

INTERIM MEASURES IN INTELLECTUAL PROPERTY MATTERS

14 DEC 2021

When undergoing an infringement of their intellectual property rights, it is paramount that the injured party can react quickly. Interim measures allow such a fast reaction. Such measures differ from ordinary proceedings in four aspects: 1) the injured party's claim must be plausible; 2) in the absence of a legal decision within a short period of time, irreparable damage would result; 3) the judge of the interim measures sets a deadline for the claimant to bring an action on the merits; 4) the claimant may have to compensate the respondent if the judge on the merits rejects the action. This newsletter aims to provide an overview of the different requirements to be met in the context of a request for interim measures in intellectual property matters.

I. FORMAL CONDITIONS

In terms of procedure, art. 261 ff. of the Swiss Civil Procedure Code (RS 272; "**CPC**") are applicable to interim measures¹. The principle of non ultra petita of art. 58 para 1 CPC applies: the judge cannot award more than what the claimant requests. The court can, of course, award less than what is requested by the claimant (as long as it is not less than what was admitted by the opposing party)². The pleadings must be precise enough to be included as they stand in the operative part of the judgement; and the judgement must be enforceable without the enforcement judge having to carry out a material examination of the case³.

According to art. 59 of the Trade Marks Protection Act (RS 232.11; "**TmPA**"), any person requesting provisional measures may in particular ask the court to order measures to a) secure evidence; b) establish the origin of items unlawfully bearing a trade mark or indication of source; c) preserve the existing state of affairs; d) provisionally enforce claims for injunctive relief and remedy.

The open-ended nature of the enumeration in art. 59 TmPA means that the list of measures that can be the subject of a provisional injunction is not exhaustive, as is the case with art. 262 CPC⁴.

While art. 65 of the Copyright Act (RS 231.1; "**CopA**"), art. 38 of the Designs Act (RS 232.12) and art. 59 TmPA contain the same catalogue of the different interim measures that can be ordered and their description, art. 77 of the Patents Act (RS 232.4; "**PatA**") is broader. It begins by citing three types of measures: to secure evidence, to preserve the existing state of affairs or to provisionally enforce claims for injunctive relief and remedy (art. 77 para 1 lit. a PatA). It then introduces two complementary measures: description (lit. b) and seizure (lit. c), which are accompanied by rules on the safeguarding of the defendant's trade secrets (art. 77 para 3 ff PatA) and specificities regarding the procedure of description (art. 77 para 4-5 PatA). The party requesting the description must only show that the patent right has been infringed or is about to be infringed but not that it would cause him damage that would be difficult to repair⁵.

1 TISSOT Nathalie/KRAUS Daniel/SALVADÉ Vincent, Précis de propriété intellectuelle, 2019, N 1141.

2 CHABLOZ Isabelle, Petit Commentaire du Code de procédure civile, Bâle (Helbing Lichtenhahn) 2020, ad art. 58 N 6.

3 SCHLOSSER Paul, Les conditions d'octroi des mesures provisionnelles en matière de propriété intellectuelle et de concurrence déloyale, in sic! 5/2005, p. 341 ; ATF 97 II 92.

4 Précis de propriété intellectuelle, N 1137.

5 Précis de propriété intellectuelle, N 1140 ; cf. infra p.2-3.



On another note, the referral of the case must be to the correct authority and that the court seized must have material jurisdiction⁶. Active legitimation, i.e. to bring the action before court, belongs to the person who makes it probable that they meet the legal requirements to take action against the infringer⁷. Any person requesting preliminary measures for trade marks, patents or designs must first prove that the according right has been registered, and not only filed⁸.

As regards to the repartition of costs, the respondent should be ordered to pay the costs of the proceedings whether the application is allowed or dismissed for lack of risk of repetition because the respondent has ceased the offending conduct or promised not to engage in it again. The same applies if the applicant withdraws his conclusions following the respondent's undertaking⁹.

II. MATERIAL CONDITIONS

It is the proper of interim measures to be based on probability. The claimant must make plausible two conditions (art. 261 para 1 CPC):

- the existence of an unlawful infringement; and
- a damage that is not easily repairable.

These two conditions must be made plausible in the sense that the judge must attribute a greater probability to the occurrence of these elements than to their non occurrence¹⁰.

1. EXISTENCE OF AN UNLAWFUL INFRINGEMENT (ART. 261 PARA 1 LIT. A CPC)

The claimant must establish that his "[right] or related right is infringed or threatened" (art. 62 para 1 CopA; art. 55 para 1 TmPA) or that he is "*threatened with or had his rights infringed*" (art. 72 PatA). The idea is that the applicant must make it likely that the respondent's conduct is unlawful, but also that there is a risk that the respondent will actually engage in, continue or resume the offending conduct in the near future¹¹.

If the infringement has not yet taken place, the claimant must make probable a first infringement of his rights¹². If the infringement has already taken place and is continuing, the applicant must make it likely that the offending conduct has taken place and is still ongoing¹³.

In this case, a risk of repetition can generally be accepted when the offender contests the illegality of his or her conduct¹⁴. This may be the case where the offender, in view of a forthcoming trial, has stopped the impugned conduct but seeks to justify it in the proceedings. This is a rebuttable presumption. In this situation, only an unequivocal written undertaking would reliably defeat the claim of a risk of repetition¹⁵.

2. DAMAGE NOT EASILY REPARABLE (ART. 261 PARA 1 LIT. B CPC)

A damage that is difficult to repair occurs when the implementation of the applicant's rights would be jeopardised if he were reduced to asserting them in ordinary proceedings¹⁶.

There are different types of damages¹⁷:

- **Material damage** occurs when financial reparation is not likely to fully compensate the person concerned. Examples of material damage are the loss of customers; the extent of the damage resulting from the reduction in prices that the right holder is forced to make as a result of the appearance of competing products on the market.
- **Intangible damage** is not capable of being repaired in money, or only in an imperfect manner. Intangible damages are, for instance, reputational damage, market disruption, conflict with licensees, risk of loss of evidence, etc.

III. PROPORTIONALITY

The principle of proportionality is divided into three sub-principles.

First, the measure must be **adequate**. This means that it must be appropriate to achieve the intended purpose.



6 SCHLOSSER, p. 340.

7 SCHLOSSER, p. 341.

8 Judgement of the Swiss federal court for patents, S2019_003 of 11 July 2019, consid. 28.

9 SCHLOSSER, p. 346.

10 SCHLOSSER, p. 342.

11 SCHLOSSER, p. 344.

12 ATF 109 II 338, consid. 3.

13 SCHLOSSER, p. 344.

14 Précis de propriété intellectuelle, N 1146.

15 SCHLOSSER, p. 345; Précis de propriété intellectuelle, N 1146.

16 SCHLOSSER, p. 347.

17 SCHLOSSER, p. 347 ff.

Secondly, the court must prefer the least intrusive of all the possible measures (**principle of necessity**). Thus, the court will, for example, require that a seizure be dispensed where prohibition measures are sufficient to achieve the desired goal¹⁸. According to art. 77 para 2 PatA, if a party requests a description to be made, it must provide prima facie evidence that an existing claim has been infringed or that an infringement is suspected.

Finally, the **principle of proportionality *stricto sensu*** requires the renunciation to a measure which, although valid according to the two criteria examined above, consequences for the respondent would be so incisive that they would appear disproportionate¹⁹. According to the Swiss Supreme Court, when the damage threatening the claimant is difficult to repair and the other conditions of art. 77 para 2 PatA are fulfilled, interim measures must be ordered, regardless of the consequences for the other party²⁰. However, the more difficult it is for the measure to be reversed, the stricter the judge must be in examining the conditions for granting provisional measures²¹.

IV. URGENCY/EXPIRY DATE

The last condition for the admissibility of the request for interim measures is that the time limit for expiry has not been reached.

Generally speaking, it is accepted that the injured party may bring an action on the merits as soon as he is aware of the violation and its perpetrator²². The damage is sufficiently defined when the claimant has enough information to enable him to assess the extent of the damage²³.

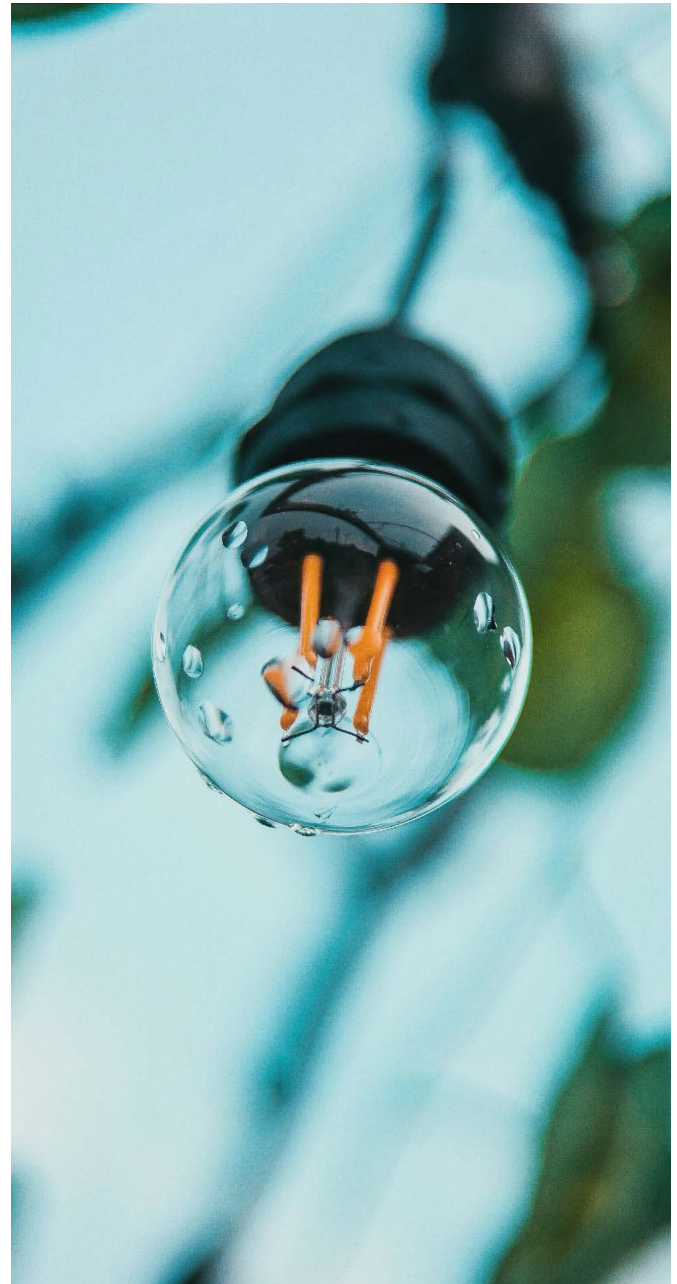
According to the Swiss Supreme Court, the application for interim measures can only be rejected for lateness if it turns out that an ordinary procedure introduced in time would have led to a resolution of the dispute more or less at the same time or shortly thereafter²⁴.

V. CONCLUSION

The prerequisites for the issuance of precautionary measures are a damage that cannot be repaired easily, a particular emergency that goes beyond the general endeavour to implement legal requirements as quickly as possible, as well as the proportionality of the injunction²⁵. The claimant should introduce his claim as soon as he has knowledge of these elements.

Although summary, the hearing of a request for provisional measures requires the respondent to be heard (art. 265 CPC). However, in cases of qualified urgency, the legislation has provided for the institution of pre-provisional or extreme urgency measures that allow the hearing of the opposing party to be bypassed. This will be the case where there is a risk of obstruction, i.e. the disappearance of evidence²⁶.

Whenever the conditions for interim measures or extreme urgency measures are fulfilled, the court must grant immediate protection to the claimant²⁷.



18 SCHLOSSER, p. 350.

19 SCHLOSSER, p. 351

20 ATF 94 I 8, consid 5 and 8 lit. c.

21 Précis de propriété intellectuelle, N 1145 ; ATF 130 II 149, consid. 2.3.

22 SCHLOSSER, p. 356.

23 ATF 108 Ib 97, consid. 1.c).

24 SCHLOSSER, p. 355.

25 ATF 130 II 149, consid. 2.3.

26 SCHLOSSER, p. 357.

27 Précis de propriété intellectuelle, N 1149.



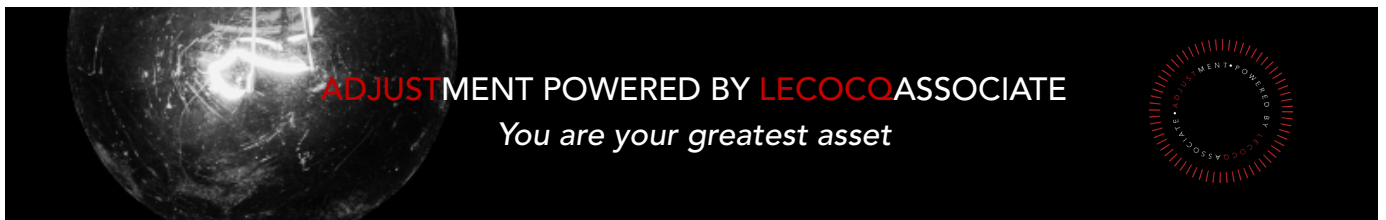
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