



**Finding evidence in Europe:
The application of article 7 IPR
Enforcement Directive in the EU**

Jan-Diederik Lindemans
Crowell & Moring Brussels

ACI - Foreign patent law & regulation
December 8, 2009 - The Carlton - New York

OVERVIEW

I. Article 7 IPR Enforcement Directive

- a. Directive 2004/48/EC
- b. Article 7
- c. Innovation or all time classic?

II. Implementation of article 7 in UK, France, the Netherlands and Belgium

III. Comparison between these EU-member states

- a. Preserving evidence vs. obtaining evidence vs. seizures
- b. Cast & crew
- c. Conditions
- d. Preventing & curing

IV. Specific issues

- a. Be prepared
- b. No pay, no play
- c. In for a penny ...
- d. Privileged & confidential?
- e. Exporting evidence

I. Article 7 IPR Enforcement Directive

- a. Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights:

“The objective of this Directive is to approximate legislative systems so as to ensure a high, equivalent and homogeneous level of protection in the internal market” (consideration 10)

“This Directive should not affect substantive law on intellectual property [...]” (consideration 15)

I. Article 7 IPR Enforcement Directive

- a. Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights (2):

*“Given that **evidence is an element of paramount importance** for establishing the infringement of intellectual property rights, it is appropriate to ensure that effective means of presenting, obtaining and preserving evidence are available. The procedures should have regard to the rights of the defence and provide the necessary guarantees, including the protection of confidential information. [...]” (Consideration 20)*

I. Article 7 IPR Enforcement Directive

b. Article 7

- Even before proceedings on the merits
- After presenting reasonable evidence of (possible) infringement
- Access to provisional measures to preserve evidence
- If need be *ex parte*
- Possible adequate security for possible damages
- Review of measures possible if requested by other party
- Compensate other party for damage if measure

I. Article 7 IPR Enforcement Directive

c. Innovation or all time classic?

- Variant of article 7 existed in several EU-member states prior to entry into force on May 1st, 2007 (France, Belgium, UK, etc.)

- Was (partly) new in other EU-member states (the Netherlands, Poland, etc.)

II. Implementation of article 7 in UK, France, the Netherlands and Belgium

- **NL => Bewijsbeslag**
(Article 1019b Code on Civil Proceedings)
- **UK => Search (and seizure) (Anton Pillar order)**
(Section 7 of the Civil Procedure Act)
- **FR => Saisie contrefaçon**
(Article LL. 615-5 (patents) IP Code)
- **BE => Saisie contrefaçon / beslag inzake namaak**
(Article 1369bis Judicial Code)

III. Comparison between these EU-member states

a. Preserving evidence vs. obtaining evidence vs. seizures

NL=> inventory of seized evidence, but separate proceedings needed to see actual evidence

UK=> report re preserved evidence for parties & court

FR=> affidavit re preserved evidence for parties & court and (not « or ») actual seizure of goods possible

BE=> report re preserved evidence for parties & court and (not « or ») actual seizure of goods possible

III. Comparison between these EU-member states

b. Cast & crew

	Key person	If authorised, assisted by	Extra
NL	Bailiff	Attorney of plaintiff Technical expert (complex matters)	Police Sequestrator
UK	Supervising solicitor	Plaintiff	Police Technicians
FR	Bailiff	'Independent' technical expert (Attorney of) plaintiff	Police Technicians
BE	'Independent' technical expert Bailiff	(Attorney of) plaintiff	Police Technicians

III. Comparison between these EU-member states

c. Conditions

Article 7

- reasonable evidence of (possible) infringement on IPR rights

UK => search order is *ultimum remedium*

- strong prima facie case of infringement,
- very serious (potential) damage for the claimant
- clear evidence of real possibility that the evidence will be destroyed
- the harm that might be caused by the execution is not excessive to the requested interim measure

BE => EP is golden ticket

- EP are deemed *prima facie* valid
- indication of possible infringement of EP is sufficient

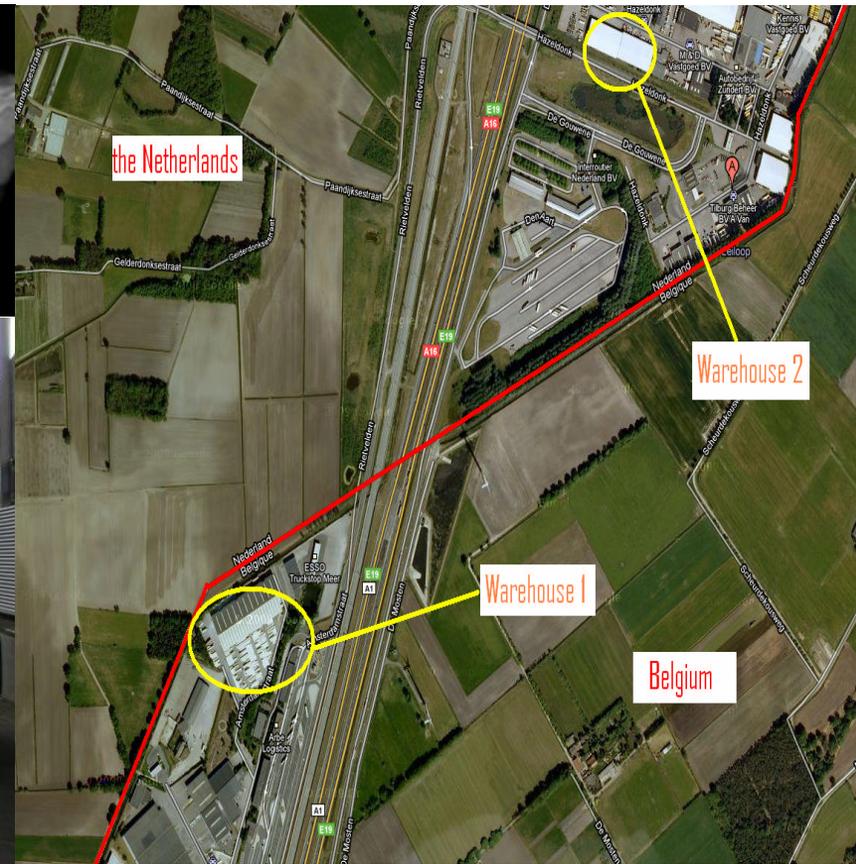
III. Comparison between these EU-member states

d. Preventing & curing

- Protective letters to the court in some EU-member states (DE, NL (The Hague), BE (all?))
- (Voluntary) disclosure of targeted information (e.g. UK search order is *ultimum remedium*)
- Appeal (manner of execution of) the court order

IV. Specific issues

a. Be prepared



IV. Specific issues

a. Be prepared (2)

As applicant:

- Obtain as much info as possible prior to any action
- To ask/take additional measures (judge «on call », client « on call », extra bailiffs, logistics, etc.)
- For contradiction by other party, questions by judge, etc.
- To correctly disclose information to judge in petition
- Do not lie about IPR and/or facts (infringement, pending litigation abroad, etc.)
- Gagging order

IV. Specific issues

a. Be prepared (3)

As other party:

- Get key people trained by legal dept. / outside legal counsel
- Carefully check who can be present to do what
- Have legal backup « on call »
- Check info communicated by applicant to judge
- Note down info obtained by applicant
- Keep quiet during seizure: preserving evidence ≠ interviewing
- Spread the word (intra group, intra industry branch, etc.)

IV. Specific issues

b. No pay, no play

Article 7.2. “Member States shall ensure that the measures to preserve evidence may be subject to the lodging by the applicant of **adequate security** or an equivalent assurance intended to ensure compensation for any prejudice suffered by the defendant”

- Amount ranges from 1.000 EUR to couple of 100.000 EUR
- General: cash paid into blocked (third party) bank account
- Alternative: bank guarantee, etc.

IV. Specific issues

c. In for a penny ...

Article 7.3. “[...]measures to preserve evidence are revoked or otherwise cease to have effect, upon request of the defendant, without prejudice to the damages which may be claimed, if the applicant does not institute, within a reasonable period, proceedings leading to a decision on the merits of the case [...]”

« Reasonable »: as decided by the court in search order or standard 20 working days or 31 calendar days i.p. as of search order.

Sanction: revocation of order => nullification of all effects

IV. Specific issues

d. Privileged & confidential?

Filter 1: the judge excludes certain information (no fishing expeditions)

Filter 2: sequestrator or expert keeping sensitive information at the judge's (and not the applicant's disposal)

Filter 3: specific rules on client-attorney privilege, advice in-house counsel, etc.

Filter 4: protective order issued from abroad

IV. Specific issues

e. Exporting evidence

- Evidence can be used in foreign litigation (BE (Sanac-ruling 1999)), (NL (Synthon / Astellas Pharma-ruling, 2007)), etc.), sometimes explicit court authorisation required (e.g. UK)

- Proceedings on the merits after search can be initiated in different member state

- Gathered evidence and affidavits/reports remains nonetheless confidential... until ruling on the merits?!

Thank you

Crowell & Moring Brussels
Jan-Diederik LINDEMANS
71, Rue Royale
1000 Brussels
Belgium
jlindemans@crowell.com
T: +32 2 282 40 82