

Norway

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Norway: Patent Litigation

1. What is the forum for the conduct of patent litigation?

Oslo District Court is the mandatory first instance venue for patent litigation in Norway. The District Court is constituted with one legal judge. In addition, two technical expert judges are normally called for in patent cases. Each party may request expert judges, and the court may decide to call expert judges independently of any such request. There is no permanent group or list of expert judges from which the experts are appointed, and the court regularly asks the parties to come up with proposals. The appointment process is sometimes complicated and time consuming.

2. What is the typical timeline and form of first instance patent litigation proceedings?

Under Norwegian Law, a defendant that wishes to invoke invalidity as defence against an infringement claim, has to file a counterclaim for invalidation before the same court that handles the infringement case. Infringement and validity will then be handled in the same case, and the court will assess invalidity before it assesses infringement (infringement will only be assessed if the court concludes that the patent is valid). All issues of claim construction are considered together with validity and/or infringement and the assessment of validity and infringement shall be based on the same construction of the claims. Depending on the scope and complexity of the case, it typically takes between one year and one and a half year to obtain a first instance decision on infringement and/or validity.

3. Can interim and final decisions in patent cases be appealed?

A decision (both interim and final decisions) by the District Court may be appealed to the Court of Appeal. The appeal term is one month from the service of the appealed decision. Normally, no leave is required, but the Court of Appeal may refuse leave to appeal if it finds it clear that the appeal will not succeed. In patent cases leave is rarely refused. In ordinary proceedings, the appeal procedure is similar to the procedure before the District Court. In interim proceedings, the appeal will normally be decided in chambers, i.e. there will not be a

new oral hearing. A decision by the Court of Appeal may be appealed to the Supreme Court. The term of appeal is one month. Leave is required. If admitted to the Supreme Court the case is heard by five legal judges. It typically takes between one year and a one and half year (counted from the time when the first instance issued its decision) to obtain a decision from the Court of Appeal. The case handling time before the Supreme Court is however, much quicker. If leave is granted it typically takes approximately six to ten months counted from the date of the Court of Appeal's decision to obtain a decision from the Supreme Court. A decision from the first instance granting a preliminary injunction may be enforced immediately also if the first instance's decision is appealed. A decision on the merits issued in ordinary proceedings (i.e. not preliminary injunction proceedings) regarding infringement and/or validity only becomes effective and enforceable from the time the decision becomes final, i.e. from the time the term of appeal has expired without an appeal being filed or from the time the decision is upheld after an appeal.

4. Which acts constitute direct patent infringement?

Pursuant to section 3 of the Patents Act the following acts constitute direct patent infringement: a) manufacturing, offering for sale, putting on the market or using a product protected by the patent, or importing or possessing the product for such purposes; b) using or offering to use a process protected by the patent or, whilst knowing or being obvious under the circumstances, that the use of the process is prohibited without the patentee's consent, offering the product for use in the country; c) offering for sale, putting on the market or using a product made by a process protected by the patent, or importing or possessing the product for such purposes.

5. Do the concepts of indirect patent infringement or contributory infringement exist? If, so what are the elements of such forms of infringement?

The concepts of indirect patent infringement and contributory infringement exist under Norwegian Law.

Section 3, second paragraph, of the Patents Act governs indirect infringement. The provision forbids "offering or supplying" any person who is not entitled to exploit the invention in the country with the means for carrying out the invention, provided that the person supplying or offering the means knows, or it is obvious under the circumstances, that the means are suitable and intended for such exploitation. "Means" are typically materials or parts that enable the recipient to manufacture a patented product or exercise a patented method. The means must regard an "essential element of the invention". Section 3 makes an exception for staple commodities. The offering for sale or supplying of such commodities will only constitute infringement if the person offering or supplying attempts to induce the recipient to commit patent infringement.

As for contributory infringement, such as acts of aiding and abetting another's patent infringement, the patent proprietor may claim remuneration or compensation for damages from the contributor, provided that the contributor has acted intentionally or through negligence, cf. Section 58, third paragraph, of the Patents Act. The patent proprietor may also obtain an injunction against the contributor, prohibiting the contributor from repeating the action(s) constituting the contributory infringement, cf. Section 56a of the Patents Act.

6. How is the scope of protection of patent claims construed?

Pursuant to section 39 of the Patents Act, the extent of the protection conferred by a patent is determined by the patent claims. The description may serve as a guide to the understanding and interpretation of the patent claims. Norwegian Law provides for protection by equivalence. Following the Supreme Court's decision in the so-called Donepezil Decision from 2009, the conditions for protection by equivalence under Norwegian law, may be summarized as follows: First, the alleged infringing product or process must solve the same problem as the patented invention, second, the modifications made must have been obvious to a skilled person and third, the alleged infringing product or process must not belong to the prior art. With respect to the second condition it is not sufficient for determining infringement by equivalence that the modifications are obvious to the skilled person (based on the inventive step standard). According to the abovementioned Donepezil Decision, it is an additional requirement that the modifications are so close to the solution in the patent claim that it is fair to characterize the modification as "reasonably identical" to that solution.

Even though all of the abovementioned conditions are fulfilled, other circumstances may prevent the finding of infringement by equivalence. The prosecution history is the most important example of such circumstances that may exclude the finding of infringement by equivalence.

The prosecution history's relevance for both the interpretation of patent claims and the assessment related to determining the patent's scope of protection is undisputed under Norwegian patent law.

Furthermore, the prosecution history may generally have a greater impact on the assessment of infringement by equivalence than for direct infringement.

It is first and foremost the consideration of third parties that speaks in favour of emphasizing the prosecution history. As a general guideline, protection through the application of infringement by equivalence should be denied where the prosecution history gives a third party legitimate reason to assume that the intent was to waive protection for the disputed embodiment. If the applicant has previously limited the claims to stay clear of the state of art, this may give third parties the impression that the applicant has waived the embodiments which the limitation intended to exclude. Furthermore, if the applicant during prosecution expressly waived certain embodiments, he cannot reasonably claim that these should later be within the scope of protection through infringement by equivalence.

7. What are the key defences to patent infringement?

Invalidity: If sued for infringement, the normal reaction, which is adopted in almost every infringement case, is to file a counter claim for invalidation of the patent.

Research exemption: Experiments and research on the invention itself is exempted from the "patent holder's exclusive right. The exemption does not only regard "pure" research but also commercial research and development. Although there are some examples that the research exemption has been invoked as defence, this is quite uncommon. **License:** The defence of leave and license is not expressly dealt with in the Patents Act but is generally accepted as being a valid defence to an infringement claim. The defence can be based on both an express and implied license between the patent holder and the defendant. **Exhaustion:** The exhaustion defence is based on the patentee's exclusive right being exhausted for products put on the European Economic Area (EEA) market by the patentee, or which are brought onto the EEA market with the patentee's consent.

8. What are the key grounds of patent invalidity?

Lack of inventive step is still the most commonly applied ground for invalidation of patents in Norway. There are however examples from the recent years that invalidation has been based on insufficient disclosure and added matter. Lack of clarity of the claims may be a ground for refusing to grant a patent, but cannot be invoked as ground for invalidation after a patent has been granted.

9. How is prior art considered in the context of an invalidity action?

Everything that was available to the public anywhere in the world before the patent's priority or filing date, either in writing, in lectures, by exploitation or otherwise, constitute prior art. When assessing novelty, one may not combine prior art items, however this may be done in the assessment of inventive step.

Norwegian patent applications filed before the patent's priority date which were published on or after that date shall be considered as relevant prior art for the assessment of novelty, but not for the assessment of inventive step (obviousness).

10. Can a patentee seek to amend a patent that is in the midst of patent litigation?

A patentee is entitled to seek to amend a patent during a litigation. This can be done at any stage of the litigation, i.e. also in an appeal case. The patentee can seek to amend the patent by filing auxiliary claims in the court case, or by filing a request for administrative limitation to the Norwegian Industrial Property Office (NIPO).

When the patentee seeks to amend the patent during ongoing legal proceedings, the opposing party in the legal proceedings can submit any invalidity arguments against the amended claims.

When the patentee seeks to amend the claims by filing a request for administrative limitation to the NIPO, any third party can submit arguments against the lawfulness of the patentee's requested amendments. For the assessment of allowing a requested amendment, the NIPO will only assess added matter and whether the requested amendments do limit the scope of protection, as well as the requirements of clarity, sufficiency of disclosure and whether the new claims are supported by the description. Therefore, any third party arguments concerning novelty or inventive step will not be considered by the NIPO in their assessment of allowing the requested amendments

and must be submitted separately in relation to a request for an administrative review to the NIPO or in a legal court action in the time after the NIPO decides to allow the patentee's requested limitations.

11. Is some form of patent term extension available?

Patent term extensions for medicinal products are available under Norwegian Law. The codified Supplementary Protection Certificate (SPC) Regulation (469/2009(EC)) is incorporated in the Norwegian Patents Act and is applicable as Norwegian Law. This means that the total protection period for a medicinal product under a patent and an SPC may go up to 25 years and 6 months as a maximum (20 years under the patent and 5 years and 6 months under the SPC with the six months so-called paediatric extension of the SPC). A patent term extension for plant protection products is also available in Norway under the Regulation concerning the SPC for plant protection products (1610/96/EC) which is incorporated in the Norwegian Patents Act and is applicable as Norwegian Law. This means that the total protection period for a plant protection product under a patent and an SPC may go up to 25 years (20 years under the patent and 5 years under the SPC). The requirements for granting SPCs for medicinal products and plant protection products are the following (all of them must be fulfilled): a) the product must be protected by a patent that is in force; (b) a valid authorization to place the product on the market must have been granted; (c) the product must not already have been the subject of an SPC; and (d) the authorization referred to in (b) is the first authorization to place the product on the market. The duration of an SPC for medicinal products cannot exceed five and a half years and the duration of an SPC for plant protection products cannot exceed five years. The validity of SPCs can be challenged both on the grounds that the underlying patent is invalid and that the requirements for granting a SPC were not fulfilled. In September 2022, the Ministry of Justice proposed certain changes to the Patent Act concerning the implementation of regulation 2019/922, introducing an exception to the SPC protection for export to countries outside the EEA while the certificate is valid, and an exception for production and storage the last six months of the certificate's validity period with a view to sale in the EEA after the certificate expires. Since there is very limited pharmaceutical production in Norway, we expect the practical significance of these changes to be small.

12. How are technical matters considered in

patent litigation proceedings?

Evidence is subject to free assessment by the court. There is no restriction as to the kind of evidence, which may be documents, physical objects like models or infringing goods, witness statements and expert statements. The court may appoint experts either at the request of a party or on the court's own initiative if the court finds that such appointment is necessary to establish a sound factual basis for deciding the case. In patent cases, it is more common that the parties present their own experts as witnesses. A party may call witnesses to give expert testimony. An expert witness may attend the hearing throughout and may be allowed to ask questions to parties, witnesses and experts. Usually the expert witness presents a written report to the court. The expert witness will however have to present the main content of the report orally during the oral hearing and he or she will be subject to cross examination during the oral hearing. Although expert witnesses are instructed by a party, the expert witness is obliged to present his/hers sincere assessment and views to the court.

13. Is some form of discovery/disclosure and/or court-mandated evidence seizure/protection (e.g. saisie-contrefaçon) available, either before the commencement of or during patent litigation proceedings?

Pursuant to Norwegian Civil Procedural Law, evidence may to a certain extent be obtained and secured outside a lawsuit by judicial examination of parties and witnesses, and by providing access to and inspecting documents, including electronically stored material, and other real evidence. Norwegian law does not recognize the concept of discovery. However, all persons are obliged to make available as evidence objects, including documents, that are in their possession or of which they can obtain possession. The Norwegian Civil Procedural Act also contains provisions that correspond to Article 8 of Directive 2004/48/EC on the enforcement of intellectual property rights. Thus, when there are reasonable grounds to believe that an infringement of a patent has been committed, the court may at the request of the patentee rule that the infringer shall disclose information on the origin and distribution networks of the goods, including information about the name and address of manufacturers, distributors, suppliers and others who have had the goods in its possession, name and address of wholesalers and retailers, and information on production quantities and prices. Such information may also be required, inter alia, from those having contributed to the infringement or have been in possession of the

infringing goods.

14. Are there procedures available which would assist a patentee to determine infringement of a process patent?

Under Norwegian Civil Procedural Law, the burden of proof may be reversed under certain circumstances. With respect to infringement of a process patent, the burden of proof is normally reversed if the patent concerns a process for the manufacturing of a new product. Thus, in such cases the burden of proof will at the outset rest with the defendant (the alleged infringer) and it will be up to the defendant to prove the alleged infringing products are manufactured through a process that does not infringe.

15. Are there established mechanisms to protect confidential information required to be disclosed/exchanged in the course of patent litigation (e.g. confidentiality clubs)?

Under the Norwegian Civil Procedural Act, the court may order that information that is disclosed/exchanged during the course of a patent litigation shall be treated as confidential. This means that the parties and their representatives are legally bound to treat the information confidentially. The court may also decide that only a limited and predetermined circle of people representing a Party shall have access to the information.

16. Is there a system of post-grant opposition proceedings? If so, how does this system interact with the patent litigation system?

There is a system of post-grant opposition proceedings in Norway. Oppositions may be filed within nine months after the grant of the patent. Invalidation actions before the courts can be filed once a patent is granted. It is possible to file an opposition and initiate an invalidation action before the courts simultaneously. It will then be for the NIPO and the court to decide whether the handling of the opposition or the court case should be stayed to await the decision from the other body. Normally the court will not stay a court case awaiting the outcome of an opposition. There is also a procedure for administrative review in Norway, where anyone may request the NIPO to declare a patent invalid through an administrative review. A request for an administrative review cannot be filed before the time limit for oppositions has expired or while an opposition procedure or patent limitation proceedings are pending before the

NIPO. Requests for administrative review can be filed until the patent expires and also after expiry if the party requesting an administrative review has a legal interest in having the issue reviewed after the expiry, e.g. if the party has been accused of infringement while the patent was in force. A request for an administrative review can, however, not be filed if and for as long as legal proceedings regarding the patent are pending before the courts. If court proceedings are initiated before the NIPO has made a final decision on a request for an administrative review, the NIPO shall suspend its handling of the administrative review until the legal proceedings have been finally decided unless the request for administrative review was made by the patentee. Further, a party that has requested administrative review cannot initiate legal proceedings regarding the patent while administrative review proceedings are pending before the NIPO.

17. To what extent are decisions from other fora/jurisdictions relevant or influential, and if so, are there any particularly influential fora/jurisdictions?

Case law from the EPO is regarded as highly relevant and influential for the interpretation of the Norwegian Patents Act. Decisions from the higher courts of other European countries, especially Denmark, Sweden, Germany, the Netherlands and the UK, are considered relevant and influential for the interpretation of the Norwegian Patent Act as well. Decisions from other jurisdictions regarding foreign equivalents of the patent in suit may also be regarded relevant and influential for the specific assessment. This applies in particular to decisions from other European Countries and especially from Denmark, Sweden, Germany, Netherlands and the UK.

18. How does a court determine whether it has jurisdiction to hear a patent action?

Norwegian courts do not have jurisdiction to assess the validity of foreign patents and will dismiss a case or a claim concerning the validity of a foreign patent. Norwegian courts may assess questions of infringement of foreign patents provided that the alleged infringer may be sued in Norway, i.e. is domiciled in Norway. However, foreign companies cannot be sued in Norway for actions carried out outside Norway. It is therefore difficult to envisage a practical situation where a Norwegian court can assess whether a foreign patent has been infringed.

19. What are the options for alternative dispute resolution (ADR) in patent cases? Are they commonly used? Are there any mandatory ADR provisions in patent cases?

ADR is never used in patent disputes relating to infringement and invalidity. There are no mandatory ADR provisions in patent cases. An infringement dispute may be settled by arbitration. This is however not possible for a dispute regarding the validity of a patent. Since invalidity often is used as defence against infringement, arbitration is not a practical option in infringement disputes.

20. What are the key procedural steps that must be satisfied before a patent action can be commenced? Are there any limitation periods for commencing an action?

The procedure is governed by the Norwegian Civil Procedural Act. Before bringing an action, the plaintiff must notify the defendant of his intention to bring an action, and inform him/her of the claim(s) and the grounds for the claim(s). Failure to notify may impact the court's decision on legal costs, but cannot lead to dismissal of the case. Claims for damages or compensation arising from patent infringement are normally subject to a limitation period of three years counted from the date on which the party obtained, or reasonably ought to have obtained, necessary knowledge of the damage and the responsible party. The limitation period may be longer under certain circumstances, but will in any case lapse twenty years after the grounds for liability ceased. A patent infringement claim, e.g. a claim for an injunction, may not in itself be time barred. A claim for invalidation of a patent may be filed any time during the period the patent is in force.

21. Which parties have standing to bring a patent infringement action? Under which circumstances will a patent licensee have standing to bring an action?

Patentee: Patent infringement proceedings may be brought by the patentee. Exclusive license: If the licensee has been granted an exclusive license, the licensee may initiate legal proceedings and claim compensation (damages, etc.) for the loss incurred as a result of the infringement. Exclusive licensees may also normally claim preliminary and ordinary injunction. Non-exclusive license: If, on the contrary, the licensee has not been granted an exclusive license, the licensee cannot claim an

injunction, but may sue for damages.

22. Who has standing to bring an invalidity action against a patent? Is any particular connection to the patentee or patent required?

Pursuant to section 52 of the Patents Act, anyone may bring legal proceedings in order to invalidate a granted patent.

23. Are interim injunctions available in patent litigation proceedings?

Interim (preliminary) injunctions are available in patent litigation proceedings. It is possible to request that a preliminary injunction is granted without the defendant being heard. However, this is seldom granted in patent cases. Preliminary injunction proceedings in patent cases will as a general rule be conducted as inter partes proceedings – either as separate proceedings or as a part of ordinary proceedings on the merits. In order to obtain an injunction, the petitioner must substantiate the claim and the urgency of the matter. In patent cases, the fact that there is an ongoing infringement of the patent normally makes the matter sufficiently urgent and therefore provides sufficient basis for obtaining a preliminary injunction. The court shall reject a petition for a preliminary injunction if the loss or inconvenience to the defendant is clearly disproportionate to the interests of the claimant in the interim measure being granted. However, in patent cases preliminary injunctions are very rarely rejected on this basis. In patent cases, the main remedy is normally a prohibition against further use or sales of the infringing goods or process. The court may make the preliminary injunction conditioned on financial security from the petitioner. This is quite normal. If a preliminary injunction is reversed through appeal or in subsequent ordinary proceedings, the petitioner has a strict liability for damages caused to the other party as a consequence of the injunction.

24. What final remedies, both monetary and non-monetary, are available for patent infringement? Of these, which are most commonly sought and which are typically ordered?

Non-monetary remedies: Injunctions are the most commonly sought and typically ordered non-monetary remedy. If it is substantiated that infringement has occurred, the right holder is as the dominating rule entitled to get an injunction prohibiting the continuation of the Infringement. Further, injunctions may be granted

intended to prevent any imminent infringement of a patent. The court cannot reject to grant a final injunction based on a proportionality assessment. Under very strict conditions the court may however, in special circumstances, decide that the infringer should pay a reasonable license fee (royalty) instead of issuing a final injunction. The court may, on the patentee's request, and as to prevent further infringement, decide on remedies such as amendment, seizure, destruction of the infringing goods, etc. The court may also order that information about the judgment shall be communicated in a suitable manner for the infringer's account.

Monetary remedies: In cases of intentional or negligent infringement the patentee is entitled to a compensation determined on the most favourable of the following grounds: 1. compensation corresponding to a reasonable license fee for the exploitation, as well as damages for any loss resulting from the infringement that would not have arisen in connection with licensing; 2. damages for any loss resulting from the infringement; or 3. compensation corresponding to the gain obtained through the infringement. If the infringement has been committed intentionally or through gross negligence, the patent holder is entitled to claim compensation on the basis of a fourth option, that is compensation corresponding to double a reasonable license fee for the exploitation. For infringements that have taken place in good faith, the infringer shall, insofar as this is not seen as unreasonable, pay compensation corresponding to a reasonable licence fee for the exploitation or corresponding to the gain procured as a result of the infringement.

25. On what basis are damages for patent infringement calculated? Is it possible to obtain additional or exemplary damages? Can the successful party elect between different monetary remedies?

See answer to previous question.

26. How readily are final injunctions granted in patent litigation proceedings?

See answer to question 24 above.

27. Are there provisions for obtaining declaratory relief, and if so, what are the legal and procedural requirements for obtaining such relief?

Declaratory relief is available under the Norwegian Civil

Procedural Act. Both declarations of infringement and non-infringement are available provided that the plaintiff can substantiate an actual and real need to obtain such a declaration. That will e.g. be the case if the party that is initiating an action for a declaratory relief has been accused of patent infringement or if someone has informed the patentee that an infringing activity will be initiated.

28. What are the costs typically incurred by each party to patent litigation proceedings at first instance? What are the typical costs of an appeal at each appellate level?

Proceedings (Infringement) first instance: Normally EUR 200,000 –EUR 400,000. Proceedings (Invalidity) first instance: Normally EUR 200,000 –EUR 400,000. Proceedings (Infringement and Invalidity) first instance: Normally EUR 400,000 –EUR 1000,000. The costs will normally be the same before the Court of Appeal as before the first instance in ordinary infringement and invalidity actions. Preliminary injunction proceedings first instance: Normally EUR 100,000–EUR 200,000. In preliminary injunction proceedings the costs will normally be lower before the Court of Appeal than before the first instance. Before the Supreme Court the costs will normally be significantly lower than before the lower courts both in ordinary proceedings and preliminary injunction proceedings.

29. Can the successful party to a patent litigation action recover its costs?

The party regarded as having won the case in its "entirety" or "in its essentials", is entitled to compensation for legal costs from the losing party. Legal costs include "all necessary costs relating to the case", such as expenses for legal counsel, travel costs, expert's fees etc.

30. What are the biggest patent litigation growth areas in your jurisdiction in terms of industry sector?

The primary areas of growth for patent litigation in Norway is technology within the life sciences industry, particularly biologics and biosimilars, as well as technology within the oil services industry.

31. How has or will the Unified Patent Court impact patent litigation in your jurisdiction?

As a non-member state, the UPC Agreement does not apply in Norway. Nevertheless, it is very likely that the case law of the Unified Patent Court will have influence and impact on patent litigation in Norway. Legal action can be initiated by Norwegian entities holding European patents with unitary effect with the Unified Patent Court and against Norwegian entities on the basis of their infringement of such European patents.

32. What do you predict will be the most contentious patent litigation issues in your jurisdiction over the next twelve months?

The most contentious patent litigation issues do not vary a lot over time. Claim construction are always among the most contentious patent litigation issues both in infringement and validity cases.

33. Which aspects of patent litigation, either substantive or procedural, are most in need of reform in your jurisdiction?

The Norwegian Patent Litigation regime is fairly up to date and well-functioning and we consider that there are no pressing needs for reforms to the system.

34. What are the biggest challenges and opportunities confronting the international patent system?

The complexity of the system and the costs, resources and time it takes to obtain patent protection and to litigate patent disputes in several jurisdictions are the biggest challenges to the system in our view.

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