

Contributing firm  
**Cabinet Aksiman**



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## Legal framework

### Moroccan regulations

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 its implementation. The other applicable acts are:

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

### International regulations

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 Organization;
- the Nairobi Treaty on the Protection of the Olympic Symbol;
- the Treaty on the Right of Marks; and
- the Patent Cooperation Treaty.

### Border measures

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

- 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 which:

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

The application must:

- be supported by appropriate elements proving an infringement of the protected rights; and
- provide sufficient information about the suspected goods to enable the customs authorities 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 the customs authorities.

The application for suspension is valid for a year or the period during which the

trademark registration on which it is based remains valid, whichever is the shorter.

#### **Seizure procedure**

When the customs authorities know or suspect that the goods that are imported or in transit are counterfeit, they automatically suspend the goods from circulation. The customs authorities then advise the rights holder without delay about the measure taken. They also provide the rights holder, upon request, with the name and address of:

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

The customs authorities will also inform 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, the rights holder has:

- provided evidence of measures taken or actions initiated according to the law to the customs authorities; 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 of importation of the goods at issue. 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 the customs authorities 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 products 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 that include 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 specifically to manufacture counterfeit products.

#### **Civil enforcement**

Any party that infringes a manufacture 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**

**Seizure procedure:** 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 authorized to search for and detail any evidence of counterfeiting.

The enforcement of such an order is dependent 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 the execution of the seizure order. Failing to file an infringement action will result in the seizure becoming void, without prejudice for possible damages.

**Provisional prohibition:** 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 undertake to compensate the rights holder or its licensee for any damage caused during

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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 infringement relating to the Internet.

### 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 *Comité National pour la Propriété Industrielle et Anti-contrefaçon*. This body is tasked with:

- raising awareness among consumers, businesspeople and companies about rules and regulations applying to industrial property;
- assisting in the training of staff of 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 would not have access to the machinery necessary to produce such parts. The local production of counterfeits is limited to the best performing local industries – namely, agribusiness, textile (mainly the clothing industry), leather manufacture and audiovisual.

The key issue with regard to counterfeiting and piracy in Morocco comes from the importation of foreign goods. The main traffic in contraband comes from Spain through Ceuta and Mellila – two Spanish enclaves in northern Morocco. The two cities have become hubs for the importation and transit of counterfeits from Spain and Asia.

These counterfeit goods consist mainly of:

- clothing;
- food products;
- cosmetics;
- electronics;
- domestic appliances;
- household goods;
- tyres; and
- automotive spare parts.

This illegal trade has a huge impact on the Moroccan economy and had a hand in 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 discovered large-scale trade in counterfeit perfumes of large US and EU brand owners. This trade 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. The customs authorities regularly seize and destroy these products publicly. Nevertheless, such symbolic actions seem 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 become catastrophic for the local economy. [WTR](#)



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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 recognized for his expertise and the exceptional quality of his services and was accordingly awarded the Belgian medal of *Chevalier de l'Ordre du Mérite de l'Invention*.

Mr Aksiman 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.