



# ASSESSMENT OF DAMAGE TO INTELLECTUAL PROPERTY: A VIEW FROM THE COLOMBIAN LEGAL SYSTEM

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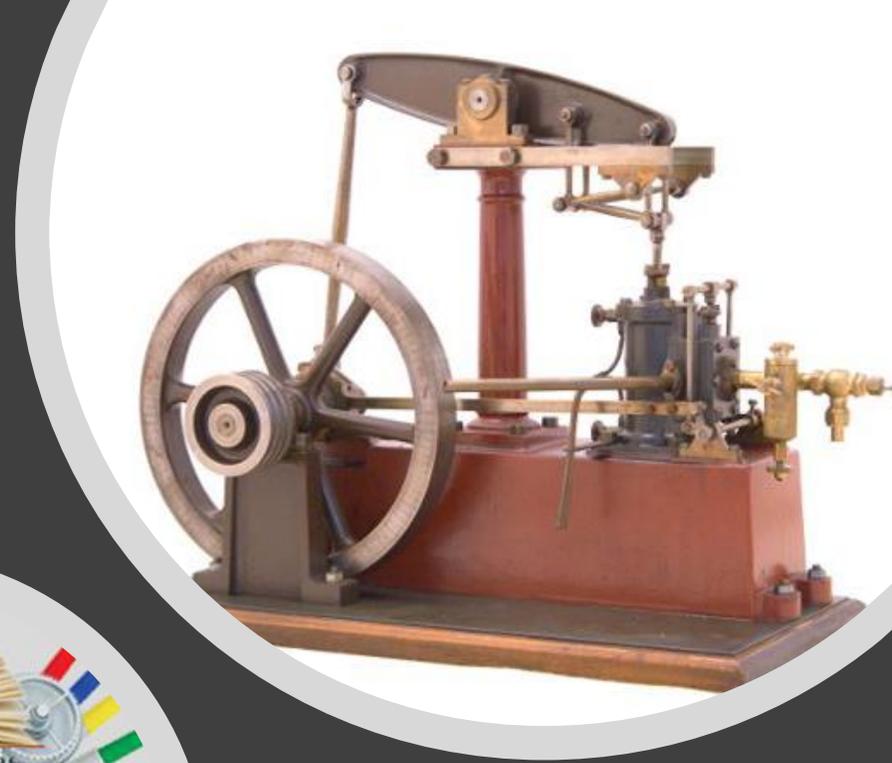
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GOBIERNO DE COLOMBIA

Intangible assets, including those that are protected under intellectual property (IP) laws, have significant value in the economy since they are crucial not only for companies but also for public and private entities whose activities are, to a certain degree, founded on the exploitation of IPRs.





The intangible nature of IP assets makes particularly difficult to determine their value when it comes to compensation for the damage caused in particular by IP infringement.

This is mainly because intangible assets, such as trademarks, patents and copyright-protected works have no intrinsic value; they derive their value from the frequency and success with which they are exploited in the market.



A comprehensive and effective IPR protection and enforcement cannot be limited to developing mechanisms that prevent or stop infringing actions. Rather, they should include *inter alia* mechanisms, which ensure that right holders receive effective reparations for injuries resulting from acts that infringe their exclusive IPRs.



WORLD TRADE  
ORGANIZATION

# Article 45 - Damages (TRIPS)

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

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

## CIVIL LIABILITY IN THE COLOMBIAN LEGAL SYSTEM - CONCEPT

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The concept of civil liability in the Colombian Civil Code is derived from the principle that each person shall be liable to repair the harm he or she causes to another person. In other words, civil liability generally presupposes the existence of a relationship between two individuals, namely one who causes the harm and another who suffers it. The legal consequence is an obligation on the part of the perpetrator to repair the harm caused.



## Extra-contractual civil liability

Extra-contractual civil liability, which arises from the violation of a subjective right where there is no contractual relationship and which would typically apply to an IPR infringement, is established by three cumulative elements under Colombian law, namely:

- ✓ An intentional act or negligence that causes a damage.
- ✓ The damage or the prejudice.
- ✓ The existence of a causal link between the damage and the act in question.



## DAMAGE

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The damage is defined as the violation or impairment of a legally protected interest or of a person's subjective rights, such as IPRs.

Traditionally the damage was defined as a violation or impairment of the patrimony or property of a person.



## INTENTIONAL ACT OR NEGLIGENCE

This concept refers to the fact that the damage must arise from the infringer's behavior or action that is reprehensible either because it is intended to cause harm or because it falls short of the due diligence, based on the way an average person would act (i.e., how a person would normally act with a certain degree of prudence and diligence).

## CAUSAL LINK



There must be a causal link between the act and the damage caused, namely the damage must result from an act that constitutes the cause of the violation or infringement of the victim's legitimate interest or subjective right.



The great difficulty in intellectual property is to prove the amount of the damage resulting of an infraction.

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Special regulation related to reparations for injuries resulting from an infraction of IPR.



# SPECIAL CRITERIA ESTABLISHED FOR INDUSTRIAL PROPERTY STANDARDS

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Andean Community Decision No. 486 of 2000,  
article 243:

*“(a) the actual damage and the loss of revenue suffered by the owner of the rights as the result of the infringement;*

*(b) the amount of the profits earned by the infringer as a result of the infringing acts;*

*(c) the price that the infringer would have paid for a contractual license, due regard being had to the market value of the infringed rights and to contractual licenses that have already been granted”.*





## THE SYSTEM OF PRE-ESTABLISHED DAMAGES IN THE AREA OF TRADEMARKS

The Trade Promotion Agreement between Colombia and the United States establishes that in civil judicial proceedings, each state party shall, *“at least with respect to infringement concerning copyright or related rights and trademark counterfeiting, establish or maintain pre-established damages, which shall be available on the election of the right holder as an alternative to actual damages”*.



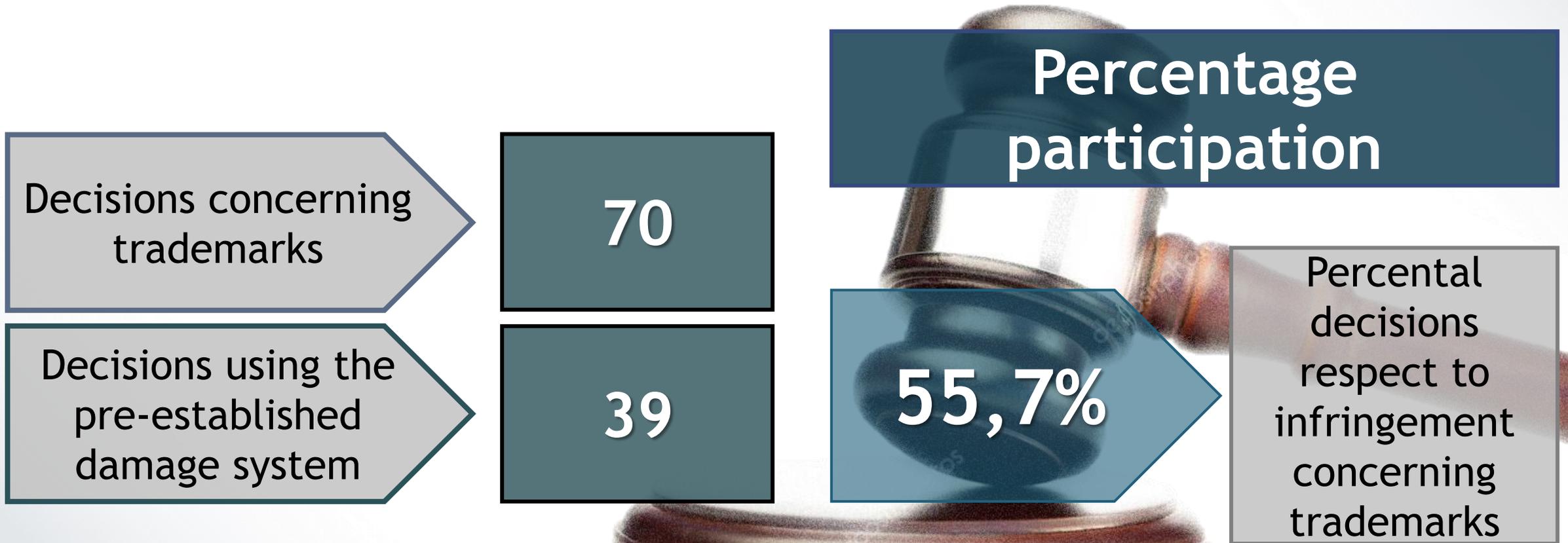
## **Law 1648 of 2013 and Decree No. 2264 of 2014.**

The damages shall range from a “minimum of three (3) times up to a maximum of one hundred (100) times the minimum statutory monthly wage at prevailing rates, for each trademark infringement. This amount may increase to two hundred (200) times the minimum statutory monthly wage at prevailing rates if the infringed trademark has been declared a well-known trademark by the judge; the malicious intent of the infringer has been established; the life or health of persons has been put at risk and/or it is established that the trademark infringement is a repeat offence”.

# Features of the pre-established damages system

- 1 It is an alternative system.
- 2 The owner of IPR has not to prove the amount of the damage.
- 3 Currently is only for trademark infractions.

# IP Pre-established damage system data



From January 2015 to August 2018

# SPECIAL CRITERIA FOR COPYRIGHT

In the area of copyright, Andean Community Decision No. 351 of 1993 does not establish special criteria to guide the judge in establishing the amount of damages arising from the infringement of copyright or related rights.





Law No. 44 of 1993 provides that the following criteria shall be taken into account when assessing the material damage resulting from an infringing act:

- “1. the market value of the copies produced or reproduced without authorization;*
- 2. the amount that the right holder would have charged if he had authorized exploitation;*
- 3. the period during which the unlawful exploitation took place”.*

## The Colombian legal system



Lastly, it is worth mentioning that recently was approved in Colombia a copyright's bill that set up a system of pre-established damages (Law 1915 of 2018).

This Law must be regulated later by the national government.



**Industria y Comercio**  

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**SUPERINTENDENCIA**

*Valoramos lo que tú valoras.*

# Calculation of Damages in the Case of Infringement of Intellectual Property

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This paper was submitted to the thirteenth session of the WIPO Advisory Committee on Enforcement / Geneva, September 2018.

# Civil Liability

- Civil Liability is generally defined as the obligation to repair the damage caused to another person. It can be divided into two types of liability: (a) contractual liability, which results from a breach of contract; and (b) tort liability. The situation differs whether the infringer is bound by a contractual obligation to the right holder of intellectual property rights (IPRs) (in general), or to the right holder of a copyright or trademark (specifically), or in the case of committing an act which infringes upon such rights without being bound by any contractual obligations.

# Civil Liability

- Whatever the case may be, liability is founded on (i) an infringing act or a contract breach, (ii) actual damage and (iii) the causation principle between (i) and (ii). In other words, for the plaintiff to recover damages, the damage must result from the act of infringement or breach of contract.

# Basis for Calculating Damages

- The TRIPS Agreement does not provide for mechanisms or baselines to calculate damages. Instead, Member States shall confer powers on their judicial authorities for those subject-matters which may give rise to damages claims, on the understanding that damages awarded should be proportionate to the damage suffered by the right holder and may include, as appropriate, the payment of the plaintiff's legal expenses and attorney fees.

# Basis for Calculating Damages in Accordance with National Legislation

- The Jordanian IP laws do not specify eligibility requirements to claim damages nor a basis for the calculation thereof, except for the Jordanian Copyright Protection Law, which specifies some factors to guide the calculation of damages for infringement of protected works. Consequently, reference should be made to the provisions of the latter Law, as well as those under the Jordanian Civil Code governing tort liability.

The general rules governing tort liability are as follows:

- “Every injurious act shall render the person who commits it liable for damages even if he is a non-discerning person”, as a general principle.
- Under the Jordanian Civil Code, liability may arise by direct action or causation. Direct action implies liability regardless of whether the act was willful or not; whereas recovery of damages which are caused indirectly requires proof of willfulness.
- Proportionate liability may be applied in cases involving multiple tort-feasors if their respective “contributions” can be established. Otherwise, courts may choose to apply equal or joint.
- Types of damage: material and moral.

# Material Damage

- Material damage: damage resulting in an economic loss. Article 266 of the Jordanian Civil Code provides that the amount of compensation awarded thereon is determined by the “actual losses” and the “loss of profits” suffered by the plaintiff as a result of a wrongful act. In other words, it aims to compensate the plaintiff for their losses, which in turn need to be established and evaluated.
- Compensation, in any form, is calculated on the basis of the direct damage caused by the infringing act, whether this damage is material or moral, foreseeable or unexpected, current or future provided they are imminent. The assessment of direct damage implicates two essential elements: (i) actual losses and (ii) loss of profits.

# Moral Damage

- Moral Damage: damage resulting from the injury to an individual's social status. Article 267(1) of the Jordanian Civil Code provides that a party is liable for the damage caused for any damage to the liberty, honor, reputation, or social or financial status of another party.

# Basis for Calculating Damages for the Proprietor of a Trademark

- In principle, any damage suffered by a trademark proprietor is a material damage. According to Article 266 of the Jordanian Civil Code, material damage is defined as “the actual losses and loss of profits” suffered by the plaintiff. Therefore, in order for a court to award the appropriate compensation, a trademark owner will have to produce the necessary legal evidence of such damage and a valuation thereof. In cases of industrial property right infringements, there are no claims for moral damage, since any prejudice to a trademark’s reputation will lead to a loss in the market value of the trademark and a decrease in sales. This will in turn lead to a loss of profits for the owner of the trademark, which is considered as a material damage.

- According to Article 266 of the Jordanian Civil Code, the calculation of damages is based on:
  1. The actual damage, *i.e.*, the damage or loss effectively sustained by the right holder of a trademark as a result of an infringing act; and
  2. The loss of profits resulting from the infringing act.

- In several decisions, the Jordanian courts have applied the above-mentioned principles by determining the actual damage and loss of profits suffered by a plaintiff as a result of the infringing act, invoking the following rationale:
  - Proof of infringement does not imply proof of damage.
  - For determining and evaluating the damages and evidence produced, the Court considered in its reasoning, the following elements:

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1. The market value of the trademark;
    - Expert entities specialized in evaluating IP rights, including trademarks, can be mandated to assess the value of the damage suffered by the trademark owner as well as the impact of the infringement on the trademark's value in the market.

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2. Damage resulting from loss of profits;
    - The profits of the trademark owner can be assessed by reference to the plaintiff's audited financial statements before and after the infringement act. This is used to determine the damage resulting from the loss of profits.

### 3. Sales decrease;

- The decrease must be established by the plaintiff by showing (a) a likelihood of confusion between the plaintiff's and defendant's trademarks; and (b) that the latter is using the trademark to mislead the public by creating the belief that it is a branch or agent of the plaintiff so as to divert sales from the plaintiff to the defendant.
- For example, the Court awarded JOD 25,474 in damages to a plaintiff, as he was able to prove that the defendant had infringed upon his well-known trademark "AL sultan Charcoal". The plaintiff was also able to establish the subsequent decrease in sales in 2013-2014 during which period the defendant's counterfeit products had entered the market.

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4. Expenses incurred for trademark protection, such as attorney fees;
    - The Court did not award compensation for attorney fees in a case where the plaintiff did not produce evidence of the expenses incurred to prevent the defendant from registering a similar trademark, despite the plaintiff's having been successful in legal proceedings before the Registrar and Administrative Court where the plaintiff had filed an objection.

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5. Advertising and publicity expenses incurred by the plaintiff and the defendant's unlawful free riding thereon;
- For example, the Court decided to award JOD 17,361 to the plaintiff as compensation for advertising expenses related to products bearing the trademark “KOSMODISK” in the press, medical journals and on TV, as well as for the expenses incurred in publishing flyers, brochures, leaflets, bags, promotional materials and in participating in exhibitions.

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6. Office and storage costs as well as employees' remuneration;
- The Court did not take into account these expenses for the calculation of damages, as they are operational costs incurred independently of any infringing act.

# Basis for Calculating Damages for the Holder of a Copyright or Related Right

- As defined under Articles 8 and 9 of the Jordanian Copyright Protection Law, copyright and related rights are economic and moral rights which may be subject to infringement and may give rise to a claim for damages. This implies the need to determine the nature of the infringed right and the possible damage (material or moral) suffered by the right holder.
- Although proceedings relating to damages claims are governed by the Jordanian Civil Code, Article 49 of the Copyright Protection Law additionally requires that compensation must be fair and provides for additional principles when calculating damages suffered by the right holder, as follows:

1. The author's cultural status;
  - The status of an author who has won awards for scientific, cultural or literary achievement is taken into account when assessing compensation for the material damage, including the benefits that the infringer unlawfully gained as a result of their infringement, which also represents a loss of profits for the author. The author's status is also an important element that experts take into account in assessing the moral damage where an author's moral rights are infringed.

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2. The value of a literary, scientific or artistic work;
    - The value of an award-winning work, which is highly rated, widely viewed or considered to be influential in its domain, shall be taken into account when assessing compensation for material and moral damage.

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3. The market value of an original work;
    - In assessing the calculation of damages, this value underpins the plaintiff's loss of profits as well as the profits gained by the defendant. However, the full work's market value is not considered as a whole loss of profits since it also includes production costs incurred by both the plaintiff and defendant in calculating, respectively, their loss of profits and gained profits.

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4. The extent to which the infringer benefited from the exploitation of the work;
    - For this purpose, the plaintiff must establish the following:
      - I. Quantity of works affected by copyright and related rights infringement;
      - II. Market share lost by the plaintiff due to such infringement; and
      - III. Loss of profits for the plaintiff due to such loss of market share.

- For instance, the Jordanian Court of Cassation decided in one case that the plaintiff had suffered a material damage as a consequence of the defendant's exploitation of the plaintiff's work – an audio recording of the Quran – by way of unlawfully distributing 55,000 copies of the CD while the plaintiff was selling each copy for one Jordanian dinar with a margin of profit of 35 piasters.

## Calculation of moral damages under Articles 8 and 23 of the Copyright Protection Law:

- Every author enjoys moral rights in their work that are, by nature, inalienable, perpetual and to which the statute of limitations does not apply. Generally, works are understood to be an extension of the author's personality rights and, thus, any adaptation, modification or alteration to a work, without the consent of its author, is considered an infringement of the author's moral rights, for which the author may, consequently, claim damages. In Jordan, the amount of moral damages awarded is generally left to the discretion of the judiciary since setting an absolute amount would be incompatible with the nature of such damage.

- Therefore, the expert will assess the reasonable amount of damages to be awarded on a case-by-case basis in light of the evidence produced by the plaintiff and taking into account the principles established under Article 49 of the Jordanian Copyright Protection Law, as referred to above.

- For instance, the Jordanian Court of Cassation considered, in one case, that the addition of words and phrases and their attribution to the plaintiff without the plaintiff's knowledge and prior consent gave rise to a valid cause of action for damages. In its reasoning, the Court considered that moral rights were independent from the author's economic rights and that they were non-transferable.

- Therefore, although the plaintiff had concluded a contract with the defendant to prepare a scientific study in Jordan, such an agreement did not give the defendant the right to reuse the material of the plaintiff's work without the latter's authorization or to prevent the plaintiff from objecting to any distortion, mutilation or other modification of, or other derogatory action in relation to his / her work, which would be prejudicial to his / her honor or reputation.

## Whether it would be possible to calculate damages for IPR infringement based on the values of the license agreements

- The value of a license agreement can be used as a basis for the calculation of damages. The loss of future income from a license agreement that has been terminated as a result of the infringement could, subject to the judge's discretion, be treated as a measure of the plaintiff's loss of profits. Thus, the present value of the license agreement would constitute a base for calculating damages, provided it is registered with regard to all industrial property rights, including trademarks. A license agreement is enforceable against third parties only from the date of its registration. As for Copyright and Related Rights, such contracts must be set out in writing.

- A judge will not simply presume the existence of such agreement, as under the Jordanian legal system the plaintiff has the burden of producing evidence of damage and proving its amount. However, the value of license agreements covering the same IP rights, offered or negotiated prior to the infringement, may be used as guidance for the calculation of damages.

- The compensation to which the plaintiff is entitled shall include the following:
  1. court fees incurred by the plaintiff;
  2. expenses incurred by the plaintiff during the proceedings, such as experts' fees, witnesses' expenses and costs for the seizure of infringing goods;
  3. attorney fees, which are estimated by the Court. They are in no event less than five percent of the award and may reach the maximum of one thousand Jordanian dinars at the trial stage before the Court of First Instance. They do not exceed half the attorney's fees estimated at the first instance when the case is before the Court of Appeal; and
  4. legal interest rate of nine percent per annum on the total award. This is regarded as pre-established damages, which is calculated from the date of institution of proceedings until the date of payment by the defendant.

# Conclusion

- The Jordanian legal system provides for compensation for both material and moral damage. Material damage is determined by the actual losses and loss of profits suffered by the plaintiff. Under this system, courts may neither apply general rules of equity and fairness when calculating damages nor award punitive damages. Regarding moral damage, the plaintiff must produce evidence of damage and an expert valuation thereof. Furthermore, the amount of damages awarded neither depends on the nature of the infringing act nor the willfulness of the infringer's actions but it is determined by the actual damage and loss of profits suffered by the plaintiff, if such damage was a natural consequence of the infringing act. Finally, courts may award compensation equal to the value of a license agreement if the plaintiff can prove the merits of the claim.

**Thank you!**



المملكة المغربية  
محكمة الاستئناف التجارية  
بالدار البيضاء

# التعويض عن الضرر في دعاوى

## التزيف

من اعداد :

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الرئيس الأول لمحكمة الاستئناف التجارية

بالدار البيضاء

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# مقدمة

فعل التزييف هو اعتداء على حق من حقوق الملكية الفكرية يتسبب في ضرر لمالك العلامة ويوجب التعويض

## الاطار القانوني العام للتعويض في القانون المغربي :

- **الفصل 77 :** « كل فعل ارتكبه الإنسان عن بينة واختيار، ومن غير أن يسمح له به القانون، فأحدث ضررا ماديا أو معنويا للغير، ألزم مرتكبه بتعويض هذا الضرر »
- **الفصل 78 :** « كل شخص مسؤول عن الضرر المعنوي أو المادي الذي أحدثه، لا بفعله فقط ولكن بخطئه أيضا »
- **الفصل 98 :** « الضرر في الجرائم وأشباه الجرائم، هو الخسارة التي لحقت المدعي فعلا والمصروفات الضرورية التي اضطر أو سيضطر إلى إنفاقها لإصلاح نتائج الفعل الذي ارتكب إضرارا به، وكذلك ما حرم منه من نفع في دائرة الحدود العادية لنتائج هذا الفعل. ويجب على المحكمة أن تقدر الأضرار بكيفية مختلفة حسبما تكون ناتجة عن خطأ المدين أو عن تدليس »

إذن الحق في التعويض يرتكز على وجود خرق التزام قانوني وتحقق الضرر ووجود علاقة سببية بينهما.

## الاطار القانوني للتعويض في دعاوى التزييف

- ❑ قانون 23 يونيو 1916 السابق ← تضمن عقوبات مالية زهيدة
- ❑ ثم بعده قانون 17-97 ← جمع بين الحق في المطالبة بالتعويض الكامل أو المطالبة بالتعويض المسبق المحدد سلفا من المشرع
- ❑ ثم عدل بالقانونين رقم 23-13 و 31-05 ← ليرفع مبلغ التعويض المنصوص عليه بالمادة 224 من قانون 17-97 كما يلي :
  - رفع الحد الأدنى للتعويض من 5000 الى 50000 درهم (من حوالي 500 دولار الى 5000 دولار )
  - و رفع الحد الأقصى من 25000 درهم الى 500000 درهم (من حوالي 2500 دولار الى 50000 دولار )
- ❑ امكانية الاختيار بين التعويض عن الاضرار الفعلية بالإضافة الى الارباح او التعويض عن الاضرار المحددة اعلاه حسب ما تعتبره المحكمة عادلا لجبر الضرر
- ❑ تطابق قانون حماية الملكية الصناعية المغربي مع المعايير و المعاهدات الدولية المتعلقة بالملكية الفكرية.

# الأساس القانوني لتقدير التعويض

□ المادة 224 من قانون 97-17 (قاعدة استثنائية في مجال التعويض) : مالك العلامة عند تقديم الدعوى يملك إما :

■ الحق في الاختيار بين التقدير القضائي للتعويض الكامل عن الضرر الذي أصابه جراء فعل التزييف ← حيث يتم تطبيق القواعد العامة مع إثبات الخسارة و الربح الضائع لفعل التزييف.

■ او المطالبة بالتقدير القانوني للتعويض عن التزييف ← تعويض جزافي عن ضرر مفترض عند تعذر الاثبات :

□ حيث جاء في القرار رقم 3280 بتاريخ 31-05-2017 ملف رقم 1845-8211-2017 صادر عن

محكمة الاستئناف التجارية بالدار البيضاء : «ما تمسك به الطاعن من كون المحكمة لم تبين حجم الضرر والخسارة والمصروفات الضرورية التي اضطر أو سيضطر مالك العلامة إلى إنفاقها لإصلاح نتائج الفعل ، يبقى غير جدير بالاعتبار لأن هذا التعويض هو تعويض مفترض وجزافي لا يشترط للحكم به إثبات المدعي لحجم الضرر الذي أصابه لذا يتعين رده وتأييد الحكم. »

# سلطة القاضي في تقدير التعويض

□ حرية القاضي في تكوين قناعته في تقدير التعويض انطلاقا من وثائق وملابسات القضية

□ لكن مع ضرورة تعليل الوسائل المعتمدة في تحديد مبلغ التعويض، و امكانية الاستعانة بالخبراء في المسائل الفنية

▪ جاء في قرار لمحكمة النقض المغربية بتاريخ 20 نونبر 1985 تحت عدد 2749 في الملف رقم 27390/81 : «يقدر التعويض على أساس ما لحق بالمتضرر من خسارة وما فاتته من كسب وعلى المحكمة أن تبرز ما اعتمده منها في تقدير التعويض، حتى تمكن محكمة النقض من بسط رقابتها بشأن حقيقة الضرر الذي لحق بالمدعي. وأن المحكمة لما خفضت مبلغ التعويض المحكوم به ابتدائيا كان عليها أن تعلق قضاءها تعليلا كافيا يبرر ذلك التخفيض»

▪ و في القرار عدد 1608 بتاريخ 28-03-2018 ملف رقم 1849-8211-2017 عن محكمة الاستئناف التجارية بالدار البيضاء : «لئن كان التعويض الجزافي المحدد من طرف المشرع بين 50.000 درهم و500.000 درهم كحد أقصى يعني مالك العلامة من إثبات الضرر طالما أنه تعويض عن ضرر مفترض إلا أن المطالبة بالتعويض الكامل الذي لحق بمالك العلامة يفرض على المدعي إثبات حجم هذا الضرر وأن الحكم الذي حدد مبلغ 800.000 درهم لم يستند على أي أساس ولم يبين الطريقة التي توصل من خلالها الى تقدير هذا المبلغ مما ارتأى معه نظر المحكمة وبعد منازعة الطرفين في مقدار التعويض الأمر بإجراء خبرة حسابية لبيان الضرر المباشر المترتب عن الخسارة التي لحقت مالك العلامة والربح الضائع من خلال الاطلاع على الدفاتر التجارية للطرفين وجميع الوثائق المحاسبية ، وأن الخبير المنتدب خلص الى اقتراح مبلغ 190.000 درهم وأن هذه المحكمة تعتبره مبلغا كافيا لجبر الضرر الناجم عن التزييف طالما أن الطرفين وخاصة مالك العلامة لم يدل بما يخالف هذا التقدير أو يناقضه ولا دليل بالملف على أن الضرر الذي لحقه يفوق هذا المبلغ علما أنه هو المكلف قانونا بإثبات حجم الضرر لذا تبقى منازعة الطرفين في تقرير الخبرة غير مؤسسة ويتعين تأييد الامر المستأنف مع تعديله بخفض المبلغ المحكوم به الى 190.000 درهم»

## المعايير المعتمدة عند تقدير التعويض

□ يعتمد القضاء المغربي العديد من المعايير عند تقدير التعويض المحدد لوجود فرق كبير جدا بين الحدين الأدنى و الأقصى منها :

- كمية البضاعة المزيفة المحجوزة

حيث جاء في القرار رقم 2728 بتاريخ 20-05-2014 الصادر عن محكمة الاستئناف التجارية بالدار البيضاء : « استنادا إلى السلطة التقديرية المخولة للمحكمة في تحديد التعويض الجزافي فإن هذه المحكمة ترى أن المبلغ المحكوم به على سبيل التعويض في حدود 20.000 درهم غير جابر للضرر الحاصل بالنظر إلى ضخامة الكمية المحجوزة من السلع المزيفة والتي تتحدد في 686 زوجا من الأحذية الحاملة لعلامة الطاعنة وبالتالي تستجيب هذه المحكمة لطلب رفعه إلى المبلغ الأقصى في التعويض الجزافي وهو 25.000 درهم »

- نوعية التجار المدعى عليهم : تاجر كبير يعرض كميات كبيرة من السلع المزيفة أو تاجر بسيط يبيع عددا محدودا منها

## حسن أو سوء النية وتأثيره على تقدير التعويض

□ الركن المعنوي ومدى تأثيره على مقدار التعويض الممنوح في إطار دعوى التزييف

ميز التشريع والقضاء المغربيان بين حالتين اثنتين :

- حالة المدعى عليه (شخص معنوي أو طبيعي) يقوم بصناعة المنتج المزيف ← حيث يحكم عليه بأداء التعويض المشار إليه أعلاه دون البحث في سوء أو حسن النية لكون الصانع هو أول حلقة من حلقات التزييف وهو المسؤول الأول عن أفعال التعدي مما يوجب تشدد القضاء.
- حالة المدعى عليه غير الصانع الذي يعرض ويبيع المنتجات المزيفة ويتمسك غالبا بحسن نيته ← حيث إن القضاء المغربي مستقر في احكامه استنادا الى قاعدة أن التاجر المحترف له القدرة على التمييز بين المزيف وغيره، و لا يمكنه التمسك بحسن النية.

شكرا على انتباهكم

# QUANTIFICATION OF DAMAGES IN THE UK

District Judge Alan Johns QC

# QUANTIFICATION OF DAMAGES IN THE UK



# QUANTIFICATION OF DAMAGES IN THE UK

## **Negotiating damages:**

- Do not depend on showing guilty knowledge
- Do not depend on showing lost profits
- Are not an account of profits

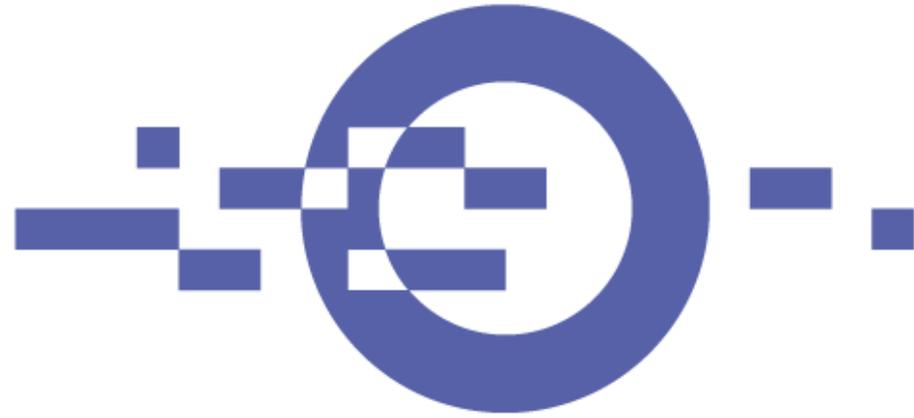
# QUANTIFICATION OF DAMAGES IN THE UK

## **Negotiating damages – some principles:**

- That the parties would not in fact have reached an agreement is irrelevant
- The hypothetical licence is for the period of the infringement
- The Court will have regard to the circumstances in which the parties were placed
- The Court will take account of any non-infringing alternative available to the infringer
- But the Court will not take into account the parties' financial circumstances or character traits

# QUANTIFICATION OF DAMAGES IN THE UK





**A I P P I**

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

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



# Advisory Committee on Enforcement

5 September 2018

WIPO, Geneva



# Introduction to AIPPI Resolutions

Ari Laakkonen

Assistant Reporter General

AIPPI



# AIPPI Resolutions

- A Resolution is the formal position of AIPPI produced after detailed study and debate
- A Resolution is adopted by a vote of the Executive Committee (ExCo)
- A Resolution may be derived from a Study Question or proposed by a Standing Committee



# AIPPI Resolutions – Study Questions

- ExCo votes on topics proposed by the Reporter General's Team (RGT)
- 4 Study Questions
  - Patents
  - Copyright
  - Trademarks/Designs
  - General
- National and Regional Groups file reports on the basis of detailed Study Guidelines
  - Present state of their law
  - Possible improvements for their law
  - Proposals for harmonization



# AIPPI Resolutions – Study Questions

- Reporter General’s Team prepares a summary report of each Study Question
- A Study Committee is appointed for each Study Question
- Each Study Committee prepares a draft Resolution for their Study Question
- The Study Committee debates the Draft Resolution at the Congress
- The refined Draft Resolution is further debated in a dedicated Plenary Session
- The Resolution is presented to the ExCo for final debate/adoption

# AIPPI Resolutions – Standing Committees



- Standing Committees have terms of reference referable to a particular area of IP law or topic, e.g. patents, anti-counterfeiting
- Standing Committee proposed Resolutions are often prepared on the basis of a questionnaire circulated to the AIPPI membership or a study conducted with the Standing Committee
- Standing Committee prepares a summary report and draft Resolution
- The draft Resolution is debated at a dedicated Plenary Session at the Congress
- The Resolution is presented to the ExCo for final debate/adoption



# AIPPI Resolution on Quantification of monetary relief (Sydney, 2017)

# Scope of the Resolution

Quantification of monetary relief in relation to the infringement of intellectual property (IP) rights

- Methods of quantification of damages
- How should damages be calculated?

Does not address:

- Certain types of IP rights – trade secrets
- Criminal damages
- FRAND issues
- Accounts of profit

# TRIPS – Trade Related Aspects of Intellectual Property



## Article 45:

### *Damages*

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

# Why is this important?

- Problem
  - ‘Same’ IP right is infringed in different countries
  - But different countries award different remedies
- Why
  - Methods of quantification vary
  - Evidence upon which quantification is based varies
- Consequence
  - Lack of consistency
    - Enforcement of IP rights
    - Amount of compensation

# Resolution on quantification of monetary relief



## Key principles

1) Damages should compensate the right holder:

- a) for its lost profits in respect of sales of products or services that the right holder would have made but for the infringement; and/or
  - b) for its lost profits in respect of price erosion; and/or
  - c) by a reasonable royalty in respect of infringing sales that are not proved to have been lost sales of the right holder,
- save that the right holder cannot recover twice for the same loss.

# Resolution on quantification of monetary relief



## Damages – factors to be considered

- 3) Lost profits should be assessed taking into account relevant circumstances including, without limitation:
  - a) the similarities and differences between the parties' competing products or services (e.g., design, quality, price, sales channels);
  - b) the availability of other substitutable products or services in the market;
  - c) the capacity of the right holder to meet demand;
  - d) sales, service and warranty offerings of the parties;
  - e) geographic reach;
  - f) reputation of the parties in the market;
  - g) advertising spend;
  - h) price of the products or services;
  - i) the change in turnover of the right holder following the commencement of
  - j) infringing sales.

# Resolution on quantification of monetary relief



## Damages – calculation

- Paragraph 2 – the role of the court
- Paragraph 4 – the role of evidence
- Paragraph 5 – basis of calculation
- Paragraph 6 – causally connected loss

# Resolution on quantification of monetary relief



## Reasonable royalties – principles

- 10) In assessing a reasonable royalty, the parties should be considered as if they were willing licensor and licensee respectively, with the attributes of the actual right holder and infringer, but disregarding the fact that one or both parties would not in practice have agreed to license the IP right in suit.
- 11) A reasonable royalty should be assessed on the basis that the IP right in suit is valid and infringed where validity and infringement have been determined in the same proceeding or, otherwise, if warranted in the circumstances.

# Resolution on quantification of monetary relief



## Reasonable royalties – factors

- 9) In assessing a reasonable royalty, a court should have regard to factors including, without limitation:
- a) other licence agreements of the same IP right as the IP right in suit (but taking due account of the circumstances in which any such other licence agreement was negotiated and, in particular, but not limited to, whether infringement and/or validity of the IP right in suit had been determined);
  - b) other licence agreements of similar IP rights to the IP right in suit;
  - c) the cost of non-infringing alternatives;
  - d) advantages of the IP right in suit when compared with alternatives (including any applicable licence fees for alternatives);
  - e) profitability of the products or services encompassing the IP right in suit
  - f) development costs of the IP right in suit; and
  - g) the absence and/or circumstances of prior licensing discussions between the parties.

# Resolution on quantification of monetary relief



## Convoyed goods and larger assemblies

- 12) In assessing lost profits, compensation should be available in respect of convoyed sales made by the infringer to the extent that such sales are found to result from the lost sales of goods or services that implement the IP right in suit.
- 13) Where the IP right in suit relates to a part of a multi-component product or service sold by the infringer, the value to be attributed to the IP right in suit (and the compensation available by way of lost profits or reasonable royalty) should be assessed having regard to the extent to which the infringing component provides the basis for customer demand for that multi-component product or service.

# Resolution on quantification of monetary relief



## Future losses

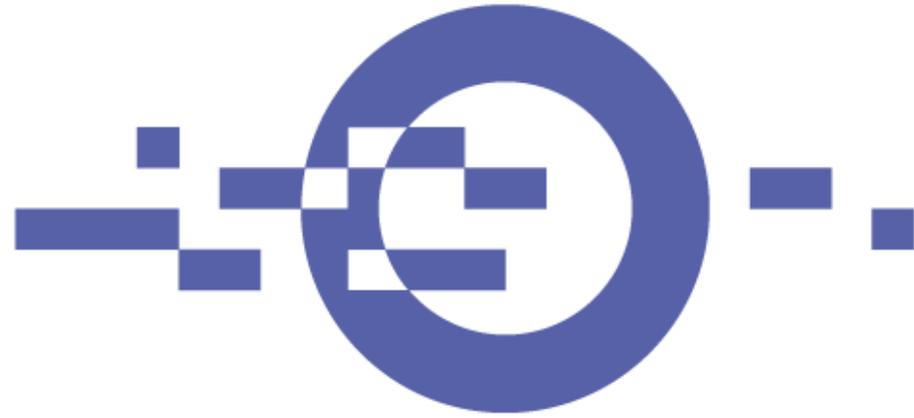
- 14) In assessing lost profits, regard should be had to the present value of future losses that will be sustained by the right holder after the date of the damages award. The mere fact that an injunction is also granted in addition to damages does not mean that there will be no future losses.

# Resolution on quantification of monetary relief



## Future reasonable royalties

- 16) In assessing a reasonable royalty where no injunction is granted, the royalty should include a royalty in respect of future infringements, if any.



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