

## Question Q236

**National Group:** The Netherlands

**Title:** Relief in IP proceedings other than injunctions or damages

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## Questions

The Groups are invited to answer the following questions under their national laws.

### I. Analysis of current law and case law

1) What forms of Additional Relief are available in IP proceedings?

In The Netherlands, an IPR holder can claim any form of Additional Relief. There is no exhaustive list of available relief and there are no other limitations by law. The Dutch Code of Civil Procedure does not exhaustively list remedies available, nor does it entail specific limitations to what an IPR holder can or cannot claim as a remedy: in brief, anything goes provided that the plaintiff has a legitimate interest and a basis in law and in fact in having the specific remedy sought granted.

Annexure B1 lists the availability of the specific Additional Reliefs indicated by AIPPI. Annexure B2 lists a selection of Additional reliefs available in The Netherlands that is discussed in Question 3.

2) Are those forms of Additional Relief available for all types of IPRs? If not, please indicate what types of Additional Relief are available for what types of IPRs.

Yes, all forms of Additional Relief are available for all types of IPRs. Confidential information /trade secrets are not considered to be IP-rights. However, most forms of Additional Relief are available in proceedings where such information and secrets are enforced, excluding the full cost award.

- 3) Having regard to the types of Additional Relief available addressed by questions 1 and 2, what are the criteria for the grant of that relief?

Generally, the courts will sustain the relief as claimed by the IPR holder, provided that the IPR holder has a legitimate interest and the relief claimed is proportional considering the circumstances of the case.

There may be different criteria for the different types of Additional Relief identified. Hence, the Groups are asked to address the individual criteria for each type of Additional Relief that is available in IP proceedings in their country.

Annexure B2 lists a selection of Additional reliefs available in The Netherlands that is discussed below.

#### I. Declaratory relief

Section 3:302 Dutch Civil Code (declaratory judgment) stipulates that upon a legal claim of a person who is immediately involved in a specific legal relationship, the court may give a declaratory decision about this legal relationship. A claim based on a wrongful act (which includes IP infringements) may serve to obtain a declaratory judgment to the effect that the challenged practice of the defendant constitutes infringement of the plaintiff's IPR, or vice versa, that the plaintiff's practice does not constitute infringement of the defendant's IPR.

In the Netherlands, declaratory relief can only be obtained upon the request of a party and only in proceedings on the merits. It is not possible to obtain a declaratory judgment in summary or interim proceedings. For obtaining a declaratory judgment of (non-)infringement, the interested party only needs to show that he has a reasonable legitimate interest. One can not apply to courts for academic or purely ideological disputes. For example, when it comes to a mere hypothetical activity, the Dutch patent courts are not willing to render a declaratory judgment.

#### II. Delivery up / destruction

##### *General*

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) allows for delivery up and destruction of goods.

Pursuant to Article 10 (corrective measures) of the Enforcement Directive, without prejudice to any damages due to the right holder by reason of the infringement, and without compensation of any sort, Member States shall ensure that the competent judicial authorities may order, at the request of the applicant, that appropriate measures be taken with regard to goods that they have found to be infringing an IPR and, in appropriate cases, with regard to

materials and implements principally used in the creation or manufacture of those goods.

Such measures shall include: (a) recall from the channels of commerce; (b) definitive removal from the channels of commerce; or (c) destruction. Further to Section 10(2) of the Directive, the judicial authorities shall order that those measures be carried out at the expense of the infringer, unless particular reasons are invoked for not doing so.

Furthermore, according to the Section 10(3), in considering a request for corrective measures, the need for proportionality between the seriousness of the infringement and the remedies ordered as well as the interests of third parties shall be taken into account.

Article 10 of the Enforcement Directive was implemented in the various Dutch IP laws mentioned below and the Dutch Courts will thus (have to) take into account the aforementioned general criteria for the grant of relief for delivery up/destruction etc.

<b>IPR Right</b>	<b>Relevant article</b>
<b>Patents</b>	<b>70(7) Patent Act</b>
<b>Trademarks</b>	<b>2.21(3) BCIP</b>
<b>Copyrights</b>	<b>28(1) Copyright Act</b>
<b>Designs</b>	<b>3.17(3) BCIP</b>
<b>Databases</b>	<b>5c(1) Databases Act</b>
<b>Semiconductors / integrated circuit topography</b>	<b>18(1) Topography Act</b>
<b>Neighbouring rights</b>	<b>17(1) Neighbouring Rights Act</b>
<b>Geographical indications</b>	<b>Art. 13a (8) AQA</b>

***Patent (NL, EP, SPC)***

Pursuant to Article 70(7) of the Dutch Patent Act (DPA), in case of infringement of its patent, the patent holder is authorized to claim the ownership of any moveable property that infringes his right or to claim the power to remove such property from the market, to destroy it or to render it unusable, and to demand that materials and machines that are used primarily in the production of those goods be removed from the market. A claim within the meaning of the first sentence shall be executed at the expense of the defendant unless that is barred for special reasons.

The abovementioned type of Additional Relief is also available in the event of infringement of EPs and SPCs.

***Trademark (BX, CTM)***

Pursuant to Article 2.21(3) of the Benelux Convention on Intellectual Property (BCIP), by way of compensation a Court may order the surrender of the goods that infringe a trademark right to the trademark owner and, where appropriate, of the materials and tools primarily used in the production of those goods. The Court can order that the surrender will only take place in exchange for compensation to be stipulated by the Court and paid by the plaintiff. Given that

the BCIP stipulates that this involves ‘an action for compensation’ the requirements needed to claim compensation will apply here as well. The rule that the Court can order surrender in exchange for compensation enables the Court – as the occasion arises – to prevent the plaintiff from benefiting unfairly<sup>1</sup>.

Pursuant to Article 2.22(1) BCIP (which implements Article 46 TRIPs and Article 10 of the Enforcement Directive), at the request of the trade mark owner, in case of infringement the Court can order a recall from the market, definitive removal from circulation, or destruction of infringing goods and, where appropriate, of the materials and tools primarily used in the production of those goods. In principle, all of this if for the expense of the infringer and in any event without any compensation of any kind. The abovementioned types of Additional Relief are also available in the event of infringement of CTMs.

### *Copyright*

Further to Article 28 (1) of the Dutch Copyright Act (which implements Article 10 of the Enforcement Directive), the infringement of a copyright shall entitle the right holder to claim as his property any goods that are not filed in the public records and which have been communicated to the public in violation of copyright or are unauthorized reproductions, or to apply for the infringing goods to be removed from circulation, destroyed or rendered useless. The right holder may bring a claim for the handing over of the said goods so that they can be destroyed or rendered useless. The same right to claim goods exists:

- a. with respect to entrance money paid by persons attending a recitation, performance, exhibition or presentation which infringes copyright;
- b. with respect to other monies that may be assumed to have been obtained by or as a result of an infringement of copyright.

The same right to apply for the destruction or rendering unusable of goods applies to goods that are not filed in the public records and which have been used to effect an infringement of copyright. The right holder may apply for the handing over of the said goods so that they can be destroyed or rendered unusable.

### *Design (BX, CDR, Unreg. DR)*

Pursuant to Section 3.17(3) BCIP (which implements Article 46 TRIPs and Article 10 of the Enforcement Directive), by way of compensation a Court may order the surrender of the goods that infringe a design right to the design right owner and, where appropriate, demand that materials and machines that are used primarily in the production of those goods be removed from the market. The Court can order that the surrender will only take place in exchange for compensation to be stipulated by the Court and paid by the plaintiff. Given that the BCIP stipulates that this involves ‘an action for compensation’ the requirements needed to claim compensation will apply here as well. The rule that the Court can order surrender in exchange for compensation enables the Court – as the occasion arises – to prevent the plaintiff from benefiting unfairly<sup>2</sup>. The abovementioned type of Additional Relief is also available in the event of infringement of CDRs and unregistered CDRs.

### *Database*

Pursuant to Article 5c of the Dutch Database Act (which implements Article 10(1) of the Enforcement Directive), in the event of infringement, the producer

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<sup>1</sup> European Trademark Law, Cohen Jehoram, p. 397, 398.

<sup>2</sup> European Trademark Law, Cohen Jehoram, p. 397.

of the database may claim the ownership, removal from the market, destruction or to render unusable (part of) the database and also of the materials, products and parts used to facilitate the circumvention of the technical protection of the database.

#### *Topographies*

Pursuant to Article 18 of the Original Topographies of Semiconductor Products Act (which implements Article 10 of the Enforcement Directive), in case of infringement, the right holder may claim the ownership, removal from the market, destruction or render unusable the infringing items of the topography or semiconductor and also of the materials used to produce said items.

#### *Neighbouring rights*

Pursuant to Article 17 of the Neighbouring Rights Act (NRA), in case of infringement the right holder may claim as his property any recordings or reproductions thereof communicated to the public in violation of its rights and any unauthorized reproductions, or to apply for them to be destroyed or rendered useless. The same entitlement shall apply to goods that are not filed in the public records, and which have directly served to manufacture the recordings or reproductions referred to in the first sentence.

Similar entitlement to claim ownership or to apply for surrender for destruction or rendering useless shall exist in relation to equipment, products and components as specified in Article 19 NRA and reproductions as specified in Article 19a NRA, not being property subject to registration.

Furthermore, a right exists to claim monies that may be assumed to have been obtained by or as a result of an infringement of the Neighbouring rights as stipulated in Articles 2, 6, 7a and 8 NRA).

#### *Geographical indications / designations of origin*

Pursuant to Art. 13a(8) Agricultural Quality Act (AQA) delivery up or destruction of goods may be ordered.

#### *Confidential information / trade secrets*

There is no specific legal basis for a recall order and/or order for destruction, but a confidential information/trade secrets holder may e.g. request this as a form of alternative damages (see below). If the unfair trade practice results from a breach of a (confidentiality) obligation, it may also be that the agreement itself provides for this relief.

### III. Rectification

Pursuant to Article 6:167 (rectification) of the Dutch Civil Code, when someone is liable towards another person because of an incorrect or, by its incompleteness, misleading publication of information of factual nature, the court may, upon a right of action (legal claim) of this other person, order the publication of a correction in a way to be determined by the court. This Article also applies to orders in IP cases to correct an error in a register or in a document. For Geographical indications / designations of origin, rectification is addressed in Art. 13a(12) Agricultural Quality Act.

#### IV. Alteration of infringing goods

##### *General*

Pursuant to Article 10 (corrective measures) of the Enforcement Directive, Member States shall ensure that the competent judicial authorities may order, at the request of the applicant, that appropriate measures be taken with regard to goods that they have found to be infringing an IPR and, in appropriate cases, with regard to materials and implements principally used in the creation or manufacture of those goods.

In art. 10(1) under a)-c) the Enforcement Directive provides a non-exhaustive list of such corrective measures and therefore under the Enforcement Directive an order to the alteration of the infringing goods is formally not excluded. However, in the implementation of the Enforcement Directive in the various Dutch IP laws, this form of relief has not explicitly been made available.

##### *Patent (NL/EP/ SPC)*

Reference is made to the remarks under the heading 'general'. Furthermore, in view of the patentee's right under art. 70(7) of the Dutch Patents Act to claim tangible goods that infringe upon his right as his property or their destruction, an order that the infringing products are to be altered does not seem an obvious alternative.

##### *Trademark (BX and CTM)*

Reference is made to the remarks under the heading 'general'. There has been one case in which a defendant active in the field of revising certain trademarked products was ordered to remove the original trademark after revision as the revision had altered the condition of the product.

#### V. Modification of technology

Reference is made to the remark above on general availability by the fact that the Enforcement Directive provides a non/exhaustive list of measures and the modification of technology is not excluded. No cases are known to us in which such a claim was awarded.

#### VI. Corrective advertising

##### *General*

Under case law in the Netherlands, it is possible to claim a recall and it is quite common for the Court to award claims for a recall to be performed via letters to be sent by the infringer to its customers. The text of the recall letter is generally included verbatim in the order and non-compliance with sending the letter in the exact wording of the Court is usually sanctioned by a penalty sum. Other forms of corrective advertising in the form of a statement regarding the outcome of court proceedings are also possible, such as a rectification or notice of the court order and/or injunction in magazines or newspapers.

##### *Geographical indications / designations of origin*

Pursuant to Art. 13a(12) Agricultural Quality Act (AQA) corrective advertising may be ordered

### ***Confidential information / trade secrets***

Subject to the terms and limitations that apply to corrective advertising in general, an unfair trade practitioner can be ordered to e.g. notify its customers of the fact that he was held by the Dutch Court to have committed an unlawful act or to have breached a (confidentiality) agreement.

## **VII. Publication of judgment**

### ***General***

Under article 121 of the Constitution of the Netherlands, decisions are public, although the published version of a decision is usually anonymized under the Act on the protection of personal data. Also under article 15 of the Enforcement Directive, member states are to create the possibility for rights holders to claim the publication of a decision. The publication of a court order has been ordered in the past, but since the 1970s this court order has practically been replaced by the recall order.

### ***Patent (NL/EP/ SPC)***

Reference is made to the remarks under the heading 'general' and in addition art. 70(12) of the Dutch Patents Act implicitly provides for a provision regarding the publication of the judgment.

### ***Copyright***

Reference is made to the remarks under the heading 'general' and in addition art. 28(10) of the Dutch Copyright Act implicitly provides for a provision regarding the publication of the judgment.

### ***Database***

Reference is made to the remarks under the heading 'general' and in addition art. 5e of the Dutch Database Act implicitly provides for a provision regarding the publication of the judgment.

### ***Neighbouring rights***

Reference is made to the remarks under the heading 'general' and in addition art. 18a of the Neighbouring Rights Act implicitly provides for a provision regarding the publication of the judgment.

### ***Geographical indications / designations of origin***

Pursuant to Art. 13a(12) Agricultural Quality Act (AQA) corrective advertising may be ordered.

### ***Confidential information / trade secrets***

Reference is made to the remarks under the heading 'general'.

## **VIII. Order for inspection**

In the Netherlands, an order for inspection is available as a remedy both as a final measure and as an interim measure, in the latter case either provisionally in the context of proceedings on the merits, in interim relief

proceedings or in ex parte proceedings aimed especially at seizure of materials for evidence preservation purposes. This general rule equally applies to claims for an order for inspection. There are no limitations either in statute or in case law as to the allowability of this type of remedy in proceedings on the merits.

In furtherance of articles 6 and 7 of the Enforcement Directive (2004/48/EC), specific rules as to the seizure or capturing of evidence in relation to IP infringement in any form, for evidence preservation purposes, are contained in articles 1019b-d of the Dutch Code of Civil Procedure. These provisions explicitly mention the possibility to obtain a ‘detailed description’ or to ‘obtain samples’ of allegedly infringing goods, etc., but these remedies are not exhaustive. Orders for the purpose of capturing evidence in virtually any other form sought are equally allowable in principle. Access to such evidence for the IPR holder is not automatic, but subject to a specific disclosure order ensuing from separate further proceedings. It is noteworthy that these remedies are usually granted ex parte, but equally available as provisional or final remedies in inter partes proceedings on the merits. Finally, leave for seizure of evidence is also routinely granted outside of the scope of IP-right infringement, such as in the context of misuse of confidential information / trade secrets.

#### IX. Order to provide information

Orders to provide information about manufacturers, suppliers, customers or other entities in the supply or distribution chain, product and stock information, as well as on any other aspect of the (scope, nature, duration) of the infringement and the parties involved, have been a staple part of the IP holders' tool box for decades in the Netherlands. In addition to the general discretionary power of Dutch courts to grant such orders under the main rules described above, an explicit legal basis for this remedy in relation to various individual IP rights is provided in the applicable statutes:

<u>IPR Right</u>	<u>Relevant article</u>
Patents	70(10) Patent Act
Trademarks	2.22(4) BCIP
Copyrights	28(9) Copyright Act
Designs	3.18(4) BCIP
Databases	5c(5) Databases Act
Semiconductors / integrated circuit topography	18(8) Topography Act
Neighbouring rights	17(6) Neighbouring Rights Act
Geographical indications	Art. 13a AQA jo. Section 15 DCCP

Dutch Courts routinely award orders to provide information in cases that infringement has been found. The extent of the order is usually limited only to take into account the defendants' legitimate interest, if any, in keeping confidential sensitive business information, which are to be balanced against the interests of plaintiff in such disclosure. In general, acting of bad faith on the infringers' side is not a requirement for the obligation to provide information.

## X. Surrender of profits

In the Netherlands, IPR holders in proceedings on the merits can choose whether to claim damages or to have the defendants ordered to surrender profits made with their infringing activities. These are alternative and mutually exclusive remedies: accumulation of surrender of profits and compensation of damages for IP infringement is not possible. Note that the election of surrender of profits for IP infringement does not necessarily preclude a claim for damages on different grounds claimed in the same action. Obviously, other remedies (such as injunctive relief) also remain available without limitation. The possibility to claim surrender of profits is not only enshrined in article 6:104 of the Dutch Civil Code, but also provided in relation to various individual IP rights specifically the applicable statutes:

<u>IPR Right</u>	<u>Relevant article</u>
Patents	70(5) Patents Act
Trademarks	2.21(4) BCIP
Copyrights	27a Copyright Act
Designs	3.17(4) BCIP
Databases	5d(1) Databases Act
Semiconductors / integrated circuit topography	17(4) Topography Act
Neighbouring rights	16(2) Neighbouring Rights Act
Geographical indications	Art. 13a(6) AQA

## XI. Account of profits

In order to facilitate effective surrender of profits, or the election to claim so, IPR holders in the Netherlands have traditionally had recourse to the remedy of claiming a full account of the profits that were made as a result of the infringement, in whatever form desired by the plaintiff (usually: certified by an independent auditor). This remedy is based on the same statutory provisions as outlined above for surrender of profits. Dutch Courts routinely award such claims in cases that infringement has been found. As with the order to provide information, the extent of the order may take into account the defendants' interest in keeping confidential sensitive business information. A standard way to take such interests into account in practice is to order full disclosure to an independent third party, such as an independent accountant, who will then provide a report.

## XII. Reasonable royalty

Pursuant to article 6:97 of the Dutch Civil Code, Courts are held to assess the damages in the most appropriate manner in relation to the nature of the damages suffered. Reasonable royalties are one of the tools available to the Dutch Courts to assess such damages. In this respect, the reasonable royalties remedy hence is a measure of damages rather than a separate form of relief in the Netherlands. There are no general rules of thumb as to calculation of reasonable royalties, although for specific sets of circumstances rules have crystallized out in case law. A statutory basis for an order to pay reasonable royalties in relation to various individual IP rights specifically is found in the applicable statutes:

<u>IPR Right</u>	<u>Relevant article</u>
Patents	70(5) Patent Act
Trademarks	2.21(2)b BCIP
Copyrights	27(2) and 27a Copyright Act
Designs	3.17(b) BCIP
Databases	5d(2) Databases Act
Semiconductors / integrated circuit topography	17(4) Topography Act
Neighbouring rights	16(1) Neighbouring Rights Act

### XIII. Reparation

In principle, damages are to be compensated in monetary form. However, article 6:103 Dutch Civil Code provides that Dutch Courts at the demand of the person suffering the loss (i.e. IPR holder), may equally award compensation in any other form deemed appropriate to either limit, redress or repair damages. This kind of alternative compensation may for example be embodied as a moratorium. The infringer or unfair trade practitioner can be ordered to suspend its activities for a period of time equal to the time which was unfairly gained as a result of the infringement, or the misuse of the confidential information / trade secrets. In this way, the illegitimate "head start" is repaired.

### XIV. Order for costs

Article 14 of the Enforcement Directive (2004/48/EC) has been implemented in article 1019h Dutch Civil Code of Procedure. Henceforth, the parties can seek an order for full costs in all cases regarding the enforcement of IP rights. The interpretation of this provision has been the subject of a vast body of case law, relating firstly to the *scope* of its application. This scope is very broad. Even after the Bericap decision of the ECJ (C-180/11), full costs continue to be awarded in nullity proceedings, in any event where they are conducted as a defense against an infringement action or to pre-empt such action. Secondly, the nature of the costs that can be claimed has been subject of discussion. Also here, the position is a broad one. Not only legal costs may be claimed, but also all other costs in relation to the litigation. Finally the amount of costs which can be deemed reasonable and proportional is considered by the Dutch Courts. In practice, parties usually agree on amounts that they consider to be reasonable for the case at hand, which is then adopted without scrutiny by the Court. In patent cases, full cost reimbursement is the general rule. For other cases, a protocol of indicative rates in first instance cases has been made available, providing guidance on the assessment of reasonable legal costs in practice. While not binding, the Courts generally use these tariffs as a yardstick. As confidential information /trade secrets are not considered to be IP-rights, full costs are not available in proceedings where such information and secrets are enforced.

## XV. Penalty

In general, injunctions in the Netherlands are backed by a directly enforceable penalty sum payable to the party who has been awarded the injunction, subject only to limited conditions pursuant to article 611a Dutch Civil Code of Procedure.

- 4) Is there any element of judicial discretion in relation to the grant of any form of Additional Relief addressed in questions 1 and 2? If so, how is that discretion applied?

**The Dutch Courts have full discretion in relation to the grant of any form of Additional Relief. In considering a request for Additional Relief, the Court will make a balance between the interest of the IPR holder and the interest of the defendant (and insofar as applicable of non-parties as well, see Q 9) and will take into account the need for proportionality between the seriousness of the infringement and the remedies claimed.**

- 5) Are any particular forms of Additional Relief invariably ordered in certain circumstances? If so, what types of Additional Relief and in what circumstances? Does that occur pursuant to mandatory statutory regulation, or by reason of the practice of the relevant court (or applicable administrative body)?

**No, generally the Courts will sustain the Additional Relief claimed by the IPR holder only if the IPR holder has a legitimate interest and the relief claimed is proportional considering the circumstances of the case. The Additional Relief orders given by the Court depend fully on the claims of the plaintiff and will thus vary depending on the circumstances of the case at hand. Only the fortification of injunctions with penalty sums, albeit sometimes mitigated or capped, is virtually almost ordered when claimed. Orders for costs, provided that they are timely claimed and appropriately substantiated, are usually awarded against the party losing the litigation.**

- 6) Are there any specific considerations relevant to particular IPR holders? If so, what considerations are relevant and in respect of what IPR holders?

**No, there are no specific considerations relevant to particular IPR holders. All identified Additional Reliefs are available irrespective of the identity, activities, nature or location of the IPR holder concerned.**

- 7) Can a court (or applicable administrative body) order any form of Additional Relief directly against a non-party to an IP proceeding?

**No. The Dutch Courts may not make any orders against non-parties to legal proceedings. If an IPR holder wishes to obtain an order against a party that performs infringing activities or contributes thereto (for example Internet Service Providers), it will have to involve such a party in legal proceedings.**

- 8) If yes to question 7:

**N.A.**

a) in what circumstances;

b) what forms of Additional Relief may be ordered; and

c) in respect of what types of IPR infringement?

- 9) Is a court (or applicable administrative body), in making an order for Additional Relief against an IPR infringer who is a party to the IP proceeding, obliged to consider the impact of such order on any non-party?

**Yes. In general, the Court will consider the impact of any order given by the Court. In its assessment if the IPR holder has an interest in obtaining Additional Relief claimed and if such Additional Relief is proportional given the circumstances of a particular case, the Court shall take into account the interest of third parties that will be affected by such Additional Relief.**

If so, how does the court (or applicable administrative body) fulfil that obligation?

**This is fulfilled on the own motion of the Court, as part of the considerations for judgment. If the Court is of the opinion that the Additional Relief as claimed is disproportional or the interest of a third party should prevail, it may reject the claim for Additional Relief or limit the scope thereof.**

- 10) If yes to question 7 or 9, is the court (or applicable administrative body) obliged to give any relevant non-party an opportunity to be heard?

**No.**

If so, how is that effected?

**N.A.**

## **II. Proposals for harmonisation**

Groups are invited to put forward proposals for the adoption of harmonised rules in relation to Additional Relief in IP proceedings. More specifically, the Groups are invited to answer the following questions:

- 11) What forms of Additional Relief should be available in IP proceedings, and for what types of IPRs?

**See annexure B3.**

- 12) What should the criteria be for the grant of the types of Additional Relief identified in response to question 11?

**It should be possible for any IPR holder to claim any form of Additional Relief. The courts should sustain the relief as claimed by the IPR holder if the IPR holder has a legitimate interest and if the relief claimed is proportional considering the circumstances of the case.**

- 13) Should there be any specific considerations relevant to particular IPR holders? If so, what should those considerations be and in respect of which IPR holders?

**No. All IPR holders should be treated equally.**

- 14) Should any particular form of Additional Relief be mandatory in certain circumstances? If so, what types of Additional Relief and in what circumstances?

**The courts should have full discretion in relation to the grant of Additional Relief and should not be limited in any way. In deciding whether a claim should be awarded, the court should balance the interests of the parties and assess the proportionality of the remedy, taking into account all circumstances of the case at hand.**

- 15) Should a court (or applicable administrative body) be empowered to order any form of Additional Relief directly against a non-party to an IP proceeding?

**No, it would be contrary to the European Convention of the Human rights as such non-parties would not be able to defend against such an order.**

- 16) If yes, to question 15:

**N.A.**

- a) in what circumstances;  
b) what forms of Additional Relief should a court (or applicable administrative body) be empowered to order; and  
c) in respect of what types of IPR infringement?

- 17) Should a court (or applicable administrative body), in making an order against an IPR infringer who is a party to the proceeding, be obliged to consider the impact of such order on any non-party?

**Yes, because third parties do not have any form of redress at the court as they are not a party. Any provisions that would impact third parties should be tested for their proportionality.**

Yes, If yes, how should the court (or applicable administrative body) fulfil that obligation?

**This may be fulfilled on the own motion of the court, as part of the considerations for judgment.**

- 18) If yes to question 15 or 17, should the court (or applicable administrative body) be obliged to give any relevant non-party an opportunity to be heard?

**No, in IP cases there are often impacts on third parties, and giving these parties an opportunity to be heard would potentially overcomplicate the enforcement of IP rights. Rather, the judgment should ensure that impacts on third parties are commensurate.**

If so, how should that be effected?

**N.A.**

- 19) Please provide any other proposals in respect of harmonisation as to the types of Additional Relief that should be available in IP proceedings and the conditions in which such relief should be ordered.

**We propose further harmonisation on use of evidence collected in a first jurisdiction in court proceedings in a second jurisdiction. Such evidence**

may for example have been collected during procedures for discovery of evidence.

In that perspective, we also propose harmonisation on client-attorney privileges with respect to exchange of information and legal advice in particular.

In the field of costs awards under Article 14 of the Enforcement Directive (2004/48/EC), we propose that a protocol be made to harmonize the implementation of litigation cost recovery in the various European countries. Such protocol should also harmonize the cost recovery that shall be available for litigation of the various types of the various IP rights.

## ANNEXURE B

Relief	Patent	Trademark	Copyright	Design	Confidential information/ trade secrets	[Other see Annexure B2]
Declaratory relief	y	y	y	y	y	Y
Delivery up/ destruction	Y	y	y	y	y	y
Rectification	y	y	y	y	y	Y
Alteration of infringing goods	Y	y	y	y	y	y
Modification of technology	y	N/A	y <sup>1</sup>	N/A	y	Y
Corrective advertising	Y	y	y	y	y	y
Publication of judgment	y	y	y	y	y	Y
Order for inspection *	Y	y	y	y	y	y
Order to provide information	y	y	y	y	y	Y
Account of profits *	Y	y	y	y	y	y
Reasonable royalty *	y	y	y	y	y	Y
Reparation	y	y	y	y	y	y
<b>[Other: see annexure B2]</b>	y	y	y	y	y	Y

\* Please see paragraphs 31), 33) and 34) of these Working Guidelines and observe the note under question 2 in Part I of the Questions.

<sup>1</sup> This may be applicable in case of software





Recall from market	<input type="radio"/>								
Expert hearings	<input type="radio"/>								
Witness hearings	<input type="radio"/>								

\* Please see paragraphs 31), 33) and 34) of these Working Guidelines and observe the note under question 2 in Part I of the Questions.

1) This may be applicable in case of software

2) semiconductor topography relates to the lay-out of a circuit, not to the underlying technology

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<sup>i</sup> Article 39 par (1) and par (2) of TRIPS imposes upon the treaty states the obligation to prevent that know-how (defined as "undisclosed information" which is "secret") is obtained by third parties as a result of an unfair trade practice. In the Dutch legal framework, confidential information/trade secrets are not considered to be intellectual property rights. As a result, the holder of confidential information/trade secrets cannot profit (directly) from the enforcement tools which are provided to IP-right holders in the Dutch Code of Civil Procedure following the Enforcement Directive. Protection and enforcement of confidential information/trade secrets can be obtained on the basis of the general law of unlawful act ("onrechtmatige daadsrecht"), and the law of agreements ("contractenrecht").

<sup>ii</sup> According to Article 13a of the Dutch Agricultural Quality Act (*Landbouwkwaliteitswet*), the holder of a geographical indication or designation of origin, may enforce its right against any one who performs the acts as described in Article 13 of Regulation 1151/2012. In fact, the Agricultural Quality Act still refers to Regulation (EU) 510/2006 of 20 March 2006 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs. However, Regulation (EU) No 1151/2012 of 21 November 2012 on quality schemes for agricultural products and foodstuffs repealing and replacing Council Regulation (EC) No 510/2006 entered into force on 3 January 2013. According to the Interlocutory Judge of the District Court The Hague also other geographical indications and designations of origin (i.e. those not falling under Regulation 1151/2012) could be perceived as intellectual property rights and (thus) fall within the scope of the Enforcement Directive (Interlocutory Judge of the District Court The Hague, 8 October 2010, CIVC v Unilever, *Champagne*). This was based on Article 1(2) jo. 22 and 23 TRIPS. National law should thus be interpreted in conformity with the Enforcement Directive. Also, holders of a geographical indication may fall back on general provisions regarding tort, and request measures based on (for instance) misleading advertising.





Recall from market	<input type="radio"/>								
Expert hearings	<input type="radio"/>								
Witness hearings	<input type="radio"/>								

\* Please see paragraphs 31), 33) and 34) of these Working Guidelines and observe the note under question 2 in Part I of the Questions.

1) This may be applicable in case of software

2) semiconductor topography relates to the lay-out of a circuit, not to the underlying technology

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<sup>i</sup> Article 39 par (1) and par (2) of TRIPS imposes upon the treaty states the obligation to prevent that know-how (defined as "undisclosed information" which is "secret") is obtained by third parties as a result of an unfair trade practice. In the Dutch legal framework, confidential information/trade secrets are not considered to be intellectual property rights. As a result, the holder of confidential information/trade secrets cannot profit (directly) from the enforcement tools which are provided to IP-right holders in the Dutch Code of Civil Procedure following the Enforcement Directive. Protection and enforcement of confidential information/trade secrets can be obtained on the basis of the general law of unlawful act ("onrechtmatige daadsrecht"), and the law of agreements ("contractenrecht").

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