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AIPPI Q275 – Standing to Litigate and Effect on Remedies

REPORT OF THE SWISS GROUP*

I. Current law and practice

1. Who has standing to bring a claim of infringement of an IP right? Please also address whether co-owners and exclusive, non-exclusive and/or sole licensees, or authorised persons may bring a claim of infringement of an IP right.

In principle, any person whose IP right is infringed or threatened to be infringed has standing to bring an infringement claim (Art. 55 para. 1 Trade Mark Protection Act [“TmPA”]; Art. 35 para. 1 Designs Act [“DesA”]; Art. 72 Patents Act [“PatA”]; Art. 62 para. 1 Copyright Act [“CA”]).

a) Sole ownership

It is undisputed that the sole owner of an IP right has standing to bring an infringement claim.

As far as persons other than the sole owner of an IP right are concerned, one has to make a distinction based on the legal position of the relevant person and the type of IP concerned:

b) Collective ownership

Swiss IP legislation does not explicitly distinguish between different types of collective ownership. However, Swiss property law explicitly distinguishes between *co-ownership* and *joint ownership*. Each of the co-owners owns a share in the item that is subject to the co-ownership, whereas the joint owners do not own a share in that item but rather own the whole item jointly. It is broadly acknowledged that this distinction applies in principle also to collective ownership in IP rights, bearing in mind the peculiarities resulting from the immaterial nature of IP rights.

According to the principles of property law, each co-owner individually has standing to bring a claim for violation of its property right, whereas joint owners have such standing only jointly.

These principles may be applied to the different types of IP rights, taking into consideration their immaterial nature and the specific legislation applying to such IP right:

- Trade marks: The TmPA is silent on the standing to sue on the part of collective owners. Scholars unanimously acknowledge that joint owners necessarily need to bring a claim together. For co-ownership, it is the prevailing opinion that each of the co-owners can bring an infringement action in its own name without involving the other co-owners, whereas according to a minority opinion it should be required that all co-owners sue together.
- Designs: The law provides for the existence of collective ownership (Art. 11 DesA) but is silent on the standing to bring an infringement claim. It is broadly acknowledged that joint owners have to bring an infringement claim together. For co-owners it is the prevailing opinion that each of the co-owners can file an infringement action on its own.
- Patents: According to Art. 33 para. 2 PatA, where a patent is owned by two or more persons, each of them may bring an action for infringement of the patent. Previously, it had been the prevailing opinion that this should only apply to co-owners, whereas joint owners would have to bring the action together. More recently, scholars have taken the view that Art. 33 para. 2 PatA is *lex specialis* that overrides the rule of property law, so that it applies to both types of collective ownership, meaning that not only each co-owner, but also each joint owner can bring the action independently, i.e. without involving the other owners.

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- Copyright: Art. 7 para. 1 CA provides for collective ownership for creators who have jointly contributed to the creation of the work. Each of them can file infringement actions independently, but must request performance for the benefit at all owners (Art. 7 para. 3 CA). This also applies to requests for injunctions, but for such requests it is not necessary to ask for relief for the benefit of all owners.

c) Exclusive licensees

Exclusive licensees have standing to bring a claim of infringement provided this has not been explicitly excluded in the relevant licence agreement (Art. 55 para. 4 TmPA; Art. 35 para. 4 DesA; Art. 75 para. 1 PatA; art. 62 para. 3 CA). There are different views about the legal nature of this standing. It used to be the prevailing opinion that the exclusive licensee enforces another person's (i.e. the owner's) right in its own name. As a consequence, the right owner would lose its standing to bring action itself. More recently the prevailing opinion seems to be that the exclusive licensee has a standing *sui generis*, which allows it to exercise its own right in its own name, without depriving the right owner of the standing to bring action itself. Courts seem to have followed this latter approach.

d) Sole licensees

Swiss IP legislation does not deal with sole licensees. Amongst scholars it is disputed whether a sole licensee has the same standing to bring infringement actions as an exclusive licensee. Swiss courts have not dealt with this question so far.

e) Non-exclusive licensees

Non-exclusive licensees do not have standing to bring a claim for IP infringement. They are only entitled to join an already pending infringement action in order to claim their own damages (Art. 55 para. 4 *in fine* TmPA; Art. 35 para. 4 *in fine* DesA; Art. 75 para. 2 PatA; Art. 62 para. 3 *in fine* CA).

f) Exclusive sub-licensees

Exclusive sub-licensees have standing to bring a claim of infringement, provided the sub-licensor is an exclusive licensee. It is the prevailing opinion that the exclusive licensee who has granted an exclusive sub-licence retains its own standing to bring action.

g) Usufructuaries and pledgees

Swiss IP legislation does not deal with the standing of a usufructuary or of a pledgee to bring a claim. Scholars take the view that usufructuaries have standing to bring a claim of IP infringement, whereas pledgees do not.

h) Authorised claimants

Swiss law does not allow the enforcement of IP rights to be delegated to third parties in the sense that the authorised claimant would be granted the right to enforce the IP owner's right in the authorised claimant's own name except where provided for by law.

If the IP owner wants to give to another person the standing to bring a claim of infringement of its IP right, it would have to assign its claims to that person. Such person can then invoke its own claims in its own name. Such assignment is possible for financial claims; however, it has not been decided yet whether such assignment is also possible for claims for injunctive relief and remedy of existing infringements. Current scholarly writing tends to the opinion that the latter is not possible.

i) Other persons

The following other persons have, under general principles of Swiss law, the standing to bring claims of other persons. Such claims can also include claims of infringement of IP rights:

- In inheritance situations, estate administrators for IP rights that are part of the estate;
- In inheritance situations, the executor of an estate if IP rights are part of that estate;
- In bankruptcy, the bankruptcy estate (represented by the bankruptcy administrator) or creditors to whom claims for IP infringement have been assigned according to Art. 260 of the Swiss Debt Collection and Bankruptcy Act.

The right of associations to bring legal actions in the interest of their members is not further examined herein and should be the subject of a separate question.

2. For each class of person identified under 1. above, please explain.

- a) Whether the permission of anyone else is needed, in order to bring the claim?

If a person has an independent standing to sue, it does not need the permission of anybody else to bring a claim. This applies to sole owners, exclusive licensees, exclusive sub-licensees, usufructuaries, inheritance estate administrators, executors of an inheritance estate, bankruptcy estates (represented by the bankruptcy administrator), and creditors in bankruptcy (once the claim has been assigned to them).

Where the permission to enforce the licensed IP has been explicitly excluded in an exclusive licence agreement or an exclusive sub-licence agreement, the exclusive licensee or sub-licensee does not have standing to bring such an action (Art. 55 para. 4 TmPA; Art. 35 para. 4 DesA; Art. 75 para. 1 PatA; Art. 62 para. 3 CA).

- b) Whether any other person is required to be joined into the claim, in order to bring the claim?

If a person has an independent standing to sue, it does not need to be joined by anybody else to bring the claim. This applies to sole owners, exclusive licensees, exclusive sub-licensees, usufructuaries, inheritance estate administrators, executors of an inheritance estate, bankruptcy estates (represented by the bankruptcy administrator), and creditors in bankruptcy (once the claim has been assigned to them).

In principle, joint owners of IP rights must sue together. Some scholars take the view that this does not apply to jointly owned patents (see above ad Question 1).

A non-exclusive licensee who wants to claim damages from an infringer needs to join an already pending infringement action (initiated by the IP owner or an exclusive licensee) against the infringer (Art. 55 para. 4 *in fine* TmPA; Art. 35 para. 4 *in fine* DesA; Art. 75 para. 2 PatA; Art. 62 para. 3 *in fine* CA).

- c) Whether there are any other conditions that are required to be satisfied, in order to bring the claim?

Apart from the standing to bring the action, each claimant has to show a legal interest in its infringement claim. This is a procedural requirement for any complaint in Switzerland.

By way of example, the Federal Patent Court decided that an exclusive sub-licensor lacks legal interest in an infringement action if the sub-licence it has granted is royalty-free.

3. Does the relief available to a claimant for infringement depend on the standing of the claimant, and if so, how?

Yes.

- *Right owners* always have standing to sue for all kinds of reliefs (*inter alia*, injunction and financial compensation). The same applies to usufructuaries and the “other persons» entitled to bring a claim set out in Question 1.
- *Exclusive licensees* have standing to sue for all kinds of reliefs, except if the standing to sue has been excluded in the licence agreement.
- *Non-exclusive licensees* only have the right to join an existing action (started by the right owner or an exclusive licensee) to claim *damages corresponding to the licensee’s own loss*. The right to join an existing lawsuit can only be exercised if the claimant (right owner or exclusive licensee) is itself claiming damages. Non-exclusive licensees cannot request any other relief, such as for example an injunction.

4. Whom could a claim for inter partes declaration of invalidity and/or declaration of non-infringement be brought against (please refer to paragraph 33)?

- a) As a defence (objection) in a pending infringement lawsuit
- aa) *Inter partes* declaration of invalidity (nullity) as a defence (objection) in an infringement lawsuit

A claim for *inter partes* declaration of invalidity (nullity) can be brought as a defence (objection) against claimant(s) in an infringement lawsuit, i.e. against:

- the IP owner
- an exclusive licensee (registered or not with the respective public registers, unless the licencing contract excludes standing to sue for infringement)
- all licensees who have joined the action.

The dispositive part of the judgment will only deal with the infringement; the nullity will only be dealt with in the reasoning of the judgment.

bb) *Inter partes* declaration of non-infringement as a defence in an infringement lawsuit

A claim for *inter partes* declaration of non-infringement can be brought as a defence (objection) against claimant(s) in an infringement lawsuit, i.e. against:

- the IP owner
- an exclusive licensee (registered or not with the respective public registers, unless the licencing contract excludes standing to sue for infringement)
- all licensees who have joined the action.

b) *Inter partes* declaration of invalidity (nullity) in a pending lawsuit for declaration of non-infringement

A claim for an *inter partes* declaration of invalidity (nullity) can be brought as an additional argument against a defendant in a procedure for declaration of non-infringement, i.e. against:

- the IP owner
- an exclusive licensee (registered or not with the respective public registers, unless the licencing contract excludes active legitimation to sue for infringement).

The dispositive part of judgment will only deal with non-infringement; nullity will only be dealt with in the reasoning of the judgment.

c) As an independent lawsuit

aa) *Inter partes* declaration of invalidity as an independent lawsuit

Such claim can be filed against:

- the IP owner
- an exclusive licensee
- anybody who claims that an IP right is infringed.

To the Swiss Group's knowledge, there are no precedents in Switzerland of such a lawsuit being filed against a licensee, although scholarly writing confirms that this should be possible. In such a situation, the presumed infringer would be on the safer side to file not only an *inter partes* declaratory lawsuit for invalidity against the exclusive licensee, but an invalidity lawsuit against the right owner.

bb) *Inter partes* declaration of non-infringement as an independent lawsuit

Such claim can be filed against:

- the IP owner
- an exclusive licensee
- anybody who claims that an IP right is infringed.

5. Who could a claim for in rem revocation/nullity be brought against? Please refer to paragraph 35.

A claim for annulment of an IP right, whether in the form of a claim for negative declaratory relief or of a counterclaim, can only be brought against the right owner.

Since the claimant (either in independent nullity proceedings or as a defendant and counter-claimant in infringement proceedings) can have the IP right declared invalid by the court with final, binding and *erga omnes* effect, the right owner must be involved in the proceedings, because otherwise it risks losing its IP right without the possibility of defending its validity against the claim for nullity. For this reason, the prevailing doctrine is of the opinion that a claim for *in rem* revocation/nullity may only be brought against the right owner.

The question to be examined *ex officio* whether a party is entitled to act as plaintiff (standing to sue) and which party is to be sued (standing to be sued) is determined by substantive law, not by procedural law. The absence of either of them leads to the dismissal of the claim.

If an exclusive licensee starts infringement proceedings based on the licensed IP right, the defendant cannot bring a counterclaim against the plaintiff-licensee because of the licensee's lack of standing to be sued. To put it differently: The licence agreement in combination with the substantive law grants the exclusive licensee the standing to bring an infringement claim in its own name, but not the standing to be sued in proceedings regarding the validity of the IP right.

This does not create any substantial negative effects for the (alleged) infringer sued by an exclusive licensee, since it may raise an objection of invalidity of the IP right which it allegedly infringes (see above ad Question 4/a/aa), which – if successful – leads to the dismissal of the action. The decision on the objection is not part of the dispositive part of the judgment, but only forms part of the reasoning. Thus, the decision on the validity of the IP right does not acquire substantive legal force and is only effective *intra partes*, not *erga omnes*. Due to these limited consequences – in particular since the IP owner is not affected in its rights – the objection of nullity against the licensee who has filed suit is admissible.

The same goes for any claim for *in rem* revocation/nullity brought against sole or non-exclusive licensees, usufructuaries and pledgees. A nullity action brought against any of them would have to be dismissed by the court.

Collective owners of an IP right, whether co-owners or joint owners (see above ad Question 1), must be sued or counter-sued jointly for nullity of their IP right, even if only one of them brings a claim for infringement of that IP right, either on the basis of an internal authorisation (Art. 647a para. 2 Civil Code) or because the defence is urgent (Art. 647 para. 2 item 2 Civil Code), or based on Art. 33 para. 2 PatA (as *lex specialis*).

The exclusive licensee does not have the obligation to include the IP right owner in the infringement proceedings, although it would be free and may be well advised to do so. It is rather the party asserting the nullity who must bring its nullity action against the right owner, or against all of the right owners, because otherwise its claim would be dismissed for lack of standing to be sued.

6. Are there any standing requirements to bring a claim under 4. above (inter partes declaration of invalidity and/or non-infringement)?

a) As a defence (objection) in a pending infringement lawsuit

aa) *Inter partes* declaration of invalidity (nullity) as a defence (objection) in an infringement lawsuit

The infringement lawsuit must be pending and the alleged infringer must allege the invalidity and has the burden to prove invalidity.

bb) *Inter partes* declaration of non-infringement as a defence in an infringement lawsuit

A declaration of non-infringement in a pending infringement lawsuit is in principle neither necessary nor possible, as the decision dismissing an infringement claim is implicitly also declaring that the IP right in suit is not infringed.

However, in specific situations, the defendant to an infringement lawsuit can have a special interest in an additional declaration of non-infringement, in particular if part or all of the allegedly infringing products have not yet been manufactured or imported yet (see below ad Question 12). Thus, an explicit request (plea for relief) to have a non-infringement declared within the framework of an infringement lawsuit is available for an existing product and for a proposed or future product that has not yet been made or offered or sold.

A request for a declaration of non-infringement regarding a product that does not yet exist, practically requires that the specific features of the planned or future product are known to the parties and can be examined with regard to a potential infringement in the course of the lawsuit.

- b) *Inter partes* declaration of invalidity (nullity) in a pending lawsuit for declaration of non-infringement

The procedure for declaration of non-infringement must be pending, the alleged infringer must allege invalidity and has the burden to prove invalidity.

- c) As an independent lawsuit

- aa) *Inter partes* declaration of invalidity as an independent lawsuit

The claimant (alleged infringer) must prove a legal interest in the proceedings. Three criteria for the legal interest have been defined: (1) the claimant party is in a legally uncertain situation; (2) the claimant cannot be expected to further tolerate the legal uncertainty; and (3) no alternative to the declaration of non-infringement is available.

- bb) *Inter partes* declaration of non-infringement as an independent lawsuit

What has been set out above regarding the *inter partes* declaration of invalidity as an independent lawsuit (Question 6a/c/aa) applies equally to the *inter partes* declaration of non-infringement as an independent lawsuit. However, the threshold to prove legal interest in a declaration of non-infringement is substantially higher than the threshold to prove legal interest in a declaration of invalidity.

In practice, a legal interest for a declaration of non-infringement may be proven, e.g. when unfounded allegations of infringement are raised in the market place against the alleged infringer, or when the alleged infringer is denied the grant of a royalty-free licence or other confirmation for freedom-to-operate for his product from the patent owner.

6. Are there any standing requirements to bring a claim under 5. above (in rem revocation/nullity)?

For asserting *in rem* revocation/nullity of the respective IP right by means of an action for a declaratory judgment, the plaintiff must prove that it has a legally relevant interest. Being a procedural requirement, the interest is examined *ex officio* (Arts. 59, 60 Civil Procedure Code), and it is widely acknowledged that its absence leads to the court not taking the claim at hand (instead of dismissing the claim).

There is no doubt that the court would affirm the interest of the alleged infringer if it wants to bring an invalidity counterclaim against an accusation of infringement. The defendant accused of IP infringement has an interest in a declaratory judgement of partial invalidity of the IP right only if the allegation of infringement is thereby invalidated.

Even in other circumstances, the threshold for a legally relevant interest remains low. In patent law, it is sufficient, e.g. if the parties are in a competitive relationship and if the scope of protection of a patent extends to the plaintiff's field of activity, whereby the plaintiff does not have to prove that any product manufactured/process practised by it actually falls within the scope of protection of the granted claims of the patent it wants to attack (*in rem* revocation/nullity). Whether the principle that being in a competitive relationship is sufficient to have standing to sue for invalidity applies to all IP rights or only to patents has not yet been decided by Swiss case law.

The interest may therefore be defined broadly, and an interest may be affirmed whenever the plaintiff is able to show a legal or factual impediment to its economic freedom. A competitive relationship need not necessarily exist; it is sufficient that the IP right may affect the economic activities of the plaintiff, which may be the case even without a competitive relationship, e.g. if the IP owner is an IP exploitation company (IP troll). An indirect interest in the sense that not the plaintiff itself, but its potential customers are affected by the IP right, is also sufficient.

The interest may be denied, however, if somebody who seeks an *in rem* revocation/nullity cannot demonstrate that the nullity would confer any benefit to it, or who is merely interested in inflicting economic damage and disadvantage on the right owner.

In addition, mere idealistic interests do not suffice.

II. Policy considerations and proposals for improvements of your Group's current law

7. Are there aspects of your Group's current law or practice relating to standing to litigate IP rights that could be improved? If YES, please explain.

The Swiss Group finds the current position, that non-exclusive licensees do not have standing to enforce the licensed IP rights against third-party infringers, unsatisfactory in certain situations (e.g. where the right owner does not have sufficient interest in enforcing the right against a specific infringer because it does not feel overly affected by the specific infringement). Such infringements, however, may harm the non-exclusive licensee significantly, and it may not be sufficient for the licensee to rely on damage claims it may have against the inactive right owner (particularly because such damage claims are often difficult to quantify and to enforce). The Swiss Group would welcome the possibility for the right owner to assign specific claims for injunctive relief against specific infringers to the non-exclusive licensee.

The Swiss Group would welcome a clear statutory regime regarding the standing to sue in case of collective ownership of IP rights, which takes into account the peculiarities of such rights. In addition, the same statutory regime should, to the extent practicable, apply to all IP rights.

8. Should the standing of a person to litigate an IP right depend on whether that person suffers loss caused by the infringement, or has any other interest in the claim?

The Swiss Group takes the view that some kind of interest should be required for admitting the standing of a person to litigate. However, this does not necessarily have to be a loss that such person has suffered. The interest can be any other interest worthy of protection.

9. Should it be possible to "outsource" enforcement of IP rights by authorising third parties, who suffer no loss from any infringement, to litigate?

In principle, such "outsourcing" should not be possible (regarding non-exclusive licensees, who suffer a loss from the infringement, see the answer above ad Question 7). Swiss law has sufficient means to allow third parties to finance a court procedure without 'outsourcing' the enforcement claim to the financing party.

10. If it is possible to "outsource" enforcement of IP rights to third parties, should the quantification of damages in such an outsourced action depend on the loss suffered by the third-party claimant, or the loss suffered by the owner of the IP right?

In the opinion of the Swiss Group, the third-party claimant should only be able to sue for the amount of the loss it suffered itself and not for the amount of damages suffered by the right owner, except if the claimant is a fiduciary or trustee for the third party or is obligated to hold the third party harmless. The possibility to sue for the entire loss suffered by the right owner should nonetheless remain possible, but only if the right owner assigns its financial claim to the third party.

11. Should IP right owners always be joined into a case if there is an *in rem* determination of validity?

There are compelling arguments to require that the owner/all of the owners of the IP right in question should be involved in the case involving the potential *in rem* declaration of nullity of that IP right in all circumstances. Otherwise, poor litigation tactics by the exclusive licensee could lead to an adverse decision and the definitive revocation and nullity of the IP right, without its owner having any way to defend its property.

This principle should apply in all circumstances, even if the right owner has given a royalty-free exclusive licence for its IP right.

Proceedings where the *in rem* validity or nullity of an IP right is at stake therefore need to include the right owner(s).

12. Should a declaration of non-infringement only be available in relation to an existing product, or should such a claim also be available for proposed products that have not been made or sold yet?

The Swiss Group takes the view that any concrete interest would justify a claim for a declaration of non-infringement. According to Swiss practice, for such a claim a mere future interest is sufficient if it is at minimum likely to materialise. Therefore, a claim for a declaration of non-infringement may also be available for a party who intends and proposes to manufacture and market products which would infringe the relevant IP right, if it were valid. A prospective market entrant must have the possibility to clear the risk of a potential IP infringement before actually entering that market.

Nonetheless, the claimant must be able to show that there is a concrete risk that an infringement claim will be raised regarding the specific proposed product.

13. Are there any other policy considerations and/or proposals for improvement to your Group's current law falling within the scope of this Study Question?

The Swiss Group finds that it is unclear, under current Swiss law, on what basis non-exclusive licensees can join an infringement action and whether they have an autonomous claim for financial compensation against the infringer or whether they are claiming the right owner's loss in their own name. The Swiss Group would welcome a clarification of this issue in the statute or by a precedent.

III. Proposals for harmonisation

14. Do you believe that there should be harmonisation in relation to standing to litigate IP rights?

Yes. Harmonising the standing to litigate IP rights would contribute to avoiding difficulties when enforcing IP rights in cross-border constellations.

15. Who should have standing to bring a claim of infringement of an IP right, and subject to what (if any) conditions?

In the Swiss Group's view, right owners should always have standing to sue. For collective ownership, the statute governing the respective IP right should define expressly whether collective owners have standing to bring an infringement claim individually or collectively. The members of the Swiss Group unanimously take the view that joint owners always should bring such a claim together. The majority of the Swiss Group further takes the view that each of the co-owners should be entitled to bring action regardless of the other co-owners.

Exclusive licensees and exclusive sub-licensees should have standing to sue unless such standing is excluded in the respective licence agreement. Furthermore, the Swiss Group would welcome the possibility for the right owner to assign specific claims for injunction relief against specific infringers to non-exclusive licensees.

In very special circumstances, such as inheritance or bankruptcy situations, other persons may be given the standing to sue in their own name, but we do not see a need to grant such right more broadly.

In order for any of the above to bring a claim of infringement, an interest worthy of protection should always be required (as a requirement of substantive or procedural law), however low the standard may be. It should be considered to let purely idealistic motives suffice (see Question 19).

16. Should the remedies available, including the quantification of damages, depend on who brings claim of infringement of an IP right, and if so, how?

The Swiss Group submits that some differentiation is necessary in the available remedies, depending on who brings the infringement claim.

- The right owner should always be entitled to claim all remedies available in the respective jurisdiction (injunction, destruction, recall, damages, disgorgement of profits, etc.). The right owner's standing to sue should not be mutually exclusive with other potential claimants, i.e. the right

owner should always have standing to sue for all remedies available, irrespective of whether others (e.g. an exclusive licensee) are also joined in the lawsuit.

- Exclusive licensees should be able to claim the same remedies as right owners, except if the licence agreement limits or excludes one or more of these rights. However, when suing for damages, exclusive licensees should only be able to claim damages for the loss suffered by them, including damage that persons suffered whom they have to hold harmless (sublicensees, etc.), to the exclusion of the loss of the right owner or other licensees.
- The remedies that can be claimed by other claimants should be more limited. There are no policy reasons to allow, e.g. non-exclusive licensees to sue for an injunction or the destruction of infringing devices. This is particularly true in situations with many parallel non-exclusive licence agreements, where non-exclusive licensees can have interests opposite to the right owner or each other.
- Non-exclusive licensees should be entitled to damages corresponding to their own loss. This can be either with the consent of the right holder or without its consent.

17. Who could a claim for an *inter partes* declaration of invalidity or a declaration of non-infringement be brought against?

In the view of the Swiss Group, an *inter partes* declaration of non-infringement should be brought against anyone who would have standing to sue for infringement, as well as any person who alleges that the claimant is infringing an IP right.

In the view of the Swiss Group, there is no compelling case to limit the standing to be sued for an *inter partes* declaration of invalidity.

- The defendant in infringement proceedings should always be able to object that the allegedly infringed IP right is invalid.
- If an alleged infringer initiates a separate lawsuit for an *inter partes* declaration of invalidity (and the alleged infringer has the required standing to sue), it should equally be able to argue against any defendant that the underlying IP right is invalid.

18. Who could a claim for *in rem* revocation/nullity be brought against?

In view of the Swiss Group, there is a compelling case that the right owner (and, in case of collective ownership, all right owners) must be joined to a case where the IP right can be revoked *in rem* (see above ad Question 11).

19. What conditions/standing requirements should be satisfied by a claimant before a claim for a declaration of invalidity and/or non-infringement can be brought?

In the view of the Swiss Group, the threshold for bringing a claim for a declaration of invalidity should be low. Mere idealistic interest should suffice if a patent would otherwise never be able to be challenged, e.g. for violation of public policy, such as patenting the human body (Art. 1a PatA), on the condition that the idealistic motives are not a sham for illicit economic intentions.

In a lawsuit for a declaration of non-infringement, the burden of proof of infringement generally lies with the right owner, i.e. the defendant. Such a lawsuit, in effect, forces the right owner to conduct an infringement lawsuit against its will. Therefore, in the view of the Swiss Group, the threshold for bringing a claim for a declaration of non-infringement should be higher. In any event, the person who is accused of IP infringement should always have an interest in a declaration of non-infringement.

20. Should there be any difference, in terms of requirements for standing, between actions in courts and actions in administrative tribunals (such as patent offices)?

Regarding the standing to be sued, it is the view of the Swiss Group that all IP owners must necessarily participate in any (administrative or civil) proceedings that may result in declaring the IP right invalid *in rem*.

With regard to the standing to sue, the Swiss Group thinks it is desirable, but not necessary, that the requirements be identical between civil courts and administrative bodies.

21. Please comment on any additional issues concerning any aspect of standing to litigate IP rights you consider relevant to this Study Question.

n/a

22. Please indicate which industry sector views provided by in-house counsel are included in your Group's answers to Part III.

None.

Summary

The question of who is entitled to bring an action, which claims can be brought against whom and in which proceedings is particularly relevant in intellectual property law. AIPPI's Questionnaire Q275 also goes further than its title suggests and discusses, besides the actual issue of standing to sue, some related issues, such as whether the alleged infringer of an intellectual property right may request a declaration of invalidity of the same with only inter partes effect, or whether certain types of claims may only be brought by certain groups of claimants. Like any AIPPI Study Questionnaire, Q275 contains three parts. In the first part, the respective (here: Swiss) law is discussed de lege lata. In the second part, the working group proposes improvements to the applicable law de lege ferenda; in this case, the Swiss group would welcome some clarifications and selective changes, in particular regarding the standing to sue of non-exclusive licensees. In the final part, questions are raised concerning the international harmonisation of this area of law. In this respect, the Swiss Group would welcome a harmonisation in that right holders and exclusive licensees should in principle have standing to sue for infringement actions and that an erga omnes annulment of an intellectual property right should not be possible in proceedings without the participation of the right holder.

Zusammenfassung

Die Frage, wer berechtigt ist, welche Ansprüche gegen wen und in welchem Verfahren einzuklagen, ist im Immaterialgüterrecht besonders relevant. Der Fragebogen Q275 der AIPPI geht zudem weiter als sein Titel es ahnen lässt und erörtert neben dem eigentlichen Thema der Aktivlegitimation noch einige verwandte Themen, wie beispielsweise die Frage, ob der angebliche Verletzer eines Immaterialgüterrechts eine Nichtigkeitsklärung desselben mit Wirkung nur inter partes verlangen kann oder ob gewisse Arten von Rechtsbegehren nur von gewissen Gruppen von Klägern gestellt werden können. Wie jeder AIPPI Study Questionnaire enthält auch Q275 drei Teile. In einem ersten Teil wird das jeweilige (hier: das schweizerische) Recht de lege lata erörtert. Im zweiten Teil schlägt die Arbeitsgruppe Verbesserungen des anwendbaren Rechts de lege ferenda vor; vorliegend würde die Schweizer Gruppe einige Klarstellungen und punktuelle Änderungen, insbesondere bei der Aktivlegitimation von nichtausschliesslichen Lizenznehmern, begrüssen. Im letzten Teil werden Fragen zur internationalen Harmonisierung dieses Rechtsgebiets gestellt. Die Schweizer Gruppe wünscht insofern eine Vereinheitlichung, dass Rechtsinhaber und ausschliessliche Lizenznehmer für Verletzungsklagen grundsätzlich aktivlegitimiert sein sollen und dass eine Nichtigkeitsklärung erga omnes eines Immaterialgüterrechts nicht in einem Verfahren ohne Beteiligung des Rechtsinhabers möglich sein soll.

Résumé

La question de savoir qui est habilité à intenter une action, quelles prétentions doivent être portées contre qui et dans quelle procédure est particulièrement pertinente en droit de la propriété intellectuelle. Le Questionnaire Q275 de l'AIPPI va, de surcroît, plus loin que son titre ne le suggère et aborde, outre la question de la légitimation active, certaines questions connexes, telles que la question de savoir si le contrefacteur présumé d'un droit de propriété intellectuelle peut demander la déclaration d'invalidité de ce droit avec effet seulement inter partes, ou si certains types de demandes ne peuvent être présentées que par certains groupes de demandeurs. Comme tout questionnaire de l'AIPPI, le Q275 comporte trois parties. Dans la première partie, le droit applicable (ici: suisse) est examiné de lege lata. Dans la deuxième partie, le groupe de travail propose des améliorations du droit

applicable de lege ferenda; dans ce cas, le groupe suisse accueillerait favorablement certaines clarifications et modifications ponctuelles, notamment en ce qui concerne la légitimation active des preneurs de licence non exclusive. La dernière partie soulève des questions concernant l'harmonisation internationale de ces questions juridiques. À cet égard, le groupe suisse souhaite une unification en ce sens que les titulaires de droits et les preneurs de licences exclusives devraient en principe bénéficier d'une légitimation active et qu'une annulation erga omnes d'un droit de propriété intellectuelle ne devrait pas être possible sans la participation du titulaire du droit dans la procédure.