

Contributing firm
Cabinet Aksiman



Authors

El Mostafa Aksiman and **Mohamed Amine Aksiman**

Legal framework

Industrial property in Morocco is regulated by the Industrial Property Law (17-97), as amended and supplemented by Law 31-05. Decree 2-00-368 of June 7 2004 sets out the conditions of the law's implementation. The other applicable acts are:

- the Copyrights and Connected Rights Law (2-00); and
- the Protection of New Plant Varieties of Plants Law (9-94), as amended and supplemented by Law 34-05.

Morocco is a signatory to the following international conventions and treaties:

- the Paris Convention for the Protection of Industrial Property;
- the Berne Convention for the Protection of Literary and Artistic Works;
- the Madrid Agreement for the International Registration of Marks;
- the Madrid Protocol;

- the Hague Agreement concerning the International Registration of Industrial Designs;
- the Lisbon Agreement;
- the Nice Classification;
- the Brussels Convention relating to the Distribution of Programme-Carrying Signals Transmitted by Satellite;
- the Moroccan Office for Industrial Property Convention relating to the World Intellectual Property Organisation;
- the Nairobi Treaty on the Protection of the Olympic Symbol;
- the Trademark Law Treaty; and
- the Patent Cooperation Treaty.

Border measures

The Industrial Property Law provides for two types of border measure:

- the customs detention procedure; and
- the seizure procedure.

Customs detention procedure

The Customs and Indirect Tax Administration may, upon an application filed by the owner

of a registered mark or a beneficiary of an exclusive right of exploitation, suspend the free circulation of goods that:

- are suspected of being counterfeit; and
- bear a mark that is identical or similar to the applicant's registered mark, causing confusion with authentic goods.

The application must:

- be supported by appropriate elements proving that an infringement of the protected rights has taken place; and
- provide sufficient information about the suspected goods to enable Customs to establish whether they are counterfeits.

The applicant, petitioner or owner of the goods shall be informed, without delay, of the suspension measure taken by Customs.

The application for suspension is valid for a year or for the period during which the trademark registration on which it is based remains valid, whichever is shorter.

Seizure procedure

When Customs knows or suspects that goods

“ Goods suspended from free circulation and identified, according to a final court decision, as counterfeit shall be destroyed, barring exceptional circumstances ”

that are imported or in transit are counterfeit, it automatically suspends them from circulation. Customs then advises the rights holder without delay about the measures taken and provides, upon request, the name and address of:

- the sender;
- the importer; and
- the owner of the goods or their addressee.

Customs also informs the rights holder of the quantity of goods at issue.

The declarant or holder of the goods is also informed of this measure without delay.

The suspension procedure will be lifted 10 working days after the rights holder has been notified of the measure unless, within that period, it has:

- provided evidence to Customs of measures taken or actions initiated according to the law; and
- filed a suit as prescribed by law.

Legal actions

The rights holder may choose between two types of suit:

- an application for preliminary measures, which should be filed with the court that has jurisdiction over the location where the goods were imported. The president of the relevant court will then issue a decision; or
- a full lawsuit, which requires the payment of a bond in case the suspected goods turn out to be genuine.

To bring these proceedings, the applicant must obtain from Customs the names and addresses of the sender, importer and consignee or holder of the products, as well as the quantity of goods at issue.

Goods suspended from free circulation and identified, according to a final court

decision, as counterfeit shall be destroyed, barring exceptional circumstances.

If the goods prove to be genuine, the importer may apply to the court for an order requiring the plaintiff to pay damages to compensate for any harm caused.

Criminal prosecution

Counterfeiting is a criminal offence and is subject to penalties, including fines and imprisonment.

Penalties may range from one to six months' imprisonment and between €5,000 and €50,000 in fines, depending on the nature of the infringement. The court may also order the destruction of counterfeit goods that are the property of the counterfeiter and all equipment used to manufacture the counterfeit products.

Civil enforcement

Any party that infringes a manufacturer's mark, trademark or service mark may be prosecuted *ex officio* by the public prosecutor, without the need for the rights holder or a third party to file a complaint.

Preliminary measures

In case of infringement, the holder of an exclusive right may ask the court to issue a descriptive seizure order. Such orders are enforced by bailiffs, who will be authorised to search for and detail any evidence of counterfeiting.

The enforcement of such an order depends on the payment into court by the applicant of a bond that will cover any damage suffered by the defendant should the action prove groundless.

The rights holder must file an infringement action with the court within 30 days of execution of the seizure order. Failing to file an infringement action will result in the seizure becoming void, without

prejudice for possible damages.

When an infringement action is brought to court, the court president may issue an interim measure:

- provisionally prohibiting the alleged infringing activity; or
- allowing the defendant to continue the activity on condition that it undertakes to compensate the rights holder or its licensee for any damage caused during that time should the claim prove successful.

The prohibition or the guarantee constitution will not be admissible unless:

- the civil action seems serious; and
- the civil action is filed within 30 days of the rights holder being notified of the facts on which the action is based.

Should the infringement action prove groundless, the court will order the plaintiff to compensate the defendant for any possible damages and prejudice it has suffered as a result of the action.

Remedies

Following a successful civil action against a counterfeiter, the infringing goods and any equipment used in their manufacture will be destroyed, barring exceptional circumstances. The rights holder can also apply for:

- damages covering the actual damage caused by the infringement; or
- a discretionary award of between €500 and €2,500, depending on what the court feels is appropriate.

Anti-counterfeiting online

No specific regulations apply to online trade in Morocco at present. Rights holders must use the standard measures provided under the current legislation to deal with online infringements.

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Preventive measures/strategies

In addition to the provisions available to fight counterfeiting, the Moroccan government recently launched a new industrial property and anti-counterfeiting body – the National Committee for Industrial Property and Anti-counterfeiting. This body is tasked with:

- raising awareness among consumers, businesspeople and companies about rules and regulations applicable to industrial property;
- assisting in training staff at the competent authorities;
- reinforcing the legislative framework; and
- assessing the impact of counterfeiting on the economy.

The production of counterfeits on a commercial scale is relatively rare in Morocco and is limited in scope. This is due mainly to the fact that technology is not available locally to reproduce even simple industrial goods. Counterfeiters in Morocco would struggle to manufacture products such as car spare parts because they do not have access to the machinery necessary to produce them. The local production of counterfeits is limited to the best-performing local industries – namely, agribusiness, textiles (mainly the clothing industry), leather manufacture and audiovisual goods.

The key issue with regard to counterfeiting and piracy in Morocco is the import of foreign goods. The main traffic in contraband comes from Spain through Ceuta and Mellila – two Spanish enclaves in northern Morocco. These two cities have become hubs for the import and transit of counterfeits from Spain and Asia, consisting mainly of clothing, food products, cosmetics, electronics, domestic appliances,

household goods, tyres and automotive spare parts.

This illegal trade has had a major impact on the Moroccan economy and contributed to the closure of several industrial and commercial companies in the north of the country, which lost sales as a result of the rise in cheap knockoffs.

The border with Algeria is becoming a hotspot for counterfeit goods and other illegal trade, in particular drugs, food products (eg, coffee) and fuel. A recent investigation conducted by Cabinet Aksiman uncovered a large-scale trade in counterfeit perfumes of large US and EU brand owners. This trade has now developed to such an extent that shops selling counterfeit perfumes are flourishing all over the country.

Another important problem is the proliferation of pirated DVDs, CDs and other audiovisual products. Customs regularly seizes and destroys these products publicly. Nevertheless, such symbolic actions appear to have no real deterrent effect.

Unfortunately, the tools available to fight counterfeiting are insufficient and inappropriate. They cannot meet the real needs of local markets and neither can they meet those of international rights holders. Counterfeiting and piracy are comparatively small-scale activities in Morocco, but unless adequate measures are taken, they could be catastrophic for the local economy. [WTR](#)



CABINET AKSIMAN
INTELLECTUAL PROPERTY OFFICE

Biographies Cabinet Aksiman

Cabinet Aksiman
60 Boulevard Ibn Tachfine
1st Floor no. 3
20310 Casablanca, Morocco
Tel +212 5 22 31 05 50
Fax +212 5 22 31 04 53
Web www.aksiman.com



El Mostafa Aksiman
Founding partner
info@aksiman.com

El Mostafa Aksiman became active in the field of intellectual property after he discovered a passion for innovation and creativity when he filed his first patent application in the 1970s. In 1981 Mr Aksiman created the Association of Inventors and Innovators of Morocco and the Arabic World, of which he became president. He founded Cabinet Aksiman in 1982.

Mr Aksiman has played an important role in the development of the profession of IP counsel in Morocco. He is recognised for his expertise and was accordingly awarded the Belgian medal of *Chevalier de l'Ordre du Mérite de l'Invention*.

Mr Aksiman has conducted a number of studies on the role of industrial property in the resolution of problems such as unemployment, business creation and technology transfer. He was designated by the Counterfeiting Intelligence Bureau as the exclusive representative in Morocco of the Counterforce Network.



Mohamed Amine Aksiman
Industrial property counsel
info@aksiman.com

Mohamed Amine Aksiman joined the office in 2008 after completing several training courses. Previously, Mr Aksiman undertook training in industrial property matters in France. He is currently industrial property counsel in charge of oppositions and relations with the patent administration office.