

Norway



By **Rune Nordengen**, Bull & Co Advokatfirma AS

1. What are the most effective ways for a European patent holder whose rights cover your jurisdiction to enforce its rights in your jurisdiction?

Cases concerning patent infringement must be brought before the ordinary courts in Norway.

A preliminary injunction is the fastest and most effective way of stopping infringing acts. The conditions for obtaining a preliminary injunction are described below in Question 13. Once a preliminary injunction has been obtained, it must be followed by main proceedings.

Main proceedings involving patents are generally brought directly before:

- the district court with jurisdiction over the area where the infringer is based; or
- the court with jurisdiction over the area in which the damage originated, or in which its effect occurred or may occur.

2. What level of expertise can a patent owner expect from the courts in your jurisdiction?

Norway has no specialised patent courts. Professional judges are educated and trained in law and rarely have any technical expertise. However, if requested by one of the parties for the proper conduct of the case, the court shall appoint lay judges, who may be experts. In patent cases it is usual for one or both parties to request the appointment of judges with special technical knowledge relevant to the case and/or expertise related to the patent system.

The Oslo City Court is the mandatory venue for cases involving patent invalidity claims. Consequently, that court is also the venue for most Norwegian patent infringement

cases. Many professional judges of that court are therefore highly experienced in patent cases.

3. How do your country's courts deal with validity and infringement? Are they handled together or separately?

The starting point is that these two cases are separate.

The defendant may, however, bring counterclaims – for example, a claim for invalidity – against the claimant and request that the cases be joined. A prerequisite to joining an invalidity case with an infringement case is that the court be the correct venue for one of the claims. As discussed above, a claim for invalidity must be brought before the Oslo City Court. Consequently, if – as is often the case – invalidity is raised as a counterclaim, the plaintiff in the invalidity case can request that the two cases be joined, but only before the Oslo City Court. A request to join an infringement case and an invalidity case is usually accepted.

4. To what extent is cross-examination of witnesses permitted during proceedings?

Witnesses give oral testimony. The witness should normally provide a continuous account of all or certain parts of the facts of the case, before more detailed questions are asked. Written statements made for the purpose of the case may be presented as evidence if the parties have the opportunity to examine the person who has made the statement. Cross-examination of witnesses is thus permitted during the proceedings.

5. What role can and do expert witnesses play in proceedings?

Expert witnesses play an important role, as

patent cases often involve complex technical assessments. Professional judges and attorneys will not usually possess a formal technical/scientific education and expert witnesses can thus offer valuable help and insight into specialist areas.

Expert witnesses may be appointed by the court itself and the parties may call witnesses to give expert testimony. It is common for the parties to call expert witnesses.

An expert witness may attend the hearing throughout and may be allowed to ask questions to parties, witnesses and experts.

6. Is pre-trial discovery permitted? If so, to what extent?

Before submission of the writ of summons, a party may request that evidence be secured by judicial examination of parties and witnesses, and by providing access to – and inspecting – real evidence. A petition to secure evidence shall, as a rule, be submitted to the court before which a lawsuit will subsequently be brought.

In order to succeed in an action to secure evidence, such evidence must be significant to a dispute to which the petitioner may become a party or intervener. There must also be a clear risk that the evidence would be either lost or considerably impaired, or other reasons why it is particularly important to obtain access to the evidence before a lawsuit is instigated.

The petitioner shall cover expenses incurred by its opponents in this regard, but may later claim costs from the opponent in a subsequent court case if the evidence thus secured is used in a trial.

After a writ of summons is submitted, the parties must ensure that the factual basis of the case is properly and completely explained. The parties must provide such accounts and present such evidence as is necessary to fulfil this duty; they must give testimony and grant access to anything that may constitute evidence in the legal proceedings.

All parties must disclose the existence of important evidence of which they are aware, even if such evidence is not in their possession and if they have reason to believe that their opponent is unaware of it. This applies irrespective of whether such evidence favours their case.

A party or witness may refuse to provide

access to evidence that cannot be made available without revealing trade or business secrets. The court may nevertheless order the disclosure of such evidence if, after balancing the relevant interests, the court finds this necessary.

7. Do the courts in your jurisdiction apply the doctrine of equivalents?

The Supreme Court confirmed in 2009 what had been claimed in legal theory – namely, that the doctrine of equivalents exists in Norway. The criteria for applying the doctrine are that:

- the allegedly infringing object solve the same problem as the patented invention;
- the modifications be obvious to the skilled person; and
- the allegedly infringing object be made not using free available techniques.

8. Are certain patent rights (eg, those relating to business methods, software and biotechnology) more difficult to enforce than others?

To the author's knowledge, no specific rights are more difficult to enforce than others. The assessment depends on the strength of the individual patent.

9. How far are the courts bound by previous decisions in cases that have covered similar issues?

Courts are not formally bound by previous decisions. However, judgments in similar cases, especially judgments of higher courts – in particular, the Supreme Court – are followed in practice.

In assessing the question of invalidity, the courts have full power of judicial review. However, in practice the Norwegian courts exercise restraint when reviewing the opinion of the Norwegian Industrial Property Office.

10. Are there any restrictions on whom parties can select to represent them in a dispute?

The parties must select an attorney at law to represent them before the courts. The appointed attorney usually cooperates closely with a patent attorney, as well as with other experts.

11. Are the courts willing to consider the reasoning of courts in other jurisdictions that have dealt with similar cases?

The courts are willing to consider the reasoning of courts in other jurisdictions, but they do not feel bound by decisions in individual cases. The courts assess the individual merit of the decisions from other jurisdictions.

Decisions are then taken based on an assessment of the facts of the Norwegian case. It is common for the courts in Norway to reach a conclusion that differs from that of courts in other jurisdictions in similar cases.

12. How easy is it for defendants to delay proceedings and how can plaintiffs prevent them from doing so?

It is difficult to delay proceedings. The courts must schedule a case within six months of the date of submission of the writ of summons. The case may be scheduled later than six months only if special circumstances make it necessary. District courts usually manage to schedule cases within the specified timeframe.

However, processing times at the appeal courts are significantly longer, due to a lack of capacity.

13. Is it possible to obtain preliminary injunctions? If so, under what circumstances?

The court may grant a preliminary injunction if the claim in respect of which the petition for a preliminary injunction is made and the basis for security are proven on a balance of probabilities. The court will grant a temporary injunction if either:

- the defendant's conduct makes it necessary to secure the claim provisionally, as the action or execution of the claim would otherwise be considerably impeded; or
- the court finds it necessary to establish a temporary arrangement in relation to a disputed legal issue in order to avert considerable loss or inconvenience.

Further, a preliminary injunction cannot be granted if the loss or inconvenience to the defendant would be clearly disproportionate to the interests of the petitioner in the preliminary injunction being granted. The court has some discretion in assessing whether an injunction shall be granted.

If the court finds that delay poses a risk, it may grant a preliminary injunction even if the petitioner's claim is not proven.

The court may decide that a preliminary injunction shall become effective and executed only if the petitioner provides security determined by the court, to cover any compensation to the defendant for which the petitioner may eventually be found liable.

14. How much should a litigant plan to pay to take a case through to a decision at first instance?

In the author's experience, the legal fees for each side of a full patent trial before a court of first instance will often amount to between Nkr750,000 and Nkr1.5 million, sometimes even more. The costs of other experts and advisers are additional. The cost is, of course, dependent on the complexity of the case, the amount of evidence to consider and the need for consultations and assistance from expert advisers and witnesses. If a case involves both an infringement and invalidity claim that may be joined in one hearing, the costs may be somewhat higher – although, as the technical difficulties are essentially the same, it is cost efficient to join the cases.

A case for a preliminary injunction will amount to approximately the same as an ordinary court case if a full oral hearing is required.

In addition to legal fees, the parties will be required to pay court fees and the fees of the expert lay judges. Court fees are not high, but expert lay judges normally command the same hourly rates as legal counsel and expert consultants.

15. Is it possible for the successful party in a case to obtain costs from the losing party?

In most cases the winning party will be awarded all costs. The losing party may consequently end up paying all costs on both sides, as well as the court fees and the fees of the lay judges.

16. What are the typical remedies granted to a successful plaintiff by the courts?

The typical remedies in a patent infringement case are an injunction order (ie, ordering the infringer to stop the infringing actions) and damages.

17. How are damages awards calculated? Is it possible to obtain punitive damages?

The main rule for calculating damages/compensation is that damages shall provide compensation for the exploitation of someone else's property. The amount is calculated using one of two methods – either the licence fee (royalty) approach or the loss of sales approach. The patent holder may also claim additional damages beyond compensation for exploitation, provided that it can prove additional losses, such as increased marketing or sales costs.

Further, the court may apply two different rules for limiting or modifying the compensation based on minor blame or mitigating circumstances (eg, where the infringer acted with care and in good faith).

The court may not award punitive damages.

18. How common is it for courts to grant permanent injunctions to successful plaintiffs and under what circumstances will they do this?

The court will grant permanent injunctions to successful plaintiffs.

19. How long does it take to obtain a decision at first instance and is it possible to expedite this process?

According to the Civil Proceedings Act, a hearing shall be scheduled within six months of the filing of a writ of summons. After the hearing has concluded, the court should issue its decision within four weeks, although in more complex cases (typically, patent cases) the court usually needs more time. It is difficult to expedite the process.

20. Under what circumstances will the losing party in a first instance case be granted the right to appeal? How long does an appeal typically take?

The losing party in a first instance case usually has the right to appeal.

An appeal against a judgment in an asset claim shall not be referred for hearing without leave of the court of appeal if the value of the subject matter of the appeal is less than Nkr125,000. This limitation is seldom problematic in patent cases, because the enforcement of a patent often relates to higher

values, and because enforcement of a patent right also has a value beyond the monetary value of the damages claim.

An appellate court may also refuse leave to appeal a judgment if it is clear that the appeal will be unsuccessful. The application of this right for the appeal court to refuse leave is limited.

The appeal courts are bound by the same rules as those described under Question 19 above. However, processing times are currently longer than the six-month rule. Decisions should not be expected within one year of filing the appeal.

21. Are parties obliged to undertake any type of mediation/arbitration prior to bringing a case before the courts? Is alternative dispute resolution a realistic alternative to litigation?

Mediation is not mandatory. However, the Dispute Act especially mentions that the parties to a dispute may agree to out-of-court mediation and/or mediation before the courts.

Alternative dispute resolution may be a realistic alternative, but this depends on the facts of the case and the willingness of the parties.

22. In broad terms, how pro-patentee are the courts in your jurisdiction?

The author's experience is that the courts' assessment depends on the strength of the individual patent and is usually quite balanced.

23. Has your jurisdiction signed up to the London Agreement on Translations? If not, how likely is it to do so?

Norway has not signed the London Agreement on Translations and is unlikely to do so in the near future. *iam*

Bull & Co Advokatfirma AS

Observatorieggt 1B, PB 2583 Solli
0203 Oslo, Norway

Tel +47 23 01 01 01

Fax +47 23 01 01 11

Web www.bullco.no



Rune Nordengen

Senior associate

+47 23 01 01 01

r@bullco.no

Rune Nordengen specialises in IP and general commercial law, focusing on patents, trademarks marketing and copyright. He obtained his *cand jur* from the University of Oslo and his LLM from the University of Leicester in 2001. He acts for a number of Norwegian and international companies on questions of IP rights and marketing law, as well as providing general legal advice. His clients include household-name brand, as well as pharmaceutical companies. He has broad experience in pursuing infringements of IP rights. Mr Nordengen has litigation experience - especially in the areas of patent, trademark and marketing law - before all Norwegian courts, including the Supreme Court.

He is a member of the Norwegian Bar Association and several professional associations, such as the Norwegian group of the International Association for the Protection of Intellectual Property.