

Question Q236



National Group: The Swedish AIPPI Group

Title: **Relief in IP proceedings other than injunctions or damages**

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I. Analysis of current law and case law

1. What forms of Additional Relief are available in IP proceedings?

[See tabular, appendix 1.](#)

2. Are those forms of Additional Relief available for all types of IPRs? If not, please indicate what types of Additional Relief are available for what types of IPRs.

[See tabular, appendix 1.](#)

3. Having regard to the types of Additional Relief available addressed by questions 1 and 2, what are the criteria for the grant of that relief? There may be different criteria for the different types of Additional Relief identified. Hence, the Groups are asked to address the individual criteria for each type of Additional Relief that is available in IP proceedings in their country.

General

[As a general rule the courts in Sweden are in contentious matters bound by the parties' motions. In theory a great number of different Additional Reliefs may therefore apply in proceedings regarding IPRs. The Additional Reliefs we address are the ones that are provided for in the different IPRs Acts and the Code of Judicial Procedure and therefore the most common \(and accepted\) reliefs.](#)

Additional Relief: Withdrawal from the market, alteration of infringing goods, surrendered for safekeeping, destruction or any other measure including means of assistance

	Patent	Trademark	Copyright	Design	Trade names	Plant Variety Rights	Topographies for Semiconductor Products
Relief							
Withdrawal from the market	✓	✓	✓	✓	✓	✓	✓
Modification/alteration of infringing goods (may include modification of technology)	✓	✓	✓	✓	✓	N/A	✓
Surrendered for safekeeping	✓	N/A	N/A	✓	N/A	N/A	N/A
Destruction	✓	✓	✓	✓	✓	✓	✓
Any other measure (e.g. delivery up and donating the products to charity)	✓	✓	✓	✓	✓	✓	✓

The court may grant a petition that the infringing product shall be withdrawn from the market, modified/alterd (this may include modification of technology), surrendered for safekeeping for the remainder of the period of the patent/term of protection (design) or destroyed or that any other measure shall be taken with it. “Any other measure” includes e.g. delivery up and donating the product to charity. The same applies to any means of assistance that was used or intended to be used for the infringement.

Criteria:

- Infringement has occurred.
- A petition by the one suffering the infringement (rightholder or licensee).
- It has to be reasonable (proportionality).
- The protected product was manufactured without the rightholder’s consent.
- A decision shall not be granted where forfeiture or any measure for the prevention of misuse shall be decided due to a criminal act either under the relevant IPRs Act or the Penal Code.

Additional Relief: Publication of judgment

	Patent	Trademark	Copyright	Design	Trade names	Plant Variety Rights	Topographies for Semiconductor Products
Relief							
Publication of judgment	✓	✓	✓	✓	✓	✓	✓

The court may order, at the request of the plaintiff, that the infringer or someone who has contributed to the infringement, pays the costs of appropriate measures for the dissemination of the information concerning the judgement. “Appropriate measures” includes first and foremost publication of the judgement in whole or part but may also include other disseminating measures, such as advertising or informing certain persons/entities depending on the case at hand.

Criteria:

- Judgment.
- A petition by the plaintiff (rightholder or licensee).

- Appropriate measures (proportionality).
- Decision against the infringer or someone that has contributed to the infringement.

Additional Relief: Order to provide information

Relief	Patent	Trademark	Copyright	Design	Trade names	Plant Variety Rights	Topographies for Semiconductor Products
Order to provide information	✓	✓	✓	✓	✓	✓	✓
Document production order	✓	✓	✓	✓	✓	✓	✓

The court may order, at the request of the plaintiff, that the infringer or any other person who, on a commercial scale, has disposition over an infringing product/has used an infringing service/has provided electronic communications service or another service which has been used in conjunction with the infringement or has participated in the manufacture or distribution of the infringing product or provision of the service, shall provide information regarding the origin and distribution networks of the goods or services which infringe an intellectual property right.

Criteria:

- Probable cause that someone has committed an infringement (the infringer does not have to be identified nor does one have to show that the infringement was committed with intent or by negligence).
- A petition by the rightholder or licensee.
- It may be issued only if it can be assumed that the information would facilitate an inquiry into the infringement or the violation related to the goods or services.
- Against the infringer or any other person mentioned above.
- An order to provide information may be issued only if the reasons speaking in favour of the measure outweigh the inconvenience or other harm that the measure would cause to the party against which it is directed or to any other opposite interest.
- The actions are further not amenable to out-of-court settlement and the court therefore always has to make an independent assessment of facts.
- The information does not encompass information which would disclose that the information provider or his/her kindred has committed a criminal act.

There is also a duty to produce documents as evidence (document production order) in a pending litigation under the Code of Judicial Procedure.

Criteria:

- The court may order anybody holding a written document that can be assumed to be of importance as evidence to produce it.
- There is an obligation to produce such document, however, with several exceptions, such as a party is not obliged to produce written communications between a party and a related person; public officials and other specifically mentioned professionals are not obliged to produce documents containing information they are not obliged to be heard as a witness about; a party is not

obliged to produce a document when the document is held by the party for whose benefit an obligation of confidentiality is imposed; there is no obligation for the party to produce a document that may incriminate the party or a person related to him. Furthermore, there is no obligation to produce jottings or any other like personal notes prepared exclusively for one's private use unless extraordinary reason exists for their production. Neither is there an obligation for someone in the possession of documents requested to be produced to disclose his or her trade secrets unless extraordinary reason exists for their production.

Additional Relief: Order for inspection

	Patent	Trademark	Copyright	Design	Trade names	Plant Variety Rights	Topographies for Semiconductor Products
Relief							
Order for inspection	✓	✓	✓	✓	✓	✓	✓

The court may, for the purpose of preserving evidence relating to the infringement where it can reasonably be assumed that someone has committed, or contributed to, an infringement, upon petition order that an investigation be undertaken in respect of that party in order to search for objects or documents that can be assumed to be of importance for the inquiry into the infringement (infringement investigation).

Criteria:

- Reasonably be assumed that someone has committed, or contributed to, an infringement.
- A petition by the rightholder or licensee.
- Purpose of preserving evidence relating to the infringement.
- An order for an infringement investigation may be issued only if the reasons speaking in favour of the measure outweigh the inconvenience or other harm that the measure would cause to the party against which it is directed or any other opposite interest.
- The opposite party shall be given an opportunity to respond before an order for an investigation is issued. Where a delay would entail a risk that objects or documents of importance for the inquiry of the infringement would be removed, destroyed or distorted, the court may, however, immediately issue an order to be valid until otherwise decided.
- An order for an infringement investigation may be issued only where the applicant deposits with the court a security to cover the loss that the opposing party may suffer. If the applicant does not have the means, the court may waive the security requirement.

Additional Relief: Declaratory relief

	Patent	Trademark	Copyright	Design	Trade names	Plant Variety Rights	Topographies for Semiconductor Products
Relief							
Declaratory relief	✓	✓	✓	✓	✓	✓	✓

A plaintiff may bring an action for a declaratory judgment to establish whether he or she enjoys protection against another party on the basis of a certain IPR, if there is uncertainty in this respect and this is prejudicial to him or her. This is specifically

mentioned in the Patents Act, the Design Act and the Plant Variety Act. Such declaratory relief may for the other IPRs be brought under the Code of Judicial Procedure to establish a legal relationship.

Furthermore, a declaratory relief under the Code of Judicial Procedure may be brought to establish whether an infringement is at hand or not or regarding prior/better right of trademarks and trade names (the Patents Act, the Design Act and the Plant Variety Act have specific rules in this respect*).

Criteria:

- An action by the rightholder or licensee.
- An uncertainty exists to a legal relationship.
- The uncertainty exposes the plaintiff to detriment.
- *Upon an action by the one entitled, the court shall transfer the registration. There is also a time limitation within which an action must be brought.

Additional Relief: Rectification etc.

Relief	Patent	Trademark	Copyright	Design	Trade names	Plant Variety Rights	Topographies for Semiconductor Products
Rectification	✓	✓	N/A	✓	N/A	✓	N/A
Transfer of an application due to a prior/better right	✓	✓	N/A	✓	N/A	✓	N/A
Transfer of a registration due to a prior/better right	✓	✓	N/A	✓	N/A	✓	N/A
Cancellation of registration	✓	✓	N/A	✓	✓	✓	N/A

Transfers of rights (and pledges), licenses and judgments declaring superior right to a registration shall be noted in the register upon request. Note that a pledge is created with effect in relation to third parties by applying to register a written agreement regarding pledging of the IPR.

Regarding transfer of a registration due to a prior/better right, see above under declaratory relief.

In this context cancellations of registration may also be discussed. Cancellation of patents, designs or plant variety rights is obtained by bringing an action to the court. Regarding trademarks and trade names cancellation may either be applied for at the registering authority (Patent and Registration Office or Swedish Companies Registration Office) or by bringing an action to the court

Criteria:

- Rectification in a register is in general made upon request.
- Rights shall be deregistered once a cancellation order has gained legal force.

Additional Relief: Reasonable compensation

Relief	Patent	Trademark	Copyright	Design	Trade names	Plant Variety Rights	Topographies for Semiconductor Products
Reasonable compensation (royalty)	✓	✓	✓	✓	✓	✓	✓
Reasonable compensation when continued use of infringing goods	✓	N/A	✓	✓	N/A	✓	N/A (with reservation)

Reasonable compensation (usually determined as a reasonable royalty) shall be paid as damages in IP proceedings where an infringement has been established.

Criteria:

- In copyright proceedings where an infringement has been established.
- In topographies for semiconductor products proceedings where an infringement has been established and it is deemed reasonable.
- In patent, trademark, design, trade names and plant variety's rights proceedings where an infringement has been established and the infringer has been at least negligent or that it is otherwise considered reasonable to order a good faith infringer to pay compensation.

Reasonable compensation shall be paid when an owner of infringing goods is entitled to use such goods for the remainder of, or a part of, the period of protection.

Criteria:

- Upon petition by an owner of infringing goods.
- Such owner has acted in good faith.
- There exist extraordinary reasons for the court to order that such owner shall enjoy the use of the property for the remainder of, or a part of, the period of protection.

Particularly about trade secrets

Most of the Additional Reliefs mentioned in our tabular are not applicable on misappropriation of trade secrets, which legislation differs from the other IPRs mentioned. See Appendix 2. The reason for the substantial difference compared to the other IPRs is that the legislation in relation to confidential information/trade secrets is not subject to the Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the Enforcement of Intellectual Property Rights (the "EU Enforcement Directive on IPRs"). The Additional Reliefs applicable are first of all delivery up (under certain circumstances compensation by the rightholder may be ordered by the court). If the trade secrets cannot, without prejudice, be delivered to the rightful owner alteration or destruction of e.g. the documents may be ordered or any other measure be taken that may prevent abuse. A decision shall not be granted if the use or disclosure was not unauthorized or of if forfeiture or other measure for the prevention of misuse shall be decided under the Penal Code.

It is also possible to obtain a document production order under the general rules in the Code of Judicial procedure, as well as a declaratory relief and provisional attachment and other security measures.

Account of profits or reasonable royalty is not mentioned in the provisions regarding damages, but it may be argued before the court and taken into account in the court's assessment of damages.

4. Is there any element of judicial discretion in relation to the grant of any form of Additional Relief addressed in questions 1 and 2? If so, how is that discretion applied?

As mentioned above the courts are bound by the parties' motions. No Additional Reliefs are ordered unless requested by the plaintiff. The judicial discretion is exercised in that the courts make their individual assessment of the relevant circumstances in the case at hand.

5. Are any particular forms of Additional Relief invariably ordered in certain circumstances? If so, what types of Additional Relief and in what circumstances? Does that occur pursuant to mandatory statutory regulation, or by reason of the practice of the relevant court (or applicable administrative body)?

No Additional Reliefs are ordered unless requested by the plaintiff. The courts are not mandated to order any Additional Relief on own motion. Neither are any types of Additional Relief mandatory under law. There is always room for the courts' individual assessment of the relevant circumstances in the case at hand.

"Reasonable compensation" (usually determined as a reasonable royalty) shall always be paid as damages in copyright proceedings where an infringement has been established (irrespective of the infringer having acted in good faith), while in other IP proceedings it is required that the infringer has been at least negligent or that it is otherwise considered reasonable to order a good faith infringer to pay compensation. However, the threshold for negligence in IP proceedings is generally low and "reasonable compensation" is therefore invariably ordered as damages.

6. Are there any specific considerations relevant to particular IPR holders? If so, what considerations are relevant and in respect of what IPR holders?

There are no specific considerations relevant to particular IPR holders, such as so-called Non-Practicing Entities ("NPEs"). To be noted is that also non-exclusive licensees generally have party standing in IP proceedings. For non-exclusive licensees it may be problematic to show that the infringer *inter alia* infringed the licensed right and was aware of the licensed right being infringed, i.e. was not acting in good faith when conducting the infringement (see e.g. the court of appeal case Göta Hovrätt, docket no. T 3050-11, 25 September 2012, leave to appeal to the Supreme Court denied and the judgment is therefore final).

7. Can a court (or applicable administrative body) order any form of Additional Relief directly against a non-party to an IP proceeding?

Yes. However, it should be noted that it is a general principle of Swedish law that everyone has a right to be heard and we have thus interpreted questions 7-10 to include the case where a rightholder files a separate motion directly against a non-party to the main IP proceedings.

8. If yes to question 7:

a) in what circumstances;

The court may order, upon application, that any other person (apart from the infringer) who, on a commercial scale, have disposition over an infringing product/have used an infringing service/have provided electronic communications service or another service which has been used in conjunction with the infringement or have participated in the manufacture of distribution of the infringing product or provision of the services to provide information (what type of information is specified under b).

Criteria:

- Probable cause that someone has committed an infringement (the infringer does not have to be identified nor does one have to show that the infringement was committed with intent or by negligence).
- A petition by the rightholder or licensee.
- It may only be issued if it can be assumed that the information would facilitate an inquiry into the infringement of the violation related to the goods or services.
- An order to provide information may only be issued if the reasons speaking in favour of the measure outweigh the inconvenience or other harm that the measure would cause to the party against which it is directed or any other opposite interest.
- The actions are further not amenable to out-of-court settlement and the court therefore always has to make an independent assessment of facts.
- The information does not encompass information which would disclose that the information provider or his/her kindred has committed a criminal act.

According to the preparatory works (to the Swedish Copyright Act) this could mean that an internet service provider would be obliged to disclose information about which specific subscriber that has had an IP-address, which has been used to make available or copy works protected by copyright via the internet (in a recent case from the Supreme Court, Ö 4189-09, the court ordered an internet service provider to disclose the identity of the person behind a specific IP-number.)

b) what forms of Additional Relief may be ordered;

The information could, in particular, comprise:

- The names and addresses of the producers, manufacturers, distributors, suppliers and other previous holders of the goods or services.
- The names and addresses of the intended wholesalers and retailers.
- Information on the quantities produced, manufacture red, delivered received or ordered, as well as the price obtained for the goods or services in question.

c) in respect of what types of IPR infringement?

	Patent	Trademark	Copyright	Design	Trade names	Plant Variety Rights	Topographies for Semiconductor Products
Relief							
Order to provide information	✓	✓	✓	✓	✓	✓	✓

9) Is a court (or applicable administrative body), in making an order for Additional Relief against an IPR infringer who is party to the IP proceeding, obliged to consider the impact of such order on any non-party? If so, how does the court (or applicable administrative body) fulfill that obligation?

The court shall consider competition law binding and therefore take it into consideration in any proceedings regarding IPR. This is however rarely discussed in the courts' findings other than when a party has particularly brought it into the case. Another aspect is that when a court issues an **order to provide information** or an **order for inspection** it has to assess whether reasons speaking in favour of the measures outweigh the inconvenience or other harm that the measures would cause to the party against which it is directed or *any other opposite interest*. Such *opposite interest* could typically include interests of non-parties and must therefore be considered when the court decides whether or not to grant the motion to provide information.

10) If yes to question 7 or 9, is the court (or applicable administrative body) obliged to give relevant non-party an opportunity to be heard? If so, how is that effected?

No.

II. Proposals for harmonisation

11. What forms of Additional Relief should be available in IP proceedings, and for what types of IPRs?

With regard to the forms of Additional Relief that are available in IP proceedings, as explained in tabular, appendix 1, it is our belief that the forms of Additional Relief harmonised through the EU Enforcement Directive on IPRs are, at the moment, sufficient. It is the Group's belief that the time is not right to introduce additional rules in relation to Additional Relief in IP proceedings. At this point focus shall instead be on increasing the acceptance of the existing measures and to ensure that these measures are applied in a balanced way. The introduction of provisions on i.a. order to provide information and order for inspection has caused discussions on the aspect of integrity and the measures are considered to be rather far-reaching, not the least because the IPRs (at the stage of the proceedings when such preliminary measures are decided) are often uncertain regarding validity and scope of protection. In order to maintain respect for IPRs in society and in the commercial sector it is thus of utmost importance to obtain acceptance for the rights and the already available measures before considering any additional harmonization of rules on Additional Relief. However, as IPR, technology, etc. develops there may be need for further alternatives of Additional Relief in the future.

The Group believes that, in addition to clearly establishing the available Additional Relief in IP proceedings in the EU, it is desirable to harmonise the provisions on marketing law and trade secrets in certain aspects in order for the legislations to become more in conformity with that for the IPRs covered by the EU Enforcement Directive on IPRs.

12. What should the criteria be for the grant of the types of Additional Relief identified in response to question 11?

Please see the EU Enforcement Directive on IPRs and question 1-3 above

13. Should there be any specific considerations relevant to particular IPR holders? If so, what should those considerations be and in respect of which IPR holders?

In principle, no. While there may be valid concerns regarding the use of injunctions by certain IPR holders in a manner which is not desirable, this does not seem to be an issue with regard to any Additional Relief. In exceptional cases when it is completely clear that an abuse is at hand there may be a potential need for specific considerations.

14. Should any particular form of Additional Relief be mandatory in certain circumstances? If so, what types of Additional Relief and in what circumstances?

No.

15) Should a court (or applicable administrative body) be empowered to order any form of Additional Relief directly against a non-party to an IP proceeding?

Yes, but only courts should have this power and the circumstances under which any form of Additional Relief is justifiable to be ordered directly against a non-party to an IP proceeding should be strictly limited. The option of raising such claim directly against the relevant non-party and thus engaging such non-party as a party to infringement proceedings, separately or jointly, should be considered as a main alternative.

16) If yes to question 15:

a) in what circumstances;

Please refer to question 15.

b) what forms of Additional Relief should a court (or applicable administrative body) be empowered to order; and

This should normally be limited to such relief as is described in article 8 of the the EU Enforcement Directive on IPRs and article 50.1 b in TRIPS – i.e. information orders. Other types of Additional Relief should require the plaintiff to initiate proceedings against the non-party.

c) in respect of what types of IPR infringement?

The Group considers certain IPRs, such as copyright and trademark infringements, to be the obvious types to be included. Alleged patent infringement should normally be included, but it is acknowledged that there is a risk for “fishing expeditions” in search of technical information. There is a risk of increased difficulty for the courts to assess whether information requested might damage the party subject to the request in terms of its IPR or trade secrets in a patent related situation. The assessment of

whether there is a substantiated claim of infringement is also normally more difficult to make in a patent case.

- 17) Should a court (or applicable administrative body), in making an order against an IPR infringer who is a party to the proceeding, be obliged to consider the impact of such order on any non-party? If yes, how should the court (or applicable administrative body) fulfil that obligation?**

Court and administrative bodies should always be obliged to consider the effects of their decisions.

- 18) If yes to question 15 or 17, should the court (or applicable administrative body) be obliged to give any relevant non-party an opportunity to be heard? If so, how should that be effected?**

Yes, in relation to question 15, in order to limit the possible damage of harmful disclosure of non-party trade secrets and in the interest of avoiding the ordering of self-incriminating disclosures. The obligation should, however, not be absolute but in the discretion of the court with a similar assessment as made in other cases of a party seeking *ex parte* relief. The Group further considers that there should be an opportunity also for the non-party to appeal any Additional Relief directed against such non-party separately from the “main proceedings”.

- 19) Please provide any other proposals in respect of harmonisation as to the types of Additional Relief that should be available in IP proceedings and the conditions in which such relief should be ordered.**

Please refer to Question 11.

SUMMARY

There is a wide range of additional reliefs available in Sweden in relation to IPR infringement. The IP legislation is harmonized with respect to the EU Enforcement Directive on IPRs (Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights). The implementation of the Directive came into force in Sweden as of April 2009 and court practice regarding new reliefs such as order to provide information and publication of judgment have not been developed except in one case where the CJEU (C-461/10) issued guidance in relation to an order requiring an internet service provider to provide information about IP addresses. In the national stage of the same case (Ö 4189-09) the Swedish Supreme Court has reminded that the threshold of evidence to show infringement must not be too high (likelihood of infringement).

Trade secrets are not subject to the Directive and in some parts dealt with in a different way than the IPRs.

There are limited possibilities for judicial discretion and reliefs against third parties. We have not found any case law indicating different approach with respect to NPEs.

As to the harmonization part the Swedish group is of the opinion that the range of different reliefs available in Sweden (and the EU) is satisfactory and that no further Additional Reliefs are required in proposals for harmonisations. The challenge is to obtain acceptance in some groups of the society for the sanctions available.

Question 1-2

Relief	Patent	Trademark	Copyright	Design	Trade names	Plant Variety Rights	Topographies for Semiconductor Products
Withdrawal from the market	✓	✓	✓	✓	✓	✓	✓
Modification/alteration of infringing goods (may include modification of technology)	✓	✓	✓	✓	✓	N/A	✓
Surrendered for safekeeping	✓	N/A	N/A	✓	N/A	N/A	N/A
Destruction	✓	✓	✓	✓	✓	✓	✓
Any other measure (e.g. delivery up and donating the products to charity)	✓	✓	✓	✓	✓	✓	✓
Publication of judgment	✓	✓	✓	✓	✓	✓	✓
Order to provide information	✓	✓	✓	✓	✓	✓	✓
Order for inspection	✓	✓	✓	✓	✓	✓	✓
Declaratory relief	✓	✓	✓	✓	✓	✓	✓
Rectification	✓	✓	N/A	✓	N/A	✓	N/A
Transfer of an application due to a prior/better right	✓	✓	N/A	✓	N/A	✓	N/A
Transfer of a registration due to a prior/better right	✓	✓	N/A	✓	N/A	✓	N/A
Cancellation of registration	✓	✓	N/A	✓	✓	✓	N/A
Account of profits – is part of the assessment of damages*	✓	✓	✓	✓	✓	✓	✓
Reasonable compensation (royalty)	✓	✓	✓	✓	✓	✓	✓
Reasonable compensation when continued use of infringing goods	✓	N/A	✓	✓	N/A	✓	N/A (with reservation)
Order of sequestration	✓	✓	✓	✓	✓	✓	✓

* Since account of profits is part of the assessment of damages it will not be discussed further.

Question 1-2

Relief	Confidential information/trade secrets
Delivery up	✓
Destruction	✓
Alteration of document or object	✓
Any other measure	✓
Document production order	✓
Declaratory relief	✓
Account of profits	(May be part of the assessment of damages)
Reasonable royalty	(May be part of the assessment of damages)