

XXXV NIR MEETING 2022, OSLO

Preliminary injunctions in IP cases

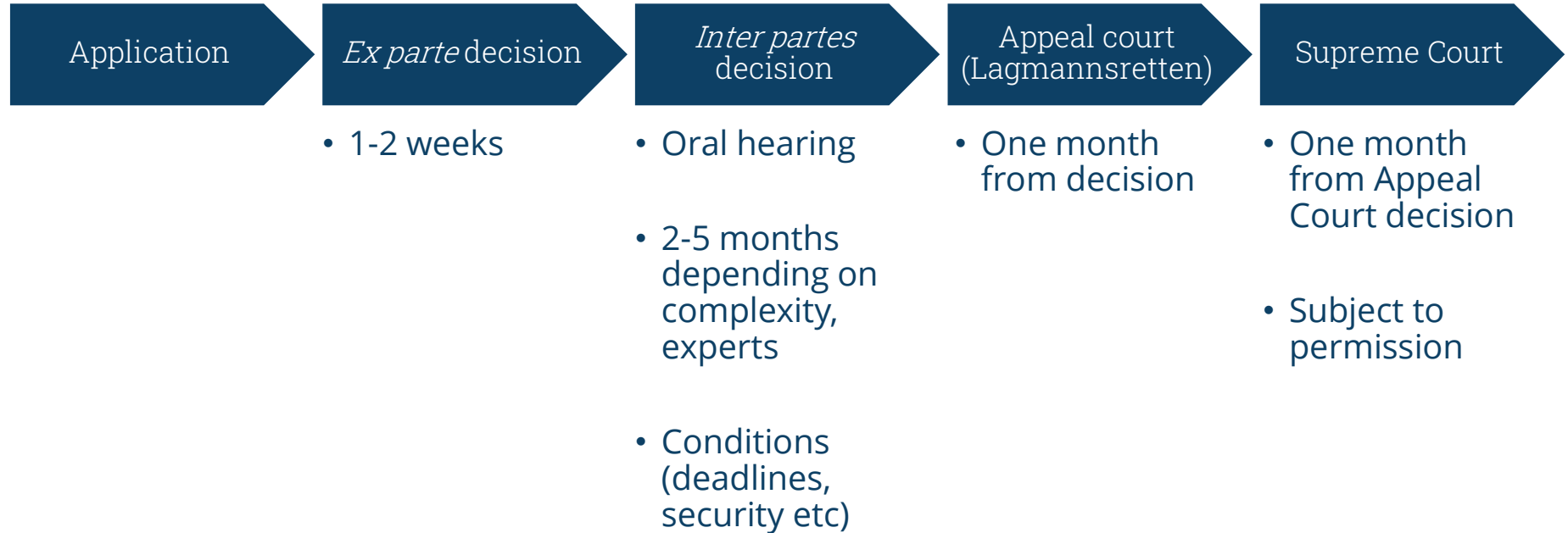
Norway

ADVOKAT CAMILLA VISLIE (H)

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Timelines and process



Conditions

Claim

- Assessment of infringement and validity
- Invalidity defense may be tried prejudicially in injunction cases Rt. 2004 s. 763 (Vestdavit)

Need for preliminary measure

- Defendant's conduct - action or execution of the claim would be considerably impeded Rt. 2003 s. 1165, **or**
- Necessary to avoid considerable loss or inconvenience LB-2015-90322

Proportionality

- LB-2015-90322

Security

- The court **may** require security
- TOBYF-2010-139982 (MNOK 44) og TOBYF-2010-19069 (MNOK 35)



Availability pre grant

- Injunction **may** be decided before grant in certain situations (§ 60 cf. § 56 a)
- Conditions:
 - application is available to the public
 - likely that the application will be granted to the extent that it covers the disputed product/practice (Prop. 81 L (2012-2013))



Validity – burden of proof and defending a PI based on invalidity arguments

- The claimant must substantiate the claim and the need for preliminary measure (+ 50% probability)
- Defending a PI based on invalidity arguments
 - Patents/SPCs: At the outset there is a presumption for validity (Rt. 1975-603 (Swingball)) – in practice the defendant must present new evidence/arguments for invalidity
 - Invalidity arguments are often presented in PI cases 17-183870TVI-OBYF (Merck/Exeltis 2018), 20-101788TVI-OBYF og 20-103739TVI-OBYF (Biomar/Evos)
 - If there is a serious, non-negligible probability that the patent would be invalidated in (regular) invalidity proceedings, injunction will not be granted
 - Validity presumption (the "Swingball principle") does not apply the same way to trademark cases LB-2015-195034 (Potetgull)
 - Burden of proof may shift from claimant to defendant and back again depending on presented arguments/evidence LB-2020-88741 (Lotto)

Impact of pending oppositions in national registration offices/EPO

- The patent is legally binding during opposition and until a final invalidity decision is made (§§ 61, 24)
- The court may stay the proceedings awaiting a final decision from EPO (§ 63 a, Dispute Act § 16-18)
- Normally the Court will not stay an ongoing case pending the outcome of an opposition.
 - Expected duration of delay due to EPO handling time is important (TOSLO-2016-113257, Borgarting lagmannsrett 20.02.2019 (Teva))
- The effect of an administrative annulment that is not yet final, because it is appealed or brought before the courts, is less clear



Use of experts (expert judges, court appointed experts, parties' experts)

- One legal judge and two technical judges are normally appointed in PI proceedings in patent cases (Appeal Court 2+3)
- Court appointed experts is possible, but rarely used
- Parties' expert witnesses and written expert reports are often presented in oral hearings
- Expert witnesses are subject to direct and cross examination



Impact of foreign rulings on validity/invalidity

- Decisions from foreign European Courts in the same or parallel case complex are relevant and may have impact
 - LB-2014-117680 (Gilead-Idenix) "The desire for a uniform interpretation throughout the convention area implies that one should also look to relevant decisions from national courts in other convention states"
- Not necessarily important for the concrete assessment
 - Faber Rt. 1964 s. 1090
 - Swingball Rt. 1975 s. 603
- ..but the reasoning of a foreign court decision is sometimes referred to in support of the court's own conclusions
 - Actelion Pharmaceuticals v. Icos Corporation 15-177113TVI-OTIR/07

How is the PI enforced/is there a security/how is it set

- Executed pursuant to the Enforcement Act as soon as the claimant requests execution
- PI shall not be executed until security has been provided
- Security is intended to cover a potential liability and determined in the court's discretion
 - Validity doubts may be relevant LB-2015-90322 (Calanus)
 - Amount may correspond to but shall not exceed defendant's estimated profit TOBYF-2010-139982 og LB-2015-90322



Liability for damages in light of CJEU Bayer v. Richter

- Norwegian law follow the concept of strict liability for the patent proprietor's liability when an injunction is lifted
 - Damages may be substantial LB-2008-142381 Losartan 20-067771TVI-TOSL/06 Neurim
 - "Chilling effect" on preliminary enforcement in practise
- The Norwegian liability rule is stricter than art. 9 (7) of Directive 2004/48
- Directive 2004/48 is not part of the EEC Agreement, and it is therefore not directly relevant for Norway (as opposed to directives that are implemented under the EEC)
- Bayer v Richter gives reason to reconsider practice
 - Ørstavik "Erstatning etter grunnløs håndheving av immaterialrettigheter"

Thank you for your attention!

thommessen.no
Oslo • Bergen • Stavanger • London



Camilla Vislie

PARTNER // ADVOKAT (H)

Oslo

M +47 99 26 91 42

E cav@thommessen.no