will provide photographs of the detained products to help the trademark owner determine the nature of the seized products. The trademark owner can also request a sample of the detained products from CBP, after posting a bond to indemnify the importer (in case the products are not counterfeit).

If the products are determined to be counterfeit, then the shipment will be seized and CBP will take physical possession of the shipment. The imported products are then typically destroyed.

If your company wants to take advantage of CBP’s useful, low-cost tool for enforcement, here are some suggestions for next steps:

- Register your trademark with the U.S. Patent and Trademark Office, and/or your copyrighted work with the U.S. Copyright Office.

- Gather the relevant information on product suppliers, licensees, product images, and any documentation on known counterfeiters related to your product.

- With the information gathered, prepare and file a recordation of your registered trademark/copyright with CBP, online at the Intellectual Property Rights e-Recordation database (iprr.cbp.gov). Update your recordation when new or relevant information arises, not just at the renewal time.
• Supplement your recordation filings with a Product ID training guide or webinar. You can provide CBP with additional data and background on product bar codes, suspect product examples, recognizable product attributes, and other issues encountered related to counterfeit products.

• Use the CBP’s e-allegations system (eallegations.cbp.gov) to report any suspicious shipments or companies.

• Respond promptly if contacted by CBP regarding a product seizure.

• Establish internal controls related to counterfeit products, such as the creation of detailed processes for the purchasing department to follow when contracting with suppliers, and education of employees on identifying intellectual property violations.

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