

CHECKLIST OF ISSUES ON ENFORCEMENT<sup>1</sup>

Responses from Norway

Civil and Administrative Procedures and Remedies

(a) *Civil judicial procedures and remedies*

**1. Specify the courts which have jurisdiction over IPR infringement cases.**

All courts except the conciliation board have jurisdiction over IPR infringement cases.

**2. Which persons have standing to assert IPRs? How may they be represented? Are there requirements for mandatory personal appearances before the court by the right holder?**

All persons who have a legal interest in asserting IPRs, have standing to do so. They may be represented by independent legal counsel before the court.

In general, each party to civil proceedings is required to appear personally before the court (Sections 115, 116, 117, and 278 of the Act 13 August 1915 No. 6 relating to Judicial procedure in Civil Cases (JPCCA). However, a party who would have to travel far in order to appear personally, is exempted from the obligation to do so, provided that the court has not decided differently (JPCCA Section 199, cf Section 115). The court may order a party who is domiciled in Denmark, Sweden, Finland, or Iceland to appear before the court pursuant to the Act 21 March 1975 No. 9 relating to the Duty of Nordic Witnesses to Give Testimony (cf JPCCA Section 115). This is, however, seldom done, and a party who is domiciled abroad will therefore normally not be under any obligation to appear personally.

**3. What authority do the judicial authorities have to order, at the request of an opposing party, a party to a proceeding to produce evidence which lies within its control?**

The judicial authorities may, at the request of an opposing party, order a party to the proceedings to produce written evidence which lies within that party's control, unless the written evidence contains information which that party pursuant to the provisions relating to witnesses would not have to reveal if it were an oral testimony (JPCCA Section 250). The provisions relating to witnesses are primarily found in Section 204 to 209a of the JPCCA, and may be divided into two categories: (i) provisions which prohibit the witness from giving testimony (*e g*, in cases where the testimony could damage the security of the realm or relations to a foreign state), and (ii) provisions which allow a witness to refuse to give testimony, but without prohibiting the witness from giving testimony (*e g*, in cases where the testimony would be self-incriminating).

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**4. What means exist to identify and protect confidential information brought forward as evidence?**

In order to protect confidential information being brought forward as evidence, the court may decide to hear the evidence in a closed-doors session pursuant to Sections 125 and 127 of the Act 13 August 1915 No. 5 Relating to the Courts of Justice (the Courts Act) or Sections 204 to 206 of the JPCCA. Furthermore, in cases concerning patent rights, Section 65 of the Patents Act empowers the court to decide that the public, for the sake of commercial or business secrets of a party or a witness, shall be excluded from all or a part of the proceedings.

The court may instruct all those present in a closed-doors session not to reveal anything that they have learned in that session (Section 130 of the Courts Act).

**5. Describe the remedies that may be ordered by the judicial authorities and criteria, legislative or jurisprudential, for their use:**

- **injunctions;**
- **damages, including recovery of profits, and expenses, including attorney's fees;**
- **destruction or other disposal of infringing goods and materials/implements for their production;**
- **any other remedies.**

No particular term of law applies in Norwegian to what in English would be an "injunction", and Norwegian law therefore has no particular rules relating to injunctions as such. However, as regards Article 44 of the TRIPS Agreement, it should be noted that a right holder, or anyone else with a legal interest therein, may request the judicial authorities to establish the existence or non-existence of a legal right (JPCCA Section 54). The court may in such cases proclaim that a party does not have the right to commit an act, if committing it would constitute an infringement of an intellectual property right. The court may, e.g. proclaim that a party does not have the right to enter into the channels of commerce imported goods that involve the infringement of an intellectual property right.

Furthermore, it should in this context be noted that infringements of IPRs may be criminally prosecuted (cf the answers *infra* to questions 20 to 25). It may therefore also be said to follow *ipso jure* that a party is under an obligation to desist from infringement of IPRs.

Damages in respect of an infringement of an intellectual property right may be awarded pursuant to Section 38 of the Trade Marks Act, Section 58 of the Patents Act, Section 36 of the Designs Act, Section 6 of the Layout-Designs Act, Section 23 of the Plant Breeder's Right Act and Section 55 of the Copyright Act. Such damages include payment of a reasonable compensation for the (unlawful) use of the protected right, as well as for other losses that the infringement has caused the right holder.

A party to civil proceedings may be granted compensation for expenses incurred during the proceedings, including appropriate attorney's fees, pursuant to Chapter 13 of the JPCCA. The general rule is that a party who loses a case before the court, shall be ordered to compensate the other party's expenses in full (Section 172). If a case is partly won and partly lost, the main rule is that the parties have to cover their own expenses (Section 174).

Provisions on the destruction or other disposal of infringing goods are found in Section 40 of the Trade Marks Act, Section 59 of the Patents Act, Section 37 of the Designs Act, Section 8 of the Layout-Designs Act and Section 56 of the Copyright Act.

**6. In what circumstances, if any, do judicial authorities have the authority to order the infringer to inform the right holder of the identity of third persons involved in the production and distribution of the goods or services found to be infringing and of their channels of distribution?**

There are no particular provisions in Norwegian law giving judicial authorities in a civil case the authority to order the infringer to inform the right holder of the identity of third persons involved in the production and distribution of the goods or services found to be infringing, or of their channels of distribution.

**7. Describe provisions relating to the indemnification of defendants wrongfully enjoined. To what extent are public authorities and/or officials liable in such a situation and what "remedial measures" are applicable to them?**

A party who has abused enforcement procedures by requesting measures to be taken to wrongfully enjoin or restrain another party, may be ordered by the judicial authorities to provide compensation for the injury suffered because of such abuse (Section 3-5 of the Act 26 June 1992 No. 86 Relating to the Enforcement of Claims). The compensation is normally intended to cover all the losses that the abuse has caused the other party. The compensation may therefore also include all expenses incurred in the process of exoneration, including appropriate attorney's fees.

Public authorities are, also on the basis of jurisprudential law, not exempted from liability to appropriate remedial measures, where actions are taken or intended in bad faith in the course of the administration of any law pertaining to the protection or enforcement of IPRs.

**8. Describe provisions governing the length and cost of proceedings. Provide any available data on the actual duration of proceedings and their cost.**

There are no particular provisions governing the length and cost of proceedings. We have no available data on the actual duration of proceedings or their cost.

*(b) Administrative procedures and remedies*

**9. Reply to the above questions in relation to any administrative procedures on the merits and remedies that may result from these procedures.**

There are in Norway no administrative procedures or remedies relating to the issues dealt with in questions 1 to 8.

## **Provisional Measures**

(a) *Judicial measures*

**10. Describe the types of provisional measures that judicial authorities may order, and the legal basis for such authority.**

A person (the claimant) who has a claim against another person (the defendant) for something other than money, may request a provisional measure ("midlertidig forfoyning") pursuant to Chapter 15 of the Act 26 June 1992 No. 86 Relating to the Enforcement of Claims (ECA).

If the claim is for money, the claimant may request that "arrest" be taken in a piece of property owned by the defendant (Chapter 14 of the ECA). The rules relating to arrest are to a large extent the same as the rules relating to other provisional measures, but they will not be elaborated here since they are of no particular interest in relation to the requirements of the TRIPS Agreement.

A provisional measure may be ordered by the court if:

- (i) the defendant's behaviour necessitates a provisional safeguard of the main claim because the enforcement or the carrying out of that claim otherwise would become considerably more difficult, or
- (ii) it is necessary to establish a provisional arrangement in a legal dispute in order to avoid substantial damage or inconvenience, or to avoid any such violent action as the behaviour of the defendant might give reason to fear.

A provisional measure may, however, under no circumstances be ordered if the damage or inconvenience brought upon the defendant is in obvious disproportion to the claimant's interest in having the measure ordered (ECA Section 15-2).

As a provisional measure, the court may order the defendant to refrain from, to commit or to tolerate an act. The court may also order that a piece of property be taken out of the defendant's possession, or taken under custody or management. Imprisonment or any other form of restriction of the defendant's personal liberty may on the other hand not be ordered as a provisional measure (ECA Section 15-8).

**11. In what circumstances may such measures be ordered *inaudita altera parte*?**

Provisional measures may be ordered *inaudita altera parte* in two situations (ECA Section 15-7 first subsection):

- (i) If due notice of the oral proceedings has been given to the defendant, the court may order a provisional measure even if the defendant does not appear before the court. The court may, however, decide to postpone the proceedings instead if it is likely that the defendant has a valid reason for not appearing, or if the court has been informed that the defendant has a valid reason for being absent.
- (ii) If a delay might be dangerous, the court may order a provisional measure without hearing the defendant first in oral proceedings. (A delay may be considered "dangerous" if, e.g., it is likely to cause irreparable harm to the right holder, or where there is a demonstrable risk of evidence being destroyed.) In such cases, the defendant (as well

as anyone else affected by the measure) has the right to request that oral proceedings be held subsequently with a view to deciding, within a reasonable period after the notification of the measures, whether the measures shall be notified, revoked or confirmed (ECA Section 15-10). The parties shall be informed by the court of this right (ECA Section 15-8 fourth subsection).

**12. Describe the main procedures for the initiation, ordering and maintenance in force of provisional measures, in particular relevant time-limits and safeguards to protect the legitimate interests of the defendant.**

A provisional measure may as a general rule not be ordered unless the claimant has proven that it is more likely than not that he has a claim against the defendant (ECA Section 15-6). The court may make it a condition for ordering a provisional measure that the claimant provides a security or equivalent assurance sufficient to protect the defendant.

If the court decides to order a provisional measure, it shall at the same time decide how the measure is to be effectuated (ECA Section 15-8 second subsection). The court may decide when the measure is to enter into force, and the duration of it. The court may also decide that the defendant is to be able to avoid the entering into force and the effectuation of a provisional measure by providing a security or equivalent assurance sufficient to protect the claimant.

The court may in its decision to order a provisional measure, or in a later decision made upon the request of the defendant, determine a reasonable period in which the claimant must initiate civil proceedings leading to a decision on the merits of the case (ECA Section 15-8 third subsection).

The defendant may request a nullification or limitation of the measure if new evidence is put forward, or if the circumstances which the decision to order the provisional measure was based upon, in some other way have changed (ECA Section 15-11).

Where the provisional measures are revoked or where they lapse due to any act or omission by the claimant, or where it is subsequently found that there had been no infringement of an intellectual property right when the provisional measure was ordered, the judicial authorities have the authority to order the claimant to provide the defendant appropriate compensation for any injury caused by the measures (ECA Section 3-5).

**13. Describe provisions governing the length and cost of proceedings. Provide any available data on the actual duration of proceedings and their cost.**

The duration of these proceedings is generally very short, and the proceedings are comparatively cheap. We unfortunately do not have more concrete information available.

*(b) Administrative measures*

**14. Reply to the above questions in relation to any administrative provisional measures.**

Provisional measures may not be ordered administratively in Norway.

### **Special Requirements Related to Border Measures**

- 15. Indicate for which goods it is possible to apply for the suspension by the customs authorities of the release into free circulation, in particular whether these procedures are available also in respect of goods which involve infringements of intellectual property rights other than counterfeit trademark or pirated copyright goods as defined in the TRIPS Agreement (footnote to Article 51). Specify, together with relevant criteria, any imports excluded from the application of such procedures (such as goods from another member of a customs union, goods in transit or *de minimis* imports). Do the procedures apply to imports of goods put on the market in another country by or with the consent of the right holder and to goods destined for exportation?**

The laws and regulations relating to border measures are currently under revision with a view to ensuring the conformity of the relevant provisions with the requirements of the TRIPS Agreement. This will i.a. include changes in the Act Relating to Control of Marketing and Contract Terms and Conditions with regard to border control measures relating to wine and alcohol.

- 16. Provide a description of the main elements of the procedures relating to the suspension of the release of goods by customs authorities, in particular the competent authorities (Article 51), the requirements for an application (Article 52) and various requirements related to the duration of suspension (Article 55). How have Articles 53 (security or equivalent assurance), 56 (indemnification of the importer and of the owner of the goods) and 57 (right of inspection and information) been implemented?**

See answer to question 15.

- 17. Describe provisions governing the length and cost of proceedings. Provide any available data on the actual duration of proceedings and their cost. How long is the validity of decisions by the competent authorities for the suspension of the release of goods into free circulation?**

See answer to question 15.

- 18. Are competent authorities required to act upon their own initiative and, if so, in what circumstances? Are there any special provisions applicable to *ex officio* action?**

See answer question 15.

- 19. Describe the remedies that the competent authorities have the authority to order and any criteria regulating their use.**

See answer question 15.

### **Criminal Procedures**

- 20. Specify the courts which have jurisdiction over criminal acts of infringement of IPRs.**

All courts except the Conciliation Board have jurisdiction over criminal acts of infringement of IPRs.

**21. In respect of which infringements of which intellectual property rights are criminal procedures and penalties available?**

Criminal procedures and penalties are available in respect of:

- (i) the wilful use of a trade mark if the use constitutes an infringement of another person's right under the Trade Marks Act (Section 37 of that Act),
- (ii) any wilful infringement of a patent (Patents Act Section 57),
- (iii) any wilful infringement of a right to a design (Designs Act Section 57), and
- (iv) the wilful or grossly negligent infringement of another person's right under the Layout-Designs Act (Section 9 of that Act).
- (v) the wilful or negligent contravention of the Copyright Act (Section 54)
- (vi) the wilful infringement of the Plant Breeder's Right Act (Section 22)

Criminal proceedings and penalties are also available in respect of anyone who is an accessory to any of the Acts mentioned above under (i) to (vi).

**22. Which public authorities are responsible for initiating criminal proceedings? Are they required to do this on their own initiative and/or in response to complaints?**

The police are responsible for initiating criminal proceedings in respect of infringement of IPRs (Section 67 of the Criminal Procedure Act (CPA)).

In respect of violations of the Trade Marks Act, the Patents Act, and the Designs Act, criminal proceedings may only be initiated at the request of the aggrieved person. In respect of violations of the Layout-Designs Act, criminal proceedings may also be initiated on the own initiative of the police, if this is required in the public interest.

**23. Do private persons have standing to initiate criminal proceedings and, if so, who?**

The aggrieved party has standing to initiate criminal proceedings if the police decide not to initiate such proceedings, provided that prosecution has not been waived pursuant to Sections 69 or 70 of the Criminal Procedures Act (CPA Section 402).

**24. Specify, by category of IPR and type of infringement where necessary, the penalties and other remedies that may be imposed:**

- **imprisonment;**
- **monetary fines;**
- **seizure, forfeiture and destruction of infringing goods and materials and implements for their production;**
- **other.**

Fines or the imprisonment for up to three months is the punishment for anyone who is found guilty of infringement of another person's right under the Trade Marks Act (see Section 37), the Patents Act (see Section 57), the Designs Act (see Section 35), the Layout-Designs Act (see Section 9), the Copyright Act (see Section 54) or the Plant Breeder's Right Act (see Section 22).

For the rules governing the confiscation, destruction or amendment of goods constituting an infringement of:

- (i) a trade-mark, see Section 40 of the Trade Marks Act.
- (ii) a patent, see Section 59 of the Patents Act.
- (iii) a design, see Section 37 of the Designs Act.
- (iv) a layout-design, see Section 8 of the Layout-Designs Act.
- (v) a copyright or a neighbouring right, see Section 56 of the Copyright Act.
- (vi) a plant breeder's right, see Section 24 of the Plant Breeder's Right Act.

**25. Describe provisions governing the length and any cost of proceedings. Provide any available data on the actual duration of proceedings and their cost, if any.**

There are no provisions particularly governing the length or cost of proceedings. We have no available data on the actual duration of proceedings or their cost.