



The Legal 500 & The In-House Lawyer
Comparative Legal Guide
Norway: Intellectual Property (3rd edition)

This country-specific Q&A provides an overview to intellectual property laws and regulations that may occur in Norway.

This Q&A is part of the global guide to Intellectual Property. For a full list of jurisdictional Q&As visit <http://www.inhouselawyer.co.uk/practice-areas/intellectual-property-third-edition/>



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1. **What different types of intellectual property rights exist in your jurisdiction to protect: (a) Inventions; (b) Brands; (c) Other creations, technology and proprietary interests**

1.1.1 Inventions (e.g. patents, supplementary protection certificates, rights in confidential information and/or know-how);

There are two different types of intellectual property rights available for the protection of inventions: patents and trade secrets. Patents protecting medicinal products and plant protection products may enjoy an additional period of protection in the form of supplementary protection certificates (SPCs).

1.1.2 Brands (e.g. trade marks, cause of action in passing off, rights to prevent unfair competition, association marks, certification marks, hallmarks, designations of origin, geographical indications, traditional speciality guarantees);

Brands are subject to protection as trademarks. Registered business names and personal names used for goods and services enjoy protection against others' use within the same geographical area. Geographical indications for wine and liquor are protected according to the Marketing Act.

1.1.3 Other creations, technology and proprietary interests (e.g. copyright, design rights, semiconductor topography rights, plant varieties, database rights, rights in confidential information and/or know-how).

Copyright exists for the protection of works/intellectual creations, including computer programmes. Designs are subject to protection as registered designs. Database rights provide protection of databases. Third parties' use of technical aids, products, hallmarks, catalogues, means for advertising etc. are protected according to the Marketing Act. In addition, the Marketing Act contains a prohibition for actions in conflict with good business practice.

2. What is the duration of each of these intellectual property rights? What procedures exist to extend the life of registered rights in appropriate circumstances?

A granted patent is valid for 20 years after the filing date of the first application. Trade secrets are valid for as long as the information meets the requirements for being a trade secret. A registered trademark is valid for ten years from the filing date of the application. A granted design registration is valid for five years after the filing date of the application. The maximum duration of design rights are 25 years. Copyright exists in the originators lifetime and for 70 years thereafter. Database rights last for 15 years after the production of the database.

Patent rights for medicinal products and plant protection products may be extended by SPCs. The procedures for such extension comply with the EU SPC Regulations for medicinal and plant protection products. Medicinal products that are indicated for treatment of children may be granted an additional paediatric extension of six months after the expiry of the SPC.

To be granted a SPC or a paediatric extension, the patent-holder must hold a valid marketing



authorisation for a medicinal or plant protection product. The application must be filed within six months of receiving the first marketing authorisation for the product. The applicant must pay an additional fee.

Registered trademarks may be extended for ten years at a time, upon written application to the Norwegian Industrial Property Office (NIPO) at the earliest one year before, and at the latest six months after, the expiration of the registration period. A fixed fee is to be paid upon requests for renewal.

Registered designs may be extended for five years at a time. The procedure for extending the rights corresponds to the procedure for extending trademark rights.

3. Who is the first owner of each of these intellectual property rights and is this different for rights created in the course of employment or under a commission?

The first owner of a patent, a design registration, a copyright and a database right is the inventor/designer/originator, respectively. The first owner of a trademark is the holder of the trademark application. The first owner of technical aids, products, hallmarks, catalogues, means for advertising etc. according to the Marketing Act is the relevant company.

If an invention is created in the course of a research or inventive based employment, the first owner of the patent rights is the employer. In such cases, the employee is obliged to inform the employer of the invention. The employer shall then notify the employee in writing in order to obtain the rights to the invention. For inventions made by employees in other positions, the employer enjoys certain exploitation and priority rights.

The first owner of the copyright to a computer programme created in the course of employment is the employer. The droit moral lies with the employee.

4. Which of the intellectual property rights described above are registered rights?

Patents, designs, trademarks and business names are registered rights.

5. Who can apply for registration of these intellectual property rights and, briefly, what is the procedure for registration?

The inventor or an otherwise rightful owner of the invention can apply for a patent. The designer or an otherwise rightful owner of the design can apply for registration of a design. Anyone can apply for registration of a trademark. Anyone in business can apply for registration of a business name.

The applications, including the application forms, are filed in writing before NIPO. The patent application needs to include a detailed description of the invention and patent claims. The design application needs to include the relevant product or products and pictures clearly displaying the design. The trademark application needs to include a representation of the brand and a list of the goods or services the brand is applied to be registered for. After payment of the application fee, NIPO controls whether the formal requirements are met. If they are not, the applicant will receive a notification with a short deadline for rectifying any formal discrepancies.

The applicant of a design registration may, after payment of a fee, request NIPO to conduct a supplemental examination of the design application, including novelty and inventive step. NIPO shall inform the applicant of its results, without deciding whether the conditions for a design right are met.

As for inventions and brands, NIPO conducts a more substantive assessment, including patentability and distinctiveness, respectively. The applicant will be given the opportunity to rectify any deficiencies identified by NIPO within a set deadline. Often NIPO continues to assess the application based on the applicant's response. If the applicant does not respond within the deadline, the application may be denied. However, if the applicant does respond and complies with NIPO's request within four months after the deadline, the application may be reopened by paying a fee.

Once all deficiencies are rectified and NIPO considers the requirements for registration to be present, the application may be granted upon the applicant's payment of the granting fee. The grant of a patent, a design or a trademark is published in the Norwegian Patent, Design and Trademark Gazette, respectively. The patent, design or trademark is also included in the relevant registry.



The application for a business name is filed as a notice of registration before the Register of Business Enterprises.

6. How long does the registration procedure usually take?

Statistics from NIPO state that the average duration of the grant procedure for a national patent is 3.6 years. NIPO provides its first assessment of the patentability of the invention within five-seven months.

The registration procedure for designs takes two three months.

If an application for a trademark is filed via NIPO's application guide, the registration procedure takes three weeks. If the application is filed in a different way, NIPO will provide its first assessment within five six months. The timing for the registration procedure will in both cases depend on whether, and to what extent, there are deficiencies in the application rectified by the applicant.

The registration procedure for business names takes approximately two weeks.

7. Do third parties have the right to take part in or comment on the registration process?

Anyone may file a protest to a patent or trademark application before the relevant right has been granted. The person submitting a protest does not become party to the proceedings, but NIPO shall take into account the protest when processing the application.

As for designs and business names, third parties are left with the option of filing a complaint after the relevant right has been registered.

8. What (if any) steps can the applicant take if registration is

refused?

If registration of a patent, design or a trademark is refused, the applicant will have the opportunity to rectify the deficiencies within a deadline set by NIPO.

If NIPO's refusal of the patent, design or trademark application is final, the applicant has a right to appeal the decision to the Norwegian Board of Appeal for Industrial Property Rights (KFIR). KFIR's decision may further be appealed to the Oslo District Court if the decision from KFIR goes against the applicant.

9. What are the current application and renewal fees for each of these intellectual property rights?

The current application fee for patents is NOK 4650 for businesses with more than 20 man-years, and NOK 850 for businesses with 20 man-years or less. For each patent claim beyond ten, a fee of NOK 250 applies.

Before the patent can be granted, a granting fee of NOK 1200 must be paid. For each page beyond 14, an additional fee of NOK 250 applies. For each patent claim beyond ten, a fee of NOK 250 applies.

The annual fee for patents starts at NOK 700 for the first three years and gradually increases to NOK 6500 for the 20th year. The annual fee for SPCs is NOK 6500.

The current application fee for design registration is NOK 1900. The fee for renewal varies between NOK 2900 and NOK 5000, depending on whether it is the first, second, third or fourth request.

The current application fee for registration of trademarks is NOK 2900. The renewal fee for up to three classes is NOK 2600. For each class beyond three, an additional fee of NOK 1000 applies.

Registration of business names is free.

10. **What are the consequences of a failure to pay any renewal fees and what (if any) steps can be taken to remedy a failure to pay renewal fees?**

If the annual fee for a patent is not paid at the application stage, the application will be rejected. Failure to pay the annual fee for a granted patent will lead to the patent being deleted. If the renewal fee for a registered design or trademark is not paid, the registration will cease to exist.

A failure to pay may be rectified within a deadline of six months, by payment of the annual fee/renewal fee and an additional late payment fee.

11. **What are the requirements to assign ownership of each of the intellectual property rights described in section A?**

There are no specific requirements on assigning an intellectual property right pursuant to Norwegian law.

12. **Is there a requirement to register an assignment of any of these intellectual property rights and, if so, what is the consequence of failing to register?**

There is no requirement to register an assignment of an intellectual property right pursuant to Norwegian law, but it is recommended. Ensuring the correct owner is registered provides notoriety for third parties and enables NIPO to send the notification of annual fee to the right person. Also, the first registration of assignment gives legal protection in cases of assignment of the same right to multiple parties or bankruptcy proceedings.

13. **What are the requirements to licence a third party to use each**

of the intellectual property rights described in section A?

There are no specific requirements on licencing an intellectual prop–erty right pursuant to Norwegian law.

14. Is there a requirement to register a licence of any of these intellectual property rights and, if so, what is the consequence of failing to register?

There is no requirement to register a licence of an intellectual prop–erty right pursuant to Norwegian law, but it is recommended. Such registrations are done with NIPO. Also, registration gives legal protection in case of licencing of the same right to multiple parties or bankruptcy proceedings.

15. Are exclusive and non-exclusive licensees given different rights in respect of the enforcement of the licensed IP, and if so, how do those rights differ?

There are no specific rights given to licensees pursuant to Norwegian law. It is possible for licensees to file an action for infringement. This applies both for exclusive and non-exclusive licensees that have standing in the case, and depends on the provisions of the licence agreement.

16. Are there criminal sanctions for infringement of any intellectual property rights, and if so, what are they and how are they invoked?

Pursuant to Norwegian law, criminal sanctions are available for infringement of any intellectual property rights. The general minimum and maximum sentences for infringement of patents, designs, trademarks, business names and copyright are fines or prison up to one year. In case of particular aggravating circumstances, the minimum and maximum sentences are fines or prison up to three years. For rights according to the Marketing Act, such as trade secrets and

protection against third parties' use of products etc., only serious breach of the provisions are criminally sanctioned. In such cases, the minimum and maximum sentences are fines or prison up to six months.

If a rights holder wishes to invoke criminal sanctions, the infringement must be reported to the police. The prosecuting authority may neglect prosecution, unless public considerations indicate otherwise. To date, criminal proceedings to stop infringement are uncommon.

17. What other enforcement options are available in your jurisdiction for each of the intellectual property rights described in section A? For example, civil court proceedings, intellectual property office proceedings, administrative proceedings, alternative dispute resolution.

Civil court proceedings, preliminary injunctions (PI) and alternative dispute resolution are available for infringement of any intellectual property rights, although alternative dispute resolution is not a common way of settling an intellectual property case.

18. What is the length and cost of such procedures?

Civil court proceedings and PI proceedings on intellectual property rights often include counterclaims, such as revocation of a patent. In these cases, the civil court proceedings normally last for 10-15 months from the filing of the statement of claim to a decision being handed down in first instance. An appeal case normally lasts for 12-18 months from the filing of the appeal to having the appeal court's decision. PI cases are usually heard within six months from filing the PI request.

The court fee for commencing proceedings is a fixed fee depending on the number of days the oral hearing lasts (if there is one) and the court instance. For a one-day case in the district court, the court fee is NOK 5750 in 2019. The fixed fee is different from cases of preliminary injunctions.

Other costs, including attorney's fees and technical expert fees, may amount to MNOK 1 5 for each instance depending on the scope of the case.

Arbitration proceedings normally last for 6-12 months from filing the request to the tribunal's decision being handed down. The cost of such procedures may amount to MNOK 1-5 in total.

19. **Where court action is available, please provide details of which court(s) have jurisdiction, how to start proceedings, the basics of the procedure, the time to trial, the format of the trial, the time to judgment and award of relief and whether any appeal is available.**

Only the court instances in Oslo have jurisdiction to hear intellectual property civil court cases. For cases concerning the Marketing Act and PI proceedings, general civil procedural rules on jurisdiction apply.

The civil court proceedings are initiated by filing a statement of claim to the Oslo District Court. A PI case is initiated by the PI request. In both cases, the defendant will be given a deadline for filing a statement of defence. Having received the statement of defence, the Court arranges a case management conference (CMC) to be held with the parties' counsels. In the CMC, the parties agree with the Court on the further timeline of the case and other issues, such as the timing for the trial. The parties are allowed to file pleadings and evidence up until the closing date for the case preparation, which is normally two-three weeks prior to the oral hearing. The trial is normally scheduled around 9-12 months from filing the statement of claim.

The parties present their cases starting with the claimant, both in opening and closing arguments. Following the defendant's opening arguments, testimonies, including expert witness evidence, are heard. The hearing usually lasts from three to eight court days. In the most complex cases, longer hearings may occur.

The time to judgment is normally four-eight weeks, depending on the size of the case. The judgment may be appealed within one month from the serving of the judgment. The general rule is that the winning party is awarded costs.

20. **What customs procedures are available to stop the import**

and/or export of infringing goods?

Preliminary injunctions are available for stopping the import and/or export of products that will infringe an intellectual property right, when the goods are in the control of the customs authorities, even if the receiver of the products is unknown. Such a preliminary injunction obliges the customs authorities to retain the goods in question for the duration of the preliminary injunction. The customs authority has a ten working days jurisdiction to retain goods without PI procedures having been initiated.

21. Are any non-court enforcement options or dispute resolution mechanisms mandatory in respect of intellectual property disputes in any circumstances? If so, please provide details.

No non-court enforcement options or dispute resolution mechanisms are mandatory in respect of intellectual property disputes pursuant to Norwegian law.

22. What options are available to settle intellectual property disputes in your jurisdiction?

At any point prior to the decision being handed down, the parties may decide to settle the case. During the CMC, the court will ask the parties if they wish to go through court mediation to seek a settlement, but this is not mandatory. If the parties settle the case, they will usually submit a joint pleading requesting that the case is withdrawn.

23. What is required to establish infringement of each of the intellectual property rights described in section A? What evidence is necessary in this context?

In order to establish infringement of a patent or a registered design, the holder must show that an unlawful use of the invention/design has occurred or been largely prepared. For patents, all features of the patent claim, interpreted in light of the patent description and drawings, need to be present in the infringing object. If the infringing object is equivalent to the patented

invention, this may also suffice.

In order to establish infringement of a trademark, the infringing mark must either be identical to the trademark and applied for the same goods or services, or there must be a likelihood of confusion between the marks. For well-known trademarks, establishing unreasonable exploitation of, or damage to, the trademark's distinctiveness or goodwill will suffice.

In order to establish infringement of copyright, the proprietor must show that an unlawful reproduction of copies or communication to the public of the work has occurred.

In order to establish infringement of a business name, the holder must show that there is a likelihood of confusion between the protected and infringing business names.

In order to establish infringement of a trade secret, or a technical aid, product etc. according to the Marketing Act, unpermitted use needs to be established.

Photographs, drawings, market surveys and expert evidence may serve as evidence for establishing infringement of intellectual property rights.

24. **How does the court acquire any necessary information (fact or technical) and in what circumstances does it do so? In particular - a) Is there a technical judge, a judge with technical experience, a court appointed expert, an expert agreed by the parties, and/or parties' expert witness evidence? b) What mechanisms are available for compelling the obtaining and protecting of evidence? Is disclosure or discovery available?**

In patent and trademark cases, the court panel will normally consist of one legal judge and two expert judges jointly (or separately) proposed by the parties. In addition, the parties usually present expert witness evidence.

There are mechanisms by which a party to an intellectual property matter may obtain relevant information and evidence from the other party or a third party. After the initiation of a lawsuit, a party may request disclosure of relevant information from the other party. The other party may

reject such requests under certain circumstances, e.g. if the information is covered by attorney-client privilege, contains a trade secret or is not sufficiently specified by the requesting party. In the case of trade secrets, the court may decide that the information shall be disclosed, but this is normally done with confidentiality measures.

The right to information also applies to third parties who have contributed to the infringement, been in possession of a product that infringes, have used a service that infringes, have offered a service that infringes, or otherwise have been designated by a person involved as being involved in the infringement. These persons may be compelled by a court of law, upon the right holder's request, to provide information of the origin and distribution network for goods and services that the infringement concerns, provided that there are reasonable grounds to believe that there has been an infringement of an intellectual property right.

25. **How is information and evidence submitted to the court scrutinised? For example, is cross-examination available and if so, how frequently is it employed in practice?**

All information and evidence which the parties wish the court to consider, must be presented orally to the court (save for written procedures available in PI proceedings). Cross-examination of witnesses is available and is almost always employed in practice.

26. **What defences to infringement are available?**

A defendant may put forward several defences in response to alleged infringement, including that the intellectual property right is invalid. An invalidity claim must be submitted in a counter-claim to the case, not simply as a defence.

For works/intellectual creations and trade secrets, the defendant may argue that the work or secrets do not fulfil the relevant conditions to qualify as protected copyright or trade secrets.

A defendant may also argue that it has prior-use rights, or that the intellectual property rights have been exhausted in the relevant case.

27. Who can challenge each of the intellectual property rights described above?

According to Norwegian law, anyone can challenge patents, designs and trademarks. The same apply for business names, provided that legal standing is demonstrated.

28. When may a challenge to these intellectual property rights be made (e.g. during any registration process or at any time during the subsistence of the right)?

A challenge against a patent or a trademark may be made during the registration process, either as a protest to the application or during an opposition period, or at any time during the subsistence of the right. A challenge against a design or a business name can be made at any time during the subsistence of the right.

29. Briefly, what is the forum and the procedure for challenging each of these intellectual property rights and what are the grounds for a finding of invalidity of each of these intellectual property rights?

A protest to a patent or trademark application is brought before NIPO. The person submitting a protest does not become party to the proceedings, but NIPO shall take into account the protest when processing the application.

An opposition to a patent needs to be brought before NIPO within nine months from the grant of the patent. For trademarks the deadline is three months from the announcement of the grant. NIPO informs the rights holder of the opposition and sets a deadline for providing comments.

During the subsistence of the right, a third party wishing to remove the effects of a patent, design, a trademark or a business name may file a claim for an administrative review from NIPO or file a lawsuit. For administrative review of business names, a deadline of three years from registration applies.

A patent may be found invalid for added subject matter and lack of technical effect, novelty, inventive step and sufficiency. A registered design may be found invalid for not complying with the legal definition of “designs”, for lack of novelty and inventive step, for contradicting public interests or third party rights and for being determined by technical function. A registered trademark may be found invalid for not complying with the legal definition of “mark”, for lack of distinctiveness, and for contradicting public interests or third party rights.

30. **Are there any other methods to remove or limit the effect of any of the intellectual property rights described in section A, for example, declaratory relief or licences of right?**

Licensing of rights or declaratory reliefs may serve as methods to remove or limit the effect of the intellectual property rights. In response to a claim for infringement, the defendant may seek a declaratory judgment that the relevant intellectual property right cannot serve as basis for prohibiting the alleged infringing acts.

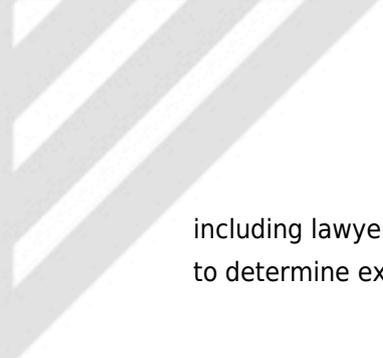
31. **What remedies (both interim and final) are available for infringement of each of the intellectual property rights described in section A?**

For patents, trade secrets, designs, trademarks, business names and copyright, the same type of remedies are available. The most common types of remedies are damages and injunctive relief against on-going and future infringement.

32. **What are the costs of enforcement proceedings and is any kind of costs recovery available for successful parties? Is there a procedural mechanism enabling or requiring security for costs?**

See item 18 above.

The general rule is that the losing party shall reimburse the successful party's costs and fees,



including lawyers' fees, as long as these are necessary and reasonable. The court has discretion to determine exceptions and to reduce the successful party's claim for costs and fees.

To protect itself a potential opponent may require a security bond to be posted by the intellectual property owner, to ensure payment of the opponent's potential loss.