



The Legal 500 & The In-House Lawyer
Comparative Legal Guide
Norway: Intellectual Property

This country-specific Q&A provides an overview to intellectual property law in Norway.

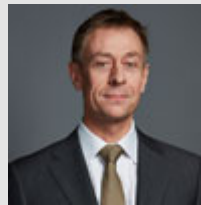
It will cover intellectual property rights, licensing, enforcement, establishing infringement or liability, and challenges to intellectual property.

This Q&A is part of the global guide to Intellectual Property. For a full list of jurisdictional Q&As visit <http://www.inhouselawyer.co.uk/index.php/practice-areas/intellectual-property/>



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- 1. What different types of intellectual property rights exist to protect: (a) Inventions (e.g. patents, supplementary protection certificates, rights in trade secrets, confidential information**

and/or know-how); (b) Brands (e.g. trade marks, cause of action in passing off, rights to prevent unfair competition, association marks, certification marks, hallmarks, designations of origin, geographical indications, traditional speciality guarantees); (c) Other creations, technology and proprietary interests (e.g. copyright, design rights, semiconductor topography rights, plant varieties, database rights, rights in trade secrets, confidential information and/or know-how).

(a) Inventions (e.g. patents, supplementary protection certificates, rights in trade secrets, confidential information and/or know-how):>

The following types of intellectual property rights exist in Norway to protect inventions:

Patents

An invention may be protected by a patent. Patent rights are regulated by the Norwegian Patents Act of 15 December 1967 (Patents Act). Provided that the requirements of novelty and inventive step are fulfilled, any person who has made an invention which may be applied industrially, may be granted a patent following an application to the Norwegian Industrial Property Office ("NIPO").

The Norwegian patent regime also allows for Supplementary Protection Certificates (SPC) for medicinal products and plant protection products. The Norwegian legislation for SPCs is based on two EC regulations (regulations (EC) No 469/2009 and (EC) 1610/96).

An SPC comes into force after the basic patent has expired, and has a maximum term of five years. The term of an SPC can be extended by another six months when the SPC relates to a human medicinal product for which data from clinical trials conducted in accordance with an agreed Pediatric Investigation Plan have been submitted ("Pediatric Extension").

Protection of trade secrets and know-how

Although trade secrets are not intellectual property in a strict legal sense, they are closely related and are, as such, protected by the Norwegian Marketing Control Act of 9 January 2009 (Marketing Control Act).

According to section 28 of the Act, a person who has obtained knowledge or possession of a trade secret in connection with an employment or business relationship or a position of trust shall not exploit the secret unlawfully in the course of trade. The same applies to any person who has obtained knowledge or possession of a trade secret through another person's breach of a confidentiality obligation or otherwise through the unlawful act of another person.


This also applies to persons who have been entrusted with or obtained possession of technical drawings, descriptions, formulas, models or similar technical aids, cf. section 29.

Unfair competition and copying of products under Norwegian Marketing legislation

The Marketing Control Act also applies to acts and terms and conditions that are directed at consumers or businesses.

Section 25 of the Act requires that no act that breaches "good business practice" among businesses shall be performed in the course of trade. This is a very practical rule, which gives a legal standard allowing for a broad assessment of loyal and acceptable vs disloyal and non-acceptable business practice, taking into account e.g. if a previous relationship between the parties exist.

Moreover, section 30 prohibits, in the course of trade, the use of copies of distinguishing marks, products, catalogues, advertising material and other produced items in such a manner and under such circumstances that the use must be considered an unfair exploitation of the efforts or results of another person, thus presenting a risk of confusion.



The Marketing Control Act is thus vital in providing additional protection to intellectual property right holders.

(b) Brands (e.g. trade marks, cause of action in passing off, rights to prevent unfair competition, association marks, certification marks, hallmarks, designations of origin, geographical indications, traditional speciality guarantees);

The following types of intellectual property rights exists in Norway to protect brands:

Trademarks

The Norwegian Trademarks Act of 26 March 2010 (Trademarks Act), in principle, gives protection to all signs capable of distinguishing an entity's goods or services from others, such as words (including slogans), numbers, figures and images, trade dress and packaging.

Also sounds, colors and scents may be eligible for trademark protection. In HR-2017-2356-A the Norwegian Supreme Court addressed whether a colour could be established as a trade mark by use. The Supreme Court confirmed that a colour may constitute a mark, as it may be graphically presented. However, the condition to establish the trade mark by use was not met, as the producer of the pharmaceutical had used several different nuances of the colour, which suggested that the incorporation of the nuance as a trade mark was undeliberate.

Furthermore, the Trademarks Act establishes that "collective trademarks" may be protected, that is, trademarks pertaining to a society or organization to be used by its members. A sub-category of the "collective trade mark" is the so-called guarantee or certification mark, which is used by agencies, foundations, companies or other associations to demonstrate that certain standards or controls to which the marks relate are met (see section 1, first and second para and section 2, first para).

As indicated, the Trademarks Act establishes the so-called "two-track" system by which protection can be obtained by registration and/or by use. Applications for registration are sent to the NIPO and can be either national or international, asserting the Madrid



System, hereunder the EU designation available in Madrid.

Company names

Norwegian legislation also recognizes rights to signs or identifiers besides trademarks, e.g., rights to company names and trade names.

The rights to company names and secondary trade names are outlined in the Company Name Register Act of 21 June 1985 (Company Name Act). Any company name, which is not identical to an existing and registered company name may be registered at the Brønnøysund Register Centre ("Brønnøysundregisteret"). In order for the company name to be protected further – against confusingly similar trademarks – the company name must be deemed to have met the same requirements of distinctiveness as trademarks.

The rights to secondary trade names is established by use. The secondary trade name is considered to be established by use when and for as long as it is well known as such in the circle of trade in Norway for the relevant goods and services.

Unfair competition and copying of products under Norwegian Marketing legislation


See our comments under question no 1 a).

(c) Other creations, technology and proprietary interests (e.g. copyright, design rights, semiconductor topography rights, plant varieties, database rights, rights in trade secrets, confidential information and/or know-how).

The following types of intellectual property rights exists in Norway to protect other creations, technology and proprietary interests:

Copyright

Pursuant to the Copyright Act of 15 June 2018 (Copyright Act), any original literary or



artistic work of any kind with individual character may be copyrightable. Section 2 of the Act includes a list of specific works that are copyrightable, but this list is not exhaustive: other works may also be protected, subject to the general requirements.

Designs

The exclusive right to a new design with an individual character is protected under the Norwegian Designs Act of 14 March 2003 (Designs Act). According to section 2 first para, the term "design" means "the appearance of a product or part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture or materials of the product itself or its ornamentation."

Insofar as the design meets the requirements set out in the Designs Act, registration may be granted by the NIPO following an application.

Unfair competition and copying of products under Norwegian Marketing legislation

See our answer to question no 1 a).

Topographies for semiconductor products

Protection of semiconductor topographies is regulated in the Act relating to the protection of semiconductor topographies of 15 June 1990 (Protection of Semiconductor Topographies Act).

In order for the semiconductor topography to enjoy protection in accordance with the act, the semiconductor topography must be the result of the creator's own intellectual effort and may not be commonplace in the industry, cf. section 1 third para.

Plant Varieties

A plant variety right may be obtained in accordance with the Plant Breeder's Right Act of 12 March 1993 (Plant Breeder's Right Act), and may be subject to both patent rights

and plant variety rights. According to section 2, the plant breeder's right in accordance with the Act may only be granted in respect of varieties

i. which can be clearly distinguished from all other varieties that were known before the date of application,

ii. which are sufficiently uniform,

iii. which are stable in the characteristics enabling the variety to be clearly distinguished from the other varieties specified in litra (a), when propagated as indicated by the variety owner, and

iv. which have not been sold or offered for sale with the consent of the variety owner

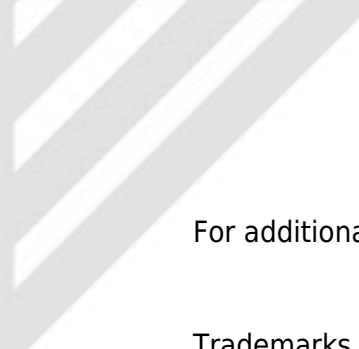
1) in Norway before the date of application, or

2) abroad more than six years before the date of application in the case of vines, trees and their rootstocks or more than four years before the date of application in the case of other plants.

2. What is the duration of each of these intellectual property rights? What procedures exist to extend the life of registered rights in appropriate circumstances?

Patents

The term of a patent is twenty years after the date of filing of the application, cf. section 40 of the Patents Act. For medicinal products and plant protection products, the term may be extended by an SPC and, for human medicinal products, further extended by six months (pediatric extension).



For additional information, please see our answer under question no 1 a).

Trademarks

The protection provided by registration is ten years from the application date and, insofar as the trademark owner has requested a renewal, ten years from the expiry of the previous period. There are no limitations on how many times a trade mark can be renewed.

The request for renewal must be filed in writing no earlier than one year before and no later than six months after the expiry of the registration period, cf. sections 32 and 33 of the Trademarks Act.

Company names


Exclusive right to a company name is perpetual, remaining in force until the actual use of the company name ceases, the registration of the company name is revoked or the enterprise is stricken from the Brønnøysund Register Centre, cf. section 3-1 of the Company Name Act.

Copyright

The duration of a copyright is for the lifetime of the author and 70 years after the time of death. For joint works, the term is 70 years after the death of the longest surviving author, cf. section 11 of the Copyright Act.

Designs

A design registration shall be valid for the period or periods of five years applied for in the application, calculated from the application date. A registration valid for a period shorter than twenty-five years may be renewed for further five-year periods up to a total registration period of twenty-five years. Each period shall run from the end of the previous period.



For the design of a component part used for the purpose of the repair of a complex product so as to restore its original appearance (spare part), registration shall be valid for a maximum of five years. See section 23 of the Designs Act.

Trade secrets and know-how

The protection of trade secrets is not limited in time.

Marketing legislation

Protection under the Marketing Act is not limited in time.

Topographies for semiconductor products

The exclusive right to a semiconductor topography shall come into existence from the date when the semiconductor topography was created, and shall come to an end 10 years from the end of the calendar year in which the semiconductor topography was commercially exploited for the first time.

The exclusive right shall nevertheless come to an end 15 years from the end of the calendar year in which the semiconductor topography was created, provided that the semiconductor topography has by then not yet been commercially exploited. See section 5 of the Protection of Semiconductor Topographies Act.

Plant Varieties

According to section 13 of the Plant Breeder's right Act, the plant breeder's right may be maintained until the end of the twentieth calendar year after the year in which it was granted. For trees and vines, the plant breeder's right may be maintained until the twenty-fifth year.

For the plant breeder's right to be maintained for the calendar year following the year in which it was granted, the annual fee prescribed by regulations must be paid.

3. Who is the first owner of each of these intellectual property rights and is this different for rights created in the course of employment or under a commission?

Patents

The first owner of an invention is the physical person, or team of physical persons, who made the invention, cf. section 1 of the Patents Act. This applies irrespective of whether the invention is created in the course of employment or under a commission.

If the invention was made by an employee, the employer shall, according to section 4 first para of the Norwegian Employee Inventors Act of April 17 1970, be entitled to claim all or part of the rights to the invention if the exploitation of the invention comes within the sphere of activity of the undertaking.


For the employer to be able to acquire such rights, the employee must either: i) be principally engaged in research or inventive work and make the invention in the course of such duties; or ii) be assigned a specified task as part of his employment which results in an invention.

According to section 7 first para, the employee shall be entitled to reasonable compensation regardless of any agreement concluded before the invention was made.

Please be advised that section 4 first para does not apply if the employee is a teacher and/or a person part of a scientific staff at a university or college, and the employee intends to publish the invention, cf. section 6 third para of the Act.

If the invention was made by a consultant under commission, the contractor's entitlement to claim all or parts of the rights to the invention will depend on the contract.

Trademarks



Exclusive right to a trademark vests with the natural or legal person whom established or had the Trademark registered at the NIPO, cf. section 3 of the Trademark Act.

Company Names

Exclusive right to a company name shall be with the proprietor of the company to which the company name belongs, cf. section 3-1 of the Company Name Act.

Copyright

The first owner of a copyright protected work is the author. Where a work has two or more authors, whose contributions do not constitute independent works, the Copyright is owned by the authors jointly, cf. section 2 and 8 of the Copyright Act.

There is a presumption in Norwegian law that copyright protected work is transferred from the employee to the employer insofar as the transfer is reasonable and necessary to achieve the purpose of the employment contract. Whether the same applies if the copyright protected work was created under commission will depend on the contract. The legal starting point is however that the consultant has the right to the copyright protected work.

For software, there is a specific rule in section 71, whereby copyright to software created by employees while working shall vest in the employer.

Designs

Exclusive right to a design vests with the person who has created and registered the design, or the designer's successor in title, cf. section 1 of the Designs Act.

There is a presumption in Norwegian law that designs are transferred from the employee to the employer insofar as the transfer is reasonable and necessary to achieve the purpose of the employment contract. Whether the same applies if the design was created under commission will depend on the contract. The legal starting

point is however that the consultant has the right to the design.

Topographies for semiconductor products

Exclusive right to a semiconductor topography vests with the person who has created the semiconductor topography, cf. section 1 of the Protection of Semiconductor Topographies Act.

If a semiconductor topography has been created in the course of the creator's employment, the exclusive right shall pass to the employer unless otherwise agreed, cf. section 4 second para.

Plant Variety rights

Exclusive right to a plant variety vests with the person who has bred a plant variety or to whom the breeder's right has passed (the variety owner), cf. section 1 of the Act relating to the Plant Breeder's right.

4. Which of the intellectual property rights described above are registered rights?

Patents (and SPCs)

Trademarks

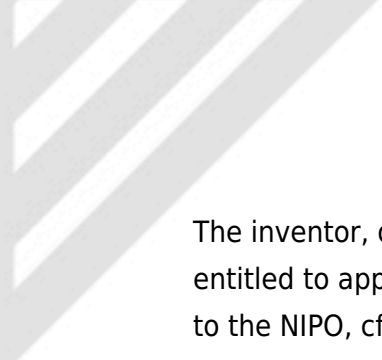
Company names

Designs

Plant Varieties

5. Who can apply for registration of these intellectual property rights and, briefly, what is the procedure for registration?

Patents



The inventor, or the person(s) to whom the inventor's rights have succeeded is/are entitled to apply for a patent, cf. section 1 of the Patents Act. Applications may be filed to the NIPO, cf. section 8.

Trademarks

Any natural or legal person may apply for a trademark, cf. section 1 of the Trademarks Act. Applications may be filed to the NIPO, cf. section 12 and 66.

Company names

See our answer to question no 1 b).

Designs

The person who has created the design, or the designer's successor in title, may file an application to the NIPO, cf. section 13 of the Designs Act.

Plant Variety Right

An exclusive right to a plant variety may be obtained upon application before the Norwegian Plant Variety Board ("PVB") by the person who has bred the plant variety or to whom the breeder's right has passed (the variety owner), cf. section 1 of the Act relating to the Plant Breeder's right.

6. How long does the registration procedure usually take?

Patents

Between 1 - 2 years. This may however vary considerably depending on the formulation of the claims, third party observations etc.



Trademarks

Approximately 6 – 7 months.

Company names

Approximately 7 – 14 days.

Designs

Approximately 2-3 months.

Plant Variety Right

Approximately 3 – 6 months. If the plant is new and therefore not tested, the registration procedure may however take 2 years minimum.

7. Do third parties have the right to take part in or comment on the registration process?

Patents

Third parties cannot become a party to the registration process. Third parties may however file third party observations during the registration process.

Trademarks

Third parties cannot become a party to the registration process. Third parties may however file informal protests during the registration process.



Company names

No.

Design

Third parties cannot become a party to the registration process. Third parties may however file informal protests during the registration process.

Plant Variety Right

No.

8. What (if any) steps can the applicant take if registration is refused?

Patent-, trademark-, design- and plant variety right registration

If the final decision by the NIPO / PVB with respect to an application has gone against the applicant, he may file an appeal against the decision with the Norwegian Board of Appeal for Industrial Property Rights ("KFIR").

An appeal must be received by the NIPO / PVB within two months from the date on which notification of the decision was sent to the party concerned.

A decision by the KFIR may not be brought before the ordinary courts later than two months from the date on which the applicant was notified of the decision. Information with respect to the time limit for instituting proceedings shall be given in the notification.

Company names

According to the Business Enterprise Registration Act of 21. June 1985, any party with a legal interest can file an appeal to the Ministry of Trade, Industry and Fisheries, cf. section 9-1.

The appeal must be filed within three weeks from the date on which notification of the decision was received by the party concerned or from the date on which the party concerned was acquainted with or should have gotten acquainted with the decision.

9. **What are the current application and renewal fees for each of these intellectual property rights?**

Patents

Application fee:

- Companies with more than 20 full-time employees (or equivalent): NOK 4650
- Companies with 20 or less full-time employees (or equivalent) (small company or private person): NOK 850
- Additional fee for each patent claim in excess of ten: NOK 250

Fees for granting a patent:

- Basic fee: NOK 1200
- Additional fee for each page in excess of 14 (with the exception of claims translated into Norwegian for English language applications, and for sequence lists, which are exempt from the page fee): NOK 250
- Additional fee for each new patent claim over 10: NOK 250

Annual fees:

1st fee year: NOK 700

2nd fee year: NOK 700



3rd fee year: NOK 700
4th fee year: NOK 1350
5th fee year: NOK 1650
6th fee year: NOK 2000
7th fee year: NOK 2200
8th fee year: NOK 2550
9th fee year: NOK 2850
10th fee year: NOK 3200
11th fee year: NOK 3500
12th fee year: NOK 3850
13th fee year: NOK 4200
14th fee year: NOK 4500
15th fee year: NOK 4850
16th fee year: NOK 5200
17th fee year: NOK 5500
18th fee year: NOK 5800
19th fee year: NOK 6200
20th fee year: NOK 6500
21st fee year: NOK 6500 SPC
22nd fee year: NOK 6500 SPC
23th fee year: NOK 6500 SPC
24th fee year: NOK 6500 SPC
25th fee year: NOK 6500 SPC

Trademarks

Application fee:

- Application fee including registration for up to 3 classes: NOK 2900
- Additional fee for each class in excess of three: NOK 750

Renewal fee:

- Renewal Fee for up to 3 classes: NOK 2600
- Additional fee for each class in excess of three: NOK 1000
- Additional fee for late payment of renewal fee: NOK 550

Company names

Application fee: included in application fee for registration of the company.

Change of company name: NOK 1440 / NOK 2832

Designs

Application fee: NOK 1900

Renewal fee:

- 5th fee year: NOK 2900 for first renewal
- 10th fee year: NOK 3500 for second renewal
- 15th fee year: NOK 4100 for third renewal
- 20 fee year: NOK 5000 for fourth renewal

Plant Varieties

Application fee: NOK 1500

DUS testing prior to registration: between NOK 10 000 – NOK 30 000.

Renewal fee: NOK 1800 a year.

10. **What are the consequences of a failure to pay any renewal fees and what (if any) steps can be taken to remedy a failure to pay renewal fees?**

If the owner does not pay the renewal fees or neglects to renew the registration, the registration will eventually cease.

11. What are the requirements to assign ownership of each of the intellectual property rights described above?

Copyright protected work, patents, trademarks, company names, designs, plant variety and semiconductor topography rights may be transferred pursuant to Norwegian contract law and freedom of contract. There is no requirement to register such transfers, although specific registers exist for those rights that are registrable.

12. Is there a requirement to register an assignment of any of these intellectual property rights and, if so, what is the consequence of failing to register?

There is no requirement to register an assignment, although specific registers exist for those rights that are registrable, and registration may be advisable in terms of obtaining legal protection.

13. What are the requirements to licence a third party to use each of the intellectual property rights described above?

There is generally nothing to prevent the parties agreeing upon the terms and conditions regulating the licence agreement, as they consider appropriate, but competition law may be asserted if the agreement aims to prevent, restrict or distort competition, e.g., by fixed pricing or market-sharing. The parties to the licence agreement would therefore be advised to consider the principles relating to competition law before preparing and carrying out the agreement (see section 10 of the Act on Competition between undertakings and control of concentrations of 5 March 2004 (Competition Act)).

14. Is there a requirement to register a licence of any of these intellectual property rights and, if so, what is the consequence of failing to register?

There is no requirement to register the licence agreement.

15. Are exclusive and non-exclusive licensees given different rights in respect of the enforcement of the licensed IP, and if so, how do those rights differ?

Exclusive and non-exclusive licensees may enforce the licensed IP without the consent from the owner of the right, unless otherwise agreed. The licensee shall notify the owner if an infringement action is initiated.

16. What other enforcement options are available for each of the intellectual property rights described above? For example, civil court proceedings, intellectual property office proceedings, administrative proceedings, alternative dispute resolution.

NIPO and PVB proceedings

Such proceedings are available in Norway when the claim relates to patents, trademarks, designs and plant variety rights. Third parties may oppose the grant of such rights within a certain amount of time.

Administrative proceedings

Administrative proceedings are available in Norway when the claim relates to patents, trademarks, company names, designs and plant varieties. Depending on the claim, administrative proceedings may be initiated by both third parties and the right holder.

Civil court proceedings

Civil court proceedings, may be initiated in Norway for disputes concerning all of the abovementioned intellectual property rights. Depending on the claim, civil court proceedings may be initiated by both third parties and the right holder, e.g. claiming infringement, non-infringement or invalidity.

Alternative dispute resolution

The parties are encouraged to attempt to reach amicable settlement out of court. The parties shall therefore investigate whether there is a possibility to settle the dispute before an action is brought. The parties may make use of out of court-mechanisms such as arbitration and judicial mediation.

As the Act relating to mediation and procedure in civil dispute of 17 June 2005 (Dispute Act) aims to resolve disputes outside court, court sponsored mediation is provided prior to the main hearing in the first instance. Judicial mediation is therefore the main rule unless the parties refuse or have agreed otherwise.

Other forms of ADR are uncommon, and arbitration is rarely used. Conciliation before a conciliation board is exempted for cases concerning patents, semiconductor topographies, plant varieties, trademarks and designs.

17. **What is the length and cost of such procedures?**

If the case is brought before the ordinary courts, the Dispute Act states that a case shall be heard within six months of the submission of the writ, but this is not necessarily adhered to in reality. For a case brought before the ordinary courts, an average time in the first instance is somewhere around 6-8 months.

Large complex cases with a lot of procedural issues may however take much longer.

Costs for bringing an infringement action to conclusion in the first instance will depend on the complexity of the case – i.e., the length of the case, the need to bring in expert opinions, etc.

Typically, a case concerning an intellectual property right can for example be heard in one to three court days and would accrue costs of approximately NOK 300' to 1 MNOK, ex. VAT, whereas in more complex cases dealing with both infringement and validity disputes the costs will typically be in the region 2 MNOK to 5 MNOK, ex. VAT.

18. Where court action is available, please provide details of which court(s) have jurisdiction, how to start proceedings, the basics of the procedure, the time to trial, the format of the trial, the time to judgment and award of relief and whether any appeal is available.

Prior to the proceedings, the rights holder will typically send a cease and desist letter to the alleged infringer. Should the alleged infringer disregard the warning letter, the rights holder may initiate legal proceedings. Legal proceedings will typically be initiated by a writ of summons. For a case brought before the ordinary courts, an average time in the first instance is somewhere around 6-8 months.

The Oslo District Court is the mandatory legal venue for patents, trademarks, designs, copyright protected works and plant variety rights cases relating to actions concerning a review of a decision made by the KFIR and actions concerning invalidity and infringement.

Requests for a preliminary injunction follow the ordinary rules of venue. A request for preliminary injunction may therefore be filed with the district court of the ordinary venue of the defendant, or with the district court where the business enterprise's head office is located, according to the Register of Business Enterprises.

However, if an infringement or revocation action is already pending, the request for a preliminary action must be filed with the court handling the ongoing action.

From the date of trial it takes about six weeks for the judgment to be made available, whereinafter an appeal must be filed within one month.

19. **What customs procedures are available to stop the import and/or export of infringing goods?**

The Norwegian legal system provides for customs seizure of counterfeits and illegal parallel imports. Relevant provisions are found under the Norwegian Act on Customs Duties and Movement of Goods of 21 December 2007, where it is stated that the customs authorities may - notwithstanding the duty of confidentiality - notify the owners of IP in cases of reasoned suspicion that imported or exported goods that are subject to control by the customs authorities will constitute a violation of an IP right. The customs authorities are allowed to detain the goods for up to ten business days from the date the notice was given (see section 15-1). The above-mentioned rule does not apply to private import and/or export.

Provided that the general requirements to request a preliminary injunction under the Dispute Act are fulfilled, the court may order a preliminary injunction against the recipient and decide that the customs authorities shall detain the goods as long as the import or export of the goods constitutes an infringement of the IP.

20. **Are any non-court enforcement options or dispute resolution mechanisms mandatory in respect of intellectual property disputes in any circumstances? If so, please provide details.**

It is not mandatory to engage in mediation. However, according to the Dispute Act, the parties shall investigate whether it is possible to reach an amicable settlement before initiating the court proceedings, and try to settle the dispute outside court.

As a matter of form, please note that the above-mentioned does not apply when filing a request for preliminary injunction in accordance with chapter 34 of the Dispute Act.

21. **What options are available to settle intellectual property disputes?**

The parties can choose to settle at any time until the judgment has been given. It is quite common to settle during court-sponsored mediation prior to the oral hearing in the court of first instance. If prudent, the judge will also remind and encourage the parties to discuss potential settlements during the main hearing.

22. **What is required to establish infringement of each of the intellectual property rights described above? What evidence is necessary in this context?**

As for all intellectual property rights mentioned in section A, an infringement action can be filed by any party with a legal interest, i.e. the rights holder or the licensee. The rights holder or the licensee has the burden of proof in terms of showing that the alleged infringer has committed an infringement.


In order to succeed on a claim for infringement, the rights holder must demonstrate that he has a right and that the alleged infringer has infringed the right. Typical evidence to that effect will be documentary and witness evidence substantiating the claim.

Patents

The court will apply the all elements rule and the doctrine of equivalence when establishing whether the patented product has been infringed.

Trade secrets and know-how

The court must find that the information fulfils all the requirements for being classified



as trade secrets, and that such information has been disclosed to the defendant in connection with an employment or a business relationship or a position of trust, or obtained by the defendant through another person's breach of a confidentiality obligation or otherwise through the unlawful act of another person. Furthermore, the court must find that such information has been unlawfully exploited in the course of trade.

Trademarks and company names

The court must find that there is a likelihood of confusion between the plaintiff's trademark and the mark used by the defendant.

Copyright

The court must find that the infringing product shows a substantial amount of similarities so that it must be considered as within the scope of protection of the plaintiff's work.

Designs

The court must find that the infringing design produces the same overall impression as that of the registered design.

Topographies for semiconductor products

The court must find that the infringer has imported, exploited or reproduced the protected topography for commercial purposes.

Plant Variety rights

The court must find that the infringer has produced or imported plant material of the protected variety with a view to offering it for sale or otherwise marketing it for purposes of propagation.

23. **How does the court acquire any necessary information (fact or technical) and in what circumstances does it do so? In particular a) Is there a technical judge, a judge with technical experience, a court appointed expert, an expert agreed by the parties, and/or parties' expert witness evidence? b) What mechanisms are available for compelling the obtaining and protecting of evidence? Is disclosure or discovery available?**

a) Is there a technical judge, a judge with technical experience, a court appointed expert, an expert agreed by the parties, and/or parties' expert witness evidence?

If requested by one of the parties or the court deems it necessary, the court shall, in main proceedings, appoint two expert lay judges. In the first instance the expert lay judges will be a part of the panel of judges together with one legal judge; in the second instance the panel will consist of two expert lay judges and three legal judges. The expert lay judges are normally appointed upon proposal (often joint) from the parties, and have their background within the technical field to which the case relates. They will not be contacted by the parties in advance of being appointed, and will normally not know which of the parties that proposed them.

In preliminary injunction proceedings expert lay judges cannot be appointed, but in such proceedings it is common to use court-appointed experts if the case concerns technical issues. Such experts shall be without any connections to the parties, and shall assist the legal judge. They will not be a part of the panel, but shall hear the trial and deliver an opinion on the matter in open court, often also delivering a written opinion.

The parties may also provide evidence in the form of own expert witnesses, and will often do, especially in patent cases. The expert witness may provide a written report, and will testify before the court in the oral hearing.

b) What mechanisms are available for compelling the obtaining and protecting of

evidence? Is disclosure or discovery available?

Disclosure and discovery as used in e.g. UK and US are not available in Norway.

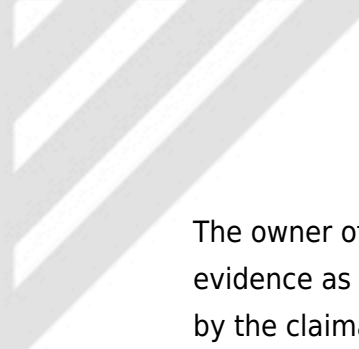
However, according to the Dispute Act, there is a possibility in certain circumstances to secure evidence and obtain information from a potential defendant or a third party prior to filing a court action. In order to secure evidence, the claimant must show that there is either i) a clear risk that the evidence will be lost or considerably impaired, or ii) other reasons why it is particularly important to obtain access to the evidence before a lawsuit is filed. The court may grant access to evidence *ex parte* if there is reason to fear that notice to the possible defendant could obstruct the securing of evidence. If so, the opposite party can request a subsequent oral hearing. The claimant shall in that case not be given access to the evidence until the ruling is final.

Further, when there are reasonable grounds to believe that an intellectual property rights has been infringed, the court may, at the request of the holder of the right, order the (potential) infringer and/or certain third parties, to provide information on the origin and distribution network of the (potential) infringing goods or services, cf. section 28 A-1 first para of the Dispute Act. The person that the request is directed against must be given the opportunity to comment before the decision is made.

During the proceedings, each party may request the other party to produce evidence in the possession of that party. If the evidence is confidential, the court may instruct the recipients to keep the material confidential, and establish regimes under which a limited number of persons are given access.

24. **How is information and evidence submitted to the court scrutinised? For example, is cross-examination available and if so, how frequently is it employed in practice?**

The Court will decide the case based on the submitted evidence. In general, the court will apply the balance of probability test, wherein the rights holder or the licensee has the primary burden of proof to establish that an infringement has occurred.



The owner of the rights and the alleged infringer will primarily provide documentary evidence as well as witness evidence. The claimant's witnesses will first be examined by the claimant's attorney, and then cross-examined by the defendant's attorney. Thereafter, the panel of judges may have some questions, and the claimant's attorney will also have the opportunity to ask follow-up questions. The same procedure will be used for the defendant's witnesses. It is quite normal that the witnesses are cross-examined by the other party's attorney, but the cross-examination will normally be much shorter than the main examination.

25. **What defences to infringement are available?**

Patent

The primary defence to a claim for patent infringement is that the alleged infringing product or process falls outside the scope of the patent claims.

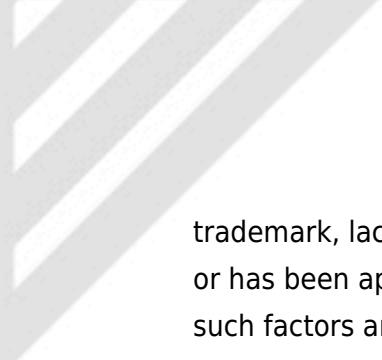
In ordinary proceedings, the alleged infringer cannot claim invalidity as a defence, unless the defendant files a separate claim for invalidity with a reference to i.a. insufficiency, lack of novelty and inventive step. In preliminary injunction proceedings, however, the alleged infringer can claim invalidity as a defence, and the court may decide not to grant an injunction on the basis that the patent is most likely invalid.

Other grounds of defence may be that the defendant is entitled to a compulsory licence, or that the defendant is entitled to a prior use right on the basis that it was using the invention also before the date of priority.

Trademark

The primary defences are lack of danger of confusion, i.e., lack of trade-mark similarity and goods and services similarity.

The alleged infringer may also make a counterclaim, claiming that the trade mark is not valid due to i.a. that the mark is identical or confusingly similar to an earlier



trademark, lacks distinctiveness, is degenerated, or that it has been subject to non-use or has been applied for in bad faith. Additionally, parody, satire, etc., are possible, if such factors are present.

In preliminary injunction proceedings, these claims can be made without filing a counterclaim.

Copyright

The defendant may claim non-infringement or that the work is not protected under the Copyright Act. Lack of creative effort is often a theme.

Design

In design infringement cases, a main defense is to argue that the scope of protection does not cover the infringing product.

The alleged infringer may also make a counterclaim, claiming that the registration should be revoked due to lack of novelty, which is a criteria for registration, or that the scope of protection should in practice be limited to imitations due to the lack of freedom to variation within the field.

In preliminary injunction proceedings, these claims can be made without filing a counterclaim.

Plant variety rights

Besides claiming non-infringement, the alleged infringer may commence revocation proceedings against the registration.

Topographies for semiconductor products

The alleged infringer may claim use in good faith, non-infringement or that the semiconductor topography is not protected under the Protection of Semiconductor topographies Act.

Trade secrets and know-how

The alleged infringer may claim that the information cannot be acknowledge as a trade secret or that the information was not held secret in a way that was appropriate for a trade secret, e.g. by submitting evidence to that effect.

The alleged infringer may also claim that the trade secret has not been used unlawfully, e.g., if the alleged infringer has developed the product etc. in and independent manner.

26. **Who can challenge each of the intellectual property rights described above?**

Any natural or legal person with a legal interest may challenge the intellectual property rights described in section A, cf. the Dispute Act section 1-3.

27. **When may a challenge to these intellectual property rights be made (e.g. during any registration process or at any time during the subsistence of the right)?**

A challenge may be made during the registration process for patents, trademarks and designs via third party observations (patents) or informal protests (trademarks and designs).

All of the intellectual property rights described in section A may be challenged once the right has come into being (upon registration for the abovementioned registrable rights).

28. **Briefly, what is the forum and the procedure for challenging each of these intellectual property rights and what are the grounds for a finding of invalidity of each of these intellectual property rights?**

NIPO is the correct instance for patents, trademarks and designs if a challenge is brought during the registration procedure. NIPO is also the correct instance for applications for administrative reviews. Once registered and/or decided by the NIPO, all of the registrable rights may be challenged within a specified time period to the KFIR. All of the intellectual property rights may further be challenged before the ordinary courts.

The grounds for finding invalidity of a patent in Norway are the same as for European patents, i.e. lack of novelty and/or inventive step, insufficiency and added matter, as well as lack of technical effect and industrial applicability.

The grounds for finding invalidity of a trademark are the same as described in Articles 3 and 4 of the Directive 2008/95/EC.

The grounds for finding invalidity of a registered design is lack of novelty and/or individual character, if the design is contrary to public interests or if the design is contrary to the rights of other persons.

29. **Are there any other methods to remove or limit the effect of any of the intellectual property rights described above, for example, declaratory relief or licences of right?**

Yes, both declaratory relief and licenses, herein compulsory licenses, are available.

30. **What remedies (both interim and final) are available for infringement of each of the intellectual property rights described above?**

Both preliminary and final injunctions are available for infringement of each of the intellectual property rights described in Section A.

Compensation and damages for infringement of trademarks, company names, patents, copyrightable works, designs, semiconductor topographies and plant variety rights shall be determined on the basis of one of the following options, whichever is most favourable for the owner of the IP-right:

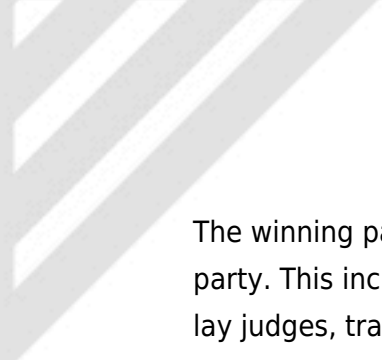
- compensation corresponding to a reasonable licence fee for the use, as well as damages for any loss resulting from the infringement that would not have arisen in connection with licensing;
- damages for any loss resulting from the infringement; or
- compensation corresponding to the gain obtained by the infringer through the infringement.

In the event of wilful or gross negligent infringement, the infringer shall instead pay compensation corresponding to twice a reasonable licence, if demanded by the rights-holder. In the event of infringement committed in good faith, the compensation shall correspond to a reasonable licence fee. Additionally, the plaintiff may also assert a claim that the infringing goods are destroyed or handed over to the rights holder.

Please be advised that the liability mentioned here may be reduced pursuant to the Act on Compensatory Damages if there are significant reasons to suggest such a reduction.

31. **What are the costs of enforcement proceedings and is any kind of costs recovery available for successful parties? Is there a procedural mechanism enabling or requiring security for costs?**

See our answer to question no 18.



The winning party is entitled to full compensation for their legal costs from the opposite party. This includes attorney's fees, court fees, costs for expert witnesses and expert lay judges, translation costs etc., as long as these costs are not found by the court to be unnecessary or disproportionate and the expenses of the party for travelling to the court hearing.

In cases where the outcome of the case was uncertain or where the successful party has rejected a reasonable offer of settlement, the court may exempt the opposite party from liability for legal costs, in whole or in full, if it finds significant reasons to do so, such as cost efficiency (see sections 10-5, first para and 20-2, first and third para).