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des brevets

# Patent enforcement in Europe

A country-by-country overview



European Patent Academy

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All references to natural persons are to be understood as applying to all genders.

**Additional references**

For further information on patent litigation regimes (both administrative and civil procedures) across the 38 EPC contracting states, the publication “Patent litigation in Europe” is available at [www.epo.org/litigation-MS](http://www.epo.org/litigation-MS).

For further information on compulsory licensing, the publication “Compulsory licensing in Europe” ([www.epo.org/compulsory-licensing](http://www.epo.org/compulsory-licensing)) provides a country-by-country overview of compulsory licensing regimes across the 38 EPC contracting states including possible grounds for grant, procedural framework and jurisprudence.

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## Introduction

Intellectual property law is an area that has been a pioneer for cross-border agreements and co-operation. In Europe, the European Patent Convention (EPC) created the legal framework for a single, harmonised patent granting procedure for the European patent. However, once granted, European patents have to be enforced before national courts and other authorities.

In 1994, for the first time on an international level, the TRIPS Agreement provided for enforcement procedures that right holders could rely upon to protect their IP rights.

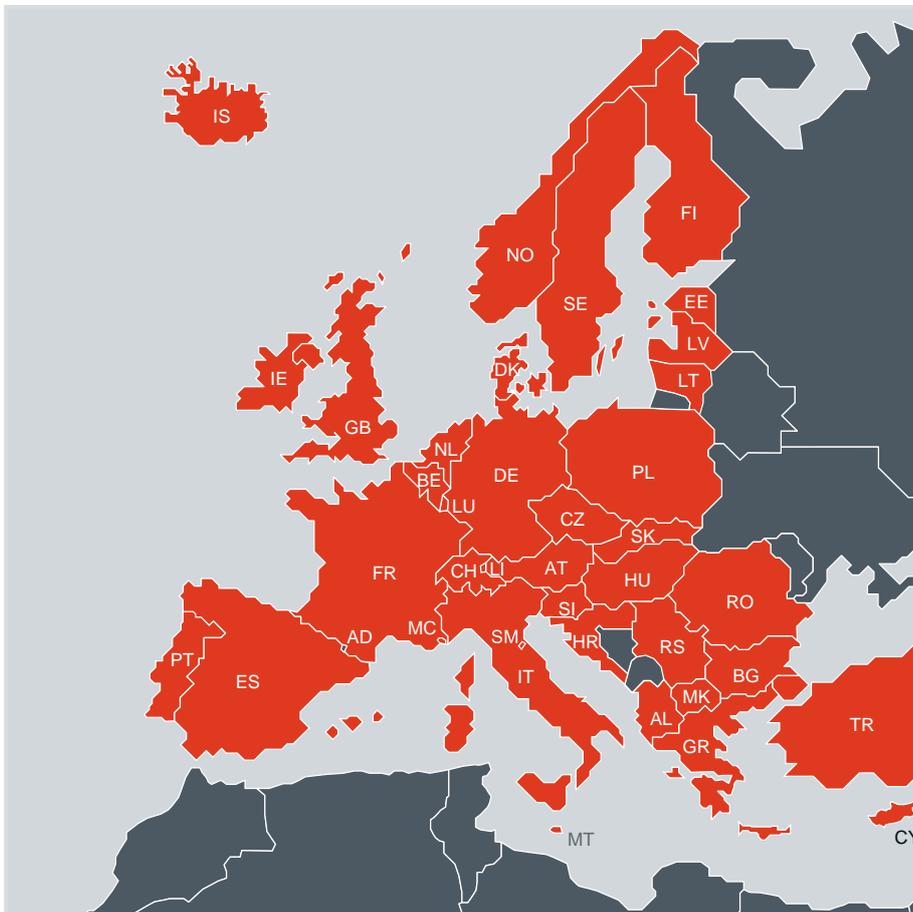
The EU took a further step in harmonising standards and adopted the Directive 2004/48/EC on the enforcement of intellectual property rights (Enforcement Directive), which seeks to approximate the legislation of EU member states to ensure a minimum, homogeneous level of protection within the internal market and strengthen the enforcement of intellectual property rights. However, despite the common rules of the TRIPS Agreement and the transposition of the Enforcement Directive into national legislations, the manner

in which the enforcement of patent rights remains subject to national procedures and vary across the continent.

In 2013, the Agreement on the Unified Patent Court (UPCA) was signed and for the first time provides an international civil court which will allow harmonised enforcement of European patents and future Unitary Patents. Decisions of the Court will, according to Article 82(3) UPCA be enforced in the same way as a decision of a national court or authority of the UPCA contracting state where the enforcement takes place.

In the interests of promoting harmonisation and knowledge exchange in patent enforcement and litigation practices the European Patent Academy, together with authors from all over Europe, has compiled this book to offer a comprehensive reference and guide to the measures available to protect patent rights across the 38 EPC contracting states, as well as the relevant national procedures to enforce them.

European Patent Academy



EPC contracting states (2019)

## List of abbreviations

ED	Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights (Enforcement Directive)
EPC	Convention on the Grant of European Patents (European Patent Convention) of 5 October 1973 as revised
EPO	European Patent Office
EU	European Union
EU Regulation 608/2013	Regulation (EU) No 608/2013 of the European Parliament and of the Council of 12 June 2013 concerning customs enforcement of intellectual property rights
TRIPS	Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, 1869 U.N.T.S. 299, 33 I.L.M. 1197 (1994).
UPC	Unified Patent Court
UPC Agreement	Agreement on a Unified Patent Court

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### Country profiles

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AL	Albania	11	IT	Italy	259
AT	Austria	21	LI	Liechtenstein	269
BE	Belgium	37	LT	Lithuania	271
BG	Bulgaria	49	LU	Luxembourg	283
CH	Switzerland	61	LV	Latvia	293
CY	Cyprus	75	MC	Monaco	307
CZ	Czech Republic	87	MK	Republic of North Macedonia	319
DE	Germany	99	MT	Malta	327
DK	Denmark	111	NL	The Netherlands	337
EE	Estonia	127	NO	Norway	347
ES	Spain	139	PL	Poland	359
FI	Finland	153	PT	Portugal	371
FR	France	163	RO	Romania	379
GB	United Kingdom	175	RS	Serbia	393
GR	Greece	195	SE	Sweden	403
HR	Croatia	205	SI	Slovenia	415
HU	Hungary	219	SK	Slovakia	429
IE	Ireland	233	SM	San Marino	441
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## Monaco

### I Evidence

#### Title of the order

*Demande incidente de communication de pieces* (incidental request to disclose supporting evidence)

*Requête aux fins de compulsoire* (*ex parte* request to obtain disclosure of evidence out of trial)

*Assignment en référés* (summons to appear before the emergency judge)

#### Basic procedural framework

Where relevant evidence is controlled by the opposing party, the claimant may request three types of orders having a similar purpose to Art. 6.1 ED depending on whether proceedings on the merits are already pending and whether the proceedings are before civil or criminal courts.

Art. 6.1 ED refers exclusively to the case where a civil proceeding is already pending (Procedure A). For information purposes, two other relevant procedures in Monaco are described below.

#### Situation A: Pending civil proceedings on the merits against a party in possession of relevant evidence

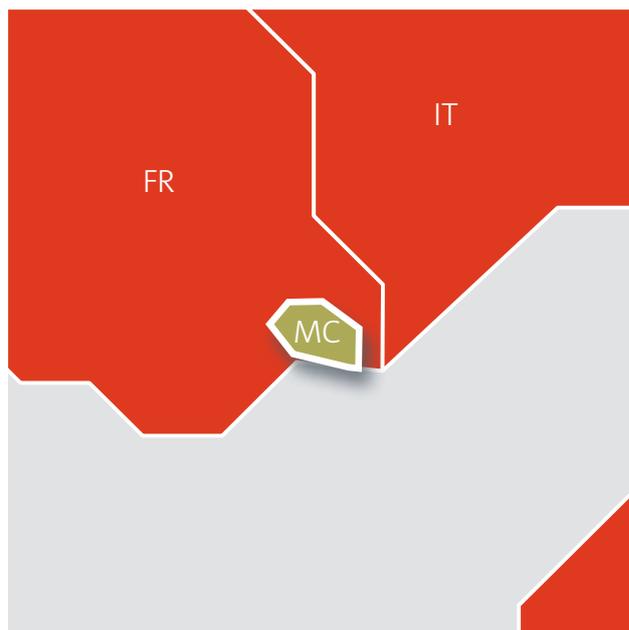
The Court of First Instance (*Tribunal de première instance*) and, as the case may be, the Court of Appeal (*Cour d'appel*) is the competent authority. A party may submit a request called *Demande incidente de communication de pièces* (Arts. 379, 380 and 381 Code of Civil Procedure, hereinafter "CCP") and ask the judge, before any decision on the merits, to render a decision ordering disclosure of the evidence (this decision is called *Jugement avant dire droit*).

Disclosure relies on the goodwill of the alleged infringer. It is not an execution order. Where the alleged infringer does not comply with the Court's decision, the claimant may lodge a request (*Requête*) with the President of the Court of First Instance to issue an order authorising the forced compliance of the decision (*Ordonnance sur requête*).

<sup>1</sup> Articles 414-421 CCP  
<sup>2</sup> Art. 851 CCP

General note: No specific Monegasque legal and/or regulatory provision has been passed or taken with the specific aim of implementing the ED or legislating for identical standards. However, references to the relevant articles of the ED are made where appropriate.

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The measure may be ordered in any civil *inter partes* proceedings including proceedings on the merits and also *inter partes* emergency proceedings for interim relief (*Référés*<sup>1</sup>).

The order may impose a financial penalty (*Astreinte*) set by the Court to compel the party in possession of relevant evidence to comply with the judgement.

#### Situation B: Absence of pending civil proceedings against the alleged infringer

The claimant may lodge a request (*Requête*<sup>2</sup>) with the President of the Court of First Instance to order the gathering of evidence under the control of the alleged infringer (*Ordonnance sur requête*).

Such *Requête* may be used either to obtain evidence as a preliminary measure before the claim on the merits or to enforce a court decision by requesting compliance with a measure, in the event that this was not requested and/or granted by the court in its decision.

Situation C: Pending criminal proceedings on the merits against an alleged infringer

Following a complaint accompanied by the lodging of an application for criminal indemnification (*Plainte avec constitution de partie civile*)<sup>3</sup> during the pre-trial phase, the investigating judge (*Juge d'instruction*) may take any measure deemed necessary for the determination of the truth.

The claimant may file a reasoned request to the investigating judge to order the presentation of a piece of evidence by the alleged infringer or to take any other measure that would have an equivalent effect, such as to allow a search the premises of the alleged infringer.

### Provision of evidence by third parties

The President of the Court of First Instance may pursuant to a request from a claimant (*Requête aux fins de compulsoire*) issue an order (*Ordonnance sur requête*) requesting a third party to disclose information and granting authorisation to a bailiff, appointed by the requesting party, to seize the evidence.<sup>4</sup>

### Assessment of evidence in support of the application

The claim is justified where there is clear evidence that the information is held by the alleged infringer or by a third party and that this information is necessary either to:

- a) found jurisdiction for a case on the merits, or
- b) to allow the requesting party to gather evidence before a trial on the merits, either against the infringing party (*Requête*) or a third party (*Requête aux fins de compulsoire*).

### Protection of confidential information

In Monaco, no specific measures are available to ensure the protection of confidential information.

The court will carry out a proportionality test in order to ascertain whether the order is justified and whether the right of the patent holder to be protected against

infringement has priority over the confidentiality of information of the other party.

### Non-compliance with an order

Any difficulty with the execution of a judicial decision may be brought before the President of the Court of First Instance in an accelerated proceedings (*Référé*).

This includes non-compliance with the abovementioned procedures A to C.

A specific provision enables such accelerated proceedings (*Référé difficulté d'exécution*, Art. 415 CCP). The corresponding provision with regard to a decision of the Court of Appeal is provided for in Art. 434 CCP. The President of the Court of Appeal may be requested in the context of the urgent *Référé* procedure to take enforcement measures.

In civil proceedings, there is no possibility of taking coercive measures. Recurring penalties are the usual sanctions. In criminal proceedings, the police and the judicial authorities, during the pre-trial and trial stages, have wider powers to impose coercive measures (custody, pre-trial custody, issue warrants, etc.).

### Appeal/review

#### Procedure A

Where civil proceedings on the merits are pending, the court may decide in a provisional judgment to grant an order to obtain evidence before any decision is rendered on the merits, or may render its decision on the merits including its decision to reject the request for the order.

In the first case, according to the established case law<sup>5</sup> and Arts. 301 and 423 CCP, the judgment of the Court is to be considered as strictly limited to the provisional measure. Only the final decision of the Court of First Instance, including the decision to grant an order and the decision to grant or refuse an order (i.e. the second case), may be appealed before the Court of Appeal.

An appeal must be lodged within 30 days after the judgment on the merits is served by the bailiff on the unsuccessful party.

<sup>3</sup> Pursuant to Arts. 47 and 48 of Law No. 606 on Patents and Arts. 74, 75, 82 et seq. Code of Criminal Procedure

<sup>4</sup> Article 851 CCP

<sup>5</sup> Court of Appeal, May 3<sup>rd</sup>, 1994 Société Général X Ray Company c/ Société Immobilière du Quai du Commerce

## Procedure B

Where there are no pending civil proceedings on the merits against the alleged infringer and the claimant files a request before the President of the Court of First Instance<sup>6</sup> there are two possible outcomes:

1. If the President of the Court of First Instance refuses to grant the requested order, the claimant may appeal the refusal to the Court of Appeal sitting “in Chamber”<sup>7</sup>. In this case, there is no provision stating a period for filing the appeal.
2. If the President of the Court of First Instance grants the requested order, the party against whom the order is made may appeal by requesting urgent interim relief (*Référé*) before the President of the Court of First Instance (i.e. if the President rendered the first decision he will delegate the hearing of the appeal to another judge):
  - (a) If a legal provision enables the appeal of the specific requested measure (i.e. this is not the case when the order required is to obtain the presentation of evidence by the presumed infringer). The period for filing the appeal is provided by the provision enabling the appeal of the requested order. The judicial authority to which the appeal shall be lodged will depend on the legal provision.

Or

- (b) If the order granted by the President of the Court of First Instance expressly allows an appeal,<sup>8</sup> the period for filing the appeal will be mentioned in the order. The appeal will be lodged as urgent interim relief (*Référé*) before the President of the Court of First Instance.

## Admissibility of evidence

Evidence obtained in criminal, administrative or other civil proceedings in Monaco is admissible in civil proceedings, as long as it has been legally obtained.

National courts may take into consideration any factual evidence offered, including evidence obtained in foreign proceedings. Such evidence will be admissible as fact only,

i.e. the national courts are not bound by the probative force given by the evidence by foreign law or foreign judicial authorities.

Monaco is part of the Convention of 5 October 1961 Abolishing the Requirement of Legalisation for Foreign Public Documents (known as the Apostille Convention) enabling the recognition of the origin of public documents obtained in another contracting country.

Since Monaco is not part of the EU, enforcement of EU court decisions is subject to *Exequatur* proceedings whose outcome can be the full retrial of the case on the merits. However, Monaco has signed judicial cooperation and assistance agreements with other countries such as France and Italy facilitating recognition of the validity judgments, orders or investigating measures and, as is the case for agreements signed with France, providing assistance to enforce foreign decisions in Monaco and vice-versa.

- Convention on mutual judicial assistance signed on 21 September 1949 between France and the Principality of Monaco implemented by ordinance No. 106 of 2 December 1949;
- Convention on mutual judicial assistance in criminal matters signed on 8 November 2005 implemented by Ordinance n° 1.828 of 18 September 2008;
- Convention on mutual judicial assistance signed on 20 July 1871 between Italy and the Principality of Monaco implemented by Ordinance of 24 January 1872.

## Legal basis and case law

Arts. 301, 379- 381, 414 – 421, 423, 434, 851 and 852 CCP  
Arts. 47 and 48 Law No. 606 on patents of 20 June 1955 (hereinafter “Law No. 606”)  
Arts. 74, 75, and 82 et seq. Code of Criminal Procedure

Court of Appeal, November the 6th 1990, *Société Générale c/ L., Mes R., A. et C.*

Court of Appeal, May the 3rd 1994 *Société Général X Ray Company c/ Société Immobilière du Quai du Commerce*

<sup>6</sup> “Requête” – Art. 851 CCP

<sup>7</sup> “Cour d’appel statuant en Chambre du conseil” – Court of Appeal, November 6<sup>th</sup> 1990, *Société Générale c/ L., Mes R., A. et C.*

<sup>8</sup> Art. 852 CCP

## II Measures for preserving evidence

### Title of the order

*Saisie-contrefaçon*

### Further available measures

None available.

### Basic procedural framework

The President of the Court of First Instance is competent to issue an order in separate *ex parte* proceedings before the proceedings on the merits have been initiated.

The procedure for requesting the measure (*Requête aux fins de saisie-contrefaçon*) is similar to the abovementioned “*Requête*” procedure to obtain an order from the President of the Court of first instance (See Part I, “Basic Procedural Framework, Procedure B”).

Once the President of the Court of First Instance grants the order (*Ordonnance aux fins de saisie-contrefaçon*), the requesting party must appoint a bailiff to enforce it.

The decision may include the nomination of an expert to assist the bailiff in describing the goods.

### *Ex parte* requests

Without judging on the merits, a *Saisie-contrefaçon* will be ordered if:

- a) There is clear evidence as to the claimant’s entitlement as the patent owner;
- b) The goods of the alleged infringer raise a clear likelihood of infringement. In practice, the required standard of proof is higher when the requested measure is a physical seizure of the goods; and
- c) Depending on the degree of the requested measure (description or physical seizure), the alleged infringing goods may cause irreparable harm to the right holder.

The risk of destruction of evidence is not considered in this context.

When the claim on the merits is filed, the defendant has the opportunity to challenge the measure.

### Protection available to defendant

In cases where the order issued by the President of the Court of First Instance is for physical seizure, the lodging of a security deposit may be required. A copy of the deed recording the lodge of security must be given to the defendant.

The amount of security is decided at the discretion of the President of the Court of First Instance.

### Period to initiate proceedings on the merits

The claimant is required to lodge a claim on the merits, within eight days from the day the measure was enforced, either before the civil or criminal courts. If the claimant fails to do so, the order is automatically considered null and void.

### Witness identity protection

During civil proceedings on the merits, the identity of witnesses is disclosed only to the parties. They are heard separately and the public is not allowed to attend the hearing.

The Court of First Instance may exceptionally request a party to leave the hearing room provided such party shall have access to the witnesses’ statements right after their deposition.

Any intervention from the parties is forbidden whilst the court conducts the hearing. Questions are formulated by the members of the court, including the public prosecutor if he is part of the procedure.

In patent infringement proceedings before the criminal court there is further protection for witness identities.

The judge in charge of investigating the case before it is referred to the court for decision, has the possibility to conceal the identity of a witness when:

- a) the hearing could imperil the life or the physical security of the witness, his family or close relatives; or
- b) the witness is a police agent or officer.

Anonymity is authorised by an order of the First President of the Court of Appeal, which order cannot be appealed.

## Non-compliance with an order

Non-compliance with an order may arise in two different situations:

1. The bailiff was not able to obtain access to the infringing goods:

This may be the case when e.g. the allegedly infringing goods were moved beforehand, the premises are closed, etc. The order granting access to the allegedly infringing goods to make a description or to seize them may also provide that the bailiff may execute the order with the assistance of police.

Any difficulty with the execution of the order may be brought before the President of the Court of First Instance in accelerated proceedings (*Référé* under Arts. 414-421 CCP). The President of the Court of First Instance is seized by the claimant filing a summons requesting the urgent execution of the order.

See also Part I, “Non-compliance with an order”.

2. The order granting access to the alleged infringing goods is implemented, but the alleged infringer misappropriates or destroys the goods or attempts to do so.

Misappropriation or destruction of goods subject to an order for seizure, or an attempt to do so, constitute criminal offences. The claimant may file a reasoned request to the investigating judge, to proceed with the execution of the order with the assistance of the police.

The claimant may also request a public prosecutor to bring a criminal claim against the alleged infringer. This claim would be separate from the claim for infringement. In such a case a civil judge must stay the proceedings pending a decision in the criminal proceedings.

The criminal sanctions are either:

- a) Imprisonment from six months to a maximum of five years and a fine amounting from EUR 9 000 to EUR 18 000 if the alleged infringer has custody of the infringing goods;

- b) Imprisonment between one and five years and penalty amounting from EUR 18 000 to EUR 90 000. This is decided at the discretion of the judge on a case-by-case basis.

## Appeal/review

Law No. 606 on patents does not provide a procedure under which the order may be appealed or reviewed and the available public case-law does not cover this question. However, the following procedures may be available:

If the President of the Court of First Instance refuses to grant the requested order, the claimant may appeal the refusal to the Court of Appeal sitting “in Chamber”<sup>9</sup>, a restricted composition of the Court of Appeal having specific competence, the hearings of which are not public.

If the President of the Court of First Instance grants the requested order, the defendant may attack the validity of the order before the Court judging on the merits since the claimant is obliged to bring a claim on the merits within eight days from the day the order was executed.

Consequently, only the final decision of the Court of First Instance, including the decision to grant an order and the decision on the merits, may be appealed before the Court of Appeal.

These procedures are in line with those described above at “Part I Evidence, Appeal/review, Procedure A”.

There is no specific provision on the period for filing a request for an appeal of the order, in case of refusal to grant the requested measure. Either the order specifies the period or the 30-day legal period applies.

Appeal of the decision granting the measure is to be filed within 30 days from the day the decision on the merits is served.

## Non-compliance with UPC-issued order

Not applicable as Monaco is not a signatory of the Agreement on the Unified Patent Court.

9 “Cour d’appel statuant en Chambre du conseil” – Court of Appeal, November 6th 1990, Société Générale c/ L., Mes R., A. et C.

## Legal basis and case law

*Saisie-contrefaçon*: Art. 50 et seq. Law No. 606  
Protection of witnesses: Art. 327 et seq. CCP  
Art. 147-1 et seq. Code of Criminal Procedure  
*Référé difficulté d'exécution*: Art. 415 CCP  
Misappropriation or destruction of goods under seizure:  
Art. 324 Criminal Code  
Pre-trial investigation measures: Arts. 74, 75, and 82 et seq.  
Code of Criminal Procedure

## III Right of information

### Title of the order

There is no specific procedure in Monegasque law foreseen for the provision of information by the alleged infringer and/or other involved parties. Ordinary civil or criminal procedures will apply.

### Basic procedural framework

Civil courts may take investigative measures (Articles 300 et seq. CCP) and perform all verifications deemed necessary (Article 309 et seq. CCP). They may call on the assistance of the public prosecutor to carry out these measures. However, civil courts have less investigative powers than criminal courts.

Criminal proceedings may include a pre-trial phase during which an investigating judge ("*Juge d'instruction*") is specifically appointed to take any measure deemed necessary to establish the facts, usually with the assistance of the police (Arts. 74, 75, and 82 et seq. Code of Criminal Procedure). The measures may be decided by the investigating judge or requested by the public prosecutor or the claimant.

## Legal basis and case law

Investigating measures and verifications before civil courts:  
Art. 300 et seq. CCP  
Art. 309 et seq. CCP  
Investigating measures during the criminal pre-trial phase:  
Arts. 74, 75, and 82 et seq. Code of Criminal Procedure

## IV Provisional and precautionary measures

### Title of the order

There is no specific national patent law provision on interlocutory injunctions. The Monegasque *Référé* procedure (Art. 414 et seq. CCP) may meet the objective of the interlocutory injunction as defined by Article 9.1 ED.

Art. 50 et seq. Law No. 606 provides for precautionary seizures in a patent context (see also Part II "Measures for preserving evidence", *Saisie contrefaçon* above).

### Basic procedural framework

The President of the Court of First Instance is competent to issue such orders.

Interlocutory injunctions may be issued in the framework of the *Référé* procedure which is an *inter partes* procedure. The orders may be issued in separate proceedings before the proceedings on the merits have been initiated. The claimant may appoint a bailiff who will enforce the measures.

In the case of precautionary seizures (*Saisie-contrefaçon*), a claim on the merits must be filed within eight days from execution of the order (see Part II "Measures on preserving evidence", *Saisie contrefaçon*).

### Factors considered by the court

In interlocutory injunction (*Référé*) proceedings, two main conditions that the judge is legally required to take into account are:

- (a) urgency of the situation;
- (b) that the order the judge may issue as *référé* shall be of a provisional nature and shall not have irremediable effects on the merits.

For precautionary seizures, see Part II "*Ex parte* requests".

### Recurring penalty payments

In interlocutory injunction (*Référé*) proceedings, an order for penalty payments may only be issued if the judge is able to assess the likelihood of a finding of infringement during subsequent proceedings on merits, including during urgent matters proceedings such as the *Référé* procedure.

There is no separate procedure to request an order for recurring penalty payments if infringement continues following the grant of the interlocutory injunction and penalty payments were not requested in the original writ.

Recurring penalty payments would only apply in cases of non-compliance with an order for precautionary seizure, since such order is requested in preliminary proceedings where infringement is not yet established.

In determining the amount of the penalty payments, there is no provision specifying a method to determine the amount, but two key factors are considered:

- a) damage allegedly suffered by the claimant;
- b) the amount deemed sufficient to deter the defendant from continuing the patent infringement.

### Provisional and precautionary measures against intermediaries

With regard to evidence under the control of a third party, where there is no pending civil procedure on the merits, the President of the Court of First Instance may pursuant to a request from a party (*Requête aux fins de compulsoire*) issue an order (*Ordonnance sur requête*) requesting a third party to disclose information and granting authorisation to ask a bailiff, appointed by the requesting party, to seize the evidence<sup>10</sup> (see also Part I Evidence, “Provision of evidence by third parties”).

### Circumstances justifying an order for precautionary seizure

See above Part II, “*Ex parte* requests”.

### Assessment of required evidence

There is no provision in the law providing guidance for assessing the evidence required for the granting of these orders. Case-law is also scarce. There are no practical examples illustrating what constitutes, “reasonably available evidence” capable of satisfying the competent authority with a “sufficient degree of certainty” both as referred to in Art. 9.3 ED in the context of patent infringement.

### Conditions justifying *ex parte* order

See Part II “*Ex parte* requests”.

### Protections available to the defendant

Protections for the defendant ordered by the court will depend on the damage that the defendant could suffer from the order.

Where the measure involves a physical seizure of goods, the amount of security lodged will generally be calculated on the basis of the total value of the seized goods.

Where the order authorises the bailiff to deliver a report describing the goods, the judge will in practice, not request the lodging of a security if no damage may be suffered by the defendant.

In both cases (seizure and description) the calculation is based upon the actual damage likely to be suffered. For instance, the damage suffered from the revenue shortfall may be calculated on the basis of the net loss of income or the loss of gross profits, if the defendant is able to substantiate the loss he is likely to incur.

Pursuant to Art. 51 Law No. 606, if the order is considered null and void because the claimant did not file an action on the merits within eight days from the day the order was executed, compensation is not “automatically” granted to the defendant. The defendant will have to file a claim before the Court of First Instance.

### Non-compliance with an order

See Part I “Non-compliance with an order”. For non-compliance of precautionary seizures (*Saisie contrefaçon*), see Part II “Non-compliance with an order”.

### Appeal/review

The order taken by the *Juge des référés* for an interlocutory injunction may be appealed before the Court of Appeal within 15 days after either the judgment or the notification of the judgment to the defendant was delivered.

<sup>10</sup> Art. 851 CCP

Neither the legislation (Law No. 606) nor case law provides any provision or guidance as to whether an order for precautionary seizure may be appealed or reviewed. See Part II “Appeal/review” for appeal procedures that are arguably available.

### Non-compliance with UPC-issued order

Not applicable as Monaco is not a signatory of the Agreement on the Unified Patent Court.

### Legal basis and case law

*Saisie-contrefaçon*: Art. 50 et seq. Law No. 606

*Référé*: Art. 414 et seq. CCP

*Référé difficulté d'exécution*: Art. 415 CCP

Misappropriation or destruction of goods under seizure: Art. 324 Criminal Code

*Indisponibilité temporaire*: Arts. 487, 488 and 489 CCP

## V Corrective measures

### Title of the order

*Confiscation* (definitive removal).

### Other available measures in Monaco

None.

### Basic procedural framework

Art. 52 Law No. 606 provides for this measure which has equivalent effect to the definitive removal from the channels of commerce (as referred to in Art. 10.1 ED). Where the court has decided in favour of the claimant and, in a criminal case, even if the defendant is acquitted but the infringement is established, the infringing goods are confiscated from the defendant, and third parties such as distributors. This shall be done at the expense of the defendant. The “*confiscation*” measure is not an option but an automatic measure once infringement is established.

During first instance proceedings the competent authorities would be the Court of First Instance or the Criminal Court (*Tribunal correctionnel*) in a criminal complaint and would involve the public prosecutor. The Court of Appeal would be the competent second instance in both civil and criminal proceedings.

The order is issued in the main proceedings on the merits. A bailiff appointed by the claimant will enforce the order and draw up a certified report of its execution.

### Assessment of proportionality for ordering remedies

The law does not provide guidance as to the factors that the court must consider when issuing the order. However in practice, it must strike a balance between the benefit of such measure for the claimant and the detriment to the defendant, and the interests of third parties involved. In such case, objective evidence must be considered such as the number of infringing goods on the market.

Another factor is the existence of precautionary measures such as earlier physical seizure of infringing goods and the number of goods remaining after the seizure.

### Evidence of destruction

Destruction is not provided for in Monaco in patent cases.

### Non-compliance with an order

In case of non-compliance with an order for *confiscation*, the claimant may:

- (a) seize the President of the Court of First Instance in an accelerated proceedings (*Référé*, Arts. 414-421 CCP); and/or
- (b) file a criminal complaint.

For more detail, see Part II “Non-compliance with an order”.

### Appeal/review

The entire decision on the merits rendered by the Court of First Instance, rather than only an individual measure, must be appealed before the Court of Appeal by serving a writ on the other party to appear before the Court of Appeal. The writ must contain:

- a) a summons to appear before the Court of Appeal on the date set out in the writ;
- b) the statement of objections; and
- c) the appointment of a lawyer.

The appeal must be submitted to the clerk of the Court of Appeal within 30 days from the day the decision of the Court of First Instance was served.

### Non-compliance with UPC-issued order

Not applicable as Monaco is not a signatory of the Agreement on the Unified Patent Court.

### Legal basis and case law

Art. 52 Law No. 606

## VI Injunctions

### Title of the order

*Astreinte* (permanent injunction)

### Basic procedural framework

An injunction order may be issued as part of the decision on the merits.

As an exception to the above, when seized because of a difficulty in enforcing a decision on the merits, the President of the Court of Appeal may not issue an *astreinte* order<sup>11</sup>.

Once a court grants an *astreinte*, the requesting party must appoint a bailiff to enforce it.

### Injunctions against intermediaries

An *astreinte* order may only be issued against intermediaries when intermediaries are part of the proceedings as defendants.

### Compulsory licence as a defence

It is possible to bring forward arguments justifying the grant of a compulsory licence as a defence in infringement proceedings.

### Court's discretion if finding of infringement

Upon establishing infringement, the court has a discretion whether or not to grant an injunction. Any relevant factors or matters highlighting the risk of future infringement and the necessity to force the defendant to comply with the judgment are taken into account by the court.

### Non-compliance with an order

See Part I "Non-compliance with an order".

### Appeal/review

See Part V "Appeal/review".

### Non-compliance with UPC-issued order

Not applicable as Monaco is not a signatory of the Agreement on the Unified Patent Court.

### Legal basis and case law

*Juge des référés*: Article 421 CCP  
Court of Review, November, 28<sup>th</sup>, 2013, SAM SAMEGI c/ L'Etat de Monaco

## VII Alternative measures

There is no provision in the national law enabling a judicial authority to choose alternative measures as referred to in Art. 12 ED.

## VIII Damages

### Calculation methods available in Monaco

See below.

### Basic procedural framework

The determination of the amount of damages is part of the main patent infringement proceedings on the merits.

<sup>11</sup> Court of Review, November 28<sup>th</sup>, 2013, SAM SAMEGI c/ L'Etat de Monaco

## Methods of calculation

There is no legal or regulatory provision specifying different calculation methods or authorising the simultaneous use of the methods referred to in Art. 13 ED.

The claimant shall provide evidence of all the damage suffered. All aspects of the damage may be taken into account, such as loss of profits, undue profits of the defendant, costs resulting from the infringement (e.g. disruption to the claimant's business, the need to find new partners, etc.).

Depending on the level of detail of the alleged damage, the court will either respond specifically to each head of claim or, as happens most frequently, set a lump sum based on the aforementioned aspects.

## Evidence of lack of knowledge

There is no provision in Monegasque legislation which would allow the court a discretion to not order damages where the defendant did not knowingly engage in the infringing activity.

## Non-compliance with an order

Where there is non-compliance with the order for damages, the claimant may submit a written request (*Requête*) to the President of the Court of First Instance in order to obtain an execution order authorising the right holder to collect the damages awarded on the merits by implementing execution measures such as seizing the defendant's assets.

Recurring penalty payments may be ordered.

## Appeal/review

See Part V "Appeal/review".

## Non-compliance with UPC-issued order

Not applicable as Monaco is not a signatory of the Agreement on the Unified Patent Court.

## Legal basis and case law

Appeal: Arts. 422 et seq. and 156 CCP  
Damages: Art. 50 et seq. Law No. 606

## IX Legal costs

### Overview of assessment of costs

There is no provision of national law providing guidance to the meaning of "reasonable and proportionate" as referred to in Art. 14 ED.

In Monaco, recoverable costs and expenses are set out in Art. 231 et seq. CCP and are called *dépens*. *Dépens* are assessed according to rules taking into account a minimal amount for each type of costs multiplied by a ratio. For claims amounting to less than EUR 7 600, a fixed rate will apply. If the claim amounts to more than EUR 7 600, various proportional rates may apply, the highest being 0.4% of the amount of the claim, where said claim exceeds EUR 23 000.

The *dépens* include:

- (a) stamp and registration fees;
- (b) cost of procedural acts;
- (c) cost of serving a decision;
- (d) costs of experts;
- (e) travel costs (under certain conditions).

There are national rules governing minimum costs of assistance of attorneys.

Costs are decided in the main infringement action.

### Legal basis and case law

Art. 231 et seq. CCP

## X Publication of judicial decisions

### Title of the order

*Publication des décisions de justice*

### Basic procedural framework

The Court may alternatively or cumulatively order the following measures:

- (a) Public display of the decision in a place decided by the Court;

- (b) Publication of a decision in the Monaco Official Gazette; (*Plainte avec constitution de partie civile* – Arts. 47 and 48 Law No. 606, Arts. 74, 75, and 82 et seq. of the Code of criminal procedure).
- (c) Publication of a decision in other newspapers.

The full judgment or extracts, depending on the media in which it is published may be required. The judicial authority that rendered the decision on the merits is competent to issue the order.

There is no case law available that explains the factors to be taken into consideration when issuing such order.

### Non-compliance with an order

The measure is not to be executed by the media designated by the successful party, and the expense of publication must be borne by the unsuccessful party.

Non-compliance would mean with the obligation to pay the expenses of publication is procedurally considered the same as non-payment of damages (see Part VIII “Non-compliance with an order”).

### Appeal/review

See Part V “Appeal/review”.

### Non-compliance with UPC-issued order

Not applicable as Monaco is not a signatory of the Agreement on the Unified Patent Court.

### Legal basis and case law

Art. 52 Law No. 606

## XI Other appropriate sanctions

### Name and type of sanctions

Criminal proceedings are available. Along with civil proceedings, the claimant may file a separate criminal complaint with an application to join the proceedings as a civil party claiming damages before the public prosecutor

Since patent infringement is also a criminal offence, the following criminal sentences may be ordered by the Criminal Court following a criminal proceeding:

- (a) for a single criminal offence: a penalty from 24 000 francs<sup>12</sup> up to 180 000 francs;
- (b) where there is recurring infringement: the same penalty plus an imprisonment between one and six months.

### Non-compliance with an order

The competent judicial authority is the Court of First Instance judging on civil matters. The claimant may seize the Court of First Instance by lodging a request (*Requête*) to authorise the forced execution of the court decision.

Imprisonment (*Contrainte par corps*) may be ordered to ensure the implementation of a decision. Imprisonment may be up to 18 months where the party was ordered to pay more than EUR 18 000 in damages.

### Appeal/review

See Part VI “Appeal/review”.

Where the convicted party is imprisoned, the party may request a review of the measure before the President of the Court of First Instance in the context of an urgent *Référé* procedure (Arts. 414-421 CCP).

### Legal basis and case law

Art. 44 et seq. Law No. 606  
 Art. 600 et seq. Code of Criminal Procedure  
 Art. 47 and 48 Law No. 606  
 Arts. 74, 75, and 82 et seq. Code of Criminal Procedure

<sup>12</sup> Art. 44 Law No. 606 sets out the amounts for penalty payments in “francs” and have not been converted into Euros. There is no publicly available case law on which we can rely to amend and insert the corresponding amounts in Euros. If any judicial authority was to apply these provisions, the penalty would be converted in euros taking into consideration the value of the currency at the time of the changeover.

## XII Additional options

### Other available options in Monaco

In addition to the possibility to lodge a civil action and/or to prosecute an alleged infringer by initiating a criminal action before competent Monaco authorities (Court of First Instance or General Prosecutor), infringements to Monegasque laws may be established and pursued by the French customs authorities, by virtue of Article 11 of the Mutual Customs Agreement between France and Monaco dated 18 May 1963, establishing a customs union between France and Monaco and their territorial waters.