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DEL AZUAY**

**University of Azuay**

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“Analysis of the regulation and application of border measures in Ecuador  
and their impact on the protection of intellectual rights”

**Thesis prior to obtaining the Degree in International Studies with a Bilingualism  
mention in Foreign Trade**

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**Cuenca, Ecuador 2020**

## **Dedication**

I dedicate this degree work mainly to God, to my angel, my mother Claudia who has been my pillar and main motivation and who has taught me about unconditional love, strength, courage and perseverance to achieve everything I set out to do, to my sister Valentina and to my family in general.

I want to dedicate this work to the most unconditional people in my life: my daddy Fernando, my mommy Fanny and my life partner: Marco.

## **Acknowledgements**

I thank God, my beloved aunts who gave me all their trust and support to end this stage of my life, my grandparents Blanca and Jaime who have given me their wisdom to face life, my dear study friend Maria Jose for having walked with me this journey from the beginning, my tutor Susana Vazquez for guiding us during these months of work and all the people who in one way or another contributed to the realization of it.

I cannot help but thank the Supreme Being who has given me the life and wisdom to get where I am today. To my beloved parents, who have always been there for me, to my aunt Alejandra who has been my second mother, to my partner and friend Paula, for going through this journey and reaching the goal together like from the first day and finally to that special person who is my motivation day by day to improve myself and keep on fulfilling more dreams, my dear Marco.

## INDEX OF CONTENTS

INTRODUCTION.....	13
CHAPTER 1: PROPERTY AND INTELLECTUAL RIGHTS .....	17
1.1 Notion of Property and Intellectual Rights.....	17
1.2 Historical Background of Intellectual Property.....	18
1.3 Regulation of Intellectual Property in Ecuador .....	21
1. The Constitution of the Republic .....	21
2. International Instruments.....	25
2.1 Paris Convention.....	25
2.2.- Berne Convention.....	26
2.3.- TRIP`S.....	27
2.4.- WIPO-Administered Treaties.....	28
2. Supranational regulations .....	28
Decision 351.-.....	29
Decision 486.-.....	30
Decision 345.-.....	31
3. Nacional Law.....	31
4. General Regulations of the "Ingenios" Code.....	33
1.3 Areas of intellectual property:.....	33
a. Industrial property:.....	33
a.1. Distinctive signs.....	33
1. Brand. -.....	34
2. Trade motto. -.....	35
3. Trade names. –.....	35
4. Distinctive Appearance. -.....	35
5. Designation of origin and geographical indication. -.....	36
6. Traditional specialities guaranteed. -.....	36
a.2 Invention patents. –.....	36
1. Patents proper. -.....	36
2. Utility models: .....	38
3. Industrial designs. -.....	38
1.5 Areas of Intellectual Property: Copyright and Related Rights.....	39
A. Copyright.....	39
Principles of Copyright. -.....	40

1. Non-protection of ideas. - .....	40
2. Non-discrimination of the work. - .....	40
3. Automatic site protection. - .....	40
4. Autonomy and compatibility of copyright. - .....	41
Difference between author and owner of a work.....	41
Duty rates .....	42
a. Moral rights: .....	42
1. Parenthood:.....	43
2. Dissemination:.....	43
3. Integrity:.....	43
4. Access to the unique or rare copy of the work:.....	43
b. Economic Rights: .....	44
1- Reproduction: .....	44
2- Public Communication:.....	44
3- Public distribution:.....	44
4- Import: .....	45
5- Transformation: .....	45
6- Making available to the public:.....	45
7- Resale of plastic works: .....	45
B. Related Rights .....	46
Categories of related rights: .....	47
1. The artists, performers:.....	47
2. The Phonogram Producers:.....	47
3. Broadcasting organizations: .....	48
1.6 Intellectual Rights: Exceptions and Limitations to Intellectual Rights.....	49
1.6.1- Exceptions and limitations to copyright and related rights.....	49
1.6.2.- Limitations on trademark law.....	50
1.6.3.- Limitations on patent law.....	51
1.6.4.- Limitations on the breeder's right.....	52
Conclusion.....	53
CHAPTER 2: BORDER MEASURES IN THE FIELD OF CUSTOMS AND INTELLECTUAL	
.....	54
PROPERTY .....	54
2.1 Conceptual delineation of goods .....	54

2.2 Nature of border measures: Concepts, characteristics, classes, objectives and importance.....	54
Concept. –.....	54
Characteristics. –.....	55
Classes. –.....	55
Objectives. –.....	56
Importance. –.....	56
2.3 Border measures in the customs field.....	57
Competent body for non-tariff measures .....	60
Principles .....	60
Customs control .....	61
2.4 Border measures in the field of intellectual property.....	75
Classes. –.....	77
Objectives. –.....	79
2.5 Applicable regulatory framework.....	79
1. Constitution of the Republic of Ecuador.....	80
2.- Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS).....	80
3.- Regional Legislation - Decisions of the Andean Community of Nations - CAN.....	83
1. Decision 486 on Industrial Property:.....	83
2. Decision 351 on Copyright and Related Rights.....	85
3. Decision 345 on Plant Varieties.....	85
4.-National Legislation.....	87
4.1.- Organic Code of the Social Economy of Knowledge, Creativity ....	87
and Innovation – “INGENIOS” Code.....	87
4.2.- Intellectual Property Law and its Regulations.....	88
2.6 Exceptions to border measures.....	89
Sample with no commercial value.....	89
Personal or Traveler's Luggage .....	89
Small batches.....	90
2.7 Comparison of the Intellectual Property Law and the "Ingenios" Code.....	91
A.- Transcription of legal provisions .....	91
1.- Articles 342 and 343 of the Law on Intellectual Property .....	91
2.- Articles 575 to 583 of the current “Ingenios” Code .....	93

Reference to the differences identified between the regulatory bodies	95
1.- Object.....	95
2.- Procedure.....	96
Procedures provided for in the Law on Intellectual Property.....	96
Procedure provided for in the Organic Code of the Social Economy of .....	99
Knowledge Creativity and Innovation or "Ingenios" Code .....	99
3.- Competent body .....	101
4.- Regulation:.....	102
Regulations to the Law on Intellectual Property: .....	102
Regulations to the "Ingenios" Code: .....	103
B.- Comparative analysis of the above legal provisions.....	103
1.- General analysis:.....	103
2.- Specific analyses: .....	104
Conclusion.....	111
CHAPTER 3: BORDER MEASURES IN ECUADOR AND LATIN AMERICA.....	113
3.1 Nationals cases studies .....	113
3.1.1 Cases from the city of Cuenca .....	113
3.1.2 Cases from the city of Guayaquil .....	124
Conclusion.....	130
3.1.3 Comparison between the cities of Cuenca and Guayaquil and its .....	130
subsequent analysis: .....	129
Analysis .....	129
3.2 Analysis of legislation in three Latin American countries. Study of two cases of border measures in the Republic of Peru and the Republic of Colombia. ....	130
3.2.1 Republic of Peru .....	130
Procedure for the application of border measures in Peru: .....	131
Case of Border Measures in Peru: .....	134
Analysis of the case: .....	135
3.2.2 Republic of Argentina .....	136
3.2.2.1 The Legal Regime of Intellectual Property (Law 11.723) .....	136
3.2.2.2 Border measures - Law 25,986 (Customs Code) - Piracy and counterfeiting. ....	139

3.2.2.3 Law on Trademarks and Commercial Designations (Law 22,362)	140
Process for the implementation of a border measure in Argentina: ...	141
3.2.3 Republic of Colombia	142
Procedure	143
Article 4. Request for suspension of the customs operation.	143
Article 5. Content of the application.	144
Article 6. Effects of the application.	145
Article 7. Processing of the application.	145
Article 8: Intervention of the competent authority.	146
Article 10. Excluded operations.	147
Article 11. Directory of holders.	147
Case of Border Measures in Colombia:	148
Analysis of the case	149
3.2.4 Comparison between international legislation and Ecuadorian	
legislation	151
CHAPTER 4: DISCUSSION AND ANALYSIS OF RESULTS	154
4.1 Conclusions and Recommendations	154
4.1.1 Conclusions	154
4.1.2 Recommendations	157
Bibliography	159
Annexes	163

## **INDEX OF TABLES**

Table 1 Summary of similarities and differences between the Old Intellectual Property Law and the current "Ingenios" Code	109
Table 2 Summary of comparison of the information of the cases presented in the cities of Cuenca and Guayaquil	128
Table 3 Summary of similarities and differences between the legislations of Peru, Argentina, Colombia and Ecuador regarding intellectual rights and border measures	150

## **INDEX OF FIGURES**

Figure 1: Number of cases presented in the city of Cuenca from 2007 to 2020	
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.....	
121	
Figure 2: Country of origin of goods retained in the cases of Cuenca .....	122
Figure 3: Decisions agreed upon in the Border Measurement cases presented in the city of Cuenca. ....	
123	
Figure 4: Number of cases presented in the city of Guayaquil from 2008 to 2020. ....	
127	
Figure 5: Summary of the decisions agreed upon in the Border Measure cases presented in Guayaquil from 2008 to 2015 .....	128
Figure 6: Summary of the decisions agreed upon in the Border Measure cases presented in Guayaquil from 2016 to 2019. ....	129

**INDEX OF ANNEXES**

Annex A. Summary table of application of reasonable doubt .....	163
Annex B. National cases on border measures .....	165
Annex C. Case of the Republic of Colombia .....	223
Annex D. Interview .....	230

## **Summary**

This paper focuses on answering the question of whether or not there is effective protection of intellectual rights through the application of border measures in Ecuador. Border measures are understood as a protection mechanism that trademark or copyright holders have to request the Administration to stop the customs activity in which such rights could be infringed.

To reach the main objective of this work, an exhaustive analysis has been made about what intellectual rights comprise, as well as, through cases and statistical data, a review of the treatment given to border measures both in Ecuador and in three Latin American countries: Colombia, Peru and Argentina.

At the end of this research, we reached strict conclusions and finally made recommendations on how to better protect copyrights and trademarks through a correct and effective application of border measures in Ecuador.

## INTRODUCTION

For years, the notion of intellectual property protection has existed, which traditionally refers to creations that come from the mind, which can include literary works, artistic and scientific works and distinctive signs, but in the Ecuadorian legal system, plant varieties and traditional knowledge associated or not to a biological or genetic resource are also contemplated, so that now it is more accurate to speak of intellectual rights. The intellectual property, as its name indicates, confers to its owner, in addition to the faculties of the traditional domain, the possibility of activating the administrative or judicial apparatus for the defense of his intellectual creations.

The protection of intellectual property had its formal beginnings with two international conventions administered by the World Intellectual Property Organization-WIPO: The Paris Convention of 1883 for the protection of industrial property; and the Berne Convention, adopted in 1886 for the protection of literary and artistic works.

With regard to the Paris Convention, there are three categories of the fundamental provisions of this convention: national treatment, right of priority and common standards. The Berne Convention, for its part, was founded on three basic principles, as well as on a number of special provisions for developing countries seeking to benefit from it. The convention also refers to exceptions where works may be used without the author's authorization and without payment of compensation; all these principles and their exceptions will be exhaustively developed in the development of the thesis.

In the case of the Andean regulations, at the beginning of the 1970s, the countries of the sub region decided to establish a Common Regime, which was reflected, for example, in Decision 24 of the Cartagena Agreement, which proposed such a regime for the treatment of foreign capital and for trademarks, patents, licenses and royalties, establishing guidelines for the actions of the countries in this area; currently in force are Andean Decision 486

on Industrial Property and Decision 351 on Copyright and Related Rights, regulatory bodies which, in harmony with the Paris and Berne Conventions, establish the basic principles of intellectual property developed in the internal regulation, principles to which reference will be made in this research paper.

Internally speaking, in 1830 when Ecuador was constituted as an independent Republic, it saw the need to have its own legal framework to regulate the actions of individuals. In this sense, the concern for the protection of intellectual property was always present, since this issue was embodied in the Constitution of 1835, precisely in Article 99, which stated: "the author or inventor shall have exclusive ownership of his discovery, production, for the time granted by law, and if the law requires its publication, the inventor shall be given the corresponding compensation". (Political Constitution of Ecuador, 1835).

In this context, as we see, it has always been primarily the responsibility of the government authorities of each country to ensure these rights on the basis of international and regional agreements and national laws.

Precisely, as a form of protection of intellectual rights, there is an instrument called border measures, currently regulated in Ecuador through the Organic Code of the Social Economy of Knowledge, Creativity and Innovation, colloquially known as the "*Ingenious*" Code, which states that border measures are "precautionary measures that may be requested by the owner of a trademark or copyright who has knowledge that goods will be imported that infringe his rights. The purpose of these measures is to suspend the customs operation and have the goods detained". (Organic Code of the Social Economy of Knowledge, Creativity and Innovation, 2016).

In the case of Ecuador, when referring to border measures, it is the National Service for Intellectual Rights - SENADI, which is in charge in the first instance of knowing and resolving border measures, but since these are activities that take place specifically at the border, its work could go in parallel with the

National Customs Service of Ecuador-SENAE, since the latter is the entity that, according to the Organic Code of Production, Trade and Investment "COPCI", carries out non-customs control and the respective collection of taxes on this commercial practice.

In short, the protection of intellectual rights has evolved from the very existence of man to what it is today. Intellectual protection is now recognized as a human right and is based on strict international and regional instruments, as well as on the legislation of each country.

One of the mechanisms adopted for the protection of intellectual rights is border measures, the concept of which was detailed above. Through this research work, we intend to respond to the question of whether or not border measures are effective in Ecuador, to know their true impact, and finally, based on a comparison with other legislation, to propose certain changes to the legal provisions that contemplate them.

The main reason for this research is that it is considered that there is not enough knowledge at the academic and professional level, and even less in the community, about which are the faculties that assist the owners of trademarks and copyrights, not only to oppose the marketing of a product that infringes their trademark or intellectual creation, but also to prevent such product from entering through the borders of the country.

It is also clear that there is a high degree of ignorance about the fact that the ultimate purpose of intellectual property is to prevent consumers' rights from being affected when they acquire a product that is not original.

The research that was carried out was mixed, because it is theoretical, descriptive and inductive. In the first instance, we proceeded to consult bibliographic sources directly related to the topic, such as web pages of public institutions, books, previously developed theses, interviews, among other sources.

In turn, the research was based on the comparative analysis between the Intellectual Property Law and the "Ingenious" Code, thus allowing to assess the performance, evolution and applicability at a national level. Then we proceeded to the analysis of real cases in Ecuador in the cities of Cuenca and Guayaquil on the border measures presented from 2008 to 2020.

Finally, a comparison was made with laws that protect border measures in Peru, Argentina and Colombia specifically, to subsequently generate a critical analysis, as well as to make suggestions and recommendations based on the results obtained.

## **CHAPTER 1: PROPERTY AND INTELLECTUAL RIGHTS.**

### **1.1 Notion of Property and Intellectual Rights**

In order to make a first approach to the subject that will be developed in this work, it is important to outline a preliminary concept of what we should understand by intellectual property, thus, the World Intellectual Property Organization-WIPO although it does not expressly define what should be understood by intellectual property; however, it points out that intellectual property is reserved to the types of property that are the result of creations of the human mind, of the intellect, which allows us to deduce that intellectual property is a special type of property, since it comprises the three faculties of the domain, but that it falls on the products of the human intellect, and as a general rule, the rights that it implies, have a validity in time.

The world governing body of matter considers that intellectual property is related to the creations of the mind: inventions, literary and artistic works, as well as symbols, names and images used in commerce. Intellectual property is generally divided into two categories: industrial property and copyright, but in the case of Ecuador, as was initially mentioned, we are now talking about a broader concept such as intellectual rights, which include, in addition to the areas already mentioned, plant varieties and traditional knowledge, whether or not they are associated with a genetic resource.

It should be noted a priori that border measures in our country are reserved only for intellectual property, trademarks and copyrights, an aspect that will be taken up again later.

## 1.2 Historical Background of Intellectual Property

Most of the branches of law known today were originated in the Roman world; however, in the case of Intellectual Property, the emergence of a branch of law regulating it, is essentially modern.

Nevertheless, it is important to mention certain events that will allow a better understanding of the origin of Intellectual Property.

Thus, the first signs of invention date back to the origins of human life, since man, from his very existence, began to make tools or utensils of stone or metal that could facilitate his activities on Earth.

However, it was not until the 15th century that the first technological advances appeared and after the dark period of the Middle Ages, what is known as invention privileges arose, which corresponded to prerogatives granted by the King in order to exploit an invention. These prerogatives, however, were not a right as such, but a reward adopted in various ways: a cash prize, a salary, an income to continue inventing, or even a position in the administration.

One of the first known invention privileges in the world was granted in 1421 by the Republic of Florence to Federico Brunelleschi, the most remarkable architect of the Renaissance, for a barge with a crane for transporting marble. This privilege was granted for a period of three years.

Another example can be found in 1416 when the Council of Venice granted Franciscus Petri an exclusive monopoly for 50 years so that only he and his heirs could build a type of machine to cut and knit fabrics.

As a result, the first law regulating these privileges, known as the Venice Decree, was published in Venice in 1474.



The Law on Patents approved by the Senate of Venice in the 15th century stated that "any person who makes a new and ingenious device in this city shall be obliged to register it with the "Provveditore's Office" of the Commune, as soon as it has been perfected and it is possible to use and apply it", prohibiting other persons from doing so.

Thus, throughout the 15th century, these privileges of invention and manufacture continue to be granted throughout the European continent. Their granting is systematized with the enactment of legal instruments such as the Monopoly Statute in England in 1624, which authorizes the Monarch to grant monopolies on inventions.

However, years later, by a decree issued in Massachusetts, the granting of monopolies was prohibited unless they were profitable inventions for the country and for a short time.

Thus, it was in 1790 that President George Washington published the first American Patent Act and a year later France also passed its first Patent Act.

Thirty years later, in 1820, the Spanish Law was approved, which together with the French Law have served as an inspiring source in the field of patents, especially for Latin American countries.

In relation to distinctive signs, authors such as Sonia Mendieta, quoted by the treatise writer Marco Matías Alemán, consider that "the antecedents of this type of mark go back to prehistory, in the caves of southwestern Europe where in certain paintings marks have been found on painted animals, which apparently served to identify the owners..." (Alemán, 2012).

There are certain references to the fact that in ancient Greece signs were used to distinguish objects made by the inhabitants of the city, and that in Rome they were used to distinguish certain everyday articles, and above all these signs helped to recognize the authors so that they could collect their fees.

In addition to the above, in the Middle Ages, craftsmen had to use some distinctive sign that differentiated the products of each corporation with the aim of guaranteeing quality to their respective customers. Thus, it seems that the origin of trademark law dates back to 1373 with the Ordinances of Pedro IV of Aragon, which provided for the weavers of cloth manufactured in the town of Torroella in Spain, the placement of a tower as a local brand.

In spite of the above, it is after the Industrial Revolution, in the 19th century, when the trademark acquires the connotation that it has nowadays, since, when the production level of the companies is increased, counterfeits begin to be generated and consequently the need of a regulation that can control the nascent problem arises; in this way, the first laws that regulate the trademark law arise in Western Europe.

In the middle of the 19th century, almost all Latin American countries began to enact trademark laws inspired by the French system which attributes the birth of a trademark to its use; unlike the German system which makes the birth of the trademark conditional upon its registration with the competent national office.

As regards the origin of copyright, the Roman conception did not incorporate at all the idea of creation in the proper sense, but applied to its legal system the concept of the *specificatio* which consisted in an autonomous way of acquiring property. Roman law was more inclined to protect the material object used for writing or creation, but did not focus on protecting inventions or creations as such.

Therefore, copyright is a modern phenomenon that began to take shape with the appearance of the printing press created by Gutenberg in 1450, because at that time there were radical changes in the world and the production and sale of literary works increased, which began to give rights to printers and to eliminate certain privileges for both the church, kings and the most powerful

who wanted to control the market (Copyright Institute, 2017); Consequently, the dissemination of information resulted in knowledge that was for the exclusive use of the monasteries becoming available in school books throughout Europe.

But it was not until 1709 that the real legal recognition of authors began with the Statute of Queen Anne, "which ended the royal privilege of 1557 established in favor of the Stationers Company, which held the monopoly of book publication in England" (Copyright Institute, 2017), transforming it into a right for the authors and granting them the printing and sale of their work for a period of 14 years, renewable for the same period.

In Spain, the Royal Court of 1762, 1763 and 1764 granted authors the exclusive right to print their book, on a hereditary basis.

However, it was not until after the French Revolution in 1789 that the copyright governing Europe today, was established.

In 1813 the Cortes de Cádiz, granted the author the exclusive right to publish and reproduce his works during his lifetime and in addition the heirs were granted the power to reproduce them for a limited time.

Finally, in the 20th century, copyright is universally recognized as a right of the individuals, in the Universal Declaration of Human Rights of 1948 (Copyright Institute, 2017).

### **1.3 Regulation of Intellectual Property in Ecuador**

With respect to the regulation of intellectual property and more specifically intellectual rights, there are five types of normative bodies that regulate this matter in Ecuador:

- 1.-Constitution of the Republic
- 2.-International instruments:

- 2.1. International conventions such as the Paris Convention for the Protection of Industrial Property and the Berne Convention for the Protection of Literary and Artistic Works (1886).
- 2.2. Agreements such as the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS, 1996)
- 2.3. Treaties administered by WIPO, such as the WCT, (2002)
- 3.-Supranational regulations such as Decision 351 of the Andean Community on Copyright and Related Rights, Decision 486 on Industrial Property, and Decision 345 on Plant Varieties.
4. The National Law, specifically the Organic Code of the Social Economy of Knowledge, Creativity and Innovation, known colloquially as Code "Ingenios" (2016).
5. General Regulations for the "Ingenios" Code

We will then develop each of these sources:

### **1. The Constitution of the Republic.**

The first Ecuadorian normative precedent on the regulation of intellectual property dates back to the 1835 Constitution, article 99, which referred to intellectual property in the following terms

The author or inventor shall have exclusive ownership of his discovery or production for the time allowed him by law, and if the law should require its publication, the inventor shall be given the corresponding indemnification" (Political Constitution of Ecuador, 1835).

The 2008 Constitution expressly states the protection of intellectual property and tacitly recognizes intellectual rights without mentioning them, as shown in the following articles:

Article 322 of the Constitution entitled "Intellectual Property" states that it "recognizes intellectual property in accordance with the conditions established by law". The Constitution referred to the Law on Intellectual Property which in its article 1 determined: "The State recognizes, regulates and

guarantees the intellectual property acquired in accordance with the Law, the Decisions of the Commission of the Andean Community and the international conventions in force in Ecuador"(Constitution of the Republic of Ecuador, 2008).

Specifically, with regard to copyright and related rights, article 22 of the Constitution entitled "Right to artistic and cultural development" expressly guarantees copyright protection. This article links and conceives in an inseparable way the creative, cultural and artistic development with the intellectual property right as the necessary incentive and reward for the creators and artists who generate culture in our country.

*Art. 22.- "Persons have the right to develop their creative capacity, to engage in cultural and artistic activities in a dignified and sustained manner and to benefit from the protection of the moral and economic rights to which they are entitled by virtue of the scientific, literary or artistic productions of which they are authors" (Constitution of the Republic of Ecuador, 2008).*

The Constitution in this article simply recognizes the importance of copyright and its qualification as a human right as mandated by the Universal Declaration of Human Rights.

With respect to unfair competition, in Chapter VI Labor and Production, Section 5, "Economic exchanges and fair trade", Article 335 obliges the State to establish "the mechanisms of sanction to avoid any practice of unfair competition"(Constitution of the Republic of Ecuador, 2008). Most of the unfair competition practices take place within the framework of intellectual property rights (diluting intangible assets, misleading, unfair commercial use of test data or other confidential information or its disclosure, etc.). For this reason, the Constitution sanctions this type of illicit practices and punishes those who seek to benefit from the effort and work of others.

With respect to distinctive signs, reference is made to geographical indications and trademarks. With regard to geographical indications, article 281 of the

Constitution, in Chapter III on "Food Sovereignty", states that it shall be the responsibility of the State to promote the production, agro-food and fisheries processing of small and medium-sized production units, communities and popular and solidarity-based economy. This is precisely one of the policies that SENADI has undertaken to give intangible value to certain Ecuadorian agricultural and handicraft products belonging to small and medium-sized community production units and social and solidarity-based economy, through the protection of geographical indications or collective marks (Corral Ponce, 2010).

An example of this is the recognition of "cacao arriba" and "montecristi with the toquilla straw hats" as designations of origin and as an example of the registration of a collective mark to protect the producers are the "Salcedo ice cream". The recognition of a geographical indication determines that a product is unique in the world, being a way to add intangible value. This is rural development through intellectual property, policies that are being used by many poor countries, and Ecuador understood that these rights are true instruments of development, particularly in the rural sector (Corral Ponce, 2010).

With respect to trademarks in Chapter VI Labor and Production, Section 5a. "Economic exchanges and fair trade", in Article 336 second paragraph the Constitution makes a tacit reference to trademarks and other distinctive signs as the only legal instrument to make the market transparent and avoid confusion when acquiring a product or service. This article states that: "The State shall promote and ensure fair trade as a means of access to quality goods and services, which minimizes the distortions of intermediation and promotes sustainability. The State will ensure transparency and efficiency in the markets and will promote competition under equal conditions and opportunities, which will be defined by law". (Constitution of the Republic of Ecuador, 2008).

This provision refers to the Intellectual Property Law that guarantees a transparent market through distinctive signs, such as trademarks, trade names, distinctive appearances, commercial slogans, geographical indications.

With respect to patents and plant varieties, the Constitution in Section 8 "Science, technology, innovation and ancestral knowledge", promotes and encourages research and technological development, innovation and knowledge as the foundations of a new economy in the current world economic order, in particular promotes research in the field of traditional knowledge or ancestral knowledge (Corral Ponce, 2010).

Article 385 indicates the purposes of the national system of science, technology, innovation and ancestral knowledge and in its numeral 3, determines as one of the purposes the "Development of technologies and innovations that boost national production, increase efficiency and productivity, improve the quality of life and contribute to the realization of good living". (Corral Ponce, 2010).

## **2. International Instruments**

Ecuador is a signatory to a number of international agreements that also regulate this area, including the Berne Convention, the Paris Convention, the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) and the conventions administered by WIPO.

Formally, the importance of intellectual property is first recognized in the Paris Convention for the Protection of Industrial Property of 1833, and the Berne Convention for the Protection of Literary and Artistic Works of 1886.

### **2.1 Paris Convention**

With respect to the Paris Convention, it deals with Industrial Property and includes the issue of patents, trademarks, industrial designs, utility models,

service marks, trade names, geographical indications and unfair competition (Paris Convention for the Protection of Industrial Property, 1883).

In general, the provisions of this Convention can be divided into three main categories which are: national treatment, right of priority and common standards.

On national treatment, the Convention specifies that Contracting States must grant nationals of other Contracting States the same protection as they grant to their own nationals.

The right of priority is established in relation to patents, trademarks and industrial designs. This principle provides that when filing a first application for a patent for invention or for the registration of a mark which is filed in one of the Contracting States, the applicant may, during a period of 12 months (for patents and six months for industrial designs and marks), apply for protection in any of the other Contracting States; that is, such subsequent applications shall be considered as filed on the same day as the first application and shall have priority over subsequent applications which may be filed by other persons for the same invention, utility model, mark or design.

Finally, the common rules in the field of substantive law comprise the regulations establishing rights and obligations and rules to which all Contracting States must adhere. With respect to the common rules, among the most important are: in relation to patents, trademarks, industrial designs, trade names, indications of source, unfair competition (World Intellectual Property Organization WIPO, 1883).

## **2.2.- Berne Convention**

The Berne Convention, adopted in 1886, deals with the protection of artistic and literary works and gives creators of works the power to control who uses their works and under what conditions. It was founded on three basic principles, with minimum conditions of protection and provisions for



developing countries seeking to benefit from it (Berne Convention for the Protection of Literary and Artistic Works, 1886).

The three basic principles point out:

1. Principle of national treatment

The protection of works should not be subject to the fulfilment of any formality. Protection is independent of the existence of protection in the country of origin of the work.

2. The minimum conditions of protection refer to the works and rights to be protected and the duration of the protection.

Protection shall extend to all productions in the literary, scientific and artistic fields, in any form of expression.

The right to translate, the right to make adaptations and arrangements, the right to broadcast, the right to make a reproduction, etc., are recognized as exclusive rights of authorization.

With regard to the duration of protection, it is granted for a period of 50 years after the death of the author.

3. Developing countries are allowed to translate and reproduce works for teaching purposes without the authorization of the right holder, subject to the payment of remuneration to be established by law. (World Intellectual Property Organization WIPO, 1886)

### **2.3.- TRIP`S**

The Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) was created in 1996 by the World Trade Organization WTO, which included for the first time discussions on the aspects of intellectual property rights that had an impact on international trade, the result of which was the so-called TRIPS Agreement. In addition to trademarks and patents, this agreement covers other issues such as copyright and related rights, geographical indications and

industrial designs, among others (Trade-Related Aspects of Intellectual Property Rights, 1995).

This agreement provides for the obligation to bring national laws into conformity with the minimum standards it enshrines, and further provides for consultations to establish arrangements for cooperation and a mutually supportive relationship between WTO and WIPO in the field of intellectual property.

#### **2.4.- WIPO-Administered Treaties**

The World Intellectual Property Organization (WIPO) was created in 1970 with the entry into force of the 1967 WIPO Convention. WIPO was born as an organization that ensures the protection of the rights of creators and holders of intellectual property, working closely with its Member States and other stakeholders to ensure the proper functioning of these rights (World Intellectual Property Organization, 2007). Such is the case of Ecuador, which is working together with WIPO to properly regulate intellectual rights.

The WIPO Copyright Treaty, which was adopted in 1996 and entered into force in 2002, is a particular arrangement generated by the Berne Convention on the Protection of Authors' Works and Rights in the Digital Environment rights (World Intellectual Property Organization, 2002).

### **2. Supranational regulations**

At the regional level, the Andean Community Law on Industrial Property presents some special characteristics; thus, it is an autonomous law, which prevails over the internal law, is unique for all the member countries and is of direct and uniform application.

The most relevant aspects of Decisions 351, 486 and 345 of the Andean Community are developed below, which focus on specific issues:

## **Decision 351.-**

Given in the city of Lima, Peru, on the seventeenth day of December in the year nineteen hundred and ninety-three, focused specifically on the members of the Andean Community of Nations (CAN).

This Decision establishes a common regime on Copyright and Related Rights, recognizing the protection due to the authors and owners of works of invention that falls on all literary, artistic and scientific works that can be reproduced or disseminated by any form or means known or to be known.

In turn, it defines basic terminology for understanding the content and provisions of this Decision. It also specifies the moral rights and economic rights, establishes the duration of protection of these rights, as well as limitations and exceptions, deals with computer and database programs, transmission and assignment of rights, related rights, collective management, national offices competent in this field, procedural aspects, complementary provisions and also refers to transitional provisions.

The moral rights and the economic rights are detailed below, and it is important to take them into account:

- Moral rights: The author has the inalienable, unattachable, imprescriptible and unrenounceable right to:

a) Preserve the unpublished work or to disclose it;

(b) Claim authorship of the work at any time;

(c) Object to any distortion, mutilation or modification that would prejudice the decorum of the work or the reputation of the author.

- Economic rights: The author has the exclusive right to perform, authorize or prohibit:

(a) Reproduction of the work by any form or procedure;

- (b) Communication of the work to the public by any means that serves to disseminate the words, signs, sounds or images;
- (c) Distribution of copies or copies of the work to the public by sale, rental or hire;
- (d) Importation into the territory of any member country of copies made without the authorization of the owner of the rights;
- (e) Translation, adaptation, arrangement or other transformation of the work.

It is important to point out that the protection of these rights may not be less than for the entire lifetime of the author and up to 50 years following his death. Where the ownership of these rights belongs to a legal entity, the term of protection shall be 50 years following the making, disclosure or publication of the work, as the case may be.

As regards related rights, the protection of these rights shall in no way affect the protection of copyright in scientific, artistic or literary works Common (Regime on Copyright and Related Rights, 1993).

**Decision 486.-**

Given in the city of Lima, Peru, on the fourteenth day of September of the year two thousand, for all the Andean Community of Nations (CAN). This Decision replaces Commission Decision 344.

It establishes a Common Regime on Industrial Property, and begins by indicating which the general provisions are regarding National Treatment, Most Favored Nation Treatment, terms and deadlines, notifications, language, priority claims, and on abandonment and waiver.

Subsequently, everything related to Patents of Invention, Utility Models, Layout Designs of Integrated Circuits, Industrial Designs, Trademarks, Commercial Slogans, Collective Marks, Certification Marks, the Commercial Name, Signs, Geographical Indications, Well-known Distinctive Signs, claiming actions,

actions for infringement of rights (such as border measures), unfair competition related to industrial property.

Lastly, the final provisions, complementary provisions and transitional provisions are established (Common Regime On Industrial Property, 2000)

### **Decision 345.-**

Given in the city of Santafé de Bogotá, Colombia, on the twenty-first day of October in the year nineteen hundred and ninety-three.

This Decision establishes the Common Regime for the Protection of the Rights of Breeders of Plant Varieties.

It states that the purpose is:

- ✓ To recognize and ensure the protection of the rights of the breeder of new plant varieties by the granting of a breeder's certificate
- ✓ To promote research activities in the Andean area
- ✓ To promote technology, transfer activities within the Sub region and outside it.

In turn, key definitions are proposed for the understanding of the same, what refers to the recognition of the rights of the breeder, registration, obligations and rights of the breeder, the licensing regime, nullity and cancellation and finally the complementary and transitory provisions are proposed (Common Regime for the Protection of Plant Breeders' Rights, 1993).

### **3. Nacional Law**

The first Trademark Law of 1899, published in official register No. 988 of November 6 of the same year, was amended twice by Legislative and Executive decrees in October 1901.

In 1908, the new Trademark Law was issued, which, with several amendments, was in force until May 1998. In the same year, the Intellectual Property Law published in the Official Register No. 320 of May 19, 1998, entered into force. In addition to its regulation on intellectual matters, this law created the governing body on this subject in the country, the Ecuadorian Institute of Intellectual Property (IEPI).

The creation of the IEPI succeeded in bringing together under a single autonomous and decentralized state body the management and control of intellectual rights regulations. Having an institute specialized in this area was fundamental for the country because the objective of the new law was to promote foreign investment, thus achieving national development and improving the standard of living of its inhabitants.

The Intellectual Property Law was issued due to international pressure from Ecuador's most important economic partner, the United States of America, since the protection of Intellectual Property in the country was almost null due to the deficient legal scheme in this area, regulated mainly by the Trademark Law, the Patent Law and the Copyright Law; which represented a low protectionist level.

On December 9, 2016, the Organic Code of the Social Economy of Knowledge, Creativity and Innovation, known colloquially as the "Ingenios" Code, came into force. In Book III of this Code, the so-called Knowledge Management is regulated, with a change of vision, since it establishes on the one hand that the general rule is: "knowledge is universal and intellectual rights are the exception". (Organic Code of the Social Economy of Knowledge, Creativity and Innovation, 2016).

With the "Ingenios" Code, the National Service of Intellectual Rights (SENADI) was created, an organization and authority in charge of promoting and fostering intellectual rights, which include both the figures of Intellectual Property (Copyrights, Distinctive Signs) as well as plant varieties and traditional knowledge associated or not to a genetic or biological resource.

#### **4. General Regulations of the “Ingenios” Code**

On May 23, 2017, through Executive Decree No. 1435, the general regulations to the Code of the matter were promulgated, whose title III called "KNOWLEDGE MANAGEMENT", constitutes an unsuccessful attempt to develop some figures of intellectual property, so it is imperative that the Presidency of the Republic dictates specific regulations to ensure the promotion and protection of intellectual rights in the country.

##### **1.3 Areas of intellectual property:**

###### **a. Industrial property:**

###### **a.1. Distinctive signs**

In the commercial field we find the distinctive signs. As mentioned in the first point, it is the Paris Convention that regulates the issue of Industrial Property, and includes figures such as patents, trademarks for products and services, industrial designs, utility models, service marks, trade names, geographical indications and the repression of unfair competition (World Intellectual Property Organization WIPO, 1883)

It is important to understand that distinctive signs are those signs that convey information to consumers about the product or service that businesses offer in the marketplace. Therefore, "the protection is intended to prevent any unauthorized use of such signs, which could mislead consumers, as well as any practice that would be generally misleading". (World Intellectual Property Organization WIPO, 2016)

Among the distinctive signs we find the trademarks, as the main figure, but there are also regulated the commercial slogan, the trade name, the distinctive appearances, the geographical indications, the traditional specialties guaranteed that for the first time are included in the Ecuadorian regulations, understanding as such, the “Ingenios” Code. Next, a brief

reference will be made to the best known distinctive sign in our environment, and which is subject to protection through a border measure, such as the trademark.

### **1. Brand. -**

They are understood as a sign or combination of signs which differentiate the goods and services of one undertaking from those of other undertakings.

Signs are considered to be words, letters, numbers, photos, shapes and colors or a combination thereof. In addition, three-dimensional signs such as the Coca-Cola bottle, sound signs such as the lion's roar in the Goldwyn Mayer Metro movies, or olfactory signs such as the smell of a type of motor oil can also be considered as a mark.

There are, however, certain specific conditions for signs to qualify as trademarks: first, the signs must be captured by the human senses, whether visual, auditory, olfactory, taste or tactile. Second, they must be represented through graphic means.

There are also other categories of marks such as collective marks, which are owned by associations such as the association of ice cream producers in Salcedo. Certification marks, such as the ISO 9001 mark, which denotes compliance with certain practices under quality conditions.

There are also service marks that are often used in hotels, restaurants, travel agencies, airlines, etc.

The marks, as such, have four specific functions:

- To differentiate a company's products and services from those of others.
- To differentiate the goods or services from other identical or similar ones.
- To denote a particular quality of the product or service.
- To promote the marketing and sale of products and services



## **2. Trade motto. -**

They are understood as those words or phrases that are used as a complement to a trademark. It is possible to acquire a commercial slogan that does not contain allusions, references or expressions harmful to similar products or brands.

In order to register a slogan, it must be specified which trademark it will complement and its validity will be subject to the validity of the trademark to which it is being complemented (Organic Code of the Social Economy of Knowledge, Creativity and Innovation, 2016).

## **3. Trade names. -**

A trade name is the name or designation that identifies a company. Article 8 of the Paris Convention states that "the trade name shall be protected in all the countries of the Union without any obligation to deposit or register, whether or not it is part of a trademark" (Paris Convention for the Protection of Industrial Property, 1883)

Consequently, trade names will enjoy automatic protection without the need for prior formalities.

Basically, this type of protection means that the trade name of an undertaking may not be used by another undertaking either as a trade name or as a trademark, nor may similar names be used that might mislead the public.

## **4. Distinctive Appearance. -**

Distinctive appearance means the whole set of colors, presentations, shapes, designs or particulars of a commercial establishment or of a product which are capable of distinguishing it from others. Their form of acquisition and execution is identical to that of trademarks provided that they actually demonstrate distinctiveness (Organic Code of the Social Economy of Knowledge, Creativity and Innovation, 2016).

## **5. Designation of origin and geographical indication. -**

The appellation of origin refers to the use of a sign to identify goods of a specific geographical origin whose qualities or reputation are due to natural and human factors existing in that place of origin.

This type of sign can be used for a wide variety of products; however, agricultural products are more predominant. A clear example could be "Cacao de arriba" to differentiate Ecuadorian cocoa from that specific country site.

Geographical indications can also be extended to countries such as the use of the word "Swiss" for all products manufactured in Switzerland, especially watches. The protection of geographical indications makes it impossible for third parties to use such indications as they could be misleading as to the true origin of the product.

## **6. Traditional specialities guaranteed. -**

A TSG is defined as the identification of an agricultural product or foodstuff that has specific characteristics because it has been produced from traditional raw materials or ingredients or because its production contains artisanal or traditional processing that is characteristic of a cultural identity. The protection of a TSG grants the right to incorporate the indication of Traditional Speciality Guaranteed on the label or in any type of advertising. Agricultural products that have been registered as a plant variety cannot be protected as a TSG.

### **a.2 Invention patents. –**

In the industrial field we find the patents of invention themselves, the utility models and the industrial designs.

#### **1. Patents proper. -**

The "Real Academia Española de la Lengua RAE" defines the word invent as the act of finding or discovering something new or unknown (Real Academia

Española, 2018). Several laws do not specifically define what an invention is; however, some countries conceive it as: "any new solution to a technical problem".

It should be noted that the fact of creating something that already exists in nature is not sufficient reason for it to be considered an invention, since creation must respond to the ingenuity, creativity and inventiveness of people.

Patents for invention are considered to be a "document officially recognizing an invention and the rights deriving therefrom" and are the most general means of protecting technical inventions. The granting of these documents helps to promote innovation and technology transfer, meeting the interests of creators as well as users and the general public.

Once a State has granted a patent, the holder has the right to prevent third parties from exploiting the invention, for a limited period of time generally 20 years. In order to obtain a patent, the applicant must disclose his invention and his rights are only granted in the territory where the patent was issued; however, the right of priority, which was specified in the Paris Convention, comes into play here.

Once the patent protection ends, the invention becomes part of the public domain and therefore the patent holder ceases his exclusive rights of invention.

The rights conferred by a patent are specified in the patent laws of each country, but the following are generally considered to be the exclusive rights of the patent holder:

- The right to prevent the manufacture, use, sale or offer of the product or the import of the products obtained through these processes without the consent of the patent owner.

## **2. Utility models:**

They are less well known than patents, but they also serve to protect inventions, and the rights conferred here are similar to those of patents.

Article 321 of the Ecuadorian legislation on "Ingenios" Code details the subject matter that can be protected under a utility model and states: "A utility model patent shall be granted for any new form, configuration or arrangement of elements of any device, tool, instrument, mechanism or other object or any of its parts, which allows a better or different operation, use or manufacture of the object incorporating it or which provides it with any utility, advantage or technical effect that it did not have before". (Organic Code of the Social Economy of Knowledge, Creativity and Innovation, 2016).

Generally, utility model protection is granted to those inventions that involve a lesser degree of technical complexity and that are intended to be marketed for a limited period (10 years).

The requirements for applying for this type of protection are less stringent than for a patent; however, the "novelty" requirement is mandatory.

## **3. Industrial designs. -**

This type of protection applies to various products of industry and crafts. "They relate to ornamental and aesthetic aspects of an article, including compositions of lines or colors in three-dimensional forms which give a special appearance to a product or craftwork". (World Intellectual Property Organization, 2016).

The design of the articles must be aesthetically attractive and must be capable of being reproduced by industrial means. In this way, manufacturers protect one of the creative and attractive elements that usually make the product successful in the market.

The objective of protecting industrial designs is to reward the efforts of creators while motivating them to invest in the design activity.

The right to acquire an industrial design belongs to the designer and may be transferred between persons or by succession, as explained in Article 348 of the "Ingenios" Code (Organic Code of the Social Economy of Knowledge, Creativity and Innovation, 2016).

At the time of registration of an industrial design, protection is obtained against unauthorized exploitation of the design that has been applied to the industrial products; therefore, the owner is granted the exclusive right to make, import, sell, rent, or offer the articles.

Generally, the term granted to industrial design rights is between 10 and 25 years (World Intellectual Property Organization, 2016). In the case of our country is for 10 years, after which the design becomes public domain and anyone can use it without paying royalties for the purpose.

### **1.5 Areas of Intellectual Property: Copyright and Related Rights.**

There are two international conventions that underpinned both copyright and related rights. These are the Berne Conventions on the Protection of Artistic and Literary Works and the Rome Convention on the Protection of Performers, Producers of Phonograms and Broadcasting Organizations.

#### **A. Copyright**

The term copyright is used to describe the rights that creators have over their literary and artistic works. This right is of a double nature and can be considered as the set of subjective rights of the author over creations that present originality resulting from his intellectual activity that refers to moral rights. And the second facet of the Copyright, is the one related to the

temporary economic exploitation of the work or intellectual work, different from the material property as such that refers to the economic rights.

## **Principles of Copyright. -**

### **1. Non-protection of ideas. -**

This principle can be summed up as the fact that ideas are not protected, but rather their form of expression. If this were not the case, it would undermine freedom of information and expression, as well as limit access to future sources of creation. As the "Wits" Code points out in Article 102 that: "If there is only one form of expression, it is not protected"(Organic Code of the Social Economy of Knowledge, Creativity and Innovation, 2016). Nor is it permitted to protect ideas in literary or artistic works; the ideological or technical content of scientific works; and mathematical procedures, methods of operation or concepts.

### **2. Non-discrimination of the work. -**

By this principle, works are protected regardless of genre, merit or purpose, destination or mode of expression. The genre of the work refers to the fact that the work can be literary, artistic, musical, etc. The merit refers to the importance given to the work by the critics; the destiny considered in the sense of whether it can be disclosed or not; and finally the mode of expression, in the sense of the work that can be written, sound or audiovisual.

### **3. Automatic site protection. -**

According to this principle, works are protected without the need for registration or other formalities, as soon as they are created or made available, but their materialization is important in order to prove their existence, in the possible case of a dispute regarding the copyright held by the work. As indicated in Article 101 of the "Ingenios" Code:

“The acquisition and exercise of copyright and related rights not subject to registration or deposit or to the completion of any formality” (Organic Code of the Social Economy of Knowledge, Creativity and Innovation, 2016).

#### **4. Autonomy and compatibility of copyright. -**

This principle is also considered as a cumulative protection right. It is understood that copyright is independent of the ownership of the material object in which the work is incorporated and is compatible with other intellectual property rights, such as trademark or patent rights. In this connection, the "Ingenios" Code provides in Article 103 that: "Industrial property rights shall not affect the use of the work when it enters the public domain" (World Intellectual Property Organization, 2016).

Among the works that are generally protected by copyright are:

- Literary works such as novels, poems, stage performances, reference works, newspaper articles, etc.
- Software and databases
- Films, musical compositions and choreographies
- Artistic works such as paintings, drawings, photographs and sculptures
- Architecture
- Announcements, maps and technical drawings (World Intellectual Property Organization).

#### **Difference between author and owner of a work**

First, the work is defined as the recognized protection that falls on all literary, artistic and scientific works, which must comply with two fundamental requirements: that it be original and that it be susceptible of being reproduced or disclosed by any known or yet to be known means, as stated in Article 104 of the "Ingenios" Code in accordance with other definitions given by the Royal Academy of Language, the former Law on Intellectual Property and in Article 3 of Decision 351 of the Cartagena Agreement (Organic Code of the Social Economy of Knowledge, Creativity and Innovation, 2016).

The author is the natural person who creates some literary, artistic or scientific work. In the Ecuadorian legal system there is no such thing as a corporate author, which means that a legal entity cannot be considered the author of a work, unlike in countries such as the United States. (Aparicio Vaquero & Batuecas Caletrió, 2019) .

On the other hand, the owner of the work is the person, whether natural or legal, who holds the title with respect to the attributes of an economic or patrimonial nature. It is the person who decides on the fate of the work, that is to say, who decides whether the royalties generated by the work are to be collected by the author, whether the right thereto is to be waived, whether licenses are to be granted for the use of the work or whether the economic rights of the author are to be transferred in whole or in part. That is why authorship does not always coincide with ownership of the work.

### **Duty rates**

Copyright, as noted above, can be moral and economic. In the following, we will refer to each of them.

#### **a. Moral rights:**

These rights are inalienable, unseizable and imprescriptible as indicated in the "Ingenios" Code. This last characteristic is excepted in the right of integrity and disclosure since they are wrongly prescribed in the same term as the economic rights, as can be deduced from the contents of the second paragraph of Article 118 of the "Ingenios" Code (Organic Code of the Social Economy of Knowledge, Creativity and Innovation, 2016).



These rights are divided into:

### **1. Parenthood:**

The author is the one who is attributed the status of father of the work, that is, he has the right to demand that he be identified as such in his relationship with his work. This is infringed when it is not correctly cited.

In Ecuador, article 118 of the "Ingenios" Code, numeral 2 declares that it is an author's right:

"To claim the paternity of his work at any time, and to demand that his name or pseudonym be mentioned or excluded each time it is used when the normal use of the work allows it".

### **2. Dissemination:**

It is the author's right to keep the work in his private, personal or unpublished environment or to disclose it through any known or unknown means.

### **3. Integrity:**

As stated in Article 118 of the "Ingenios" Code, paragraph 3, the author has the right to "oppose any deformation, mutilation, alteration or modification of the work that would be detrimental to the decorum of the work, or to the honor or reputation of its author" (Organic Code of the Social Economy of Knowledge, Creativity and Innovation, 2016).

### **4. Access to the unique or rare copy of the work:**

The "Ingenios" Code states that when the medium of this type of work is in the possession or is the property of a third party, in order to exercise the right of disclosure, the author has the moral right of access to the said copy after compensating the holder for any damage that may be caused. (Organic Code of the Social Economy of Knowledge, Creativity and Innovation, 2016).

## **b. Economic Rights:**

In principle, the author has the exclusive right to exercise the exploitation rights, which cannot be exercised by another person without his authorization. As decreed by the "Ingenios" Code, the author is allowed to transfer the exercise of these exploitation rights free of charge or in exchange for an economic remuneration to a third party who is the owner of the rights so that the latter is the one who exercises them and who decides how they are to be exploited, whether reproductions are authorised, etc. (Aparicio Vaquero & Batuecas Caletrió, 2019).

Within these rights we find:

### **1- Reproduction:**

As the "Ingenios" Code states, reproduction consists of the act of fixing a work in a medium that allows its perception, communication or the obtaining of copies of all or part of it. This right includes not only the copyright or the right to copy, but also the act of fixing a work, when a musical work is downloaded from the Internet and fixed or recorded on a device without authorization, even if no copies are made, this type of right would be infringed.

### **2- Public Communication:**

Public communication means any act by which a plurality of persons, whether or not gathered in the same place and at the time they individually decide, may have access to the work without prior distribution of copies to each of them (Organic Code of the Social Economy of Knowledge, Creativity and Innovation, 2016).

### **3- Public distribution:**

Distribution of a work means the making available to the public of the original or copies of the work, on a physical medium, by sale or other transfer of ownership, lease or rental.

#### **4- Import:**

The right to import confers on the proprietor the power to prohibit the introduction into Ecuadorian territory of copies of the work made without the proprietor's authorization (Organic Code of the Social Economy of Knowledge, Creativity and Innovation, 2016).

This right will be exercised both to suspend by customs the entry of such works through border measures, as well as to withdraw them from trade (administrative protection), except in the case of a minimum import as traveler's luggage, as will be seen below.

#### **5- Transformation:**

According to WIPO, the rights of translation and adaptation are different, even if they involve in one way or another the modification of an existing work. Translation means the making of a version of the work in another language; adaptation of a work means the adjustment of a work, the making of a new version or the remodeling of a work for purposes such as adaptation to another medium.

#### **6- Making available to the public:**

It is the right by virtue of which members of the public may access a work from a place and at a time individually chosen by them. This right is part of the public communication; however, the national legislator decided to conceive it in an individual way.

#### **7- Resale of plastic works:**

Known as *Droit de suite* or right of resale, it is a right that the author has to claim part of the proceeds from the subsequent sale of his original work on the basis that that work constitutes either an original work of art or an original manuscript of a writer or composer. This is because visual artists are disadvantaged in the exploitation of their works, because rights such as reproduction and performance rights are of little importance to them since

the main source of income comes from the sale of the original work, i.e. they will not make a profit from the sale of numerous copies of their works.

The "Ingenios" Code specifically mentions the following:

Article 121: "The right to receive compensation for the resale of works constitutes a right of equitable remuneration (Organic Code of the Social Economy of Knowledge, Creativity and Innovation, 2016).

In accordance with the Berne Convention, copyright protection is obtained automatically without the need for registration or any other formality. However, some countries have a specialized system of registration and deposit of works which facilitates knowing who the author or owner of the work really is, what the financial transactions are, the sales, assignments and transfers of rights (Organización Mundial de la Propiedad Intelectual OMPI, 1886).

## **B. Related Rights**

Unlike copyright, which concerns authors per se, related rights protect the interests of certain persons or legal entities that contribute to the performance, recording and dissemination of works. Related Rights cover other categories of right holders, such as performers, producers of phonograms and broadcasting organizations.

It is important to emphasize that the exercise of related rights should not in any way affect copyright protection.

The Rome Convention of 1961 ensures protection of the performances of performers; phonograms of producers of phonograms and broadcasts of broadcasting organizations. WIPO, the International Labor Organization (ILO) and the United Nations Educational, Scientific and Cultural Organization (UNESCO) are responsible for administering this convention. These three bodies constitute the Secretariat of the Intergovernmental Committee established for this Convention, which is composed of representatives of 12 Contracting States.

The Convention is open to States that are party to the Berne Convention or to the Universal Copyright Convention. It should be noted that States may make reservations with respect to the application of certain provisions set forth in this Convention (Rome Convention on the Protection of Performers, Phonogram Producers and Broadcasting Organizations, 1961)

These rights can also be both moral and economic rights and in the case of performers, they have both.

### **Categories of related rights:**

#### **1. The artists, performers:**

These include actors, singers, musicians, dancers and others who perform or execute literary or artistic works. They shall enjoy the exclusive right to authorize the broadcasting and communication to the public and the fixation of their performances. They shall likewise have the sole and exclusive right to authorize or prohibit the direct or indirect reproduction by any means or process or distribution, which shall include the commercial rental to the public of the original work and copies thereof, and the making available to the public by wireless means (National Service of Intellectual Rights, 2019)

In the Rome Convention, it is stated that one of the rights that performers have is national treatment, which refers to the fact that Contracting States shall accord the same treatment as to their nationals (Rome Convention on the Protection of Performers, Phonogram Producers and Broadcasting Organizations, 1961)

#### **2. The Phonogram Producers:**

WIPO notes that a phonogram is any fixation of the sounds of a performance, or of a representation of sounds, other than in the form of a fixation included in a cinematographic or audiovisual work. A "producer of phonograms" is the

natural person or legal entity who, on his own initiative, has economic responsibility for the first fixation of the sounds of a performance or other sounds or representations of sounds.

Producers of phonograms have the right to authorize or prohibit the direct or indirect reproduction of their phonograms. A phonogram means the exclusively aural fixation of the sounds of a performance or other sounds. Where the phonogram published for commercial purposes is the subject of secondary uses such as broadcasting or communication to the public in any form, the user shall pay a single equitable remuneration to the performers or to the producers of phonograms, or to both; however, Contracting States have the option of not applying this standard or of limiting its application (World Intellectual Property Organization, 1996).

### **3. Broadcasting organizations:**

They are those companies that transmit information to the public by television or radio. They have the right to authorize or prohibit certain acts, such as the retransmission of their broadcasts; the fixation of their broadcasts; the reproduction of such fixations; the communication to the public of their television broadcasts when this is done in places accessible to the public against payment of the entry fee.

The duration of protection of related rights is at least 20 years from the end of the year in which it is granted:

- The fixation of the phonograms and the performances incorporated in them has been carried out
- Performances not incorporated in phonograms have taken place
- Broadcasts have been made

It should be borne in mind that national laws provide for a term of protection of 50 years for performances and for phonograms, calculated from 1 January of the year following that of the performance, recording or broadcast (Rome Convention on the Protection of Performers, Phonogram Producers and

Broadcasting Organizations, 1961)

## **1.6 Intellectual Rights: Exceptions and Limitations to Intellectual Rights**

It is a well-known principle that no right is absolute, even more so when we are talking about rights that can be freely disposed of (patrimonial aspect), for this reason, we will now refer to the exceptions and limitations to these rights.

### **1.6.1- Exceptions and limitations to copyright and related rights**

In order to maintain an appropriate balance between the interests of right holders and content users, certain limitations and exceptions to economic rights are permitted. In short, limitations and exceptions concern the case where works may be used without the authorization of the right holder and without payment of remuneration.

These limitations and exceptions vary from one country to another because each one presents different social, economic and historical realities. International treaties recognize this diversity and therefore empower the legislators of each country to decide whether these limitations and exceptions will be applied and to determine their scope.

Article 9(2) of the Berne Convention for the Protection of Literary and Artistic Works states that the laws of each country may permit the reproduction of their works in certain special cases, provided that such reproduction does not conflict with a normal exploitation of the work and does not unreasonably prejudice the legitimate interests of the author. (Berne Convention for the Protection of Literary and Artistic Works, 1886)

To cite another example, the same Convention in Article 2bis.1 deals with the subject of political speeches and judicial debates and mentions that each country is entitled to the protection of political speeches and judicial debates.

The Rome Convention for the Protection of the Rights of Performers, Producers of Phonograms and Broadcasting Organizations establishes four specific exceptions:

- When the use is for private use.
- When short extracts have been used for reporting on current events
- In the case of an ephemeral fixation made by a broadcaster by its own means and for its own broadcasts
- In the case of use solely for educational or scientific research purposes.

(Rome Convention on the Protection of Performers, Phonogram Producers and Broadcasting Organizations, 1961)

### **1.6.2.- Limitations on trademark law**

Now, with respect to trademark law, the Ecuadorian legislation, the "Ingenios" Code, also provides for certain exceptions and limitations, as well:

Article 369 on the use of the mark by third parties for information purposes mentions that: provided that a trademark is used in good faith and does not constitute use as a trademark, third parties may, without the consent of the owner of the registered trademark, use in commerce their own name, address or pseudonym, a geographical name or any other indication relating to the species, quantity, destination, value, place, origin or time of production or other characteristics of goods and services; provided that it is specifically intended for informational purposes and is not capable of misleading the public as to the origin of the goods and services (Organic Code of the Social Economy of Knowledge, Creativity and Innovation, 2016).

Article 370, on the use of trademarks for advertising purposes, states that the registration of a trademark shall not confer on the owner the right to prohibit a third party from using the trademark to advertise, including in comparative advertising, to offer for sale or to indicate the existence of legitimately marked goods and services provided that it is done in good faith and limits



the purpose of informing the public for the sale and does not mislead or confuse customers.

(Organic Code of the Social Economy of Knowledge, Creativity and Innovation, 2016).

Finally, Article 371 on the exhaustion of rights states "The registration of a trademark shall not confer the right to prevent a third party from carrying out acts of commerce in respect of a product protected by such registration, after that product has been introduced into the commerce of any country".

(Organic Code of the Social Economy of Knowledge, Creativity and Innovation, 2016).

This last article is of vital importance to understand the issue of border measures, because even if a trader registers his trademark in a given territory, this fact does not mean that his product will be marketed only by him, since clearly the article states that once the legitimate product enters the market of any country, the good can be marketed without further restriction.

### **1.6.3.- Limitations on patent law**

With regard to limitations on patent law, Article 294 of the "Ingenios" Code provides that holders of patent rights may not exercise their rights in the following cases:

1. Private acts that do not have a commercial scope.
2. Experimental acts related to the patent.
3. Acts of teaching, scientific or academic research.
4. Free introduction of patented objects that are part of locomotive devices.
5. When a protected biological material is used as a basis for obtaining a new viable material.
6. Acts relating to the testing, use, sale or manufacture of a patented invention for the sole purpose of presenting information for the

manufacture, use or sale of any product, whether it be pharmaceutical, chemical or agricultural.

In addition to the above, the following article indicates that the patent does not give a third party the right to carry out acts of commerce with the patented product when it has already been inserted in the commerce of any country with the consent of the owner or a person related to the owner; such case is known as exhaustion of the right.

#### **1.6.4.- Limitations on the breeder's right**

The limitations that the holder of a plant variety right has are four, the same as those specified in Article 490 of the "Ingenios" Code and are:

1. Acts in the private sphere and for non-commercial purposes.
2. Acts for experimental purposes.
3. Events for teaching, scientific or academic research.
4. Acts aimed at achieving a new variety.

In addition, it is specified that farmers may use plant varieties only for propagation or exchange with other farmers without it becoming a commercial purpose. The exchanges made must be subject to the law and regulations on the movement of plant material.

Article 492 explains that, as in the case of patents, the holders of a plant variety right cannot prevent a third party from carrying out acts with respect to the protected material when it is already in the commercial spectrum, except in certain cases specified in the aforementioned standard.

## **Conclusion**

In order to better develop the topic of research work on border measures, it was first necessary to start with a notion of what intellectual property means, and then continue with a brief historical overview of its evolution. This historical summary is a clear example of how intellectual property rights have always been protected, either in an explicit way or in a subtler one. It was also necessary to know the legal provisions that regulate an intellectual right, thus recognizing that this right is not only universally recognized, but is also strengthened in the legislation of the different regions, as well as in that of each country.

Finally, as was mentioned at the time, it is recognized worldwide that intellectual property is divided into the following branches: copyright, related rights and industrial property. But in our country, it also includes plant varieties and traditional knowledge associated or not to a genetic or biological resource.

Likewise, intellectual property is so broad, due to the fact that each field has different ramifications. In our environment the border measures only allude to a specific protection of copyrights and trademarks, a topic that will be developed in depth in the following chapter.

## **CHAPTER 2: BORDER MEASURES IN THE FIELD OF CUSTOMS AND INTELLECTUAL PROPERTY**

### **2.1 Conceptual delineation of goods**

Firstly, it is imperative to mention that goods are understood to be all goods that can be subject to customs regimes, operations and destinations.

The Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), as detailed in its Article 51, expresses what shall be understood as counterfeit and pirated goods:

Counterfeit trademark goods: Any goods, including their packaging, bearing without authorization a trademark identical to the validly registered trademark or which cannot be distinguished in its essential aspects from such a trademark, and which consequently infringe the rights granted to the owner of the trademark in the country of importation.

Pirated goods: Any copy made without the consent of the copyright owner or of a person duly authorized by him in the country of production (Trade-related aspects of intellectual property rights, 1995).

### **2.2 Nature of border measures: Concepts, characteristics, classes, objectives and importance**

#### **Concept. –**

Border measures are considered as those mechanisms or tools used by the competent national authorities in the customs field, in order to protect different rights such as intellectual property. To this end, the State has applied, ex officio or at the request of a party, border measures to suspend import or

export operations involving allegedly infringing goods that infringe intellectual property rights on trademarks and copyrights, through acts that could even constitute counterfeiting or piracy. These measures have facilitated border controls and discouraged the illegal entry of goods.

But in addition to intellectual property, border measures could involve the adoption of other non-customs measures or control mechanisms, which are provided for in the Organic Code of Production, Trade and Investment (COPCI), to prevent products that could affect other rights, such as those of consumers, cultural heritage, human or animal health, from entering a country's commercial circuits through customs.

### **Characteristics. –**

The characteristics of these measures are basically that they are complex acts in whose procedure several public institutions intervene or must intervene, coordinated by the body responsible for executing the policies of the Sectorial Council of Production, in application of the provisions of the current Code on production, trade and investment (COPCI).

These measures are also considered as a suitable mechanism applied clearly in border areas to prevent and effectively control piracy of works, trademark counterfeiting, as well as other forms of infringement of intellectual property rights.

### **Classes. –**

As far as the types of border measures are concerned, we will basically refer to two: border measures in the customs field, to differentiate them from border measures that are implemented to specifically protect an intellectual property right.

### **Objectives. –**

The general objective of border measures is to ensure respect for the legal system and the customs and tax interests of a state, which is achieved by applying proper control by the customs authorities, in coordination with other authorities, in certain special cases.

The specific objective that border measures must meet is to prevent the free circulation of illegal goods, so that they do not reach the commercial circuits of a territory, even putting at risk the health or life of people, in extreme cases, such as when entering or leaving the country, goods that do not have the basic requirements such as safety.

### **Importance. –**

Border measures are of great importance because, among the fundamental objectives of the state is not only to guarantee the protection of the rights, both of the owners of trademarks or copyrights, but also the rights of vulnerable sectors such as consumers, since the market should only offer products that do not harm human or animal health, to name but a few cases, and this would be achieved if correct border controls are applied.

At the same time, correctly applying these measures at the border motivates and protects intellectual creation, since people will feel safe in the knowledge that the State guarantees those exclusive rights, so they will develop their maximum potential. These measures also help to generate better competitiveness and ensure that there is fair trade within nations.

Based on the above, taking into account how important and necessary the nature of border measures is to guarantee the integrity of people, we consider that in Ecuador new mechanisms should be increased to control the infringing merchandise such as a better joint work of all the state institutions that have relation with the matter, since the current system has certain shortcomings that will be analyzed later.

### **2.3 Border measures in the customs field**

Customs play a fundamental role in the trade of all countries, their work is so important that they must be alert to customs and non-customs risks that may arise at borders and must therefore make decisions that help to eliminate such risks or at least restrict them. Therefore, through their means of action, these bodies must create an environment capable of curbing and controlling the illegal traffic in goods that violate any type of right.

It is therefore imperative to have effective legislative tools that make it possible to improve border control systems. Thus, the Organic Code of Production, Trade and Investment - COPCI, establishes in its Article 74 that: "(...) the Ministries and public institutions responsible for the administration of authorizations or procedures prior to the import or export of goods, in the areas of public health, environment, animal and plant health, technical regulation and quality, cultural heritage, control of narcotics and psychotropic substances, and other measures related to trade, shall execute these functions in accordance with the policies and standards adopted by the governing body in matters of trade policy. These bodies may not apply administrative or technical measures relating to trade which have not been previously coordinated with the governing body for trade policy (...)".

**(underlined outside text)** (Organic Code of Production, Trade and Investments, 2018).

For the effect in the referred, normative body, it is foreseen the existence of the so called NON TARIFF MEASURES OF THE FOREIGN TRADE. Thus, Article 78 states the following:

#### **Article 78 - Non-tariff measures**

The Committee on Foreign Trade may establish **non-tariff regulatory measures** on the import and export of goods in the following cases:

- a. When necessary to guarantee the exercise of a fundamental right recognized by the Constitution of the Republic.
- b. To comply with the provisions of international treaties or conventions to which the Ecuadorian State is a party;
- c. To protect the life, health, security of persons and national security;
- d. To guarantee the preservation of the environment, biodiversity, and animal and plant health;
- e. When it is required to impose measures in response to Ecuadorian export restrictions, unilaterally and unjustifiably applied by other countries, in accordance with the rules and procedures provided for in the respective international trade agreements and the provisions established by the governing body on foreign trade;
- f. Where temporary measures are required to correct imbalances in the balance of payments;
- g. To prevent illicit trafficking in narcotic drugs and psychotropic substances; and
- h. To achieve compliance with laws and regulations, compatible with international commitments, in matters such as customs controls, intellectual property rights, defense of consumer rights, quality control or marketing of products for international trade, among others. **(Underlined outside text)**

Article 79 - In addition to the cases provided for, non-tariff export regulation and restriction measures may be established in the following cases

- a. To avoid shortages of foodstuffs or other essential products for the country, as well as to control the adjustment of prices of these types of products;
- b. To ensure the supply of raw materials to domestic producers, in implementation of a government industrial development plan.



c. To protect the country's non-renewable natural resources; to protect the national heritage of cultural, artistic, historical or archaeological value; and

d. In all other cases established by the competent body in this matter, as it is convenient to Ecuador's trade and economic policies, as established in duly ratified international agreements (Organic Code of Production, Trade and Investments, 2018).

From the transcription of the legal dispositions made, it is deduced that the catalogue of goods to be preserved, is ample, thus, we have that, the maximum organism that regulates and fixes the policies in the matter of foreign trade in our country, the COMEX, could establish as nontariff regulation measures, those necessary to preserve:

- 1.- A fundamental right recognized by the Constitution; or for the fulfillment of an obligation assumed under an international treaty or convention that is a law of the Republic
- 2.- Life, health, security of persons and national security, including the possibility of preventing trafficking in narcotic and psychotropic substances.
- 3.- The environment, biodiversity, and animal and plant health
- 4.- Intellectual Property
- 5.- The rights of the consumer
- 6.- The country's non-renewable natural resources
- 7.- National heritages of cultural, artistic, historical or archaeological value

But according to the content of the provisions transcribed, these measures can also be foreseen as a result of a trade defense policy decision, such as when it is required to impose measures in response to Ecuadorian export restrictions or when it is required to apply measures on a temporary basis to correct imbalances in the balance of payments.

Finally, they could be established as a result of the application of a state economic policy, such as to ensure the supply of raw materials or capital goods that ensure the existence of national production, or of finished products, which will be consumed by the country's nationals.

Therefore, we could preliminarily conclude that these three types of border measures foreseen in the customs area, would be equivalent to NON TARIFF measures, being the border measures in intellectual property matters, a kind of non-tariff measure, destined, as we will see later, to protect the interests of the owners of a trademark or a copyright.

### **Competent body for non-tariff measures**

The body responsible for implementing the three types of border measures identified is the National Customs Service of Ecuador (SENAE), which is a Stateowned, autonomous, citizen-oriented (Company National Customs Service of Ecuador, 2019).

### **Principles**

In accordance with Article 104 of the COPCI, among the fundamental principles pursued by the Customs are:

- Facilitation of foreign trade
- Customs control
- Cooperation and exchange of information
- Good faith
- Advertising
- Implementation of international good practices (Ecuador Customs Service, 2015)

Because of the relevance of the principle of customs control to the subject of the investigation, it will be further developed below.

## **Customs control**

As previously stated, one of the principles that SENAE must comply with is customs control, by virtue of which, in all foreign trade operations, precise controls will be applied through **risk management**, ensuring respect for the **legal system and fiscal interest**. (Highlighted outside text)

But it is imperative to start from a concept of what should be understood by customs control, in that sense, Decision 574 of the Andean Customs Regime on Customs Control of the Andean Community, establishes that it consists of the: "Application of selective criteria or methods, based on risk management criteria for the application of risk profiles, with respect to the types of valuation to be practiced in customs clearance".

The risk profile is also summarized as a predetermined combination of risk indicators based on information collected, analyzed and prioritized. (SENAE Intelligence Department, 2014)

In accordance with what has been stated so far, customs control is carried out because there are risks that can affect the integrity of the inhabitants of a nation, or the tangible or intangible heritage of a state, among the most common risks are:

- undercutting
- incorrect tariff classification
- smuggling
- informal commerce
- intellectual property
- archaeological, historical and cultural heritage
- weapons and explosives
- drug trafficking
- cash smuggling

It is necessary to take into account that the risk can be both tax and non-tax. The tax risk refers to the impossibility of collecting the corresponding taxes. The

non-tax risk refers to injury or violation of health standards, industrial and intellectual property rights, use of animals or protected species, protection of cultural heritage, among others.

Bearing in mind that the risk presented both at the borders and in the territory is transcendental in terms of trade and rights, it is imperative to have an organizational framework that makes it possible to better manage and control this inconvenience.

### **Stages of customs control**

According to Art. 144 of the Code of the matter: The customs control will be applied to the entrance, permanence, transfer, circulation, storage and exit of merchandise, units of load and means of transport towards and from the national territory, including the merchandise that enters and leaves the Special Zones of Economic Development, for any reason.

Customs control shall also be exercised over persons involved in foreign trade operations and those entering and leaving the customs territory.

Customs control will be carried out in the following phases in accordance with international regulations: prior control, concurrent control and subsequent control.

The Andean Decision states in this regard in Article 4 that: "Customs control may be carried out in the following phases:

(a) Prior control means the control exercised by the customs administration prior to the acceptance of the customs declaration of goods.

(b) In-clearance control means control exercised from the time of acceptance of the declaration by customs up to the time of release or loading of the goods.

(c) 'Post-clearance control' means control exercised from the time of release or loading of the goods released for a given customs procedure.

It follows that the customs power of control can be applied to goods, means of transport and persons involved in trade operations and can be carried out in three stages. In the following, we will refer briefly to each of these phases.

### **Preliminary or prior control**

The prior or earlier control begins when there is a document indicating that the goods will be placed under a customs procedure or operation. This monitoring can be carried out even before the goods leave their origin. They are controls performed either by the customs office of export or also by the customs operators in the country of destination and basically manage nontax risks (Felipe Martínez , 2016).

At this stage, information can be obtained about: importers, exporters, persons involved in the operation, as well as the goods that are the object of the customs operation. It is also possible to access information contained in provisional and final manifests, information on means of transport, among others.

As stated in Article 5 of the Andean Decision, "The above control shall be carried out through:

a) ) Research activities of a general nature:

- i. On certain risk groups and sensitive economic sectors
- ii. On certain trade operators; iii. On certain classes of goods; or, iv. On goods from certain countries.

b) Direct research actions:

- i. On background information held by the Customs administration concerning the consignee, the importer or exporter of the goods, the persons involved in the operation as intermediaries or representatives;
  - ii. On the information contained in the provisional and final manifests
  - iii. On the means of transport;
  - iv. On loading units; or,
  - v. On unloaded goods.
- c) Verification, monitoring and control actions:

- i. Of the means of transport and the loading units;
- ii. Of the goods while they remain on board the means of transport;
- iii. Of the unloading of the goods and the result of the unloading, in accordance with the manifest; or,
- iv. Of the goods during their transfer and stay in temporary storage or in authorized warehouse.

### **Concurrent control**

Concurrent control is carried out on goods that have already been made available to the customs authorities.

At this point, a risk analysis will be carried out to determine what type of valuation or inspection the goods will be subjected to, which may be documentary or physical valuation. In addition, depending on the risk, it will be determined what actions and documents will be required.

When carrying out a concurrent control, one of the most common problems is the evasion of taxes, that is to say, the entry of goods that are intended to pay less taxes than they really have to. Therefore, in cases where the customs authorities have received a customs declaration and doubts arise as to the accuracy or truthfulness of the declared value or the documents being submitted; i.e. there is evidence of "reasonable doubt", the customs administration may ask the operators for written explanations, documents or any additional evidence to prove that the declared value represents the total amount actually paid or payable for the imported goods.

When the importer is notified of the doubt, he has five working days, extendable by five more days, to provide sufficient evidence of the price actually paid or payable (National Customs Service of Ecuador, 2015).

This whole process is known as customs valuation and the World Trade Organization defines it as a procedure that is applied to determine the customs value of imported goods.

This process, however, is not as simple as it seems, because there are methods of valuation or verification that are used by all countries subscribing to the WTO.

It is precisely after the conclusion of the Uruguay Round that the WTO Agreement on the Application of Article VII of the GATT (General Agreement on Tariffs and Trade) of 1994 is established and this basically establishes that the valuation of goods will be based on the ad valorem tariff.

The Agreement provides for six methods of customs valuation, which are to be used progressively as necessary.

### **Method 1: Transaction value**

It refers to the price actually paid or payable for the imported goods that the buyer must or has made to the seller or a third party to fulfil an obligation of the seller.

The conditions required for this first method are that:

- 1) There is actual proof of the sale made, such as commercial invoices, contracts, orders, etc.
- 2) There is no restriction on the use or transfer of the goods other than those imposed by the law of the country of importation.
- 3) The sales price must not be subject to conditions that prevent the value of the goods from being determined.

- 4) The price may not be reversed under any circumstances unless the appropriate adjustment is made for reasons such as brokerage fees and expenses, certain services, subsequent profits, insurance cost.
- 5) There must be no link between the buyer and the seller; however, if there is, it must be shown that the link did not influence the price of the goods.

### **Method 2: Transaction value of identical goods**

Identical goods are understood to be those that are equal in all physical aspects of quality and commercial prestige, that have been produced in the same country and by the same producer as the goods being valued.

In addition, to perform valuation under this method, the goods must have been imported at the same time as the goods being valued.

If there are no identical goods with all the specified characteristics, some exceptions are allowed:

- Identical goods produced by a different person in the same country may be taken into account.
- Small differences in physical appearance are not taken into account when they comply in all other respects.

### **Method 3: Transaction value of similar goods**

Similar goods are those which resemble the goods being valued in their composition and characteristics, which may also fulfil the same functions and are commercially interchangeable.

In this method it is also important that the goods have been produced in the same country and by the same producer and that they have been sold to the same country of importation and at the same time as the goods being valued.



#### **Method 4: Deductive Value**

This method is used when it is impossible to determine the customs value on the basis of the transaction value of the imported goods, therefore the determination will be made on the basis of the unit price at which the largest quantity of the product is sold to a buyer who is not related to the seller.

Such sale must be made at the time of importation of the goods being valued or at a time up to 90 days after importation of the goods.

In sum, the deductive value is the sales price in the country of import, but to arrive at the customs value, certain deductions must be made, such as:

- Commissions paid
- Transport and insurance costs
- Customs duty and other internal taxes

#### **Method 5: Rebuilt Value**

This is one of the most complicated and least used methods since certain costs need to be taken into account in order to achieve a customs value.

The customs value is therefore determined on the basis of the cost of production plus a value for profits and overheads generated on the sale of the goods.

The cost of production can be summarized as being equal to the value of the materials plus the costs of manufacture. The value of materials refers to items such as raw materials and the costs incurred in bringing the materials to the production site.

On the other hand, manufacturing costs refer to labor, assembly expenses and also indirect costs such as factory maintenance, overtime, etc.

The profits and general expenses, on the other hand, are generated at the time of sale in the country of importation and include items such as rental costs, basic services, legal expenses, etc.

In addition to the above, other types of expenses must be taken into account, such as the cost of transport, loading, unloading and handling costs and the cost of insurance.

### **Method 6: Method of last resort**

As its name suggests, it is a method used when the customs value cannot be determined using the above methods and will therefore be determined using reasonable criteria that are consistent with the principles and general provisions of the Agreement together with Article VII of GATT 1994 and also using criteria or data available in the country of importation.

These criteria; however, they should not be based on:

- Sales price of goods that have been manufactured in the same country of import.
- A system which provides for the use of the highest values for customs valuation purposes.
- The price of goods in the domestic market of the exporting country
- A cost of production other than constructed values that have been determined for identical or similar goods.
- The price of goods sold to a third country
- Minimum customs values
- Arbitrary or fictitious values. (World Trade Organization, 2019)

### **Subsequent control**

This type of control is carried out after the loading or the release of the goods, generally it is done to certain groups that are considered as risk groups and to

sensitive economic sectors, that is to say, to foreign trade operators of certain classes of goods and goods coming from certain countries. (Intelligence Department SENA, 2014)

Typical risks that occur at a later control stage are

- Non-compliance with customs procedures
- Failure to comply with tax exemption conditions (Wagner, 2016)

In this regard, Article 145 of the COPCI states

"(...)Within a period of five years from the date of payment of taxes on foreign trade, the National Customs Service of Ecuador may submit to verification the customs declarations, as well as any information held by any natural or legal person related to imported goods. Risk management systems will be used to determine the customs declarations subject to subsequent control.

If it is determined that the tax return suffered from errors that give rise to differences in favor of the taxpayer, the respective rectification will be made without prejudice to the other actions that legally correspond, the rectification of taxes will be enforceable and sufficient to exercise the coercive action.

The taxable person may lodge a substitute declaration in order to correct errors in good faith in customs declarations where they result in greater revenue or even if they do not change the value payable, within five years of acceptance of the declaration, provided that the administration has not issued a tax adjustment for the same reason or the subsequent control process has not been formally initiated. The replacement declaration shall be validated and accepted in the same way as the customs declaration.

If considered necessary, the National Customs Service of Ecuador may arrange for audits of special regimes to be carried out within a period of five years from the date of the customs declaration, for which all types of findings may be made, whether they are documentary, accounting or physical.

In addition, the National Customs Service of Ecuador, through its operational units, has the authority to investigate complaints of customs violations submitted to it, as well as to carry out the controls it deems necessary within the customs territory in the scope of its competence, to ensure compliance with this Code and its regulations, adopting the necessary preventive measures and surveillance actions.

The operational unit of the National Customs Service of Ecuador responsible for subsequent control may seize goods and objects that may constitute elements of conviction or evidence of the commission of a customs offence and place them immediately at the disposal of the servant in charge of the corresponding district management (Organic Code of Production, Trade and Investments, 2018).

As indicated from the provision transcribed above, the purpose of the subsequent control is, on the one hand, to correct errors of good faith which may have been made by the importer of goods in the customs declaration, in order to avoid damage to the State's coffers and, on the other hand, the subsequent control, through the SENA Customs Surveillance Unit, seeks to prevent actions that constitute customs infringements, affecting both the referred trademarks, as in the case of smuggling, but that could also affect other types of rights such as the rights of the owners of distinctive signs on their trademarks and, ultimately, the rights of consumers, in case that merchandise is false.

In this regard, the Andean Decision states in its Article 17.- The customs administrations shall establish post-control units composed of officials with knowledge and experience in customs, tax, foreign trade, accounting and auditing matters.

The subsequent control units may be structured in each Member Country into central or national units or regional units, in accordance with the scope of their

territorial action, providing them with the powers and competences that enable them to fulfil their function.

Article 18.- It corresponds to the subsequent control units:

(c) Verify the origin, tariff classification and other data declared;

(g) Formulate the proposal for a penalty resulting from the infringements detected during the subsequent check;

(h) Adopting such precautionary measures as may have been authorized, in accordance with the provisions of the domestic legislation of each Member Country;

l) Coordinate and exchange information with the corresponding authorities of other Member Countries;

j) To carry out joint actions for subsequent control with the corresponding authorities of the other Member Countries;

k) To submit their reports to the Customs Administration for the consequent purposes and, in the cases required by national provisions, to the Judiciary, the Legislative and the Prosecutor's Offices and other public administration bodies, when the results thereof must be communicated to them;

n) To carry out other actions expressly provided for in the legislation of each Member Country.

From the transcribed provision it can be inferred that, in the case of our country, the Customs Surveillance Unit is the one that carries out acts of subsequent control, such as the seizure of goods that could imply a noncustoms risk, such as an infringement of an intellectual right and communicates to the competent authority, in our case the SENADI so that the pertinent procedure is initiated to prevent the allegedly infringing merchandise from entering the commercial circuits, however, as will be seen below, this last entity does not act ex officio.

## **Risk management:**

Taking into account all of the above, the World Customs Organization - WCO has a Risk Management Compendium, which contains the fundamental principles for the creation of an effective management framework:

- 1. Have a comprehensive understanding of customs administration:** Know the factors both internal (structural aspects, governance, knowledge, risk culture, etc.) and external (political, economic, social and technological considerations) that condition the achievement of customs objectives.
- 2. Establish a risk management policy:** This is based on the definition of a policy that is materialized through periodic plans in which the risk programmes, lines of action and control are defined.
- 3. Design a policy to establish responsibilities and authorities:** An organizational structure with a clear definition of roles and responsibilities must be in place, as well as a chain of command that effectively conveys policies and other processes.
- 4. Identify appropriate resources:** Ensure quantitative and qualitative adequacy of both human and technical resources.
- 5. Design an internal and external communication policy:** This policy must facilitate the communication of risk management plans both internally and externally, as well as to operators and stakeholders.  
(Felipe Martínez, 2016).

In addition to these principles to establish this risk management framework the WCO also promoted the SAFE regulatory framework which is articulated in four basic principles:

1. Harmonization of advanced information systems.

2. Implementation of risk management in the countries.
3. At the request of the country of destination, the Customs of the country of origin may inspect high-risk goods or containers bound for foreign countries using non-intrusive equipment.
4. Definition of benefits that the Customs will grant to those companies that comply with the security standards of the logistics chain.

It is necessary to emphasize that the customs services need support and cooperation from other customs administrations in different countries, this mutual support can be achieved through the following elements:

- Creation of "trusted operator" programs that serve to build a logistics chain.
- Mutual recognition of these programmes
- Exchange of information
- Design of one-stop shops.

(Wagner, 2016)

In sum, the role of the Customs Administration in the country is of vital importance since it acts as the main control entity by which all goods entering and leaving the territory must be submitted.

Customs must ensure that both national and international laws and regulations are fully complied with at the country's borders.

In addition, they must act as the intermediate entity since, for example, if it is determined that there are archaeological pieces that intend to leave the country, the Customs as the first control must request documents and evidence that corroborate that the pieces are leaving legally, otherwise it

must stop the goods and act jointly with the other national institutions, in this specific case with the National Institute of Heritage and Culture - INPC. In other words, Customs is an institution that performs such delicate functions that its work must be carried out in coordination with all the competent authorities in each area, so that security and control at Customs is stricter and more effective.

In addition to the above, it is important to take as a reference and example the case of the Spanish Customs, which uses instruments that perfect and improve border control. This is based on the intensive use of risk analysis systems, use of computer filters that are capable of detecting commercial operations that violate intellectual property rights.

All this type of customs control is especially focused on the sectors and goods most affected by this illicit, among which are the electronics sector, toys, perfumes, the pharmaceutical industry, and watches.

Despite a strict and complete procedure to stop the violation of intellectual property rights, the Spanish Customs tries to achieve a fair balance between the fluidity of international trade and the fight against fraud, carrying out controls in a selective way.

Finally, its control goes beyond physical and documentary inspections as it also extends to the detection of networks through investigations carried out by the Services of the Inspection and Investigation Department of the (Customs World Intellectual Property Organization, 2005).

Therefore, as a preliminary conclusion in the customs field, border measures have a broad connotation, but it is believed that in the case of measures planned to implement economic policy decisions, either for trade defense or to promote and ensure the supply of products and domestic industry, measures of a tariff nature should be established and therefore, of exclusive competence of the respective entity, unlike the measures planned to protect



other rights, which are not the exclusive competence of SENAE, but require the intervention of the competent entities in each area.

In addition, the internal work of the customs administration is extremely important and therefore it is necessary to have a risk management framework, which must be based on efficient rules and policies that facilitate controls and thus ensure the protection not only of the country's fiscal coffers but also of civil rights, specifically copyright and trademark rights.

Finally, the work of the customs administration cannot be isolated, but must have the support and cooperation of other inter-State customs offices, since this allows for quality information and the recognition of those operators who have been certified as reliable operators in a third country as reliable.

#### **2.4 Border measures in the field of intellectual property**

In recent years there has been a significant increase in objects infringing intellectual property rights. Moreover, it must be recognized that the evolving nature of piracy and counterfeiting is based on several principles: quantity, the most common objects are counterfeited and can be produced on a commercial scale; nature of the products: clothing is no longer the most counterfeited, now the food, pharmaceutical and music industries are predominant; finally, there are international organized crime networks that use their organizations to distribute fake and pirated objects (World Intellectual Property Organization, 2005).

As noted above, the NON-TARIFF measures provided for in COPCI are applied to imports or exports in order to prevent the infringement of other rights such as intellectual property rights. These measures may include import licenses, sanitary and phytosanitary measures, tariff quotas, technical regulations and conformity assessment, customs provisions and minimum prices (Organic Code of Production, Trade and Investments, 2018).

Correlatively, the border measures in the field of intellectual property are regulated in several normative bodies, as will be seen in the following point. In order to be able to talk about border measures in this field, it is necessary to review how the doctrine conceptualizes this type of measure.

For Natasha Bluztein and Nelson Yépez:

"(...) the border measure, also called measure of enforcement of intellectual property rights and in some countries called precautionary measure applied at the border, is an action that starts as a provisional measure to prevent a possible violation of intellectual property rights and that has as its main objective, knowing the substance of the matter, to counteract with this measure that some right of a third party is violated, is applied specifically at the border of the countries, this means, prohibiting the release of infringing goods, to prevent these goods from entering the commercial circuits. These measures can be taken for both imports and exports"<sup>1</sup>.

From this definition it can be inferred that this sui generis figure is a process of enforcement of rights, which takes place exclusively within the limits of the Member States of the conventions for the protection of intellectual property.

Observance can be considered generically as the rigorous fulfillment of what is commanded by law, authority or superior<sup>2</sup>, for instance, by applying this concept to the field of research one could say that it is the exact enforcement of intellectual property rights and the measures that countries must apply when someone infringes them in some way.

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<sup>1</sup> BLUZTEIN, Natasha and YEPEZ, Nelson. "Measures at the Ecuadorian border." Intellectual Property Magazine. Catholic University Santiago de Guayaquil. Guayaquil. 2011. Page 177

<sup>2</sup> Cf. CABANELLAS DE TORRES, Guillermo, Diccionario enciclopédico de Derecho Usual, tomo V. ed. Heliasta, 29 edición, Buenos Aires, 2006. Pag.634

As regards enforcement procedures, the first section of Article 41 of the TRIPS Agreement sets out the general obligations to which these procedures must conform, in the following terms:

"The obligation of members to ensure that their laws provide for procedures for the enforcement of intellectual property rights, including expeditious procedures for the prevention of infringement. Similarly, the principle of justice and equity should be implicit in not setting unfair time limits.

Decisions on matters of substance shall preferably be taken in writing, without undue delay, on the basis of evidence and with due regard for the rights of the defense.

The parties are also guaranteed the opportunity for review by the judicial authority of final administrative decisions appropriate to the provisions of each State in the area of its jurisdiction, with the exception of judgments of acquittal where the possibility of review is not mandatory (...)³"

These measures have been considered as a suitable mechanism to prevent and effectively control piracy of works, trademark counterfeiting, as well as other forms of infringement of intellectual rights.

### **Characteristics. –**

Border measures stand out for having three particular characteristics in the field of intellectual property, which are

First, because they are a measure for the enforcement of intellectual property rights; also because they are clearly applied at the borders and because they are a mixed or self-fulfilling measure.

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³ SALAZAR, Daniel Octavio, "Enforcement of Intellectual Property Rights". Intellectual Property Magazine, <http://www.redalyc.org/articulo.oa?id=189017092003> (available online as of 13 June 2014), p. 34.

The first characteristic refers to the protection of intellectual rights through compliance with the law and the adoption of preventive means. In itself, the next characteristic refers to the fact that measures should be applied specifically at the border in accordance with the provisions of each internal order, respecting national sovereignty since each country is autonomous in implementing different mechanisms to protect intellectual rights. Finally, the third characteristic refers to the legal nature of border measures because we are talking about a hybrid right; that is, practices from other legal systems coexist (Natasha Bluztein y Nélon Franco Yépez, 2011).

### **Classes. –**

There are two types of enforcement of border measures in the field of intellectual property: precautionary processes and knowledge. In precautionary processes, a rapid measure is sought which must be reinforced, it means that once the precautionary measure is applied, a fundamental action is initiated to make it known and to ratify this measure. On the other hand, the knowledge processes are going to know the substance of the conflict so that the competent authority can express a criterion and adopt a resolution.

In Ecuador, the border measures were a mixture of these two processes, although they were born as a precautionary measure applied by SENAE. They became a process of knowledge when they were sent to the IEPI for resolution, where the conflict was analyzed, the measure adopted was confirmed or revoked and returned to Ecuadorian Customs. It is important to emphasize that the process was one, thus generating the self-sustaining or self-satisfying measure<sup>4</sup>.

It should be noted that the Intellectual Property Law does not make a distinction between the precautionary phase and the processes of

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<sup>4</sup> BLUZTEIN, Natasha and YEPEZ, Nelson. "Measures at the Ecuadorian border." Intellectual Property Magazine. Catholic University Santiago de Guayaquil. Guayaquil. 2011. Page 179

knowledge, unlike the current "Ingenious" Code which does clearly establish what the precautionary measures are and what the process of knowledge is, as well as explaining how to apply them correctly at the border.

### **Objectives. –**

The fundamental objectives of border measures in the field of intellectual property are:

- 1.- To stimulate and reward the creations of human ingenuity through the protection given to them by the State.
- 2.- Regulating competition in the market with the consequent protection of consumer rights.

### **2.5 Applicable regulatory framework**

The issue of border measures in Ecuador is regulated both by the international treaties signed by the country and by national regulations.

Ecuador's legal system is composed of the Constitution of the Republic, followed by international regulations, such as the Agreements on TradeRelated Aspects of Intellectual Property Rights (TRIPS), the Decisions of the

Andean Community of Nations, internally the Organic Code of the Social Economy of Knowledge, Creativity and Innovation - "Ingenious" Code, and, temporarily, the Intellectual Property Law and its regulations, until the respective regulations that make the provisions of the aforementioned "Ingenious" Code viable are promulgated.

We will now review the main provisions regulating border measures in the field of intellectual property.

## 1. Constitution of the Republic of Ecuador

Although, in the Constitution we do not find provisions that expressly refer to the subject under discussion; however, a tacit reference in art. 321 of the aforementioned Charter, points out that The State **recognizes and guarantees the right to property** in its public, private, community, state, associative, cooperative and mixed forms and that it must fulfill its social and environmental function (Constitution of the Republic of Ecuador, 2008) (Underlined outside text).

Intellectual property is a special form of property that can be private in the case of rights holders such as trademarks or copyright holders, or collective, in the case of the right recognized to the legitimate holders of traditional or ancestral knowledge.

In full accordance with Art. 322 of the referred normative body expressly states that the intellectual property is recognized in accordance with the conditions that the law indicates, the Code "Ingenious" is now understood, that is to say that, when recognizing the existence of the property in the conditions that are developed in the law, the constituent assemblyman, is recognizing the need for the State to design an adequate system for the recognition and consequent protection of this type of property, through judicial or administrative procedures, generically known as rights enforcement measures, among which is the mechanism of border measures, as will be seen below.

## 2.- Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS)

The TRIPS agreement, the CAN agreements and the same national regulatory body, the "Ingenious" Code, harmonizes the enforcement of intellectual property rights, giving States the power to put in place their own required regulations in this area according to national needs. Article 41.1 of the TRIPS Agreement obliges the countries that belong to the WTO to create legal mechanisms, such as criminal law or civil, administrative and customs

procedures, in order to legally protect intellectual property rights. (Conde, 2016).

TRIPS has been established as the framework agreement on the subject of border measures at the international level and it is since the accession of several countries to it that the provisions contained therein have begun to be adopted.

The background to the TRIPS Agreement can be found in the Paris Convention, specifically its Article 9 which states "Any product unlawfully bearing a trademark or trade name shall be liable to seizure upon importation into those countries of the Union in which such trademark or trade name is entitled to legal protection.

Similarly, the initial proposals by the United States and the European Economic Community under the GATT for an Anti-Piracy Code laid the groundwork for the adoption of such measures in the TRIPS (Natasha Bluztein y Nélon Franco Yépez, 2011).

Since the signing of the Agreement, there has been a concern to protect intellectual rights, so the structure of the TRIPS Agreement created a section on the implementation of an instrument to protect intellectual rights, called the Border Measures. As not all the countries are members of the World Trade Organization and therefore not subscribers to the TRIPS, the Agreement provides for the intervention of the customs authorities to prevent the free circulation of illegal goods.

The section that TRIPS reserved to deal with Border Measures is Part III Section IV which consists of ten articles ranging from 51 to 60 that detail the procedure for the application of a border measure.

The procedure set out in the TRIPS Agreement is the one adopted in most countries' legislation and is based on the fact that it is the interested party, who has valid grounds for suspecting that the importation of counterfeit trademark goods or pirated goods infringing copyright is being prepared, who must first

file an application, with the application of border measures being secondary *ex officio*.

The person concerned shall submit the application to the competent customs authority where he establishes his right and provides sufficient evidence of the presumption of the infringement of his intellectual property right, and in addition he shall submit a description of the infringed goods so that the authority is able to recognize them.

The customs authority must inform whether or not the application has been accepted.

The competent authorities have the power to require the applicant to provide a security or guarantee that is sufficient to protect the defendant and prevent abuse (Trade-Related Aspects of Intellectual Property Rights, 1995, art. 53). If the request has been accepted, the complainant must initiate proceedings on the merits of the case within ten days, otherwise the goods will be cleared.

At this point the customs authority shall notify the right holder and the importer of the suspension of the customs clearance of the goods and what kind of measure has been taken.

If the procedure leading to a final decision has been initiated, a review including a right to be heard shall take place within a reasonable period of time, with the objective of saying whether the measures should be modified, revoked or confirmed (Trade-Related Aspects of Intellectual Property Rights, 1995, Art 55).

If the outcome of the procedure has determined that the measure taken was unfounded, the complainant may be required to pay compensation to the owner of the goods.

On the other hand, if the result concludes that the goods actually violate intellectual property rights, the competent authority may order that the goods be destroyed or removed from the trade circle.



Article 59 specifies that the goods may not be re-exported in the same state or placed under any other customs procedure, with certain exceptions (Natasha Bluztein y Nélon Franco Yépez, 2011).

As already mentioned, the TRIPS Agreement is binding on the members and not on individuals, and it is therefore up to the States to regulate their domestic legal systems, since the rules contained in the TRIPS Agreement will not be directly applicable and will require domestic legislation.

Precisely, in application of the commitment assumed by the country when it joined the WTO in the 90s, the Intellectual Property Law was enacted, an instrument that provided for a procedure to take border measures, similar to the one described above, a procedure that, as we will see below, differs from the one provided for in the body of regulations currently in force.

### **3.- Regional Legislation - Decisions of the Andean Community of Nations -CAN**

Regional regulations on intellectual property require member countries to establish strict controls with respect to the enforcement of intellectual property rights. Therefore, control of the entry and exit of goods is imperative since it is necessary to verify that the goods that are intended to enter or leave the country do not infringe intellectual property rights.

The decisions of the CAN are complementary to the provisions of the TRIPS Agreement, so there is no contradiction between the two.

The decisions adopted by Ecuador on this subject are as follows:

#### **1. Decision 486 on Industrial Property:**

For the issue of border measures this Decision has considered only the issue of trademark rights, leaving aside the other branches of industrial property.

This Decision regulates that border measures will be applied to import and export regimes, later on as we will see, Decision 689 was also extended to those goods that were under the transit regime, but our country did not ratify it, reason why this possibility is not foreseen in our internal legislation.

It is precisely chapter III of this decision that deals in six articles (251-256) with the issue of border measures.

These articles detail the procedure to be followed when applying for a border measure, which is completely the same as that established in the TRIPS Agreement. The Decision further provides that, if the legislation of each country so permits, the competent national authority may order the application of border measures *ex officio* (Arispe, 2018).

When regulating only the branch of trademark rights, Decision 486, the former Ecuadorian Institute of Intellectual Property, now the National Service of Intellectual Rights, in two official letters dated July 2009, stated that "Industrial Property matters not covered by the Decision shall be regulated by the internal rules of the Member Countries" (Natasha Bluztein y Nélon Franco Yépez, 2011).

The CAN also issued Decision 689 "Adaptation of Certain Articles of Decision 486-Common Industrial Property Regime, to permit the Development and Enhancement of Industrial Property Rights through the Domestic Legislation of Member Countries" which essentially addresses what its title implies. For its part, Ecuador did not subscribe to this Decision because it considered that it would not contribute to the development, expansion or protection of other forms of industrial property through border measures and therefore did not adhere to Decision 689.

## **2. Decision 351 on Copyright and Related Rights**

The main background to this decision is the Berne Convention, which the main convention is providing for the possibility of confiscating works when they have been counterfeited.

The Decision as such does not contain a special chapter on the application of border measures; however, within its body it determines such possibility. Thus, it establishes that the owner of the copyright has the exclusive right to authorize, make or prohibit, among other actions, the importation into the territory of any member country of copies made without the authorization of the owner of the right, the same exclusive right is granted to the producers of phonograms.

The Decision also empowers the National Authority to issue precautionary measures for goods that infringe copyright (Arispe, 2018).

However, it should be stressed that once the holder of a right has placed his works on the market, the holder will no longer have the right to prevent imports or to influence the price of goods, this act is known as exhaustion of rights.

## **3. Decision 345 on Plant Varieties**

Decision 345 of the Andean Community, tries to unify the application of the norm at a sub-regional level in the matter of protection of the so-called plant varieties, which are those intellectual creations obtained by applying techniques or procedures to obtain a new, different, stable and homogeneous plant variety. Although, as mentioned earlier, border measures in the field of intellectual property are provided for in our legal system only for trademarks and copyrights, we consider it appropriate to refer, by way of reference, to the articles of this decision applicable to the subject:

**"Article 24.** - The grant of a breeder's certificate shall confer on its owner the right to prevent third parties from carrying out the following acts without his consent in respect of the material of reproduction, propagation or multiplication of the protected variety

(e) Export

(f) Importation

**"Article 28:** Where necessary, the Member Countries may adopt measures to regulate or control the production or marketing, import or export of the propagating material of a variety on their territory, provided that such measures do not entail disregard for the breeders' rights recognized by this Decision or prevent the exercise thereof. (Commission of the Cartagena Agreement, 1993).

This decision could serve as a basis for Ecuadorian legislation to also protect these intellectual rights; however, this branch of the law is completely technical and customs officials do not have the necessary knowledge or expertise to determine whether they are indeed facing a case of infringement of rights and therefore a specialized expert in the field will be required (Natasha Bluztein y Nélon Franco Yépez, 2011).

It should be noted, however, that since Ecuador is an exporter of goods protected by plant varieties, as in the case of roses, but not an importer of such products, if Ecuador were to adopt the above-mentioned reform, the border measures would, unfortunately, be carried out for the most part to specifically control exports that infringe the rights of plant variety owners, who are generally of foreign nationality.

## **4.-National Legislation**

### **4.1. - Organic Code of the Social Economy of Knowledge, Creativity and Innovation – “INGENIOS” Code**

This code created in 2016 contains a section of nine articles (575-583) that specifically develops the border measures; however, it includes the clarification that the provisions established in the referred code will not be against the commitments assumed by Ecuador in the Decisions of the Andean Community in its condition of Member Country.

It should be emphasized that the "Ingenios" Code, in harmony with the Decisions to which it is a signatory, refers only to the application of border measures in cases that damage copyrights and trademark rights, leaving aside the other branches of intellectual property. This can be deduced from the content of Article 575, which states "The owner of a trademark or copyright registration who has evidence sufficient to presume that the import or export of goods infringing his trademark or copyright will be carried out, may request the national authority competent in intellectual property rights to suspend that customs operation" (Organic Code of the Social Economy of Knowledge, Creativity and Innovation, 2016).

Nevertheless, the above-mentioned, section IV of the "Ingenious" Code called Of the Rights and Limitations in article 353 indicates that:

"The acquisition of an industrial design shall confer on its owner the right to prevent third parties not having his consent from manufacturing, selling or importing for commercial purposes products that incorporate or reproduce the industrial design (Organic Code of the Social Economy of Knowledge, Creativity and Innovation, 2016).

The transcribed provisions generate ambiguity in practice, because border measures, as was preliminarily stated, are only foreseen for copyright and

trademark rights, notwithstanding which, the owner of an industrial design, according to the last article cited, could also request the competent authority to prohibit the importation of products that reproduce or incorporate an industrial design, which would ultimately constitute a sort of border measure.

With regard to the procedure for applying border measures, this is quite similar to TRIPS, as we will see in detail later.

#### **4.2.- Intellectual Property Law and its Regulations**

Due to the lack of regulation of the "Ingenios" Code, the Intellectual Property Law and its regulations would be temporarily applied to everything that is not provided for in the Code, according to the Third Transitional Provision of the "Ingenios" Code, which states: "(...) As for the procedures that are being carried out in accordance with the Intellectual Property Law, they will follow the procedure and terms established in that Law. However, those procedures that will start to be carried out as from the validity and promulgation of this Code, must be carried out in accordance with the rules established in this legal body, in what is not regulated, the Law on Intellectual Property and other regulations will be applied temporarily, while the respective regulations are issued (...) (Intellectual Property Law, 1998).

The intellectual property law developed in two articles the border measures, as we will see later and in its regulations there was no express reference to this figure; however, it spoke of a precautionary measure ready to protect any type of intellectual property right. With the issuance of the "Ingenios" Code, the protection was limited to copyrights and trademarks; furthermore, the old law provided for SENA as the main authority to control the entry or exit of any goods that violate intellectual rights; currently, SENADI has this responsibility in the first instance.

For these and other reasons, it is believed that the old Law, in spite of explaining in two articles the issue of precautionary measures, was more

efficient and concrete on the subject, unlike the current Code that still presents many deficiencies and weaknesses, a subject that will be seen later.

## **2.6 Exceptions to border measures**

Article 160 of the TRIPS Agreement states that: Members may exclude the application of border measures to goods in small quantities for noncommercial purposes; to goods contained in travelers' luggage or to goods which are sent in small consignments (World Trade Organization, 1994)

Correlatively, Article 256 of Andean Decision 486 establishes: Small quantities of goods that have no commercial character and are part of the personal luggage of travelers or are sent in small consignments are excluded from the application of the provisions of this article.

Also, Article 583 of the "*Ingenios*" Code reads as follows: Small quantities of goods of a non-commercial nature forming part of the personal luggage of travelers or sent in small consignments are excluded from the application of the provisions of this chapter (Organic Code of the Social Economy of Knowledge, Creativity and Innovation, 2016).

### **Sample with no commercial value**

These goods are mainly intended for market studies, research, development, laboratory tests, and trials, among others. These goods must meet certain conditions: the customs value must be equal to or less than four hundred dollars or not exceed three units per item or commercial presentation; and they must be identified as a sample with no commercial value or it must be demonstrated that they will not be sold.

### **Personal or Traveler's Luggage**

It includes necessary personal goods and other merchandise that accompany the traveler whether new or used which cannot be marketed

under any circumstances. These goods must be intended for use, consumption or gift, with a number and value that cannot be presumed to have a commercial purpose.

Among the necessary personal goods are: clothing, personal hygiene items, jewelry, books, portable entertainment equipment, medicines, sealed food, etc. Items for professional use or that are necessary as equipment and tools for the traveler's trade are also considered personal goods.

New goods cannot exceed two thousand dollars.

In turn, there are certain goods that are acquired for personal use, for home and office, these cannot be more than one copy such as: camera, phones, TV maximum 22 inches, personal computer tablet, etc.

The traveler has the obligation to present his luggage for the respective verification of the goods by the customs control before leaving the international arrival hall. If he evades customs controls, a fine will be applied for regulatory failure, as established by the COPCI.

### **Small batches**

These are minimal import goods as the volume and value of trade is negligible. If border measures are carried out on this type of merchandise, the State would spend more on the administrative processes for the corresponding control than on what it would collect for the entry of these imports.

As established in the Transitional Provision of the Kyoto Convention, signed in the framework of the World Customs Organization, national legislations will determine the minimum value or amount over which no duties or taxes will be collected since it would cause unnecessary expenses for administrators as well as for importers or exporters.

In Ecuador, SENAE has set the value of goods exempt from payment of duties and taxes on the basis of the declared FOB value, which must be less than



\$400 in less than 4 kilos; goods with these characteristics follow a simplified procedure (Merchan Larrea & Molina Santillan, 2013).

As we can see, these are the only cases in which the procedure for the establishment of the so-called border measures would not apply, even in the case that the goods violate the rights of a trademark or copyright holder, but it is considered that the objective is not to introduce the goods into the commercial circuit of the country, but the personal or professional use of the traveler.

## **2.7 Comparison of the Intellectual Property Law and the "Ingenios" Code**

In order to carry out the respective analysis, we will first proceed to transcribe the articles to be compared, then we will refer to the main differences identified to conclude with a general and specific analysis of these differences.

### **A. - Transcription of legal provisions**

#### **1. - Articles 342 and 343 of the Law on Intellectual Property**

**Article. 342.** Customs administrators and all those who have control over the entry or exit of goods into or from Ecuador have the obligation to prevent the entry or export of products that in any way violate intellectual property rights.

If, at the request of an interested party, they do not prevent the entry or export of such goods, they will be considered accomplices to the crime committed, without prejudice to the corresponding administrative penalty.

Where, either ex officio or at the request of a party, they prevent the entry or export of any product that infringes intellectual property rights, they shall inform the President of the IEPI in a

detailed report, and the latter shall confirm or revoke the measure taken within a period of five days. Once the measure has been confirmed, the goods shall be placed at the disposal of a criminal court.

Where the Administrator of Customs or any other competent official has refused to take the required measure or has failed to issue a ruling within a period of three days, the person concerned may, within the following three days, appeal directly to the President of the IEPI for an order (Intellectual Property Law, 1998). Whoever orders the measure may require security in accordance with the following article

**Article 343.** Without prejudice to the provisions of the foregoing Article, any of the National Directors, depending on his area of competence, may, at the request of a party, order the suspension of the entry or export of any product that in any way violates intellectual property rights.

The ruling shall be issued within a period of three days following the request. If it is considered necessary or advisable, provision may be made for the applicant to provide adequate security. If it is not granted within five days of the request, the measure shall be without effect.

At the request of the party affected by the suspension, the National Director of the IEPI shall, as the case may be, arrange for a hearing to be held to examine the merchandise and, where appropriate, revoke the measure. If he does not revoke it, he shall arrange for everything that has been done to be referred to a criminal court (Intellectual Property Law, 1998)

## **2.- Articles 575 to 583 of the current “Ingenios” Code**

**Article 575.** - From the application for border measures. - The owner of a trademark or copyright registration who has sufficient evidence to believe that the import or export of goods infringing his trademark or copyright will take place may apply to the national authority competent in matters of intellectual property rights to suspend that customs operation. Once the application for border measures has been filed, the authority competent in customs matters shall suspend the import or export of the goods in question until the national authority competent in intellectual property matters has ruled on the application. In addition, where the national authority competent in intellectual property matters becomes aware of an import or export of goods that infringe the trademark or copyright, it may order the suspension of the customs operation, ex officio (Organic Code of the Social Economy of Knowledge, Creativity and Innovation, 2016)

**Article 576.**- Of the procedure. - Actions for border measures shall be filed with the competent national authority for intellectual property rights in accordance with the content, requirements, deadlines, procedure and other rules laid down in the relevant regulations (Organic Code of the Social Economy of Knowledge, Creativity and Innovation, 2016).

**Article 577.**- Information on import or export. - Any person who requests border measures shall provide the national authority competent in matters of intellectual property rights with the necessary information and a sufficiently detailed and precise description of the goods that are the subject of the alleged infringement to enable them to be recognized. For the purposes of the foregoing paragraph, the competent customs authority that has control over the entry into or exit from the country of goods shall provide the information service relating to the import or export operations of goods (Organic Code of the Social Economy of Knowledge, Creativity and Innovation, 2016).

**Article 578.-** Bail. - The national authority competent in the field of intellectual property rights may, in order to order precautionary measures, require the lodging of a security or guarantee to protect the importer or exporter and prevent possible abuse of rights. The amount fixed shall be proportional to the possible economic, commercial and social impact generated by the measure (Organic Code of the Social Economy of Knowledge, Creativity and Innovation, 2016)

**Article 579.-** Inspection of goods. - For the purposes of substantiating his claims, the owner of the intellectual property right may apply directly to the competent national customs authority for permission to inspect the goods to be imported or exported, without prejudice to the taking of such measures as may be necessary for the protection of confidential information (Organic Code of the Social Economy of Knowledge, Creativity and Innovation, 2016)

**Article 580.-** Border measures for goods infringing copyright or with a counterfeit trademark. - Where border measures are imposed at the request of a party in respect of the importation or exportation of pirated merchandise that infringes copyright or merchandise bearing a counterfeit trademark, they shall be carried out only after sufficient evidence has been filed, together with a detailed account of the alleged infringement. The competent national authority in the field of intellectual property rights may, in order to order precautionary measures, require the lodging of a security or guarantee that will make it possible to protect the importer or exporter and prevent possible abuse of rights. Border measures may not be taken in respect of imports or exports that are not on a commercial scale and those that are insignificant, such as: those that are not of a commercial nature or form part of the personal luggage of travelers or are sent in small consignments (Organic Code of the Social Economy of Knowledge, Creativity and Innovation, 2016).

**Article 581.-** Sanction. - Where the competent national authority in the field of intellectual property rights determines in a reasoned decision that there has been an infringement of intellectual property rights, it shall punish the infringer

with a fine of between one point five unified basic wages and up to 142 unified basic wages, depending on the nature of the infringement and the criteria laid down in the relevant regulations. The same resolution may provide for the adoption of any of the precautionary measures provided for in this Section or confirm those that have been provisionally ordered (Organic Code of the Social Economy of Knowledge, Creativity and Innovation, 2016).

**Article 582.-** Expiry of border measures. - On the expiry of ten working days from the date of notification of the suspension of the customs operation without the plaintiff having initiated the main action or without the competent national authority having extended the suspension, the measure shall be lifted and the detained goods shall be released. This requirement shall be deemed to have been complied with by the initiation of an action for administrative protection, a civil action or, where appropriate, a criminal proceeding, at the option of the plaintiff (Organic Code of the Social Economy of Knowledge, Creativity and Innovation, 2016).

**Article 583.-** Exclusions. - The provisions of this chapter shall not apply to small quantities of goods of a non-commercial nature forming part of travelers' personal luggage or sent in small consignments (Organic Code of the Social Economy of Knowledge, Creativity and Innovation, 2016).

## **Reference to the differences identified between the regulatory bodies**

### **1.- Object**

- The Intellectual Property Law refers to products that violate intellectual property rights, in general.
  
- The "Ingenious" Code specifically refers to the right of the owner of a trademark or copyright registration, in particular.

- As already stated, despite the fact that the relevant provision of the "Ingenious" Code establishes the subject matter of border measures and limits it to trademarks and copyrights, there is another provision such as Article 353 which details it: The acquisition of an industrial design shall confer on its owner the right to prevent third parties not having his consent from manufacturing, selling or importing for commercial purposes products incorporating or reproducing the industrial design.
- This article would confirm that there is the possibility to request as a precautionary measure within an administrative protection procedure, the prohibition of importing products that include industrial designs protected in the country, which could be considered as indirectly extending the measure to other figures of industrial property.
- Another of the perceived differences is the inclusion in our internal normative body of an article that provides for the possibility of revoking precautionary measures in enforcement processes, in the following terms: "The violation of intellectual rights established in this Code will give rise to the exercise of judicial and administrative actions. In exceptional circumstances, without prejudice to the substance or outcome of the main action, in application of the principle of proportionality and at the request of a party, the lifting or suspension of precautionary measures may be ordered" (Organic Code of the Social Economy of Knowledge, Creativity and Innovation, 2016)

## **2.- Procedure**

Next, we will make a summary of the procedures foreseen both in the Intellectual Property Law and in the "Ingenios" Code.

### **Procedures provided for in the Law on Intellectual Property**

The procedures, as indicated in the previous point, are foreseen in articles 342 and 343 of the Law on Intellectual Property, which can be summarized in the following points:

## **a.- Procedure initiated before the National Customs Service -SENAE**

### **1. Ex officio. -**

#### **1.- Informed by SENAE-**

Submission of a detailed report by the highest authority of the Customs to the then IEPI, requesting confirmation or revocation of the measure that suspended the customs operation.

#### **2.- Informed by IEPI. –**

Within five days, the IEPI must issue a report in which it must confirm or revoke the measure ordered by SENAE

#### **3.- Compliance with IEPI Resolution. –**

On the basis of the report issued by the IEPI, the Customs office has to decide whether or not to continue the corresponding customs operation.

### **2. At the request of a party.-**

#### **1.- Submission of the application to SENAE. –**

The owner of an intellectual property right could file an application with SENAE to order the suspension of the import or export operation that in some way infringes his right.

If, at the request of an interested party, customs administrators did not prevent the entry or export of such goods, they could be considered accomplices to the offence that had been committed, without prejudice to any administrative penalty that might have been imposed.

## **2.- Informed by SENAE. –**

In accordance with the standard, SENAE was subsequently required to send a detailed report by the highest authority in Customs to the then IEPI, requesting confirmation or revocation of the measure that suspended the customs operation

## **3.- Informed by IEPI. –**

Within five days, the IEPI must issue a report in which it must confirm or revoke the measure ordered by SENAE.

In case of confirmation of the measure, if there is merit for the effect, the action must be sent to the Prosecutor's Office (the reference in the law is to a Criminal Judge, but based on the accusatory system, the sending is to the organ that directs the criminal investigation)

## **4.- Compliance with IEPI resolution. –**

On the basis of the report issued by the IEPI, the Customs office had to decide whether or not to continue the corresponding customs operation.

## **b.- Procedure initiated before the then Ecuadorian Institute of Intellectual Property -IEPI**

### **1.- Presentation of the application. –**

The owner of an intellectual property right who has been refused an application by SENAE, who has not received any ruling from that body or who has voluntarily decided to do so, may file an application for suspension of the customs operation with any of the National Directorates of the then IEPI.



## **2.- Issuance of the resolution. –**

Once the request has been submitted, as can be deduced from the above-mentioned legal provisions, the IEPI has to decide whether or not the measure was appropriate, within three days.

## **3.- Fixing the amount of the guarantee. –**

If it considered it necessary or desirable, the competent authority could set an amount as security, in order to avoid damage to the importer or exporter of the allegedly infringing goods.

## **4.- Audience Signage. –**

At the request of the party affected by the suspension, the IEPI could set a date and time so that the goods could be examined and, if appropriate, revoke the resolution that ordered the suspension of the customs operation.

The provision contained in Article 343 states that, if the measure had not been revoked, the proceedings should be sent to the corresponding criminal court.

## **Procedure provided for in the Organic Code of the Social Economy of Knowledge Creativity and Innovation or "Ingenios" Code**

In the same way, we would like to point out the current procedure foreseen in the "*Ingenios*" Code:

**Article 576.-** Of the procedure. - Actions for border measures shall be filed with the competent national authority for intellectual property rights in accordance with the content, requirements, deadlines, procedure and other

rules laid down in the relevant regulations (Organic Code of the Social Economy of Knowledge, Creativity and Innovation, 2016)

However, starting from article 575 of the "Ingenuity" Code, a not so clear-cut procedure is developed, as we will summarize below:

### **1.- Submitting an application. –**

Presentation to the National Service of Intellectual Rights-SENAE of an application for the suspension of a customs operation, by the owner of a trademark or copyright, which has sufficient evidence.

### **2.- Suspension of the customs operation. –**

Once the request is received, SENADI must inform SENAE of the suspension of the Customs operation.

### **3.- Bail bonding. –**

If deemed necessary, SENADI can set a bond to prevent possible abuse of rights when precautionary measures have been requested.

### **4.- Issuance of the resolution. –**

Once the value of the security has been deposited, the competent body must issue the corresponding decision on the appropriateness of the border measures in which the measures already ordered may or may not be confirmed or other precautionary measures may be taken.

## **5.- Initiation of the main procedure or process.-**

In the event that the border measures have been confirmed, the main proceedings, which could consist of administrative protection or judicial proceedings, must be initiated within 10 days of notification of the said resolution, otherwise the measures will lapse.

### **3.- Competent body**

As for the competent body, the Law on Intellectual Property provides a twofold possibility, namely:

- The intervention of the customs authority, through its officials, who should, ex officio or at the request of an interested party, prevent the import or export of allegedly infringing goods. In case the measure has been at the request of a party, if the measure was not ordered, even these customs administrators could be considered accomplices of a crime, as well as subjects of an administrative sanction.
- The intervention of the competent authority in matters of intellectual property, through the national Directors to order, at the request of an interested party, the suspension of the import or export of any product that violates intellectual property rights.

In the "*Ingenios*" Code, the first possibility was eliminated, granting exclusive competence to the officials of the competent national authority in matters of intellectual rights-SENADI, who must proceed ex officio or at the request of a party.

From what has been stated in this point we can limit that, the competence is no longer optional, that is, the owner of a right could choose before if he requested SENA E or went to what was then the IEPI, either voluntarily or in case of a refusal or lack of pronouncement by SENA E, which was not very common

in practice, since the respective norm established a kind of legal obligation of the SENA officials, under penalty of being considered accomplices of a crime.

The referred legal obligation, as it will be seen later, brought as a consequence that the border measure is a more or less effective tool to guarantee the protection of the intellectual property rights in this area, unlike what happens at the present time with the enforcement of the "Ingenios" Code.

#### **4.- Regulation:**

##### **Regulations to the Law on Intellectual Property:**

Reviewing the regulations to the Law on Intellectual Property, it can be observed that there is no section dealing with border measures, but only with precautionary measures. However, it should be noted that, in the current procedure, within border measures, the possibility of ordering precautionary measures is foreseen; that is to say, a border measure is more general while a precautionary measure would be more specific.

As a reference, we will cite Article 565 of the "Ingenios" Code, which sets out the forms that an interim measure may take:

**Article 565.-** Provision of precautionary measures. - Depending on the nature of the infringement, one or more of the following precautionary measures may be ordered and practiced:

1. The immediate cessation of the acts constituting the alleged infringement;
2. The withdrawal from commercial channels of the goods resulting from the alleged infringement, including containers, packaging, labels, printed matter or advertising or other material, and also the main materials and means used to commit the alleged infringement;
3. Suspension of the communication to the public of the protected content on digital media, ordered to the infringer or intermediary;

4. The suspension of the services of the web portal for an alleged violation of intellectual property rights, ordered to the infringer or intermediary;
5. Suspension of the import or export of the goods, materials or media referred to in the foregoing paragraph, which shall be notified immediately to the customs authority;
6. Temporary closure of the establishment of the alleged infringer where necessary to prevent the continuation or repetition of the alleged infringement;
7. If any of the measures described in the foregoing paragraphs proves insufficient, any other reasonable measure aimed at stopping the infringement may be requested, taking into account the legitimate interests of the owner of the intellectual property right and those of the alleged infringer. This measure shall be applicable if the interests of third parties are not affected (Intellectual Property Law, 1998).

### **Regulations to the "Ingenios" Code:**

To date, only the general regulations have been issued to the "Ingenuity" Code, which does not comply with the fundamental objective of the issue at hand, such as the development of the respective procedures for border measures, which causes a legal vacuum and, therefore, a deficit in the protection of intellectual rights.

## **B.- Comparative analysis of the above legal provisions**

### **1.- General analysis:**

An analysis of both the Intellectual Property Law and the "Ingenios" Code shows in a general way that

Both the law and the code do not have a section that can concisely define the concept of border measurement. The Intellectual Property Law, first to be

issued chronologically, begins to explain the process in a direct manner, but without a reference to what this measure means. The "Ingenios" Code simply makes a brief reference to when to apply for the measure, but does not provide a definition as such.

We consider at this point that defining the terms within the law is fundamental, since it facilitates the understanding and correct application of a measure aimed at protecting rights.

## **2.- Specific analyses:**

As can be seen, the Intellectual Property Law in articles 342 and 343 referred briefly to a procedure that should be developed in the regulations to that law, but this fact did not occur during the entire time that the law was in force, which, in the opinion of the competent authorities, generated a lack of protection for intellectual property rights and therefore a lack of legal certainty.

In the "Ingenios" Code, the procedure for taking measures at the border is developed with more amplitude, however, we could point out that it is not the most advisable thing for the legislative technique to include in a substantive code, rules of procedure, even more if such procedure is not completely clear, hence the fact that in our opinion, it is necessary to include reforms, as well as, the urgent issuance of a regulation for the observance of rights that clarifies the doubts and contradictions detected in the "Ingenios" Code, in order to provide certainty to the holders of intellectual rights (trademarks and copyrights) that their assets will be effectively protected.

1. At this point it is appropriate to make a very important criticism of the Code "Ingenios" because the most important part of the procedure is being entrusted to the National Service of Intellectual Rights, that is, the task of the authorities of this body is, in the first instance, to prevent the entry or exit of goods that infringe copyright or trademarks and to

sanction any infringement by adopting a border measure. However, the authorities of the mentioned organism, do not develop their functions daily at the borders, but their offices are located in a secondary zone, therefore, how can a SENADI server have the scoop that in an import or export could be injuring the intellectual rights? As a result of what has been said, we believe that competences should be divided between the customs authority and the intellectual rights authority, as will be explained later.

**Table 1 Summary of similarities and differences between the Old Intellectual Property Law and the current "Ingenios" Code**

<b>SIMILARITIES</b>		
They do not have a clear and precise definition of the concept of Border Measures.		
<b>DIFFERENCES</b>		
	<b>Intellectual Property Law</b>	<b>"INGENIOS" Code</b>
<b>OBJECT</b>	Products that violate intellectual property rights in general	Goods that specifically violate copyright and trademark rights.
<b>COMPETENT BODY</b>	<ul style="list-style-type: none"> <li>- Customs officials. (of office - at the request of a party) Or</li> <li>- Competent Intellectual Property Authority (at the request of a party)</li> </ul>	<ul style="list-style-type: none"> <li>- Officials of the Intellectual Rights Service: (officials - at the request of a party)</li> </ul>



<p><b>PROCEDURE</b></p>	<p><b>A. Procedure before SENAE</b></p> <p><b>a.1 Ex officio:</b></p> <ol style="list-style-type: none"> <li>1. Report by SENAE.</li> <li>2. IEPI report.</li> <li>3. Compliance with the resolution of the IEPI</li> </ol> <p><b>a.2 At the request of party:</b></p> <ol style="list-style-type: none"> <li>1. Submission of the application to SENAE.</li> <li>2. SENAE 's report</li> <li>3. IEPI report</li> <li>4. Compliance with IEPI resolution</li> </ol> <p><b>B. Procedure before the IEPI</b></p> <ol style="list-style-type: none"> <li>1. Submission of the Application.</li> <li>2. Fixing the amount of the guarantee.</li> <li>3. Setting of the Hearing.</li> <li>4. Issuance of the resolution.</li> </ol>	<ol style="list-style-type: none"> <li>1. Submission of the application.</li> <li>2. Suspension of the customs operation</li> <li>3. Lodging of a security</li> <li>4. Issuance of the resolution.</li> <li>5. Initiation of the main proceedings.</li> </ol>
<p><b>REGULATIONS</b></p>	<p>The regulations of the Intellectual Property Law speak only about precautionary measures, but do not refer to border measures.</p>	<p>No specific regulations have been issued. The procedure is developed in the "Ingenios" Code.</p>

**Author:** Own elaboration

**Source:** Organic Law on Intellectual Property-"INGENIOS" Code



## Conclusion

This chapter focused on the development of border measures in the customs and intellectual property fields, for which the concept of border measures was first developed in a general way, as well as their characteristics, classes, objectives and importance.

It was necessary to cite specific legal provisions for each subject at the international, regional and national levels, since they help to better understand the subject and to know the sustainable bases of the "Ingenios" Code.

In addition, within this chapter it can be seen that as in the other intellectual property topics, the border measures are also supported by a series of legal provisions that start in a general way from the Constitution of Ecuador, international treaties such as the TRIPS, the decisions of the CAN and what is established in the old Intellectual Property Law, as well as in the "Ingenios" Code itself. However, an error that could be identified is the lack of regulation both in the old law, which despite having a regulation, only refers to precautionary measures, as well as in the "Ingenios" Code, even more so when the latter instrument does not have the specific regulation that develops the procedure contemplated in that code.

Another conclusion that could be reached preliminarily is the change of competences in the current Code. As already mentioned in the development of the chapter, the previous Intellectual Property Law stated that when it comes to a border measure, the competent authority could be either SENAE or SENADI; however, the current Code "Ingenios" only grants competence to SENADI, a change that is considered inopportune and even inconsistent since, as it is a border measure, the logical thing is that the customs should first take charge of the case and then have the support of other government entities. SENADI clearly does not work at the border and therefore is not aware of when an intellectual property right is being infringed.

Finally, when making the summary of similarities and differences between the Old Intellectual Property Law and the current Code "Ingenios", we could realize that the only similarity between these laws is the lack of inclusion of a concept of border measures, but that there are differences in the object, the competent body and the procedure.

We believe that these changes have indeed had an impact on the way border measures are applied in Ecuador today.

## **CHAPTER 3: BORDER MEASURES IN ECUADOR AND LATIN AMERICA**

### **3.1 Nationals cases studies**

The Ecuadorian Customs Office is obliged to apply the "risk profile" analysis method, which, as previously stated, is a procedure provided worldwide to prevent the entry of infringing goods that violate intellectual rights such as trademarks and copyrights, in accordance with the "Ingenios" Code. Through this profile, it is possible to select or classify shipments and declarations based on the level of risk they present or when they are presumed to contain products that are not permitted for marketing. These types of acts help to ensure that any type of merchandise presumed to be infringing does not enter national territory and therefore does not affect trademarks or copyrights in the country of destination.

Below, the cases of border measures over the last thirteen years will be analyzed based on the information obtained by the SENADI Sub-Directorates in the cities of Cuenca and Guayaquil. It is necessary to clarify that due to the lack of information it was not possible to obtain the data from the city of Quito; however, with the data obtained from Cuenca and Guayaquil it is already possible to find interesting aspects that are detailed below.

#### **3.1.1 Cases from the city of Cuenca**

The first group of cases to be presented belong to the period from 2007 to 2013, a period in which a total of eleven cases of border measures have been presented in the city of Cuenca.

In the first case that was presented in 2007, as deduced from Manifest No. 1092007-03-311, the consignee was Claudio Arevalo, who imported from China sports shoes identified with the brands Nike, Adidas (Yomax), Sckechers (knu) and HI TEC; this merchandise entered the country by land, through the District of Macará. The right that was violated was the right to trademarks.

In this case, the National Customs Service of Ecuador-SENAE notified the then Ecuadorian Institute of Intellectual Property-IEPI about this case on December 19, 2007 through official letter No. CAE-GFZ-DI-1293, received on January 8, 2008 and days later, the latter entity issued an administrative act by which it partially confirmed the measure taken due to the fact that it had the support of the owners of the trademarks AIR, HITEX and YOMAX, through the presentation of an expert report and a sworn statement about the distribution and commercialization channels of the referred trademarks, documents from which it could be inferred that the merchandise was not original and revoked the measure regarding the trademarks YOMAX (white shoe), VELOCITY and KNUO and DESIGN.

In this manner, the IEPI notified SENAE with the objective of not continuing with the procedure for the nationalization of the merchandise identified with the trademarks already referred to.

The second case was filed in 2008, when the consignees Fabián Granda and Juner Lapo, according to the declaration No. 109-07-10-001343 and 109-07-10-001345 and; Anabel Moreno and Víctor Valladares (Refrendos 109-07-10001347 and 109-07-10-001353 respectively)- imported from China allegedly infringing material, specifically toys representing characters such as Barney, Winnie Pooh, Mickey Mouse, Toy Story and Barbie, thus infringing upon trademark and copyright rights. On January 16, 2008, the IEPI, after the notification by SENAE, contained in official letter No. CAE-GFZ-DI-024, requested a detailed report on the alleged violation of rights, which was not answered by the Customs Service.

The third case was developed in 2010 and corresponds to the importer and distributor Altaprince CIA. Ltda. Company that also imported from China according to customs declaration No. 091-10-10-002289, shoes of the brands Nike, Puma, Converse, Vans, Belle by Altaprince. The goods entered by sea and were retained due to an apparent violation of trademark rights.

On August 31, 2010 the IEPI issued the respective letter in which it partially confirmed the decision, this because it had the support of the owner of the

trademarks NIKE and PUMA, through an expert report and a sworn statement which inferred that the goods were not original and revoked the measure in relation to the marks VANS, CONVERSE and BELL BY ALTAPRINCE, providing for the nationalization of the goods identified with those marks.

In the same year, the same consignee made a new import in this case of shoes, and additionally, sandals of the following marks: NIKE, PUMA, ADIDAS, CONVERSE, IPANEMA, CROCS and DOLCE & GABANNA, according to declaration No.091-10-10-002288. The IEPI's letter was issued on October 21, 2010 and also partially confirmed the decision of border measure for the infringement of trademarks ADIDAS, PUMA, NIKE and CROCS and revoked with respect to trademarks CONVERSE, IPANEMA and DOLCE & GABANNA.

For a third time and in the same year, the above mentioned importer, according to customs declaration No.091-10-10-002292, entered Ecuador by sea, sports shoes brand NIKE, PUMA, ADIDAS, CONVERSE, ARMANI AND VANS and cardboard boxes, presumably infringing trademark rights. The Intellectual Property Institute-IEPI issued its respective official letter on November 12, 2010, by which it again partially confirmed the border measure ordered by SENAE, in relation to products identified with the marks NIKE, PUMA, ADIDAS and ARMANI and revoked the measure in relation to the marks CONVERSE and VANS, due to lack of support from the trademark owner.

As a scope of the resolution taken, the then IEPI confirmed the border measure ordered by SENAE in relation to the shoe boxes identified with the above mentioned trademarks, because it considered that they were using the trademarks registered by the international federation of association football, without authorization of their owner, as stated by its attorney-in-fact who appeared in the respective administrative proceeding.

In these three cases, no administrative appeal or judicial proceeding was filed. The sixth case has as consignee Mr. Boris Palacios who imported according to

DAU No. 17238894 in 2011 from China manual greasing machines brand PRESSOL, having been retained its goods by an apparent violation of trademark rights.

SENAE issued the respective notice on January 13, 2011 and seven days later IEPI revoked the decision to apply a border measure, because the infringement of rights in this case was not confirmed due to lack of sufficient evidence. As in the previous cases, no appeal or legal action was filed.

In the seventh case the consignee was Fabricio Dominguez who, according to DAU 091-11-10-001518, imported from China watches, necklaces, earrings, bracelets and wallets with images similar to those of brands such as BETTY BOOP, NAUGHTY NAUGHTY PET'S, TOUS, GUESS, GENEVE and LUSCIOUS for an FOB value of \$467.88. This import presumably infringed on trademarks and copyrights.

After the notification by SENAE, the IEPI issued its official letter on May 31, 2011 and partially confirmed the decision of a border measure, with respect to the trademark TOUS and revoked the measure with respect to the trademarks Betty Boop, Naughty Naughty Pet's, Guess, Geneve and Luscious due to the lack of adhesion of the trademark owner or a report from which it could be deduced that the material was not infringing. In the present case, no appeal was lodged or legal proceedings initiated.

In the eighth case the consignee Juana Espinosa according to the DAU 17892892, in 2011 imported from China handles, pendants, earrings and necklaces of the Bylgari and Cartier brand. Her merchandise entered Ecuador by sea and was detained due to an alleged violation of trademark rights. On September 29, 2011, IEPI partially confirmed the decision with respect to the articles identified with the BVULGARI trademark and revoked the measure with respect to the CARTIER trademark, by an agreement reached by the parties to eliminate the aforementioned denomination from the articles. In this case



an appeal for reversal was lodged<sup>5</sup>, which was confirmed by the authority that initially knew the case.

The ninth case involves Angel Sanchez who according to DAU 18537812 imported in 2012 from Hong Kong stuffed animals, key chains, dolls, piggy banks, PSP cases, steering wheels, controls, memories and headphones identified with characters such as SMURFS, MARIO BROSS, NINTENDO WII, SONY and ANGRY BIRDS for an FOB value of \$17,718.90. The right allegedly infringed was the trademark right and the copyright.

IEPI partially confirmed the decision on June 6, 2012, only in relation to the products identified with the trademark SMURFS, MARIO BROSS and SONY AND ANGRY BIRDS. In this case, the Customs Service filed an appeal before the then Committee on Intellectual Property (now the Collegiate Body on Intellectual Rights); however, the Committee noted that there was no place for the appeal since the Customs Service is not a party to the proceedings as it is a public institution and therefore is not entitled to file an appeal.

The last case corresponds to the consignee Eva Ulloa who according to DAI No. 091-2013-10-00459636 imported from China toys of the characters BRATZ AND TRANSFORMERS. Her merchandise entered in 2013 by sea and was detained due to an alleged violation of copyright and trademarks. On October 12, 2013, the IEPI partially confirmed the border measure ordered by SENA E; however, an appeal was filed and resolved on January 31, 2019, rejecting the referred appeal because the Court considered that SENA E did not prove to be the owner of a subjective right that had been infringed by an administrative action.

In 2013, a case of subsequent control was presented in which SENA E informed IEPI that, according to the provisional retention act No. UVAP-OPE-ARP-2013105, consignee Susana Allpa is importing goods that allegedly infringe

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<sup>5</sup> The Appeal for Reposition is the one that was formulated before the same public authority that issued the administrative act that is the subject of the challenge, in order to get that authority to revoke, reform or substitute it.

intellectual property rights. The IEPI requested a detailed report in order to carry out the corresponding analysis and adopt a decision.

SENAE sent this report and the IEPI, by means of a report, abstained from issuing any opinion on the matter.

Continuing with the analysis, the second group of cases to be presented correspond to the years 2014 to 2020, when there were a total of seven cases, as detailed below:

It should be noted that, within this group of cases, in some of them it was found that there was no pronouncement by the IEPI because the merchandise was seized as a consequence of a subsequent control act within a secondary zone, it was not a consequence of a border measure, reason why, in the respective resolutions it is left safe from the right of the intellectual right holder to file the respective administrative action (protection) or judicial action, as appropriate.

In the year 2014 three cases of border measures were presented: with respect to the first case, according to DA No. 091-2014-10-00496389 consignee Karla Viviana Beltrán imported clothing and shoes of the brands H&M, KENNETH COLE, BEBE, ARMANI EXCHANGE, AVEC, CHARLOTTEE RUSSE, PAPAYA, SWEET RAIN, AMERICAN EAGLE, GUESS, FOREVER 21, CALVIN KLEIN, HOLLISTER, GAP, DIVIDED, MICHAEL KORS, IZPD, TOMMY HILFIGER, BANANA REPUBLIC, ANN TAYLOR, EXPRESS, LEVI STRAUSS, PERRY ELIS, LEVIS, RALPH LAUREN, HERITAGE, DEBUT, PUMA, AEROPOSTALE, MAY QUEEN COUTURE, XINKI, JANICE, FLAMINGO, BLACK RIVET, ULTIMATE and BOZZOLO, allegedly infringing the Industrial Property rights of the respective owners. On October 17, 2014, the IEPI decided to revoke the border measure, because the trademark owners did not appear and adhered to the measure ordered by SENAE, and therefore there were not sufficient elements to warn that their rights had been infringed.

In the second case, the consignee was Mr. Manuel Zeta, who imported from Peru toys identified with the trademarks and characters of CARS and BEN10, according to DAU No. 082-2014-10-00526943. The merchandise entered by land with an FOB value of US\$519.60. On December 10 of that year, the IEPI

confirmed the violation of the copyright and trademarks, as well as the application of the corresponding border measures consisting of the prohibition to resume the nationalization of the merchandise.

In the following case, the then IEPI received from SENAE a forfeiture order according to which, by means of an arrest warrant No. UAC-OPE-AA-2014146, the customs authority, upon inspection of a transport vehicle, found allegedly infringing merchandise, specifically sports shirts for which Mr. Ortega Quevedo was the addressee (the name does not appear). SENAE notified IEPI of this case on November 14, 2014. In the resolution there was no pronouncement, because the case was presented as a consequence of a subsequent control act in a secondary area and the institutional criterion is that the IEPI does not act *ex officio*, but at the request of a party, so that he or the holders of intellectual rights must present the corresponding administrative or judicial action as stated above.

In the year 2015, two cases of border measures were presented:

In the first case, the consignees were Vanessa Pinzón, Víctor Ramón and Ana Duran, who, according to the provisional detention report No. UVAH-OPE-PR2015-0078 imported from Peru allegedly infringing goods, specifically shorts of the trademarks RIPCURL, QUICKSILVER, BILLABONG. SENAE notified the IEPI about the case on February 24, 2015 and on February 3 of that year, the latter entity issued a notice by which it partially confirmed the application of the border measure since the right of the owner of the BILLABONG trademark was infringed, who appeared in the process requesting the corresponding measure, through his attorney-in-fact.

In the second case, SENAE informed the then IEPI that, as a result of a subsequent control act, allegedly infringing goods were seized from Mr. Mario Esteban Iñiguez, specifically jewelry identified with the trademarks TOUS, CARTIER, BULGARY, TORY BURCH, CHANEL, MICHAEL KORS, YSL, DIOR, HERMES, TIFANNY, VA&C, GUCCI and, MANKINS. SENAE notified IEPI of the case on May 21, 2015. There was no pronouncement in the decision; it was not a border

measure or an administrative guardianship, because the case was registered as a consequence of a subsequent control act in a secondary area.

In 2016 there were only two cases notified by SENAE to the IEPI, but as in previous occasions, there was no pronouncement since the merchandise was seized by a subsequent act of control within a secondary zone.

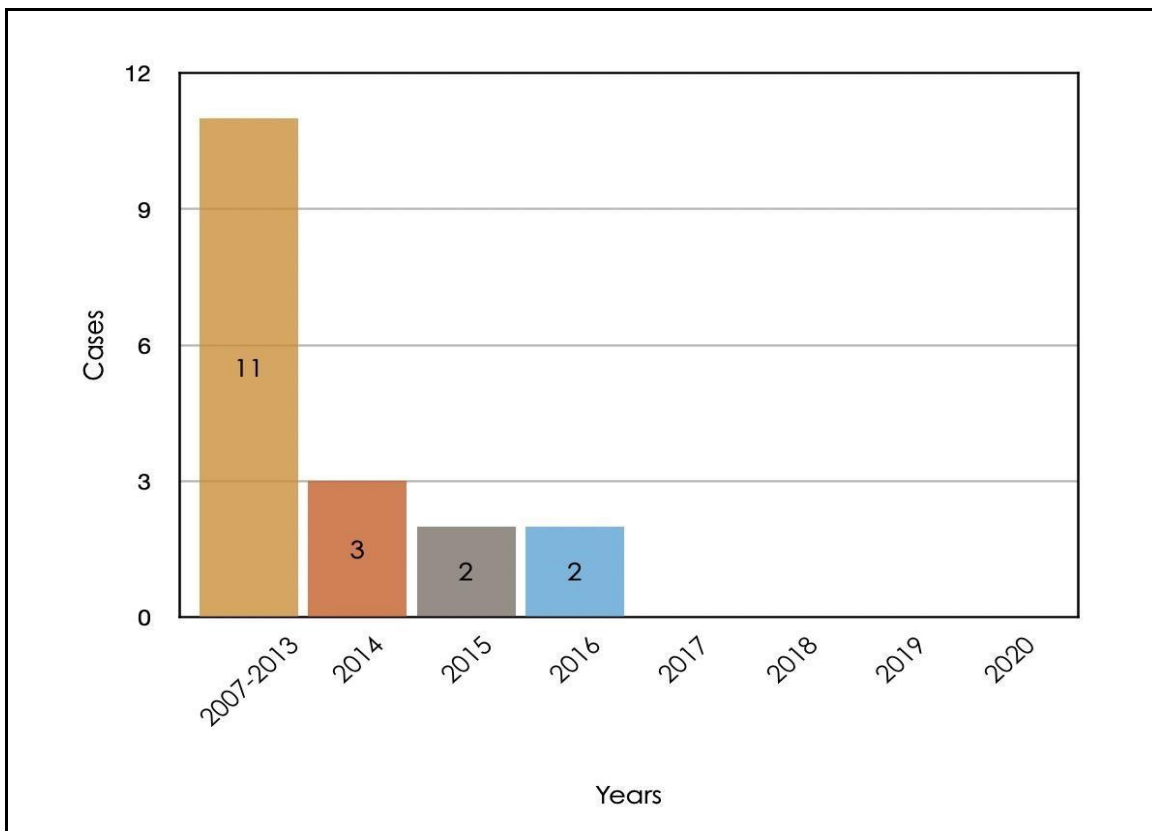
In the first case, the merchandise was definitively abandoned after an act of subsequent control under the terms of apprehension act No. UVAC-OPE-AA2015-017, such merchandise consisted of watches and spare parts for watches identified with the brands TOMMY HILFIGER, NAUTICA, RENOS, NIKE, FOSSIL, CAT, ADIDAS, FERRARI, DIESEL, LACOSTE, MICHEL KORSS, SHORS, LOGO EMELEC, LOGO BARCELONA, XINJA, POLIT, MINGUI, WR, GUESS, ROLEX, KLOSS, DNS, GENEVA, MUNG DU and SONY. The SENAE duly notified the IEPI on February 2 of that year, but there was no pronouncement since the merchandise was seized by a subsequent control act within a secondary zone, it was not a border measure nor was a request for administrative protection filed.

In the second case, similarly, the merchandise was subject to definitive abandonment after an act of subsequent control under the apprehension act No. UVAC-OPE-AA-2015-114, such merchandise consisted of watches and jewelry identified with the marks BVLGARI, CHANEL, CARTIER, TOUS, MICHAEL KORSS and LOUIS VUITTON. SENAE made the respective communication to the IEPI on February 3, 2016 and, as in the previous case, there was no pronouncement from the competent entity in matters of intellectual rights, since it was a border measure and not an administrative protection.

In the years 2017, 2018, 2019 and so far in 2020, according to information from the current SENADI, no case has been filed regarding border measures. This may be due to the change in functions of the authorities in charge of this matter, since the "Ingenios" Code established new roles and now the institution in charge of verifying the goods and applying the corresponding border measure is exclusively SENADI.

Up to this point, the cases presented in Cuenca from 2008 to March 2020 have been summarized. In order to make a more didactic summary and achieve a better understanding, statistical tables will be presented with the most relevant data of the cases presented.

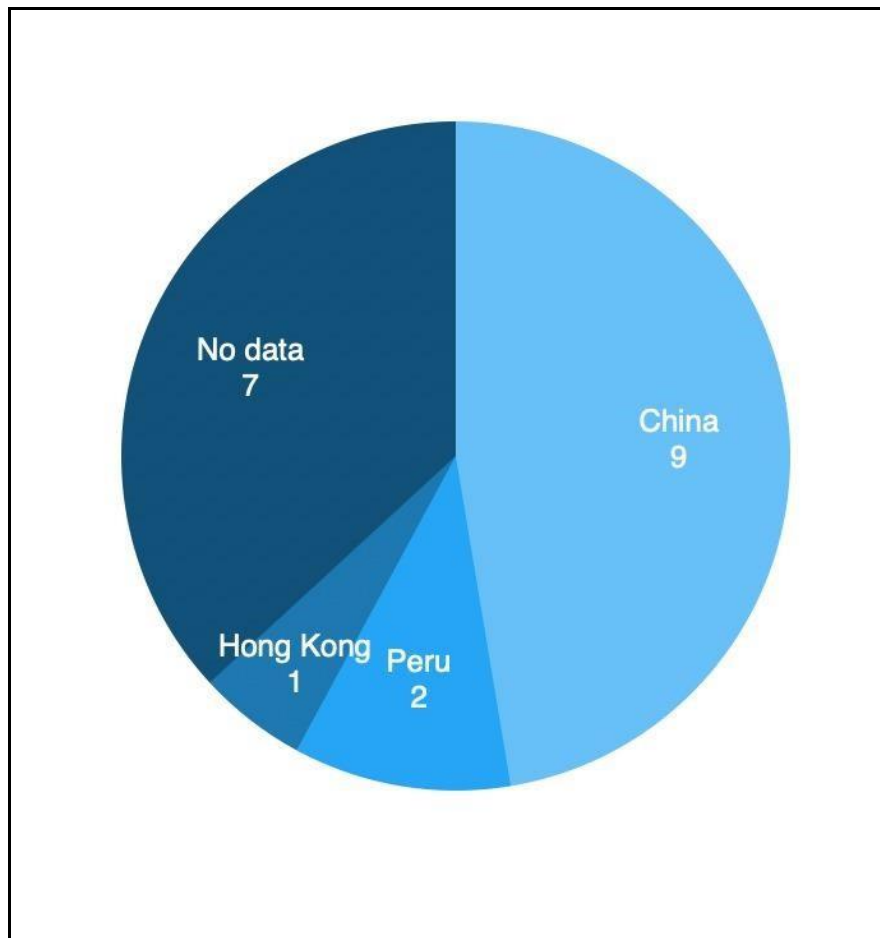
**Figure 1 Number of cases presented in the city of Cuenca from 2007 to 2020**



**Authors:** Own elaboration

**Source:** SENADI data

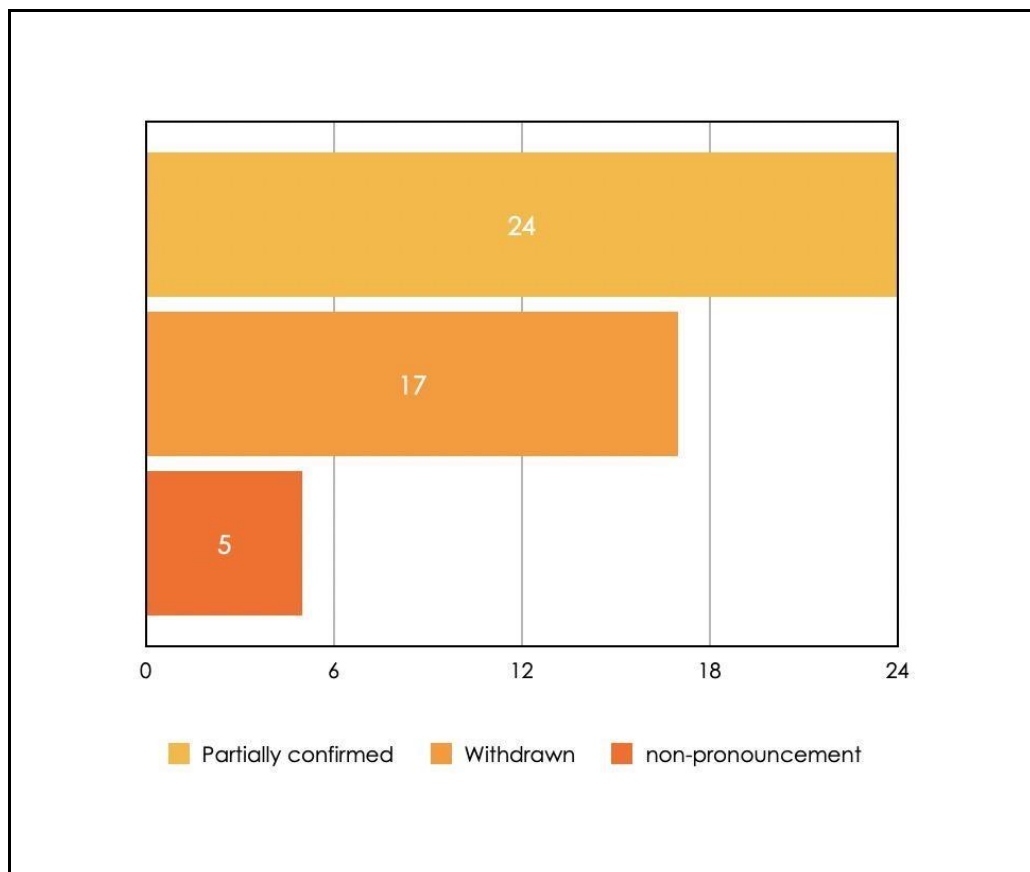
**Figure 2: Country of origin of goods retained in the cases of Cuenca**



**Authors:** Own elaboration

**Source:** SENADI data

**Figure 3 Decisions agreed upon in the Border Measurement cases presented in the city of Cuenca.**



**Authors:** Own elaboration

**Source:** SENADI data

As a conclusion of the border measure cases presented in the city of Cuenca, it can be highlighted that, during the thirteen years studied, only 18 cases were presented, in which it is noted that within the same procedure several decisions were taken, depending on the support, not on the owner of the trademark of the imported goods. That is to say, in certain files, some border measures were confirmed or revoked by the competent authority, since the respective owners appeared or not, respectively.

The number of cases is not higher, in comparison with the city of Guayaquil (as will be seen below) since more than 1000 cases have been filed in that city to date. Nevertheless, it cannot be ignored that Guayaquil, being the main

seaport of Ecuador, has a superior flow of goods from several countries of the world.

Another preliminary conclusion is that most of the goods detained come from China, which is not new since China is the largest exporter of the goods most frequently detained (clothing, jewelry, toys, etc.).

Finally, it is worth noting that the tendency in the resolutions in the cases presented in the city of Cuenca is to partially confirm the decision, as explained above, which means that the owners of copyrights or trademarks do not always adhere to the process and collaborate by presenting expert reports and sworn statements that confirm that their trademark or their works are indeed being violated by some foreign trade operation carried out in the country.

### **3.1.2 Cases from the city of Guayaquil**

The following summary and subsequent statistical tables with their respective analysis were made with the support of the SENADI Sub-Directorate in the city of Guayaquil, as they facilitated the collection of the corresponding data.

Between 2008 and 2011, there is no specific information on what type of merchandise was imported, on the name of the consignee or on the injured right; however, the scarce data that could be obtained are the following:

Year 2008: 485 border measures taken, of which 444 were confirmed, 14 measures revoked and 27 measures partially confirmed.

Year 2009: 189 border measures were taken of which 144 were confirmed, 29 revoked and 16 partial measures.

Year 2010: 220 measures taken of which 125 were confirmed, 58 were revoked and 37 were partially confirmed.

Year 2011: During this year 175 border measures were taken of which 106 were confirmed, 52 were revoked and 17 were partially confirmed.



From 2012 onwards, the information required by SENADI is more complete and specific information on the cases presented, as well:

During 2012, 101 cases of border measures were presented, of which 59 were confirmed, 25 revoked and 17 partially confirmed. Of the 101 cases presented, it is known that 65 imports apparently infringed trademark rights, 27 infringed copyright and 9 infringed both rights. Among the goods detained were mainly shoes, toys, jewelry and technological items such as cell phones, memories, USB, cables, among others.

In 2013, a total of 125 cases of border measures were filed, of which 73 cases involved trademark infringement, 28 copyright infringement, 19 cases involved infringement of both rights, and 5 cases did not specify which intellectual property right was infringed. Among the decisions taken, the following stand out: 35 measures were confirmed, 44 were revoked and 46 were partially confirmed. As for the type of goods, these mainly consisted of shoes, wallets, toys, cell phone accessories, video game consoles, etc.

The following year, 115 cases of border measures were considered, out of the total 71 cases where trademark rights were infringed, 21 cases where copyright was infringed and 23 cases where both trademark and copyright were infringed. The decisions that were taken were, 30 measures confirmed, 28 revoked, 54 partially confirmed and 3 that had no decision. The goods detained included mainly toys, clothing, car accessories, cell phone accessories, and jewelry, among others.

In 2015, 184 cases of border measures were registered, of which 125 were entered by sea and 59 by air. The resolutions in these cases were; 50 measures confirmed, 94 measures revoked, 39 measures partially confirmed and one unresolved. Both copyright and trademark rights were specifically infringed, and the merchandise retained included books, cartridge cases, cell phone cases, and mirrors, among others.

In 2016, a total of 149 measures were taken, one of which was resolved in the city of Quito. Of these cases, in 28 cases the goods were brought in by air and in 121 cases the goods were brought in by sea. The resolutions were given in

the following manner: 25 measures were confirmed, 64 measures were revoked, 47 measures were partially confirmed, 2 are unresolved and 10 measures were not decided by the then IEPI. Among the goods detained this year were bags, earrings, shippers, caps, among others.

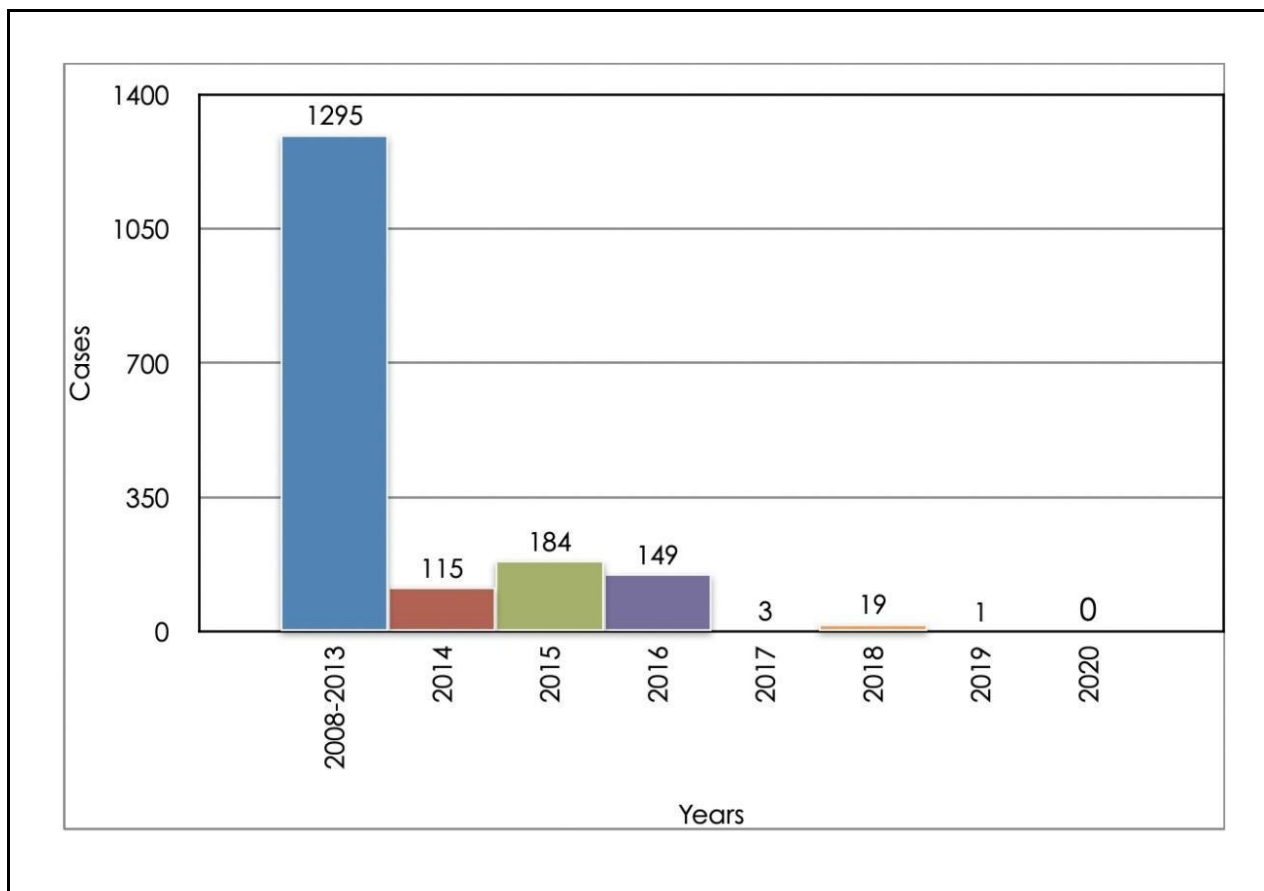
By 2017 there were 3 border measures taken, two of which involved goods entering by sea and one by air. The resolutions have not been responded to and the merchandise detained was Colgate Palmolive brand articles, a Nike belt and Balloon and Headband Stickers.

In 2018, 19 cases were registered, of which the means of entry and the resolutions are not known. Among the merchandise retained were goods identified with brands such as Hawlett Packard, Colgate, Victoria Secret, Huda Beauty Limite, Apple, etc.

In 2019 only one case of border measure has been filed. There was no information available detailing the case.

So far in 2020, no application for border measures has been filed.

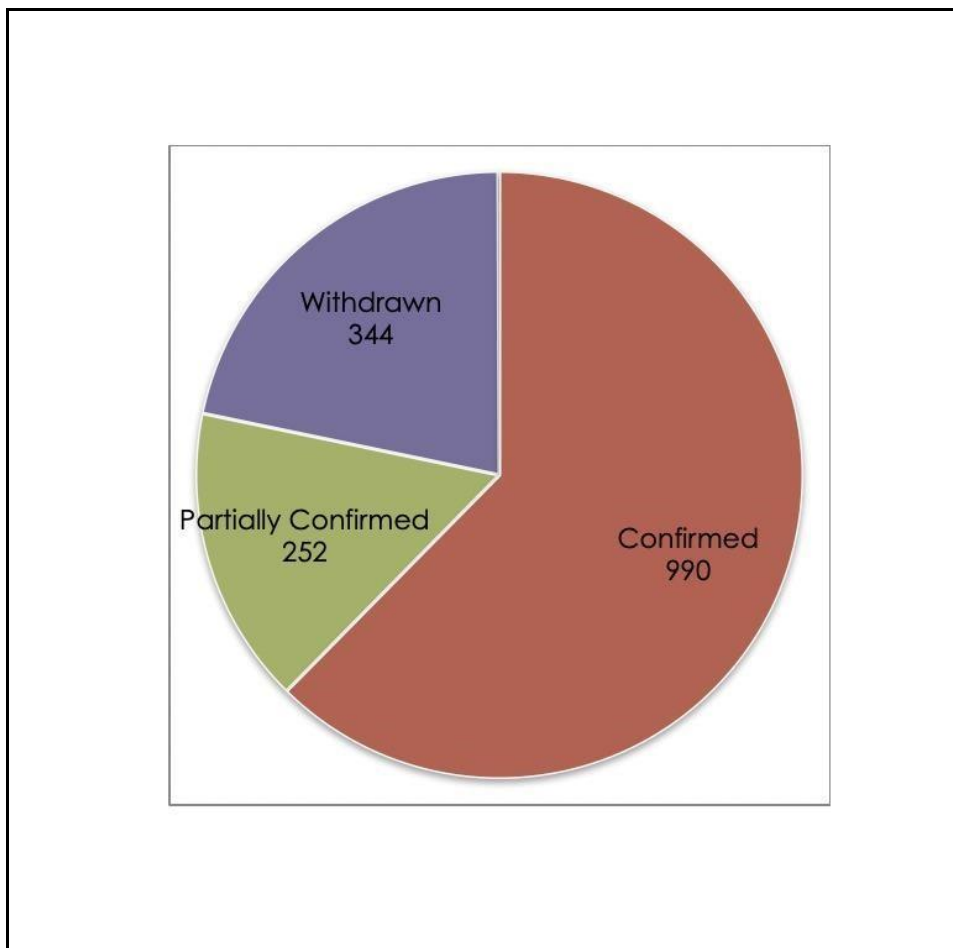
**Figure 4** Number of cases presented in the city of Guayaquil from 2008 to 2020.



**Authors:** Own elaboration

**Source:** SENADI data

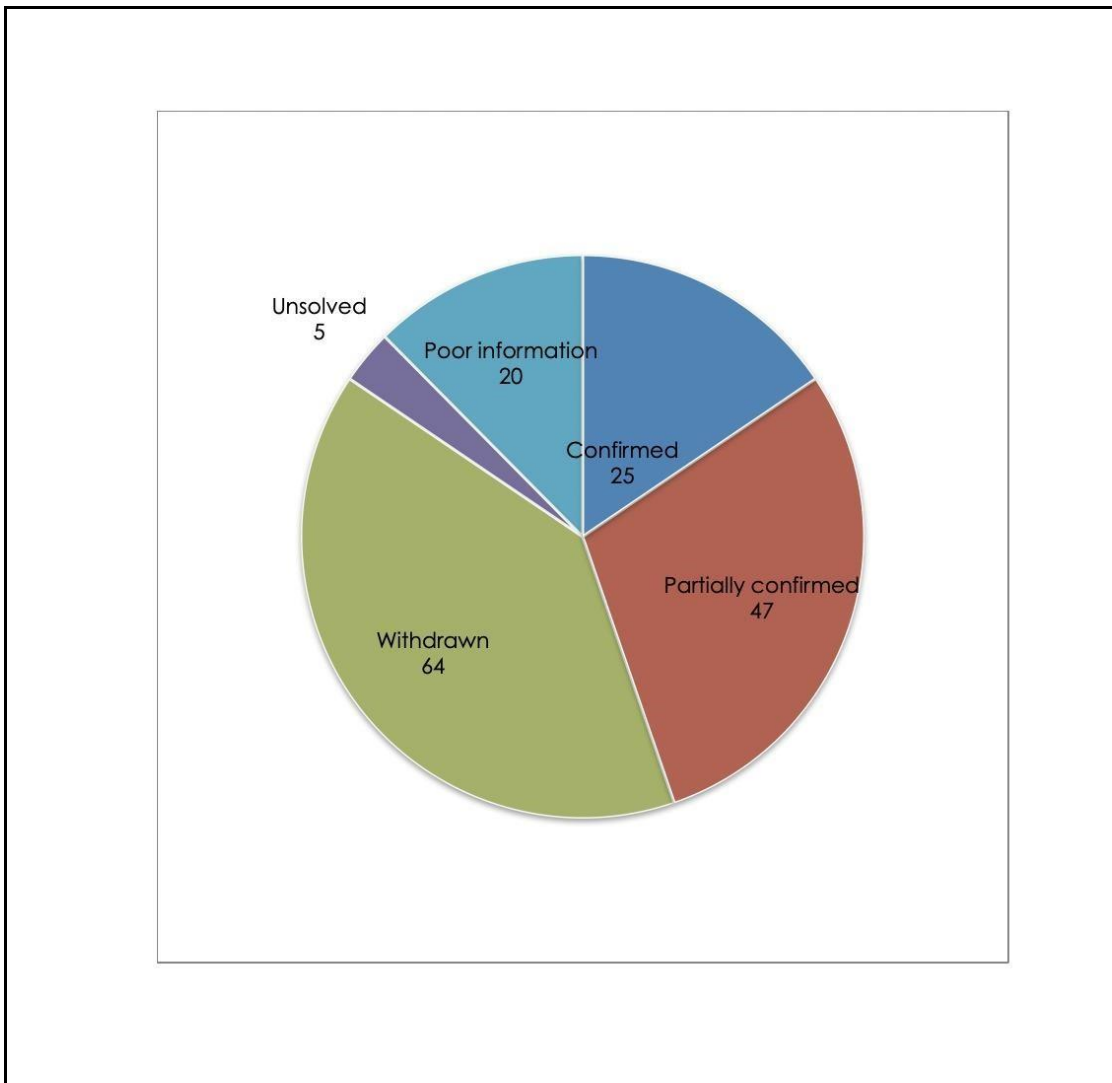
**Figure 5 Summary of the decisions agreed upon in the Border Measure cases presented in Guayaquil from 2008 to 2015**



**Authors:** Own elaboration

**Source:** SENADI data

**Figure 6 Summary of the decisions agreed upon in the Border Measure cases presented in Guayaquil from 2016 to 2019.**



**Authors:** Own elaboration

**Source:** SENADI data

## **Conclusion**

From the above, it is concluded that, during the thirteen years analyzed, a total of 1776 cases have occurred, of which 1018 were confirmed as border averages.

It is also concluded that in 2008 there were 485 cases of border measures, standing out for being the year with the highest number of cases during the period analyzed, when the Intellectual Property Law was still in force; while in 2019 only one case was presented, regulated by the current "Ingenios" Code.

Regarding the decisions agreed for these cases during the period 2008-2015, the results were the following: 344 measures were revoked, 253 partially confirmed and 993 confirmed. It should be noted that from 2016 to 2020, with a total of 172 cases presented, 21 cases provided insufficient information for the respective analysis; however, there were 25 confirmed measures, five unresolved measures, 47 partially confirmed, 10 cases without pronouncement and 64 revoked measures. As mentioned above, Guayaquil is the main port of the country, therefore, the daily flow of goods is higher than the rest of the cities, presenting a higher number of cases of border measures and is where there is more risk for an intellectual right to be violated.

### **3.1.3 Comparison between the cities of Cuenca and Guayaquil and its**

#### **subsequent analysis:**

In the city of Cuenca there was a total of 18 cases of border measures, of which 16 were presented between the years 2007 and 2015, unlike the city of Guayaquil where there was a total of 1766 cases of border measures between the years 2008 and 2020, of which 1594 belong to the years 2008 to 2015. With respect to the origin of the goods; of the 18 cases presented in Cuenca, nine cases came from China, two from Peru, one from Hong Kong and the rest are not specified. In the data provided for the cases of Guayaquil, the country of origin of the goods is not detailed.

In Cuenca, several decisions were presented for the same case, which depended on the adherence or not of the trademark owner, therefore, in only

one case there were confirmed or revoked measures. Unlike the city of Guayaquil, where the decisions agreed for these cases were: 1018 were confirmed, 408 measures were revoked, 300 were partially confirmed, nine were not resolved, 10 were not pronounced and 21 presented insufficient information.

**Table 2 Summary of comparison of the information of the cases presented in the cities of Cuenca and Guayaquil**

	<b>CUENCA</b>	<b>GUAYAQUIL</b>
<b>Total period 2008-2020</b>	18 cases	1766 cases
<b>Period 2008-2020</b>	16 cases	1594 cases
<b>Period 2016-2020</b>	2 cases	172 cases
<b>Decisions on measures</b>	<ul style="list-style-type: none"> <li>• Several decisions for the same case, which depended on the adhesion or not of the owner of the mark, therefore, in only one case there were confirmed or revoked measures.</li> </ul>	<ul style="list-style-type: none"> <li>• 1018 confirmed measures</li> <li>• 408 measures revoked</li> <li>• 300 partially confirmed six unresolved</li> <li>• In 10 there was no pronouncement</li> <li>• Nine without resolution</li> <li>• 21 present insufficient information</li> </ul>
<b>Violated rights</b>	Copyright and Trademarks	Copyright and Trademarks
	<ul style="list-style-type: none"> <li>- China</li> <li>- Perú</li> </ul>	



<b>Country of origin of the goods</b>	- Hong Kong	Not specified
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**Authors:** Own elaboration

**Source:** SENADI data



## **Analysis**

From the table above, it can be deduced that, in the last three years, cases of border measures have been partially scarce compared to previous years. Only two cases were presented in the city of Cuenca and only 172 cases were presented in the city of Guayaquil during 2016 to 2020, which is an alarming and important figure to consider since during the years 2008 to 2015 was the period in which the highest number of cases were presented in these two cities, that is, during the validity of the Intellectual Property Law.

Therefore, it is believed that the significant change may be due to the reforms in intellectual rights and border measures established in the current "Ingenios" Code, since the entity now in charge in this aspect is SENADI exclusively. Previously, SENAIE, mainly ex officio, was the entity that notified the IEPI about possible cases that infringed any intellectual right at the border, and it was the latter entity that, ex officio, after its respective analysis, confirmed or revoked such measure.

It is considered that this function should be worked together as it was established in the previous Intellectual Property Law. As the statistics indicate, it is believed that SENAIE should act directly at the borders and detect imports or exports that violate an intellectual right since it is always executing the due control of the goods in the border areas. The tendency in the cases presented was to partially confirm the measures, from which it can be deduced that there were indeed obvious cases in which intellectual rights were infringed.

It is important to highlight that Guayaquil is the city where the highest number of cases of border measures are presented since, as mentioned above, it is where the main port of the country is located and therefore international trade is much higher, and there is a greater risk that an intellectual right will be affected.

### **3.2 Analysis of legislation in three Latin American countries. Study of two cases of border measures in the Republic of Peru and the Republic of Colombia.**

Next, a general analysis will be made of the legislation of Peru, Argentina and Colombia (countries that have been chosen for their geographical proximity and, why not, social and cultural proximity) in order to find out how border measures are regulated in these countries for the proper protection of intellectual rights. It will also be complemented by two case studies concerning the Republic of Peru and the Republic of Colombia, in order to highlight the most important data that will allow a subsequent comparison with Ecuadorian legislation and thus reach the appropriate conclusions.

#### **3.2.1 Republic of Peru**

The Republic of Peru, which is also a member of the Andean Community of Nations (CAN), recognizes that it must not only adhere to supranational standards, whether these are decisions of the CAN or the TRIPS agreements, but that it is also important to strengthen its domestic laws.

Before the implementation of border measures, precautionary measures were used as a means of suspending imports with infringing goods. These precautionary measures were regulated in a chapter of the TRIPS Agreement that also established that such measures must be issued by a judicial authority. (Alburquerque, 2018)

Today, Peru is using border measures by applying the 2008 Trade Promotion Agreement between Peru and the United States, through Legislative Decree No. 1092 and its respective Supreme Decree No. 003-2009, which entered into force on February 1, 2009. The Decree states that the application of border measures is done on the import, export or transit regimes.

These decrees together with their regulations approve and regulate the procedure of Border Measures for the protection of trademark, copyright and

related rights. This decree seeks to implement the provisions of the TRIPS Agreement and at the same time to strengthen the Customs Administration with effective means capable of establishing controls and complying with the commitments undertaken as members of the WTO.

In order to verify the ownership of relevant products and suspend them at the border, trademark holders or legal representatives may voluntarily register in the Voluntary Registry of Rights Holders of the National Superintendence of Tax Administration SUNAT. (Mago, 2018)

The owner of the right or the legal representative must provide all the information related to the trademark, copyright or related rights, as well as update the information submitted.

The National Institute for the Defense of Competition and the Protection of Intellectual Property (INDECOPI) also works together with SUNAT, and its functions are those of a national intellectual property office that also controls and sanctions matters derived from unfair competition and antitrust practices in Peru, and it is precisely this office that is in charge of approving the registrations submitted by the owners or representatives of an intellectual property right. (Mago, 2018)

The Regulation establishes that "INDECOPI shall provide the Customs Administration with access to the records relating to trademarks, copyrights and related rights that they have implemented". (Alburqueque, 2018)

#### **Procedure for the application of border measures in Peru:**

The procedure can be initiated either by a citizen, by a legal person or by the customs administration. The customs authorities, if they have reasonable grounds to suspect the existence of counterfeit or pirated goods, have the power to carry out ex officio inspections of all goods entering the country without being liable for damage to such goods (Mago, 2018).

In the event that a right holder requests a border measure, he will be required by the authority to post a security to cover possible damage or loss to the foreign trade operator. The value of the bond corresponds to a percentage of 20% of the FOB value of the merchandise retained, in the case of perishable products, the bond will be equivalent to 100% and goods whose FOB value is below \$200 will not require a bond (Mago, 2018).

Border measures in Peru may be granted to block trade in the products either by immobilization, seizure or detention of the goods.

In the event that the accused is caught in the act of suborning or there are sufficient elements of conviction, the Public Ministry initiates a legal process to apply the principle of opportunity, which seeks to reach an agreement between the parties to compensate the damages that have been generated; however, this principle is essentially applied when the damage caused does not have a significant impact on society and the penalty to be imposed is minimal (Mago, 2018).

Legislative Decree No. 1092 also indicates that, in the event of a court order, the competent authority must destroy the pirated or counterfeit goods unless the holder of the right consents to their being disposed of in another manner. In specific cases the goods may be donated for charitable purposes provided that the infringing characteristics of the goods are removed and the goods are no longer identifiable with the removed trademark. In addition, the fact that the illegally affixed mark is removed does not mean that the goods may enter commercial channels (Legislative decree approving border measures for the protection of copyright, related and trademark rights, 2008).

#### **Ex officio application of border measures:**

- 1. Suspension of the release of goods:** The Customs Administration has the power to suspend the release of goods where it is suspected that the goods might infringe copyright, related rights or trademark rights.

- 2. Notification:** SUNAT must notify within three days the holder of the right or his legal representative to prove that he has initiated the infringement action.
  
- 3. Period of suspension:** The suspension of the release is made for a period of ten days, if during that period INDECOPI does not issue a precautionary measure, the release of the goods is automatically authorized after compliance with the requirements of law.  
(Alburqueque, 2018).

Up to this point, the summary of the Peruvian law regarding the application of border measures can be appreciated, the conclusions that can be reached are essentially the following: The Peruvian legislation provides that border measures protect copyrights, trademark rights and also extends to related rights, and the procedure is similar to that provided by the Intellectual Property Law in Ecuador.

On the other hand, Peruvian legislation provides for complementary work between institutions such as the Customs Administration (SUNAT), which acts as the main watchdog on imports of counterfeit or pirated goods; and is responsible for the registration of all right holders in order to create a database that allows easy access to determine which rights and which holders are being affected; and INDECOPI, which is the intellectual property office responsible for the control and sanctioning of acts of unfair competition, and for consumer rights. Oppositely, the Public Ministry is the one that carries out the investigation within the criminal process and finally the National Police of Peru also acts together with the Specialized Customs Crime Prosecutors' Offices, which are the organs that carry out seizures of infringing goods in the secondary zone, that is, within the commercial spectrum.

Additionally, the fact that Peru has a database composed on a voluntary basis by the holders of trademark, copyright or related rights, helps to make the application of measures at the border more effective, since both the

Customs Administration knows who is being injured by the rights and on the other hand the holders are informed in case there are facts harmful to them.

However, despite the fact that Peru apparently has effective means and a process involving several authorities, one of the most widely perceived criticisms is the issue of bail. It is mentioned that many of the importers, due to economic factors, do not request a border measure because of the payment of a guarantee that in many cases is 100% of the FOB value of the imported merchandise. For this reason, the right holders expect the merchandise to enter the commercialization zone so that the Police together with the Prosecutor's Office can seize the merchandise as a consequence of a subsequent control.

Even in Peru, a paradox can be seen in the fact that, on the one hand, the administrative authorities such as SUNAT and INDECOPI, in the face of a lack of presentation of a measure at the border, allow the entry of infringing merchandise by virtue of the principle of trade facilitation and on the other hand, the National Police together with the Prosecutor's Office seize the same merchandise in the secondary zone, that is to say, there is still a lack of coordination of interests. Therefore, even if the pirated or counterfeit goods have paid taxes and have been subjected to customs control, this does not mean that they are legal goods. (Alburqueque, 2018)

### **Case of Border Measures in Peru:**

On October 12, 2011 the goods (pots with the brand super king) of the Company Lima Plus Import & Export were retained by Customs and immobilized to primary zone since it was evident that it would be merchandise that violates the rights of industrial property. On October 19, SUNAT informed the owner of the right, in this case Nevans Corporation, about the immobilization made in order to file a complaint with INDECOPI.

The case details that the term has elapsed and INDECOPI did not pronounce itself to establish any type of precautionary measure, therefore, SUNAT issued



a resolution in which it left the measure at the border without effect and consequently authorized the release of the merchandise for its entry and circulation in Peruvian territory.

The company Nevans Corporation, holder of the right, upon learning that a border measure could not be applied, decided to make a verbal complaint, for the alleged commission of an offence against industrial property rights, before the Fiscal Police.

Thus, on November 16, 2011, the Division of Crimes against Intellectual Rights of the Tax Police intervened a truck carrying a container, whose goods consisted of super king pots, owned by the company Lima Plus Import & Export EIRL, the goods were intervened in secondary area and the seizure of approximately 1300 pots that had the registration super king.

However, the Public Ministry in reviewing the Customs Declaration of Import DAM realized that this DAM had already been subject to application of measures at the border so as not to violate the right of Nom Bis In Idem that applies to the case in question, could not apply another measure and the process was closed on January 18, 2012.

#### **Analysis of the case:**

In the case presented, it can be evidenced that the right holder did not obtain a positive or favorable response through the administrative channel and therefore intended to resort to the criminal channel in order to have the merchandise immobilized; however, he did not obtain a favorable response either.

It can also be verified that between SUNAT and INDECOPI there is no harmonic procedure that allows border measures to be an effective instrument or mechanism, since, on the one hand, SUNAT immobilized the merchandise, but INDECOPI did not pronounce itself and no precautionary measure can be applied.

In this sense, it is necessary to impose changes that allow a joint action between the institutions that participate in the whole process of entry and control of goods in order to achieve greater prevention against possible infringements of intellectual property rights. (Alburqueque, 2018)

### **3.2.2 Republic of Argentina**

The Argentine Republic, like other countries in the region, adopted the TRIPS Agreement and thereby committed itself to establishing national legislation that regulates border traffic and in turn guarantees respect for intellectual rights. To this end, the National Institute of Industrial Property (INPI) is the state agency responsible for everything related to the registration and protection of industrial property, geographical indications and appellations of origin are under the responsibility of the Ministry of Agribusiness, while everything related to copyright and related rights is regulated by the Ministry of Justice and Human Rights (National Institute of Industrial Property, 2019).

The national law states that the federal judge will be the only competent authority to sanction the crimes of counterfeiting or piracy in the field of intellectual property, since a prior order from the judge will always be required to take the respective measures at the border.

At the national level, 20 laws regulating intellectual property have been created, including The Legal Regime for Intellectual Property (Law 11,723), Law on Patents and Utility Models (Law 24,481), Law on Collective Marks (Law 26,355), Law on Industrial Models and Designs (Law 27,444), Border Measures (Law 25,986), Law on Transfer of Technology (Law 22,426) and the Law on Trademarks and Commercial Descriptions (Law 22,362). (World Intellectual Property Organization, 2019).

For a better understanding, emphasis will be placed on three fundamental laws in this area: The Legal Regime of Intellectual Property (Law 11.723), Border

Measures (Law 25.986-Customs Code); and the Law on Trademarks and Commercial Designations" (Law 22.362).

### **3.2.2.1 The Legal Regime of Intellectual Property (Law 11.723)**

The Law on Intellectual Property came into force on September 26, 1933, with the purpose of regulating the Rights of Authors and Related Rights specifically, which is regulated by Decree 41233/34. This law was ratified by Law 25.036, which modified articles 1, 4, 9 and 57 and incorporated article 55 to Law 11.723 (Legal Regime of Intellectual Property-Law 11,723, 1933)

The first of the rules concerning copyright and related rights, protects in its first article to: "Scientific, literary and artistic works of all kinds and sizes, including source and object computer programs; compilations of data or other materials; dramatic works, musical compositions, drama and music; cinematographic, choreographic and pantomime works; works of drawing, painting, sculpture, architecture; models and works of art or science applied to trade or industry; printed matter, plans and maps; plastics, photographs, engravings and phonograms; and all scientific, literary, artistic and educational works, whatever their method of reproduction". (Legal Regime of Intellectual Property-Law 11,723, 1933).

The penalty for the infringement of the rights deriving from the abovementioned works is duly established in Article 71 of this Law, which states literally that

"Any person who in any way and in any form defrauds the intellectual property rights recognized by this Law shall be punished by the penalty laid down in Article 172 of the Criminal Code. (Legal Regime of Intellectual Property-Law 11,723, 1933)

It is important to cite article 172 of the Criminal Code:

"Anyone who defrauds another person with an assumed name, simulated quality, false titles, lying influence, abuse of trust or pretending assets, credit, commission, company or negotiation or using any other trick or deception shall be punished with a prison term of one month to six years. (Penal Code of the Argentine Nation, 1984).

In the same sense, Article 72 bis of this law refers to related rights and also establishes a penalty of one month to six years in prison for the cases listed as special cases of fraud, which are:

- (a) anyone who publishes, sells or reproduces by any means or instrument an unpublished or published work without the authorization of the author or his successors in title
- (b) anyone who falsifies intellectual works, the term being taken to mean the publication of a work already published, falsely displaying the name of the publisher authorized for the purpose
- (c) anyone who publishes, sells or reproduces a work by deleting or changing the name of the author or the title thereof or by fraudulently altering the text
- (d) anyone who publishes or reproduces more than the number of duly authorized copies. (Legal Regime of Intellectual Property-Law 11,723, 1933)

The preventive measures provided for by the law should also be mentioned:

Judges may, subject to the provision of security, order the suspension of a theatrical, cinematographic, philharmonic or other similar performance, the seizure of the works complained of, and the seizure of the proceeds from all the above and any measure that serves to protect effectively the rights protected by this Law. No formality shall be required to clarify the rights of the author or his successors in title. In the event of a challenge, the rights shall be subject to the means of

proof established by the laws in force" (Legal Regime of Intellectual Property-Law 11,723, 1933).

In general terms, this law clearly establishes in its 89 articles everything related to: foreign works, collaboration, special provisions, publishing, representation, sale, performers, the registry of works, the registry of intellectual property, promotion of arts and letters, penalties, preventive measures, civil procedure, complaints, national registry of intellectual property and transitional provisions. This broadens and facilitates the understanding of the procedures that support copyright and related rights in Argentina.

### **3.2.2.2 Border measures - Law 25,986 (Customs Code) - Piracy and counterfeiting.**

The Argentine Customs Code was enacted on December 29, 2004 with a total of 48 articles.

With regard to border measures, its third title, specifically article 46, provides as follows:

"The import or export of goods under any customs suspensive or definitive destination shall be prohibited when the mere verification of such destination shows that the goods are counterfeit, pirated or infringe other intellectual or industrial property rights granted to the owner by national legislation". (Customs Code, 2004)

In the event that there is only a suspicion of goods infringing a copyright or trademark, the customs service may suspend the drawing-up for a maximum period of seven working days, in order to consult the owner of the right so that he may have the opportunity to apply to the competent judge for the appropriate precautionary measures. If the owner of the rights fails to make a declaration, the customs authorities shall notify the authority responsible for consumer rights of the fact.

Based on the above, since 2007 Argentina has had a Warning Entry System (S.A.A.) created in order to control trademark fraud, since those who register

their trademark will automatically receive information on the trade of products so that the holder can take the respective measures to prevent the entry of infringing goods. Owners of trademarks or copyright and related rights may register voluntarily and free of charge under this system (Orieta, 2018).

In turn, the Division of Trademark Fraud of the National Customs Administration receives information in order to facilitate the identification of infringing goods related to trademark rights and thus improve the application of corresponding border measures.

In summary, this standard exceeds what is established in the TRIPS Agreement since it not only provides for the implementation of border measures in a mandatory manner, but also provides for the import or export of goods that infringe upon the intellectual rights holder.

It is known that, in the matter of border measures, Argentina still does not have a specific or complete definition, which is due to the lack of regulation.

### **3.2.2.3 Law on Trademarks and Commercial Designations (Law 22,362)**

Law 22,362 on Trademarks and Commercial Designations was created on December 26, 1980, which regulates in its Chapter 3, Article 31, the following illegal trademarks.

It shall be punished with imprisonment from three months to two years and a fine of four thousand pesos (\$ 4,000) to one hundred thousand pesos (\$ 100,000) may also be applied:

- (a) "Falsification or fraudulent issue of a registered trademark or commercial designation.
- (b) Use of falsified, fraudulently issued or belonging to a third party trademark or designation without its authorization.
- (c) Putting up for sale or selling a counterfeit, fraudulently imitated or belonging to a third party trademark or designation without its authorization.
- (d) Putting up for sale, selling or any form of marketing of goods or services

with a falsified or fraudulently imitated trademark". (Trademarks and Commercial Designations Law- Law No. 22,362, 1980.

Article 38 of Law 22362 also indicates that the owner of a registered trademark who is aware of the existence of objects with an infringing trademark may apply for precautionary measures:

- a) the seizure of the objects;
- b) an inventory and description thereof
- c) the seizure of one of the objects of the offence.

Such application must be initiated by the affected owner who is aware of the existence of objects with a trademark in infringement and must request the federal judge to implement the measures mentioned above. (Trademarks and Commercial Designations Law- Law No. 22,362, 1980)

This law has 52 articles in which it deals with different aspects such as: property law of trademarks, registration formalities and procedures, extinction of the right, designations, punishable acts and actions, precautionary measures, the authority of application, and transitional and derogatory provisions. This highlights all that is regulated at the national level on trademark law and commercial designations.

#### **Process for the implementation of a border measure in Argentina:**

The action for the protection of intellectual rights in Argentina will be initiated ex officio, by complaint or lawsuit. When an action, complaint or suit is filed respectively by the owner of the rights concerned, the federal judge shall be the competent authority to order the seizure or embargo of the works complained of or copies that materialize the unlawfulness, as well as the elements of reproduction, on a well-founded basis. The judge shall implement all measures that serve to effectively protect the rights protected by this Law, with reference to the seizure of the merchandise, the destruction of the

unlawful copies and the auctioning of the reproduction equipment as appropriate.

If the owner of the intellectual property right does not initiate any action, complaint or lawsuit within 15 days following the detention of the merchandise, the seizure of the merchandise shall be without effect.

It should be noted that all these laws are subject to the provisions of the Civil and Criminal Codes in respect of matters not regulated and in respect of the civil liability regime arising from the infringement of these rights. In turn, all these border measures must be carried out under the supervision of the national customs authority (Sala Mercado, 2012).

**Note:** To find an Argentinean case on the subject, we resorted to a digital search through official websites, research papers, theses, etc., without being able to get a positive result. Through our thesis director, we were able to contact people related to the subject in Argentina; however, in spite of the efforts made, we did not get any answer, so unfortunately we could not analyze a practical example, but only studied it based on the applicable rules of the Argentinean legislation.

From all the above, we conclude that there are several national legislations focused on guaranteeing an efficient protection to the intellectual rights of a holder, constituting what the Doctrine has called TRIPS PLUS legislations. At the same time, it is also highlighted that border controls and sentences are clearly focused when there are false or pirated goods that attempt against copyrights, related rights and trademarks specifically. It is important to highlight in the Argentine legal system, the existence of the Alert System (S.A.A.) that warns the owner when he is entering allegedly infringing goods through the border, so that he can request that the respective controls be carried out and, if applicable, that the corresponding measures be implemented. All the customs controls are applied with the supervision of the customs authorities, but the competent authority to dictate the precautionary



measures and the decision with respect to the cases, is the Federal Judge, supported by the respective institutions depending on the right infringed.

### **3.2.3 Republic of Colombia**

Due to its limits with Ecuador, Colombia is a legislation of imperious analysis, since this will allow to review what similarities and differences it presents with the Ecuadorian legislation; and thus to propose opportune recommendations.

The Republic of Colombia, like Peru, is a member of the Andean Community of Nations, and it is clear that what is stated in the supranational regulations must be reinforced through internal laws that support and guarantee intellectual rights.

The National Constitution of Colombia in its article 61 speaks about the Industrial Property Delegation: "The State shall protect intellectual property for time and through the formalities established by law". (Political Constitution of Colombia, 2016).

Article 150 of the same Constitution establishes in numeral 24 that the regime of industrial property, patents and trademarks and other intellectual forms are regulated.

With respect to the protection of Intellectual Property, the main and specific instrument is Decree 4540 of 2006 by means of which customs controls are adopted for this purpose and in which chapter II details the procedure to be followed for the application of a control measure.

This decree begins by defining certain terms for a better understanding of the decree. Then, in chapter two, it speaks specifically about the procedure to protect Intellectual Property. It should be noted that the decree does not mention at any time the term "border measure" explicitly; however, when talking about customs controls, it can be inferred that one talks about precautionary measures that are developed within a border measure.

The following is a verbatim extract from chapter two:

## **Procedure**

### **Article 4. Request for suspension of the customs operation.**

The holder of an Intellectual Property Right linked to goods that are the object of **import, export or transit** may request the **Customs Administration** to provisionally suspend the said operation while the competent **judicial authority** resolves the complaint or claim that the holder must present due to the alleged condition of piracy or false trade mark. If this condition is established, the **release** of the goods, **or authorization for their loading**, or Customs transit, as the case may be, shall not proceed. (highlighted out of text).

The suspension of the customs operation may also be **ordered directly by the competent authority**, as a **precautionary measure** and pending the resolution of the substance of the case. (highlighted out of text)

The request for suspension will be heard by the Foreign Trade Service Division, or the unit that acts as such, of the Customs Administration where the Import, Export or Transit is processed.

### **Article 5. Content of the application.**

The application must be submitted in person by the holder of the right; the Federation or Association empowered to represent him/her; the legal representative or proxy, duly constituted. It shall provide the following information.

- Full name, identification and residence address of the holder of the Intellectual Property Right;
- Name or corporate name and address of the person in the country who is authorized or licensed to enjoy the Intellectual Property Right;

- Identification of your Intellectual Property Right and the facts in which it is violated. If possible, the alleged perpetrators will be identified. In the case of trademarks, the registration certificate number shall be indicated;
- Indication of the place where the genuine goods are edited, recorded, printed or, in general, produced; the identity of the manufacturer, its address and other means of communication known to him;
- Detailed description of the genuine goods; Si fuere posible, la descripción de las mercancías supuestamente piratas o de marca falsa, objeto de la solicitud e indicación del lugar de su ubicación;

If I consider it necessary and have not done so previously, the request for authorisation to examine the goods.

ANNEXES. The following documents shall be attached to the application:

1. A copy of the registration, title or document attesting to your ownership of the right, where this is legally necessary for the constitution of the right;
2. The power of attorney or document attesting to the capacity in which it is acted upon, if any;
3. If the proceedings on the infringement of intellectual property rights have already been brought before the competent authority, a copy of the corresponding complaint or claim shall also be annexed
4. Evidence showing the existence of an indication of infringement of the right.

#### **Article 6. Effects of the application.**

The submission of the application has the following consequences:

1. The suspension of the term of storage and consequently of the release, or of the authorization of the shipment, or of the Transit operation, as the case may be;

2. The impossibility of obtaining direct delivery of the goods, in which case the transfer of the goods to a warehouse will be ordered. The same measure shall be adopted in relation to goods in Transit.

**Article 7. Processing of the application.**

The Customs Administration will admit or reject the application by order, within three (3) days of its submission. The order will be issued:

- 1) The suspension of the customs operation;
- 2) The constitution of a guarantee, from a bank or insurance company, within five (5) days following the execution of the order, equivalent to twenty percent (20%) of the FOB value of the merchandise, to guarantee any damages that may be caused to the importer or exporter, without prejudice to the responsibility of another order. There will be no place to constitute the guarantee if the petitioner proves that he has already done so in the suit or complaint he has filed with the competent authority. Any security shall expressly waive the benefit of exemption;
- (3) communication to the warehouse of the suspension of the customs operation; and
- (4) authorization for the applicant to examine the goods within the following five days. This procedure shall be carried out in the presence of the customs authority and the costs shall be borne by the applicant.

The decision on the application shall be notified in person or by mail to the applicant, the importer, exporter or declarant, and only an appeal for reversal shall be available against it.

In the case of highly perishable goods, and without prejudice to the application to the competent authority, there shall be no need to suspend the customs operation if the user so requests and provides a bank or insurance company guarantee equivalent to one hundred percent (100%) of the FOB value of the goods, to guarantee the damages that may be caused by the

alleged violation of intellectual property rights. In this case, a sample of the goods may be taken.

**Article 8: Intervention of the competent authority.**

Within ten (10) days of notification of the order admitting the application, the petitioner must file with the Customs Administration:

- 1) The security referred to in the preceding article; and,
- 2) A copy of the complaint or denunciation with which you have initiated the corresponding process before the competent judicial authority, if you have not already done so.

Failure to deliver these documents within the term provided herein shall be deemed to be withdrawal of the request, in which case the customs operation shall continue normally. Where the decision of the competent authority declares the goods to be pirated or counterfeit, the customs authority shall refuse to release the goods, to authorize their loading or to allow them to transit, and they shall remain at the disposal of the competent authority.

Where it is decided that there is no piracy or counterfeiting, the terms shall be reinstated and the customs operation may continue normally. In this case, the Customs shall order the release of the security to the person concerned, who shall be given the original of the security if the competent authority has not ruled on this aspect. No appeal shall lie against this decision.

While the competent authority is deciding on the merits of the case, the goods shall be detained in the warehouse or free zone at the disposal of the Customs. The costs shall be borne by the Customs user.

Up to this point, chapter two of the Decree is quoted verbatim; however, it is appropriate to point out two articles of the third chapter which detail:

**Article 10. Excluded operations.**

Exclude the following goods from the provisions of this Decree:

1. Those subject to the passenger regime;

2. Goods which do not constitute a commercial consignment

3. Urgent deliveries.

### **Article 11. Directory of holders.**

**The Directorate of National Taxes and Customs** may draw up a directory of owners of the intellectual property rights referred to in this Decree, their representatives or attorneys-in-fact, which may be renewed from time to time, to facilitate rapid communication by the Customs Authority. (highlighted out of text) (Decree Number 4540, 2006).

### **Decree 390 of 2016**

It is also important to point out Decree 390, since it clearly establishes the parameters to be followed in the event of an infringement of the rights of holders.

This decree, created on March 7, 2016, seeks to harmonize Colombian customs regulations with international conventions in order to modernize, simplify and adapt customs regulations to international practices, facilitating trade and thus ensuring compliance with international trade agreements.

The Decree applies throughout the national territory and regulates the legal relations between the customs administration and foreign trade operators. It has 673 articles and covers issues such as the principles in which the actions of the Decree should be developed, such as the principle of efficiency, justice, typicality, etc. It also devotes space to conceptualize key words within trade. It deals with guarantees, transit of goods, transit regimes, etc. And it is title XVIII that develops everything related to the protection of intellectual property. It starts by defining key words, then explains the procedure for the suspension of the customs operation and finally talks about common provisions, among other topics. (Members of the Colombian Cabinet, 2016)

### **Case of Border Measures in Colombia:**

On April 5, 2019, the Customs Department proceeded to the goods review of the cargo KOSU451202-4 consigned to the company to IEXPOR. This cargo

contained 954 packages with goods of various categories, including eyeglasses, their parts and accessories.

It was evident that the number of packages was covered by the transport documents; however, upon analysis, goods not described in the documents were found. With reference to the spectacles, an alleged falsehood was observed, for which reason the precautionary measure of immobilization was taken.

Immediately we proceeded to act in accordance with the provisions of Article 626 of Decree 390 of 2016 which states that when the official in control finds goods with signs of falsification or piracy, he will communicate with the interested party to inform him that he must present himself to the Customs Directorate to examine the goods and confirm the existence of fraud, and he may then present the request for suspension within the following two working days, otherwise the customs operation will continue.

In fact, this process was carried out and the official contacted the company, representative in Colombia of the RAY BAN brand. Thus, on April 11, 2019, the expert assigned by the owner of the mentioned trademark verified the goods and found: 203 boxes containing REY BIC brand glasses in good condition, so the expert concluded that such elements present similar characteristics to those manufactured by the company LUXOTTICA GROUP SPA. owners in Colombia of the RAY-BAN trademark, so the marketing of these products would generate a risk of confusion and/or association with the trademark.

Due to the above, it was considered that the industrial property rights of the RAY-BAN trademark were violated in accordance with Article 306 of the Criminal Code and Articles 155 and 238 of the Andean legislation.

Concluding, on April 12 of the same year, the attorney-in-fact of the company LUXOTTICA GROUP SPA. requested the suspension of the customs operation of the merchandise imported by IEXPOR S.A. for the alleged crime of usurpation

of industrial property rights and plant breeders' rights. (Directorate of National Taxes and Customs - DIAN, 2019).

### **Analysis of the case**

The above case is a clear example of how the procedure is carried out when the rights of the trademark holders are presumed to have been violated, with the help of the documentation required for customs clearance. The important synchronization and coordination between institutions and right holders, acting in accordance with the provisions of Article 626 of Decree 390 mentioned above, should be highlighted, since it is the customs office who directly communicates to the interested party and it is the latter who decides whether or not to act against a possible fraud.

Also, it is established that, if there are sanctions for those who violate the industrial rights, either with the suspension of customs operations or with the retention of the merchandise, as the case may be.

After detailing all the process and other points of Decree 4540 by which customs controls are carried out to protect Intellectual Property, it is necessary to make certain clarifications:

First, as already mentioned, there is no explicit reference to the application of a border measure, but from the nature of the measure and from what has been reviewed in the laws of other countries, it can be inferred that this customs control does indeed refer to a border measure.

Second, the application of these controls has a scope in relation to false or pirated goods. The first chapter defines what the holder of a copyright or related right is and also what is understood by the holder of a trademark right, so it could be assumed that the scope actually covers copyright, related rights and trademark rights. Furthermore, this customs control will be applied to imports, exports, as well as goods in transit.



Thirdly, within this type of customs control, two main entities participate: The Customs Administration which can act *ex officio* or at the request of a party, and the Judiciary specialized in Intellectual Property matters which is the competent authority capable of resolving the substance of the case.

Fourthly, the consequences of actually applying a control may be the refusal of the release, the authorization of the shipment or the transit of the goods; however, there is no mention of fines, sanctions or destruction of the goods.

Fifthly, among the exceptions when applying this type of control are urgent deliveries; however, it is not defined what is understood as such, so it is a little subjective and could be a gap that prevents the detection of the entry of false or pirated goods.

Finally, in the Colombian legislation there is also an open letter to the elaboration of a data base where the holders of intellectual rights or their attorneys-in-fact are registered, which seems to us to be correct.

#### **3.2.4 Comparison between international legislation and Ecuadorian legislation**

The following conclusions can be drawn from the analysis of international legislation on border measures in Peru, Argentina and Colombia, and from what is set out in chapter 2 of this thesis on the same subject in Ecuador:

First, the four legislations provide that the border measures protect both copyrights, trademark rights, as well as related rights. Each country has internal laws and several institutions to regulate and sanction respectively everything related to this matter.

In turn, they also establish that border measures are clearly granted to block trade in infringing products, either by immobilization, seizure or detention of the goods. The procedure of a border measure can be initiated by a citizen, a legal person or a competent authority.

Additionally, Peru, Argentina and Colombia have a database of intellectual property rights holders, which facilitates and improves the application of border measures, because the holder has direct knowledge when his rights are being infringed. Contrary to what has been stated, Ecuador does not have a database of right holders, however, it applies the "risk profile" analysis that would help to identify allegedly infringing goods so that they do not enter national territory.

It is important to emphasize that it was not possible to analyze a case from Argentina, due to the previously mentioned reasons; however, it was possible to analyze a Peruvian and a Colombian case and, through this, also obtain valuable conclusions.

**Table 3 Summary of similarities and differences between the legislations of Peru, Argentina, Colombia and Ecuador regarding intellectual rights and border measures**

<b>SIMILARITIES</b>				
Border measures are granted to block trade in the products either by immobilization, seizure or detention of the goods.				
All countries have internal laws and a competent body to regulate this matter, strengthening what is already established in supranational laws.				
The procedure for initiating a border measure can be initiated by a citizen, a legal person or a competent authority.				
In all countries when an infringement is suspected, inspections are or can be carried out.				
The owner of the right or the legal representative must provide all the information related to the trademark, copyright or related rights when their rights have been violated.				
<b>Aspects to be compared</b>	<b>DIFFERENCES</b>			
	<b>PERÚ</b>	<b>ARGENTINA</b>	<b>COLOMBIA</b>	<b>ECUADOR</b>

<p><b>SELF- GOVERNMENT OR AUTHORITIES IN CHAR</b></p>	<p>SUNAT E INDECOPI.</p>	<p>Customs Service; Federal Judge, competent entity in matters of consumer rights.</p>	<p>Customs and judicial authorities</p>	<p>SENADI; since SENAE has a non-leading participation.</p>
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<p><b>MECHANISMS</b></p>	<p>SUNAT has a Voluntary Registry of Rights Holders that facilitates the verification of product ownership and the suspension of products at the border.</p>	<p>It has a System of Alert Seats (S.A.A.) created to be able to warn the trademark holder about the import of products so that the respective measures can be taken to prevent the entry of infringing goods.</p>	<p>The National Tax and Customs Administration has a directory of intellectual property right holders to facilitate communication.</p>	<p>The holder of the right or SENADI must verify on its own account if products are entering at the border that infringe the rights of the holders.</p>

<b>PENALTY</b>	Destroy pirated or counterfeit goods. In certain cases, the goods can be donated.	Destruction, confiscation, auction or sale of the goods and other infringing elements.	The customs authority shall refuse the release, loading or transit of the goods and they shall remain at the disposal of the competent authority.	Kidnapping of the goods detected as infringing.
<b>NORMATIVE INSTRUMENT</b>	Legislative Decree No. 1092	"Law 11.723, Law 25.986 and Law 22.362"	Decree No. 4540 and Decree 390	"Ingenios" Code

**Author:** Own elaboration

**Source:** Legislative Decree No. 1092, Law 11,723, Law 25,986, Law 22,362, Decree No. 4540 and the "Ingenios" Code

## Conclusion

This chapter focused on analyzing case studies regarding border measures over the last thirteen years in the cities of Cuenca and Guayaquil specifically, since, due to lack of information, it was not possible to obtain data from the city of Quito. The aim was to present each case in detail in order to have a better understanding and perspective.

The purpose of the case study was to demonstrate that during the coming into force of the "Ingenios" Code in 2016, the number of cases regarding the protection of intellectual rights in these two cities has decreased drastically in relation to previous years.

One of the most important passages in this chapter was the analysis of international legislation and from what has been exposed above it can be concluded mainly that Ecuador, like the rest of the countries in the region, in application of what is established in supranational and international laws in this matter, has generated internal laws adapted to its different realities, which seek as much as possible, to protect the holders of intellectual rights in their countries.

However, as shown in the table above, it is appropriate that, in Ecuador, the regulations provide for a procedure that combines the parallel work between SENADI and SENAIE, and through this union strengthen the eradication of the violation of intellectual rights, implementing different instruments such as the creation of a database as Peru has, Argentina and Colombia, to increase security and in turn improve communication with intellectual rights holders because they would be informed when any of their rights are violated and at the same time it would be easier for the competent institutions to identify the merchandise, the right and its respective holder.

In order to achieve the above, it is necessary that the Ecuadorian law is modified and expanded in relation to this issue. In addition, it is of great

importance the creation of the respective regulation to the "Ingenios" Code that sustains and specifies what is already established in this law in favor of generating a better protection to the intellectual rights based on a correct application of measures at the border.

#### **CHAPTER 4: DISCUSSION AND ANALYSIS OF RESULTS**

## **4.1 Conclusions and Recommendations**

### **4.1.1 Conclusions**

When concluding with the exhaustive analysis of the issue of border measures in Ecuador, it can be stated that in reality there is not enough regulation of the issue that is capable of protecting intellectual rights, be they copyright or trademark rights. The Ecuadorian legislation presents repeated shortcomings on the subject, which are detailed below:

Firstly, we can talk about the legal provision that includes the issue of border measures. The Organic Code of the Social Economy, Knowledge and Innovation or "Ingenios" Code is a weak body of legislation, which includes the subject in an inadequate manner. Within this body there is a tendency to mix the substantive provisions of a code with adjective provisions that should be included in a specific regulation, which does not exist to date.

This lack of a strong body of law means that there is no legal certainty and that, as a result, the holders of intellectual rights suffer the consequences of their infringement.

Secondly, the issue of competences. In Ecuador, with the promulgation of the "Ingenios" Code, the National Service of Intellectual Rights took on the main role, leaving the Customs Service as a secondary actor with less participation.

This change of competence significantly affects the adoption of a measure at the border, since it must be taken when, ex officio or at the request of a party, it becomes known that in some customs operation, copyright or trademark rights may be infringed. However, the question is how can SENADI act ex officio if its center of operations is not at the border in the first place and therefore it does not have direct knowledge of the customs operations? Furthermore, how can a right holder file an application for border measures if



he also has no knowledge of or access to daily information on all customs operations generated by the country?

Therefore, logically, the first entity that should work on the application of a border measure is the SENA, since its functions include carrying out customs and non-customs control, monitoring what merchandise enters and leaves the country, collecting taxes, and stopping piracy and illegal trafficking, among others.

However, the importance that SENADI has in these cases cannot be ignored, since this entity has a deep knowledge of the issue of intellectual rights and therefore has more and better mechanisms to identify when there is a violation of trademark rights and copyright; of course with the support of the owner of the rights who really knows their products or with the intervention of qualified experts who have experience in the field.

What should be tried is to achieve joint work between the competent government institutions; however, this type of achievement must be based on strong and sustainable laws, sadly, so far Ecuadorian legislation has had wide gaps that have often brought conflict in cases where the analysis is more profound.

In spite of having taken the Customs and the Intellectual Rights Service as the fundamental axes of the issue, the actions of other institutions that are also important, such as the Prosecutor's Office and the Judicial Police, cannot be overlooked. These actors also become important when the merchandise is already circulating in Ecuadorian territory; however, they also do not have their tasks defined and undoubtedly not all are capable of recognizing at first sight infringing merchandise that may not be of notoriety or high renown.

Another important point within the conclusions is the issue of the beginning of the applications at the request of the parties, with the validity of the Law on Intellectual Property this lack was reflected in the little importance given to the

intellectual rights, since the owners of these rights did not demand the referred protection. With the entry into force of the "*Ingenios*" Code, this situation changed and the owners of rights have to make their best efforts to find out when allegedly infringing goods have arrived in the primary zone and at that time submit the corresponding request to SENADI, without prejudice to the possibility of requesting an inspection of the goods by SENAE, as explained at the time.

As was seen in the comparisons of international laws, there are quite useful mechanisms for both civilians and government entities to work together in mutual support. One of these mechanisms was a kind of registry and/or system that contains important data from the owners and that is capable of: on the one hand, helping SENAE and SENADI to easily and quickly identify the owner whose rights are being violated and on the other hand, so that the owners are informed and updated when there is a suspicion of violation, then it would be more feasible to talk about requests at the request of a party.

As another important point to take into account is the issue of customs regimes, clearly the "*Ingenios*" Code does not make any reference to whether the border measures must be presented only and exclusively in a definitive import or export or if they can also be taken in any type of customs regime, this undoubtedly causes a terrible legal vacuum, so we must remember that Ecuador did not sign the Andean Decision that extends the possibility that the border measure can be taken in case of goods in transit.

Continuous training must also be a daily task, as we have noticed, the most seized goods correspond to well-known or highly reputed trademarks, but what about those trademarks whose name is not yet in the public domain? Unfortunately, these are trademarks that may not have the same degree of protection as those that at first sight are recognized, which is why the issue is highly complex, because in the globalized world in which we live, it is imperative that both the authorities and the right holders themselves are

concerned about training the administrators of Customs and society in general, so that their rights are respected and valued.

#### **4.1.2 Recommendations**

After the work has been done and once we have reached the preliminary and final conclusions, it is necessary to make the following recommendations, in order to give guidelines to be able to improve this issue in the country.

1. Work on a reform of the normative instrument in force, the "Ingenios" Code, specifically with regard to aspects such as: what border measures consist of, when they are applied and which entity or entities are competent to order them and ratify or revoke them. As stated at the time, the provision that creates doubt about whether border measures also apply to industrial designs should be reformed or repealed, and a provision about the customs procedures under which border measures may be applied should be included.
2. The regulations on the protection of intellectual rights and, specifically, on border measures should be promulgated, which should include all the adjective provisions and develop a clear procedure guaranteeing the effectiveness of the border measures, since, as it is currently drafted, the procedure in the "Ingenios" Code is incomprehensible and, therefore, inapplicable, which generates legal uncertainty. It is therefore required to issue a document in which it is clearly established that the border measures have a sui generis nature, which must begin and end within the Customs Authority, since it is the competent authority to carry out the no customs control, but whose main procedure must be developed, as it cannot be otherwise, in our legal system, within the competent authority in matters of intellectual rights, as it was previously, although in a perfectible way, in the Articles 342 and 343 of the Law of Intellectual Property.

- 3.** Cooperation between the two main institutions must be encouraged: SENAE and SENADI, which will allow both entities to efficiently fulfill their own tasks and thus achieve a better application of a border measure.
- 4.** The legal instruments should provide for the creation of a confidential database with the most important information on each right holder, which in turn should contain an alert system to enable right holders to be informed of a possible infringement. This warning system could be operated through the Ecuapass or a similar system; and shared with the different institutions of other countries and thus further strengthen the desired protection.
- 5.** Finally, the interest of the community in the protection of intellectual rights should be encouraged through training on the subject, but most importantly through the transmission of statistical information that demonstrates that intellectual rights are indeed being protected, since efficient laws are of no use if we do not have authorities that apply them and guarantee in practice the effective protection of the population's intellectual rights.

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## Annexes

### Annex A. Summary table of application of reasonable doubt

No.	Actividad	Producto de Entrada	Descripción de Actividad	Responsable	Producto de Salida
1.	Revisa el FOB unitario declarado	Alerta de valor del perfilador de riesgos	Revisa el FOB unitario de cada ítem declarado frente a lo registrado en la base de valor de aduana u otras fuentes especializadas. Si los valores declarados son menores a los de la base de valor procede de acuerdo a la actividad 2, caso contrario finaliza el procedimiento. Tomar en cuenta consideración 5.2	Técnico operador	FOB unitario de mercancías revisado
2.	Notifica el inicio de "Duda razonable"	FOB unitario de mercancías revisado	Notifica al OCE el inicio de la duda razonable a través del Ecuapass y solicita documentos de soporte correspondientes. La notificación puede ser consultada de acuerdo a la consideración general 5.15.	Técnico operador	Envío de la notificación de duda razonable a través del Ecuapass
3.	Presenta documentos de soporte	Envío de la notificación de duda razonable a través del Ecuapass	Envía la documentación de soporte de valoración de la mercancía, a través de la siguiente ruta: <u>Portal externo</u> >Elaboración de e-doc operativo>Documentos	OCE	Documentos de soporte enviados por el OCE

No.	Actividad	Producto de Entrada	Descripción de Actividad	Responsable	Producto de Salida
			electrónicos>Despacho aduanero> <u>Sustitutivo del detalle del documento de importación</u> . Si el envío de los documentos lo realiza dentro del plazo procede de acuerdo a la actividad 4 de lo contrario a la 6.		
4.	Revisa soportes presentados	Documentos de soporte enviados por el OCE	Revisa los soportes enviados por parte del OCE según lo indicado en la normativa vigente. Si no justifica la duda razonable procede de acuerdo a la actividad 5 de lo contrario finaliza el procedimiento.	Técnico operador	Documentos de soporte de valor revisados
5.	Notifica la no aceptación de la justificación	Documentos de soporte de valor revisados	Notifica al usuario que no han sido aceptados los soportes de valor presentados, sustentando en dicha observación los motivos por los cuales fueron rechazados. La notificación puede ser consultada de acuerdo a la consideración general 5.15.	Técnico operador	Documentos de soporte de valor rechazados
6.	Realiza correcciones en FOB unitario	Documentos de soporte de valor rechazados	Corrige el FOB unitario de los ítems observados con los valores encontrados en la base de valor o conforme los métodos de valoración utilizados para el efecto.	Técnico operador	Ajuste de valor de mercancías

## Annex B. National cases on border measures

Year 2008

Oficio No.- CAE-GFZ-DI-170  
Guayaquil, 06 de Febrero del 2008

Corporación Aduanera Ecuatoriana  
Av. 25 de Julio Km. 2.5  
Vía Puerto Marítimo  
PBX: 04-2480640  
Guayaquil-Ecuador  
www.aduana.gov.ec



Doctora  
Susana Vásquez  
Subdirector Regional del Instituto Ecuatoriano de Propiedad Intelectual  
IEPI  
Cuenca.-

De mi consideración:

En relación a su Oficio No. 08-002-SRC-IEPI, y cumpliendo con lo solicitado, pongo en su conocimiento, que en el Distrito de Macará al realizar la Inspección Física de las mercancías de los importadores **MORENO ESTRADA GIMENA ANAVEL, VALLADARES VEINTIMILLA VICTOR HUGO, GRANDA AÑZACO FABIAN DE JESUS y LAPO REYES JUNER JOSE**, amparadas en los referidos 109-07-10-001347, 109-07-10-001353, 109-07-10-001343 y 109-07-10-001345 respectivamente, se detectaron **SOMBRILLAS** con diseños similares a los personajes de **BARNEY, WINNIE THE POOH y BARBIE**, así como **CAMIONCITOS DE JUGUETES** que presentan diseños y leyendas similares a los personajes de **TOYS STORY**; y **MOCHILAS PEQUEÑAS** con leyendas de **WINNIE THE POOH Y MICKEY**, los cuales podrían vulnerar Derechos de Propiedad Intelectual. Cúmpleme informar que las muestras fueron enviadas junto al Oficio No. CAE-GFZ-DI-024 de fecha 4 de Enero del 2008.

Con el fin de cumplir con lo estipulado en el Artículo 342 de la Ley de Propiedad Intelectual, indico a continuación un análisis pormenorizado según informe de fiscalización sobre el caso:

- 1- El producto viene embalado por unidad, en cartones en los cuales no se observan referencias o empresas que distribuyen las marcas en discrepancia.
- 2- Todas las mercancías inspeccionadas y separadas, presentan diseños y/o leyendas de los personajes de las marcas en discrepancia, los cuales se pueden observar en las fotos y las muestras físicas, enviadas con anterioridad mediante Oficio No.- CAE-GFZ-DI-023 y Oficio No.- CAE-GFZ-DI-024.
- 3- Según se puede observar, se detectaron sombrillas con leyendas de "Baibie" y diseños similares a Barbie, las cuales podrían causar confusión y riesgo de asociación, ya que suscitan en la mente del consumidor una idéntica impresión visual a los diseños de la reconocida marca registrada por "Mattel".
- 4- Se detectaron otras sombrillas en las que no se encuentra ninguna leyenda pero se observan los personajes de Barney con sus amigos y Winnie the Pooh, causando en el consumidor, el mismo efecto antes mencionado.
- 5- Se puede observar también en los camioncitos de juguetes leyendas y personajes de TOYS STORY, sin que dicho producto posea referencias de la marca o distribuidor, por lo cual se estaría dando uso indebido a los personajes de la mencionada marca, así también se puede observar leyendas de Pooh y Mickey en las mochilas pequeñas.
- 6- Ninguno de los Importadores presentaron documentos por parte de los propietarios o licenciatarios de las marcas que soporten la originalidad de las mercancías en discrepancia.

Recibido

- 7- Existen antecedentes similares para estas marcas, los cuales fueron confirmados por el IEPI con anterioridad, mediante **Oficio No. 2007-402-P-IEPI** (Winnie the Pooh, Barney) y **Oficio No. 32-2007 G-MF-IEPI** (Barbie) (anexo).
- 8- Por lo hasta ahora expresado se presume que los productos con diseños similares a **BARBIE, WINNIE THE POOH, TOYS STORY Y MICKEY**, estarían dando un uso indebido a los diseños de las marcas en controversia, y se estaría transgrediendo derechos de propiedad intelectual.

Mediante **Oficios No.- CAE-GFZ-DI-021, CAE-GFZ-DI-022, CAE-GFZ-DI-018, CAE-GFZ-DI-019**, hemos procedido a notificar a los Importadores que el trámite de importación de los referidos 109-07-10-001347, 109-07-10-001353, 109-07-10-001343 y 109-07-10-001345 del manifiesto No. 109-2007-03-311, han sido retenidos hasta que el Instituto Ecuatoriano de la Propiedad Intelectual conforme lo establece el art. 342 de la Ley de Propiedad Intelectual **Confirme o Revoque** la medida en frontera aplicada por la Corporación Aduanera Ecuatoriana.

Acogiéndonos al Artículo 342 de la Ley de Propiedad Intelectual, solicito a usted con estos antecedentes **confirmar o revocar** las medidas tomadas.


A la espera de contestación.

Atentamente,



**Econ. Xavier Cárdenas M.**  
**Gerente de Fiscalización**  
**CORPORACION ADUANERA ECUATORIANA**

C.C. File

Fecha: 06/02/2008  
Elaborado por: G. M.   
Revisado por: A. R.

The case of the city of Guayaquil in 2010



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No.- CIN-DGR-JPO-OF-2683  
Guayaquil, octubre 11 del 2010

**Dra.**  
**Susana Vásquez Zambrano**  
Subdirectora Regional del Instituto Ecuatoriano de Propiedad Intelectual IEPI  
Av. José Peralta y 12 de abril, Edificio Acrópolis, 5 piso, oficina 508  
Teléfono: 074103708 - 074103627  
Cuenca.-

De mi consideración,

Una vez que la Gerencia Distrital de Cuenca, mediante oficio No. **GDC-OF-(i)-096** (anexo 1), nos informara a la Coordinación General de Intervención, sobre las novedades detectadas en el acto administrativo de Aforo Físico en cuanto a las mercancías no declaradas del consignatario **IMPORTADORA Y DISTRIBUCIONES ALTAPRINCE CIA. LTDA.**, amparadas en la declaración aduanera No. **091-10-10-002292** por presumir que podrían vulnerar Derechos de Propiedad Intelectual, al tratarse de **ZAPATOS** con diseños similares a las marcas **NIKE, PUMA, ADIDAS, CONVERSE, ARMANI** y **VANS** (se adjuntan 12 muestras físicas); y en cumplimiento a lo estipulado en el Artículo 342 de la Ley de Propiedad Intelectual, ponemos a su conocimiento el siguiente informe pormenorizado a fin de que en el término establecido, en el mencionado artículo, el IEPI emita el correspondiente acto administrativo confirmando o revocando la medida tomada por la CAE.

**Informe sobre la presunción de vulneración de los Derechos de Propiedad Intelectual.-**

**Características de la mercancía.**

- 1- Un zapato deportivo en colores negro y blanco, en la que se observa el uso de diseños similares del "swoosh" y la denominación de la marca NIKE en varias partes, el calzado viene empaquetado en caja de cartón que posee impresas entre otras, varias marcas gráficas usadas por la marca NIKE, adicionalmente se encuentra una funda blanca para empaque en la que se observa impresa los logotipos de varias marcas como "Nike, Adidas, Reebok, Puma y Converse".
- 2- Un zapato deportivo en colores negro y verde, en el que se visualiza la utilización de diseños similares del "swoosh" y la denominación de la marca NIKE en varias partes, el calzado viene empaquetado en caja de cartón color naranja e incluye una funda y en un papel de seda para empaque en la que se observa impreso el swoosh y denominación de la marca NIKE.
- 3- Un zapato deportivo en colores negro y fucsia, en el que se evidencia el uso de varios diseños similares a los usados por la marca NIKE, se observa que el "swoosh" situado en los lados del calzado se encuentra entrecortado por la costura de otra parte de la capellada, algo inusual en la confección de prendas de la marca NIKE, este calzado viene empaquetado en una caja de cartón con diseño de paisaje nocturno en colores blanco y negro que no hacen alusión a la marca antes descrita.
- 4- Un zapato deportivo en colores negro, blanco y amarillo, en el cual se observa la utilización de varios diseños similares de las marcas registradas por ADIDAS, lo particular de este caso es que se utiliza en un mismo producto el diseño de 3 rayas y el de trefoil. La plantilla posee pegado un trozo de material de plástico como talón y lleva impreso el diseño de 3 rayas y este presenta fallas en la impresión, empaquetados en una caja de cartón en la que se observa la denominación "ADIDAS" que en su interior tiene una funda blanca para empacar con la denominación "ADIDAS".
- 5- Un zapato deportivo en colores negro y blanco, en el que se visualiza varios de diseños similares a la marca ADIDAS, se observan en este producto fallas en el bordado situado en el talón, un diseño de logotipo ubicado en la plantilla que difiere a los usados por la marca ADIDAS, vienen

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- empaquetados en un caja de cartón en la que se visualiza la denominación "ADIBAS", en cuyo interior posee una funda de empaque transparente.
- 6- Un zapato deportivo en colores blanco y plomo, en los que se visualiza la utilización de varios diseños similares a la marca ADIDAS, en la etiqueta que se encuentra en la lengüeta que no posee ciertas características como código de calzado y detalle de composición de materiales, empaquetado en una caja color negro con rayas blancas y en cuyo interior se observa una funda blanca de empaque y una etiqueta de cartón, todas ellas presentan la denominación ADIDAS.
  - 7- Un zapato deportivo en colores azul y amarillo, en los que se observa el uso de varios diseños similares a la marca PUMA, se observa en la parte del talón y en la lengüeta, bordados del gato salvaje saltando con una mala calidad, una etiqueta de cartón color rojo en la que se observan fallas de impresión en la denominación "OFFICIAL MERCHANDISE", empaquetadas en una caja color negro que lleva impresa la denominación "PUMA CELL".
  - 8- Un zapato deportivo color negro, en lo que se visualiza la utilización de diseños similares a la marca PUMA como el diseño de franja y bordados del gato salvaje saltando con mala calidad, empaquetados en una caja color roja, un cuyo interior posee una funda plástica blanca y una etiqueta con impresos similares al logotipo y la denominación PUMA.
  - 9- Un zapato deportivo en colores negro y verde, en que presenta diseños similares a la marca VANS, en los que se evidencian errores en la alineación del estampado de la etiqueta de las tallas se encuentra pegada en la lengüeta, empaquetado en una caja de cartón con diseño de paisaje nocturno en colores blanco y negro que no hacen alusión a la marca antes descrita, esta caja presenta una similitud con la descrita en el ítem 3 para un calzado similar a la marca NIKE.
  - 10- Un zapato casual color café, en el que se observa el uso de logotipos y denominaciones similares a las usadas por la marca ARMANI, en la lengüeta se observa un estampado con la denominación "GIORGIO ARMANI", en la parte lateral derecha, en la plantilla y en el talón se observa la impresión de un diseño similar a logotipo de la marca ARMANI. El calzado lleva un etiqueta colgante en la que se observa la denominación "FASHION SPORTS", viene empaquetado en una caja color naranja que presenta las siluetas de personas practicando varios deportes y en la que se lee la denominación SHLANG HIAI HUAER, la que posee una funda plástica blanca de empaque con la denominación "SPORTS".
  - 11- Un zapato deportivo en colores blanco y verde, en el cual se observa la utilización de varios diseños similares de la marca ADIDAS, lo particular de este otro caso es que se utiliza también en un mismo producto el diseño de 3 rayas y el de trefoil. La plantilla lleva impreso el diseño de 3 rayas, viene empaquetado en una caja de cartón de color naranja y crema (caja usualmente utilizada para productos de la marca "NIKE") en cuyo interior tiene una funda blanca para empacar con la denominación "ADIDAS".
  - 12- Un zapato deportivo en colores negro y blanco, en el que se visualiza el uso de varios diseños similares a la marca CONVERSE, se observa tanto en la lengüeta, plantilla, y parte posterior del calzado el uso de las denominaciones "ALL STAR" y "CONVERSE", vienen empaquetados en una caja en la que se observa impreso el logo y la denominación de la marca CONVERSE.
  - 13- Se presume que con la importación de estos zapatos, se causaría un riesgo de asociación y/o confusión al consumidor como si fueren de las marcas descritas anteriormente.
  - 14- Los zapatos descritos anteriormente presentan fallas de costura, de bordados y estampados, lo que haría presumir que no se trata de productos originales, vulnerando los derechos de propiedad de Intelectual de las marcas antes mencionadas.
  - 15- La cantidad encontrada se trataría de 375 pares de zapatos con la marca "PUMA", 675 pares de zapatos con la marca "ADIDAS", 520 pares de zapatos con la marca "VANS", 550 pares de zapatos con la marca "NIKE", 100 pares de zapatos con la marca "CONVERSE", 60 pares de zapatos con la marca "ARMANI".
  - 16- La mercancía tiene como procedencia CHINA y el embarcador XIA TAI IMPORTS AND EXPORTS.

**Oficios emitidos**

Mediante **Oficio No.- CIN-DGR-JPO-OF-2684** (anexo 2), se puso en conocimiento del *Importador* que la mercancías en controversia han sido retenidas hasta que el IEPI conforme lo establece el art. 342 de la Ley de Propiedad Intelectual **Confirme o Revoque** la medida en frontera aplicada por la CAE.

Mediante **Oficio No.- CIN-DGR-JPO-OF-2703** (anexo 3), hemos procedido a comunicar al Estudio Jurídico *LCILAW Luzuriaga, Castro & Torres*, apoderado de la marca **NIKE y PUMA y ADIDAS**, sobre la medida tomada por la Corporación Aduanera Ecuatoriana.

Mediante **Oficio No.- CIN-DGR-JPO-OF-2704** (anexo 4), hemos procedido a comunicar al Estudio Jurídico *Brño & Pinto*, apoderado de la marca **CONVERSE**, sobre la medida tomada por la Corporación Aduanera Ecuatoriana.

Mediante **Oficio No.- CIN-DGR-JPO-OF-2705** (anexo 4), hemos procedido a comunicar al Estudio Jurídico *Corral & Rosales*, apoderado de la marca **ARMANI**, sobre la medida tomada por la Corporación Aduanera Ecuatoriana.

*Cabe indicar que por ser el IEPI a quien le corresponde ejercer la tutela administrativa de los derechos sobre la propiedad intelectual y velar por su cumplimiento y observancia, le corresponde notificar los actos administrativos emanados de sus respectivas autoridades.*

*Atentamente,*



**Econ. Carlos Andrés Henríquez Henríquez**  
**Director de Gestión de Riesgos**  
**Coordinación General de Intervención**  
**Corporación Aduanera Ecuatoriana**



Adjunto: 12 muestras físicas al presente informe.

C.c. File

Elaborado por: E. Rodríguez  
Revisado por: K. Santistevan  
Revisado por: I. Oyarzun  
Fecha de elaboración: 11/07/2010  
Hoja de trámite: 10-091-SEGC-05376



INSTITUTO ECUATORIANO DE LA PROPIEDAD INTELECTUAL-IEPI-  
SUBDIRECCIÓN REGIONAL CUENCA



OFICIO No. 032-2010-SRC-IEPI  
Cuenca, 12 de noviembre de 2010

Señor Economista  
Carlos Andrés Henríquez Henríquez  
COORDINACIÓN GENERAL DE INTERVENCIÓN  
CORPORACIÓN ADUANERA ECUATORIANA-CAE-  
Av. 25 de Julio Km. 2.5, vía Puerto Marítimo  
Guayaquil-Ecuador

Señor Director:

En atención a su oficio No. CIN-DGR-JPO-OF-2683 de fecha 11 de octubre de 2010, recibido en este despacho el 5 de noviembre de 2010, manifiesto a Usted lo siguiente:

**ANTECEDENTES.-**

Usted Señor Director en el oficio antes referido indica que: *"Una vez que la Gerencia Distrital de Cuenca, mediante oficio No. GDC-OF-(I)-096 (anexo 1) nos informará a la Coordinación General de Intervención, sobre las novedades detectadas en el acto administrativo de Aforo Físico en cuanto a las mercancías no declaradas del consignatario IMPORTADORA Y DISTRIBUCIONES ALTAPRINCE CIA. LTDA, amparadas en la declaración aduanera No. 091-10-10-002292 por presumir que podrían vulnerar Derechos de Propiedad Intelectual, al tratarse de ZAPATOS con diseños similares a las marcas NIKE, PUMA, ADIDAS, CONVERSE, ARMANI y VANS (se adjuntan 12 muestras físicas); y en cumplimiento a lo estipulado en el Artículo 342 de la Ley de Propiedad Intelectual, ponemos a su conocimiento el siguiente informe pormenorizado a fin de que en el término establecido, en el mencionado artículo, el IEPI emita el correspondiente acto administrativo confirmando o revocando la medida tomada por la CAE ..."*

Las muestras físicas que se adjuntaron al oficio No. CIN-DGR-JPO-OF-2683 de fecha 11 de octubre de 2010, recibido en este despacho el 5 de noviembre de 2010, corresponden a: 1.- Un zapato deportivo en colores negro y blanco, en el que se observa el uso de un diseño similar al swoosh de la marca NIKE en los costados y en la suela, el uso de la denominación NIKE en la parte posterior y en la plantilla del zapato, la muestra se presentó dentro de una caja de color café claro en la que se pueden observar reproducidos logotipos de varias marcas; 2.- Un zapato deportivo en colores negro y verde, en el que se visualiza la utilización de un diseño similar al swoosh de la marca NIKE en los costados y en la suela de la muestra, el uso de la denominación NIKE en la parte posterior y en la plantilla del zapato, la muestra se presentó dentro de una caja de color naranja en la que se observa un diseño similar al swoosh de la marca NIKE en color blanco; 3.- Un zapato deportivo en colores negro, fucsia, verde, lila y blanco, en el que se observa el uso de un diseño similar al swoosh de la marca NIKE en los costados de la muestra, el uso de la denominación NIKE AIR en la lengüeta, en la parte posterior y en la plantilla del zapato, la muestra se presentó dentro de una caja de color negro y gris en la que se pueden observar caracteres en otro idioma y la figura de unas flores; 4.- Un zapato deportivo en colores negro, amarillo, gris y blanco, en el que en se observa el uso de un



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diseño similar a las tres líneas de la marca ADIDAS en los costados de la muestra, el uso de la denominación ADIDAS acompañada de lo que parece ser el signo conocido como trefoil en color amarillo sobre un fondo gris en la parte posterior del zapato, en la lengüeta se observa al denominación ADIDAS escritas en letras negras sobre un fondo gris y en la plantilla del zapato se observa la figura de lo que parece ser el signo conocido como trefoil en color amarillo, acompañado de la denominación ADIDAS, la muestra se presentó dentro de una caja de cartón en color café en la que se lee la denominación ADIBAS (el subrayado me pertenece) acompañada del diseño de tres rayas en color negro; 5.- Un zapato deportivo en colores negro y blanco, en el que se observa el uso de un diseño similar a las tres líneas de la marca ADIDAS en los costados de la muestra y la denominación ADIDAS acompañada de las referidas líneas en la parte posterior del zapato y en la plantilla; en la lengüeta del zapato se observa el signo antes mencionado, acompañado de la denominación TOP TEN y la figura de un círculo y una estrella en color negro sobre un fondo blanco, la muestra se encontró dentro de una caja de cartón en color café en la que se lee la denominación ADIBAS (el subrayado me pertenece) acompañada del diseño de tres rayas en color negro; 6.- Un zapato deportivo en colores gris y blanco, en el que se observa el uso la denominación ADIDAS acompañada de tres líneas en la parte posterior, en la plantilla y en la lengüeta del zapato, la muestra se encontró dentro de una caja de cartón en color negro en la que se observan tres líneas en color blanco y la denominación ADIDAS acompañada de tres líneas; 7.- Un zapato deportivo en colores azul, amarillo y gris, en cuya lengüeta y plantilla se observa el uso la denominación PUMA escrita en letras minúsculas color gris acompañada de la figura de lo que parece ser un animal felino en el mismo color, igualmente en los costados y la parte posterior de la muestra se observa la figura de lo que parece ser un animal felino en color gris, la muestra se encontró en una caja de cartón color negro en la que se observa la denominación PUMA CELL escrita en letras mayúsculas y minúsculas en color rojo sobre un fondo negro, acompañadas de la figura de lo que parece ser un animal felino en el mismo color; 8.- Un zapato deportivo en colores negro y blanco, en cuya lengüeta y plantilla se observa el uso la denominación PUMA escrita en letras minúsculas color blanco acompañada de la figura de lo que parece ser un animal felino en el mismo color, igualmente en la parte posterior y frontal de la muestra se observa la figura de lo que parece ser un animal felino en color blanco, así como en la suela del zapato, la muestra se encontró en una caja de cartón en color rojo, en la que se observa la denominación PUMA escrita en letras mayúsculas y minúsculas en color blanco, acompañadas de la figura de lo que parece ser un animal felino en el mismo color, de igual forma, en la parte superior de la caja se observa figura de lo que parece ser un animal felino en color blanco; 9.- Un zapato en colores negro, verde y blanco, en cuya lengüeta y parte posterior se observa el uso la denominación VANS OF THE WALL escrita en letras blancas sobre un fondo verde, en la plantilla, la suela y uno de sus costados se observa la denominación VANS escrita en letras minúsculas color blanco sobre un fondo verde, la muestra se encontró dentro de una caja de color negro y gris en la que se pueden observar caracteres en otro idioma y la figura de unas flores; 10.- Un zapato en colores café y crema, en cuya lengüeta se observa el uso la denominación CIORCIO ARMANI escrita en letras de color café sobre un fondo dorado, en uno de los costados de la muestra se observa la denominación ARMA...MADE CHINA acompañada de la figura de una especie de letra V, en color dorado, en la plantilla y en la parte posterior del zapato se observa el mismo logotipo, la muestra se encontró dentro de una caja de color naranja en la que se pueden observar caracteres en otro idioma, la expresión SHANG HAI HUA'ER y una figura de lo que aparentan ser jugadores de básquetbol; 11.- Un zapato deportivo en colores blanco y verde, en cuya lengüeta y parte posterior se observa el uso de la denominación ADIDAS acompañada de lo que parece ser el signo conocido como trefoil en color gris y verde respectivamente sobre un fondo blanco, en la plantilla se observa la denominación ADIDAS escrita en letras blancas sobre un fondo verde, la muestra se encontró dentro de una caja de cartón en color café, negro y rojo; 12.- Un zapato deportivo color negro, la capellada es de materia textil y la suela es de un material que parece caucho; en la lengüeta del zapato se observa la marca ALL STAR con la figura de una estrella en color negro sobre un fondo blanco, en la plantilla se observa la denominación CONVERSE escrita en letras de color azul sobre un fondo blanco y en la suela del zapato se observa la denominación CONVERSE ALL STAR acompañado de la figura de una estrella, la muestra se presentó dentro de una caja de cartón en color negro y café en la que se observa la denominación CONVERSE ALL STAR (chuck Taylor) acompañado de la figura de una estrella.

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Mediante oficio No.CIN-DGR-JPO-OF-2684 (anexo 2) la Corporación Aduanera Ecuatoriana a través de la Coordinación General de Intervención comunicó al importador acerca de la medida tomada por la Gerencia Distrital de la Corporación Aduanera Ecuatoriana-CAE-con sede en Cuenca, sin que haya presentado justificación o argumentación alguna dentro del expediente.

Por medio del oficio No.CIN-DGR-JPO-OF-2703 (anexo 3) la Corporación Aduanera Ecuatoriana a través de la Coordinación General de Intervención comunicó al Estudio Jurídico LCTLAW Luzuriaga, Castro & Torres apoderados de las compañías titulares de las marcas NIKE, PUMA y ADIDAS acerca de la medida tomada por la Gerencia Distrital de la Corporación Aduanera Ecuatoriana-CAE-con sede en Cuenca.

En fecha 12 de noviembre de 2010, las 10:28, el Dr. Gonzalo Luzuriaga, apoderado especial de la empresa NIKE INTERNATIONAL LTDA, titular de la marca NIKE presenta en las dependencias de la Subdirección Regional a mi cargo, un escrito a través del cual solicita con fundamento en los artículos 342 y 343 de la Ley de Propiedad Intelectual: "...Se confirme la medida en frontera adoptada por la Corporación Aduanera Ecuatoriana y en este sentido se suspenda la nacionalización de la mercadería presentada mediante declaración aduanera No. 091-10-10-002292, del importador IMPORTADORA Y DISTRIBUCIONES ALTAPRINCE CÍA. LTDA., presuntamente violatoria a los derechos de propiedad intelectual de NIKE INTERNATIONAL, LTD...", para lo cual adjunta un informe pericial elaborado por la Dis. Maria Fernanda Román, perito acreditada por el Consejo Nacional de la Judicatura, en el que luego de realizar un exhaustivo análisis de las muestras adjuntadas, concluye señalando que: "...LA MUESTRA DUBITADA, ZAPATO CON MARCA NIKE, CON LA DECLARACION ADUANERA # 091-10-10-002292, DEL IMPORTADOR: ALTAPRINCE CÍA. LTDA., NO ES ORIGINAL YA QUENO CUMPLE CON LAS CARACTERISTICAS TECNICAS PROPIAS DE LA MARCE NIKE Y POR CONSIGUIENTE ES FALSIFICADO, ESTE ZAPATO REPRODUCE LA MARCA NIKE Y EL SWOOSH de NIKE....."

Con fecha 12 de noviembre de 2010, las 10:29, el Dr. Gonzalo Luzuriaga, apoderado especial de la empresa ADIDAS AG, titular de la marca ADIDAS presenta en las dependencias de la Subdirección Regional, un escrito a través del cual solicita con fundamento en los artículos 342 y 343 de la Ley de Propiedad Intelectual: "...Se confirme la medida en frontera adoptada por la Corporación Aduanera Ecuatoriana y en este sentido se suspenda la nacionalización de la mercadería presentada mediante declaración aduanera No. 091-10-10-002292, del importador IMPORTADORA Y DISTRIBUCIONES ALTAPRINCE CÍA. LTDA., presuntamente violatoria a los derechos de propiedad intelectual de ADIDAS AG...", para lo cual adjunta un informe pericial elaborado por la Dis. Maria Fernanda Román, perito acreditada por el Consejo Nacional de la Judicatura, en el que luego de realizar un exhaustivo análisis de las muestras adjuntadas, concluye señalando que: "...LA MUESTRA DUBITADA, ZAPATO CON MARCA ADIDAS, CON LA DECLARACION ADUANERA # 091-10-10-002292, DEL IMPORTADOR: ALTAPRINCE CÍA. LTDA., NO ES ORIGINAL YA QUENO CUMPLE CON LAS CARACTERISTICAS TECNICAS PROPIAS DE LA MARCA ADIDAS Y POR CONSIGUIENTE ES FALSIFICADO, ESTE ZAPATO REPRODUCE LAS MARCAS ADIDAS, SHOE WITH 3 STRIPES (diseño) y TRES RAYAS DISEÑO....."

En fecha 12 de noviembre de 2010, las 10:32, el Dr. Gonzalo Luzuriaga, apoderado especial de la empresa PUMA AG, titular de la marca PUMA presenta en las dependencias de la Subdirección Regional, un escrito a través del cual solicita con fundamento en los artículos 342 y 343 de la Ley de Propiedad Intelectual: "...Se confirme la medida en frontera adoptada por la Corporación Aduanera Ecuatoriana y en este sentido se suspenda la nacionalización de la mercadería presentada mediante declaración aduanera No. 091-10-10-002292, del importador IMPORTADORA Y DISTRIBUCIONES ALTAPRINCE CÍA. LTDA., presuntamente violatoria a los derechos de propiedad intelectual de PUMA AG...", para lo cual adjunta un informe pericial elaborado por la Dis. Maria Fernanda Román, perito acreditada por el Consejo Nacional de la Judicatura, en el que luego de realizar un exhaustivo análisis de las muestras adjuntadas, concluye señalando que: "...LA MUESTRA DUBITADA, ZAPATO CON MARCA PUMA, CON LA DECLARACION ADUANERA # 091-10-10-002292, DEL IMPORTADOR: ALTAPRINCE CÍA. LTDA., NO ES ORIGINAL YA QUE NO CUMPLE CON LAS CARACTERISTICAS TECNICAS

-63-  
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"Artículo No. 1.-Delegar a la Dra. Jamileth Susana Vázquez Zambrano, Subdirectora Regional del Instituto Ecuatoriano de la Propiedad Intelectual-IEPI- de Cuenca, la atribución de ordenar medidas en frontera, en la Sierra Sur y Regional Oriental, según lo establecido en el Art. 351, literal f), de la Codificación de la Ley de Propiedad Intelectual, y en los términos previstos en el artículo 342, incisos tercero, cuarto y quinto, del mismo cuerpo legal, así como la atribución de sustanciar y resolver los recursos de reposición que lleguen a interponerse en tales casos.

Artículo 2.-La presente resolución entrará en vigencia a partir de la notificación a la funcionaria designada, sin perjuicio de su publicación en el Registro Oficial.

(...)."

El Art. 217 literal a) de la Ley de Propiedad Intelectual, en armonía con lo dispuesto en el Art. 155 literal a) de la Decisión Andina 486, señala que: "El registro de la marca confiere a su titular el derecho de actuar contra cualquier tercero que la utilice sin su consentimiento y, en especial realice, con relación a productos o servicios idénticos o similares para los cuales haya sido registrada la marca, alguno de los actos siguientes:

c) Importar o exportar productos con la marca;(..."

El artículo 76, numeral 2 de la Constitución de la República del Ecuador establece que en todo proceso en el que se determinen derechos y obligaciones de cualquier orden, se asegurará el derecho al debido proceso, que incluye, entre otras garantías básicas la presunción de la inocencia de toda persona, y será tratada como tal, mientras no se declare su responsabilidad mediante resolución firme o sentencia ejecutoriada.

#### ANÁLISIS Y CONCLUSIÓN.-

En el oficio No.CIN-DGR-JPO-OF-2683 se solicita que confirme o revoque la medida adoptada. Al respecto manifiesto lo siguiente:

Vistos los antecedentes remitidos por la Corporación Aduanera Ecuatoriana, revisadas las muestras enviadas y los informes periciales adjuntados, se puede concluir que existen evidencias suficientes que demuestran la violación de los derechos de propiedad intelectual de las compañías ADIDAS AG, PUMA AG, NIKE INTERNATIONAL LTDA. y GA MODEFINE S.A. , titulares de las marcas ADIDAS, PUMA, NIKE y GIORGIO ARMANI respectivamente.

En el caso de los productos identificados con las marcas CONVERSE y VANS no existen elementos de juicio suficientes que permitan advertir, fehacientemente, que se han transgredido los derechos de propiedad intelectual de los titulares de las referidas marcas, mediante la respectiva importación, puesto que no se cuenta con un informe técnico especializado de los productos en cuestión, que permita establecer la existencia de una falsificación de productos originales que estén protegidos en el Ecuador, o una utilización comercial del signo distintivo sin autorización de su titular.

Adicionalmente, se debe considerar que el artículo 219 de la Ley de Propiedad Intelectual codificada prevé que el derecho conferido por el registro de una marca no concede a su titular la posibilidad de prohibir el ingreso al país de productos marcados por dicho titular, su licenciatario o alguna otra persona autorizada para ellos, que hubiesen sido vendidos o de otro modo introducidos lícitamente en el comercio nacional de cualquier país, posibilidad que no ha sido desvirtuada en este caso.

Es necesario recordar que es de obligatorio cumplimiento, para toda autoridad pública, el respeto de la garantía procesal de presunción de inocencia, en los términos establecidos en la Constitución de la República del Ecuador, presunción que no ha llegado a desvanecerse en este caso, en virtud de que, como se indicó antes, no existen pruebas contundentes que permitan verificar la violación de derechos de propiedad intelectual.

-64-  
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Por las razones expuestas y en ejercicio de la facultad a mí delegada, confirmo la medida tomada por la Gerencia Distrital de la Corporación Aduanera Ecuatoriana-CAE-con sede en Cuenca en lo que respecta a los productos identificados con las marcas ADIDAS, PUMA, NIKE, GIORGIO ARMANI y revoco la medida en lo que respecta a los productos identificados con la denominación CONVERSE y VANS.

De conformidad con la norma antes invocada, los bienes deberán ser puestos a disposición del Ministerio Fiscal.

Atentamente,



Dra. Susana Vázquez Zambrano  
SUBDIRECTORA REGIONAL DEL IEPI





No. DDC-ASJC-OF-0016

Cuenca, 13 de enero del 2011.

Doctora  
Susana Vázquez  
SUBDIRECTORA REGIONAL CUENCA  
INSTITUTO ECUATORIANO DE PROPIEDAD INTELECTUAL  
Ciudad.-

*De mis consideraciones:*

Por medio del presente me dirijo a Ud. de la manera más respetuosa con el objeto de informarle que mediante oficio No. DDZC-AFPC-OF-(i)-0010, de fecha 11 de enero del año en curso, la Dirección Distrital del Servicio Nacional de Aduana del Ecuador, ha sido informada por la Dirección de Despacho y Control de Zona Primaria de esta Dirección, que luego de haber realizado el aforo físico de la mercancía importada al amparo de la Declaración Aduanera Única No. 17238894, con CDA No. 091-2011-10-000087, perteneciente al importador BORIS IVÁN PALACIOS NARANJO, se han encontrado engrasadoras manuales con empaque de la marca PRESSOI, la misma que está registrada y es de origen alemán, por lo que nos han sugerido informar al IEPI, por si existe alguna vulneración a los derechos de propiedad intelectual o a los derechos de autor, ya que en la DAU (Declaración Aduanera Única) y en la DAV (Declaración Andina de Valor), se declara todo con marca BP, que presuntamente es registrada por el importador.

De acuerdo a lo dispuesto en el Art. 227 de la Constitución: *"La administración pública constituye un servicio a la colectividad que se rige por los principios de eficacia, eficiencia, calidad, jerarquía, desconcentración, descentralización, **coordinación**, participación, planificación, transparencia y evaluación"* (el resaltado me pertenece).

Por otro lado, la Ley Orgánica de Garantías Jurisdiccionales y Control Constitucional en el Art. 4, literal 2, dispone lo siguiente: *"Principios procesales.- La justicia constitucional se sustenta en los siguientes principios procesales: Aplicación directa de la Constitución.- Los derechos y garantías establecidos en la Constitución y en los instrumentos internacionales de derechos humanos, serán de directa e inmediata aplicación por y ante cualquier servidora o servidor público, administrativo o judicial, de oficio o a petición de parte"*.

En virtud de lo expuesto y al existir indicios de que la referida mercancía podría violentar los derechos de propiedad intelectual y tomando en cuenta que el Art. 342 de la Ley de Propiedad Intelectual, dispone: *"Impedimentos de ingreso o exportación de productos.- Los administradores de Aduana y todos quienes tengan el control del ingreso o salida de mercaderías al o desde el Ecuador, tienen la obligación de impedir que ingresen o se exporten productos que de cualquier modo violen los derechos de propiedad intelectual. Si a petición de parte interesada no impidieren el ingreso o exportación de tales bienes, serán considerados cómplices del delito que se cometa, sin perjuicio de la sanción"*

Servicio Nacional de Aduana del Ecuador  
Cuenca - Av. 13ta Lata 2-088 y Av. Cáliz Ramírez Dávalos (PBX: 072907981)  
www.aduana.gub.ec



*administrativa que corresponda...”, a través del presente le informamos lo sucedido con esta importación, para que se tomen las medidas adecuadas.*

Adjunto al presente copias del oficio No. DDZC-AFFC-OF-(i)-0010; de la DAU No. 091-2011-10-000087 y sus documentos de acompañamiento; así como también le adjunto las 8 muestras consistentes en: aceitero tipo Alemán, grapa para tierra, llave de combinación, brocha, juego de piedras, cautín tipo lápiz, snap of cuter y un cepillo circular

Particular que pongo bajo su conocimiento para los fines pertinentes.

**Atentamente,**

**Ing. Mayra Calle Rodríguez.**  
**Directora Distrital Cuenca (E)**  
**Secretaría Nacional de Aduana del Ecuador**

Elaborado por: Dra. C. Campoverde.

Fecha de elaboración: 13/01/2011



Juzgado:  
Su atención  
M/Eno/2011

No. DDZC-AFFC-OF-(i)-0010

Cuenca, enero 11 del 2011

Señor Ingeniero  
**Boris Coellar Dávila,**  
**DIRECTOR DISTRITAL CUENCA,**  
**SERVICIO NACIONAL DE ADUANA DEL ECUADOR,**  
Ciudad.

De mi consideración:

Señor Director debo informar a Usted que, se ha realizado el aforo físico de la mercancía importada al amparo de la DAU 17238894 con CDA 091-2011-10-000087-3-01 perteneciente al importador PALACIOS NARANJO BORIS IVAN, constatando las siguientes novedades:

Se declaran 4214 bultos con 646.064.00 unidades comerciales de herramientas en tres contenedores, con la particularidad de que la procedencia de la mercancía es China, así como el origen declarado de la misma, sin embargo en el empaque de la mayoría de productos se puede leer la leyenda PROFESSIONAL TOOLS GERMANY ó BP GERMANY, y en ninguna parte se manifiesta el origen chino de la mercancía, de tal manera se sugiere informar de este particular a la Defensoría del Pueblo para que emita su criterio sobre la nacionalización de la mercancía.

También se encontraron engrasadoras manuales con empaque de la marca PRESSOL, la misma que está registrada y es de origen alemán, por lo que se sugiere informar al IEPI por si existe alguna vulneración a propiedad intelectual o derechos de autor, ya que en DAV y DAV se declara todo con marca BP que presuntamente es registrada por el importador.

Es todo lo que puedo informar para que se sirva tomar las acciones legales pertinentes.

Atentamente  
MAYRA CALLE RODRIGUEZ  
Ing. Mayra Calle Rodríguez  
Director de Despacho y Control de Zona Primaria

CORPORACION ADUANERA ECUATORIANA  
GERENCIA DISTRITAL CUENCA  
ARCHIVO PASIVO  
ADUANA DEL ECUADOR  
CERTIFICO QUE ES FIEL  
COPIA DE SU ORIGINAL  
FIRMA AUTORIZADA

Cc: Archivo.  
Elaborado por: Juan Carlos Andrade.  
Fecha Elaboración: 11/01/2011

2011 JAN 20 P #51



GERENCIA DISTRITAL CUENCA  
RECIBIDO

OFICIO No. 003-2011-SRC-IEPI  
Cuenca, 20 de enero de 2011


Señor Ingeniero  
Boris Coellar Dávila,  
DIRECTOR DISTRITAL CUENCA,  
SERVICIO NACIONAL DE ADUANA DEL ECUADOR,  
Ciudad.-

Señor Director:

En atención al oficio No.DDC-ASJC-OF-0016 de fecha 13 de enero de 2011, recibido en este despacho el 13 de los mismos mes y año, manifiesto a Usted lo siguiente:

#### ANTECEDENTES.-


En el oficio antes referido se indica que: "...mediante oficio No. DDZC-AFFC-OF-(j)-0010, de fecha 11 de enero del año en curso, la Dirección Distrital del Servicio Nacional de Aduana del Ecuador, ha sido informada por la Dirección de Despacho y Control de Zona Primaria de esta Dirección, que luego de haber realizado el aforo físico de la mercancía importada al amparo de la Declaración Aduanera Única No.091-2011-10-000087, perteneciente al importador BORIS IVAN PALACIOS NARANJO, se han encontrado engrasadoras manuales con empaque de la marca PRESSOL, la misma que está registrada y es de origen alemán, por lo que nos han sugerido informar al IEPI, por si existe alguna vulneración a los derechos de propiedad intelectual o a los derechos de autor, ya que en la DAU (declaración única aduanera) y en la DAV (declaración andina de valor), se declara todo con marca BP, que presuntamente es registrada por el importador..."

Las muestras físicas que se adjuntaron al oficio antes referido corresponden a:  
1.- Una caja de cartón en cuya cara frontal se lee lo siguiente: la denominación VARIO PRESSOL SYSTEM acompañada de la figura de un círculo en tonos negro y café claro. Adicionalmente se lee las denominaciones: POSI LOK, TUV PRODUCT SERVICE, GS GEPRÜFTE SICHERHEIT, LGA LANDESGEWERBEANSTALT BAYEM NÜRNBERG; en el extremo superior derecho de la referida caja consta la denominación PRESSOL escrita en letras color café claro sobre un fondo negro con un borde en el mismo color, se observa también las palabras BOMBA DE ENGRASE-ESTÁNDAR en varios idiomas y el dibujo de la bomba de engrase. Finalmente se observa un sello superpuesto en el que se leen las palabras ACEITERO TIPO ALEMAN en letras blancas sobre un fondo azul, esta denominación se encuentra acompañada de un logotipo conformado por las letras bp acompañadas de un 



diseño característico en tonos azul y amarillo, adicionalmente se observa algunas características técnicas del producto. Dentro de la caja se pudo observar que la bomba de engrase se encuentra empacada en una funda plástica en cuyo extremo superior izquierdo se observa la denominación VARIO PRESSOL SYSTEM acompañada de la figura de un círculo en tonos negro y blanco. Adicionalmente se lee la denominación POSI LOK escrita en letras blancas sobre un fondo negro; en el extremo superior derecho consta la denominación PRESSOL escrita en letras color blanco sobre un fondo negro con un borde en el mismo color; en parte central del empaque se aprecia una serie de dibujos que ilustran las instrucciones para el uso. Finalmente en la parte inferior del envase constan las denominaciones TUV PRODUCT SERVICE, GS GEPRÜFTE SICHERHEIT, LGA LANDESGEWERBEANSTALT BAYEM NÜRNBERG e información que aparentemente corresponde al fabricante del producto como direcciones y números de teléfono. 2.- Una caja en la que se lee la denominación GRAPA PARA TIERRA escrita en letras blancas sobre un fondo azul; en el extremo superior izquierdo se puede observar un logotipo conformado por las letras bp acompañadas de un diseño característico en tonos azul y amarillo, adicionalmente se observa algunas características técnicas como el tamaño del objeto. Dentro de la caja se pudo observar que en el artículo se encuentran gravadas las letras BP 300 A. 3.- Una llave de combinación en la que se puede observar un logotipo conformado por las letras bp acompañadas de un diseño característico en tonos azul y amarillo, adicionalmente se observa algunas características técnicas como el tamaño del objeto. Dentro del empaque se pudo observar que en el artículo se encuentran las letras BP. 4.- Una brocha de color amarillo en la que se puede observar la denominación BP GERMANY. 5.- Un juego de piedras en cuyo empaque se puede observar un logotipo conformado por las letras bp acompañadas de un diseño característico en tonos azul y amarillo, adicionalmente se observa algunas características como el número de los objetos. 6.- Un caudín tipo lápiz eléctrico de 60 w en cuyo empaque se puede observar un logotipo conformado por las letras bp acompañadas de un diseño característico en tonos azul y amarillo. 7.- Un estilete en cuyo empaque se puede observar un logotipo conformado por las letras bp acompañadas de un diseño característico en tonos azul y amarillo. 8.- Un cepillo circular de 200 mm en cuya caja se puede observar un logotipo conformado por las letras bp acompañadas de un diseño característico en tonos azul y amarillo, así como información relativa a las características técnicas del producto.

Mediante oficio No.DDC-ASJC-OF-0018, Ud. señor Director comunicó al Estudio Jurídico Novoa, Peña, Larrea & Torres abogados de Almacenes Boyacá, titular en el Ecuador de los derechos sobre la marca PRESSOL, conforme se desprende el título No.806-07, acerca de la medida en frontera tomada por la Dirección de Despacho y Control de Zona Primaria de la Secretaría Nacional de Aduana del Ecuador, sin que el titular marcario haya presentado hasta el momento ningún documento o argumentación en esta dependencia administrativa que demuestre fehacientemente que se trata de mercadería presuntamente infractora.

Por otra parte, revisada la base de datos del lepi se desprende que el Sr. Boris Iván Palacios Naranjo es titular de los derechos sobre la marca LOGOTIPO 

MAS LETRAS B y P conforme se deduce del título No. 4181-07, otorgado para proteger productos de la clase internacional No. 7, tales como maquinas y herramientas.

De la documentación remitida por la CAE a esta dependencia, no consta que el importador haya presentado justificación o argumentación alguna dentro del expediente.

#### **BASE LEGAL.-**

El Art. 342 de la Ley de Propiedad Intelectual; señala: "...La Corporación Aduanera Ecuatoriana y todos quienes tengan el control del ingreso o salida de mercaderías al o desde el Ecuador, tienen la obligación de impedir que ingresen o se exporten productos que de cualquier modo violen los derechos de propiedad intelectual.


*Si a petición de parte interesada no impidieren el ingreso o exportación de tales bienes, serán considerados cómplices del delito que se cometa, sin perjuicio de la sanción administrativa que corresponda.*

*Quando impidieren de oficio o a petición de parte el ingreso o exportación de cualquier producto que viole los derechos de propiedad intelectual, lo pondrán en conocimiento mediante informe pormenorizado al Presidente del IEPI, quien en el término de cinco días confirmará o revocará la medida tomada. Confirmada la medida, los bienes serán puestos a disposición del fiscal competente.*

*Si la Corporación Aduanera Ecuatoriana o cualquier otro funcionario competente se hubiere negado a tomar la medida requerida o no se hubiere pronunciado en el término de tres días, el interesado podrá recurrir directamente dentro de los tres días posteriores al Presidente del IEPI para que lo ordene.*

(...)"

Mediante resolución No. 09-130 P-IEPI de 11 de marzo de 2009, emitida con el fin de agilizar la administración de los trámites de su competencia y al amparo de lo dispuesto en el Art. 55 del Estatuto del Régimen Jurídico Administrativo de la Función Ejecutiva, el Presidente del IEPI, Ab. Andrés Ycaza resolvió:

*"Artículo No. 1.-Delegar a la Dra. Jamieth Susana Vázquez Zambrano, Subdirectora Regional del Instituto Ecuatoriano de la Propiedad Intelectual-IEPI- de Cuenca, la atribución de ordenar medidas en frontera, en la Sierra Sur y Regional Oriental, según lo establecido en el Art. 351, literal f), de la Codificación de la Ley de Propiedad Intelectual, y en los términos previstos en el artículo 342, incisos tercero, cuarto y quinto, del mismo cuerpo legal, así como la atribución de sustanciar y resolver los recursos de reposición que lleguen a interponerse en tales casos.* 

*Artículo 2.-La presente resolución entrará en vigencia a partir de la notificación a la funcionaria designada, sin perjuicio de su publicación en el Registro Oficial.*

(...)."

El artículo 76, numeral 2 de la Constitución de la República del Ecuador establece que en todo proceso en el que se determinen derechos y obligaciones de cualquier orden, se asegurará el derecho al debido proceso, que incluye, entre otras garantías básicas la presunción de *la inocencia de toda persona, y será tratada como tal, mientras no se declare su responsabilidad mediante resolución firme o sentencia ejecutoriada.*

#### **ANÁLISIS Y CONCLUSIÓN.-**

En el oficio No. DDC-ASJC-OF-0016 se pone bajo mi conocimiento para los fines pertinentes, la medida tomada por la Dirección de Despacho y Control de Zona Primaria. Al respecto manifiesto lo siguiente:

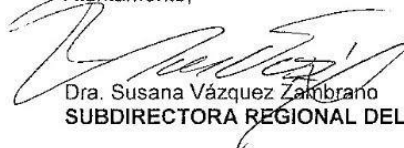
Vistos los antecedentes remitidos por la Secretaria Distrital de Aduana del Ecuador, revisadas tanto la base de datos del IEPI, así como las muestras adjuntadas al oficio con el que se me comunicó acerca de la medida tomada, se puede concluir que no existen evidencias suficientes que demuestren la violación de los derechos de propiedad intelectual que posee ALMACENES BOYACÁ en el Ecuador sobre la marca denominada PRESSOL.

Adicionalmente, se debe considerar que el artículo 219 de la Ley de Propiedad Intelectual codificada prevé que el derecho conferido por el registro de una marca no concede a su titular la posibilidad de prohibir el ingreso al país de productos marcados por dicho titular, su licenciatario o alguna otra persona autorizada para ellos, que hubiesen sido vendidos o de otro modo introducidos lícitamente en el comercio nacional de cualquier país, posibilidad que no ha sido desvirtuada en este caso por el titular marcarlo.

Es necesario recordar que es de obligatorio cumplimiento, para toda autoridad pública, el respeto de la garantía procesal de presunción de inocencia, en los términos establecidos en la Constitución de la República del Ecuador, presunción que no ha llegado a desvanecerse en este caso, en virtud de que, como se indicó antes, no existen pruebas contundentes que permitan verificar la violación de derechos de propiedad intelectual.

Por las razones expuestas y en ejercicio de la facultad a mí delegada, revoco la medida tomada por la Dirección de Despacho y Control de Zona Primaria de la Secretaria Nacional de Aduana del Ecuador.

Atentamente,

  
Dra. Susana Vázquez Zambrano  
SUBDIRECTORA REGIONAL DEL IEPI





Oficio Nro. SENAE-DDC-2012-0223-OF

Cuenca, 30 de mayo de 2012

**Asunto:** REPORTE NOVEDADES AFORO FISICO REF. 091-2012-10-001326-7  
SANCHEZ ALVARADO ANGEL JOEL

Señorita  
Jamileth Susana Vazquez Zambrano  
**Subdirección Regional Cuenca**  
**INSTITUTO ECUATORIANO DE PROPIEDAD INTELECTUAL**  
En su Despacho

*De mi consideración:*

Por medio del presente me dirijo a Ud. de la manera más respetuosa con el objeto de informarle que mediante memorando No. SENAE-DDZC-2012-0179-M, de fecha 09 de mayo del año en curso, la Dirección Distrital del Servicio Nacional de Aduana del Ecuador, ha sido informada por la Dirección de Despacho y Control de Zona Primaria de esta Dirección, que se realizó el aforo físico de la mercancía importada al amparo de la DAA 18537812 con CDA 091-2012-10-001326-7, perteneciente a la importador SANCHEZ ALVARADO ANGEL JOEL constatando las siguientes novedades: se encontraron en el acto de aforo físico varios artículos tales como:

- Peluches y juguetes del juego Mario Bros cuya marca en la envoltura dice Nintendo y Mario Bros.
- Figuras pequeñas del juego Mario Bros, en cajas individuales que indican Súper Mario Bros. Wii y cuya caja de envoltura indica la marca Furuta.
- Figuras pequeñas del juego Mario Bros envueltas en fundas plásticas sin marca.
- Controles para juego Nintendo Wii en envolturas con marca Nintendo y Shiro y volante para Nintendo Wii cuya caja utiliza las imágenes de Mario y Luigi
- Alcancías con personajes del juego Angry Birds con marca ROOGO que se presumen vulneran derechos de propiedad intelectual de la marca Rovio.
- Carcasas para PSP con marca Sony en cajas blancas sin identificación.
- Memoria para Play Station 2 y set de audífonos envueltos en caja con logos SONY
- Audífonos con logos Sony envueltas en fundas plásticas.
- Llaveros de los personajes pitufos en fundas plásticas y figuras de juguetes marca SMURFS, que se presumen vulneran derechos de propiedad intelectual de la marca PEYO.

Sobre esta mercancía se presume que ni por calidad, estética o valor declarado estos productos son originales, se observa también que las mercancías no contienen los Copyright ni marca registrada.

De lo expuesto se evidencian indicios de que la referida mercancía podría violentar los

C O N T I N U A C I O N



Oficio Nro. SENAE-DDC-2012-0223-OF

Cuenca, 30 de mayo de 2012

derechos de propiedad intelectual y de que el importador en mención habría incurrido en el delito tipificado en el art. 323 de la Ley de Propiedad Intelectual, por lo que esta autoridad ha procedido conforme lo establecido en el Art. 342 de la Ley de Propiedad Intelectual, que dispone: "*Impedimentos de ingreso o exportación de productos.- Los administradores de Aduana y todos quienes tengan el control del ingreso o salida de mercaderías al o desde el Ecuador, tienen la obligación de impedir que ingresen o se exporten productos que de cualquier modo violen los derechos de propiedad intelectual. Si a petición de parte interesada no impidieren el ingreso o exportación de tales bienes, serán considerados cómplices del delito que se cometa, sin perjuicio de la sanción administrativa que corresponda...*", a través del presente le informamos lo sucedido con esta importación, para que sea usted quien revoque o confirme la medida adoptada por esta Dirección Distrital de Cuenca, del Servicio Nacional de Aduana del Ecuador.

Adjunto al presente copias del oficio No. SENAE-DDZC-2012-0179-M; de la DAU No. 091-2012-10-001326-7 y sus documentos de acompañamiento; así como también le adjunto las muestras consistentes en: Carcasa para PSP color negra SONY, Set de audifonos para control remoto SONY, Cable para audifono color Blanco SONY, memoria para Play Statio 2 SONY, Control Blanco para Nintendo Wi, Volante para Nintendo Wii con imagen de Mario y Luigi, Control Rojo para Nintendo Wii, Alcancia tipo Angri Birds, Figura de Mario Bross con alas, Set de muñecos Mario Bross varios modelos, Peluche pequeño con figura de Yoshi Juego Mario Bross, Set de figuras de juego Mario Bross de colección, Caja Amarilla marca Futura con muñecos Mario Bross Peluche Grande tipo Mario Bross, juego de llaveros de los pitufos varios, una muestra de cada uno de los productos indicados.

Atentamente,

*Documento firmado electrónicamente*

Ing. Mayra Alejandra Calle Rodríguez  
**DIRECTOR DISTRITAL CUENCA, SUBROGANTE**

Referencias:  
SENAE DDZC-2012-0179-M

Servicio Nacional de Aduana del Ecuador

INSTITUTO ECUATORIANO DE LA PROPIEDAD INTELECTUAL  
REGISTRARIA  
CUENCA

06 JUN. 2012

16:56



SUBDIRECCIÓN REGIONAL CUENCA

-67-  
(sesenta y siete)

Oficio No. 001 – 2012-IEPI-CUE-MF  
Cuenca, 6 de junio de 2012

Señora Ingeniera  
Mayra Alexandra Calle Rodríguez  
Directora Distrital Subrogante del Servicio Nacional de Aduana del Ecuador,  
SENAE  
Ciudad.-

Estimada Directora:

En atención a su Oficio No. SENAE-DCC-2012-0223-OF, de 30 de mayo de 2012  
recibido en esta oficina regional, el mismo día, manifiesto a usted lo siguiente:

**ANTECEDENTES:**

Que Usted, en el oficio antes referido, indica que: "(...) mediante memorando SENAE-DDZC-2012-0179-M del 9 de mayo del año en curso, la Dirección Distrital del Servicio Nacional de Aduana del Ecuador, ha sido informada por la Dirección de despacho y Control de Zona Primaria de esta Dirección, que se realizó el aforo físico de la mercancía importada al amparo de la DAU 18537812 con CDA 091-2012-10-001326-7 perteneciente al importador SANCHEZ ALVARADO ANGL JOEL constatando las siguientes novedades: se encontraron en el acto de aforo físico  
Varios artículos tales como:

- Peluches y juguetes del juego Mario Bros cuya marca en la envoltura dice Nintendo y Mario Bros.
- Figuras pequeñas del juego Mario Bros, en cajas individuales que indican Super Mario Bros. Wii y cuya envoltura indica la marca Futura.
- Figuras pequeñas del juego Mario Bros envueltas en fundas plásticas sin marca
- Controles para juego Nintendo Wii en envolturas con marca Nintendo y Shiro y volante para Nintendo Wii cuya caja utiliza las imágenes de Mario y Luigi
- Alcancías con personajes del juego Angry Birds con marca ROOGO que se presumen vulneran derechos de propiedad intelectual.
- Carcasas para PSP con marca Sony en cajas blancas sin identificación
- Memoria para play station 2 y set de audífonos envueltos en caja con logos SONY.
- Audífonos con logos Sony envueltas en fundas plásticas.
- Llaveros de los personajes piñfos en fundas plásticas y figuras de juguetes marca SMURFS, que se presumen vulneran derechos de propiedad intelectual de la marca PEYO.



### SUBDIRECCIÓN REGIONAL CUENCA

*Sobre esta mercancía se presume que ni por calidad, estética o valor declarado estos productos son originales, se observa también que las mercancías no contienen los copyright ni marca registrada.*

*De lo expuesto se evidencian indicios de que la referida mercancía podría violentar los derechos de propiedad intelectual y de que el importador en mención habría incurrido en el delito tipificado en el art. 323 de la Ley de propiedad Intelectual, por lo que esta autoridad ha procedido conforme lo establecido en el Artículo 342 de la Ley de Propiedad Intelectual que dispone: "Impedimentos de ingreso o exportación de productos.-Los administradores de aduana y todos quienes tengan el control del ingreso o salida de mercaderías al o desde el Ecuador, tienen la obligación de impedir que ingresen o se exporten productos que de cualquier modo violen los derechos de propiedad intelectual. Si a petición de parte interesada no impidieren el ingreso o exportación de tales bienes, serán considerados cómplices del delito que se cometa, sin perjuicio de la sanción administrativa que corresponda...", a través del presente le informamos lo sucedido con esta importación, para que sea usted quien revoque o confirme la medida adoptada por esta Dirección Distrital de Cuenca, del Servicio Nacional de Aduana del Ecuador. (...)"*

*Que adicionalmente el indicado oficio señala que: "(...) adjunta al presente copias del oficio No. SENAE-DDZC-2012-0179-M: de la DAU NO. 091-2012-10-001326-7 y sus documentos de acompañamiento; así como también le adjunto las muestras consistentes en: Carcasa para PSP color negra SONY, Set de audífonos para control remoto SONY, Cable para audífono color blanco SONY, memora para Play Statio 2 SONY, Control blanco para Nintendo Wi, Volante para Nintendo Wii, Volante para Nintendo Wii con imagen de Mario y Luigi, Control Rojo para Nintendo Wii, Alcancia tipo Andry Birds, Figura de Mario Bross con alas, Set de muñecos Mario Bross varios modelos, Peluche pequeño con figura de Yoshi Juego Mario Bross, Set de figuras de juego Mario Bross de colección, Caja amarilla marca Futura con muñecos Mario Bross Peluche Grande tipo Mario Bross, juego de llaveros de los pitufos varios, una muestra de cada uno de los productos indicados.*

*Que las muestras físicas que se adjuntan al **Oficio No. SENAE-DCC-2012-0223-OF**, de 30 de mayo de 2012 recibido en esta oficina regional el mismo día comprenden: Carcasa para PSP color negra SONY, Set de audífonos para control remoto SONY, Cable para audífono color blanco SONY, memora para Play Statio 2 SONY, Control blanco para Nintendo Wi, Volante para Nintendo Wii, Volante para Nintendo Wii con imagen de Mario y Luigi, Control Rojo para Nintendo Wii, Alcancia tipo Andry Birds, Figura de Mario Bross con alas, Set de muñecos Mario Bross varios modelos, Peluche pequeño con figura de Yoshi Juego Mario Bross, Set de figuras de juego Mario Bross de colección, Caja amarilla marca Futura con muñecos Mario Bross Peluche Grande tipo Mario Bross, juego de llaveros de los pitufos varios*



-69-  
(sesenta y nueve)

#### SUBDIRECCIÓN REGIONAL CUENCA

Que en el **Oficio No. SENAE-DCC-2012-0223-OF**, cuya copia simple se ha acompañado al informe no pormenorizado que remite la SENAE a esta Institución, no consta ninguna referencia acerca de que se ha comunicado al importador SANCHEZ ALVARADO ANGEL JOEL, que el trámite de nacionalización de su mercadería ha sido suspendido hasta que el IEPI, conforme lo establece el art. 342 de la Ley de Propiedad Intelectual, **confirme o revoque** la medida en frontera aplicada por la SENAE.

Que hasta el momento el importador no se ha pronunciado respecto a la referida medida, ni ha presentado documentos de descargo.

Que en el **Oficio No. SENAE-DCC-2012-0223-OF**, cuya copia simple se ha acompañado al informe que remite la SENAE a esta Institución, no consta ninguna referencia acerca de que se ha comunicado a los titulares de los derechos de propiedad intelectual presuntamente afectados, acerca de que el trámite de nacionalización de la mercadería del importador, ha sido suspendido hasta que el IEPI, **confirme o revoque** la medida en frontera aplicada por la SENAE,

Que hasta el momento el titular de los derechos de propiedad intelectual sobre la marca Nintendo Wii no se ha pronunciado respecto a la medida en frontera ordenada por la SENAE, motivo por el cual esta autoridad administrativa no cuenta con los suficientes medios probatorios que le permitan dilucidar acerca de la originalidad de los productos identificados con la marca Wii, ni con un informe pormenorizado acerca de la mercadería presuntamente infractora.

Que con fecha 6 de junio de 2012, el Dr. Xavier Rosales Kuri en calidad de apoderado especial de Rovio Entertainment Ltd. (Reg. de Poderes del IEPI N° 1672), titular de los derechos sobre la marca ANGRY BIRDS, presentó en las dependencias de la Subdirección Regional a mi cargo, un escrito en cuya parte pertinente señala lo siguiente: "*Mi representada es la legítima titular de las marcas "ANGRY BIRDS" y sus variaciones en nuestro país y alrededor de todo mundo.*

*En el Ecuador, posee los títulos de registro marcarios detallados en el punto 1.1 del presente escrito, entre los cuales se encuentra la denominación "ANGRY BIRDS" que es reproducido íntegramente en la mercadería infractora (...)*

*Por lo expuesto, amparado en lo establecido en los artículos 288, 289, 332, 334 literal c), 339, 342 y siguientes de la Ley de Propiedad Intelectual, y demás normas pertinentes aplicables, solicito que se confirme la medida adoptada por la Corporación Aduanera Ecuatoriana impidiendo de forma definitiva el ingreso al país de la mercadería infractora y poniéndola a disposición del fiscal competente..."*

Que con fecha 6 de junio de 2012 el Dr. Xavier Rosales Kuri en calidad de apoderado especial de SONY CORPORATION (Reg. de Poderes del IEPI N° 1694), presentó en las dependencias de la Subdirección Regional a mi cargo, un



-70-  
(setenta)



#### SUBDIRECCIÓN REGIONAL CUENCA

escrito en cuya parte pertinente señala lo siguiente: " *Mi representada es la legítima titular de las marcas "SONY", "PS", "PSP", "PS1", "PS2", "PSP" y sus variaciones en nuestro país y alrededor de todo mundo, siendo de conocimiento público que dichas marcas, son un sinónimo de calidad y durabilidad.*

*En el Ecuador, posee los títulos de registro marcarios detallados en el punto 1.1 del presente escrito, entre los cuales se encuentra la denominación SONY que es reproducido íntegramente en la mercadería infractora.(...)*

*Por lo expuesto, amparado en lo establecido en los artículos 288, 289, 332, 334 literal c), 339, 342 y siguientes de la Ley de Propiedad Intelectual, y demás normas pertinentes aplicables, solicito que se confirme la medida adoptada por la Corporación Aduanera Ecuatoriana impidiendo de forma definitiva el ingreso al país de la mercadería infractora y poniéndola a disposición del fiscal competente."*

Que, además, es público y notorio que los personajes *MARIO BROSS* diseñado por *Shigeru Miyamoto* (y todos sus estrellas tales como *Luigi, la Princesa Peach, toad, Bowser, etc*), *ANGRY BIRDS* creados por *Mikael hed*, *LOS PITUFOS* ideados por *PeYo*, y la caricatura *YOSHI*, gozan de **protección mundial por derecho de autor**.

Que revisada la base de datos del Instituto Ecuatoriano de Propiedad Intelectual, no se encontraron registros de las marcas *FUTURA, ROOGO, ROVIO*, ni *PEYO* para identificar productos encasillados en la clase internacional No.28 que protege juguetes;

Que la marca *SHIRO* registrada para identificar productos de la clase internacional No. 9, específicamente aparatos eléctricos o electrónicos, estuvo registrada en nuestro país hasta el año 2003, por la compañía *TRANSCONTINENTAL*, con el número 311, pero actualmente se encuentra caducada.

Que mediante **Oficio No. SENAE-DCC-2012-0223-OF**, de 30 de mayo de 2012 recibido en esta oficina regional el mismo día, y, de conformidad del artículo 342 de la Ley de Propiedad Intelectual, Usted solicita que esta autoridad **confirme o revoque** la medida adoptada.

#### BASE LEGAL:

I.- El artículo número 322 de la Constitución Política de la República del Ecuador, publicada en el R.O. No. 449, de 20 octubre de 2008, que dispone:

"Se reconoce la propiedad intelectual de acuerdo con las condiciones que señale la ley. (...)"

II.- El artículo número 22 de la Constitución Política de la República del Ecuador, publicada en el R.O. No. 449, de 20 octubre de 2008, que dispone: 6



#### SUBDIRECCIÓN REGIONAL CUENCA

“Las personas tienen derecho a desarrollar su capacidad creativa, al ejercicio digno y sostenido de las actividades culturales y artísticas, y a **beneficiarse de la protección de los derechos morales y patrimoniales que les correspondan por las producciones científicas, literarias o artísticas de su autoría**”.

III.- El artículo número 76 de la Constitución de la República del Ecuador, publicada en el R.O. No. 449, de 20 octubre de 2008, donde dentro de las garantías del debido proceso dispone:

“En todo proceso en el que se determinen derechos y obligaciones de cualquier orden, se asegurará el derecho al debido proceso que incluirá las siguientes garantías básicas:

(...)

6. La ley establecerá la debida proporcionalidad entre las infracciones y las sanciones penales, administrativas o de otra naturaleza. (...).”

IV.- La Decisión 351 de la Comisión de la Comunidad Andina de Naciones.

V.- El artículo 1 de la Ley de Propiedad Intelectual, codificación 2006-13 publicada en el Suplemento del R.O. No. 426 de 28 de diciembre de 2006, que dispone:

“**El Estado reconoce, regula y garantiza la Propiedad Intelectual adquirida de conformidad con la ley**, las decisiones de la Comisión de la Comunidad Andina, y los convenios internacionales vigentes en el Ecuador.

La Propiedad Intelectual comprende:

1. **Los derechos de autor** y derechos conexos;
2. **La propiedad industrial**, que abarca entre otros elementos, los siguientes: (...)
  - c) **Las marcas** de fábrica, de comercio, de servicios y los lemas comerciales;  
(...)
3. Las obtenciones vegetales. (...).”

VI.- El artículo 2 de la Ley de Propiedad Intelectual, codificación 2006-13 publicada en el Suplemento del R.O. No. 426 de 28 de diciembre de 2006, que dispone:

“Los derechos conferidos por esta Ley se aplican **por igual** a nacionales y extranjeros, domiciliados o no en el Ecuador”.



#### SUBDIRECCIÓN REGIONAL CUENCA

VII.- El artículo 3 de la Ley de Propiedad Intelectual, codificación 2006-13 publicada en el Suplemento del R.O. No. 426 de 28 de diciembre de 2006, que dispone:

**“El Instituto Ecuatoriano de la Propiedad Intelectual (IEPI), es el organismo administrativo competente para propiciar, promover, fomentar, prevenir, proteger y defender a nombre del Estado ecuatoriano, los derechos de propiedad intelectual reconocidos en la presente Ley y en los tratados y convenios internacionales, sin perjuicio de las acciones civiles y penales que sobre esta materia deberán conocerse por la Función Judicial”.**

VIII.- El artículo 5 de la Ley de Propiedad Intelectual, codificación 2006-13 publicada en el Suplemento del R.O. No. 426 de 28 de diciembre de 2006, que dispone:

**“El derecho de autor nace y se protege por el solo hecho de la creación de la obra, independientemente de su mérito, destino o modo de expresión.**

Se protegen todas las obras, (...) **cualquiera sea el país de origen de la obra, la nacionalidad o el domicilio del autor o titular.** Esta protección también se reconoce cualquiera que sea el lugar de publicación o divulgación.

El reconocimiento de los derechos de autor y de los derechos conexos no está sometido a registro, depósito, ni al cumplimiento de formalidad alguna.

(...)”.

IX.- El artículo 6 de la Ley de Propiedad Intelectual, codificación 2006-13 publicada en el Suplemento del R.O. No. 426 de 28 de diciembre de 2006, que dispone:

**“El derecho de autor es independiente, compatible y acumulable con:**

- a) La propiedad y otros derechos que tengan por objeto la cosa material a la que esté incorporada la obra;
- b) **Los derechos de propiedad industrial que puedan existir sobre la obra;** y,
- c) Los otros derechos de propiedad intelectual reconocidos por la ley.”

X.- El artículo 19 de la Ley de Propiedad Intelectual, codificación 2006-13 publicada en el Suplemento del R.O. No. 426 de 28 de diciembre de 2006, que dispone:

**“El autor goza del derecho exclusivo de explotar su obra en cualquier forma y de obtener por ello beneficios (...)”.**

XI.- El artículo 20 de la Ley de Propiedad Intelectual, codificación 2006-13 publicada en el Suplemento del R.O. No. 426 de 28 de diciembre de 2006, que dispone:



#### SUBDIRECCIÓN REGIONAL CUENCA

“El derecho exclusivo de explotación de la obra comprende especialmente la facultad de realizar, autorizar o **prohibir**:

a) **La reproducción de la obra por cualquier forma o procedimiento;**

(...)

d) **La importación**

(...)

La explotación de la obra por cualquier forma, y especialmente mediante cualquiera de los actos enumerados en este artículo **es ilícita sin la autorización expresa del titular** de los derechos de autor (...).”

XII.- El artículo 24 de la Ley de Propiedad Intelectual, codificación 2006-13 publicada en el Suplemento del R.O. No. 426 de 28 de diciembre de 2006, que dispone:

*“**El derecho de importación confiere al titular de los derechos de autor la facultad de prohibir la introducción en el territorio ecuatoriano, incluyendo la transmisión analógica o digital, del original o copias de obras protegidas, sin perjuicio de obtener igual prohibición respecto de las copias ilícitas. Este derecho podrá ejercerse tanto para suspender el ingreso del original y copias en fronteras, como para obtener el retiro o suspender la circulación de los ejemplares que ya hubieren ingresado. Este derecho no afectará los ejemplares que formen parte del importación personal.**”*

XIII.- El artículo 288 de la Ley de Propiedad Intelectual, codificación 2006-13 publicada en el Suplemento del R.O. No. 426 de 28 de diciembre de 2006, que dispone:

“La violación de cualquiera de los derechos sobre la propiedad intelectual establecidos en esta Ley, dará lugar al ejercicio de acciones civiles y administrativas; sin perjuicio de las acciones penales a que hubiere lugar, si el hecho estuviere tipificado como delito. (...)”.

XIV.- El artículo 289 de la Ley de Propiedad Intelectual, codificación 2006-13 publicada en el Suplemento del R.O. No. 426 de 28 de diciembre de 2006, que dispone:

“En caso de infracción de los derechos reconocidos en esta Ley, se podrá demandar:

- a) La cesación de los actos violatorios;
- b) El comiso definitivo de los productos u otros objetos resultantes de la infracción, el retiro definitivo de los canales comerciales de las mercancías que constituyan infracción, así como su destrucción; (...).”



#### SUBDIRECCIÓN REGIONAL CUENCA

XV.- El artículo 332 de la Ley de Propiedad Intelectual, codificación 2006-13 publicada en el Suplemento del R.O. No. 426 de 28 de diciembre de 2006, que dispone:

***de** "La observancia y el cumplimiento de los derechos de propiedad intelectual son de interés público. El Estado, a través del Instituto Ecuatoriano de la Propiedad Intelectual, IEPI, ejercerá la tutela administrativa de los derechos sobre la propiedad intelectual y velará por su cumplimiento y observancia".*

XVI.- El artículo 342 de la Ley de Propiedad Intelectual, codificación 2006-13 publicada en el Suplemento del R.O. No. 426 de 28 de diciembre de 2006, dispone:

***"La Corporación Aduanera Ecuatoriana y todos quienes tengan el control del ingreso o salida de mercaderías al o desde el Ecuador, tienen la obligación de impedir que ingresen o se exporten productos que de cualquier modo violen los derechos de propiedad intelectual.***

*Si a petición de parte interesada no impidieren el ingreso o exportación de tales bienes, serán considerados cómplices del delito que se cometa, sin perjuicio de la sanción administrativa que corresponda.*

*Cuando impidieren, de oficio o a petición de parte, el ingreso o exportación de cualquier producto que viole los derechos de propiedad intelectual, lo pondrán en conocimiento mediante informe pormenorizado al Presidente del IEPI, quien en el término de cinco días confirmará o revocará la medida tomada. Confirmada la medida, los bienes serán puestos a disposición del fiscal competente.*

*Si la Corporación Aduanera Ecuatoriana o cualquier otro funcionario competente se hubiere negado a tomar la medida requerida o no se hubiere pronunciado en el término de tres días, el interesado podrá recurrir directamente, dentro de los tres días, posteriores, al Presidente del IEPI para que la ordene. (...)"*

*Nota: Lo resaltado y subrayado no pertenece al texto original de las normas transcritas.*

XVII.- El artículo 216 de la Ley de Propiedad Intelectual, codificación 2006-13 publicada en el Suplemento del R.O. No. 426 de 28 de diciembre de 2006, que dispone:

***"El derecho al uso exclusivo de una marca se adquirirá por su registro ante la Dirección Nacional de Propiedad Industrial. La marca debe utilizarse tal cual fue registrada (...)"***



#### SUBDIRECCIÓN REGIONAL CUENCA

XVIII.- El artículo 217 de la Ley de Propiedad Intelectual, codificación 2006-13 publicada en el Suplemento del R.O. No. 426 de 28 de diciembre de 2006, que dispone:

"El registro de la marca confiere a su titular el derecho de actuar contra cualquier tercero que la utilice sin su consentimiento y, en especial realice, con relación a productos o servicios idénticos o similares para los cuales haya sido registrada la marca, alguno de los actos siguientes:

a) Usar en el comercio un signo idéntico o similar a la marca registrada, con relación a productos idénticos o similares a aquellos para los cuales se la ha registrado, cuando el uso de ese signo pudiese causar confusión o producir a su titular un daño económico o comercial, u ocasionar una dilución de su fuerza distintiva. (...)

(...)

c) Importar o exportar productos con la marca; (...)"

XIX.-El artículo 219 de la Ley de Propiedad Intelectual, codificación 2006-13 publicada en el Suplemento del R.O. No. 426 de 28 de diciembre de 2006, que dispone:

"El derecho conferido por el registro de la marca no concede a su titular la posibilidad de prohibir el ingreso al país de productos marcados por dicho titular, su licenciatarío o alguna otra persona autorizada para ello, que hubiesen sido vendidos o de otro modo introducidos lícitamente en el comercio nacional de cualquier país."

XX.- El artículo 76, numeral 2 de la Constitución de la República del Ecuador establece que en todo proceso en el que se determinen derechos y obligaciones de cualquier orden, se asegurará el derecho al debido proceso, que incluye, entre otras garantías básicas la presunción de la inocencia de toda persona, y será tratada como tal, mientras no se declare su responsabilidad mediante resolución firme o sentencia ejecutoriada.

XXI.- La Resolución No. 09-130 P-IEPI de 11 de marzo de 2009, emitida con el fin de agilizar la administración de los trámites de su competencia y al amparo de lo dispuesto en el Art. 55 del Estatuto del Régimen Jurídico Administrativo de la Función Ejecutiva, el Presidente del IEPI, Ab. Andrés Ycaza resolvió:

*"Artículo No. 1.-Delegar a la Dra. Jamieth Susana Vázquez Zambrano, Subdirectora Regional del Instituto Ecuatoriano de la Propiedad Intelectual-IEPI- de Cuenca, la atribución de ordenar medidas en frontera, en la Sierra Sur y Regional Oriental, según lo establecido en el Art. 351, literal f), de la Codificación de la Ley de Propiedad Intelectual, y en los términos previstos en el artículo 342, incisos tercero, cuarto y quinto, del mismo cuerpo legal, así como la atribución de sustanciar y resolver los recursos de reposición que lleguen a interponerse en tales casos."*



## SUBDIRECCIÓN REGIONAL CUENCA

*Artículo 2.-La presente resolución entrará en vigencia a partir de la notificación a la funcionaria designada, sin perjuicio de su publicación en el Registro Oficial.*

(...)." "

### ANÁLISIS Y CONCLUSIÓN:

Analizados todos los antecedentes remitidos por el Servicio Nacional de Aduana del Ecuador, la base de datos del IEPI y la normativa legal vigente y aplicable, se determina que existen elementos suficientes que permiten advertir que se han vulnerado derechos de propiedad intelectual, relacionados con los personajes MARIO BROSS (y todas sus estrellas tales como Luigi, la Princesa Peach, Toad, Bowser, etc) , ANGRY BIRDS, YOSHI y LOS PITUFOS que gozan de protección mundial por derecho de autor mediante la importación de: alcancías tipo Angry Birds, que incluso, a decir del mandatario del titular marcario, no le pertenecen ni habrían sido fabricados bajo licencia ni autorización alguna, en consecuencia serían imitaciones, figuras de Mario Bross con alas, sets de muñecos Mario Bross varios modelos, peluches pequeños con la figura de Yoshi, juegos Mario Bross, sets de figuras de juego Mario Bross de colección, una caja amarilla marca Futura con 12 cajas individuales que contienen muñecos de los personajes del juego Mario Bross, peluches grandes tipo Mario Bross, juegos de llaveros de los pitufos que reproducen las imágenes de dichos personajes, sin las debidas autorizaciones; y de la marca SONY mediante la importación de Carcasas para PSP color negra SONY, Set de audífonos para control remoto SONY, Cable para audífono color blanco SONY, memoria para Play Station 2 SONY, mercadería que, al decir del mandatario de la compañía titular de los derechos marcarios, estos productos no habrían sido fabricados bajo licencia ni autorización alguna, en consecuencia serían imitaciones.

Por las razones expuestas y en ejercicio de la atribución a mí delegada, prevista en el tercer párrafo del artículo 342 de la Codificación de la Ley de Propiedad Intelectual **confirmando la medida tomada** por el Servicio Nacional de Aduana del Ecuador, con sede en Cuenca, respecto de las Carcasas para PSP color negra SONY, Set de audífonos para control remoto SONY, Cable para audífono color blanco SONY, memoria para Play Station 2 SONY, Alcancía tipo Angry Birds, Figura de Mario Bross con alas, Set de muñecos Mario Bross varios modelos, Peluche pequeño con figura de Yoshi Juego Mario Bross, Set de figuras de juego Mario Bross de colección, Caja amarilla marca Futura con 12 cajas individuales que contienen muñecos de los personajes del juego Mario Bross, Peluche Grande tipo Mario Bross, juego de llaveros de los pitufos varios. **En consecuencia, los mismos deberán ser puestos a disposición del fiscal competente para los fines de lev.**



#### SUBDIRECCIÓN REGIONAL CUENCA

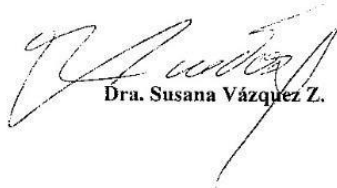
En el caso de la mercadería identificada con la marca Nintendo Wii consistente en **Control blanco para Nintendo Wi (en el que consta la palabra SHIRO), Volante para Nintendo Wii, Control Rojo para Nintendo Wii**, esta autoridad administrativa **no puede confirmar o revocar la medida tomada por la SENAE** debido a que como se señaló en la parte motiva del presente acto, no cuenta con los suficientes medios probatorios para el efecto, consistentes en un informe pormenorizado respecto a la originalidad o no de los productos, o con el pronunciamiento del titular marcario sobre este mismo tema.

El presente Acto Administrativo es susceptible de los recursos establecidos en el Art. 357 de la Ley de Propiedad Intelectual y en el Estatuto del Régimen Jurídico y Administrativo de la Función Ejecutiva, dentro de los plazos señalados para el efecto.

Sin perjuicio de las facultades que tiene el IEPI, contempladas en la Ley de Propiedad Intelectual, en virtud de que este acto constituye un acto administrativo complejo, por el que, de conformidad con el artículo 342 de la Ley de Propiedad Intelectual, el IEPI revoca y confirma la medida de frontera adoptada por el SENAE, generada del Aforo Físico de las mercancías del importador, se dispone a la SENAE notificar a las partes interesadas, en particular al consignatario y al titular de los derechos, con copia a esta Institución, para lo fines legales pertinentes.

Se señala casillero judicial No.786, ubicado en la Corte Provincial del Azuay.

Muy atentamente,

  
Dra. Susana Vázquez Z.







**Oficio Nro. SENA-E-DDP-2013-0087-OF**

**Puerto Bolívar, 11 de junio de 2013**

**Asunto:** Consulta mercancías (artesanías)

Señorita  
Diana Carolina Celi Altamirano  
**Subdirectora**  
**INSTITUTO ECUATORIANO DE PROPIEDAD INTELECTUAL**  
En su Despacho

De mi consideración:

Permitame extender un cordial saludo. Por medio del presente le hago conocer y le consulto lo siguiente: El día 07 de abril de 2013 la Unidad de Vigilancia Aduanera de Puerto Bolívar, procedió a retener 41 cartones con artesanías, levantándose el acta de retención provisional Nro. UVAP-OPE-ARP-2013-105. Comparece la señora Susana Alpaca Quispe con RUC 1752100477001 como propietaria de la mercancía retenida, solicitando la devolución de las mismas. Luego de un análisis documental y jurídico, la señora en mención desvirtúa la causa de la retención, por lo que se procede a devolver una parte de las mercancías retenidas; es decir, quedan retenidas 8.082 unidades de muestras de botellas y 4 unidades de jabas/descorchadores (artesanías) que según el informe del Técnico Operador del SENA-E estaría vulnerando propiedad intelectual.

Por los antecedentes expuestos, y de conformidad con el Art 6 de la Resolución N° SENA-E-DGN-2012-0238-RE publicada en el Registro Oficial N° 785 del 10 de septiembre de 2012, solicito comedidamente a usted se sirva a designar a un funcionario a su cargo para que se levante un informe respecto la mercancía retenida para determinar si vulneran o no propiedad intelectual (artesanías). Además, solicito se indique si la señora Susana Alpaca Quispe con RUC 1752100477001 posee los permisos y/o autorización por el IEPI para usar marcas reconocidas, y en caso de ser afirmativo detallar cuáles son esas marcas.

Las mercancías de las cuales se requiere pronunciamiento técnico del IEPI, se encuentran en las bodegas de la Dirección Distrital de Puerto Bolívar del Servicio Nacional de Aduana del Ecuador, ubicadas en la Av. Bolívar Madero Vargas 2710 vía a Puerto Bolívar en la ciudad de Machala.

Sírvase a encontrar en el anexo las fotos de la mercancía antes referida.

Con sentimientos de distinguida consideración.

Atentamente,

Servicio Nacional de Aduana del Ecuador



Oficio Nro. SENAE-DDP-2013-0087-OF

Puerto Bolivar, 11 de junio de 2013

*Documento firmado electrónicamente*

Ing. Luis Alberto Zambrano Serrano  
**DIRECTOR DISTRITAL DE PUERTO BOLIVAR**

Copia:

Señor Abogado  
Gabriel Fernando Ugarte Olvera  
**Abogado Aduanero**

Señora Abogada  
Dunía Bernarda Cordero Peña  
**Asesor Distrital**

Señor  
Daniel Andres Feijoo Perez  
**Asistente de Abogacia**

dafp/gu



*Adriana Cervantes*

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Servicio Nacional de Aduana del Ecuador

Oficio Nro. IEPI-CUE-2013-0001-OF

Cuenca, 17 de junio de 2013

Asunto: Contestación oficio SENA-EDP-2013-0087-OF (Consulta mercancías)

Señor Ingeniero  
Luis Alberto Zambrano Serrano  
**Director Distrital**  
**SERVICIO NACIONAL DE ADUANA DEL ECUADOR**  
En su Despacho

Señor Ingeniero:

De acuerdo a lo solicitado en oficio N. SENA-EDP-2013-0087-OF, de 11 de junio de 2013, debo indicarle que el artículo 342 de la Ley de Propiedad Intelectual establece que:

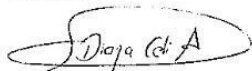
Los Administradores de Aduana y todos quienes tengan el control del ingreso o salida de mercaderías al o desde el Ecuador, tienen la obligación de impedir que ingresen o se exporten productos que de cualquier modo violen los derechos de propiedad intelectual. (...).

Cuando impidieren, de oficio o a petición de parte, el ingreso o exportación de cualquier producto que viole los derechos de propiedad intelectual, le pondrán en conocimiento mediante informe pormenorizado al Presidente del IEPI, quien en el término de cinco días confirmará o revocará la medida tomada. (...) (Énfasis añadido).

En tal sentido, esta autoridad no puede realizar pronunciamiento ni análisis alguno, mientras no cuente con el informe pormenorizado al que se refiere la disposición transcrita. A tal propósito, se recomienda que el procedimiento de adopción de medidas en frontera se realice con sujeción a las normas contenidas en la Codificación de la Ley de Propiedad Intelectual, la Decisión 486 de la Comisión de la Comunidad Andina y el Acuerdo sobre los Derechos de Propiedad Intelectual relacionados con el Comercio ADPIC.

Por lo expuesto, se recomienda dar estricto cumplimiento a lo establecido en la normativa jurídica aplicable a estos casos, para que la autoridad competente del IEPI, una vez que reciba la documentación y el informe pormenorizado indicado, pueda efectuar el análisis correspondiente y adoptar una decisión con respecto al caso.

Atentamente,



Sra. Diana Carolina Celi Altamirano  
**SUBDIRECTORA REGIONAL CUENCA (B)**

Referencias:

- IEPI-CUE-2013-0004-EX





Oficio Nro. SENAE-DDP-2013-0118-OF

Puerto Bolivar, 16 de julio de 2013

**Asunto:** Consulta sobre vulneracion de propiedad intelectual de mercancías de acta 105-2013

Señorita  
Diana Carolina Celi Altamirano  
Subdirectora  
**INSTITUTO ECUATORIANO DE PROPIEDAD INTELECTUAL**  
En su Despacho

De mi consideración:

Mediante oficio N° SENAE-DDP-2013-0087-OF de fecha 11 de junio 2013 se realizó una consulta ante su autoridad, solicitándole indique si las mercancías retenidas (artesanías) por acta N° UVAP-OPE-ARP-2013-105 consistentes en 8.082 unidades de botellas de muestra y 4 unidades de jabas/descorchadores vulneraban propiedad intelectual de marcas reconocidas; así mismo, se solicitó si la señora Susana Allpaca Quispe con RUC 1752100477001 posee los permisos y/o autorizaciones emitidas por el IEPI para usar marcas reconocidas.

En respuesta a esta consulta, se recibió el oficio N° IEPI-CUE-2013-0001-OF de fecha 17 de junio de 2013, suscrito por la srta. Diana Carolina Celi Altamirano en su calidad de Subdirectora Regional Cuenca, en el que manifiesta "...debo indicarle que el artículo 342 de la Ley de Propiedad Intelectual establece que: Los administradores de aduana y todos quienes tengan el control del ingreso o salida de mercancías al o desde el Ecuador, tienen la obligación de impedir que ingresen o se exporten productos que de cualquier modo violen los derechos de propiedad intelectual (...) Cuando impidieren de oficio o a petición de parte, el ingreso o exportación de cualquier producto que viole los derechos de propiedad intelectual, lo pondrán en conocimiento mediante informe pormenorizado al Presidente del IEPI, quien en el término de cinco días confirmará o revocará la medida tomada (...) En tal sentido, esta autoridad no puede realizar pronunciamiento ni análisis alguno, mientras no cuente con el informe pormenorizado al que se refiere la disposición transcrita. A tal propósito, se recomienda que el procedimiento de adopción de medidas en frontera se realice con sujeción a las normas contenidas en la Codificación de la Ley de Propiedad Intelectual, la Decisión 486 de la Comisión de la Comunidad Andina y el Acuerdo sobre derecho de Propiedad Intelectual relacionados con el Comercio ADPIC..."

Al respecto, cabe indicar que la Dirección Distrital de Puerto Bolívar NO REALIZA CONTROL EN FRONTERA, sino en Zona Secundaria de conformidad con los Art 106 y 144 del Código Orgánico de la Producción, Comercio e Inversiones, y que las mercancías objeto de esta consulta fueron retenidas mediante un Operativo en la ciudad de Machala,

Servicio Nacional de Aduana del Ecuador



Oficio Nro. SENAE-DDP-2013-0118-OF

Puerto Bolivar, 16 de julio de 2013

por tanto, resulta necesario un pronunciamiento inmediato por parte de el Instituto Ecuatoriano de Propiedad Intelectual, a fin de darle el destino mas idoneo.

Por lo expuesto, solicito a usted comedidamente se digne pronunciarse respecto de si las 8.082 unidades de botellas de exhibición, y las 4 unidades de jabas/descorchadores retenidos mediante acta N° 105-2013, vulneran derechos de propiedad intelectual?, y si la señora Susana Allpaca Quispe con RUC 1752100477001 posee autorizacion por parte del IEPI para usar a marcas reconocidas?, de ser afirmativo se debe señalar cuales son.

Adjunto el informe pormenorizado requerido por su autoridad.

Con sentimientos de distinguida consideración.

Atentamente,

*Documento firmado electrónicamente*

Ing. Luis Alberto Zambrano Serrano  
**DIRECTOR DISTRITAL DE PUERTO BOLIVAR**

Copia:

Señor Abogado  
Gabriel Fernando Ugarte Olvera  
Abogado Aduanero

Señora Abogada  
Dania Bernarda Cordero Peña  
Asesor Distrital

Señor  
Daniel Andres Feijoo Perez  
Asistente de Abogacia

dafp/gu



Oficio Nro. IEPI-CUE-2013-0004-OF

Cuenca, 25 de julio de 2013

**Asunto:** Contestación al oficio N. SENAE-DDP-2013-0118-OF, de 16 de julio de 2013.

Señor Ingeniero  
Luis Alberto Zambrano Serrano  
Director Distrital  
SERVICIO NACIONAL DE ADUANA DEL ECUADOR  
En su Despacho

En respuesta a su Oficio N. SENAE-DDP-2013-0118-OF, de 16 de julio de 2013, respecto a que si la mercadería retenida mediante acta 105-2013, vulnera derechos de propiedad intelectual, tal como había indicado en días anteriores en la contestación realizada mediante oficio N. IEPI-2013-0001-OF, de 17 de junio de 2013, la autoridad competente para emitir este pronunciamiento es el Director Ejecutivo de la Institución, esto de acuerdo a lo establecido en el artículo 342 de la Ley de Propiedad Intelectual, que indica lo siguiente:

“(…) Cuando impidieren, de oficio o a petición de parte, el ingreso o exportación de cualquier producto que viole los derechos de propiedad intelectual, lo pondrán en conocimiento mediante informe pormenorizado al **Presidente del IEPI**, quien en el término de cinco días confirmará o revocará la medida tomada. Confirmada la medida, los bienes serán puestos a disposición de un juez de lo penal”.  
**(Énfasis añadido)**

En este sentido, al no tener competencia sobre este pronunciamiento, me abstengo de emitir criterio alguno sobre esta consulta.

De igual forma, con respecto a la consulta de que si la señora Susana Allpaca Quispe, con RUC 1752100477001 posee autorización del IEPI para usar las marcas indicadas en el informe, debo indicar al respecto que el Instituto Ecuatoriano de la Propiedad Intelectual-IEPI-, no concede autorizaciones o licencias con respecto al uso de marcas, debido a que esto es de común acuerdo entre las partes.

Cabe indicar que la finalidad del IEPI, de acuerdo a lo establecido en el artículo 3 de la Ley de Propiedad Intelectual, es “(…) propiciar, promover, fomentar, prevenir, proteger y defender a nombre del Estado Ecuatoriano, los derechos de propiedad intelectual reconocidos en la presente Ley y en los tratados y convenios internacionales (...)”. Así mismo, de acuerdo a lo establecido en el artículo 280 de la misma ley, claramente se establece que son los titulares de las marcas, los que podrán conceder autorizaciones o licencias a terceros para la explotación o uso de las mismas, mediante contratos escritos entre las partes, y es facultativo la inscripción de estos en el IEPI, razón por la cual mal podría informar sobre este aspecto.

Atentamente,

Srta. Diana Carolina Celi Altamirano  
SUBDIRECTORA REGIONAL CUENCA (B)

Referencias:  
- IEPI-CUE-2013-0006-EX





Providencia Nro. SENAE-DDC-2014-1219-PV

Cuenca, 14 de noviembre de 2014

Providencia Decomiso Acta UVAC-OPE-AA-2014-146.  
SERVICIO NACIONAL DE ADUANA DEL ECUADOR, DIRECCIÓN DISTRITAL CUENCA.- Cuenca, a los 14 días del mes de Noviembre de 2014, a las 12h40 VISTOS.- En virtud de Memorando N° SENAE-UVAC-2014-0229-M, de fecha 07 de Julio del 2014, se pone a mi conocimiento el Acta de Aprehesión Nro. UVAC-OPE-AA-2014-146, de fecha 07 de Julio del 2014, suscrito por el señor Inspector, Manuel Acosta, Inspector Francis Saaco y los Vigilantes: Macariel Marquez, Luis Cáceres, Toms Cueva, quienes manifiestan: "...el día 05 de Julio del 2014, siendo aproximadamente las 21h30 se realiza la inspección del vehículo de transporte público de la Cooperativa Azuay, Disco Nro. 41 de placas AAA1557, conducido por el ciudadano Néstor Patino Danilo Ramón con C.C. 0104444658, al revisar la bodega se encontró un bulto conteniendo prendas de vestir de procedencia extranjera amparadas en las guía Nro. 0136763 con destinatario el Sr. Ortega Quevedo; al solicitarle los documentos que acrediten el legal ingreso al país de estas mercancías, este sujeto manifiesta que no disponía de ningún documento; se le explica al Sr. Conductor que la movilización de mercancías extranjeras dentro de la zona secundaria sin el documento que acredite la legal tenencia de las mismas, es una infracción aduanera tipificada en el Código Orgánico de la Producción Comercio e Inversiones por tal razón y en virtud de que no se justificó el legal ingreso al país de las señaladas mercancías, personal de esta Unidad procedió con la aprehensión de las mercancías conforme lo establece el artículo 211 literal b), por existir presunciones del cometimiento de una infracción aduanera tipificada en el Art. 177 literal b) del Código Orgánico de la Producción Comercio e Inversiones. Las mercancías fueron trasladadas por personal de esta Unidad hasta las Instalaciones del SENAE-Cuenca, ubicadas en los calles: Plazón 2-08 y Gál Ramírez Dávalos en donde se procedió a realizar el respectivo inventario y se constata que se trata de prendas de vestir de procedencia extranjera las mismas que no cuentan con las regulaciones establecidas en el Reglamento INEN-013. Seguidamente las mercancías son ingresadas en procedimiento de cadena de custodia a las bodegas de mercancías aprehendidas a la Dirección Distrital Cuenca del Servicio Nacional de Aduana del Ecuador, conforme lo establece el artículo 176 del Código Orgánico de la Producción Comercio e Inversiones. Posteriormente se procede a elaborar el presente parte de aprehensión para poner a órdenes de la Dirección Distrital SENAE-Cuenca". Por lo que, previo a proveer lo que corresponda en derecho, el suscrito Director Distrital considera: PRIMERO: 1.1.- Consta el Memorando Nro. SENAE-M-EC-2014-0316-M de fecha 18 de Julio del 2014, suscrito por el técnico operador Ing. Pablo Andrés González Suquimaga, quien informa que la mercancía consiste en: 1 bulto que contiene: 84 unidades correspondiente a camisetas deportivas, sin marca, todas las mercancías son de procedencia extranjera, siendo el estado de las mercancías referidas el de nuevo, cuyo valor referencial asciende a USD. \$ 466,20 (CUATROCIENTOS SESENTA Y SEIS DOLARES DE LOS ESTADOS UNIDOS DE NORTEAMÉRICA CON 20 CÉNTAVOS) e indica que la mercancía no cumple con la Norma INEN de etiquetado, en este caso puntual se encuentra desprovista de: a) Registro de Importador del Ministerio de Industrias y Productividad, b) Certificado INEN del Instituto Ecuatoriano de Normalización, y, c) Etiquetado y rotulado, incumpliendo lo dispuesto en el Reglamento Técnico Normativo RTE INEN013. Presumiéndose además de la vulneración de derechos de Propiedad Intelectual de todos los nombres. Que conforme a lo detallado en el Acta de Aprehesión Nro. UVAC-OPE-AA-2014-146, no existe ningún documento que ampare la propiedad de las mercancías, y en los cuales se pueda constatar la legalidad de la mercancía cumpliendo con todas las formalidades aduaneras, por tanto, esta Administración Aduanera considera no tener la suficiente información de los propietarios, los consignatarios y/o consignantes. 1.2.- Que, desde la aprehensión realizada el 05 de Julio del 2014 hasta la presente fecha no ha existido ninguna persona que haya reclamado o solicitado su devolución y/o justificado la propiedad de la totalidad de las mercancías aprehendidas en el Parte de Aprehesión Nro. UVAC-OPE-PA-2014-146.

Servicio Nacional de Aduana del Ecuador

Dirección Distrital de Cuenca - Elía Tur 2-08 y Gál Ramírez Dávalos-010107) PBX: (07) 2607900

www.aduana.gob.ec

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Providencia Nro. SENAE-DDC-2014-1219-PV

Cuenca, 14 de noviembre de 2014

1.3.- Que se ha configurado el vencimiento del plazo que concede el Código Orgánico de la Producción, Comercio e Inversiones para presentar la documentación que justifique y acredite el origen lícito de las mercancías. SEGUNDO: 2.1.- Que, el Código Orgánico de la Producción Comercio e Inversiones establece: Art. 123.- **"Decomiso Administrativo.- El decomiso administrativo es la pérdida de la propiedad de las mercancías por declaratoria de la servidura o el servidor a cargo de la dirección distrital correspondiente, en resolución firme o ejecutoriada, dictada en los siguientes casos: a).- Mercancías rezagadas, inclusive en la zona primaria, cuando se desconoce su propietario, consignatario y consignante."** Art. 114.- **Extinción de la Obligación Tributaria.- La obligación tributaria aduanera se extingue por g) Decomiso administrativo o judicial de las mercancías, declarado por el Director Distrital del SENAE, competente de conformidad con lo dispuesto en el Art. 218.- Competencias de las Direcciones Distritales.- La servidura o el servidor a cargo de las direcciones distritales tendrá las siguientes atribuciones: i) Declarar el decomiso administrativo y aceptar el abandono expreso de las mercancías y adjudicarlas cuando proceda, conforme lo previsto en este Código y su reglamento.** 2.2.- Que, el Ecuador es un Estado Constitucional de Derechos y Justicia, de acuerdo al Art. 1 de la Constitución de la República del Ecuador en concordancia con el Art. 169 *ibidem* que indica: "(...) No se sacrificará la justicia por la sola omisión de formalidades". 2.3.- Que, el Art. 85, numeral 1 de la Constitución de la República del Ecuador señala: "Las políticas públicas y la prestación de bienes y servicios públicos se orientarán a hacer efectivos el buen vivir y todos los derechos, y se formularán a partir del principio de solidaridad." En virtud de lo expuesto, el suscrito Director Distrital de Cuenca del Servicio Nacional de Aduana del Ecuador, en uso de las atribuciones establecidas en el literal a), i) y r) del Código Orgánico de la Producción, Comercio e Inversiones se DISPONE: 1) Declarar las referidas mercaderías como MERCADERÍA REZAGADA, por no ser posible hasta la presente fecha determinar su propietario o consignatario, y consiguientemente el DECOMISO ADMINISTRATIVO de: 1) bulto que contiene 84 unidades correspondiente a camisetas deportivas, sin marca, todas las mercancías son de procedencia extranjera, siendo el estado de las mercancías referidas el de nuevo, por cuanto no cumplen con la Norma RTE INEN 013. 2) Declarar extinguida la Obligación Tributaria Aduanera, en lo que respecta al cobro de los respectivos tributos de las mercancías detalladas en el numeral anterior, conforme lo señalado en el Art. 114 del Código Orgánico de la Producción, Comercio e Inversiones. Iniciar el proceso de adjudicación gratuita de la mercancía de acuerdo a la Resolución N° SENAE-DGN-2012-238-RE publicada en el Registro Oficial N° 785 del 10 de septiembre de 2012; y su reforma contenida en la Resolución N° SENAE-DGN-2014-0116 de fecha 17 de febrero de 2014, suscrita por el Director General SENAE. 3) Previo a iniciar el procedimiento de adjudicación gratuita de las 84 camisetas deportivas de acuerdo a la Resolución N° SENAE-DGN-2012-238-RE suscrita por el Director General de la SENAE, de fecha 03 de Julio del 2012, publicada en el Registro Oficial N° 0785, dispongo comunicar al Instituto Ecuatoriano de Propiedad Intelectual I.E.P.I, lo manifestado mediante el Memorando No SENAE-APFC-2014-0316-M de fecha 18 de Julio del 2014, en razón de existir presunción de vulneración de los derechos de propiedad intelectual, respecto de la mercancía referida contenida en el Acta de Aprehesión Nro. UAC-OPE-AA-2014-146. 4) Se deja a salvo el derecho que le asiste al Servicio Nacional de Aduana del Ecuador en iniciar el procedimiento sancionatorio en contra de quienes se determine que incurrieron con movilizar mercancía extranjera dentro de la zona secundaria sin documentos que acrediten su legal importación, tenencia o adquisición. 5) Hagase saber el contenido de esta providencia al Jefe Guardalimcén de esta Dirección Distrital, quien es el custodio de la mercancía detallada en el acta de aprehensión, comuníquese a la Secretaría General del I.E.P.I (Subdirección Regional de Cuenca), por cualquiera de los medios que establece el Art. 107 del Código Tributario en concordancia al Art. 219 del COPCI, teniéndose como medio de

Servicio Nacional de Aduana del Ecuador

Dirección Distrital de Cuenca - Elna Llac 2-08 y Gil Ramirez Dávalos (010107) PBX: (07) 2807900

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Oficio Nro. IEPI-CUE-2015-0004-OF

Cuenca, 23 de marzo de 2015

Asunto: Oficio NO. 014-2015-SRC-IEPI-OF

Ingeniero  
Christian Alfredo Ayora Vasquez  
**Director Distrital Cuenca**  
**SERVICIO NACIONAL DE ADUANA DEL ECUADOR**  
En su Despacho

De mi consideración:

En atención a lo dispuesto en la providencia No. SENA-EDC-2014-1219-PV, de 14 de noviembre del 2014, me permito poner en su conocimiento lo siguiente:

La Codificación a la Ley de propiedad intelectual, en el Título I denominado: "DE LA PROTECCION Y OBSERVANCIA DE LOS DERECHOS DE PROPIEDAD INTELECTUAL", señala en el art. 288 que: *La violación de cualquiera de los derechos sobre la propiedad intelectual establecidos en esta Ley, dará lugar al ejercicio de acciones civiles y administrativas, sin perjuicio de las acciones penales a que hubiere lugar, si el hecho estuviese tipificado como delito...*"

En lo que respecta a las acciones administrativas, la Codificación a la ley de Propiedad Intelectual contempla únicamente dos posibilidades en las que el Instituto de Propiedad Intelectual debe asumir competencia, la primera, es la llamada tutela administrativa, misma que puede ser de oficio o a petición de parte, con el fin de evitar y reprimir violaciones a los derechos de propiedad intelectual, y la segunda, que es la llamada medida en frontera, misma que tiene por objetivo evitar que las mercancías que presuntamente vulneran un derecho de propiedad intelectual, ingresen o salgan del país, y que está a cargo del Servicio Nacional de Aduana.

El principio de legalidad en materia de Derecho Administrativo consiste en que, en Derecho Público solo se puede hacer lo que expresamente se encuentra permitido por la ley, por ende, si la codificación a Ley de Propiedad Intelectual establece claramente la competencia que tiene el IEPI en el ámbito administrativo para reprimir y evitar sanciones administrativas a través de la tutela administrativa para la cual establece un procedimiento constante en el reglamento respectivo, o, para evitar el ingreso o salida de mercadería, no se podría solicitar que asuma otra competencia que no esté prevista expresamente en la normativa aplicable.

La competencia es la capacidad funcional genérica derivada de la Constitución o la ley, que le otorga el Estado a un funcionario, para que pueda actuar, dentro de un marco determinado. Al respecto el maestro Wladimir Villalba Vega, asimila a la competencia con la capacidad, pudiendo ésta a su vez entenderse como la aptitud o suficiencia para realizar una cosa o como la aptitud legal para ser sujeto de derechos y obligaciones. Cabe resaltar que la regla general es que toda persona es capaz, excepto aquella a la que la ley la declare incapaz, es decir la capacidad es la regla y la incapacidad es la excepción, pero

Oficio Nro. IEPI-CUE-2015-0004-OF

Cuenca, 23 de marzo de 2015

en el caso de la competencia es todo lo contrario, la incapacidad es la regla y la capacidad la excepción; pues la competencia viene de la Constitución o la ley, no de la voluntad del funcionario, porque ésta es una aptitud oficial de Derecho Público.

Por lo expuesto, en virtud de que la normativa aplicable no contempla expresamente la competencia que debe asumir el IEPI para pronunciarse en los trámites de decomiso administrativo, respecto a si la mercadería aprehendida vulnera o no un derecho de propiedad intelectual, me veo en la imposibilidad de pronunciarme al respecto

Con sentimientos de distinguida consideración.

Atentamente,

*Documento firmado electrónicamente*

Srta. Dra. Jamieth Susana Vazquez Zambrano  
**SUBDIRECCIÓN REGIONAL CUENCA**



Oficio Nro. SENAE-DDC-2015-0244-OF

Cuenca, 21 de mayo de 2015

**Asunto:** PRESUNCIÓN DE VULNERACIÓN DE DERECHOS DE PROPIEDAD INTELECTUAL DE LAS MARCAS: TOUS, CARTIER, BULGARY, TORY BURCH, CHANEL, MICHEL KORS, YSL, DIO, HERMES, TIFANNY, VA&C, GUCCI, MANKINS. (Acta de Aprehensión No. UVAC-OPE-AA-2013-006)

Señorita Doctora  
Janileth Susana Vazquez Zambrano  
Subdirectora Regional  
INSTITUTO ECUATORIANO DE PROPIEDAD INTELECTUAL  
En su Despacho

De mi consideración:

A través del presente me permito poner en su conocimiento las novedades encontradas dentro de un caso de Control Posterior efectuado por miembros de la Unidad de Vigilancia Aduanera, en fecha 12 de marzo del año 2013, que resultó en la aprehensión de **2 maletas tipo equipaje con bisutería** al señor **MARIO ESTEBAN ÑIGUEZ CÁRDENAS** con número de cédula 0102304185; informe que remito por presumir se estarían violentando derechos de Propiedad Intelectual de varias marcas, por cuanto la mercancía aprehendida lleva grabada los nombres de las siguientes marcas: Tous, Cartier, Bulgary, Tory Burch, Chanel, Michel Kors, Ysl, Dio, Hermes, Tiffany, Va&C, Gucci, Mankins.

#### ANTECEDENTES

Mediante Memorando No. SENAE-UVAC-2013-0024-M de fecha 13 de marzo del 2013, se remite para conocimiento de la Dirección Distrital de Cuenca del Servicio Nacional de Aduana del Ecuador, el Parte de Aprehensión No. UVAC-OPE-PA-2013-006 y Acta de Aprehensión No. UVAC-OPE-AA-2013-006. Dentro del Acta de Aprehensión No. UVAC-OPE-AA-2013-006 (**Anexo No. 1**) remitido se relatan las circunstancias de la Aprehensión, documento en el que en su parte pertinente se indica, entre otras cosas, lo siguiente: *"El día martes 12 de marzo del 2013, a las 19h00 aproximadamente, luego de recibir la denuncia vía Movitalk (sistema de comunicación del 1800 Delito Aduana), se organizó el operativo para localizar el objetivo y confirmar la denuncia. ... 20h10 aproximadamente, se localiza y se toma contacto personal con el objetivo, y luego de explicarle que se trata de un control rutinario de parte de la Aduana del Ecuador, por lo que necesitamos revisar el equipaje, el ciudadano en cuestión, me entrega el pasaporte constatando que se trata del señor ÑIGUEZ CÁRDENAS MARIO ESTEBAN, y al preguntarle el contenido del equipaje, me manifiesta que contiene efectos personales y Bisutería, para lo cual me entrega un documento que dice ser la liquidación con la cual ha pagado los impuestos de la Bisutería, ante lo cual se le solicita que nos acompañe hasta las instalaciones de nuestra unidad... Al revisar los equipajes encontramos lo siguiente: - En uno de los equipajes una funda plástica conteniendo bisutería, y una mochila color negro dentro del cual se encuentran más fundas plásticas conteniendo de igual manera bisutería. - En el otro equipaje de igual manera una funda plástica conteniendo bisutería, y una mochila color negro dentro del cual se encuentran más fundas plásticas conteniendo de igual manera bisutería. - En el otro equipaje al ser revisado encontramos solo efectos personales. - En la mochila color rojo, encontramos una funda pequeña plástica*

Servicio Nacional de Aduana del Ecuador



Oficio Nro. SENA-DDC-2015-0244-OF

Cuenca, 21 de mayo de 2015

*conteniendo de igual manera bisutería y otros efectos personales. ... "*

#### AFECTACIÓN A MARCAS

Ante la evidencia de una posible afectación a Derechos de Propiedad Intelectual, en un proceso de Control Posterior efectuado por el Servicio Nacional de Aduana del Ecuador, a través de efectivos de la Unidad de Vigilancia Aduanera, una vez en conocimiento del expediente, el suscrito efectuó las siguientes gestiones:

1.- Esta Dirección Distrital de Cuenca del Servicio Nacional de Aduana del Ecuador, solicitó a la Subdirección Regional de Cuenca del Instituto Ecuatoriano de Propiedad Intelectual (IEPI), mediante Oficio No. SENA-DDC-2014-1040-OF de fecha 23 de diciembre del 2014, información de las marcas de las que se presume vulneración de derechos, a fin de poner a su conocimiento el caso que ahora expongo ante autoridad competente. La solicitud efectuada fue respecto de las siguientes marcas: TOUS, CARTIER, BULGARY, TORY BURCH, CHANEL, MICHEL KORS, YSL, DIO, HERMES, TIFANNY, VA&C, GUCCI, MANKINS

2.- En fecha 02 de marzo del 2015, mediante Oficio No. IEPI-CUE-011-2015, y signado por el Sistema de Gestión Documental Quipux con el número SENA-DDC-2015-0582-E, la Subdirección Regional de Cuenca del Instituto Ecuatoriano de Propiedad Intelectual (IEPI), remite a esta Dirección Distrital datos suficientes para la localización de los solicitantes o apoderados de las siguientes marcas: TOUS, CARTIER, BULGARI, CHANEL, MICHAEL KORS, YSL, DIOR, HERMES y GUCCI.

3.- El suscrito procede a informar sobre el caso y solicitar el pronunciamiento de las marcas a fin de determinar o establecer si efectivamente la mercancía aprehendida corresponde a mercancía que vulnera sus derechos; pronunciamientos requeridos mediante oficios No. SENA-DDC-2015-0119-OF (CARTIER Y CHANNEL); SENA-DDC-2015-0120-OF (TOUS); SENA-DDC-2015-0121-OF (MICHAEL KORS Y DIOR); SENA-DDC-2015-0122-OF (BULGARY Y); SENA-DDC-2015-0123-OF (HERMES); SENA-DDC-2015-0124-OF (GUCCI).

4.- Mediante escrito signado por el Sistema de Gestión Documental Quipux con el número SENA-JDAR-2015-1180-E (Anexo No. 2) comparece el Dr. Luis Marín Tobar Subía, en representación de HERMES INTERNATIONAL, quien solicita sea enviados por medios electrónicos, fotografías de las muestras de bisutería aprehendida; por lo que en atención a su solicitud esta autoridad mediante Oficio No. SENA-DDC-2015-0149-OF (Anexo No. 3) procede a remitir las fotografías solicitadas, documento debidamente notificado a la dirección del Sistema de Gestión Documental Quipux señalada.

5.- Comparece la Dra. María Cecilia Romoleroux Armijos, en calidad de Apoderada Especial de las siguientes marcas:

- TOUS: Mediante escrito No. SENA-JDAR-2015-1362-E (Anexo No. 4)
- BULGARI: Mediante escrito No. SENA-JDAR-2015-1363-E (Anexo No. 5)
- CHANEL: Mediante escrito No. SENA-JDAR-2015-1364-E (Anexo No. 6)
- GUCCI: Mediante escrito No. SENA-JDAR-2015-1448-E (Anexo No. 7)

Servicio Nacional de Aduana del Ecuador



Oficio Nro. SENAE-DDC-2015-0244-OF

Cuenca, 21 de mayo de 2015

- **TORY BURCH:** Mediante escrito No. SENAE-JDAR-2015-1522-E (Anexo No. 8)

Quien indica que - *pudieron verificar que en efecto el producto retenido al señor MARIO ESTEBAN INIGUEZ CÁRDENAS corresponde a productos falsificados - por lo que a decir de la compareciente, las marcas representadas - están legitimadas para impedir que sin su consentimiento, se importen, mantengan en existencia, y comercialicen productos que incluyan marcas idénticas y/o confundibles con la suya y de solicitar la inmediata destrucción de los bienes retenidos como el en presente caso -.*

#### FUNDAMENTACIÓN LEGAL

El artículo 3 de la Ley de Propiedad Intelectual establece:

*Art. 3. El Instituto Ecuatoriano de la Propiedad Intelectual (IEPI), es el Organismo Administrativo Competente para propiciar, promover, fomentar, prevenir, proteger y defender a nombre del Estado Ecuatoriano, los derechos de propiedad intelectual reconocidos en la presente Ley y en los tratados y convenios internacionales, sin perjuicio de las acciones civiles y penales que sobre esta materia deberán conocerse por la Función Judicial.*

Así mismo el artículo 288 *ibídem* dispone:

*Art. 288. La violación de cualquiera de los derechos sobre la propiedad intelectual establecidos en esta Ley, dará lugar al ejercicio de acciones civiles y administrativas, sin perjuicio de las acciones penales a que hubiere lugar, si el hecho estuviere tipificado como delito. La tutela administrativa de los derechos de propiedad intelectual se regirá por lo previsto en el Libro V de la presente Ley.*

En concordancia de lo expuesto, los artículos 332, 333 y 334 del mismo cuerpo legal rezan:

*Art. 332. La observancia y el cumplimiento de los derechos de propiedad intelectual son de interés público. El Estado, a través del Instituto Ecuatoriano de la Propiedad Intelectual, IEPI, ejercerá la tutela administrativa de los derechos sobre la propiedad intelectual y velará por su cumplimiento y observancia.*

*Art. 333. El IEPI a través de las Direcciones nacionales ejercerá, de oficio o a petición de parte, funciones de inspección, vigilancia y sanción para evitar y reprimir violaciones a los derechos sobre la propiedad intelectual.*

*Art. 334. Cualquier persona afectada por la violación o posible violación de los derechos de propiedad intelectual podrá requerir al IEPI la adopción de las siguientes medidas: a) Inspección; b) Requerimiento de información; y, c) Sanción de la violación de los derechos de propiedad intelectual.*

Por todo lo expuesto, y en consideración a que existen derechos de propiedad intelectual que se

Servicio Nacional de Aduana del Ecuador




Oficio Nro. SENA E-DDC-2015-0244-OF

Cuenca, 21 de mayo de 2015

encontrarian presumiblemente vulnerados en virtud de lo manifestado por los representantes de las marcas; además de que la mercancía aprehendida, en caso de que fuera objeto de comercialización, podría inducir a error y engaño al potencial consumidor, remito el presente informe, a fin de que sea la Autoridad Competente en materia de Propiedad Intelectual quien emita su pronunciamiento y ejercite las acciones legales que considere pertinentes, así mismo se conmina a los representantes de las marcas a comparecer y presentar sus informes y pronunciamientos respectivos ante la misma.

Sin otro particular que comunicar, suscribo.

Atentamente,

  
Ing. Christian Alfredo Ayora Vasquez  
**DIRECTOR DISTRITAL CUENCA**



Referencias:  
- SENA E-DDC-2015-1194-PV

Anexos:  
- Anexo No. 1.zip  
- Anexo No. 2.pdf  
- Anexo No. 3.pdf  
- Anexo No. 4.pdf  
- Anexo No. 5.pdf  
- Anexo No. 6.pdf  
- Anexo No. 8.pdf  
- Anexo No. 7.pdf

Copia:  
Abogada  
Maria Cecilia Romoleroux  
**CORRAL ROSALES CARMIGNANI PEREZ**  
  
Señor Abogado  
Luis Hernán Marín Tobar Subia  
Abogado  
**PEREZ, BUSTAMANTE Y PONCE ABOGADOS**

srva

Servicio Nacional de Aduana del Ecuador

Oficio Nro. IEPI-CUE-2015-0023-OF

Cuenca, 15 de julio de 2015

**Asunto:** Contestación a Oficio No. SENA-DDC-2015-0244-OF

Ingeniero  
Christian Alfredo Ayora Vasquez  
**Director Distrital Cuenca**  
**SERVICIO NACIONAL DE ADUANA DEL ECUADOR**  
En su Despacho

De mi consideración:

Mediante oficio Nro. **SENAE-DDC-2015-0244-OF** de 21 de mayo de 2015, se puso en conocimiento de esta autoridad las novedades encontradas dentro de un caso de Control Posterior efectuado por miembros de la Unidad de Vigilancia Aduanera, en fecha 12 de marzo del año 2013, que resultó en la aprehensión de 2 maletas tipo equipaje con bisutería, de propiedad del señor **MARIO ESTEBAN ÑIGUEZ CÁRDENAS**, por presumir que se estarían violentando derechos de Propiedad Intelectual de titulares de derechos de propiedad intelectual, por cuanto la mercancía aprehendida llevaba grabada las siguientes marcas: **Tous, Cartier, Bulgary, Tory Burch, Chanel, Michel Kors, Ysl, Dio, Hermes, Tiffany, Va&C, Gucci, Mankins.**

Con el objetivo de dar contestación al referido oficio, que en su parte pertinente señala: *"... en consideración a que existen derechos de propiedad intelectual que se encontrarían presumiblemente vulnerados en virtud de lo manifestado por los representantes de las marcas; además de que la mercancía aprehendida, en caso de que fuera objeto de comercialización, podría inducir a error y engaño al potencial consumidor, remito el presente informe, a fin de que sea la Autoridad Competente en materia de Propiedad Intelectual quien emita su pronunciamiento ..."*, esta autoridad administrativa, quien actúa por delegación del Director Ejecutivo del IEPI, contenida en la resolución No. 073-2015-DE-IEPI, tiene a bien exponer lo siguiente:

**NORMATIVA APLICABLE:**

El artículo 1 de la codificación a la Ley de Propiedad Intelectual del Ecuador señala que: *"El Estado reconoce, regula y garantiza la propiedad intelectual adquirida de conformidad con la ley, las decisiones de la Comisión de la Comunidad Andina y los convenios internacionales vigentes en el Ecuador. (...)"*

Asimismo el Art. 3 de la referida Codificación establece que: *"El Instituto Ecuatoriano de la Propiedad Intelectual (IEPI), es el organismo administrativo competente para propiciar, promover, fomentar, prevenir, proteger y defender a nombre del Estado ecuatoriano, los derechos de propiedad intelectual reconocidos en la presente Ley y en*

Oficio Nro. IEPI-CUE-2015-0023-OF

Cuenca, 15 de julio de 2015

*los tratados y convenios internacionales, sin perjuicio de las acciones civiles y penales que sobre esta materia deberán conocerse por la Función Judicial".*

Correlativamente el Art. 342 de la ley de a materia dispone que: *"La Corporación Aduanera Ecuatoriana y todos quienes tengan el control del ingreso o salida de mercaderías al o desde el Ecuador, tienen la obligación de impedir que ingresen o se exporten productos que de cualquier modo violen los derechos de propiedad intelectual.*

*Si a petición de parte interesada no impidieren el ingreso o exportación de tales bienes, serán considerados cómplices del delito que se cometa, sin perjuicio de la sanción administrativa que corresponda.*

*Cuando impidieren, de oficio o a petición de parte, el ingreso o exportación de cualquier producto que viole los derechos de propiedad intelectual, lo pondrán en conocimiento mediante informe pormenorizado al Presidente del IEPI, quien en el término de cinco días confirmará o revocará la medida tomada (...)"*

Finalmente, el Art. 332 de la codificación señala que: *"La observancia y el cumplimiento de los derechos de propiedad intelectual son de interés público. El Estado, a través del Instituto Ecuatoriano de la Propiedad Intelectual, IEPI, ejercerá la tutela administrativa de los derechos sobre la propiedad intelectual y velará por su cumplimiento y observancia".*

#### CONCLUSIONES:

1.-El IEPI, como autoridad Nacional Competente en materia de Propiedad Intelectual cuenta con facultades claramente determinadas en la Ley de Propiedad Intelectual y su reglamento, así como en las normas de carácter comunitario (Decisiones Andinas) e internacional (ADPIC).

2.-Las medidas en frontera, como su nombre lo indica, son actuaciones que realizan las autoridades aduaneras respecto de los productos que se importan o exportan dentro del aforo aduanero; una vez que estos se han exportado o nacionalizado deben comercializarse libremente, salvo excepciones dadas por las características y propiedades de los bienes, como en el caso de los medicamentos, mismos que deben pasar por una revisión sanitaria, previo a su comercialización.

3.-Cuando un producto ya se encuentra en territorio ecuatoriano y ya ha pasado por todos los filtros aduaneros, es decir cuando ya se ha nacionalizado, se presume su legalidad, sin embargo, la mercadería podría ser falsificada; en ese supuesto la Ley de Propiedad Intelectual establece que el titular de la marca registrada que se sienta perjudicado, es quien deberá presentar las acciones correspondientes para impedir su circulación, venta, etc.



Oficio Nro. IEPI-CUE-2015-0023-OF

Cuenca, 15 de julio de 2015

Por todo lo expuesto, queda claro que el IEPI no puede pronunciarse respecto al pedido realizado por la SENAE, por tratarse de un caso de Control Posterior efectuado por miembros de la Unidad de Vigilancia Aduanera, ya que la mercadería importada y nacionalizada por el Señor MARIO ESTEBAN INIGUEZ CARDENAS, fue aprehendida en un operativo realizado en el territorio nacional como parte de un control rutinario y que tuvo como origen una denuncia telefónica al 1800 delito Aduana.

Con sentimientos de distinguida consideración.

Atentamente,

*Documento firmado electrónicamente*

Srta. Dra. Jamileth Susana Vazquez Zambrano  
SUBDIRECTORA REGIONAL



Year 2016



Oficio Nro. SENAE-DDC-2016-0075-OF

Cuenca, 02 de febrero de 2016

**Asunto:** Se pone en conocimiento posible vulneración de derechos de propiedad intelectual de mercancía de Acta de Aprehesión N° UVAC-OPE-AA-2015-017

Señorita Doctora  
Jamileth Susana Vazquez Zambrano  
**Subdirectora Regional**  
**INSTITUTO ECUATORIANO DE PROPIEDAD INTELECTUAL.**  
En su Despacho

De mi consideración:

Reciba un cordial saludo de mi parte, en virtud de lo dispuesto mediante providencia N° SENAE-DDC-2016-0151-PV, de fecha 01 de Febrero de 2016, la cual adjunto al presente y de acuerdo a lo dispuesto en el Art. 6 de la Resolución No. SENAE-DGN-2012-0238-RE suscrita por el Economista Xavier Cárdenas Moncayo – Director General que ordena: "...**Artículo 6: Sospecha de vulneración de derechos de propiedad intelectual.-** Si posterior a la aceptación del abandono expreso, declaratoria de abandono definitivo, decomiso, se detectare que tales mercancías vulneran de cualquier forma derechos de propiedad intelectual, se pondrá este hecho en conocimiento del Instituto Ecuatoriano de Propiedad Intelectual - IEPI cuyo pronunciamiento decidirá el tratamiento que debe dársele a las mercancías..."; me permito poner en su conocimiento la posible vulneración de derechos de propiedad intelectual de la mercancía descrita en el Acta de Aprehesión N° UVAC-OPE-AA-2015-017 a excepción de los ítems N° 28, 29, 30, 31, 32, 33 y 34, a fin que se determine el tratamiento que debe darse a la mercancía antes especificada.

Para su mayor ilustración adjunto al presente remito copia certificada del Acta de Aprehesión N° UVAC-OPE-AA-2015-017.

Solicitando de la manera más cordial se remita el informe requerido en el término de 7 días a fin de poder continuar con el trámite respectivo.

Con sentimientos de distinguida consideración.

Atentamente,

  
Ing. Diego Fernando Diverso Aguirre  
**DIRECTOR DISTRITAL CUENCA, SUBROGANTE**

Anexos:  
- acta\_de\_aprehension\_nº\_uvac-ope-aa-2015-017.pdf  
- senae-ddc-2016-0151-pv.pdf

mmcc



Servicio Nacional de Aduana del Ecuador

Dirección Distrital de Cuenca – Elía Liut 2-08 v Gil Ramírez Dávalos (010107) PBX: (07) 2807900



SERVICIO NACIONAL DE ADUANA DEL ECUADOR  
 DIRECCIÓN DISTRITAL DE CUENCA  
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Providencia Nro. SENAE-DDC-2016-0151-PV  
 Cuenca, 01 de febrero de 2016

Sumario Administrativo Nro. 067-2015 JOSE LINO CHILLOGALLI CHILLOGALLI

**SERVICIO NACIONAL DE ADUANA DEL ECUADOR, DIRECCIÓN DISTRITAL DE CUENCA,** Cuenca, a 1 día del mes de Febrero de 2016, a las 11h20. **Vistos:** Ing Diego Donoso Aguilera en mi calidad de Director Distrital de Cuenca del Servicio Nacional de Aduana del Ecuador Subrogante, calidad que lo justifico con la Acción de Personal que adjunto al presente, avoco conocimiento dentro del Sumario Administrativo N° 067-2015 iniciado en contra de **JOSE LINO CHILLOGALLI CHILLOGALLI** mediante Providencia No. SENAE-DDC-2015-0621-PV, de fecha 11 de marzo de 2015, notificada en fecha 19 de marzo de 2015, se dispuso lo siguiente: " En virtud del Art. 4 de la Resolución No. SENAE-DGN-2015-0051-RE suscrita por el Eco. Pedro Xavier Cárdenas Moncayo, DIRECTOR GENERAL se concede al sumariado, señor **JOSE LINO CHILLOGALLI CHILLOGALLI** el plazo de 30 días para cumplir con las formalidades aduaneras lo cual incluye dar destino a la mercancía constantes en el Acta de Aprehensión N° UVAC-OPE-AA-2015-017..." por lo expuesto, y en razón de que hasta a presente fecha no ha dado cumplimiento a lo dispuesto en la Providencia No. SENAE-DDC-2015-0621-PV, previo a poseer lo que fuere procedente en derecho, el suscrito **DIRECTOR DISTRITAL DE CUENCA DEL SERVICIO NACIONAL DE ADUANA DEL ECUADOR**, efectúa las siguientes consideraciones **PRIMERA.-** Esta Autoridad es competente para conocer y resolver el presente caso conforme a lo dispuesto por el Art. 248, en sus literales a.) y r.) del Código Orgánico de la Producción, Comercio e Inversiones. **SEGUNDA.-** Mediante Resolución No. SENAE-DGN-2015-0794-RE de fecha 24 de septiembre del 2015, suscrita por el Eco. Pedro Xavier Cárdenas Moncayo, Director General del Servicio Nacional de Aduana del Ecuador, se **reforma** y sustituye el artículo 5 de Resolución No. SENAE-DGN-2015-0051-RE, de fecha 22 de enero del 2015 que trata sobre "Los lineamientos para regularizar la mercancía aprehendida en zona secundaria respecto de la cual se ha iniciado un proceso de contravención administrativa", en los siguientes términos: "**Artículo 1.-** Sustituir el artículo 5 de la Resolución No. SENAE-DGN-2015-0051-RE por el siguiente: "**Art. 5.-** Aplicación de Abandono Tácito y Definitivo.- En caso de verificarse que el administrado no ha cumplido con la presentación de los documentos de control previo demás formalidades, dentro del plazo establecido en el artículo anterior, la autoridad aduanera competente deberá declarar el abandono tácito de las mercancías al amparo del literal a.) del artículo 142 del Código Orgánico de la Producción, Comercio e Inversiones, y si dentro de los veinte y cinco días hábiles posteriores no ha procedido a subsanar la causa que lo motivó, se procederá a declarar el abandono definitivo de conformidad con lo previsto en el literal a.) del artículo 143 ibidem. En caso de tratarse de mercancía perecible, de fácil descomposición, o no apta para el consumo se dispondrá la destrucción a costa del propietario, según el proceso respectivo." **TERCERA.-** La Disposición Transitoria de la Resolución No. SENAE-DGN-2015-0794-RE de fecha 24 de septiembre del 2015, establece "Los procedimientos iniciados previo a la expedición de la presente resolución hasta antes de la imposición de la multa por incumplimiento de plazos de recobrarque y disposición de mercancías administradas de las mercancías aprehendidas, deberán aplicar el nuevo procedimiento establecido en la presente Resolución, debiendo para el efecto contabilizar los plazos para el abandono tácito desde la finalización del plazo establecido en el acto administrativo sancionatorio por el cometimiento de la infracción aduanera respectiva." En el presente caso, hasta la presente fecha no se ha sancionado el incumplimiento de la disposición de recobrarque, de acuerdo a lo que manda el artículo 190 literal h) del Código Orgánico de la Producción, Comercio e Inversiones establece: "**Art. 142.- Abandono Tácito.-** El abandono tácito operará de pleno derecho, cuando se configure, cualquiera de las siguientes causas: **a.** Falta de presentación o transmisión de la declaración aduanera dentro del plazo previsto en el Reglamento al presente código ..."**QUINTA.-** El Art. 143 ibidem, en su literal a), vea: "**Art. 143.- Abandono Definitivo.-** La servidora o el servidor a cargo de la dirección distrital de la zona de abandono definitivo de las mercancías que se adscriben a una de las causas siguientes: **a.** Si dentro de los veinticinco días hábiles contemplados en el artículo anterior no se subsanan las causas de abandono tácito ..."**SEXTA.-** De la revisión del expediente se desprende que el Abandono Tácito de las mercancías objeto del presente trámite, operó en fecha 19 de abril de 2015, transcurriendo en su integridad veinte y cinco días hábiles hasta el día 25 de mayo de 2015, sin que se haya subsanado la causal del abandono tácito por parte del señor **JOSE LINO CHILLOGALLI CHILLOGALLI**. **SEPTIMA.-** El Art. 6 de la Resolución No. SENAE-DGN-2012-0238-RE establece: "...**Artículo 6: Sospecha de vulneración de derechos de propiedad intelectual.-** Si posterior a la aceptación del abandono expreso, declaratoria de abandono definitivo, decomiso se detectare que tales mercancías vulneran de cualquier forma derechos de propiedad intelectual, se pondrá

Presentación de documentos de control previo

Falta presentarse de la declaración aduanera

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Providencia Nro. SENAE-DDC-2016-0151-PV

Cuenca, 01 de febrero de 2016

este hecho en conocimiento del Instituto Ecuatoriano de Propiedad Intelectual - IEPI cuyo pronunciamiento decidirá el tratamiento que debe darse a las mercancías. Antes del pronunciamiento definitivo de la autoridad competente únicamente las entidades públicas podrán obtener estas mercancías en adjudicación gratuita siempre que cuenten con autorización expresa del titular del derecho presuntamente vulnerado. Para este propósito se publicará un listado independiente de mercancías que se encuentren en estas circunstancias en el sitio web oficial del Servicio Nacional de Aduana del Ecuador. La entidad pública que haya gestionado la autorización ante el titular del derecho presuntamente vulnerado será la adjudicataria; no obstante, las mercancías así obtenidas, no podrán ser destinadas al comercio... por tanto y en virtud de las atribuciones conferidas en el Art. 2.8 literales a) y r) del Código Orgánico de la Producción, Comercio e Inversiones en concordancia con el Art. 143 ibidem, es suscrito **DIRECTOR DISTRITAL DE CUENCA DEL SERVICIO NACIONAL DE ADUANA DEL ECUADOR, RESUELVE: 1.) Declarar el ABANDONO DEFINITIVO** de 02 bultos conteniendo relojes, pulseras de relojes, pilas de botón y cordón para lentes en un total de 256 unidades descritas en el Acta de Aprehesión N° UVAC-OPE-AA-2015-017. **2.) Declarar extinguida la Obligación Tributaria Aduanera**, en lo que respecta al cobro de los respectivos tributos de las mercancías detalladas en el numeral 1), conforme lo señalado en el Art. 114 del Código Orgánico de la Producción, Comercio e Inversiones. **3.)** En virtud de lo establecido en el Art.6 de la Resolución No. No. SENAE-DGN-2012-0238-RE ofíciase Instituto Ecuatoriano de Propiedad Intelectual poniendo en conocimiento la posible vulneración de derechos de propiedad intelectual de parte de la mercancía correspondiente al Acta de Aprehesión N° UVAC-OPE-AA-2015-017 a fin que se pronuncie al respecto y decida el tratamiento que debe darse a las mercancías. **4.)** Hagase saber el contenido de esta Providencia al Jefe Guardalmacén de esta Dirección Distrital, quien es el custodio de la mercancía detallada en el Acta de Aprehesión, por cualquiera de los medios que establece el Art. 107 del Código Tributario en concordancia al Art. 219 del COPCI, teniéndose como medio de notificación el Sistema de Gestión Documental "QUIPUX". Intervenga como Secretaria Ad-hoc la Ab. Marcela Calle C. quien estando presente acepta cumplir fiel y lealmente su cargo. **-NOTIFIQUESE Y CÚMPLASE.-**

Ab. Marcela Calle C.  
Secretaría AD-HOC

Ing. Diego Fernando Domínguez Aguilera  
**DIRECTOR DISTRITAL CUENCA, SUBROGANTE**

Copia

- Señora Ingeniera  
Martha Susana Cueva Muñoz  
Directora de Despacho y Control de Zona Primaria CCAT (Encargada), Subrogante
- Señor Licenciado  
Cristian Mauricio Carcho Ulloa  
Técnico Operador Centro de Zona Primaria

mmcc



Servicio Nacional de Aduana del Ecuador

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**SE. VICIO NACIONAL DE ADUANA DEL ECUADOR**  
**UNIDAD DE VIGILANCIA ADUANERA**  
**UNIDAD OPERATIVA "CUENCA"**  
**ACTA DE APREHENSION N° UVA-C-OP-EA-2015-017**

En la Unidad Operativa "Cuenca" de la Unidad de Vigilancia Aduanera, a las catorce días del mes de febrero del año dos mil quince, se procede a levantar la presente Acta de Aprehensión conforme a lo que establece el artículo 17 del Código Orgánico Integral Penal (COIP), en su artículo 301, en concordancia con los artículos 211 y 222 del Código Orgánico de la Producción, Comercio e Inversiones.

**ANTECEDENTES.**

El 13 de febrero del 2015, personal de la Unidad de Vigilancia Aduanera Cuenca, en cumplimiento a la Orden de Patrulla N° 011, aproximadamente a las 18h00, en el Cantón Santa Isabel, conocido como el Botadero de Basura, detuvo la marcha del vehículo de la Cooperativa de transporte "Vaya Intercanvil" de placas: AA4159, disco "2, al revisar el interior del vehícul encuentro que el Sr. Challogallí Challogallí José Lino C.I.0103560942, tenía en su poder dos fundas plásticas las cuales contienen relojes y repuestos de reloj, una vez revisada y verificado que se de mercadería con logos y marcas reconocidas como: Guess, Lacoste, Fossil, Adidas, Nike entre otras de procedencia extranjera, se le solicita al dueño la documentación de respaldo de dichas mercancías, presentando: Nota de Venta con Nos:001-001-000005675; 001-001-000005676; 001-001-000005677 y 001-001-000005678, del almacén CENTRO EL REJ RUC:070216187001518VANTIAN EL GLENTO NAYARRITE VALENCIA DIBRECCION MAYRIZ S/N Y JUAN MONTEVAVO TLF:2035-327/2938-078ALVCHALA-FL-0 En la Nota de Venta 005675 se observa no esta llenada en su totalidad y se presume adulteración de la misma. Adicional debo mencionar la presunción de violación a la Propiedad Intelectual las marcas y logos que esas mercancías poseen, ante tales hechos se le procede a explicar que la importación de mercancías extranjeras dentro de zona secundaria sin el documento que acredita la legal renuncia de las mismas, es una infracción aduanera, por tal razón se le indica al conductor que en virtud de que no se justifica el legal ingreso al país de las señaladas mercancías, personal Unidad de Vigilancia Aduanera procede con la aprehensión de las mercancías conforme lo establece el artículo 211 del Código Orgánico de la Producción, Comercio e Inversiones por e presunciones del cumplimiento de una infracción aduanera, las mercancías fueron desahucadas y colocadas en la patrullera de placas GE-A-2566 para ser trasladadas hasta Instalación SENAE Cuenca, abarcadas en las calles: Eja Luro 2-08 y Gál Ramirez Dávalos en donde se procedió a realizar el respectivo inventario determinando que se trata de artículos de vidrio (vasos monederos. Seguidamente las mercancías son ingresadas en procedimiento de cadena de custodia a las bodegas de mercancías aprehendidas de la Dirección Distrital Cuenca del Servicio Nacional Aduana del Ecuador, conforme lo establece el artículo 176 del Código Orgánico de la Producción Comercio e Inversiones. Posteriormente se procede a elaborar el presente parte de aprehita para poner a órdenes de la Dirección Distrital SENAE Cuenca. La mercancía aprehendida consiste en:

ORD	BOLTO	CANT.	UNIDAD	DESCRIPCIÓN DE LA MERCANCIA	MARCA	PROCEDENCIA	ESTADO
1		2	Unidad	Reloj de Pulsera	Tommy Hilfiger	Estranjera	Nuevo
2		2	Unidad	Reloj de Pulsera	Ninica	Estranjera	Nuevo
3		1	Unidad	Reloj de Pulsera	Raposo	Estranjera	Nuevo
4		1	Unidad	Reloj de Pulsera	Nike	Estranjera	Nuevo
5	Multo N° 1	4	Unidad	Reloj de Pulsera	Fossil	Estranjera	Nuevo
6		2	Unidad	Reloj de Pulsera	Gar	Estranjera	Nuevo

7	1	Unidad	Reloj de Pulsera	Aldas	Extranjera	Nuevo
8	1	Unidad	Reloj de Pulsera	Ferrari	Extranjera	Nuevo
9	8	Unidad	Reloj de Pulsera	Diesal	Extranjera	Nuevo
10	12	Unidad	Reloj de Pulsera	Jaosste	Extranjera	Nuevo
11	5	Unidad	Reloj de Pulsera	Michael Kors	Extranjera	Nuevo
12	1	Unidad	Reloj de Pulsera	Shibors	Extranjera	Nuevo
13	2	Unidad	Reloj de Pulsera	S/M Logo Emblem	Extranjera	Nuevo
14	3	Unidad	Reloj de Pulsera	S/M Logo Barcelona	Extranjera	Nuevo
15	16	Unidad	Reloj de Pulsera	Xanxia	Extranjera	Nuevo
16	10	Unidad	Reloj de Pulsera	Pohle	Extranjera	Nuevo
17	3	Unidad	Reloj de Pulsera	Mingau	Extranjera	Nuevo
18	9	Unidad	Reloj de Pulsera	Lacoste	Extranjera	Nuevo
19	3	Unidad	Reloj de Pulsera	Michael Kors	Extranjera	Nuevo
20	2	Unidad	Reloj de Pulsera	Wt	Extranjera	Nuevo
21	3	Unidad	Reloj de Pulsera	Giesse	Extranjera	Nuevo
22	4	Unidad	Reloj de Pulsera	Remos	Extranjera	Nuevo
23	1	Unidad	Reloj de Pulsera	Rolux	Extranjera	Nuevo
24	1	Unidad	Reloj de Pulsera	K'oss	Extranjera	Nuevo
25	1	Unidad	Reloj de Pulsera	Dps	Extranjera	Nuevo
26	1	Unidad	Reloj de Pulsera	Geneva	Extranjera	Nuevo
27	1	Unidad	Reloj de Pulsera	Ming Du	Extranjera	Nuevo

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28	8	Unidad	Pulsers para reloj metlicas	S/N/I	Extranjera	Nuevo
29	6	Unidad	Pulsers para reloj caucho	S/N/I	Extranjera	Nuevo
30	42	Unidad	Pulsers para reloj cuero	S/N/I	Extranjera	Nuevo
31	30	Unidad	Pulsers para reloj plasticos	S/N/I	Extranjera	Nuevo
32	45	Unidad	Plas de jino	Sony 3V	Extranjera	Nuevo
33	10	Unidad	Plas de jino	Sony 1.55V	Extranjera	Nuevo
34	12	Unidad	Cordones para lentes	S/N/I	Extranjera	Nuevo

Para constancia de lo actuado y en fe de conformidad, firman los aprehensores que coordinaron el operativo en cuatro ejemplares del mismo tenor y efecto, quedando las mercancías en las bodegas de mercancías aprehendidas del Servicio Nacional de Aduana del Ecuador ubicadas en la Parroquia Recarte de la ciudad de Cuenca, las mismas que están a órdenes de la Dirección Distrital SENAE Cuenca, y permanecerán en procedimiento de cadena de custodia conforme lo establece el artículo 176 del Código Orgánico de la Producción Comercio e Inversiones, ratificand entrega recepción de las mercancías el día 19 de Mayo del 2010, Guardalmacen Encargado de la Dirección Distrital Cuenca del SENAE.

Insp. Francis Saucedo  
Supervisor de Patrulla

Insp. Magdiel Aguilar  
Jefe de Patrulla

Insp. Cavopina Franklin  
Aprehensor

Vig. Coral Rodrigo  
Aprehensor

Vig. Villarreal Johnny  
Aprehensor

Ing. Paul Quito (e)  
Guardalmacen DDC

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Oficio Nro. IEPI-CUE-2016-0002-OF

Cuenca, 08 de marzo de 2016

**Asunto:** Contestación a oficio No.SENAE-DDC-2016-0075-OF

Ingeniero  
Christian Alfredo Ayora Vasquez  
**Director Distrital Cuenca**  
**SERVICIO NACIONAL DE ADUANA DEL ECUADOR**

Señor Ingeniero  
Diego Fernando Donoso Aguilera  
**Director de Despacho y Control Zona Primaria CCAT**  
**SERVICIO NACIONAL DE ADUANA DEL ECUADOR**  
En su Despacho

De mi consideración:

**CONSIDERACIONES:**

1.-Mediante oficio Nro. **SENAE-DDC-2016-0075-OF** de 02 de febrero de 2016, recibido en esta dependencia el 10 de febrero del 2016, se remitió a esta autoridad copia de la providencia No. SENAE-DDC-2016-0151-PV, en cuya parte pertinente, el Director Distrital de Cuenca del SENAE Subrogante señala que el Art. 6 de la Resolución No. SENAE-DGN-2012-0238-RE establece que: "*Si posterior a la aceptación de abandono expreso, declaratoria de abandono definitivo, decomiso, se detectare que tales mercaderías vulneran de cualquier forma derechos de propiedad intelectual se pondrá en conocimiento del IEPI, cuyo pronunciamiento definitivo decidirá el tratamiento que debe dársele a las mercancías (...)*"

De la misma forma se ha remitido a esta autoridad copia del Acta de Aprehesión No. UVAC-OPE-AA-2015-017, en la que constan las novedades reportadas dentro de un operativo de control aduanero realizado por parte del personal de la Unidad de Vigilancia Aduanera "Cuenca", en fecha 13 de enero del año 2015, mismo que concluyó con la aprehensión de 2 fundas plásticas con relojes y repuestos para relojes que se encontraban en poder del señor **JOSE LINO CHILLOGALLI CHILLOGALLI**, por presumir que se estaría violentando derechos de Propiedad Intelectual, por cuanto la mercancía aprehendida llevaba grabada las siguientes marcas: **Tommy Hilfiger, Náutica, Renos, Nike, Fossil, Cat, Adidas, Ferrari, Diesel, Lacoste, Michel Kors, Shors, Logo Emelec, Logo Barcelona, Xinja, Polit, Mingui, Wr, Guess, Rolex, Kloss, Dns, Geneva, Mung Du y Sony.**

2.-Con el objetivo de dar contestación al referido oficio, que en su parte pertinente señala: "... *me permito poner en su conocimiento la posible vulneración de derechos de*



Oficio Nro. IEPI-CUE-2016-0002-OF

Cuenca, 08 de marzo de 2016

*propiedad intelectual de la mercancía descrita en el Acta de aprehensión No. UVAC-OPE-AA-2015-017 (...), a fin de que se determine el tratamiento que debe darse a la mercadería antes especificada (...)*"; esta autoridad administrativa, quien actúa por delegación del Director Ejecutivo del IEPI, contenida en la resolución No. 006-2016-DE-IEPI, de 8 de marzo de 2016, tiene a bien exponer lo siguiente:

**NORMATIVA APLICABLE:**

La Decisión 486 de la Comunidad Andina, norma supranacional, en materia de medidas en frontera establece lo siguiente:

*"Artículo 250.- El titular de un registro de marca, que tuviera motivos fundados para suponer que se va a realizar la importación o la exportación de productos que infringen ese registro, podrá solicitar a la autoridad nacional competente suspender esa operación aduanera. Son aplicables a esa solicitud y a la orden que dicte esa autoridad las condiciones y garantías que establezcan las normas internas del País Miembro.*

*Quien pida que se tomen medidas en la frontera deberá suministrar a la autoridad nacional competente la información necesaria y una descripción suficientemente detallada y precisa de los productos objeto de la presunta infracción para que puedan ser reconocidos.*

*Si la legislación interna del País Miembro lo permite, la autoridad nacional competente podrá ordenar de oficio, la aplicación de medidas en frontera.*

*Artículo 251.- A efectos de fundamentar sus reclamaciones, la autoridad nacional competente permitirá al titular de la marca participar en la inspección de las mercancías retenidas. Igual derecho corresponderá al importador o exportador de las mercancías.*

*Al realizar la inspección, la autoridad nacional competente dispondrá lo necesario para proteger la información confidencial, en lo que fuese pertinente.*

*Artículo 252.- Cumplidas las condiciones y garantías aplicables, la autoridad nacional competente ordenará o denegará la suspensión de la operación aduanera y la notificará al solicitante.*

*En caso que se ordenara la suspensión, la notificación incluirá el nombre y dirección del consignador, importador, exportador y del consignatario de las mercancías, así como la cantidad de las mercancías objeto de la suspensión. Así mismo, notificará la suspensión al importador o exportador de los productos.*

*Artículo 253.- Transcurridos diez días hábiles contados desde la fecha de notificación de la suspensión de la operación aduanera sin que el demandante hubiere iniciado la acción por infracción, o sin que la autoridad nacional competente hubiere prolongado la suspensión, la medida se levantará y se procederá al despacho de las mercancías retenidas.*

*Artículo 254.- Iniciada la acción por infracción, la parte contra quien obró la medida podrá recurrir a la autoridad nacional competente. La autoridad nacional competente podrá modificar, revocar o confirmar la suspensión.*

*Artículo 255.- Una vez determinada la infracción, los productos con marcas falsificadas, que hubiera incautado la autoridad nacional competente, no podrán ser reexportados ni sometidos a un procedimiento aduanero diferente, salvo en los casos debidamente*

Oficio Nro. IEPI-CUE-2016-0002-OF

Cuenca, 08 de marzo de 2016

*calificados por la autoridad nacional competente, o los que cuenten con la autorización expresa del titular de la marca.*

*Sin perjuicio de las demás acciones que correspondan al titular del derecho y a reserva del derecho del demandado a apelar ante una autoridad judicial, la autoridad nacional competente podrá ordenar la destrucción o decomiso de las mercancías infractoras.*

*Artículo 256.- Quedan excluidas de la aplicación de las disposiciones del presente capítulo las cantidades pequeñas de mercancías que no tengan carácter comercial y formen parte del equipaje personal de los viajeros o se envíen en pequeñas partidas (...)*

El artículo 1 de la codificación a la Ley de Propiedad Intelectual del Ecuador, por su parte señala que: *"El Estado reconoce, regula y garantiza la propiedad intelectual adquirida de conformidad con la ley, las decisiones de la Comisión de la Comunidad Andina y los convenios internacionales vigentes en el Ecuador. (...)"*

Asimismo el Art. 3 de la referida codificación establece que: *"El Instituto Ecuatoriano de la Propiedad Intelectual (IEPI), es el organismo administrativo competente para propiciar, promover, fomentar, prevenir, proteger y defender a nombre del Estado ecuatoriano, los derechos de propiedad intelectual reconocidos en la presente Ley y en los tratados y convenios internacionales, sin perjuicio de las acciones civiles y penales que sobre esta materia deberán conocerse por la Función Judicial".*

En lo que respecta a las medidas en frontera, el Art. 342 de la ley de la materia dispone que: *"La Corporación Aduanera Ecuatoriana y todos quienes tengan el control del ingreso o salida de mercaderías al o desde el Ecuador, tienen la obligación de impedir que ingresen o se exporten productos que de cualquier modo violen los derechos de propiedad intelectual.*

*Si a petición de parte interesada no impidieren el ingreso o exportación de tales bienes, serán considerados cómplices del delito que se cometa, sin perjuicio de la sanción administrativa que corresponda.*

*Cuando impidieren, de oficio o a petición de parte, el ingreso o exportación de cualquier producto que viole los derechos de propiedad intelectual, lo pondrán en conocimiento mediante informe pormenorizado al Presidente del IEPI, quien en el término de cinco días confirmará o revocará la medida tomada (...)"*

Finalmente, el Art. 334 de la citada codificación al regular la tutela administrativa establece que: *"Cualquier persona afectada por la violación o posible violación de los derechos de propiedad intelectual podrá requerir al IEPI la adopción de las siguientes medidas:*

- a) Inspección;*
- b) Requerimiento de información; y,*

Oficio Nro. IEPI-CUE-2016-0002-OF

Cuenca, 08 de marzo de 2016

*c) Sanción de la violación de los derechos de propiedad intelectual."*

**CONCLUSIONES:**

1.-El Instituto Ecuatoriano de la Propiedad Intelectual-IEPI-, como autoridad Nacional Competente en materia de Propiedad Intelectual cuenta con facultades claramente determinadas en la Ley de Propiedad Intelectual y su reglamento, así como en las normas de carácter comunitario (Decisiones Andinas) e internacional (ADPIC).

2.-Las medidas en frontera son actuaciones que realizan las autoridades dentro del aforo aduanero para *impedir que ingresen o se exporten productos que de cualquier modo violen los derechos de propiedad intelectual*; una vez que estos productos se han exportado o nacionalizado pueden comercializarse libremente, salvo excepciones dadas por las características y propiedades de los bienes, como en el caso de los medicamentos, mismos que deben pasar por una revisión sanitaria, previo a su comercialización.

3.-Cuando un producto ha pasado por todos los filtros aduaneros, es decir cuando ya se ha nacionalizado, se presume su legalidad, sin embargo dicho producto podría ser falsificado; en ese supuesto, la Ley de Propiedad Intelectual establece que el titular de una marca que pudiese sentirse perjudicado por la violación o posible violación de un derecho de propiedad intelectual, es quien está llamado a iniciar las acciones administrativas o judiciales correspondientes para impedir la circulación del referido producto dentro del territorio nacional. Lo propio se aplicaría en el caso de que la autoridad aduanera haya aceptado el abandono expreso de las mercancías, haya declarado el abandono definitivo de las mismas por falta de presentación de los documentos de control previo, así como cuando haya procedido al decomiso de mercadería, debido a que, en estos supuestos, los productos presuntamente infractores ya se encontrarían en territorio nacional.

Por todo lo expuesto, queda claro que el IEPI no puede determinar el tratamiento que debe darse a la mercadería aprehendida, en razón de que el pronunciamiento acerca de la existencia o no de una vulneración a un derecho de propiedad intelectual luego de que la autoridad aduanera competente ha declarado el abandono definitivo de la misma, no se encuentra enmarcado dentro de las medidas de observancia contempladas en la normativa de propiedad intelectual, para cuyo conocimiento la suscrita se encuentra expresamente facultada.

Con sentimientos de distinguida consideración.

Atentamente,



**Oficio Nro. IEPI-CUE-2016-0002-OF**

**Cuenca, 08 de marzo de 2016**

*Documento firmado electrónicamente*

**Dra. Jamileth Susana Vazquez Zambrano  
SUBDIRECTORA REGIONAL**

Annex C. Case of the Republic of Colombia

472  
Servicios Postales  
Nacionales S.A.  
NIT 900.062917-9  
DG 25 G 95 A 55  
Linea Nat: 01 8000 111 210

**REMITENTE**

Nombre/ Razón Social  
DIRECCIÓN DE IMPUESTOS Y  
ADUANAS NACIONALES -  
NACIONAL - DI  
Dirección: MANGA AVENIDA 3A.  
NO. 25-04

Ciudad: CARTAGENA\_BOLIVAR

Departamento: BOLIVAR

Código Postal:

Envío: PC008236648CO

**DESTINATARIO**

Nombre/ Razón Social:  
IEXPORSAS-900065277

Dirección: AV VIA 40 73 290 OF  
405

Ciudad: BARRANQUILLA

Departamento: ATLANTICO

Código Postal: 080001000

Fecha Pre-Admisión:  
22/04/2019 11:49:41

Min. Transporte Lic de carga 000200  
del 20/05/2011

*Leti Parares  
24-4-19  
11:42 AM.*

*BQ-19-345.*



AUTO 1 48 245-1125-

POR MEDIO DEL CUAL SE RESUELVE UNA SOLICITUD DE SUSPENSIÓN DE UNA OPERACIÓN DE IMPORTACION DE MERCANCIAS POR LA PRESUNTA VIOLACIÓN DE

## DERECHOS DE PROPIEDAD INDUSTRIAL

INTERESADO	LUXOTTICA COLOMBIA SAS.
NIT	900.829.318
APODERADO	CAMILO ZAMORA FLOREZ
C.C. No.	1.026.259.272 Bogotá
T p. NO.	282.432 del C.S. de la J
DIRECCION	CALLE 90#12-28
CIUDAD	BOGOTA D.C.

LA JEFE DE LA DIVISIÓN DE GESTIÓN DE LA OPERACIÓN ADUANERA DE LA DIRECCIÓN SECCIONAL DE ADUANAS DE CARTAGENA

en uso de sus facultades legales conferidas por el artículo 11 de la Resolución No. 0009 del 4 de noviembre de 2008, Decreto 390 de 2016, Decreto 4540 del 22 de diciembre de 2006 y demás normas concordantes, y

## CONSIDERANDOS:

En respuesta a los perfiles determinados por la sala de análisis, el día 5 de abril de 2019, el reconecedor de carga, debidamente comisionado se hizo presente en las instalaciones de Sociedad Portuaria Regional cartagena, con el fin de verificar las mercancías contenidas en la unidad de carga KOSU451202-4, amparado en el documento de transporte MITCTG03010, consignado a IEXPOR S.A.S, y que dice contener 954 bultos con bañera, coche, mosquitero, pañaleras, tapete, relojes, sillas de comedor para bebe, gafas, exhibidores, elojes, chupos, partes para gafas, monturas para gafas, estuches para gafas, con un peso documental de 14.019 Kgs. al como quedo consignado en las acta de diligencia números 11547714693029 del 5 de abril de 2019, 1547714737328 y 11547714737367 del 12 de abril de 2019, se estableció que el número de bultos estaban mparados según los documentos de transporte, sin embargo, se encontró mercancía no descrita en los ocumentos de transporte y en lo referente a las gafas se observó una presunta falsedad marcaria, procediendo on la medida cautelar de inmovilización según lo establece el artículo 73-1 de la Resolución 4240 del 2000.

El importador a través de su agencia de aduanas, mediante radicado número 048E2019010768 del 10 de abril e 2018, allego los documentos que soportan la mercancía no descrita en el documento de transporte, factura úmero 150-18 del 24 de octubre de 2018 en 88 folios.

En razón a que en la diligencia de reconocimiento de carga se determinó que la mercancía consistente en gafas eneraba dudas sobre la autenticidad de la marca, se procedió de acuerdo al título XVIII del Decreto 390 de 016, más específicamente lo establecido en el artículo 613 del mismo Decreto, que determina que en caso de ue se presenten indicios de falsedad marcaria y no existiere solicitud de suspensión previa, el funcionario que jerce al control se remitirá al procedimiento previsto en el artículo 626 del mismo Decreto, como en efecto el uncionario comisionado para adelantar el reconocimiento de la carga y demás diligencias referentes a la misma rocedió; razón por la cual el día 08 de abril de 2019, se remitió correo electrónico al buzón [strategia@estrategiajuridica.co](mailto:strategia@estrategiajuridica.co) de la empresa: ESTRATEGIA JURIDICA, representante en Colombia de la marca: RAY BAN, con el fin de que efectuara el peritazgo sobre la mercancía embalada en el contenedor úmero KOSU-451202-4, BL MITCTG03010 consignado a la empresa: EXPORT S.A.S con NIT: 00.065.277.

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El día 11 de abril de 2019, se hicieron presentes en las instalaciones de SPRC el funcionario comisionado del G.I.T CARGA Y TRANSITOS, el señor Diego Camelo Torres, como perito representante de la empresa: ESTRATEGIA JURÍDICA, funcionarios de la Embajada Americana y funcionarios ubicados en grupo CSI con el fin de realizar el reconocimiento a las mercancías contenidas en el contenedor número KOSU451202-4, BL número MITCTG03010, consignado a la empresa IEXPOR y que dice contener GAFAS, de las cuales se presume falsedad marcaría por simulación.

La Dirección Seccional de Aduanas de Cartagena, garantizando el debido proceso, puso a

disposición del perito asignado por el representante de la marca citada y facilitó el procedimiento

de verificación de las mercancías el día 11 de abril de 2019, mediante la cual se verificó la siguiente mercancía: 203 cajas que contienen Gafas marca REY BIC en buen estado, las cuales son causales de presunta simulación marcaría. Como respuesta al peritaje anterior, se presentó escrito con radicado No. 048E2019011 143 de abril 12 de 2019, en lo que el perito manifiesta.

"Conclusión: De acuerdo con el análisis anterior, certifico preliminarmente que los elementos dejados a disposición del suscrito perito presentan similares características a los productos fabricados por la sociedad LUXOTTICA GROUP SPA Titulares en Colombia de la marca: RAYBAN, por lo que se concluye que estos productos pueden generar riesgo de confusión y/o asociación con la marca, frente a los consumidores."

Por lo anterior, teniendo en cuenta que la empresa LUXOTTICA GROUP S.P.A. es titular de la marca RAYBAN (mixta), con certificado de registro N° 183019 de la Superintendencia de Industria y Comercio, se considera que los derechos de propiedad industrial que otorga la marca

presuntamente se están violando de conformidad con el artículo 306 de código penal y los artículos 155 y 238 de la legislación andina. Decisión 486 de 2000.

Posteriormente mediante escrito con radicado No. 048E2019011145 de abril 12 de 2019, el abogado CAMILO ZAMORA FLOREZ, identificado con la cédula de ciudadanía No. 1.026.259.272 expedida en Bogotá, y portador de la tarjeta Profesional No. 282.432 del Consejo Superior de la Judicatura, apoderado de la compañía LUXOTTICA GROUP SPA-propietaria en Colombia de la marca RAY-BAN, fundamentado en el artículo 613 del Decreto 390 de 2016, solicitó la SUSPENSIÓN DE LA OPERACIÓN ADUANERA de la mercancía amparada en documento de transporte No. MITCTG03010, contenida en la unidad de carga No. KOSU451202-4, importada por IEXPOR S.A.S con NIT: 900.065.277, por el presunto delito de USURPACION DE DERECHOS DE PROPIEDAD INDUSTRIAL Y DERECHOS DE OBTENTORES DE VARIEDADES VEGETALES, tipificado en el artículo 306 del Código Penal, cometido en relación

con la marca RAY- BAN debidamente registrada ante la superintendencia de Industria y Comercio por la compañía LUXOTTICA GROUP SPA

Manifiesta que "De conformidad con lo exigido por el Decreto 390 del 7 de marzo de 2016 la mercancía identificada con la marca RAY-BAN es importada y distribuida directamente por LUXOTTICA COLOMBIA S.A.S con las siguientes licencias registradas.

REPRODUCCION [TIP	TITULAR	CERTIFICADO	VIGENCIA
Ray-Ban	LUXOTTICA GROUP SPA.	183019	22/01/2026
RAY- BAN	LUXOTTICA GROUP SPA.	19652	08/05/2021

Los señores estrategia jurídica, en representación de la empresa LUXOTTICA COLOMBIA S.A.S. importadores y comercializadores de la marca RAY-BAN, fundamentan su petición en los siguientes términos:



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"Las anteriores similitudes son capaces de generar confusión en el consumidor. Esto teniendo en cuenta que el Tribunal de Justicia de la Comunidad Andina ha sostenido que. La confusión en materia marcaria, se refiere a la falta de claridad para poder elegir un bien de otro, a la puedan ser inducidos los consumidores por no existir en el signo la capacidad suficiente para ser distintivo, por lo anterior el consumidor podrá adquirir los productos de la marca Rey-Bic pensando que trata de los aquellos identificados con la marca.

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Continuación Por el medio del cual se resuelve una solicitud de suspensión de una operación de importacio, por la presunta violación de derechos de propiedad industrial.

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Ray-Ban o que es una nueva línea de productos de la sociedad LUXOTT/CA GROUP S.P.A cuando en realidad no lo es. Teniendo en cuenta lo anteriormente manifestado y en virtud de las disposiciones contenidas en los artículos 613 y 614 del Decreto 390 de 2016, los interesados solicitan que suspenda provisionalmente la operación de importación de la mercancía amparada en documentos de transporte No. MITCTG03010 contenida en e/ contenedor N<sup>o</sup> KOSU-451202-4 importada por IEXPOR S.A.S y no efectúe el tránsito y/o levante de la mercancía hasta tanto la autoridad competente se pronuncie sobre la falsedad de la misma.

La anterior solicitud de suspensión de la operación aduanera, la realizan presentando los siguientes anexos:

1. Certificación de la marca No. 19652 expedida por la superintendencia de industria y comercio.
2. Certificación de la marca No. 183019 expedida por la superintendencia de industria y comercio
3. Documento de poder que acredita la calidad con que actuó.
4. Peritaje preliminar realizado del producto.

## FUNDAMENTOS JURIDICOS

### DECRETO 390 DE 2016

Artículo 613. Facultades de la Dirección de impuestos y Aduanas Nacionales. Previa solicitud, y conforme al procedimiento aquí previsto, la autoridad aduanera podrá suspender provisionalmente la importación, exportación o tránsito de mercancías supuestamente piratas o de marca falsa, mientras la autoridad competente resuelve sobre la existencia o no de tal circunstancia. Este procedimiento se surtirá en las diligencias de reconocimiento, revisión o de aforo, donde se adoptará la suspensión provisional si a ella hubiere lugar. Cuando no mediare solicitud, y hubiere indicios de piratería o falsedad marcarla, el funcionario que ejerce el control previo o el simultáneo adelantará el procedimiento previsto en el artículo 626 del presente Decreto.

Lo anterior, sin perjuicio de la aprehensión de las mercancías, cuando a ello hubiere lugar, en cuyo caso se adelantará el proceso aduanero de decomiso y no el de suspensión provisional de la operación a que se refiere este Decreto.

En caso de existir serios indicios de encontrarse las mercancías vinculadas a un delito diferente o adicional al de contrabando, estas serán puestas a disposición de la Fiscalía, incluso de oficio, y con preferencia sobre cualquier otro procedimiento

Artículo 614. Solicitud de suspensión de la operación de Importación o exportación. E/ titular de un derecho propiedad intelectual vinculado a mercancías objeto de importación o exportación puede solicitar a la Dirección Seccional Aduanas la suspensión provisional de dicha operación, mientras la autoridad competente resuelve la denuncia o demanda que el titular deberá presentar por la supuesta condición de piratas o de marcas falsa resaltado nuestro.

Artículo 616. Efectos de la solicitud. La presentación de la solicitud tiene las siguientes consecuencias:

1. La suspensión del término de almacenamiento y en consecuencia del levante, o de la autorización del embarque, según e/ caso.
2. La imposibilidad de obtener la entrega directa de la mercancía, evento en el cual se ordenará el traslado de la misma a un depósito temporal. Esta misma medida se adoptará en relación con las mercancías que se someter a los regímenes de exportación, se pretendan depósito aduanero o de tránsito.
3. Respecto de mercancías sometidas al régimen de depósito aduanero que se pretendan someter a un régimen de importación o de exportación, la mercancía permanecerá dentro del mismo depósito.

Artículo 617 Trámite de la solicitud. La administración de aduanas admitirá o rechazará la solicitud

mediante auto, dentro de los tres (3) días hábiles siguientes a su presentación. E/ auto admisorio orde ará:

1. La suspensión de la operación aduanera.

2. La constitución de una garantía de compañía de seguros, dentro de los cinco (5) días hábiles siguientes a la ejecutoria del auto, equivalente al veinte por ciento (20%) del valor FOB de la mercancía, para garantizar los perjuicios que eventualmente se causen al importador o exportador, sin perjuicio de la responsabilidad de otro orden. En toda garantía habrá renuncia expresa al beneficio de excusión. No habrá lugar a constituir la garantía si la suspensión de la operación aduanera proviene de la autoridad competente.

Artículo 620. Derechos de información e inspección. Antes de presentar la solicitud de suspensión de la operación aduanera, las mercancías podrán ser examinadas por el titular del respectivo derecho de propiedad intelectual o por la persona que él designe, previa solicitud en ese sentido ante la Dirección Seccional de Aduanas, en la que describa de manera general las mercancías y los hechos en los que hace consistir la presunta violación de los derechos propiedad intelectual. A ella anejará:

1. Copia del registro, título o documento que lo acredita como titular del derecho, en los eventos en que este fuere legalmente necesario para constituir el derecho.
2. Copia del poder o del documento que acredite la calidad con que actúa, si fuere el caso.

La solicitud se resolverá dentro de los tres (3) días hábiles siguientes, mediante auto que no admite recurso, y será comunicada al importador, expoliador o declarante por cualquier medio. La observación de la mercancía se hará en presencia de un funcionario aduanero. El peticionario podrá estar asistido por máximo dos peritos por él contratados para el efecto.

La observación de la mercancía se hará sin perjuicio de la protección de la información confidencial y podrá ser presenciada por el importador o exportador, quien no podrá interferir en la diligencia, ni obstaculizarla.

La solicitud no requerirá de presentación personal, ni de los anexos, cuando quien la suscribe aparece inscrito en el directorio de titulares, en cuyo caso podrá enviarla por fax.

Artículo 626. Utilización del directorio. La Subdirección de Gestión de Comercio Exterior pondrá el directorio a disposición de todas las Direcciones Seccionales, en el curso del mes de febrero de cada año.

El funcionario que en desarrollo del control previo o Simultáneo encuentre mercancías respecto de las que exista algún indicio de piratería o de falsedad en la marca, conforme al conocimiento que pueda tener de aquellas, se comunicará con el interesado que aparezca en el directorio para informarle que debe presentarse, en los términos que defina la Dirección de Impuestos y Aduanas IVacionales, con el fin de examinar las mercancías, luego de lo cual, si confirma la existencia del posible fraude, podrá presentar la solicitud de suspensión de la operación aduanera dentro de los dos días hábiles siguientes; de lo contrario, se continuará con la operación aduanera.

Cuando no hubiere inscripción en el directorio, el hecho se pondrá en conocimiento de la Fiscalía o de la Policía Judicial, sin perjuicio de la continuidad de/ trámite de la operación, a menos que la Fiscalía disponga la incautación de las mercancías dentro de los cinco (5) días hábiles siguientes a la denuncia.

#### LEGISLACIÓN ANDINA- DECISIÓN 486 DE 2000.

Artículo 155- El registro de una marca confiere a su titular el derecho de impedir a cualquier tercero realizar, sin su consentimiento, los siguientes actos:

- a) aplicar o colocar la marca o un signo distintivo idéntico o semejante sobre productos para los cuales se ha registrado la marca; sobre productos vinculados a los servicios para los cuales ésta se ha registrado; o sobre los envases, envolturas, embalajes o acondicionamientos de tales productos;
- b) suprimir o modificar la marca con fines comerciales, después de que se hubiese aplicado o colocado sobre los productos para los cuales se ha registrado la marca; sobre los productos vinculados a los servicios para los cuales ésta se ha registrado; o sobre los envases, envolturas, embalajes o acondicionamientos de tales productos;
- c) fabricar etiquetas, envases, envolturas, embalajes u otros materiales que reproduzcan o contengan la marca, así como comercializar o detentar tales materiales;
- d) usar en el comercio un signo idéntico o similar a la marca respecto de cualesquiera productos o servicios, cuando tal uso pudiese causar confusión o un riesgo de asociación con el titular del registro. Tratándose del uso de un signo idéntico para productos o servicios idénticos se presumirá que existe riesgo de confusión;
- e) usar en el comercio un signo idéntico o similar a una marca notoriamente conocida respecto de cualesquiera productos o servicios, cuando ello pudiese causar al titular del registro un daño económico o comercial iniusto por razón de una dilución de la fuerza distintiva o de/ valor comercial o publicitario de la marca, o por razón de un aprovechamiento iniusto del prestigio de la marca o de su titular

violación de derechos de propiedad industrial.

Usar úbicamente un si no idéntico o similar a una marca notoriamente conocida aun ara fines no comerciales, cuando ello pudiese causar una dilución de la fuerza distintiva o del valor comercial o publicitario de la marca, o un aprovechamiento iniusto de su prestigio.

#### De los Derechos del Titular

Artículo 238- El titular de un derecho protegido en virtud de esta Decisión podrá entablar acción ante la autoridad nacional competente contra cualquier persona que infrinja su derecho. También podrá actuar contra quien ejecute actos que manifiesten la inminencia de una infracción.

Si la legislación interna del País Miembro lo permite, la autoridad nacional competente podrá iniciar de oficio, las acciones por infracción previstas en dicha legislación.

En caso de cotitularidad de un derecho, cualquiera de los cotitulares podrá entablar la acción contra una infracción sin, que sea necesario el consentimiento de los demás, salvo acuerdo en contrario entre los cotitulares.

#### CONSIDERACIONES DEL DESPACHO

En mérito de lo anteriormente expuesto y en cumplimiento del procedimiento normativo, garantizando el cumplimiento del debido proceso para las partes, y teniendo en cuenta todos los documentos aportados, y con base en el informe del perito; este Despacho considera pertinente ADMITIR LA SOLICITUD DE SUSPENSIÓN DE LA OPERACIÓN ADUANERA, presentada por el abogado: CAMILO ZAMORA FLOREZ en su condición de apoderado de la empresa: LUXOTTICA COLOMBIA S.A.S., en razón a que las mismas se presentaron dentro de la oportunidad que establece el artículo 626 del Decreto 390 de 2016.

En mérito de lo expuesto, la Jefe de la División de la Gestión de la Operación Aduanera, como autoridad competente

#### RESUELVE

ARTÍCULO PRIMERO. - AUTORIZAR LA SUSPENSIÓN PROVISIONAL DE LA OPERACIÓN ADUANERA, de la mercancía amparada con el documento de transporte No. MITCTG03010, en el contenedor No. KOSU451202-4, consignado al importador IEXPOR S.A.S con NIT: 900.065.277.

ARTÍCULO SEGUNDO: - ORDENAR a la empresa: ESTRATEGIA JURIDICA y/o al abogado CAMILO ZAMORA FLOREZ con TP No. 282432 del CS de la J. en calidad de representantes en Colombia de la empresa: LUXOTTICA COLOMBIA S.A.S con NIT: 900.829.318, La constitución de una garantía de compañía de seguros, dentro de los cinco (5) días hábiles siguientes a la ejecutoria del presente auto, equivalente al veinte por ciento (20%) del valor FOB de la mercancía, para garantizar los perjuicios que eventualmente se causen al importador o exportador, sin perjuicio de la responsabilidad de otro orden. En toda garantía habrá renuncia expresa al beneficio de excusión.

ARTÍCULO TERCERO. - NOTIFICAR por correo y subsidiariamente por aviso el contenido del presente acto administrativo, por parte del Grupo Interno de Trabajo de Documentación de la División de Gestión Administrativa y Financiera de Dirección Seccional de Aduanas de Cartagena, al abogado CAMILO ZAIVLORA - FLOREZ, identificado -con- la cédula de ciudadanía No. 1.026.259.272 expedida en Bogotá, y portador de la Tarjeta Profesional No. 282.432 del Consejo Superior de la Judicatura, en calidad de apoderada de la empresa: LUXOTTICA COLOMBIA S A S. con NIT: 900.829.318, en la siguiente dirección: Calle 90 No. 12-28 en la ciudad de Bogotá, D.C., de conformidad con lo establecido en los artículos 664 y 665 del Decreto 390 de 2016.

ARTÍCULO CUARTO. —NOTIFICAR por correo y subsidiariamente por aviso el contenido del presente acto administrativo, por parte del Grupo Interno de Trabajo de Documentación de la División de Gestión Administrativa y Financiera de Dirección Seccional de Aduanas de Cartagena, a IEXPOR S.A.S. con NIT: 900.065.277 a la dirección: AV VIA 40 73 290 OF 405 en la ciudad de Bogotá, D.C de conformidad con lo establecido en los artículos 664 y 665 del Decreto 390 de 2016.

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Continuación Por el medio del cual se resuelve una solicitud de suspensión de una operación de importación, por la presunta violación de derechos de propiedad industrial.

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ARTÍCULO QUINTO. — COMUNICAR el contenido del presente acto administrativo, por parte del G.I.T Documentación de la División de Gestión Administrativa y Financiera de la Dirección Seccional de Aduanas de Cartagena, al Depósito SOCIEDAD PORTUARIA REGIONAL DE CARTAGENA S.A. con NIT: 800.200.969-1, en la siguiente Dirección: Barrio Manga Terminal Marítimo de la Ciudad de Cartagena, para su conocimiento.

ARTÍCULO SEXTO: - COMUNICAR la presente decisión, por parte del GIT Documentación de la División de Gestión Administrativa y Financiera de la Dirección Seccional de Aduanas de Cartagena, al Grupo Interno de Trabajo Control Carga y Tránsito, Grupo Interno de Trabajo Exportaciones, Grupo Interno de Trabajo Importaciones, al Grupo No Formal de Control de Garantías, al Grupo No Formal Control de Usuarios Aduaneros, así como al Grupo Interno de Trabajo de Comercialización de la División de Gestión de administrativa y Financiera de esta Dirección Seccional; para los fines pertinentes.

ARTÍCULO SÉPTIMO - ADVERTIR al solicitante que contra el presente acto administrativo sólo procede el recurso de reposición, que deberá interponer dentro de los diez. (10) días siguientes a su notificación, de conformidad a lo establecido por los artículos 74, 76 y 77 del Código de Procedimiento Administrativo y de lo Contencioso Administrativo.

ARTÍCULO OCTAVO: - REMITIR una vez notificado, comunicado y ejecutoriado el presente acto administrativo por el Grupo Interno de trabajo de Documentación de la División de gestión Administrativa y Financiera de la Dirección Seccional de Aduanas de Cartagena, copia del mismo a la División de Gestión de la Operación Aduanera de la misma dirección seccional, para los fines legales pertinentes.

NOTIFÍQUESE Y CUMPLASE,

BL N A LEONOR BASTO RIN


Jefe I



Jefe División de Gestión de la Operación Aduanera

Revisó: ALIN C STILL -BÁBILONIA  
Jefe GIT Control Carga y Tránsito (A)

Proyecto: MIRALVIS GAMARRA



Jefe GIT Control Carga y Tránsito (A)

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## **Annex D. Interview**

Questions to University Professor and former SENA E official Antonio Torres

- 1. Based on your experience as a former official of the National Customs Service of Ecuador-SENAE, do you know if in the Customs District in Cuenca there have been cases of border measures ordered for an alleged infringement of an intellectual right?**

Answer: Yes

- 2. If the above answer is affirmative, were most of the proceedings before you ordered ex officio or requested at the request of an interested party?**

Answer: By Officio

- 3. From an operational point of view, could you describe how the procedures for the application of a border measure provided for in the Intellectual Property Law were carried out?**

Answer: Training was given to companies wishing to control imported products more efficiently, and recurrent intellectual property inspections were carried out on goods considered to be controls. If any anomaly was detected in these areas, the representatives of the brands were informed and they attended the public inspections and exercised their rights over the brands through the corresponding channels.

- 4. Do you consider that the procedures referred to in the previous question were effective in preventing an infringement of an intellectual right?**

Answer: Yes

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5. The reform contained in the Sugar Mills Code promulgated on December 9, 2016, limits the participation of SENA E and grants the National Service of Intellectual Rights - SENADI the exclusive competence for the knowledge

**and resolution of a procedure of border measures in matters of intellectual rights. What is your opinion on this?**

Answer: I believe that the fact that SENADI does not have ex officio physical access to suspicious cargo may be a problem.

**6. For its part, COPCI establishes coordination between public institutions as one of the fundamental principles to be observed by SENAE, in order to prevent the occurrence of a non-customs risk. How do you think compliance with this principle could be guaranteed?**

Answer: That again the customs can motivate the coordination in case of suspicious cargo.

**7. In accordance with the previous question, how do you consider that the administrators of Customs could better detect the alleged infringement of an intellectual right in the procedures of customs control?**

Answer: By means of intrusive physical gauging can be ascertained.

Thank you for your cooperation.



