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Pre-trial measures: ex-parte searches and discoveries in IP cases

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Pre-trial measures :
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Summary

- Introduction:
 - ▶ What does the plaintiff have to prove?
 - ▶ Infringement is a question of facts
 - ▶ Most common evidentiary tools
- The French situation
 - ▶ The specific tool to prove infringement *saisie-contrefaçon*
 - ▶ Bailiff's report
 - ▶ Compulsory production of documents
 - ▶ Right of information
 - ▶ Expert proceedings
- Other European countries
 - ▶ Germany
 - ▶ The Netherlands
 - ▶ UK
 - ▶ Spain
 - ▶ Italy

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Introduction: What does the plaintiff have to prove?

- The plaintiff must prove that the defendant is infringing his rights and is liable for these acts
- If the plaintiff fails to bring such evidence, the action for infringement cannot prevail
 - ▶ In France, in 2006, approximately 5% of the actions for infringement was dismissed because insufficient evidence was provided to the Court
- It is the attorney-at-law's work to assess the level of evidence that is necessary for a given matter

What exactly must be proved?

- the accused product / process / device reproduces the patented characteristics
- the defendant(s) performs an act of infringement (sale, offer for sale, use, manufacture, importation, etc.)
- the defendant's liability is engaged by the act of infringement (wilful infringement)
- the place of the infringement (for jurisdiction issues)
- the date of the infringement (for limitation issues)
- the extent of the infringement (for damage calculation)

How difficult is it to prove?

- Infringement of a **product** patent is usually easier to prove than infringement of a **process** patent:
 - ▶ some products are available on the market, rarely a process
 - ▶ the study of the product makes it possible to identify infringement, but the study of the product obtained by the process rarely provide information on the manufacturing process
 - ▶ manufacturing processes are often kept very confidential
- Information on the extent of infringement is often not available
- the actors of the infringement are not always easy to identify

How can one prove infringement?

- Infringement is a question of facts that can be proved by any means
 - ▶ Art. L. 615-5 IPC as amended by Law 2007-1544 of October 29, 2007 " *Infringement can be proved by any means* "
- Evidentiary means vary from country to country according to:
 - ▶ the rules of civil procedure;
 - ▶ the specific rules for infringement of IP rights;
 - ▶ local Court's practice or preference

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- EC Regulation 2004/48 on enforcement of IP rights tried to harmonize evidentiary means, in particular:
 - ▶ **right to evidence (Article 6)**: judicial authority may order that evidence in the hand on one party, be presented to the other party, subject to the protection of confidential information
 - ▶ **measures for preserving evidence (article 7)**: judicial authority may order prompt and effective provisional measures to preserve relevant evidence in respect of the alleged infringement, subject to the protection of confidential information, notably the detailed description, with or without the taking of samples; those measures shall be taken, if necessary without the other party having been heard
 - ▶ **right of information (article 8)**: judicial authorities may order that information on the origin and distribution networks of the goods or services which infringe an intellectual property right be provided by the infringer and/or other persons

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Most common evidentiary means

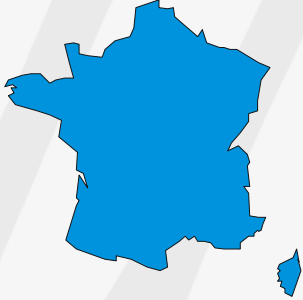
- Ordinary exhibit (publicly available commercial or administrative document e.g. catalogue, samples);
- Bailiff reports:
 - ▶ purchase reports;
 - ▶ Website reports;
- *Saisie-contrefaçon*;
- Compulsory production of documents;
- Expert proceedings;
- Discovery proceedings;
- Reversal of the burden of proof

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1. Proving infringement in France



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Preamble: Implementation of the Enforcement Directive

- 1.1. The specific tool for right holders :
the *saisie-contrefaçon*
- 1.2. Bailiff reports
- 1.3. Compulsory production of documents
- 1.4. Right of information
- 1.5. Expert proceedings

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Preliminary comment



- Directive 2004/48/EC implemented in France on

29 October 2007

(Act n° 2007-1544, French Official Journal n° 252 of 30 October 2007).



1.1. Specific tool for IP right holders: the *saisie-contrefaçon*



The *saisie-contrefaçon* in short

- The most efficient way to gather evidence of infringement
- Used in 80% of infringement actions
- 600 *saisies* ordered each year by the sole Court of Paris (probably 1500 in France each year)
- Upon authorization granted *ex-parte*, a bailiff (“*huissier*”) and a patent agent chosen by the patentee may enter any premises where proof of infringement might be found, to perform the authorized investigations and draw up a report handed to the patentee and later exhibited to the Court

What is a *saisie*?

- A *saisie* is not a seizure: the stock cannot be seized
 - ▶ the new wording of article L. 615-5 IPC is ambiguous in this respect
- A *saisie* is not an injunction
- A *saisie* is a way of gathering evidence of infringement

A *saisie* can be performed on the basis of almost all IP rights

- Patent (L. 615-5 IPC)
- Plant variety right (L. 623-27-1 IPC)
- Trademark (L. 716-7 IPC)
- Design (L. 521-4 IPC)
- Copyright
- NEW : Topography of a semi-conductor product (L. 622-7 IPC)

A *saisie* cannot be performed on the basis of a foreign title

- French legal provisions seem to deny the possibility of performing a *saisie* on the basis of a foreign title
 - ▶ a Belgian Court authorized a *saisie*, in Belgium, on the basis of a French patent (CA Brussels, February 11, 1997; Cour de Cassation, September 3, 1999)
 - ▶ A French Court admitted such *saisie*, in Belgium, on the basis of a French patent (TGI Lille, June 4, 1980)
- European Regulation No. 44/2001 and the Brussels and Lugano Conventions may allow to request a search order, similar to a *saisie*
 - ▶ the President of the Court of Paris however refused to authorize such *saisie*-like procedure (articles 145 and 812 NCPC)

The legal basis for a *saisie*

- Article L. 615-5 Intellectual Property Code (amended by Law 2007-1544 of 29 October 2007) for patent matters

“ The infringement shall be proven by any means. For that purpose, any person who has authority to bring an action for infringement shall be entitled, by virtue of an order issued by the competent civil court, given on request, to direct any bailiff, assisted by experts of the claimant, to proceed in any place with the detailed description, with or without taking samples, or the effective seizure of the allegedly infringing goods or processes as well as of any related document.

The court shall order, for the same evidential purposes, the effective seizure of equipment and tools used to manufacture or distribute the goods or to implement the allegedly infringing processes.

It may condition the implementation of the measures it ordered to the furnishing by the claimant of guarantees to ensure, if necessary, the defendant's compensation if the infringement action is subsequently held unfounded or the seizure is cancelled.

If the claimant fails to institute legal proceedings on the merits, either by civil action or criminal action, within a period of time set by regulation, the entire seizure, including the description, shall be void upon the defendant's request, without its having to motivate its request and without prejudice to the damages which may be claimed.”

- Articles R. 615-1 to -4 Intellectual Property Code
- Identical provisions exist for other IP rights, except copyright

The grant of the order: an *ex-parte* procedure



- The *saisie* must be authorized by the President of the local Court of first instance (“*Tribunal de grande instance*”)
- The petition is filed by the plaintiff's attorney-at-law
- The defendant is not informed of the petition; he is informed only upon performance of the *saisie*

The grant of the order, a right for the owner

- If presented a valid title, the Judge must grant the order authorizing the *saisie*
- No *prima facie* evidence required
- However, the Judge may:
 - ▶ restrict the terms of the petition
 - ▶ subject his authorization to a security on the part of the petitioner

The performance: who may take part to the *saisie*?

- The *saisie* is performed by a bailiff ("*huissier*")
- An expert may help the bailiff to describe the infringing device:
 - ▶ independent from the parties
 - ▶ generally a patent attorney
 - ▶ his comments must be distinguished from those of the bailiff
- A police officer (or squad if appropriate)
- Any other person whose technical skills may be useful (e.g. accountant, photographer, locksmith)



- French case Law on the expert authorized to assist the bailiff in view of article 6 of CEDH on the right to a fair trial:
 - ▶ French Supreme Court, July 6, 2000 (software): the employee of the plaintiff is not independent and is therefore not allowed to assist the bailiff
 - ▶ French Supreme Court, March 8, 2005 (trademark): The trademark attorney (*Conseil en propriété industrielle*) is considered as independent from his client and can therefore assist the bailiff
 - ▶ TGI Paris July 11, 2007 (patent): an employee of the patent agent cannot attend the *saisie* because he is not subject to the obligation of professional secrecy (very disputable decision)

Information to be gathered during the *saisie-contrefaçon*

- Description of the accused device in the bailiff's report
- Seizure of samples
- Seizure of equipment and tools to manufacture, distribute or implement the product or process
- Photographs of the accused device
- Copy of technical and commercial documents
- Accounting data regarding the scope of infringement;
- Information on the chain of liability



- The seized samples can be:
 - ▶ photographed
 - ▶ analyzed by experts (plaintiff expert or Court expert)
 - ▶ dismantled
- A sample is usually left with the Clerk of the Court



Confidentiality issues



If an objection about the confidentiality of some documents is raised, the bailiff usually places said documents in a sealed envelop that is not handed to the plaintiff (the bailiff engages his liability by performing the seizure)

The plaintiff's attorney-at-law often asks the bailiff to redact documents (name of clients) and place documents in a sealed envelop (e.g. Marketing authorization)

In such case, the Court usually appoints an expert to sort out the documents, even confidential, useful to prove the infringement, which are handed to the plaintiff from the documents which are not related to the alleged infringement, which remain with the bailiff

- ▶ Court of Lyon, May 11, 1998, Rhône Poulenc / Monsanto

An action on the merits must be initiated after the *saisie*

- One or several *saisies* can be performed:
 - ▶ before starting an action
 - ▶ when the action is already pending
- A *saisie-contrefaçon* must be followed by the launch of an action on the merits, or by written pleadings, within 20 working days or 31 calendar days, to be valid (Implementation of enforcement Directive – this time period will be soon set by a French Regulation)
- Otherwise: the whole *saisie* is null and void
 - ▶ note a change because, under the old law, in patent litigation, only the actual seizure of products or samples is void, not the description



Possible use of the bailiff's report

- The report drafted by the bailiff during the *saisie-contrefaçon* can be used:
 - ▶ for one or several French procedures regarding the same IP right (TGI Paris January 18, 2006; CA Paris, November 24, 2000)
 - ▶ for parallel foreign proceedings
 - ▶ for a unique foreign procedure? despite the absence of case law, it seems possible to start the action on the merits abroad, *e.g.* if the defendant is based abroad

- Few defendants challenged the use of documents gathered during a French *saisie*, for foreign proceedings:
 - ▶ Monsanto vs. Merck (*President TGI Paris, November 24, 1997*); documents which are useful to prove the infringement and that are not confidential may be used freely for proceedings in other countries
 - ▶ Rhône Poulenc Rorer vs. Bristol Myers Squibb (*TGI Paris, September 30, 1998*); the use in foreign proceedings of confidential documents useful to prove the infringement cannot be restricted by a preliminary order
 - ▶ Quickturn Design vs. Meta System (*President TGI Paris, May 14, 1999; President CA Paris, July 26, 1999*); non confidential documents useful to evidence the infringement can be used freely by the parties, in current or future proceedings, be they domestic or foreign, but confidential documents useful to evidence the infringement can be used in other proceedings only after a final judgment on the merits has recognized the infringement

The validity of the *saisie* is often disputed

- The defendant very often disputes the validity of the *saisie*, namely:
 - ▶ challenge the grant of the order before the Judge who authorized the *saisie* ("*action en rétractation*")
 - ▶ challenge the validity of the *saisie* before the court on the merits ("*action en nullité de la saisie*")
- Courts are increasingly (and exaggeratedly?) strict

1.2. Ordinary bailiff reports

- Ordinary reports can be drafted by a bailiff, without a Court authorization in any public place
 - ▶ Note that a shop or professional fair are private places, open to the public
- Such reports are often use:
 - ▶ to record the purchase of a product in a shop
 - ▶ to describe a website on the Internet

Advantages of ordinary reports

- Cheaper than a *saisie-contrefaçon*
- Faster to arrange
- The defendant is not aware of anything, even that a bailiff drafted a report
- Ordinary reports do not trigger an obligation to start proceedings

Drawbacks of ordinary reports

- The limit of these report is that they only enable the bailiff to record publicly available evidence, thus:
 - ▶ no report in a private place
 - ▶ no description of manufacturing process
 - ▶ no question can be asked to the defendant
- When the report resembles too closely to a *saisie*, it is declared null on the ground that it is a non authorized disguised *saisie*
 - ▶ Paris, October 25, 2006; a report drawn by a bailiff who absorbed the website is null because it constitute a disguised *saisie* (very disputable decision)

1.3. Compulsory production of documents

- A party may request exhibits kept by another party to the proceedings or third parties
- The Court (most often the judge in charge of the case management) has to decide whether the compulsory production of documents is necessary, after hearing both parties



The legal basis for compulsory production of documents

- Article 10 of French Civil Code

- ▶ *“ Everyone is bound to collaborate with the court so that truth may come out. He who, without legitimate reason, eludes that obligation when it has been legally prescribed to him, may be compelled to comply with it, if need be on pain of periodic penalty payment or of a civil fine, without prejudice to damages.”*

- Article 11 of the New Code of Civil Procedure

- ▶ *“ The parties are held to cooperate for the implementation of the investigation measures, even if the judge notes the consequences of abstention or refusal to do so. Where a party holds evidence material, the judge may, upon the petition of the other party, order him to produce it, where necessary under a periodic penalty payment. He may, upon the petition by one of the parties, request or order, where necessary under the same penalty, the production of all documents held by third parties where there is no legitimate impediment to doing so. ”*

- Article 6 of Directive EC 2004/48

1. *Member States shall ensure that, on application by a party which has presented reasonably available evidence sufficient to support its claims, and has, in substantiating those claims, specified evidence which lies in the control of the opposing party, the competent judicial authorities may order that such evidence be presented by the opposing party, subject to the protection of confidential information. For the purposes of this paragraph, Member States may provide that a reasonable sample of a substantial number of copies of a work or any other protected object be considered by the competent judicial authorities to constitute reasonable evidence.*
2. *Under the same conditions, in the case of an infringement committed on a commercial scale Member States shall take such measures as are necessary to enable the competent judicial authorities to order, where appropriate, on application by a party, the communication of banking, financial or commercial documents under the control of the opposing party, subject to the protection of confidential information.”*

No need implementing art. 6 of Enforcement Directive

- Because of the existing provisions, it has been considered that art. 6 of the Enforcement Directive did not need to be implemented in French law
- However, in practice, the compulsory production of documents was rarely ordered in France
- It was considered that such compulsory production might only be requested when:
 - ▶ the patentee was unable to gather the evidence during the *saisie* (absent an attempt to get the document during a *saisie*, the compulsory production was usually refused);
 - ▶ the requested document is clearly identified and necessarily exists (no blind or general request is admitted)

Recent French case law

- TGI Paris, JME, July 11, 2007, Schindler vs. Otis: The patentee could not obtain the accused product during the *saisie-contrefaçon* and the defendant refused to sell it. The judge in charge of case management ordered the defendant to sell two samples of the accused product to the patentee
- TGI Paris, JME, October 8, 2007, Newdeal vs. Wright: the judge in charge of the case management refuses to order the defendant to exhibit a drawing of the accused product because the patentee decided not to perform a *saisie* and does not provide evidence that the product is sold in France

1.4. Right of information

- No right of information within the meaning of article 8 of the Enforcement Directive existed under former French law
- The implementation act however added an article L. 615-5-2 IPC for patent matters and identical provisions for all other IP rights

■ New article L.615-5-2 IPC

“ If so required, the court hearing civil proceedings provided for by this title, shall order, under penalty of a daily fine if necessary, in order to determine the origin and the distribution networks of the infringing goods or processes which prejudice the claimant’s rights, the submission of any document or data held by the defendant or by any person who was found in possession of the infringing goods or goods implementing the infringing processes or who provides services used in infringing activities or was reported to take part to the production, manufacturing or distribution of such products, the implementation of such processes or the supply of such services.

The submission of documents or data shall be ordered if there is not legitimate hindrance.

The documents or data sought relate to:

- a) *The name and address of the producers, manufacturers, distributors, suppliers and other previous holders of the products, processes or services, as well as the recipient wholesalers or retailers;*
- b) *The quantities produced, commercialized, delivered, received or ordered, as well as the price obtained for the products, processes or services at issue.”*



1.6. Court appointed expert

- The Court or the Judge in charge of the case management, may appoint an expert when there is a serious technical dispute about the issue of infringement
- Such expert proceedings are extremely rare in relation to infringement
 - ▶ The Court of Appeal of Paris even criticizes the TGI ordering expert investigations on the issue of infringement (Paris, July 22, 2003, Rhodia vs. Asec, Daiichi Kigenso)
- Judges are not bound by the expert report

The legal basis for expert reports

- **Article 143** of the French New code for civil procedure: *"The factual circumstances upon which the resolution of the dispute depends, may, at the request of the parties or sua sponte, be subjected to any legally permissible preparatory inquiry."*
- **Article 144** *"At any event, the preparatory inquiries may be ordered when the judge is not supplied with sufficient material to determine the matter."*
- **Article 145** *"If there is a legitimate reason to preserve or to establish, before any legal process, the evidence of the facts upon which the resolution of the dispute depends, legally permissible preparatory inquiries may be ordered at the request of any interested party, by way of a petition or by way of a summary procedure."*

Two important articles which limit expert proceedings

- **Article 146** *"A preparatory inquiry on a fact may be ordered only if the party who pleads it does not have sufficient material to prove it.
In no case, a preparatory inquiry may be ordered for the sake of making up a party's deficiency to produce evidence."*
- **Article 147** *"The judge must limit the choice of the order as to what is sufficient for the resolution of the dispute by endeavouring to select the simplest and least onerous ones."*

... or after a saisie-contrefaçon

- **Article R.615-4 IPC**
 - ▶ *"The president of the court may order, on the ground of the official report of seizure, any measure likely to supplement the proof of the alleged counterfeit deeds. Upon the petition of the seized party acting forthwith and showing a legitimate interest may also take any measure to preserve the confidentiality of certain items"*

Examples of expert proceedings to search evidence of infringement

- TGI Lyon, JME, April 4, 2005, Rijk Zwaan vs. Vert Frais
 - ▶ the owner of a plant variety right on salad plants could not prove the accused infringement (multiplication of plants) without comparing the number of seeds purchased by the defendant with the production of salads to identify inconsistencies; an expert was appointed for this purpose
- Référé TGI Paris, November 18, 2005
 - ▶ The patentee had granted a licence of its patent portfolio, but licensee refused to pay royalties on the ground that the device it manufactured and sold did not enter in the scope of the patent
 - ▶ the patentee asked the President of the Court to appoint an expert to examine the drawings of the device sold and provide information necessary to decide whether it is covered by the patent or not

Conclusion

- All the evidentiary measures must be viewed as a tool box containing tools to be carefully selected according to the specific matter
- Several measures can be combined in a given matter
 - ▶ be careful with order: bailiff report > saisie-contrefaçon > compulsory production of documents
- The relative weight of each measure changes overtime
 - ▶ *saisie-contrefaçon* is currently under very strict scrutiny
 - ▶ the implementation of the Enforcement Directive might give more weight to compulsory production of documents

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2. Germany



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Enforcement Directive not yet implemented

- The directive has not yet been implemented in Germany
- An unofficial referee draft of 3 January 2006 has been incorporated into the Government draft bill of 24 January 2007
- It is not foreseeable when the bill will be passed and the Directive therefore implemented

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A limited right of inspection

- Art. 809 BGB provides for a general right of inspection; someone having a claim against the owner of a good, in relation to that good, or wanting to establish whether he has such claim, may demand to inspect the good, if such inspection is useful for that purpose
 - ▶ In the "Druckbalken" case, the Federal Supreme Court provided a very restrictive interpretation of that provision in a patent matter; the proprietor of a patent had to show a very high probability of infringement to support his application as to the collection of evidence in the control of the opponent
 - ▶ In the "Faxkarte" case (BGH, May 2, 2002) the Federal Supreme Court provided a far more liberal judgment for copyright / unfair competition matter considerably improved the position of the right holder who now has to present a case with a considerable probability of infringement, i.e. something like "a serious question to be tried".

- To obtain the authorisation of inspection, the patentee must demonstrate:
 - ▶ a strong likelihood of infringement
 - ▶ A balance of interests, namely that he has no other way to gather evidence, and that the inspection is acceptable for the defendant whose secrets will not be disclosed
- When authorized, the inspection can be performed by the attorney-at-law, a Court expert or a bailiff
- The inspection may be authorized even if the inspection leads to the destruction of the product

Expected implementation of the Enforcement Directive

- No fundamental changes are expected
- The draft act provides an explicit provision similar to the existing “Faxkarte” proceedings, also for patent cases, requesting the right holder to show:
 - ▶ a considerable probability of infringement, and
 - ▶ that the evidence is necessary to support his claims

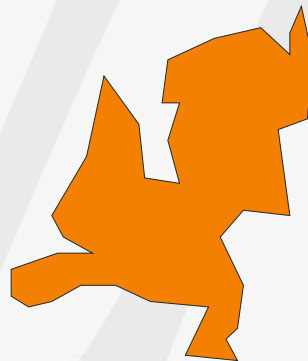
2.2. Compulsory production of documents

- German law at present does not provide for a means to get access to banking, financial or commercial documents in the control of the opponent
- In order to comply with Article 6(2) of the Enforcement Directive, the referee draft provides for such a claim subject to the condition that the information is necessary for the enforcement of damages

3.3. Right of information (art. 8 Enforcement Directive)

- The right to information under present German law cannot be enforced against other persons but the infringer. A third person can only be obliged to present an object or document if there is a need to present the concrete evidence in the pending process but not if the evidence sought is required to serve in later proceedings against other potential infringers.
- In order to comply with Article 8(1), this will be changed

3. The Netherlands



Enforcement Directive already implemented

- The IP laws relevant to Dutch territory are made at either the national level, the level of the Kingdom of The Netherlands (i.e. The Netherlands, the Dutch Antilles and Aruba), or at the Benelux level. Therefore a “triple-fold” implementation of the Directive is necessary:
 - ▶ on a national level: a new chapter in the Dutch Code of Civil Procedure, and new provisions regarding enforcement in the various national IP Acts (*e.g.* the Copyright Act, the Trade Name Act and the Database Act);
 - ▶ on the level of The Kingdom of The Netherlands: changes and addenda to article 70 of the Patents Act 1995 (regarding enforcement); and
 - ▶ on the Benelux level: changes to the (newly adopted) Benelux Convention on Intellectual Property (regarding Benelux trademarks and designs).

- The implementation of the Directive on the national level has taken place on May 1, 2007
- The implementation at Kingdom level re. the Patents Act 1995 is in force per July 1, 2006
- On the Benelux level, the Benelux Convention on Intellectual Property has taken effect in the Netherlands on 1 September 2006. A protocol amending this Convention, making it Directive-proof, has taken effect on February 1, 2007

Dutch *saisie-contrefaçon*

- Provisions in the Dutch Code of Civil Procedure regarding the previously unknown seizure and description of evidence, as referred to in article 7 of the Directive is now implemented
- According to the new provisions, the court may, without hearing the defendant, grant a request to:
 - ▶ have evidence (i.e. infringing goods, any materials used for producing infringing goods and related documents) described (a "saisie-description")
 - ▶ seize samples
 - ▶ seize the stock for provisional measures
- A number of uncertainties exist regarding the practicalities of such an operation, namely, whether the attorney to the plaintiff is allowed to be present when the bailiff describes the evidence, the right holder can be present, computers be searched, etc. Case law is thus expected

4. The United Kingdom



Enforcement Directive already implemented

- The Directive was implemented on the date required by the European Union, that is on 29 April 2006

Limited search orders

- Provisions similar to *saisie-contrefaçon* already existed but are rarely used:
 - ▶ section 33 of the Supreme Court Act 1981 and section 52 of the County Courts Act 1984, authorizing the patentee to inspect, take photographs or seize products
 - ▶ section 37 of the Supreme Court Act 1981 and section 38 of the County Courts Act 1984, on the protection of evidence
 - ▶ Section 7 of the Civil Procedure Act 1997 enabling the High court to authorize measures for the preservation of evidence called « search orders », e.g. "Anton Piller orders"
 - ▶ The Court may also order a « supervising solicitor » to enter the premises of the alleged infringer to take copies of documents and seize samples

- If a risk exists that evidence might disappear, the Court may order a “supervising solicitor” to visit the premises of the alleged infringer to copy documents and take samples
- The search might be ordered before an action is initiated only in case of urgency or if necessary for the success of the measure
- The measure may be ordered *ex parte*
- The patentee must commit:
 - ▶ to compensate the defendant for any damage that may be caused by the search
 - ▶ To start an action on the merits within a period of time set by the order

No change in UK law

- No amendment to the prior existing provisions have been implement in UK law in relation to article 7 of the Enforcement Directive

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Enforcement Directive already implemented

- Directive was implemented in Italy with legislative decree 16 March 2006 no. 140, in force since 22 April 2006
- This decree modifies both the Intellectual Property Code, and Copyright Law

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Descrizione proceedings

- Descrizione procedure, similar to *saisie-contrefaçon*, already existed (article 128 of the IPC)
- Almost no change made in relation to implementation of article 7 of the Enforcement Directive
- This procedure was only introduced in the copyright law

- The right holder can ask the President of the specialized court to order the description of the alleged infringing goods, the means to manufacture said goods and gather evidence of the infringement
- The order lists the measures that can be performed
- The order can be granted *ex parte*
- If authorized before an action on the merits has been initiated, the order sets a time period within which the action must be initiated

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6. Spain

A map of Spain, including the Balearic Islands, is shown in a solid orange color. The map is centered on the Iberian Peninsula.

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Enforcement Directive already implemented

- Directive was implemented through Spanish Law 19/2006, of 6 June 2006

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Description proceedings

- Description procedure, similar to *saisie-contrefaçon*, already existed in the general rules of civil procedure
- A specific provision now appear in the Intellectual Property Code
- The use of this procedure is facilitated and increased

- The right holder can ask the President of the local court to order the description of the alleged infringing goods, the actual seizure, manufacturing goods
- The patentee must demonstrate:
 - ▶ the risk of infringement
 - ▶ that no other way to prove infringement is available
- The measure is performed by the Court's clerk accompanied by an expert (suggested by the plaintiff)
- The Court's clerk or the expert write a report submitted to the patentee
- The order can be granted *ex parte*
- If authorized before an action on the merits has been initiated, action must be initiated within 20 days

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