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Relief in IP proceedings other than injunctions or damages (Q 236)

REPORT OF SWISS GROUP^{*}

Questions

The Groups are invited to answer the following questions under their national laws.

I. Analysis of current law and case law

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

Overview

Several forms of Relief (Additional Relief) other than injunctions or damages are available under Swiss civil law, among others (i) declaratory relief, (ii) delivery up/destruction, (iii) destruction of manufacturing means (iv) rectification by judgment, (v) corrective advertising, (vi) publication of judgment, (vii) order to provide information, (viii) account of profits as well as (ix) reasonable royalty and (x) reparation.

The basic principles for Additional Relief are set forth in the Swiss Code of Obligations (www.admin.ch/ch/d/sr/2/220.de.pdf), in particular in respect of art. 43, as well as in the Swiss Code of Civil Procedure (www.admin.ch/ch/d/sr/2/272.de.pdf).

Specific, and partly complementary, Additional Relief is expressly provided for all absolute rights, such as patents, trademarks, copyright, designs as well as for trade secrets (and proprietary know-how), mainly in their respective IP statutes, such as:

- art. 52–54, 55 para. 1 ciph. 3, 57, 60, 68 Federal Act on Trademarks and Appellations of Origin (Trademark Act), www.admin.ch/ch/d/sr/2/232.11.de.pdf
- art. 69, 70, 74, 77 para. 1 lit. b, 140d para. 2 Federal Act on Patents for Inventions (Patent Act), www.admin.ch/ch/d/sr/2/232.14.de.pdf
- art. 61, 62 para. 1 lit. c, 63, 66, 72 Federal Act on Copyright and Neighbouring Rights (Copyright Act), www.admin.ch/ch/d/sr/2/231.1.de.pdf
- art. 33, 34, 35 para. 1 ciph. 3, 36, 39, 44 Federal Act on Designs (Design Act), www.admin.ch/ch/d/sr/2/232.12.de.pdf
- art. 9 para. 1 lit b and c, 9 para. 2 Federal Act against Unfair Competition (Unfair Competition Act), www.admin.ch/ch/d/sr/2/241.de.pdf
- art. 37, 38 and 43 Federal Act on Plant Varieties Protection (Plant Varieties Protection) – The Act on Plant Varieties has been mentioned for the sake of completeness. Due to its marginal relevance in practice the authors have refrained from further comments. Further statutory Additional Relief is mentioned in the Federal Act on Topographies of integrated circuits. As this act has lost its relevance in practice, no comments will be made thereon.

Most IP statutes provide for an account of profits (art. 9 para. 3 Unfair Competition Act, art. 62 para. 2 Copyright Act, art. 55 para. 2 Trademark Act, art. 35 para. 2 Design Act). More generally, the princi-

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ples of monetary relief as provided for in the Swiss Code of Obligations art. 41 et seqq. (tort), art. 49 (reparation for moral tort), art. 62 et seqq. (unjustified enrichment), and art. 423 (I) (agency without authority) constitute the source for the definition and content of the IP-specific monetary Relief of (i) account of profits, (ii) reasonable royalties and (iii) reparation. Generally speaking, the monetary Relief were essentially developed in the jurisprudence of the Swiss Supreme Court (see answer to question 3 below).

The relief of corrective advertising is not explicitly provided in IP statutes. Nevertheless, Swiss doctrine discusses the possibility of rectification and reply in connection with Relief in Swiss IP and competition law, namely in connection with an act of unfair competition (DAVID et al., N 317). An explicit provision for corrective advertising is set forth in Art. 9 para. 2 Unfair Competition Act. According to this provision, the plaintiff can demand that a rectification or that the judgment is communicated to third parties or made otherwise public.

The availability of Additional Relief in IP proceedings can be summarized as follows¹:

Relief	Patent (incl. SPC)	Trademark	Copyright	Design	Confidential information/ trade secrets
Declaratory relief	X	X	X	X	X
Delivery up/ destruction	X	X	X	X	(X)
Destruction of manufacturing means	X	X	X	X	(X)
Rectification	X	X		X	
Corrective advertising	(X)	(X)	(X)	(X)	X
Publication of judgment	X	X	X	X	X
Order for inspection	X	X	X	X	X
Order to pro- vide informa- tion	X	X	X	X	(X)
Account of profits	X	X	X	X	X
Reasonable royalty	(X)	(X)	(X)	(X)	(X)
Reparation	X	X	X	X	X

¹ The brackets indicate that statutory law does not expressly provide for this type of relief, but that it may nevertheless be available according to Swiss doctrine and jurisprudence

Additional Relief in form of Interim Measures:

In addition to these forms of Additional Relief listed above, art. 261 para. 1 of the Swiss Code of Civil Procedure provides that the “court shall order the interim measures required provided the applicant shows credibly that (a) a right to which he or she is entitled has been violated or a violation is anticipated; and (b) the violation threatens to cause not easily reparable harm to the applicant”. Entitlement to interim measures is also explicitly mentioned in most IP statutes, such as art. 65 Copyright Act, art. 59 Trademark Act, art. 38 Design Act and art. 77 Patent Act.

The requirements for the grant of interim measures are a prima facie showing of (i) an actual or imminent violation of a right of the applicant party, (ii) a risk of not easily reparable harm, (iii) the urgency and (iv) the proportionality of the measure requested (SPITZ, SHK ZPO, ZPO 261, N 3).

In respect of the content of interim measures, art. 262 of the Code of Civil Procedure states that an interim measure may be every measure suitable to prevent imminent harm. Further, interim measures must be reversible (DAVID et al., N 633; SCHAI DAMIAN, Vorsorglicher Rechtsschutz im Immaterialgüterrecht, Unter besonderer Berücksichtigung superprovisorischer Anordnungen des aargauischen Handelsgerichts, N 231).

Patent law specifically provides for Additional Relief in the form of a precise description of an allegedly infringing process or of products allegedly manufactured through an infringing process. Such Additional Relief can be requested at any time if there is prima facie evidence of a patent infringement (art. 77 para. 1 lit. b Patent Act).

Further, Swiss procedural law sets forth the right to request a precautionary taking of evidence. Art. 158 of the Code of Civil Procedure provides that the “court shall take evidence at any time if (a) specific legal provisions grant the right to do so, and (b) the applicant shows credibly that the evidence is at risk or that he has a legitimate interest.” For this kind of relief, provisions regarding interim measures do apply (art. 158 para. 2 of the Code of Civil Procedure).

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.

Additional Relief in form of declaratory relief:

Under Swiss law, there are different kinds of declaratory relief, depending on what the concerned person wants the judge to declare (e.g. nullity, non-infringement).

An important requirement for requesting and obtaining a declaratory relief is the legal interest of the claimant (so called “Feststellungsinteresse”). This legal interest is assumed to exist under three cumulative conditions: (a) the uncertainty (or endangering) of the legal status of the claimant, (b) the unreasonableness of the continuation of this uncertainty and (c) the impossibility of the elimination by another way (in particular by way of an action for specific performance; see DAVID et al., N 326).

Often requested declaratory relief is (i) the action of nullity and (ii) the action of declaration that an IP right is not infringed. Swiss procedural law uses the term of “negative declaratory relief” (“negative Feststellungsklagen”). Most IP statutes expressly provide for negative declaratory relief, such as art. 52 Trademark Act; art. 74 Patent Act; art. 61 Copyright Act; art. 33 Design Act (E. MARBACH, in: von Büren/Marbach/Ducrey, Immaterialgüter- und Wettbewerbsrecht, 3rd ed., Berne 2008, N 931; for the condition of the legal interest in case of a declaratory relief, s. above).

In form of rectification:

Swiss law does not provide for an action for rectification. Rectification of IP registers is rather a consequence of other legal actions promoted by the plaintiff. For instance, if the IP holder demands to declare the nullity of a registered IP right, the declaratory judgment will lead to the deletion of the IP right in the register.

Alternatively, the plaintiff can ask the judge to transfer the unduly registered IP right to the plaintiff (art. 53 Trademark Act, art. 29 Patent Act and art. 34 Design Act). In case of good faith of the defendant,

this claim forfeits within two years after the publication of the registration (art. 53 para. 2 Trademark Act and art. 34 para. 2 Design Act), and of the patent's claims respectively (art. 31 para. 1 Patent Act). In case of bad faith of the defendant, the claimant can request the transfer of the concerned patent without any time restriction (art. 31 para. 2 Patent Act). Same rules apply for the transfer of trademarks and designs registered in bad faith (MARBACH, N 939).

Moreover, the Swiss registrar can himself rectify certain registrations after having balanced the public interest in the application of the law against the interest in the legal certainty (DAVID et al., N 1180).

In form of the delivery up/destruction:

Most IP statutes explicitly provide for the relief of confiscation of the infringing goods (art. 69 Patent Act, art. 57 Trademark Act, art. 63 Copyright Act and art. 36 Design Act). This relief is only granted if the infraction endures (or if the infraction is finished, but the disturbance endures), but not if the infraction is only threatened or if it does not exist any longer or does no longer have any effects (MARBACH, N 943).

In case of the confiscation the infringing goods are usually destroyed; however, the judge may also, based on his judicial discretion, decide about another use of the infringing goods (MARBACH, N 951; in respect of trademarks, see art. 57 para. 2 Trademark Act).

Please note that the Unfair Competition Act does not explicitly provide for the relief of confiscation of infringing goods. However, according to main doctrine such a confiscation request can be applied for based on art. 9 para. 1 ciph. b Unfair Competition Act that provides that the judge may order the elimination of an existing infringement (SPITZ, UWG 9, N 77, in: JUNG/SPITZ, SHK UWG, Bern 2010); (PEDRAZZINI/ PEDRAZZINI, Unlauterer Wettbewerb UWG, 2. Aufl., Bern 2002, N 14.18).

In form of destruction of equipment for producing products unlawfully:

Further a judge can order that installations, equipment and other utilities for manufacturing unlawful goods be confiscated or destroyed (art. 69 para. 1 Patent Act, art. 57 para 1 Trademark Act, art. 63 para. 1 Copyright Act, art. 36 Design Act).

In form of the publication of judgments:

Swiss IP statutes expressly provide for the right to request the judgment's publication. If the prevailing party demands the publication of the judgment – and gives evidence of a sufficient legal interest (MARBACH, N 954) – the judge may (within his judicial discretion) order the publication at costs of the other party (art. 60 Trademark Act, art. 70 Patent Act, art. 66 Copyright Act, art. 39 Design Act). The judge also decides about the format and the extent of the publication (art. 60 Trademark Act, art. 70 Patent Act, art. 66 Copyright Act, art. 39 Design Act).

In form of the order to provide information:

According to the Code of Civil Procedure, parties in civil proceedings have the duty to cooperate. The parties namely have the obligation to produce physical records if they possess such records and are requested to do so by the judge (art. 160 para. 1 lit. b Code of Civil Procedure).

In addition to that, Swiss IP statutes (except the Unfair Competition Act in respect of trade secrets and confidential information) state the right for the claimant to request information about the infringement of his rights (art. 55 para. 1 lit c Trademark Act; slightly different, art. 66 lit. b Patent Act sets forth that a person can be held responsible if it does not provide the necessary information; art. 62 para. 1 lit. c Copyright Act and art. 35 para. 1 lit. c Design Act). Among other conditions, this relief presumes that the products were manufactured unlawfully (so called "widerrechtlich" art. 55 para. 1 lit. c Trademark Act; art. 66 lit. b Patent Act, art. 62 para. 1 lit. c Copyright Act, art. 35 para. 1 lit. c Design Act).

In respect of the request for financial statements Swiss law does not contain any explicit rule. Generally, financial statements may only be asked in connection with an action concerning a monetary claim, but they cannot be asked in connection with its preparation, which is criticised by the legal doctrine (DAVID et al., N 354).

In form of the order for inspection:

The order for inspection is not explicitly mentioned in the IP statutes, but can be requested according to the civil procedural rules: Art. 181 para. 1 of the Code of Civil Procedure provides that on request of a party or ex officio, the court may conduct an inspection in order to see the facts for itself or for a better understanding of the case.

With regard to patent infringements a party may also ask that the court orders a detailed description of the alleged unlawfully used processes or the alleged unlawfully produced products or their production means (art. 77 para. 1 lit. b Patent Act).

In form of the account of profit and reasonable royalty:

a) *Account of profits: Most IP statutes provide for the right of the claimant to request an account of profit (art. 55 para. 2 Trademark Act; art. 9 para. 3 Unfair Competition Act; art. 62 para. 2 Copyright Act and art. 35 para. 2 Design Act).*

Profits of the infringer may be used as starting point to calculate the damage arising to the plaintiff in an action for damages (DAVID et al., N 401; BGE 132 III 379, cons. 3.2.3 [decision in Patent law]). The Swiss Supreme Court considers this a special case of agency without authority according to art. 423 of the Code of Obligations (BGE 132 III 379, cons. 3.2.3).

Art. 423 of the Code of Obligations requires that the infringer takes over the business of the infringed person (i.e. intervenes in the legal sphere of the infringed person) and – according to the Swiss Supreme Court (BGE 129 III 422, E. 4) – that he generates a profit out of it, and that when acting in this position he was in bad faith (DAVID et al., N 416).

Further, the plaintiff can demand the profits arising out an unjustified enrichment according to art. 62 ff. of the Code of Obligations (DAVID et al., N 413; MARBACH, N 972). The conditions for an unjustified enrichment cause of action pursuant to art. 62 of the Code of the Obligations are: (i) an enrichment of the enrichment-debtor that is (ii) originated from the fortune of the enrichment-creditor, and additionally that (iii) the enrichment took place without justification (HUGUENIN, Obligationenrecht, Allgemeiner und besonderer Teil, Zurich 2012, N 1773).

b) *Reasonable royalty: Based on the precedents of the Swiss Supreme Court, a reasonable royalty (i.e. monetary relief based on a presumed reasonable royalty as if the IPR holder and infringer had entered into a voluntary licensing agreement) is a method used to quantify the plaintiff's monetary damages resulting from the infringement (BGE 132 III 379, cons. 3.2.2, decision concerning patents and for claim originating from tort). This method can come to application (i) when the holder of the IP right agreed to grant non-exclusive licenses to third parties, (ii) when there are comparable license circumstances and (iii) when it can be assumed that a license under the same terms would have been granted to the infringer and the infringer would have been willing to conclude a license agreement with the holder (BGE 132 III 379, cons. 3.2.2).*

Further, legal doctrine proposes that a reasonable royalty may be asked also for a claim requesting an unjustified enrichment (DAVID et al., N 428), based on the doctrine of the so called "Eingriffskondiktion". The conditions of the so called "Eingriffskondiktion" are (i) an enrichment of the enrichment-debtor, (ii) at the expense of someone else (so called "Zuweisungsverstoss"), (iii) a factual connection between this behavior and the enrichment, provided that (iv) the enrichment was unjustified (DAVID et al., N 425; R. M. JENNY, Die Eingriffskondiktion bei Immaterialgüterrechtsverletzungen, Unter Berücksichtigung der Ansprüche aus unerlaubter Handlung und unechter Geschäftsführung ohne Auftrag, Zurich 2005).

c) *Relationship between the relief and damages: The question of whether the relief can be demanded alternatively or cumulatively to other damages depends on which damages the plaintiff is entitled to demand and will demand. Damages concerning loss of profit cannot be requested in addition to a reasonable royalty or for the account of profits, but other damages – such as moral tort compensation – can be demanded by the plaintiff cumulatively to this relief (DAVID et al., N 430).*

In form of the reparation:

The plaintiff can demand compensation for moral tort (see art. 49 of the Code of Obligations). Most IP statutes explicitly refer to this claim (art. 55 para. 2 Trademark Act; art. 62 para. 2 Copyright Act; art. 35 para. 2 Design Act and art. 9 para. 3 Unfair Competition Act). Patent Act does not explicitly mention this possibility – this should be understood as an oversight of the legislator (DAVID ET AL., N 408) –, but there is no doubt that a compensation for moral tort can also be requested for patent infringements.

Nevertheless, it must be noted that a compensation for moral tort is only granted if a serious impairment of the personal circumstances is given (DAVID et al., loc cit., N 408).

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?

Swiss courts must grant the requested relief if all requirements are fulfilled. However, they have discretionary power on deciding whether such requirements are fulfilled or not.

With regard to the content of the order of publication, the judge also has discretion in deciding about the adequate way to publish a judgment. In this case, the court is called to balance the mutual interests of the parties and apply the principle of proportionality (DAVID et al., N 337; see also MARBACH, N 955).

Also, a Swiss judge has important discretionary power when deciding what should be done with the confiscated goods counterfeiting trademarks (MARBACH, N 951; cf. in particular the wording of art. 57 para. 2 Trademark Act). Similarly, in patent infringement proceedings the court has discretionary power in deciding about the confiscation and the sale or destruction of products unlawfully manufactured (art. 69 para. 1 Patent Act). The same applies to equipment to be used to unlawfully manufacture products.

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)?

There are no forms of relief invariably ordered under certain circumstances, this because of the discretionary power of the judge about the fulfilment of the required conditions for the grant of the requested relief. See also answer to question 4.

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.

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

See the answer to question 8:

8. If yes to question 7:

a) *in what circumstances;*

b) *what forms of Additional Relief may be ordered; and in respect of what types of IPR infringement?*

Answer to question 7 and 8: As a general rule, in civil proceedings the court does not order any direct measures against a non-party to the proceedings.

However, the following exceptions apply:

- (i) The court may issue an order for inspection and/or an order to provide information and this may be directed also against a third party person. According to art. 160 of the Code of Civil Procedure, third parties have certain obligations to cooperate in civil proceedings, namely the obligation to al-

low an examination of their person or property by an expert (art. 160 para. 1 lit. c Code of Civil Procedure) and the obligation to produce physical records (art. 160 para. 1 lit. b Code of Civil Procedure).

- (ii) Further, the court can order the confiscation of the infringing goods in possession of a third party, if the infringer is the independent or dependent possessor (so called “*unselbstständiger oder selbstständiger Besitzer*”) of the goods or if he is entitled to give instructions to the involved third party (DAVID ET AL., N 300). Further, Swiss scholars propose that it should be possible that enterprises for outside advertising could be ordered to eliminate infringing posters (DAVID et al., N 300).

9. Is a court (or applicable administrative body), in making an order for Additional Relief against an IPR infringer who is a 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) fulfil that obligation?

There is no explicit rule known to the Swiss group which would provide such an obligation. Nevertheless, by deciding within his discretion, the judge may consider the interests of third parties.

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

Art. 53 para. 1 of the Code of Civil Procedure provides that the parties have the right to be heard. This right must also be granted to third parties that are directly concerned by the measures of the tribunal (SCHENKER URS, Stämpfli's Handkommentar, Schweizerische Zivilprozessordnung [ZPO], Bern 2010, ZPO 53 N 7). Thus, when ordering a relief mentioned in the answer to question 7 and 9, the judge should grant the third parties the right to be heard.

II. Proposals for harmonisation

Groups are invited to put forward proposals for the adoption of harmonised rules in relation to Additional Relief in IP proceedings. More specifically, the Groups are invited to answer the following questions:

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

In the view of the Swiss group (i) declaratory relief, (ii) the delivery up and destruction of infringing goods, (iii) the rectification of registers and official documents, (iv) the publication of judgments, (v) orders to provide information on the origin and the recipients of infringing goods as well as on amounts of *infringing goods involved shall be made available as non-monetary Additional Relief* in all jurisdictions.

Moreover, a claim for account of profits (as an alternative remedy to damages) or for a reasonable royalty should be available as Additional Relief for the unpermitted use of IP rights. Monetary damage compensation is very difficult to obtain under the current practice of Swiss courts that put the burden of the quantification of the damage entirely on the holder of the infringed IP rights. Accordingly, the latter has to give evidence not only about the exact amount of the damages arising to him out of the infringing behavior, but also to prove that there is an adequate causal link between such behaviour and the damage. This may be difficult to achieve, in particular if one considers that the offer of counterfeited goods does not necessarily mean that original goods are no longer purchased. More often, counterfeited (and cheaper) goods are purchased by other categories of consumers. Accordingly, and in order to grant the holder of infringed IP rights also a monetary compensation, a specific and independent *claim for account of profits or for a reasonable royalty* shall be expressly provided for in IP statutes.

With regard to the relief by an infringement of a patent or a design the destruction of the equipment to manufacture the infringing goods should also be made available as provided for under Trademark Law. Only the availability of these forms of Additional Relief (in addition to injunctions and damages) ensures that IPR infringements and their harmful consequences for the IPR holder may be effectively eliminated and allows to sanction IPR infringements in a manner that entails a deterrent effect.

The Swiss group does not see any need for a special claim for modification of technology, as it believes that the underlying interest of the IPR holder is sufficiently protected with an injunction. The same applies in principle in respect of a claim for alteration of infringing goods. However, a court should have the discretion to order the removal of infringing trademarks on goods instead of a requested destruction, if it regards under the given circumstances such a remedy as sufficient and more reasonable than a destruction.

Further, except for cases of violation of the Unfair Competition Act, the Swiss group does not see the need of a claim for corrective advertising as Additional Relief if the possibility to publish a judgment is available, since the latter relief serves the same purpose without the risk of entailing unreasonable disparaging effects on the side of the infringer.

Finally, the Swiss group does not see the necessity of an order for inspection (other than in the form of a provisional measure for the preservation of evidence or for a description in terms of a patent infringement).

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

As far as the delivering up and destruction of infringing goods appears unreasonable under the given circumstances, in particular in case the infringer did not act in bad faith and the infringement may be easily eliminated by other means than destruction, e.g. by the removal of infringing trademarks, the court should have discretion to request the infringer to eliminate the infringement by such other means instead of a requested destruction. Otherwise, the formal establishment of an IPR infringement by the court should be the only required criteria for the grant of Additional Relief identified in question 11.

With regard to the Additional Relief of a reasonable royalty for the unpermitted use of an IP right, such relief shall be made available for wilful or gross negligent behaviour only. Moreover, the judge shall determine in his discretion the amount of the "reasonable" royalty, taking into account the circumstances as well as the degree of fault (pursuant to the general principles of art. 43 CO).

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 the view of the Swiss group the above mentioned forms of Additional Relief should be available to all types of IPR holders, provided the enforcement of the related IPR does not amount as such to an abuse of rights, as may, for example, be the case with trademarks that have been filed without any intent of use.

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

All forms of Additional Relief should only be available upon specific request of the IPR holder. If the conditions for the grant of an Additional Relief are given, the court shall order the relief. Legal certainty is most relevant. However, in respect of the content of the requested Additional Relief, namely in case of a request for delivering up and destruction of the infringing goods the court shall have some discretion to issue an order that is less far-reaching for the infringer. Another exception shall be made in case of a request to order the publication of the judgment, where the judge should have some discretion to determine the scope and kind of the publication.

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, see answer to question 16.

16. If yes, to question 15:

a) *in what circumstances;*

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

c) *in respect of what types of IPR infringement?*

In the view of the Swiss Group, a court should in all types of IPR infringement be in the position to issue an order for inspection and/or an order to produce information or documents directly against a non-party to an IP proceeding and thereby secure and/or gather evidentiary material. As set forth under question 8), Swiss courts may – in any kind of IP proceedings – order third parties to make a witness statement (art. 160 para. 1 lit. a Code of Civil Procedure), produce information and documents (art. 160 para. 1 lit. b Code of Civil Procedure) or allow the court to inspect their person and/or property (art. 160 para. 1 lit. c Code of Civil Procedure) as part of their obligation to cooperate in civil proceedings. As requests for such orders may be submitted to the court even prior to initiating a claim, they may serve as a useful tool to get information to evaluate the chances and risks of a possible court proceeding.

Furthermore, the Swiss Group believes that a court should be able to order the confiscation of infringing goods situated in possession of a third party to the extent the infringer is the independent or dependent possessor (so called “*unselbständiger oder selbständiger Besitzer*”) of the goods or if he is entitled to give instructions to the third party with regard to these goods. This at least if the third party has expressed no interest in the outcome of the proceedings and thus does not want to participate as a party. With regard to the third party’s right to be heard please see below question 18).

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?

The Swiss Group does not see any need to oblige a court (or applicable administrative body) to consider the impact of its orders on any non-party.

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?

Any third party shall have the possibility to call upon their material and/or procedural rights, e.g. the right to refuse cooperation (in particular if it risks to become exposed to a criminal or civil liability) or if adherence to the order would lead to a disclosure of trade secrets. Accordingly, a court ordering a relief mentioned in the answer to question 15 should always grant the third party the right to be heard.

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.

AIPPI Swiss Group suggests that not only the content of the Additional Relief should be harmonized, but also the enforcement of the ordered Additional Relief in countries where the IP infringement takes place or shows its effects, should be ensured by appropriate means.

Accordingly, the enforcement of orders about Additional Relief should be ensured in international civil assistance and jurisdiction agreements.

Summary

Additional Relief is available in IP proceedings ruled by Swiss Law, among others (i) declaratory relief, (ii) delivery up/destruction, (iii) destruction of manufacturing means (iv) rectification by judgment, (v) corrective advertising, (vi) publication of judgment, (vii) order to provide information, (viii) account of profits as well as (ix) reasonable royalty and other means of (x) reparation. Additional Relief is expressly provided for patents, trademarks, copyright, designs, but only partly against unfair competition behaviours.

In the view of the Swiss group (i) declaratory relief, (ii) the delivery up and destruction of infringing goods, (iii) the rectification of registers and official documents, (iv) the publication of judgments, (v) orders to provide information on the origin and the recipients of infringing goods as well as on amounts

of infringing goods involved shall be made available as non-monetary Additional Relief in all jurisdictions. Moreover, a claim for account of profits (as an alternative remedy to damages) or for a reasonable royalty should be available as Additional Relief for the unpermitted use of IP rights.

In the view of the Swiss Group, a court should be in the position to issue an order for inspection and/or an order to produce information or documents directly against a non-party to IP proceedings and to order the confiscation of infringing goods situated in possession of a third party to the extent the infringer is the independent or dependent possessor of the goods or if he is entitled to give instructions to the third party with regard to these goods.

Finally, AIPPI Swiss Group also suggests that not only the content of Additional Relief should be harmonized, but also the enforcement of the ordered Additional Relief should be ensured by appropriate means.

Zusammenfassung

In Rechtsverfahren zum Schutz von IGR, die dem schweizerischen Recht unterstehen, können zusätzliche Massnahmen verlangt und angeordnet werden, u.a. (i) Feststellungsurteile, (ii) Einziehung und Vernichtung, (iii) Vernichtung der vorwiegend zu ihrer Herstellung dienenden Einrichtungen, Geräte und sonstigen Mittel (iv) Wiederstellung durch Urteil, (v) korrigierende Werbemassnahmen, (vi) Veröffentlichung des Urteils, (vii) Angabe von Informationen, (viii) Herausgabe des Gewinnes wie auch (ix) angemessene Lizenzgebühr und andere (x) Ersatzmassnahmen. Diese zusätzlichen Massnahmen können bei Patent-, Marken-, Urheberrechts- und Designverletzungen angeordnet werden. Gegen unlauteres Wettbewerbsverhalten stehen sie nicht ausdrücklich von Gesetzes wegen zur Verfügung.

Die schweizerische AIPPI Landesgruppe ist der Meinung, dass (i) Feststellungsurteile, (ii) die Einziehung von widerrechtlich hergestellten Waren, (iii) die Anpassung des Registers und der offiziellen Dokumente, (iv) die Veröffentlichung der Urteile, (v) die Verpflichtung zur Angabe von Informationen über die Herkunft der widerrechtlich hergestellten Waren und deren Abnehmer sowie über die Anzahl der rechtswidrigen Waren in allen Ländern als nicht monetäre zusätzliche Massnahmen verlangt und gewährt werden können sollten. Darüber hinaus sollte die Klage auf Herausgabe des Gewinnes – als Alternative zur Schadenersatzforderung – oder auf eine angemessene Lizenzgebühr für den rechtswidrigen Gebrauch von IGR zur Verfügung stehen.

Die schweizerische AIPPI Landesgruppe unterstützt die Zuständigkeit des Richters, einen Durchsuchungs- oder Informations- bzw. Editionsbefehl gegenüber am Verfahren nicht beteiligten Dritten anordnen zu können. Ebenfalls sollte der Richter in der Lage sein, rechtswidrig hergestellte Waren im Besitz einer Drittpartei einzuziehen, solange die beklagte Partei selbständige oder unselbständige Besitzerin der Waren ist oder diese die Drittpartei instruieren kann.

Schliesslich empfiehlt die schweizerische AIPPI-Landesgruppe eine Harmonisierung nicht nur des Inhalts der zusätzlichen Massnahmen, sondern auch deren Durchsetzung durch geeignete Rechtsinstrumente.

Résumé

Dans les procédures concernant les DPI et soumis au droit Suisse des mesures additionnelles peuvent être demandées et obtenues, entre autres (i) les décisions en constatation, (ii) la confiscation et destruction, (iii) la confiscation des instruments, de l'outillage et des autres moyens destinés principalement à leur fabrication (iv) la rectification par jugement, (v) mesures de promotion correctives, (vi) la publication du jugement, (vii) l'ordre de donner des informations, (viii) la restitution du profit ainsi que (ix) l'octroi d'une licence raisonnable et autres mesures de (x) réparation. Les mesures additionnelles sont expressément statuées pour les brevets, les marques, les designs et les droits d'auteur, mais peuvent être demandées et obtenues seul en partie contre les comportements déloyaux.

Selon le groupe national suisse de l'AIPPI (i) les décisions en constatation, (ii) la confiscation et destruction des objets illicites, (iii) la rectification du registre et des autres documents officiels, (iv) la publication des jugements, (v) l'ordre d'indiquer la provenance, la quantité ainsi que les destinataires devraient être mis à disposition du titulaire du DPI dans toutes les juridictions. En outre, l'action en restitution du profit – comme moyen alternatif de compensation de dommage-intérêt – ou pour une licence raisonnable devrait exister pour tout usage non permis des DPI.

Le groupe national suisse de l'AIPPI est d'avis qu'il devrait être permis au juge d'ordonner l'inspection ou bien la production d'information et de documents respectivement, aussi contre des tiers qui ne sont pas partie à la procédure. Aussi le juge devrait pouvoir ordonner la confiscation des biens illicites en possession de tiers, au moins si celui qui viole les DPI possède directement ou indirectement ces biens ou s'il peut donner des instructions par rapport à ces biens aux tiers détenteurs.

En conclusion, le groupe national suisse de l'AIPPI suggère que non seulement le contenu, mais aussi l'imposition des mesures additionnelles devrait être assurées par des mesures appropriées.