

Zacco

# Norway

**Trademark owners seeking to enforce their rights in Norway should typically start civil proceedings. However, mark owners should also consider applying for customs surveillance and should make use of alternative resolution bodies for solving unfair competition and domain name disputes**

## Civil proceedings

Private civil enforcement of trademarks normally starts with cease and desist letters. Most cases are settled out of court. If the defendant is not willing to cease infringing the trademark and desist from future infringement, the mark owner may institute legal proceedings. To stop ongoing infringements and to secure evidence, the mark owner may also request preliminary measures, such as interim and *ex parte* injunctions, and civil search orders.

Ordinary legal proceedings are initiated by a writ of summons from the mark owner. The defendant must file its defence in writing within 21 days of service of the writ of summons. The main hearing will normally be held within six to nine months and will typically last one to three days. A judgment can normally be expected between 14 days and one month after the main hearing has been held.

The mark owner may obtain a permanent injunction, which typically orders the defendant to cease and desist from the infringing activities. In addition, the infringer may be ordered to recall infringing products from the channels of trade. Damages and other monetary remedies are available. The general rule is that the monetary remedy for infringement is an amount corresponding to reasonable compensation for use of the trademark (normally, a sum corresponding to a hypothetical licence fee for its use). The mark owner may also claim compensation for further damages. Such claims will be sustained only against proof of actual damage.

The cost of litigation will depend on the complexity of the case. The total costs of ordinary court proceedings at first instance normally amount to between approximately Nkr50,000 and

Nkr250,000. The losing party bears the other party's costs.

## Court mediation

Court mediation is available for all matters under Chapter 8 of the Civil Procedure Act, including trademark disputes. Court mediation is usually handled by a judge from the court before which the case is brought. If the mediation does not lead to a settlement, the case will be transferred to a judge who was not involved in the mediation. The mediator must keep all information presented during the mediation confidential, including from the judge who will take over the case. Most cases brought to court mediation are settled.

Court mediation is normally carried out at an early stage of the proceedings, usually after the filing of the defence pleadings. Court mediation offers a faster and cheaper resolution than a judgment. Moreover, court mediation takes place in chambers (ie, behind closed doors). Thus, the parties involved may avoid the publicity that an ordinary trial may attract.

## Preliminary injunction

Preliminary relief in the form of a preliminary injunction is available by filing a motion with the competent district court. A preliminary injunction may be granted in Norway to a party that has a legal claim, other than for monetary payment, provided that:

- the defendant's behaviour would make the prosecution or implementation of the claim at a later stage substantially more difficult; or
- the preliminary injunction is needed to prevent substantial damage or disadvantage from occurring, or to prevent violent actions that one may fear because of the defendant's behaviour.

An injunction will be granted at the court's discretion. In addition to the requirements mentioned above, the court will also consider the balance of interest – that is, whether the loss caused by, or inconvenience of, an injunction to the defendant is not obviously disproportionate to the mark owner's interest in such

injunction. When a court grants an injunction, it normally orders the mark owner to post a security to make up for any possible loss suffered by the defendant.

A preliminary injunction will normally be granted following oral hearings and the exchange of written pleadings. However, an *ex parte* injunction may be granted if there is a risk related to delay or notification. If the court decides to grant a preliminary injunction without oral hearings, the parties can request subsequent oral hearings.

The mark owner should start main proceedings to have the preliminary injunction confirmed as binding. This does not put a duty upon the mark owner to initiate such proceedings. However, the court may in the ruling granting a preliminary injunction set a time limit for the mark owner to initiate full proceedings. In such circumstances, the preliminary injunction will lapse if the mark owner does not commence full proceedings before the expiry of the time limit.

## Criminal proceedings

The Trademark Act provides for criminal sanctions for trademark infringement. Such proceedings are available for wilful infringement or contributing to such infringement. The sanctions are fines and/or imprisonment for a maximum of three months. Public prosecution is conditional upon the filing of a complaint by the injured party and a finding that prosecution is in the public interest. In practice, criminal prosecution is rare since such cases are not a priority for the police. Very few cases are in fact prosecuted.

## Alternative dispute resolution

Alternative dispute resolution bodies provide a cost-effective and rapid way to resolve disputes. Under the Marketing Act the Committee for the Control of Unfair Competition can issue advisory decisions in unfair competition matters, such as those involving the imitation of trademarks. The proceedings are conducted in writing only.

Unless the parties agree to the committee complaint proceedings to function also as a voluntary arbitration, the committee's decision will not be legally

binding. However, as it is likely that any committee decision would be upheld by the courts, the defendants normally adhere to the committee's decisions. The fee for filing a complaint with the committee is Nkr10,000. The committee usually issues a decision within two to three months.

The forum to bring complaints concerning '.no' country-code top-level domain names is the '.no' complaint board, Norid. Complaints must be lodged with Norid within three years of the domain name registration. Of the 146 complaints filed since the launch of the '.no' dispute resolution policy in October 2003, 99 were in favour of the complainant and 20 against the complainant, 21 cases were rejected and six were solved by arbitration.

The fee for submitting a complaint to the domain complaints board is four times the court fee (Nkr3,440). A decision from the complaint board is usually handed down within two to three months.

#### Customs surveillance

As a signatory to the Agreement on Trade-Related Aspects of Intellectual Property Rights, Norway has a duty to offer border surveillance. This applies to all IP rights and is not limited to the most commonly counterfeited items. A court may, pursuant to the Civil Procedure Act, issue an interlocutory injunction for Customs to seize infringing goods that are being either exported or imported. The injunction must provide some evidence to support the suspicion of infringement and list the rights that are to be kept under surveillance. However, it does not have to list specific infringing goods or shipments. The injunction is granted against the owner of the infringing goods, even though its identity is as yet unknown, so that the application is handled quickly and without any oral hearing. Injunctions are valid for at least one year and are published on the customs authorities' website at <http://www.toll.no/upload/090323%20oversikt%20midlertidige>, supposedly as a preventive measure. When goods are seized on the basis of such injunctions, they are detained for three months to give the rights holder sufficient time either to solve the matter amicably or to file a lawsuit. At the time of writing, there were 51 such ongoing injunctions in Norway.

Since September 1 2007, the competence of the customs authorities to seize infringing goods has been extended to include conducting *ex officio* actions. In addition, they are no longer constrained by secrecy requirements regarding information



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that can be passed on to rights holders. The detention period is noticeably shorter than that allowed under an interlocutory injunction (ie, five days from the formal notification until voluntary destruction or a short-term interlocutory injunction for further detention of the goods).

Mark owners can inform Customs about any importer, exporter or producer of counterfeits they are aware of by submitting a form. No fee is payable on submission of the form. However, the fact that the form is available solely in Norwegian and requires very detailed and specific information to enable Customs to act mean that, at the time of writing, only one such form has so far been accepted by Customs.

Due to the limited resources allocated to anti-counterfeiting measures, Customs tends to give priority to rights holders that have obtained interlocutory injunctions.

The Supreme Court has not yet determined the volume of goods required to constitute trade in counterfeit goods on a commercial scale. In a 2007 decision a district court accepted that as many as 35 Louis Vuitton-branded purses had been bought as Christmas presents for female relatives (ie, for private use). [WTR](#)