

Q236 - Relief in proceedings other than injunctions or damages

Erik Ficks



ROSCHIER

Introduction

- Extensive national reports
- Intensive working session
 - Definitions
 - Monetary relief
 - Third parties
 - Corrective advertising/publication of judgment
- Resource for potential new Q issues
- High approval rate for resolution

Relief in proceedings other than injunctions or damages

Noting that:

- 1) AIPPI has studied issues related to injunctions (Q219, Q215, Q214, Q204/204P, Q134, Q86 and Q80),
- 2) AIPPI has also studied issues related to damages (Q203, Q186, Q71),
- 3) AIPPI has not previously studied, as a dedicated question, forms of relief available in cases of infringement of IPRs other than injunctions and damages (***additional relief***). Additional relief may, in particular, include declaratory relief, delivery up / surrender of goods, destruction, rectification, alteration of infringing goods, corrective advertising, publication of judgments, orders to provide information, and monetary relief (other than damages),
- 4) This resolution concerns additional relief available in inter partes proceedings of a court or applicable administrative body (collectively, ***courts***) following a finding on the merits of the case.

Relief in proceedings other than injunctions or damages

Considering that:

- 1) The TRIPS Agreement provides in Part III Section 2 for certain forms of additional relief, in particular evidence (Article 43), disposal or destruction (Article 46) and information (Article 47),
- 2) There is broad support for the proposition that various forms of additional relief should be available, that already being the case in most jurisdictions, and harmonizing the availability of additional relief furthers the creation of effective and appropriate means for enforcement of IPRs,
- 3) Additional relief should be used to achieve a fair and just result, having regard to the circumstances of the jurisdiction and the case,
- 4) It creates legal certainty and reinforces an effective system for IPR enforcement for all parties to understand the basis on which, in practice, additional relief has been awarded or refused,

Resolutions

- 1) It should be the right and responsibility of the IPR holder to request the relief it believes to be appropriate to the circumstances of the case,
- 2) Courts should have the power to award additional relief for infringement,
- 3) In relation to monetary relief (other than damages), courts should have the power to award accounts of profits, reasonable royalties and/or reparation, in each case in jurisdictions in which the concept of damages does not already include them,

Resolutions - Voting

- 1) It should be the right and responsibility of the IPR holder to request the relief it believes to be appropriate to the circumstances of the case, **YES: 98,4%**
- 2) Courts should have the power to award additional relief for infringement, **YES: 97,6%**
- 3) In relation to monetary relief (other than damages), courts should have the power to award accounts of profits, reasonable royalties and/or reparation, in each case in jurisdictions in which the concept of damages does not already include them, **YES: 98,3%**

Resolutions

- 4) Courts should also have the power to award legal costs,
- 5) All forms of additional relief should be available in principle for all forms of infringement against all infringers, but the decision on whether and what is awarded or refused should be made on a case-by-case basis,
- 6) Where the grant of additional relief is contested, courts should give reasons for awarding or refusing additional relief, such reasons being sufficient to understand the rationale,

Resolutions - Voting

4) Courts should also have the power to award legal costs,

YES: 99,2%

5) All forms of additional relief should be available in principle for all forms of infringement against all infringers, but the decision on whether and what is awarded or refused should be made on a case-by-case basis, **YES: 99,2%**

6) Where the grant of additional relief is contested, courts should give reasons for awarding or refusing additional relief, such reasons being sufficient to understand the rationale,

YES: 99,2%

Resolutions

- 7) The reasons for awarding or refusing additional relief should in general be made available to the public (anonymised or not, in accordance with national practice),
- 8) Additional relief should be awarded or refused so as to achieve a fair and just result, having regard to the circumstances of the jurisdiction and the case,
- 9) Additional relief should be appropriate to the circumstances, reasonable, practicable, and proportionate,

Resolutions - Voting

- 7) The reasons for awarding or refusing additional relief should in general be made available to the public (anonymised or not, in accordance with national practice), **YES: 98,4%**
- 8) Additional relief should be awarded or refused so as to achieve a fair and just result, having regard to the circumstances of the jurisdiction and the case, **YES: 97,6%**
- 9) Additional relief should be appropriate to the circumstances, reasonable, practicable, and proportionate, **YES: 100%**

Resolutions

- 10) Taken as a whole, damages, injunctions and additional relief should be effective to prevent and/or dissuade further infringement,
- 11) Courts may, in appropriate circumstances, take the interests of third parties into account, and may hear those third parties, when determining whether to award additional relief,

Resolutions - Voting

- 10) Taken as a whole, damages, injunctions and additional relief should be effective to prevent and/or dissuade further infringement, **YES: 98,5%**
- 11) Courts may, in appropriate circumstances, take the interests of third parties into account, and may hear those third parties, when determining whether to award additional relief, **YES: 92,2%**

Resolutions

- 12) The award in a particular jurisdiction of an order requiring corrective advertising and/or publication of a judgment should have regard to whether and how, in that jurisdiction, judgments are made available to the public,
- 13) In relation to an order for corrective advertising, in general it is preferable that:
 - a. courts' procedures require that the party requesting the order also proposes wording, placement and costs, and effects its publication,
 - b. the party against whom the order is made pays the costs of publication.

Resolutions - Voting

- 12) The award in a particular jurisdiction of an order requiring corrective advertising and/or publication of a judgment should have regard to whether and how, in that jurisdiction, judgments are made available to the public, **YES: 94,3%**
- 13) In relation to an order for corrective advertising, in general it is preferable that:
- a. courts' procedures require that the party requesting the order also proposes wording, placement **and costs [YES: 51%]**, and effects its publication,
 - b. the party against whom the order is made pays the costs of publication. **YES: 89,8%**