

World Intellectual Property Organisation  
**Fifteenth Session**



Advisory Committee on Enforcement  
Geneva

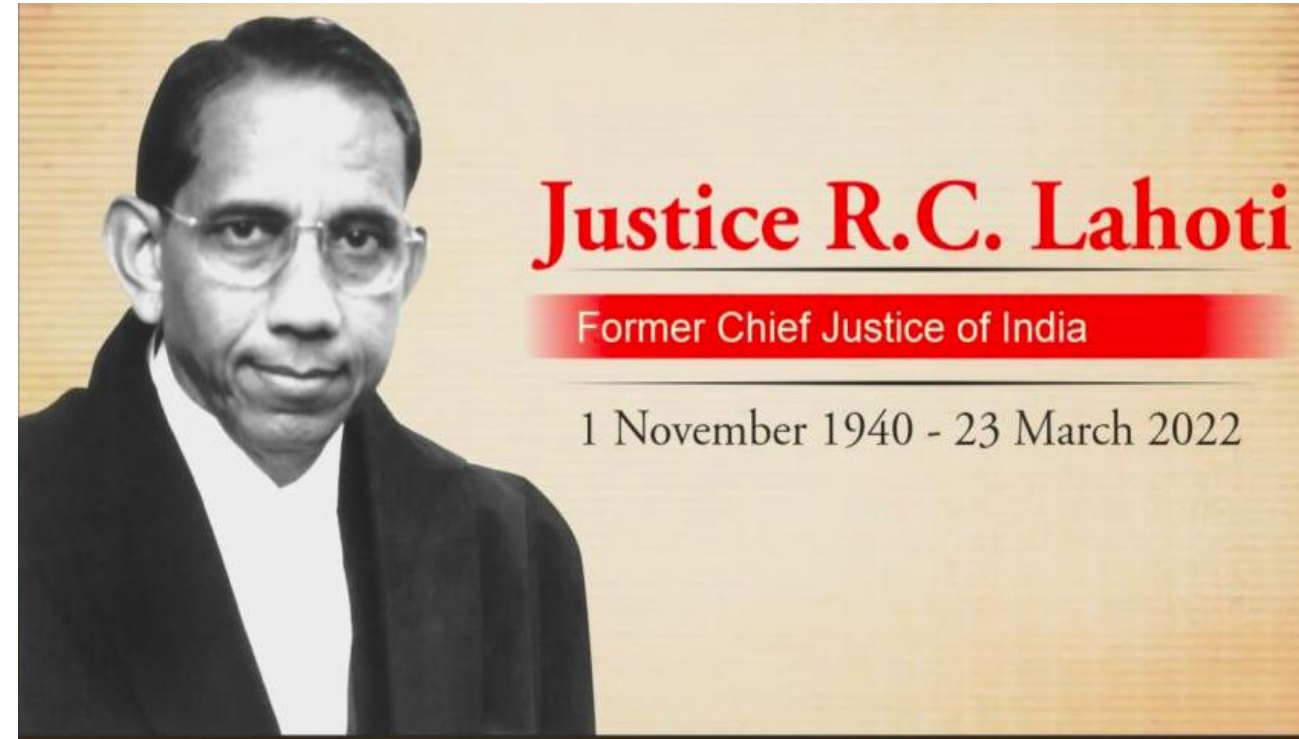
31<sup>st</sup> August – 2<sup>nd</sup> September, 2022

*Adjudication of Intellectual Property Infringement Cases -  
Dynamic Injunctions and other Injunctive Reliefs in India*

PRATHIBA M. SINGH  
Judge, Delhi High Court

*Lakshmikant V. Patel v. Chetanbhai Shah & Anr (2002)*

*“A refusal to grant an injunction in spite of availability of facts, which are prima facie established by overwhelming evidence and material on record, occasions a failure of justice, and such injury to the Plaintiff would not be capable of being undone”*



# TYPES OF INJUNCTIONS

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INDIA HAS RECOGNISED RIGHTS OF IPR OWNERS AS PER LAW

Types of injunctions:

- ❖ Ex-parte Injunction
- ❖ Interim Injunction
- ❖ Permanent Injunction





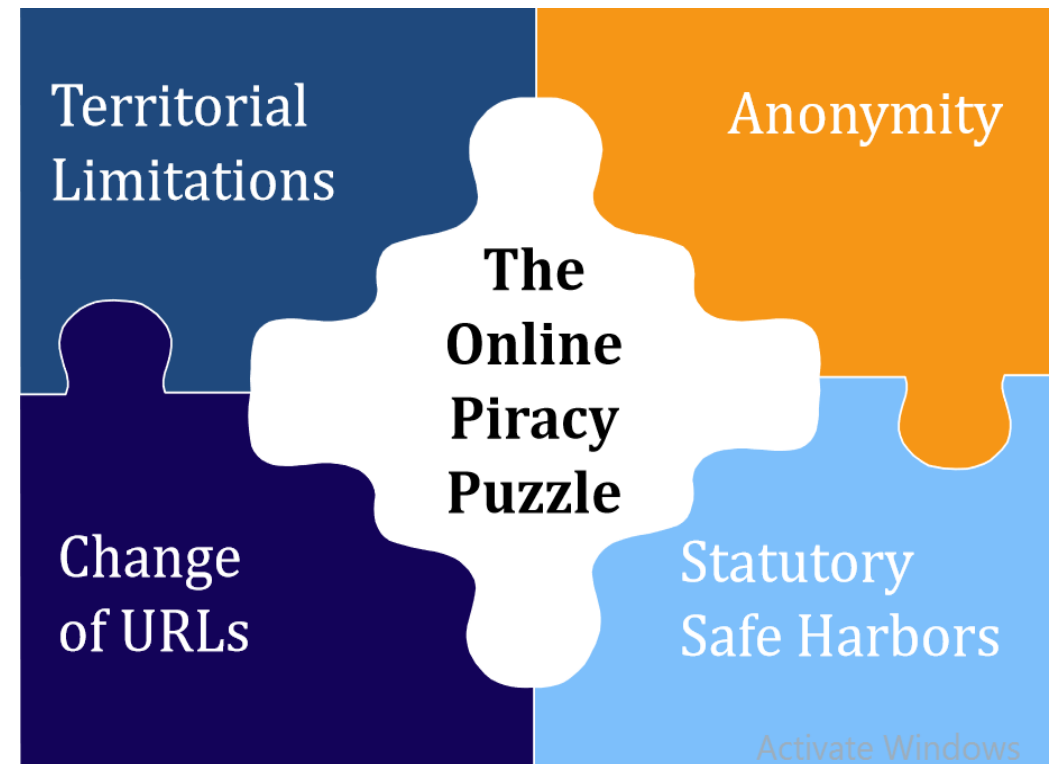
# CLASSES OF INJUNCTIONS

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- ❖ Anton-Piller Order: - Search & Seizure order. In *Anton Piller KG v. Manufacturing Process Ltd.*
- ❖ Mareva Injunction: - Order restraining moving of assets including bank accounts. In *Mareva Compania Naviera SA v. International Bulkcarriers*
- ❖ Norwich Pharmacal Order: - Order of disclosure against third parties. In *Norwich Pharmacal Co. v. Customs and Excise Commissioner*
- ❖ John Doe Order or Ashok Kumar Order - such injunctions are *ex-parte* in nature, and issued against unidentified defendants

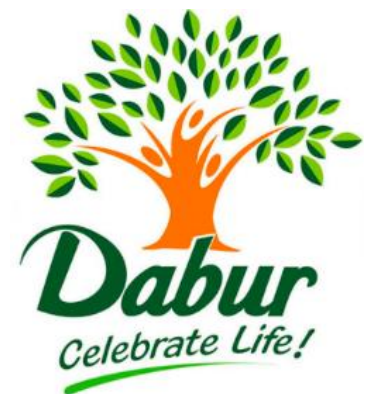
# NEW CHALLENGES POSED BY THE INTERNET

- ❖ Domain names and misuse of trademarks as part of domain names.
- ❖ Remedy - granting injunctions that were enforceable on the registrars and registrants, based largely on the provisions of the UDRP.
- ❖ With the introduction of social media platforms, e-commerce sites, online directories and other websites, the nature of IP violations multiplied.
- ❖ Courts had to grapple with the challenges that the Internet posed for passing effective orders and even in the implementation of such orders.



# CHALLENGES POSED BY THE INTERNET: DYNAMIC INJUNCTIONS IN INDIA

- ❖ Proliferation of websites which were primarily streaming infringing content.
- ❖ Initially, Courts would grant orders blocking the infringing content with reference to the specific URLs.
- ❖ Although specific URLs were being blocked, due to technological capabilities, the same content could easily be moved to a new URL in a matter of seconds.
- ❖ Led to IP owners seeking more coercive remedies, such as blocking of entire websites.



# *UTV Software Communications Ltd. v. 1337x.to*

*[CS(COMM) 724/2017, decided on 10<sup>th</sup> April, 2019]*

- ❖ Plaintiffs were companies that created content and produced and distributed cinematographic films.
- ❖ Injunction sought against unauthorized communication of original content/cinematographic films.
- ❖ Defendant websites held to be “rogue websites”. ISPs were also directed to block access to the Defendants’ websites.

# *UTV Software Communications Ltd. v. 1337x.to*

*[CS(COMM) 724/2017, decided on 10<sup>th</sup> April, 2019]*

- ❖ An infringer on the internet is not to be treated differently from an infringer in the physical world
- ❖ Putting limits on illegal content online does not violate the principles of ‘Open internet’
- ❖ The test for determining a ‘rogue website’ is a qualitative one
- ❖ India will need to work with Intermediaries as most sites are located abroad



# *UTV Software Communications Ltd. v. 1337x.to*

*[CS(COMM) 724/2017, decided on 10<sup>th</sup> April, 2019]*

- ❖ Apply the principle of proportionality
- ❖ Blocking websites may be antithetical to an open internet but may be sometime essential to curb illegalities
- ❖ Alternate measures if available to be considered
- ❖ Court cannot continuously monitor. Whenever new websites come up, file for impleadment.
- ❖ Power delegated to the Joint Registrar. ISPs can be directed to block if the websites are /mirror/redirects/alphanumeric variants

***UTV Software Communications Ltd. v. 1337x.to***  
*[CS(COMM) 724/2017, decided on 10<sup>th</sup> April, 2019]*

“This Court is of the view that to ask the plaintiffs to identify individual infringing URLs would not be proportionate or practicable as it would require the plaintiffs to expend considerable effort and cost in notifying long lists of URLs to ISPs on a daily basis”



# HOW TO DETERMINE WHETHER A WEBSITE IS 'ROGUE'

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- ❖ whether the website primarily contains illegal or infringing content;
- ❖ whether the website hides the details of the registrant;
- ❖ whether the website refuses to implement take-down orders;
- ❖ whether the identification of URLs would be burdensome to the plaintiff;
- ❖ whether the website facilitates infringement in any manner by providing details of other infringing websites, directories, etc.;



# HOW TO DETERMINE WHETHER A WEBSITE IS 'ROGUE'

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- ❖ whether the website, or the operator of the online platform, demonstrates negligence or disregard toward copyright, or infringement laws. This can become apparent upon assessing the content available on the said websites or platforms;
- ❖ whether the same website has been repeatedly subjected to court orders due to infringing content being found;
- ❖ whether the website promotes anti-circumvention measures;
- ❖ the volume of traffic or frequency of access to the website; and
- ❖ the flagrancy of the infringement.

# EXTENSION OF DYNAMIC INJUNCTIONS

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- ❖ Post Pandemic era - Dynamic injunctions are now well recognized since 2019,
- ❖ As a further extension of dynamic injunctions, recent litigations have shown that newer forms of injunctions and other forms of relief are required to be passed in other circumstances as well.



*Snapdeal Private Limited v. Snapdeallucky-draws.org.in*  
*[CS (COMM) No. 264/2020, decided on 20th July, 2020]*

- ❖ A website (snapdeallucky-draws.org.in, among others), was running a fraudulent price scheme, lottery or a lucky draw.
- ❖ Fifty rogue websites using a well-known trademark (snapdeal) as part of their domain name were enjoined by the Court.



*Snapdeal Private Limited v. GoDaddy LLC & Ors*  
*[CS (COMM) No. 176/2021, decided on 18<sup>th</sup> April, 2022]*

- ❖ *Injunction confirmed against all identified domain names.*
- ❖ *Injunction against unidentified domain names rejected.*

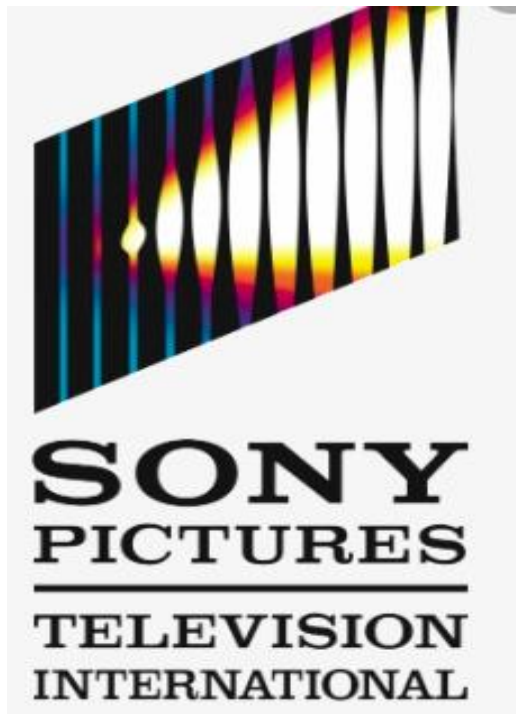


*Sony Pictures Network India Pvt. Ltd. v. [www.b1.mylivecricket.biz](http://www.b1.mylivecricket.biz)  
& Ors. (2020)  
[CS (COMM) 519/2020]*

- ❖ Sony Pictures Network was granted the exclusive license to broadcast the India-Australia Cricket Series in India.
- ❖ The Plaintiff apprehended that its exclusive media rights were likely to be violated by rogue websites which were arrayed as Defendants in the matter.
- ❖ The rogue websites were restrained by the Court from broadcasting, through any means, the footage concerning the matches to be played in the Cricket Series.



*Sony Pictures Network India Pvt. Ltd. v. [www.b1.mylivecricket.biz](http://www.b1.mylivecricket.biz) &  
Ors. (2020)  
[CS (COMM) 519/2020]*



*“Liberty is also given to the Plaintiff to approach this Court in case other rogue websites crop up which are not covered by this instant suit”*

*Living Media Limited & Anr v. News-aajtak.co.in & Ors.*

*[CS(COMM) 395/2020 decided on September 6, 2021]*

- ❖ A well-known mark used by a media company and its variants and derivatives were also protected against misuse by unknown URLs, websites, domain names and web platforms.
- ❖ The plaintiff in this case was allowed to provide a list of all such platforms to Google so that access could be disabled.

*Living Media Limited & Anr v. News-aajtak.co.in & Ors.*

*[CS(COMM) 395/2020 decided on September 6, 2021]*

*“There are various rogue websites which keep emerging resulting in disruption of business and legal interests of the plaintiffs and, therefore, leave be given to the plaintiffs to approach the Court, with an appropriate application, seeking similar orders against such websites”*



*Dabur India Limited v. Ashok Kumar & Ors [CS(COMM) 135/2022]*

- ❖ Rogue websites with domain names consisting of the mark DABUR.
- ❖ Public being duped by portraying themselves to be the Plaintiff
- ❖ Franchisees and distributors to register themselves for being appointed as agents for selling Dabur products.
- ❖ The names of the parties who had registered the domain names were not clear as the Registrars had allowed the Registrants to avail of privacy protect services.
- ❖ The Court held that the mark 'Dabur' is a well known mark and prima facie case for the grant of ex parte injunction was made out.
- ❖ The Court took notice of the rampant practice of hiding or masking the details by Registrants who impinge upon the rights of owners of trade marks.

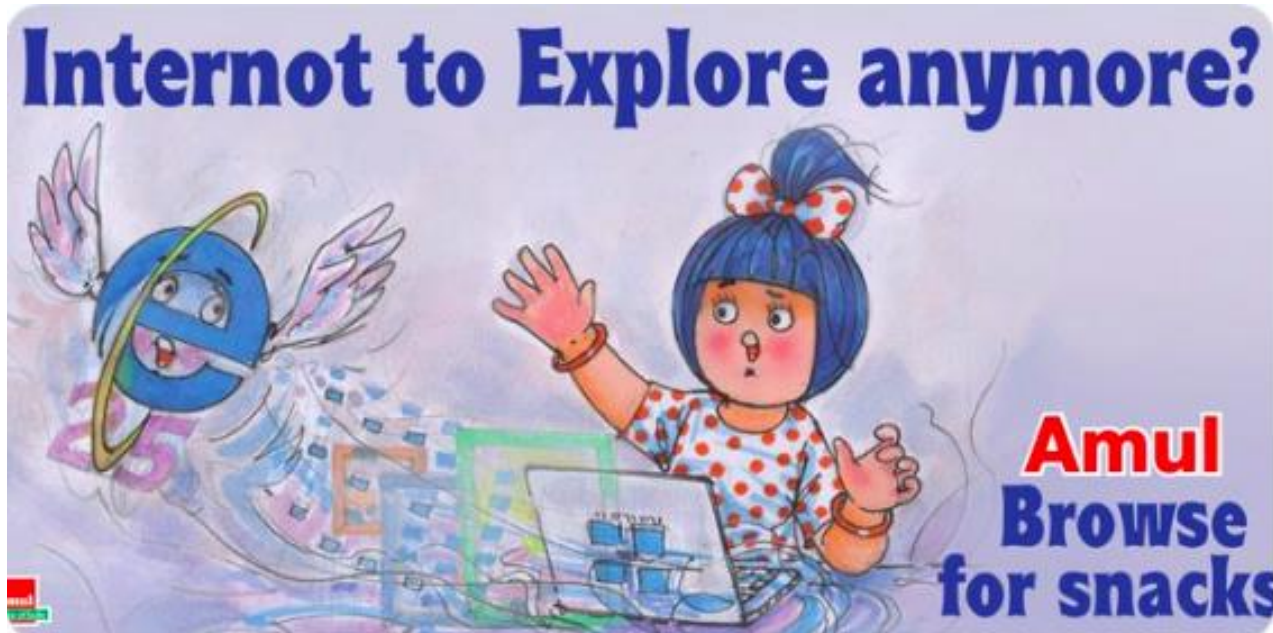
*Dabur India Limited v. Ashok Kumar & Ors*

*[CS(COMM) 135/2022]*

*“The internet era has brought various challenges to IP owners and this case is a reflection of the same. The legal rights of the Plaintiff are severely affected. Apart from the rights of the Plaintiff, it would also not be in public interest to permit these domain names to operate, so as to cheat the general public in India”*



# *Gujarat Cooperative Milk Marketing Federation Ltd. v. Amul-Franchise.in & Ors.[CS (COMM) 350/2020]*



- ❖ In order to ensure that gullible customers are not duped into paying monies to these websites who were using the names of well-known companies (such as Dabur and Amul), registration of domain names with the said mark was itself prohibited by the Court.
- ❖ This is, however, being challenged and the matter is currently *sub judice*

*HT Media & Anr v. Hindustantimes.tech & Anr*

*[CS(COMM)352/2022]*

- ❖ The masking of registrant's details under the privacy protection feature was called into question.
- ❖ The Government had been asked to file an affidavit to disclose its stand and also to whether the Registrars offering their services in India could be brought under some process by which they are asked to disclose the names of the registrants of illegally registered domain names which contain well-known trademarks.
- ❖ The petition was filed against hindustantimes.tech which was offering services identical to the ones offered by HT Media and HT Digital Streams through online and publishing services.
- ❖ Ordered blocking of the domain name 'www.hindustantimes.tech' by the internet service providers and the domain name registrar of the website

*HT Media & Anr v.  
Hindustantimes.tech & Anr*

*[CS(COMM)352/2022]*

*“The manner in which ‘WHOIS’ details of the registrant of the website ‘www.hindustantimes.tech’ are completely masked shows that Defendant No.1 has taken enormous pain to not reveal its identity”*





# *Warner Brothers Entertainment v. http.otorrents.com & Ors. [CS(COMM)367/2019]*



- ❖ Permanent injunction against rogue torrent websites that were distributing, broadcasting and transmitting the content belonging to Warner Brothers.
- ❖ *“The plaintiff is also permitted to implead any mirror/redirect/alphanumeric websites which provide access to the defendants websites by filing an appropriate application, supported by affidavits and evidence as directed in UTV Software. Any website impleaded as a result of such application will be subject to the same decree.”*

# A WORD OF CAUTION BY THE COURTS





*Versus*



## A WORD OF CAUTION BY THE COURTS...

[CS(COMM) 176/2021]

- ❖ The court held that the plaintiff has to petition the court against each domain name that it finds to be infringing, even if the process is cumbersome.
- ❖ The Court did not grant a wide injunction.
- ❖ However, the Court does say that in such cases, the Domain Name Registrars are infringers themselves, and therefore recommends that such Registrars modulate their algorithms in such a way as not to make available potentially infringing domain names.

# Recent Developments

*[Neetu Singh & Anr. v. Telegram FZ LLC,  
CS(Comm)282/2020, decision dated 30<sup>th</sup> August, 2022]*

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- ❖ Various Telegram channels unauthorizedly circulating study material for competitive exams authored by the Plaintiff-coaching teacher
- ❖ Some channels also charged money for sharing
- ❖ Study material included books written by the Plaintiff and videos of her teaching
- ❖ 28th July-23<sup>rd</sup> September, 2020: Interim orders passed directing Telegram to take down infringing channels, as and when informed by the Plaintiffs



# Recent Developments

*[Neetu Singh & Anr. v. Telegram FZ LLC,  
CS(Comm)282/2020, decision dated 30<sup>th</sup> August, 2022]*

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❖ Despite this, new hydra-headed infringing channels kept surfacing, by small changes to the names of the original channels. Eg.-

Old Channel	New Channel
t.me/rakeshpaidvideo	t.me/paidcoursesrakesh
t.me/spoken45	t.me/spoken46

❖ Plaintiff filed an application seeking disclosure of identity of channel creators, from Telegram

# Recent Developments

*[Neetu Singh & Anr. v. Telegram FZ LLC,  
CS(Comm)282/2020, decision dated 30<sup>th</sup> August, 2022]*

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## Decision dated 30<sup>th</sup> August, 2022:

- ❖ Telegram directed to submit details of infringing channels including details of devices/ IP addresses/ servers/ networks/mobile numbers, to the Court in a sealed cover for further orders.
- ❖ On Jurisdiction: Indian Courts held to have jurisdiction since-

Plaintiffs reside and conduct business in India

Infringing material being circulated in India

Copyrighted works relate to study material for preparation for Indian examinations

Telegram itself states it uses cloud computing - its servers are accessible anywhere, including from India

# Recent Developments

*[Neetu Singh & Anr. v. Telegram FZ LLC,  
CS(Comm)282/2020, decision dated 30<sup>th</sup> August, 2022]*

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## On Prima Facie Infringement and Remedies:

- ❖ Plaintiffs' works circulated unauthorizedly on Telegram constitute electronic "infringing copies" under the Copyright Act
- ❖ "Plates" used to produce such infringing copies can be seized or ordered for delivery up under Section 58 of the Copyright Act
- ❖ "Plates" includes "any device used for reproducing copies of copyrighted work"
- ❖ In modern times, this includes any electronic devices including smart phones, computers, servers, etc.

# Recent Developments

*[Neetu Singh & Anr. v. Telegram FZ LLC,  
CS(Comm)282/2020, decision dated 30<sup>th</sup> August, 2022]*

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- ❖ Copyright Act provides for remedy of damages, besides injunctive relief; **If infringers are not identified- relief of damages would be rendered nugatory**
- ❖ Infringement of copyright is also a cognizable offence
- ❖ Such details of plates i.e., devices/phones/computers/servers, used to create infringing copies lie with Telegram

*“‘Take down’ or blocking orders are merely token relief for the interregnum and without monetary relief of damages, coupled with mushrooming of infringing platforms, the copyright owner’s spirit to create and write may be considerably negated. The protection of the same is integral to the public policy behind the legislation as well. The legislative intention to prevent such continued infringement and effectively implement the provisions of the Copyright Act would be frustrated by any interpretation to the contrary.”*



# Recent Developments

*[Neetu Singh & Anr. v. Telegram FZ LLC,  
CS(Comm)282/2020, decision dated 30<sup>th</sup> August, 2022]*

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On Telegram's argument that its servers are in Singapore and it can only disclose data as per Personal Data Protection Act of Singapore, 2012:

*“Copyrighted works are entitled to automatic protection in all WTO countries...Singapore is a signatory to the Berne convention and a WTO country as well...In view of this position of the law regarding copyright, compliance with local law, i.e., PDPA, cannot be an excuse for Telegram to justify the non-furnishing of the information relating to the channels through which dissemination of infringing content takes place as, such dissemination, would in the opinion of this Court, be violative of law, even under the laws of Singapore.”*

# Recent Developments

*[Neetu Singh & Anr. v. Telegram FZ LLC,  
CS(Comm)282/2020, decision dated 30<sup>th</sup> August, 2022]*

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On Telegram being an intermediary, only mandated to disclose originator information in case of specific offences as per the Indian IT (Intermediary Guidelines and Digital Media Ethics), 2021:

*“These guidelines do not in any manner obviate the duty of Telegram as a platform to take all effective steps required to protect IP rights, including rights of copyright owners...*

*Pertinently, such production of details of infringing devices or persons or other sources, is not a comment on Telegram’s liability and does not derogate from safe harbour provisions. In fact, it is aligned with the view of Telegram’s claimed role as an intermediary, which claims to act as a conduit of information...*

*Section 81 of the IT Act shows that the provisions of the IT Act are supplemental to the provisions of the Copyright Act.”*

# Recent Developments

*[Neetu Singh & Anr. v. Telegram FZ LLC,  
CS(Comm)282/2020, decision dated 30<sup>th</sup> August, 2022]*

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## On Telegram's argument that disclosure violates right to privacy:

*"...The right to freedom of speech or the right to life including the right to privacy cannot be used by any person or entity, let alone an infringer, in order to escape the consequences of illegal actions..."*

*As per the above extract from K.S. Puttaswamy (supra) it is clear that the Supreme Court recognises that if there is a law in existence to justify the disclosure of information and there is a need for the disclosure considering the nature of encroachment of the right then privacy cannot be a ground to justify non-disclosure, so long as the same is not disproportionate. In India, the Copyright Act is clearly a law, which requires "infringing copies" to be taken into custody. The Copyright Act recognizes the right of the copyright owner to claim damages and rendition of accounts in respect of such infringement. Secondly, whenever the data is sought for a legitimate purpose, and for curbing the violation of law, including infringement of copyright, the same would be in accordance with the legal position recognised in K.S. Puttaswamy (supra)."*

# Recent Developments

[CS (COMM) 135/2022]

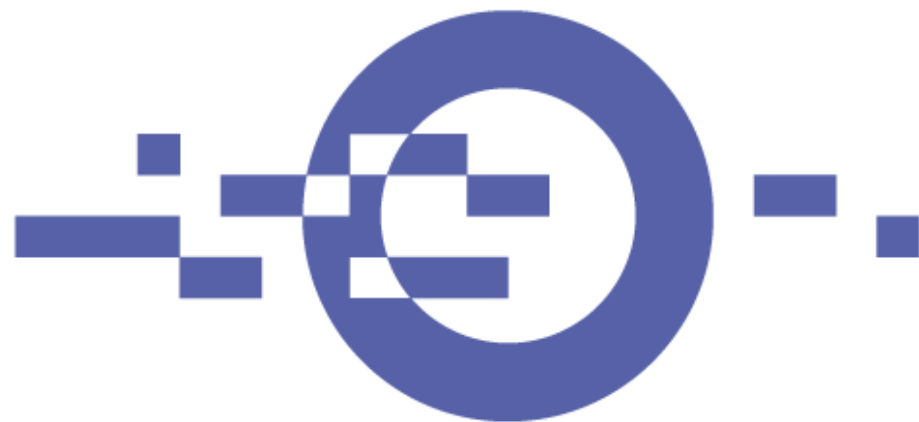
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- ❖ The Delhi High Court consolidated more than 40 suits involving established and well known brands and marks. Plaintiffs sought to restrain numerous Defendants from unauthorized use of the Plaintiff's trademarks.
- ❖ Dishonest entities were defrauding unsuspecting members of the public, claiming to be associated with the Plaintiff's.
- ❖ Relevant Government authorities, as well as ICANN and Registrars, were directed to come together and formulate solutions as to how to curb these malpractices by domain name registrants.

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THANK YOU!





**AIPPI**

**International Association for the Protection of  
Intellectual Property**

**[www.aippi.org](http://www.aippi.org)**



**WIPO - Advisory Committee on Enforcement (ACE)  
15th Session – 31 August to 2 September 2022**

**RECENT WORK CARRIED OUT BY THE  
INTERNATIONAL ASSOCIATION FOR THE PROTECTION OF  
INTELLECTUAL PROPERTY (AIPPI) ON  
THE COMPENSATION FOR IP INFRINGEMENTS**

Linda Lecomte, Assistant Reporter General  
AIPPI, Zurich, Switzerland



# AIPPI Resolutions

- A Resolution is the formal position of AIPPI produced after study and debate, and adopted by a vote of the Executive Committee (ExCo)
- Four Study Questions Each Year: Patents, Copyright, Trademarks/Designs, General (*e.g.*, Trade Secrets)
- National and Regional Groups prepare and file Group Reports on the basis of Study Guidelines by AIPPI Reporter General Team (RGT): State Law, Possible Improvements, Harmonization Proposals
- Resolution Process: Study Committee → Draft Resolution; Debate at AIPPI World Congress Plenary Sessions; Presentation to ExCo for final debate, vote, and adoption





# AIPPI Resolution on IP Damages for Acts Other Than Sales (London, 2019)

# Scope of the Resolution (London, 2019)



- Quantification of damages for acts of infringement that **do not include a sale**
- Methods of quantification of damage suffered by the right holder **caused by the infringing acts**

## Does not address:

- Statutory damages, punitive damages or accounts of profit and other relief in which the unlawful profits of the infringer are rendered to the right holder
- FRAND (fair, reasonable, and non-discriminatory) issues

# TRIPS – Trade Related Aspects of Intellectual Property



## Article 45:

### *Damages*

The judicial authorities shall have the authority to order the infringer to pay the right holder **damages adequate to compensate for the injury the right holder has suffered** because of an infringement of that person's intellectual property right by an infringer who knowingly, or with reasonable grounds to know, engaged in infringing activity.

# Why is this Important?

## Problem:

- ‘Same’ IP right is infringed in different countries
- But different countries award different remedies, if at all

## Why:

- Methods of quantification vary
- Evidence upon which quantification is based varies

## Consequence:

- Lack of consistency
  - Enforcement of IP rights
  - Amount of compensation

# Resolution on IP Damages for Acts other than Sales



## Key Principles:

- 1) Damages (*i.e.*, monetary relief) should be available as a potential remedy for non-sales infringements
- 2) To obtain damages, a causal nexus between the infringing act(s) and the damage must be established
- 3) Upon establishment of infringement, minimum damages awarded to the right holder should include a reasonable royalty

# Resolution on IP Damages for Acts other than Sales



- 4) Quantification of damages should include the following principles:
- a) for its lost profits in respect of sales of products or services that the right holder would have made but for the infringement; and/or
  - b) for its lost profits in respect of price erosion; and/or
  - c) by a reasonable royalty in respect of infringing sales that are not proved to have been lost sales of the right holder; and/or
  - d) **using as a benchmark any potential subsequent sales of the same specific product(s) (whether infringing or non-infringing; whether in the same jurisdiction or not),**
- save that the right holder cannot recover twice for the same loss.

# Resolution on IP Damages for Acts other than Sales



## Objective:

Determine the economic effect of a non-sales infringement on the right holder

# Resolution on IP Damages for Acts other than Sales



**When assessing damages for non-sales infringements in relation to a process protected by a patent, a court should, *inter alia*,**

take into account the economic effect on the right holder of both

- > use of the process and,
- > when relevant, the products that may (or may not) result from the process:



# Resolution on IP Damages for Acts other than Sales



a) In relation to patented processes (regardless of whether they result in the creation of a relevant product by the infringer), the court should, *inter alia*, consider:

- > whether the use of the process by the infringer produces an economic advantage to the infringer or a disadvantage to the right holder;
- > the turnover and potential sales associated with the use of the process as long as, in respect of the potential sales, the right holder proves a causal nexus between the infringement and the right holder's loss;
- > the frequency of use of the process.

# Resolution on IP Damages for Acts other than Sales



b) In relation to products obtained by the patented process, regardless of whether those products infringe, the court should take into account, *inter alia*, the following:

- > potential sales to be made by the infringer of any products manufactured using the process, as long as the right holder proves a causal nexus between the infringement and the right holder's loss;
- > whether the product resulting from the process is protected by the patent in question, directly or indirectly;
- > whether that product competes with products not produced using the patented process;
- > any timing advantage in launching the products given to the infringer through the use of the process (*i.e.*, a springboard advantage).

# Resolution on IP Damages for Acts other than Sales



Without prejudice to the court's power to award injunctive relief, the court should award damages in respect of each infringing act.

- May validly result in recovery of multiple awards of damages for corresponding multiple infringing acts that concern a single product.
- May be awarded as one award of damages, covering all of the multiple infringing acts.
- Should avoid “double recovery,” *i.e.*, recovering more than once in respect of the same loss suffered by the right holder. Effective and proportionate procedures, including relevant disclosure by the right holder, should exist to reduce the risk of double recovery.

# Resolution on IP Damages for Acts other than Sales



Without prejudice to any rules in relation to exhaustion and *res judicata*, there should be no “franking.”

Franking means that there should be no further liability for infringement in relation to dealings with specific products found to infringe, once damages have been awarded in respect of those goods, and such goods are considered to have been “franked.”



# AIPPI Resolution on Reasonable Awareness in Compensation for Infringement of IP Rights (Online, 2021)

# Scope of the Resolution (Online, 2021)



- Role of Awareness (*i.e.*, knowledge) in assessing compensation for infringement of IP rights, whether registered or unregistered
- Should damages be reduced or increased depending upon the level of knowledge?

## Does not address:

- Criminal law
- Role of knowledge in compensation calculated by reference to the unlawful profits of the infringer, or the reimbursement of costs of litigation

# TRIPS – Trade Related Aspects of Intellectual Property



## Article 45:

### *Damages*

(1) The judicial authorities shall have the authority to order the infringer to pay the right holder damages adequate to compensate for the injury the right holder has suffered because of an infringement of that person's intellectual property right by an infringer **who knowingly, or with reasonable grounds to know, engaged in infringing activity.**

(2) The judicial authorities shall also have the authority to order the infringer to pay the right holder expenses, which may include appropriate attorney's fees. In appropriate cases, Members may authorize the judicial authorities to order recovery of profits and/or payment of pre-established damages **even where the infringer did not knowingly, or with reasonable grounds to know, engage in infringing activity.**

# Why is this Important?

## Problem:

- ‘Same’ IP right is infringed in different countries
- But different countries award different remedies, if at all

## Why:

- Methods of quantification using reasonable awareness vary
- Evidence upon which quantification is based varies

## Consequence:

- Lack of consistency
  - Enforcement of IP rights
  - Amount of compensation



# Resolution on Reasonable Awareness in Compensation for Infringement of IP Rights



## Key Principles:

1) Where an intellectual property right is infringed, compensatory damages should be available **regardless of whether the infringer had subjective or objective knowledge:**

- > of the existence of the intellectual property right; or
- > that the infringer's act would infringe the intellectual property right.

- Subjective knowledge = knowledge a person actually has
- Objective knowledge = knowledge which there were reasonable grounds for a person to have

# Resolution on Reasonable Awareness in Compensation for Infringement of IP Rights



2) Compensatory damages should be awarded in full if the infringer **had objective knowledge** of the existence of the intellectual property right, even if the infringer:

- > did not have subjective knowledge of its existence or

- > believed that the infringer's act would not infringe it (*e.g.*, on the basis of a freedom-to-operate search or a non-infringement opinion).

# Resolution on Reasonable Awareness in Compensation for Infringement of IP Rights



3) Claimant should bear the burden of establishing that the infringer had **objective knowledge** of the existence of the intellectual property right.

- This burden should be presumed satisfied if the intellectual property right is a registered intellectual property right, details of which are ascertainable to the public.
- Each jurisdiction should specify the language(s) in which a registered intellectual property right is to be published to have legal effect.

# Resolution on Reasonable Awareness in Compensation for Infringement of IP Rights



4) The infringer's lack of knowledge of the language of the publication of a registered intellectual property right

- > should not impact the recovery,

- > nor decrease the level,

of compensatory damages,

provided that said intellectual property right **is published in a language accepted under the language requirements** stipulated by the applicable law in the jurisdiction in which said intellectual property right is in force and in which the dispute arises.

# Resolution on Reasonable Awareness in Compensation for Infringement of IP Rights



5) Where the infringer had **neither subjective nor objective knowledge** of the existence of the intellectual property right, courts should have the discretion to reduce an award of compensatory damages.

- Such award should **not** be reduced:
  - > the amount by which the infringer has been unjustly enriched by reason of the infringement; or
  - > the level of a reasonable royalty,whichever is greater.

# Resolution on Reasonable Awareness in Compensation for Infringement of IP Rights



## 6) Damages exceeding compensatory damages, if available,:

- > Damages exceeding compensatory damages should not be awarded for any period in which the infringer **had neither subjective nor objective knowledge** of the intellectual property right prior to being notified of the infringement claim
- > The amount of profit made by the infringer **should not alone constitute evidence of an intent** to infringe in order to justify damages exceeding compensatory damages, if such excess damages are available.

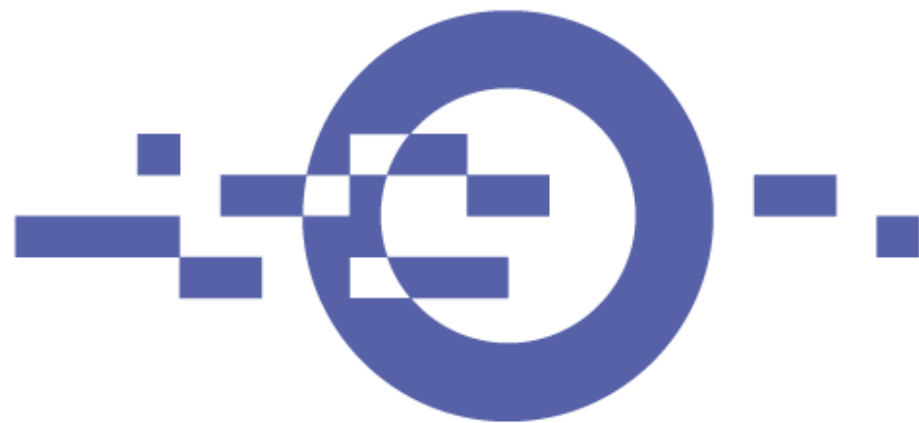


***Thank you very much for your consideration.***

***Linda Lecomte***

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**AIPPI**

**International Association for the Protection of  
Intellectual Property**

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**The work of International  
Trademark Association  
(INTA) on Harmonization of  
Preliminary Injunction  
Legislations**

# The International Trademarks Association (INTA)

- Founded in 1878, INTA is a global association of brand owners and professionals
- Supporting trademarks and complimentary Intellectual Property
- Foster consumer trust, economic growth and innovation
- Committed to building better society through brands
- Members include 6,500 organizations, representing more than 34,000 individuals (trademark owners, professionals, academics) in 185 countries
- 37 different Committees focus on specific topics or regions to advance INTA's cause in line with its strategic plan

# Enforcement Committee

- Variety of topics relevant to enforcement of IP rights
- Includes administrative and judicial proceedings such as oppositions and infringement cases
- Legislative analyses, case law monitoring, research on harmonization, development of policies to advocate for effective IPR enforcement mechanisms
- Members from 45+ countries
- Priority interest: injunctive relief

# Preliminary Injunctive Relief

- Injunctive relief – the most important tool in the hands of right holders seeking to enforce their IP rights.
- Preliminary Injunctions Task Force of the Enforcement Committee conducted study in 2017, initially focused on European Union MS, later in 2018 expanded to non-EU countries, total of 47 key jurisdictions.
- Reviewed standards, requirements and practices of different jurisdictions in granting preliminary injunctions.
- Analyzed common denominators and discrepancies to determine INTA position and identify harmonization gaps.

# Preliminary Injunctive Relief Study

- Most relevant considerations identified:
  - Conditions in which ex-parte injunctions are granted
  - Availability and likelihood of grant of injunction orders in practice
  - Competent courts – special IP courts, commercial or general courts
  - Evidentiary demands – level of evidence required for PI to be granted
  - Timelines and deadlines of such proceedings
  - Possibility of requesting seizure of goods
  - Level of involvement of defendant in the process
  - Availability of penalties and fines when violations occur
  - Security deposits

# Survey Findings

- **Deadlines** to file preliminary injunctions – fixed by statute in some countries, developed by jurisprudence in others, no deadlines in a few jurisdictions.
- **Requirements** for obtaining an injunction – Some countries set a high threshold for claimant to prove actual infringement, some allow grant of a preliminary injunction when claimant is highly likely to succeed on merits.
- **Ex Parte vs Hearing** – Most countries require hearing of defendant at some stage of the process, but in some countries, oral hearing is the rule that is excused in a broad range of circumstances (evidence of urgency, non-effectiveness of provisional measures).

# Survey Findings

- **Validity** of rights claimed – Half of the EU countries allow for detailed review of validity of plaintiff's rights causing significant delays, while others allow for such rights to be contested in the main proceedings only.
- **Time limits** for filing of motions to grant a preliminary injunction and for court to consider and grant an order strictly fixed in some jurisdictions, versus significant delays in other jurisdictions with timelines varying from 1-3 days to months.
- **Defendant's rights** – Some jurisdictions allow for possibility of defendant to oppose a preliminary injunction, others do not allow for such possibility at all.

# Survey Findings

- **Competent courts** – Special IP courts - commercial courts – general courts
- **Main Action** - mandatory requirement with strict deadline in some jurisdictions, while there are countries where this requirement is not imposed.
- **Conclusion:** significant differences which impact legal certainty, efficiency and predictability for right holders



# Board Resolution Points

- Proceedings should be **expedited** with short procedural deadlines, including for issuance of judgment or order sought
- Should be available **ex-parte**, in appropriate circumstances.
- Applicant should be able to assert claimed IP rights and submit documentary evidence to show that it is *prima facie* likely to succeed on merits, balance of inconvenience favors the Applicant. Provided this burden is met, **irreparable harm** should be presumed.
- Except in case of obvious invalidity or fraudulent registrations, court should not be burdened with re-examining the **validity** of asserted right.

# Board Resolution Points

- Balancing of rights - Defendant should be notified of any ex-parte order granted without delay, given opportunity to **challenge** the injunction and request an oral hearing or otherwise have counter arguments considered.
- **Counter claims** contesting the validity of asserted right should be adjudicated in main proceedings.
- Injunctive orders should provide for defendant to pay **penalties** for violation of said orders.

# Board Resolution Points and TRIPS

- TRIPS requirements (Article 50)
- promptness of proceedings (50.1);
- *ex parte* and without notice to defendant (50.2);
- evidence for right ownership required but no review of validity (50.3);
- notification and option to appeal for defendant (50.4);
- requirement to file main action within certain deadline (50.6);
- defendant's right to compensation (50.7).

# Harmonization and Advocacy Outreach

To improve harmonization and effective enforcement of IPR, INTA to encourage change where...

- irreparable harm required to be proved
- full review of validity of claimed rights or counter claims for invalidity possible in interim proceedings
- immoderate amount/type of evidence required of brand owners for PI to be granted, in some cases even proof of damages
- proceedings take excessive time for grant of preliminary injunction.

**Questions?**

**Thank you!**

