

AIPPI Study Question Q287 – Responsibility of online marketplaces for online infringement of Industrial Property Rights

Report of the Swiss Group

I. Current Law and Practice

A. Responsibility regimes applicable to OMs

1) In your jurisdiction, please indicate if the responsibility of OMs for IPRs infringement is subject to the following legislation (please answer YES or NO and cite the applicable texts):

a) the General IP Law regime

Partially yes.¹ The General IP Law regime provides for provisions applicable to OMs in case of infringements of the following IPRs: (i) trademarks (Arts. 55, 59, 13 para. 2 and Art. 3 para. 1 Trade Mark Protection Act (TmPA)), (ii) designs (Arts. 35, 38 and 9 Federal Act on the Protection of Designs (DesA)), and (iii) patents (Arts. 66, 72, 73, 77 and 8 Federal Act on Patents for Inventions (PatA)). These provisions mainly contain the actions available to an IPR holder in case of IPR infringements, including injunctive relief and damage claims. Liability claims are subject to the General Law regime by reference. (see below, question 1) c)).

b) a Special Digital Law regime

No.

c) the General Law regime

Partially yes. The General Law regime – notably Art. 41 of the Swiss Code of Obligations (SCO), (regarding the conditions of tort liability); Art. 50 SCO (for joint liability); Art. 423 SCO (for restitution of profits); and Art. 49 SCO (for moral prejudice) – is applicable by reference made by the General IP law regime (Art. 73 paras. 1 and 3 and Art. 55 para. 2 TmPA; Art. 35 para. 2 DesA).

It should be noted that the PatA (Art. 73 paras. 1 and 3) does not explicitly refer to the General Law claims for restitution of profit and moral prejudice, contrary to the TmPA (Art. 55 paras. 1 and 2) and the DesA (Art. 35 paras. 1 and

2). However, leading scholars² and case law³ consider that both legal remedies are also available in case of patent infringement.

d) an alternative/different regime

No.

2) If a Special Digital Law regime exists in your jurisdiction (applicable in particular to OMs), is this regime of responsibility more stringent or more liberal (e.g. exemption of responsibility, safe harbor, etc.) for OMs than the General IP Law, in case of IPRs infringement?

N/A.

3) If a Special Digital Law regime exists in your jurisdiction, what justifies the application of a Special Digital Law regime to the OMs in relation to IPRs infringement?

N/A

4) If OMs can benefit an exemption of responsibility/safe harbor, what are the criteria for determining whether an OM is subject to this regime (e.g. active or passive role of the OM, knowledge/control of the presentations of the products, awareness of the IP rights infringement, etc.). Please give examples (case law, etc.).

As mentioned (question 1), Swiss law does not contain statutory provisions specifically addressing the question of liability of OMs in case of IPR infringement, and the General IP Law and General Law regimes are applicable. Accordingly, Swiss law has no legal provision allowing OMs in particular to avoid civil liability in case of IPR infringement (i.e. there is no statutory safe harbor provision). Instead, OMs may rely on the general grounds for exclusion of liability according to the General Law regime (see below questions 5–8).

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The english translation of the summary is included on Swissex and legalis only.

1 NB: Copyrights are outside of the scope of study.

2 SCHLOSSER Ralph, Art. 73 LBI in: DE WERRA Jacques/DUCOR Philippe, Commentaire romand, B ale 2013, NN 32–33; HEINRICH Peter, PatG/EP U, Kommentar zum schweizerischen Patentgesetz und den entsprechenden Bestimmungen des Europ aischen Patent ubereinkommens synoptisch dargestellt mit erg anzenden Gesetzen und Staatsvertr agen, Z urich 1998, Art. 73 N 80.

3 DFSC, 134 III 306, consid. 4.1.2.

B. The implementation of the OMs responsibility regimes

The purpose of this chapter is to determine the implementation for each responsibility regime applicable to OMs in your jurisdiction (conditions to engage responsibility, exceptions, exemptions, etc.).

The purpose is, for instance, to determine under what conditions an OM can be considered an IP infringer, co-infringer, accomplice, or contributory IP infringer (use of the IP on its own benefit, awareness of IP rights infringement, providing of specific services such as optimizing the presentation, promoting offers, etc.), and under what conditions an OM can benefit from an exemption of responsibility/safe harbor (acting expeditiously following awareness of IP rights infringement, etc.), etc.

To answer each question in this chapter, please deal separately with each responsibility regime applicable in your jurisdiction.

General IP law regime (if applicable to OMs)

5) In your jurisdiction, under what conditions can an OM be held responsible for IP rights infringement or, on the contrary, to be exempted from responsibility for an IP rights infringement in each of these cases?

a) in patent law:

The circumstances that may give rise to civil liability under the PatA are: (a) the unlawful use (including imitation) of a patented invention; (b) the refusal to notify the authority concerned of the origin and quantity of products in her or his possession which are unlawfully manufactured or placed on the market, and to name the recipients and disclose the extent of any distribution to commercial and industrial customers; (c) the removal of the patent mark from products or their packaging without authorization from the proprietor of the patent or the licensee; and (d) the abetment to the said offenses, participation in them, or aiding or facilitating the performance of any of these acts (Art. 66 PatA).

In all cases in which the OM does not hold any goods but merely acts as a platform connecting the (i) buyers and (ii) third-party sellers, the OM may be held jointly and severally liable with the third-party seller offering for sale a patent infringing good as a party participating, aiding or facilitating a patent infringement (Art. 66 lit. d PatA; Art. 50 SCO; see the Decision of the Swiss Federal Supreme Court (DFSC) 145 III 72, para. 2.2.1 and 129 III 588, para. 4.1; see below question 6 for more details on Art. 50 SCO). In any case, the OM may only be held liable for damages and disgorgement of profit if the liability General Law regime conditions are met (see below, question 8).

The OM may still, however, be subject to a cease-and-desist order in the absence of any fault (i.e. a condition of the General Law regime). Indeed, it is sufficient that the OM participates in the threat of an unlawful infringement.

b) in trademark law:

The circumstances that may give rise to a trademark infringement are set out in Arts. 13 para. 2 cum Art. 3 para. 1

TmPA, i.e. "(a) affixing the sign to goods or their packaging; (b) offering goods, placing them on the market or storing them for such purposes under the sign; (c) offering or providing services under the sign; (d) importing, exporting or carrying in transit goods under the sign; (e) using the sign on business papers, in advertising, or otherwise in the course of trade".

In relation to the use of trademarks on internet, the Swiss Federal Supreme Court held that the mere availability of a sign on the internet is not sufficient to constitute an act of use under trademark law. Rather, a territorial link (*räumliche Beziehung*) with Switzerland is required. The use of a trademark has a relevant link if it has economic effects in Switzerland. The existence of such effects is determined on the basis of an overall assessment of the concrete circumstances. In this assessment, account must be taken of the effects of the use of the sign on the national economic interests of the right holder, but also of the balance between the interests of the user and those of the right holder. In this balancing of interests, technological developments, such as the possibility of introducing geo-blocking (by which the owner of a website excludes the possibility of access in certain countries) or geo-targeting measures, should be taken into account (DFSC 146 III 225).

If the OM stores and offers infringing goods on its own behalf, it can be held directly liable for a trademark infringement (i.e. Art. 13 para. 2 TmPA) provided that the General Law regime conditions are also met (see below, question 8).

In addition, the OM acting as an e-commerce website (connecting buyers and sellers) may be held jointly and severally liable with the third-party seller offering an infringing good (Art. 50 SCO), if it also itself fulfils the conditions of the General Law regime (see below, question 8).

The OM may still, however be subject to a cease-and-desist order in the absence of any fault (i.e. a condition of the General Law regime). Indeed, it is sufficient that the OM participates in the threat of an unlawful infringement.

c) in design law

According to Art. 9 para. 1 DesA, the design right confers on the right holder the right to prohibit others from using the design for commercial purposes. Use includes, in particular, manufacturing, storing, offering, placing on the market, importing, exporting, and carrying in transit, as well as possession for any of these purposes.

If the OM stores and offers infringing goods on its own behalf, it can be held directly liable of a design infringement (i.e. Art. 9 para. 1 DesA) provided that the General Law regime conditions are also met (see below, question 8).

In addition, the OM acting as an e-commerce website (connecting buyers and sellers) may be held jointly and severally liable with the third-party seller offering an infringing good insofar as it participates or facilitates the unlawful use (Art. 9 para. 2 DesA), if it also itself fulfils the conditions of the General Law regime (see below, question 8).

The OM may still, however, be subject to a cease-and-desist order in the absence of any fault (i.e. a condition of

the General Law regime). Indeed, it is sufficient that the OM participates in the threat of an unlawful infringement.

6) Please indicate under what circumstances an OM can be considered an IP infringer, co-infringer/joint tortfeasor, accomplice, or contributory infringer.

OMs may be considered direct IPR infringers only when they store and offer infringing goods on their own behalf. Otherwise, when OMs act as e-commerce websites (connecting buyers and sellers), they can qualify as co-infringer (Art. 66 lit. d PatA, Art. 9 para. 2 DesA, and Art. 50 SCO, see above question 5).

A co-infringer participates or facilitates the infringement, i.e. either as an accomplice or an instigator:

- An **instigator** wrongfully incites others to commit an objectively unlawful act (DFSC 145 III 72, para. 2.3.1). According to the Swiss Supreme Court (DFSC 129 III 25), whoever grants by contract the right to distribute products that fall under the patent falls under Art. 66 lit. d PatA.
- An **accomplice** aids and abets in the infringement of a right (DFSC 145 III 72, para. 2.3.1).

Concerning patents, the Swiss Federal Patent Court (SFPC) found that a party who had been ordered to refrain from an infringement must remove links to the websites of sellers on which patent-infringing products continue to be promoted and offered. Otherwise, said party's conduct is considered participation in the patent infringement. The party has a substantial duty of care and is negligent if it does not check, within the limits of what is reasonably required and possible, the offering of the various traders on their websites. In this respect, adding a disclaimer that certain products protected by a patent in Switzerland would not be sold in Switzerland is not sufficient if it adds a list of links where the products can be sold. Such disclaimers do indeed not deter website visitors from following the web links to the third-party merchants' websites (SFPC S2021_009 of March 14, 2022, para. 10 et seq.).

An action for an injunction against a co-infringer can only be successful if the claimant establishes that a wrongful act has been committed or is threatened to be committed (DFSC 145 III 72, para. 2.3.1).

Further, in a case related to copyright infringement on the internet, the Swiss Federal Supreme Court found that to admit causation between the infringement and the participating act, it must be possible to attribute the result of the infringement to the participating party. A cease and desist may not be ordered if the participating party merely has a vague influence on the unlawful act, without being sufficiently closely related thereto (DFSC 145 III 72). Though there is no case law pertaining to OMs to date, courts would likely consider OMs to have a sufficient influence concerning the infringing act to hold them liable.

Special Digital Law regime (if such a regime applies to OMs)

7) In your jurisdiction, what are the conditions for an OM to be held responsible on this basis? What obligations must the OM fulfill in order to be exempted from responsibility for an IP rights infringement? If possible, please give examples for each IPR separately.

N/A

8) In your jurisdiction, what are the conditions for an OM to be held responsible on this basis? What obligations must the OM fulfill to be exempted from responsibility for an IP rights infringement? If possible, please give examples for each IPR separately.

In addition to the conditions set out in the General IP Law regime applicable to the infringed IPR (see above question 5), the OM may only be held liable for damages if the General Law regime conditions are met. Tort liability under the Swiss General Law regime (Art. 41 CO) requires: (a) damage, (b) the infringer's fault (intentional or negligence), (c) an unlawful act, and (d) an adequate causal link between the infringing act and the damage incurred by the injured party.

Moreover, disgorgement of profit may be claimed if the following conditions are met: (a) interference in the business of another party (the principal) without a mandate; (b) violation of legally protected rights of the principal; (c) the existence of bad faith; and (d) the existence of a causal link between the interference with the business of the aggrieved party (the principal) and the profits made by the offending party (the agent). Swiss law does not allow claims for the disgorgement of profits except in specific circumstances where a statutory provision expressly provides for such a claim, such as in case of trademark infringements (Art. 55 para. 2 TMA) and design right infringements (Art. 35 para. 2 DesA). With respect to patent rights, Art. 73 paras. 1 and 3 PatA does not explicitly refer to the General Law claims for restitution of profit and moral prejudice. However, leading scholars⁴ and case law⁵ consider that this legal remedy is also available in case of patent infringement. In any case, an OM which is liable as a co-infringer will only be obliged to return its profit (to the exclusion of the profit that the third-party infringer seller has made).

In Switzerland, no specific regulations or case law outlines the circumstances under which OMs may avoid responsibility for an IPR infringement.

However, in specific circumstances and applying the general principles of the SCO, OMs may be exempted from liability. Such exemption could occur in particular if the above-mentioned requirements (i) fault and (ii) causation

4 SCHLOSSER Ralph, Art. 73 LBI in: DE WERRA Jacques/DUCOR Philippe, Commentaire romand, Bâle 2013, NN 32–33; HEINRICH Peter, PatG/EPÜ, Kommentar zum schweizerischen Patentgesetz und den entsprechenden Bestimmungen des Europäischen Patentübereinkommens synoptisch dargestellt mit ergänzenden Gesetzen und Staatsverträgen, Zürich 1998, Art. 73 N 80.

5 DFSC, 134 III 306, consid. 4.1.2.

are not met. There is currently no specific case law dealing with this question.

Arguably, in cases in which the OM is not aware that a third-party seller offers for sale an IPR infringing good on its platform, the OM may be exempt from liability as it would not meet the condition of fault. Indeed, it would likely appear disproportionate (as extremely burdensome) to impose on OMs the responsibility to monitor and control the IPR compliance of all the goods offered on its platform such that should they fail to do so they would likely not be considered negligent. As soon as the OM becomes aware of an IPR infringement or of circumstances that give rise to the suspicion of an IPR infringement, the OM will be considered at fault.

Other liability regime (if applicable to OMs)

9) In your jurisdiction, what are the conditions for an OM to be held responsible on this basis? What obligations must the OM fulfill to be exempted from responsibility for an IP infringement? If possible, please give examples for each IPR separately.

N/A

C. Sanctions that can be imposed on OMs

The purpose of this part is to determine the sanctions that can be imposed (in your jurisdiction, by a judge, or by any other state entity) on an OM whose responsibility is engaged under one or more forms of responsibility (damages, injunction to delist a seller, obligation to inform/reimburse the buyers, obligation to prevent future sales of the infringing product, etc.).

To answer each question in this chapter, please deal separately with each form of responsibility applicable in your jurisdiction. For each form of responsibility, please treat each IPR (patent, trademark, design) separately only if you consider it necessary.

General IP law regime (if applicable to OMs)

10) In your jurisdiction, what sanctions can be imposed on an OM when the conditions of its responsibility are met?

Injunction or remedy: The General IP Law regime explicitly provides that the infringer may be subject to an injunction to prevent an IPR infringement or be ordered to remedy the unlawful situation (Art. 72 PatA, Art. 35 para. 1 DesA, Art. 55 para. 1 TmPA). See also under question 12.

Destructions of goods: In case OMs offer and sell products in a capacity as an online store for third-party sellers and thus hold the IPR infringing goods, their destruction may be ordered by the court (Art. 69 PatA, Art. 57 TmPA, Art. 36 DesA) or, as a preliminary measure, the goods suspected of infringing IPRs may be seized (Art. 77 para. 1 let. c PatA, Art. 57 cum 59 TmPA, Art. 36 cum 38 DesA). In any case, the destruction of goods must be proportionate to the infringement and not be contrary to public policy or fundamental rights.

In cases in which the General Law regime liability conditions are met (see question 8), courts may order the OM to pay damages to the injured party (Art. 73 PatA, Art. 55 para. 2, Art. 35 para. 2 DesA).

Special Digital Law regime (if such a regime applies to OMs)

11) In your jurisdiction, what sanctions can be imposed on an OM when the conditions of its responsibility are met?

N/A

General Law regime (if this regime applies to OMs)

12) In your jurisdiction, what sanctions can be imposed on an OM when the conditions of its responsibility are met?

See above questions 1 and 10.

Other liability regime (if applicable to OMs)

13) In your jurisdiction, what are the sanctions that can be imposed on an OM when the conditions of its responsibility are met?

N/A

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

14) Could your Group's current law or practice relating to the responsibility of online marketplaces for online infringement of industrial property rights be improved? If YES, please explain.

Yes. The existing General Law and General IP Law regimes do not provide efficient, expeditious remedies to cease or prevent IPR infringements on OMs. While the current legal means are sufficient in substance, they are ill-adapted to the speed and ease of repeated uploading of potentially IPR infringing products on OM platforms. Therefore, the current legal mechanisms may appear unsatisfactory for IPR holders, who must initiate court proceedings to protect their IPRs and even injunctive reliefs can prove burdensome and costly.

Suitable measures to deal with IPR infringements on OMs should include notice and take down mechanisms, providing that OMs must respond promptly to notifications from IPR holders and remove or block the access to IPR infringing content. Such procedures must include the exact format of the notifications to be made by right holders and the deadlines for the OM to take infringing content offline. It is equally important that the procedure includes the steps and remedies if the (alleged) IPR infringer objects to blocking its profile or products.

Such a notice and takedown mechanism would respond adequately to the concerns of the IPR holders, who will dispose of a quick and easy means to notify and cease

infringements of their IPRs. Conversely, the OM's liability should be limited to the non-implementation or insufficient application of such a system on its platform. However, effective and efficient implementation requires that the procedures be the same regardless of the IPR concerned and that a certain degree of harmonisation be achieved on an international level.

Other measures that could be contemplated and further analysed could include, for instance:

- A notice and stay down mechanism, i.e. OMs that have become aware of infringing users could be required to take necessary measures against further infringing offers being posted in the future and to implement an automatic filtering mechanism for discerning offers that actually or potentially infringe IPRs upon becoming aware that infringing items are available on its platform. OMs could also be required to take necessary measures against the same user/seller resubmitting the same or a similarly infringing offer.
- OMs that actively support and promote offers should bear a more ongoing monitoring duty to avoid liability, or filtering mechanisms could be mandatory.

15) Could any of the following aspects of your Group's current law relating to responsibility of online marketplaces for online infringement of industrial property rights be improved? If YES, please explain.

a) The regime of responsibility applicable to OMs?

A clearly defined "safe harbor" principle, under which OMs which offer for sale goods provided by a third party are exempt from liability unless they are aware of the IPR infringement and are not acting adequately to stop it. Such a liability exemption should be accompanied by "duties of care" and "notice and take down" obligations to remove illegal online content. That being said, OMs should not be subject to a general obligation to monitor their third-party sellers' online content.

b) The implementation of the responsibility regimes applicable to OMs?

A specific notice and takedown process would likely increase predictability – hence legal security – and bolster the practical implementation of the legal protection afforded IPR holders.

A safe harbor system would help to define OMs' responsibility and give more predictability to the right holders. Such a safe harbor system could have specific requirements, such as a deadline to perform takedowns, etc. (see above question 14). Also, specific definitions deserve more attention, in particular, what exactly should be understood under the definition of an OM (given the hybrid nature or the multi-purpose functionality of many online platforms).

c) The sanctions that can be imposed to OMs

The existing civil reparations in the form of damages or disgorgement of profits are generally sufficient.

However, injunctive measures may not appear effective in all circumstances given that the amount of the sanctions for non-compliance with a cease-and-desist court order is low and thus, insufficiently dissuasive. Accordingly, increasing the amount of daily fines for non-compliance with injunctions could be appropriate to enhance the legal security.

16) 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?

Upon instruction of the Swiss Federal Council, the Federal Department of the Environment, Transport, Energy and Communications (DETEC) is in the process of preparing a draft bill on the regulation of large communication platforms (LCPs) such as Google, Facebook, YouTube and Twitter. The aim of the envisaged legislation is to strengthen the rights of users, including by achieving more transparency on the part of platforms, without limiting their positive influence on freedom of expression.

Although the topics (regulations of LCPs and of OMs) are not directly related, in particular, because the main concern related to LCPs is their influence on the public debate, whereas IPR infringements by OMs are purely of commercial relevance, there are similarities in the way the platforms function, in particular due to their global reach and to the opacity of the operations. The draft regulations currently envisage the following remedy for LCP users that could apply to sellers on OMs: access to a point of contact and the possibility to request a review of the blocking measure.

III. Proposals for harmonisation

Please consult with relevant in-house/industry members of your Group in responding to Part III

17) Do you believe that there should be harmonization in relation to the responsibility of online marketplaces for online infringement of industrial property rights?

If YES, please respond to the following questions without regard to your Group's current law or practice

Even if NO, please address the following questions to the extent your Group considers your Group's current law or practice could be improved.

Yes. Due to the cross-border nature of the internet and the activities of OMs, a certain degree of harmonisation in the liability rules and notice and take down mechanisms would prove essential.

A. Responsibility regimes applicable to OMs

The purpose of this part is to determine the responsibility regime(s) that should be applicable to OMs.

18) In case of IP rights infringement, should OMs be subject to:

a) the General IP Law regime,

A clearly defined “safe harbor” principle, under which OMs who offer for sale goods provided by a third party are exempt from liability unless they are aware of the IPR infringement and do not act adequately to stop it. Such a liability exemption should be accompanied by “duties of care” and “notice and take down” obligations to remove illegal online content. That being said, OMs should not be subject to a general obligation to monitor their third-party sellers’ online content.

Moreover, this safe harbor regime should apply equally to trademarks, patents, and designs (and would not necessarily need to be different from what certain jurisdictions provide regarding copyrights), thereby avoiding gaps in protection and enforcement.

b) a Special Digital Law regime, e.g. an exemption of responsibility (safe harbor),

At this stage, implementing a safe harbor appears possible and appropriate within the existing General IP Law regime; creating a Special Digital Law regime is not necessary.

c) the General Law regime,

From a systematic standpoint, it does not appear opportune to consider changes in the General Law regime that would be solely applicable to OMs.

d) an alternative/different responsibility regime.

N/A

19) If OMs should benefit from an exemption of responsibility/safe harbor, what should be the criteria for determining whether an OM should be subject to this regime (e.g. active or passive role of the OM, knowledge/control of the presentations of the products, awareness of the IP rights infringement, etc.)?

The OM’s awareness of IPR infringement should play a central role in the assessment. In other words, a central part of the analysis as to whether an OM may benefit from safe harbor protection (a “pre-condition” of sorts) should be the OM’s reaction upon awareness of (potential) IPR infringement. The safe harbor system should also include protections against any intentional “blindness” or improper organisation of the OM that would reduce the OM’s awareness of such IPR infringements.

B. The implementation of the OMs responsibility regimes

The purpose of this chapter is to determine the conditions that should be required for an OM to be held responsible for IP rights infringement or, on the contrary, to be exempted from responsibility.

The purpose is, for instance, to determine under what conditions an OM should be considered an IP infringer, co-infringer/

joint tortfeasor, accomplice, or contributory IP infringer (use of the IP on its own benefit, awareness of IP rights infringement, providing of specific services such as optimizing the presentation, promoting offers, etc.), and under what conditions an OM should benefit from an exemption of responsibility/safe harbor (acting expeditiously following awareness of IP rights infringement, etc.), etc.

To answer each question in this chapter, please deal separately with each of responsibility regime that should be applicable. If you consider it necessary, please treat each IPR (patent, trademark, design) separately.

General IP law regime (if this regime should be applicable to OMs)

20) Under what conditions should an OM be determined to be an IP infringer or, on the contrary, be exempted from responsibility for an IP rights infringement?

OMs should in principle not be held liable for IP infringement on their platform of which they have no knowledge; it being understood that the investment required for monitoring possible infringement is extremely burdensome and that such knowledge will occur as soon as the OM is informed by the IPR holder of an infringement. When made aware of an infringement, the OM should comply with the proposed take down process (see question 14). A notification by e-mail to the address listed by the OM on the website for this purpose or otherwise notification through a dedicated contact page on the OM’s website should be considered sufficient to prove that the OM has been informed of an infringement.

It could also be contemplated to hold an OM liable in the event it does not exclude from its platform a seller that has infringed IPRs on repeated occasions.

Accordingly, OMs should be exempted from liability if they comply with the safe harbor regime.

In specific cases, OMs should be held responsible for IP infringement even without having specific knowledge, for example, where the OM is specifically promoting an infringing product. This effectively means that OMs should have a duty to proactively monitor their promotional activities.

Special Digital Law regime (if this regime should be applicable to OMs)

21) Under what conditions an OM should be held responsible on this basis? What obligations should the OM fulfill be exempted from responsibility for an IP rights infringement?

N/A

General Law regime (if this regime should be applicable to OMs)

22) Under what conditions an OM should be held responsible on this basis? What obligations should the OM fulfill be exempted from responsibility for an IP rights infringement?

N/A

Other liability regime (if this regime should be applicable to OMs)

23) Under what conditions an OM should be held responsible on this basis? What obligations should the OM fulfill be exempted from responsibility for an IP rights infringement?

N/A

C. Sanctions that should be applicable to the OMs

The purpose of this part is to determine the sanctions that should be available against an OM whose responsibility is engaged (e.g. damages, injunction to delist a seller, obligation to inform/reimburse the buyers, obligation to prevent future sales of the infringing product, etc.).

General IP law regime (if this regime should be applicable to OMs)

24) What should be the sanctions that should be applicable to an OM when the conditions of its responsibility are met?

The sanction should be in the form of damages (where the OM would be jointly and severally liable with the principal infringer). In certain aggravated cases, OMs should have to delist the infringing sellers, be obliged to inform (e-mail sufficing) the buyers of infringing products (but not to reimburse), and have stay down obligations (see the response to question 14).

We believe the maximum sanctions for non-compliance with court injunctions could be higher.

Special Digital Law regime (if this regime should be applicable to OMs)

25) What should be the sanctions that should be applicable to an OM when the conditions of its responsibility are met?

N/A

General Law regime (if this regime should be applicable to OMs)

26) What should be the sanctions that should be applicable to an OM when the conditions of its responsibility are met?

N/A

Other liability regime (if this regime should be applicable to OMs)

27) What should be the sanctions that should be applicable to an OM when the conditions of its responsibility are met?

N/A

Other

28) Please comment on any additional issues concerning any aspect of the responsibility of online marketplaces for online infringement of Industrial Property Rights you consider relevant to this Study Question.

N/A

29) Please indicate which sectors' views provided by in-house counsel are included in your Group's answers to Part III.

In-house counsel are not included in our Group, however informal discussions on Part III have been conducted.

Zusammenfassung

Das Schweizer Recht enthält keine gesetzlichen Bestimmungen, die sich speziell mit der Frage der Haftung von Online-Marktplätzen (OMs) im Falle einer Verletzung von Rechten des geistigen Eigentums befassen, und es gelten die Regelungen des allgemeinen Rechts des geistigen Eigentums und des allgemeinen Rechts. Dementsprechend gibt es im Schweizer Recht keine gesetzliche Bestimmung, die es insbesondere OMs erlaubt, die zivilrechtliche Haftung im Falle von Schutzrechtsverletzungen zu vermeiden (d.h. keine gesetzliche Safe-Harbor-Bestimmung). OMs können als direkte Verletzer von Rechten des geistigen Eigentums angesehen werden, wenn sie in eigenem Namen rechtsverletzende Waren lagern und anbieten. Andernfalls, wenn OMs als E-Commerce-Websites fungieren (die Käufer und Verkäufer miteinander verbinden), können sie als Mittäter eingestuft werden. Ein Mittäter ist an der Rechtsverletzung beteiligt oder erleichtert sie, d.h. er ist entweder Komplize oder Verursacher.

In der Schweiz gibt es keine spezifischen Vorschriften oder Rechtsprechung, die die Umstände beschreiben, unter denen sich OMs der Verantwortung für eine Schutzrechtsverletzung entziehen können. Unter bestimmten Umständen und in Anwendung der allgemeinen Grundsätze des OR können OMs jedoch von der Haftung befreit werden. Eine solche Befreiung könnte insbesondere dann erfolgen, wenn die Voraussetzungen (i) Verschulden und (ii) Kausalität nicht erfüllt sind.

Unserer Meinung nach bieten die bestehenden Regelungen des allgemeinen Rechts und des allgemeinen Rechts des geistigen Eigentums keine effizienten, schnellen Rechtsmittel, um Verletzungen von Rechten des geistigen Eigentums auf OMs zu beenden oder zu verhindern. Die derzeitigen rechtlichen Mittel sind zwar inhaltlich ausreichend, aber sie sind nicht an die Geschwindigkeit und Leichtigkeit des wiederholten Hochladens von potenziell schutzrechtsverletzenden Produkten auf OM-Plattformen angepasst. Daher können die derzeitigen Rechtsmechanismen für die Inhaber von Rechten des geistigen Eigentums unbefriedigend sein, da sie zum Schutz ihrer Rechte des geistigen Eigentums Gerichtsverfahren einleiten müssen und selbst Unterlassungsklagen sich als mühsam und kostspielig erweisen können. Geeignete Massnahmen für den Umgang mit Verletzungen von Rechten des geistigen Eigentums auf OMs sollten z.B. einen Melde- und Rücknahmemechanismus umfassen, der vorsieht, dass OMs unverzüglich auf Meldungen von Inhabern von Rechten des geistigen Eigentums reagieren und die die Rechte des geistigen Eigentums verletzenden Inhalte entfernen oder den Zugang dazu sperren müssen.

Résumé

Le droit suisse ne contient pas de dispositions légales traitant spécifiquement de la question de la responsabilité des places de marché en ligne en cas d'atteinte aux droits de PI, et les régimes du droit général de la propriété intellectuelle et du droit général sont applicables. En conséquence, le droit suisse ne contient aucune disposition légale permettant spécifiquement aux marchés en ligne (OMs) de s'exonérer de toute responsabilité civile en cas d'atteinte aux droits de PI (DPI) d'un tiers (c'est-à-dire qu'il n'existe aucune disposition légale relative aux «safe harbour»). Les OMs peuvent être considérées comme des contrefacteurs directs de DPI lorsqu'elles stockent et proposent des marchandises contrefaites pour leur propre compte. Dans le cas contraire, lorsqu'elles agissent en tant que sites de commerce électronique (mettant en relation acheteurs et vendeurs), elles peuvent être considérées comme des co-contrefacteurs. Un co-contrefacteur participe à l'infraction ou la facilite, soit en tant que complice, soit en tant qu'instigateur.

En droit suisse, il n'existe pas de réglementation ou de jurisprudence spécifique décrivant les circonstances dans lesquelles les OMs peuvent se soustraire à la responsabilité d'une violation de DPI. Cependant, dans des circonstances spécifiques et en appliquant les principes généraux du Code des Obligations, les OMs peuvent être exonérées de responsabilité. Une telle exonération peut avoir lieu en particulier si les conditions (i) de faute et (ii) de causalité ne sont pas remplies.

À notre avis, les régimes actuels de droit général et de droit général de la propriété intellectuelle n'offrent pas de solutions efficaces et rapides pour faire cesser ou empêcher les atteintes aux DPI sur les OMs. Si les moyens juridiques actuels sont suffisants sur le fond, ils ne sont pas adaptés à la vitesse et à la facilité de téléchargement répété sur les OMs de produits susceptibles d'enfreindre les DPI. Par conséquent, les mécanismes juridiques actuels peuvent sembler insatisfaisants pour les détenteurs de DPI, qui doivent engager des procédures judiciaires pour protéger leurs DPI, et même les actions en cessation peuvent s'avérer lourdes et coûteuses. Des mesures appropriées pour traiter les violations de DPI sur les plateformes OMs devraient inclure, par exemple, des mécanismes de notification et de retrait, prévoyant que les OMs doivent répondre rapidement aux notifications des détenteurs de DPI et retirer ou bloquer l'accès au contenu enfreignant les DPI.