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

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OVERVIEW

I. Article 7 IPR Enforcement Directive
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   c. Innovation or all time classic?

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

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   d. Preventing & curing

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   b. No pay, no play
   c. In for a penny …
   d. Privileged & confidential?
   e. Exporting evidence
I. Article 7 IPR Enforcement Directive


“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


“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)
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

<table>
<thead>
<tr>
<th>Key person</th>
<th>If authorised, assisted by</th>
<th>Extra</th>
</tr>
</thead>
<tbody>
<tr>
<td><strong>NL</strong></td>
<td>Bailiff</td>
<td>Police Sequestrator</td>
</tr>
<tr>
<td></td>
<td>Attorney of plaintiff</td>
<td></td>
</tr>
<tr>
<td></td>
<td>Technical expert (complex matters)</td>
<td></td>
</tr>
<tr>
<td><strong>UK</strong></td>
<td>Supervising solicitor</td>
<td>Police Technicians</td>
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<tr>
<td></td>
<td>Plaintiff</td>
<td></td>
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<td>‘Independent’ technical expert (Attorney of) plaintiff</td>
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<tr>
<td></td>
<td>Bailiff</td>
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</tbody>
</table>
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

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