



# Memorandum D19-4-3

Ottawa, July 29, 2020

## Copyright, Trademarks and Geographical Indications

### In Brief

This memorandum reflects amendments made to the *Trademarks Act* in respect of applications for the detention of confusingly similar trademark goods that are imported into Canada, and amendments made to the *Trademarks Act* and *Copyright Act*, which expanded the Canada Border Services Agency's (CBSA's) Intellectual Property Rights (IPR) Program in respect of suspected counterfeit trademark, counterfeit geographical indication, and pirated copyright goods that are transiting through Canada. These amendments have been made as part of Canada's implementation of the *Comprehensive and Progressive Agreement for Trans-Pacific Partnership* (CPTPP) and the *Canada-United States-Mexico Agreement* (CUSMA)

This memorandum outlines and explains the legislation governing the role of the Canada Border Services Agency (CBSA) in dealing with counterfeit protected marks (i.e. Trademarks or geographical indications) or pirated copyright goods.

### Legislation

[Copyright Act](#) – Sections 44 to 44.4, and 45

[Customs Act](#) – Section 101

[Customs Tariff](#) – Section 136

[Trademarks Act](#) – Sections 51.02 to 51.12, and 53 to 53.3

## Guidelines and General Information

### Definitions

1. The following definitions apply to this memorandum:

“**CBSA Officer**” has the meaning assigned by the definition “officer” in subsection 2(1) of the *Customs Act*.

“**Copyright**” refers to the protection of literary, artistic, dramatic or musical works (including computer programs).

“**Court**” means the Federal Court or the superior court of a province.

“**Duties**” has the same meaning as in subsection 2(1) of the *Customs Act*.

“**Geographical Indication**” means an indication that identifies a wine or spirit, or an agricultural product or food of a category set out in the schedule of *Trademarks Act*, as originating in the territory of a World Trade

Organization (WTO) Member, or a region or locality of that territory, if a quality, reputation or other characteristic of the wine or spirit or the agricultural product or food is essentially attributable to its geographical origin.

**“Minister”** means the Minister of Public Safety and Emergency Preparedness.

**“Owner”** with respect to a protected geographical indication identifying a wine or spirit or agricultural product or food, means the responsible authority, as defined in section 11.11 of the *Trademarks Act*, for the wine or spirit or agricultural product or food identified by the indication.

**“sound recording, performer's performance or communication signal”** refers to (i) the rights of performers in their live performances and in their performances fixed in sound recordings, (ii) the rights of producers of sound recordings, and (iii) the rights of broadcasters in their communication signals. These rights in “other subject matter” are often referred to as copyright ‘neighboring rights’, and are distinct from the rights of the authors of copyright “works” (e.g., music composers).

**“Protected Mark”** means a registered trademark or a protected geographical indication.

**“Release”** has the same meaning as in subsection 2(1) of the *Customs Act*.

**“Relevant Protected Mark”** means a) a Trademark for goods that is identical to, or cannot be distinguished in its essential aspects from, a Trademark on such goods, including their labels or packaging, that are detained by a customs officer; or b) a protected geographical indication identifying, as the case may be, a wine or spirit, or an agricultural product or food of a category set out in the schedule of the *Trademarks Act*, that is identical to, or cannot be distinguished in its essential aspects from, an indication on such a wine or spirit or such an agricultural product or food, or on their labels or packaging, that is detained by a customs officer.

**“Rights Holder”** means the owner of a copyright in a work or other subject-matter or the owner of a registered trademark or protected geographical indication.

**“Trademarks”** refers to the words, symbols and designs (or a combination of these) that are used to distinguish the goods and services of one person or organization from those of others (e.g. a logo).

**“Working Day”** means a day other than a Saturday or a holiday as per the *Copyright Act* and *Trademarks Act*.

**Note:** As per the [Interpretation Act](#), “holiday” includes Sunday.

## General

- The [Combating Counterfeit Products Act](#), which amended the *Copyright Act* and the *Trademarks Act*, came into force January 1, 2015, followed by the *Canada-European Union Comprehensive Economic and Trade Agreement (CETA) Implementation Act*, which came into force on June 1, 2017, and further amended sections of the *Trademarks Act*. These amendments provide for the implementation of IPR border measures that allow the CBSA to detain commercial shipments, as per section 101 of the *Customs Act*, that contain suspected counterfeit trademark goods, geographical indications, and pirated copyright goods. These amendments also allow the CBSA to share certain information about those shipments with rights holders/owners that have filed a Request for Assistance (RFA) with the CBSA to allow them to seek remedy in civil court as per section 107(5)(1.1) and (1.2) of the *Customs Act*, section 44.04(1) of the *Copyright Act*, and section 51.06(1) of the *Trademarks Act*. On July 1, 2020, the *Canada-United States-Mexico Agreement (CUSMA) Implementation Act* came into force and expanded the CBSA’s application of IPR border measures to suspected counterfeit trademark goods, counterfeit geographical indications, and pirated copyright goods that are transiting Canada (e.g. that are being shipped from one place outside Canada to another while in customs transit control or customs trans-shipment control in Canada).

3. With the exception of a court order issued under the *Integrated Circuit Topography Act*, the CBSA plays a role only with respect to copyright goods, trademark goods, or geographical indications; it does not act upon any other IPR infringements such as patents or industrial designs.

## Importation and Exportation

### Prohibition on Importation or Exportation - Copyright

4. Copies of a work or other subject-matter in which copyright subsists shall not be imported or exported if they were made without the consent of the owner of the copyright in the country where they were made; and they infringe copyright or, if they were not made in Canada, they would infringe copyright had they been made in Canada by the person who made them.
5. As part of Canada's implementation of the CUSMA, there is no longer an exception under the *Copyright Act* for copies that are being shipped from one place outside of Canada to another and that are in customs transit control or customs transshipment control in Canada.
6. This prohibition does not apply to copies that are imported or exported by an individual in their possession or baggage if the circumstances, including the number of copies, indicate that the copies are intended only for their personal use.

### Prohibition on Importation or Exportation - Trademarks

7. Goods shall not be imported or exported if the goods or their labels or packaging bear – without the consent of the owner of a registered trademark for such goods – a trademark that is identical to, or that cannot be distinguished in its essential aspects from, that registered trademark.
8. As part of Canada's implementation of the CUSMA, there is no longer an exception under the *Trademarks Act* for when the goods, while being shipped from one place outside Canada to another, are in customs transit control or customs transshipment control in Canada. Canada's CUSMA implementation also amends the *Trademarks Act* to create a presumption that, for the purposes of the application of the border prohibition, goods that are moving in-transit are considered to have been imported for the purpose of release into the Canadian marketplace.
9. The importation or exportation of goods is not prohibited when:
  - (a) the trademark was applied to the goods with the consent of the owner of the trademark in the country where it was applied;
  - (b) the sale or distribution of the goods or, in the case where the trademark is on the goods' labels or packaging, of the goods in association with the labels or packaging would not be contrary to the *Trademarks Act*;
  - (c) the goods are imported or exported by an individual in their possession or baggage and the circumstances, including the number of goods, indicate that the goods are intended only for their personal use.
10. Goods that are imported or exported with labels or packaging that bear – without the consent of the owner of a registered trademark for such goods – a trademark that is identical to, or that cannot be distinguished in its essential aspect from that registered trademark **does not** give rise to a remedy under section 53.2 (Power of the Court to Grant Relief) of the *Trademarks Act*.

## Prohibition on Importation or Exportation – Geographical Indications

11. Wine or spirits shall not be imported or exported if they, or their labels or packaging, bear a protected geographical indication and the wine or spirits:
  - a) do not originate in the territory indicated by the indication; or
  - b) do originate in the territory indicated by the indication but were not produced or manufactured in accordance with the law applicable to that territory.
  
12. An agricultural product or food of a category set out in the schedule of the *Trademarks Act* shall not be imported or exported if it, or its label or packaging, bears a protected geographical indication and the agricultural product or food:
  - a) does not originate in the territory indicated by the indication; or
  - b) does originate in the territory indicated by the indication but were not produced or manufactured in accordance with the law applicable to that territory.
  
13. As part of Canada’s implementation of the CUSMA, there is no longer an exception under the *Trademarks Act* for when the wine or spirit or the agricultural product or food, while being shipped from one place outside Canada to another, are in customs transit control or customs transshipment control in Canada. Canada’s CUSMA implementation also amends the *Trademarks Act* to create a presumption that, for the purposes of the application of the border prohibition, goods that are moving in-transit are considered to have been imported for the purpose of release into the Canadian marketplace.
  
14. The above noted prohibitions do not apply if:
  - a) the sale or distribution of the wine or spirit or the agricultural product or food – or, if the label or packaging of that wine, spirit or agricultural product or food bears a protected geographical indication and the sale or distribution of that wine, spirit or agricultural product or food in association with that label or packaging – would not be contrary to this Act;
  
  - b) the wine or spirit or agricultural product or food is imported or exported by an individual in their possession or baggage and the circumstances, including the number of such goods, indicate that they are intended only for the individual’s personal use.

## Request for Assistance

15. A rights holder (RH) or owner can file a Request for Assistance (RFA) with the CBSA to pursue remedy under the *Copyright Act* or the *Trademarks Act* at no cost; the application can be accessed on the CBSA’s website: [RFA Application](#).
  
16. The RFA Application must include:
  - (a) legal name of RH/owner;
  - (b) RH’s/owners mailing address;
  - (c) RH’s/owners representative for service in Canada and their contact information, which must include a Canadian address (if applicable);
  - (d) indication if the RFA pertains to a protected mark (i.e. trademark or geographical indication) or copyright;
  - (e) protected mark (i.e. trademark or geographical indication) and/or copyright registration number (not mandatory for copyright) ; and,
  - (f) RH’s/owners signature and date.

17. The RFA application can be emailed to the CBSA ([CBSA-ASFC IPR-DPI@cbsa-asfc.gc.ca](mailto:CBSA-ASFC_IPR-DPI@cbsa-asfc.gc.ca)) or the RH/owner can mail a copy to the CBSA at the following address:

Canada Border Services Agency  
 Commercial Registration (HQ)  
 191 Laurier Avenue West, 12<sup>th</sup> Floor  
 Ottawa, ON K1A 0L8

18. The application process takes approximately four to six weeks and once the application is processed by the Commercial Registration Unit. The RH/owner will receive notification from the CBSA advising them:
- (a) if the CBSA requires further information and/or clarification in order to process the applications; or
  - (b) that your application has been accepted (refer to sample in Appendix A); or
  - (c) that your application has been rejected and reason(s) why (refer to sample in Appendix B).
19. A RFA is valid for a period of two-years beginning on the day on which it is accepted by the CBSA. The validity period may be extended for additional two-year periods at the request of the RH/owner. It is up to the RH/owner to ensure that their request for renewal is submitted to the CBSA before the current RFA expires.
20. The CBSA may, as a condition of accepting a RFA or of extending a RFA's period of validity, require that the RH/owner furnish security, in an amount and form fixed by the CBSA, for the payment of an amount for which the RH/owner becomes liable for the storage and handling charges and, if applicable, for the charges for destroying suspected counterfeit and/or pirated goods detained on their behalf.
21. The RH/owner shall inform the CBSA in writing or via email at: [CBSA-ASFC IPR-DPI@cbsa-asfc.gc.ca](mailto:CBSA-ASFC_IPR-DPI@cbsa-asfc.gc.ca), as soon as practicable, of any changes to:
- a) the subsistence of the **copyright** that is the subject of the request for assistance;
  - b) ownership of that **copyright**;
  - c) the validity of the **protected mark (i.e. trademark or geographical indication)** that is the subject of the request for assistance;
  - d) the ownership of the **protected mark (i.e. trademark or geographical indication)**; or,
  - e) the goods for which the **protected mark (i.e. trademark or geographical indication)** is registered.

### Information Provided by a CBSA Officer

22. A CBSA officer who is detaining copies of a work or other subject-matter (hereafter referred to as "copies") or goods under section 101 of the *Customs Act* may, in the officer's discretion (ex-officio powers of an officer), to obtain information about whether the importation or exportation of the copies or goods are prohibited under the *Copyright Act* or the *Trademarks Act*, provide the RH/owner with a sample of the copies or goods and with any information about the copies or goods that the customs officer reasonably believes **does not directly or indirectly identify any person**.
23. A CBSA officer who is detaining copies or goods under section 101 of the *Customs Act* and who has reasonable grounds to suspect that the importation or exportation of the copies or goods is prohibited under *Copyright Act* or the *Trademarks Act* may, in the officer's discretion, if the CBSA **has accepted a RFA** with respect to the copies or goods, provide that RH/owner with a sample of the copies or goods and with information about the copies or goods that could assist them in **pursuing a remedy** under the *Copyright Act* or the *Trademarks Act*, such as:
- a) a description of the copies or goods and their characteristics;
  - b) the name and address of their owner;

- c) the name and address of their importer;
- d) the name and address of their exporter;
- e) the name and address of their consignee;
- f) the name and address of any other person involved in the movement of the goods;
- g) the name and address of the person who made them;
- h) their quantity;
- i) the countries in which they were made and through which they passed in transit; and
- j) the day on which they were imported, if applicable.

24. When a CBSA officer encounters suspected counterfeit and/or pirated goods during an examination of commercial goods, and the RH/owner has filed a RFA with the CBSA, they will be contacted via email and provided information so they can determine if they wish to pursue a remedy under the *Copyright Act* or the *Trademarks Act*. The email address used for this purpose is the email address provided by the RH/owner in the RFA. The RH/owner has (3) three business days to advise the CBSA, via email, if they wish to pursue remedy or not.
25. If the RH/owner **does not** notify the CBSA within (3) three business days **or they notify the CBSA that they will not be pursuing remedy** under the *Copyright Act* or the *Trademarks Act*, provided the suspected counterfeit and/or pirated goods meet all other import requirements they will be released.
26. If the RH/owner notifies the CBSA that they **will be pursuing a legal remedy** under the *Copyright Act* or the *Trademarks Act*, they will be issued a “Rights Holders / Owners Notice of Detention for Goods Suspected of Contravening IPR” (refer to sample in Appendix C) via email and the suspected counterfeit and/or pirated goods will continue be detained to enable the RH/owner time to commence proceedings in court (further information regarding detention timeframes can be found under the heading “Detention Period”); the importer will be advised that the CBSA has detained their goods on a K26, Notice of Detention.

### Detention Period

27. A customs officer shall not detain copies or goods, for the purpose of enforcing the *Copyright Act* or the *Trademarks Act*, for more than (10) ten working days – or, if the copies or goods are perishable, for more than (5) five days – after the day on which the customs officer first sends or makes available a sample or information to the RH/owner. At the request of the RH/owner, made while the copies or goods are detained for the purpose of enforcing the *Copyright Act* or the *Trademarks Act*, the customs officer may, having regard to the circumstances, detain **non-perishable** copies or goods for one additional period of not more than (10) ten working days.
28. If, before the copies or goods are no longer detained for the purpose of enforcing the *Copyright Act* or the *Trademarks Act*, **the RH/owner has provided the CBSA with a copy of a document filed with a court commencing proceedings** to obtain a remedy under the *Copyright Act* or the *Trademarks Act* with respect to the detained copies or goods, the customs officer shall continue to detain them until the CBSA is informed in writing that:
- a) the proceedings are finally disposed of, settled or abandoned;
  - b) a court directs that the copies or goods are no longer to be detained for the purpose of the proceedings; or,
  - c) the RH/owner consents to the copies or goods no longer being so detained.

**Note:** If the RH/owner **does not provide CBSA with a copy of a document filed with a court** within the stipulated timeframes, then **the suspected counterfeit and/or pirated goods will be released** as long as they meet all other import requirements.

29. The occurrence of any of the events referred to above does not preclude a customs officer from continuing to detain the copies or goods under the *Customs Act* for a purpose other than the proceedings.

### Restriction on Information Use

30. A person who receives a sample or information that is provided under the *Copyright Act* or the *Trademarks Act* shall not use the information, or information that is derived from the sample, for any purpose other than to give information to the customs officer about whether the importation or exportation of the copies or goods is prohibited or to pursue remedy under the *Copyright Act* or *Trademarks Act*.
31. Confidential communication of information about the copies or goods for the purpose of reaching an out-of-court settlement is **not restricted**.

### Inspection

32. After a sample or information has been provided under the *Copyright Act* or the *Trademarks Act*, a customs officer may, in the officer's discretion, give the owner, importer, exporter and consignee of the detained copies or goods and the RH/owner an opportunity to inspect the copies or goods.

### Liability for Charges

33. RHs/owners who have received a sample or information under the *Copyright Act* or the *Trademarks Act* are liable to Her Majesty in right of Canada for the storage and handling charges for the detained copies or goods – and, if applicable, for the charges for destroying them – for the period beginning on the day after the day on which a customs officer first sends or makes available a sample or information to a RH/owner and ending on the first day on which one of the following occurs:
- a) the copies or goods are no longer detained for the purpose of enforcing the *Copyright Act* or the *Trademarks Act*;
  - b) the CBSA receives written notification in which the RH/owner states that the importation or exportation of the copies or goods does not, with respect to the RH's/owner's copyright or relevant registered Trademark, contravene the *Copyright Act* or the *Trademarks Act*;
  - c) the CBSA receives written notification in which the RH/owner states that they will not, while the copies or goods are detained for the purpose of enforcing the *Copyright Act* or the *Trademarks Act*, commence proceedings to obtain a remedy under the *Copyright Act* or the *Trademarks Act* with respect to them.
34. Despite paragraph 33 (a) if the copies are forfeited under subsection 39(1) of the *Customs Act* and the CBSA did not, before the end of the detention of the copies or goods for the purpose of enforcing the *Copyright Act* or *Trademarks Act*, receive a copy of a document filed with a court commencing proceedings to obtain a remedy under the *Copyright Act* or the *Trademarks Act* with respect to the detained copies or goods or the written notification referred to in paragraph 33 (b) or (c), the period ends on the day on which the copies are forfeited.
35. Despite paragraph 33 (c), if the copies or goods are forfeited under subsection 39(1) of the *Customs Act* after the CBSA has received written notification referred to in that paragraph, the period ends on the day on which the copies or goods are forfeited.

36. The owner and the importer or exporter of copies or goods that are forfeited in the circumstances set out in paragraphs 34 and 35 are jointly and severally, or solidarily, liable to the RH/owner for all the charges under paragraph 33 paid by the RH/owner with respect to the period:
- a) in the circumstances referred to in paragraph 34, beginning on the day on which the copies or goods are no longer detained for the purpose of enforcing the *Copyright Act* or the *Trademarks Act* and ending on the day on which the copies or goods are forfeited; and
  - b) in the circumstances referred to in paragraph 35, beginning on the day on which the CBSA receives the written notification referred to in paragraph 33 (c) and ending on the day on which the copies or goods are forfeited.
37. Paragraphs 33 to 35 do not apply if:
- a) the detention of the copies or goods for the purpose of enforcing section the *Copyright Act* or the *Trademarks Act* ends before the expiry of (10) ten working days – or, if the copies or goods are perishable, before the expiry of (5) five days – after the day on which the customs officer first sends or makes available a sample or information about the copies or goods to the RH/owner; and
  - b) the CBSA has not, by the end of the detention, received a copy of a document filed with a court commencing proceedings to obtain a remedy under the *Copyright Act* or the *Trademarks Act* with respect to the detained copies or goods of the written notification referred to in paragraph 33 (b) or (c).
38. Neither Her Majesty nor a customs officer is liable for any loss or damage suffered in relation to the enforcement or application of the *Copyright Act* or the *Trademarks Act* because of:
- a) the detention of copies or goods, except if the detention contravenes the *Copyright Act* or the *Trademarks Act*;
  - b) the failure to detain copies or goods, or
  - c) the release or cessation of detention of any copies or goods, except if the release or cessation contravenes the *Copyright Act* or the *Trademarks Act*.

### **Application to Court**

39. In the course of proceedings referred to in the *Copyright Act* or the *Trademarks Act* the court may, on the application of the CBSA or a party to the proceedings,
- a) impose conditions on the storage or detention of the copies or goods that are the subject of the proceedings; or
  - b) direct that the copies or goods are no longer to be detained for the purpose of the proceedings, on any conditions that the court may impose, if their owner, importer, exporter or consignee furnishes security in an amount fixed by the court.
40. If a party applies to have the detained copies or goods stored in a place other than a bonded warehouse or a sufferance warehouse, as those terms are defined in subsection 2(1) of the *Customs Act*, the CBSA must consent to the storage of copies or goods in that place before a condition to that effect is imposed.
41. The court may impose a condition despite section 31 of the *Customs Act*.



42. The court may direct that the copies or goods are no longer to be detained for the purpose of the proceedings but this does not preclude a customs officer from continuing to detain the copies or goods under the *Customs Act* for another purpose.
43. In the course of proceedings referred to in the *Copyright Act* t or the *Trademarks Act* the court may, on the application of the CBSA or a party to the proceedings, require the RH/owner to furnish security, in an amount fixed by the court,
- a) to cover duties, storage, and handling charges, and any other amount that may become chargeable against the copies or goods, and
  - b) to answer any damages that may, because of the detention of the copies or goods, be sustained by the owner, importer, exporter or consignee of the copies.
44. The court may award damages against the RH/owner who commenced proceedings under the *Copyright Act* t or the *Trademarks Act* to the owner, importer, exporter or consignee of the copies or goods who is a party to the proceedings for losses, costs or prejudice suffered as a result of the detention of copies if the proceedings are dismissed or discontinued.
45. Any damages under the *Copyright Act* or the *Trademarks Act* awarded to the RH/owner are to include the charges incurred by the RH/owner as a result of storing, handling or, if applicable, destroying the detained copies or goods.

#### **Prohibition Resulting from Notice - Copyright**

46. Copies made outside Canada or any work in which copyright subsists that if made in Canada would infringe copyright and as to which the owner of the copyright gives notice in writing to the CBSA that the owner desires that the copies not be imported into Canada, shall not be so imported and are deemed to be included in tariff item No. 9897.00.00 in the List of Tariff Provisions set out in the schedule to the *Customs Tariff*, with section 136 of that Act applying accordingly.

#### **Power of the Court – Copyright**

47. A court may make an order if the court is satisfied that:
- a) copies of the work are about to be imported into Canada, or have been imported into Canada but have not been released.
  - b) the copies were either made without the consent of the person who is owner of the **copyright** in the country where they were made, or made elsewhere than in a country to which this Act extends; and
  - c) the copies would infringe **copyright** if they were made in Canada by the importer and the importer knows or should have known this.
48. A court may make an order on application by the RH/owner of the **copyright** in a work in Canada.
49. In an order made, the court may:
- a) direct the CBSA to take reasonable measures, on the basis of information reasonably required by the CBSA and provided by the applicant, to detain the copies of the work, and to notify the applicant and the importer, immediately after detaining the copies of the work, of the detention and the reasons for the detention; and

- b) provide for any other matters that the court considers appropriate.
50. An application for an order may be made in an action or otherwise, and either on notice or ex parte, except that it must always be made on notice to the CBSA.
51. Before making an order, the court may require the applicant to furnish security, in an amount fixed by the court,
- a) to cover duties, storage and handling charges and any other amount that may become chargeable against the copies of the work; and
  - b) to answer any damages that may be reason of the order be incurred by the owner, importer or consignee of the work.
52. The CBSA may apply to the court for direction in implementing an order.
53. The CBSA may give the applicant or the importer an opportunity to inspect the detained copies of the work for the purpose of substantiating or refuting, as the case may be, the applicant's claim.
54. Unless an order provides otherwise, the CBSA shall, subject to the *Customs Act* and to any other Act of Parliament that prohibits, controls or regulates the importation or exportation of goods, release the copies of the work without further notice to the applicant if, within (10) ten working days after the applicant has been notified, the applicant has not notified the CBSA that they have commenced a proceeding for a final determination by the court.
55. If, in a proceeding commenced under this section, the court is satisfied that the circumstances referred to in paragraph 47 (b) and (c) existed, the court may make any order that it considers appropriate in the circumstances, including an order that the copies of work be destroyed, or that they be delivered up to the plaintiff as the plaintiff's property absolutely.
56. For greater certainty, nothing in this section affects any remedy available under any other provision of this Act or any other Act of Parliament.
57. A court may make an order in relation to a book where the court is satisfied that:
- a) copies of the book are about to be imported into Canada, or have been imported into Canada but have not yet been released;
  - b) copies of the book were made with the consent of the owner of the copyright in the book in the country where the copies were made, but were imported without the consent of the owner in Canada of the copyright in the book; and
  - c) the copies would infringe copyright if they were made in Canada by the importer and the importer knows or should have known this.
58. A court may make an order in relation to a book on application by:
- a) the owner of the copyright in the book in Canada;
  - b) the exclusive licensee of the copyright in the book in Canada; or
  - c) the exclusive distributor of the book.

59. Paragraphs 57 and 58 only apply where there is an exclusive distributor of the book and the acts described in those subsections take place in the part of Canada or in respect of the particular sector of the market for which the person is the exclusive distributor.
60. Subsections 44.12(3) to (10) of the *Copyright Act* apply, with such modifications as the circumstances require, in respect of an order made under paragraph 58.
61. No exclusive licensee of the copyright in a book in Canada, and no exclusive distributor of a book, may obtain an order under section 44.2 of the *Copyright Act* against another exclusive licensee of the copyright in that book in Canada or against another exclusive distributor of that book.
62. Paragraph 47 applies, with such modifications as the circumstances require, in respect of a sound recording, performer's performance or communication signal, where a fixation or a reproduction of a fixation of it:
- a) is about to be imported into Canada, or has been imported into Canada but has not yet been released;
  - b) either i) was made without the consent of the person who then owned the copyright in the sound recording, performer's performance or communication signal, as the case may be, in the country where the fixation or reproduction was made, or ii) was made elsewhere than in a country to which Part II extends; and
  - c) would infringe the right of the owner of copyright in the sound recording, performer's performance or communication signal if it was made in Canada by the importer and the importer knows or should have known this.
63. Notwithstanding anything in the *Copyright Act*, it is lawful for a person:
- a) to import for their own use not more than two copies of a work or other subject-matter made with the consent of the owner of the copyright in the country where it was made;
  - b) to import for use by a department of the Government of Canada or a province copies of a work or other subject-matter made with the consent of the owner of the copyright in the country where it was made;
  - c) at any time before copies of a work or other subject-matter are made in Canada, to import any copies, except copies of a book, made with the consent of the owner of the copyright in the country where the copies were made, that are required for the use of a library, archive, museum or educational institution;
  - d) to import, for the use of a library, archive, museum or educational institution, not more than one copy of a book that is made with the consent of the owner of the copyright in the country where the book was made; and
  - e) to import copies, made with the consent of the owner of the copyright in the country where they were made, of any used books, except textbooks of a scientific, technical or scholarly nature for use within an educational institution in a course of instruction.
64. An officer of customs may, in the officer's discretion, require a person seeking to import a copy of a work or other subject-matter under this section to produce satisfactory evidence of the facts necessary to establish the person's right to import the copy.

## **Power of the Court – Trademarks**

### **Proceedings for Interim Custody**

65. Where a court is satisfied, on application of any interested person, that any registered trademark, any trademark that is confusing with a registered trademark or any trade name has been applied to any goods that have been imported into Canada or are about to be distributed in Canada in such a manner that the distribution of the goods would be contrary to the *Trademarks Act*, or that any indication of a place of origin has been unlawfully applied to any goods, the court may make an order for the interim custody of the goods, pending a final determination of the legality of their importation or distribution in an action commenced within such time as is prescribed by the order.
66. Before making an order under paragraph 62, the court may require the applicant to furnish security, in an amount fixed by the court, to answer any damages that may by reason of the order be sustained by the owner, importer or consignee of the goods and for any amount that may become chargeable against the goods while they remain in custody under the order.
67. Where, by the judgment in any action under this section finally determining the legality of the importation or distribution of the goods, their importation or distribution is forbidden, either absolutely or on condition, any lien for charges against them that arose prior to the date of an order made under this section has effect only so far as may be consistent with the due execution of the judgment.
68. Where in any action under this section the court finds that the importation is or the distribution would be contrary to this Act, it may make an order prohibiting the future importation of goods to which the trademark, trade name or indication of origin has been applied.
69. An application referred to in paragraph 62 may be made in an action or otherwise, and either on notice or *ex parte*.
70. No proceedings may be taken under paragraph 62 for the interim custody of goods by the Minister if proceedings for the detention of the goods by the Minister may be taken under section 53.1 of the *Trademarks Act*.

### **Power of the Court to Grant Relief**

71. If a court is satisfied, on application of any interested person, that any act has been done contrary to the *Trademarks Act*, the court may make any order that it considers appropriate in the circumstances, including an order providing for relief by way of injunction and the recovery of damages or profits, for punitive damages and for the destruction or other disposition of any offending goods, packaging, labels and advertising material and of any equipment used to product the goods, packaging, labels or advertising material.
72. Before making an order for destruction or other disposition, the court shall direct that notice be given to any person who has an interest or right in the item to be destroyed or otherwise disposed of, unless the court is of the opinion that the interests of justice do not require that notice be given.
73. A court is not permitted, in any proceeding under section 53.1 or 53.2 of the *Trademarks Act*, to make an order under that section requiring or permitting the goods to be exported, sold or distributed in an unaltered state, except in a manner that does affect the legitimate interests of the owner of the protected mark or except in exceptional circumstances, if the court find that
  - a) goods bearing the registered Trademark have been imported into Canada in such a manner that the distribution of the goods in Canada would be contrary to this Act; and

- b) the registered Trademark has, without the consent of the owner, been applied to those goods with the intent of counterfeiting or imitating the Trademark, or of deceiving the public and inducing them to believe that the goods were made with the consent of the owner.

74. Paragraph 64 also applies with respect to goods for which the only alternation is the removal of the Trademark.

### **Information (Intel) about a Suspected Counterfeit or Pirated Goods Shipment Provided by RH/Owners to the CBSA**

75. If a RH/owner would like to provide the CBSA with information about a dangerous goods shipment that they suspect is counterfeit and/or pirated, they can contact the [Border Watch Toll-free Line](tel:1-888-502-9060) at 1-888-502-9060 within the United States and Canada.

### **Penalties**

76. There are penalty provisions for IPR infringement in the relevant legislation. It is not up to the CBSA to determine how to proceed nor does CBSA assess penalties or prosecute. The CBSA only acts upon the direction of the court.

### **Additional Information**

77. Additional Information about the IPR Program may be obtained by visiting the CBSA's website: [Combatting Counterfeit Products \(Intellectual Property Rights\)](#).

78. The CBSA's Border Information Service (BIS) line responds to public inquiries related to import requirements of other government departments, including Industry Canada. You can access BIS toll-free throughout Canada by calling 1-800-461-9999. If you are calling from outside Canada, you can access BIS by calling 204-983-3500 or 506-636-5064 (long-distance charges will apply). To speak directly to an agent, please call during regular business hours from Monday to Friday (except holidays), 8 a.m. to 4 p.m. local time. More BIS information can be found on the CBSA's website at [www.cbsa.gc.ca](http://www.cbsa.gc.ca).

## Appendix A – Sample RFA Acceptance Notification

[Insert RFA#]

[Date ACCEPTANCE EMAIL IS BEING SENT]

[NAME OF TRADEMARK, COPYRIGHT OR GEOGRAPHICAL INDICATION RIGHTS HOLDER/OWNER]

[Address of TRADEMARK, COPYRIGHT OR GEOGRAPHICAL INDICATION RIGHTS HOLDER/OWNER]

Dear Mr./Ms. [Name of REPRESENTATIVE FOR SERVICE/PERSON WHO SUBMITTED THE RFA],

Your Request for Assistance has been accepted by the Canada Border Services Agency (CBSA) under its Intellectual Property Rights Program.

Should the CBSA intercept suspected counterfeit and/or pirated goods matching the information provided in your application, the goods in question may now be temporarily detained for up to three business days so you can decide if you wish to pursue remedy through civil court. If you have not responded within 3 business days, the goods will be released.

If you decide to pursue legal remedy through civil court, a “Rights Holders Notice of Detention for Goods Suspected of Contravening IPR” will be issued providing you with the necessary information to file your claim. The CBSA will detain the suspected goods for a maximum of 10 working days (5 days if perishable); in some cases an extension can be granted for the detention of non-perishable goods. The CBSA requires, within these timeframes a copy of the court documents for the file and continued detention of the suspected goods.

By enrolling in the IPR Program, you accept liability for any costs associated with storage, handling and destruction of detained goods beginning the day after the “Rights Holders Notice of Detention for Goods Suspected of Contravening IPR” has been issued.

As a registrant of the CBSA’s IPR Program, you are encouraged to act promptly and diligently by responding to CBSA notices and take appropriate steps to enforce rights or decline the opportunity to do so. Repeated and unnecessary delays may be considered in future applications, renewals, and security requirements.

An approved RFA is valid for 2 years. To renew your RFA, it is necessary to resubmit an application 40 days before the expiry to ensure a seamless renewal of the application. It is the sole responsibility of the rights owners to ensure renewal requests are received within the allotted timeframe for processing.

Thank you for your interest in the CBSA’s IPR Program. Please feel free to send any questions, comments or concerns to [CBSA-ASFC\\_IPR-DPI@cbsa-asfc.gc.ca](mailto:CBSA-ASFC_IPR-DPI@cbsa-asfc.gc.ca).

Sincerely,

## Appendix B – Sample RFA Rejection Notification

[Date REJECTION EMAIL IS BEING SENT]

[NAME OF TRADEMARK, COPYRIGHT OR GEOGRAPHICAL INDICATION RIGHTS HOLDER/OWNER]

[Address of TRADEMARK, COPYRIGHT OR GEOGRAPHICAL INDICATION RIGHTS HOLDER/OWNER]

Dear Mr./Ms. [Name of REPRESENTATIVE FOR SERVICE/PERSON WHO SUBMITTED THE RFA],

Thank you for your interest in the Canada Border Services Agency’s Intellectual Property Rights Program.

This is to advise that the Request for Assistance (RFA) application you submitted, dated <<date of receipt of RFA>>, for “<<Name of Right holder>>” cannot be processed at this time.

(Choose appropriate reason)

[The following information is either missing or incomplete:

Section A, Box 1  
 Section A, Box 2  
 Section A, Box 3  
 Section B, Box 6  
 Section C]

[You must indicate an agent for service in Canada.]

[The trade mark(s) for which you have submitted an RFA are not currently registered in Canada under your name.]

Trademarks must be registered with the Canadian Intellectual Property Office (CIPO). It is recommended that copyright also be registered with CIPO. For more information on registering a copyright or trademark with CIPO please visit its webpage at [www.cipo.ic.gc.ca](http://www.cipo.ic.gc.ca) .

Please feel free to send any questions, comments or concerns to [CBSA-ASFC\\_IPR-DPI@cbsa-asfc.gc.ca](mailto:CBSA-ASFC_IPR-DPI@cbsa-asfc.gc.ca).

Sincerely,

## Appendix C – Sample RH/Owners Notice of Detention for Goods Suspected of Contravening IPR

**Rights Holder's/Owner's Notice of Detention for Goods  
Suspected of Contravening IPR**

[DATE]

[NAME OF TRADEMARK, COPYRIGHT OR GEOGRAPHICAL INDICATION RIGHTS HOLDER/OWNER]

[ADDRESS]

This is to inform you that the following goods were encountered on [DATE OF DETENTION].

Notification of your intent to commence action has been received by the Canada Border Services Agency (CBSA).

Description of Goods:	
Date Release Request Submitted:	
Quantity:	
Country of Origin:	
Location of Goods:	
Name and Address of Owner:	Name and Address of the Importer:
Name and Address of the Exporter:	Name and Address of the Consignee:
Name and Address of Any Other Person Involved in the Movement of the Goods:	

Pursuant to section 44.04(2) of the *Copyright Act* and section 51.06(2) of the *Trademarks Act*, the CBSA may detain these goods for a maximum period of 10 working days (5 days if goods are perishable) to allow you time to file a case in civil court if you would like to pursue legal remedy. If you require an extension for **non-perishable goods**, you may request that the CBSA consider extending the detention period for up to an additional ten (10) day period. Extensions are at the discretion of CBSA and your written request for an extension should explain why an extension is necessary in the particular circumstances of your case.

**Please Note:**



The CBSA has discretion to release these goods at any time, for any reason, unless and until you provide CBSA with a copy of a document filed with the Federal Court or the superior court of your province that commences proceedings to obtain a remedy under section 44.04(3) of the *Copyright Act* or section 51.06(3) of the *Trademarks Act*. It is your responsibility to ensure that your notice is received by CBSA.

In accordance with subsection 44.07 (1) of the *Copyright Act* and subsection 51.09 (1) of the *Trademarks Act*, the copyright and/or trademark and/or geographical indication owner holder is liable for the storage, handling and destruction of detained goods beginning on the day after the notice of detention is issued and ending on the first day on which one of the following occurs:

- A) Written notification is received stating that the importation or exportation in question does not contravene your Canadian copyright, trademark, or geographical indication;
- B) Written notification is received stating that the copyright or trademark or geographical indication owner will not commence proceedings to obtain a remedy under the *Trademarks Act* and/or *Copyright Act* while the goods are detained; and
- C) The goods are no longer held by the CBSA for the purposes of enforcing Canadian trademarks.

In accordance with section 44.06 of the *Copyright Act* and 51.08 of the *Trademarks Act*, at the discretion of CBSA, you may be provided with an opportunity to inspect the above-mentioned goods. Please advise the undersigned by email if you wish to pursue and they will make the appropriate arrangements.

[NAME AND EMAIL ADDRESS OF REGIONAL CONTACT]

<b>References</b>	
<b>Issuing Office</b>	Program and Policy Management Division Commercial Programs Directorate Commercial and Trade Branch
<b>Headquarters File</b>	4581-0, 4581-1, 4581-2, 4581-2-1, 4581-2-2, 4581-5, 4581-5-1, 4581-5-2
<b>Legislative References</b>	<a href="#"><i><u>Combating Counterfeit Products Act</u></i></a> <a href="#"><i><u>Copyright Act</u></i></a> <a href="#"><i><u>Customs Act</u></i></a> <a href="#"><i><u>Customs Tariff</u></i></a> <a href="#"><i><u>Integrated Circuit Topography Act</u></i></a> <a href="#"><i><u>Interpretation Act</u></i></a> <a href="#"><i><u>Trademarks Act</u></i></a>
<b>Other References</b>	<a href="#"><u>D4-1-4</u></a> , <a href="#"><u>D4-1-5</u></a> , <a href="#"><u>D4-1-7</u></a>
<b>Superseded Memorandum D</b>	D19-4-3 dated September 21, 2017