

**Management forum
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Seizure, inspection and disclosure in Europe

Evidence is essential to any litigation. Gathering evidence, however, is an issue in itself in patent litigation. Infringement actions may fail not only because of insufficient evidence but also because of inappropriate evidence. The reason is that the rules governing the taking of evidence are part of the civil or criminal procedure rules of each legal system.

The EC Directive No. 2004/48 regarding the enforcement of intellectual property rights includes provisions on the disclosure and gathering of evidence. Its intent is to make sure that each country provides right-holders with the same panel of tools, in particular in Article 6 (evidence), Article 7 (measures for preserving evidence), and Article 8 (right of information).

But even between systems offering similar tools for gathering evidence, the practice differs significantly.

The subject-matter of this submission is:

- ▶ to highlight that even on the basis of similar provisions resulting from EC Directive No. 2004/48, the practice can differ significantly from country to country;
- ▶ to discuss in particular how evidence is gathered in France and in the UK;
- ▶ to examine how the information gathered in one country may be used in parallel foreign actions.

In conclusion, a tentative 'ideal' strategy where there are parallel UK and French proceedings will be presented.



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1. Evidentiary tools available in most jurisdictions

EC Directive No. 2004/48 of 28 April 2004 on the Enforcement of intellectual property rights contains provisions regarding the taking of evidence:

- ▶ Article 6¹ on evidence;
- ▶ Article 7² on measures for preserving evidence;
- ▶ Article 8³ on the right of information.

¹ Article 6 of EC Directive No. 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."

² Article 7 of EC Directive No. 2004/48: "1. Member States shall ensure that, even before the commencement of proceedings on the merits of the case, the competent judicial authorities may, on application by a party who has presented reasonably available evidence to support his/her claims that his/her intellectual property right has been infringed or is about to be infringed, order prompt and effective provisional measures to preserve relevant evidence in respect of the alleged infringement, subject to the protection of confidential information. Such measures may include the detailed description, with or without the taking of samples, or the physical seizure of the infringing goods, and, in appropriate cases, the materials and implements used in the production and/or distribution of these goods and the documents relating thereto. Those measures shall be taken, if necessary without the other party having been heard, in particular where any delay is likely to cause irreparable harm to the rightholder or where there is a demonstrable risk of evidence being destroyed.

Where measures to preserve evidence are adopted without the other party having been heard, the parties affected shall be given notice, without delay after the execution of the measures at the latest. A review, including a right to be heard, shall take place upon request of the parties affected with a view to deciding, within a reasonable period after the notification of the measures, whether the measures shall be modified, revoked or confirmed.

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 as provided for in paragraph 4.

3. Member States shall ensure that the 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 before the competent judicial authority, the period to be determined by the judicial authority ordering the measures where the law of a Member State so permits or, in the absence of such determination, within a period not exceeding 20 working days or 31 calendar days, whichever is the longer.

4. Where the measures to preserve evidence are revoked, or where they lapse due to any act or omission by the applicant, or where it is subsequently found that there has been no infringement or threat of infringement of an intellectual property right, the judicial authorities shall have the authority to order the applicant, upon request of the defendant, to provide the defendant appropriate compensation for any injury caused by those measures."

³ Article 8 of EC Directive No. 2004/48: « 1. Member States shall ensure that, in the context of proceedings concerning an infringement of an intellectual property right and in response to a justified and proportionate request of the claimant, the competent 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 any other person who:

(a) was found in possession of the infringing goods on a commercial scale;

(b) was found to be using the infringing services on a commercial scale;

(c) was found to be providing on a commercial scale services used in infringing activities;

or

(d) was indicated by the person referred to in point (a), (b) or (c) as being involved in the production, manufacture or distribution of the goods or the provision of the services.

2. The information referred to in paragraph 1 shall, as appropriate, comprise:

(a) the names and addresses of the producers, manufacturers, distributors, suppliers and other previous holders of the goods or services, as well as the intended wholesalers and retailers;

(b) information on the quantities produced, manufactured, delivered, received or ordered, as well as the price obtained for the goods or services in question.

3. Paragraphs 1 and 2 shall apply without prejudice to other statutory provisions which:

(a) grant the rightholder rights to receive fuller information;

(b) govern the use in civil or criminal proceedings of the information communicated pursuant to this Article;

(c) govern responsibility for misuse of the right of information;

or

(d) afford an opportunity for refusing to provide information which would force the person referred to in paragraph 1 to admit to his/her own participation or that of his/her close relatives in an infringement of an intellectual property right;

Other instruments already contained similar or additional measures, notably the Trips agreement of 15 April 1994:

- ▶ Article 34: burden of proof for process patent;
- ▶ Article 43: evidence;
- ▶ Article 47: right of information;
- ▶ Article 50: provisional measures.

More generally, ordinary rules of civil procedure of most countries authorise other measures such as:

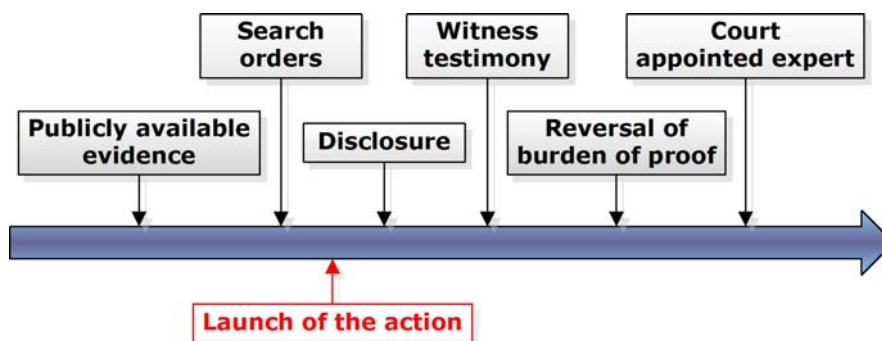
- ▶ witness statements of facts and expert reports;
- ▶ court appointed expert proceedings.

In other words, the following tools are to some extent available in most countries, at least in France and the UK:

- ▶ use of publicly available evidence;
- ▶ search orders, notably *saisie-contrefaçon*;
- ▶ witness statements of facts and expert reports;
- ▶ disclosure or compulsory production of evidence;
- ▶ right of information;
- ▶ reversal of the burden of proof for process patents;
- ▶ court appointed experts.

Each measure is available at different moment in the proceedings.

The following chronology shows when each tool is most often used:



It will be seen that, for cultural reasons, these tools are not used in the same way in various jurisdictions.

2. Gathering of evidence in various jurisdictions

The present submission will mainly deal with France (2.1.) and the UK (2.2.).

*or
(e) govern the protection of confidentiality of information sources or the processing of personal data."*

2.1. Gathering of evidence in France

The EC Directive No. 2004/48 of 28 April 2004 on the enforcement of intellectual property rights was implemented in France by Act No. 2007-1544 of 27 October 2007, which became completely enforceable after the application decree No. 2008-624 of 27 June 2008⁴.

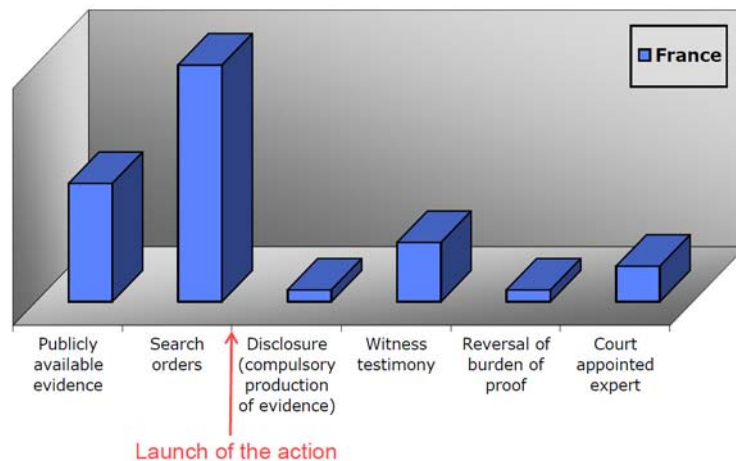
The Enforcement Directive has not significantly changed the French law regarding the gathering of evidence, except for the creation of the right of information.

The most common evidentiary means in France were and remain, by order of importance:

- ▶ the *saisie-contrefaçon*, which corresponds to Article 7 of the Enforcement Directive, but existed before the Directive;
- ▶ ordinary bailiff reports (*i.e.* purchase report or website report) which are not covered by any provision of the Enforcement Directive;
- ▶ expert opinions, which are not covered by any provision of the Enforcement Directive;
- ▶ the right of information, a new provision resulting from the implementation of Article 8 of the Enforcement Directive;
- ▶ the compulsory production of documents, which corresponds to Article 6 of the Enforcement Directive and existed before the implementation of the Directive but was rarely used.

These evidentiary tools are used beside exhibits usually adduced before the court, which correspond to publicly available documents (*e.g.* catalogue, sample, etc.).

In other words, French gathering of evidence could be represented as follows:



We will examine those tools in the chronological order in which they are usually used for a given matter, namely:

- ▶ bailiff reports;
- ▶ the *saisie-contrefaçon*;

⁴ Until French Act No. 2007/1544 of 29 October 2007, the Enforcement Directive was not directly applicable between private individuals but French law had to be interpreted in the light of the Directive. Between the Act of 29 October 2007 and the Decree of 27 June 2008, only the legal provisions requiring no application decree were enforceable. For example, the provisions regarding the right of information have been enforceable since 29 October 2007. The provisions regarding the *saisie-contrefaçon*, however, were enforceable only in patent matter.

- ▶ expert opinions;
- ▶ the compulsory production of documents;
- ▶ the right of information.

2.1.1. Bailiff reports

French courts are large consumers of bailiff reports.

Such reports are usually used to prove:

- ▶ the purchase of accused products (purchase report);
- ▶ the content of a website containing evidence of infringement (website report).

When other jurisdictions might accept the production of a sample purchased in a store or captures of websites, French courts request that such purchase or capture be performed by a bailiff.

Bailiffs and case law have developed detailed rules to draft such reports:

- ▶ for a purchase report, the bailiff, who is not authorised to enter private premises (even if they are open to the public), stays in the front of the store and records that the claimant's patent attorney enters the store with empty hands and gets out with the purchased goods, as well as with an invoice and receipt of payment; the bailiff drafts a report and seals the products, the invoice and the receipt;
- ▶ for a website report, the bailiff must follow a detailed procedure to delete the memory of his computer and prove that he has actually visited a remote website.

The advantage of such ordinary bailiff reports is that they can be drafted without informing the possible defendant and they raise no obligation to launch an action.

Accordingly, ordinary bailiff reports are regularly used before any litigation to start gathering evidence of infringement and to serve as a backup in case other pieces of evidence are refused.

2.1.2. The *saisie-contrefaçon*

The *saisie-contrefaçon* is the most efficient way of gathering evidence of infringement in France. 80% of patent infringement proceedings initiated in France start by a *saisie-contrefaçon*. 600 *saisies* are ordered each year by the court of Paris (probably 1,500 each year in France) for all IP matters.

The *saisie-contrefaçon* procedure existed in France before the Enforcement Directive. In fact, the *saisie-contrefaçon* procedure obviously inspired Article 7 of the Enforcement Directive regarding the measures for preserving evidence.

In France, the implementation of the Enforcement Directive was used as an opportunity to harmonise the provisions regarding the *saisie-contrefaçon* for all intellectual property rights. But the said implementation has not significantly changed the rules regarding the *saisie-contrefaçon*.



A *saisie-contrefaçon* is only an evidentiary measure. It is not an injunction nor a seizure of the whole stock. The seizure of the whole stock may be obtained, even in *ex-parte* proceedings, by way of a preliminary injunction.

The *saisie-contrefaçon* procedure may be described as follows, in a nutshell.

A *saisie-contrefaçon* is performed upon an authorisation granted by the presiding judge of the local court, issued in *ex-parte* proceedings. A *saisie-contrefaçon* is a right and the judge cannot refuse to authorise it. The judge may only amend the scope of the authorised measures.

The request may be filed by the patentee or an exclusive licensee.

No *prima facie* evidence of infringement is necessary. The patentee or the exclusive licensee only has to demonstrate that the patent is in force, and that they are the current patent-holder or the current exclusive licensee⁵.

The defendant is not informed of the request or the order; it is informed of the *saisie* only when it is performed.

The court order authorises a bailiff, usually accompanied by an expert (in practice the patentee's patent attorney), both chosen by the claimant, to enter the premises mentioned in the order and to:

- ▶ describe the allegedly infringing product or process;
- ▶ copy any document regarding the allegedly infringing product or process (drawings, specifications, commercial or administrative or regulatory documents);
- ▶ describe the extent of the infringement and seize accounting documents;
- ▶ physically seize samples of the products or means used to manufacture the product.

If necessary and if it is provided for in the court order, the process may be run in order to enable the description; the product may also be dismantled.

The bailiff drafts a report, in which he records all his observations as well as those of the patent attorney, hands it out to the claimant, which exhibits it to the court later.

When confidential information is described or copied, the defendant may ask the bailiff not to describe it in his report but to place the description or the seized document or product in a sealed envelope.

In such case, the envelope is kept by the bailiff until an expert is appointed by the court.

When an expert is appointed, established case law provides that the claimant is entitled to gain access to any relevant information, be it confidential or not; only irrelevant and confidential information should remain secret.

⁵ A *saisie-contrefaçon* order is usually issued in the light of an official copy of the patent, an extract from the European and / or French patent register and a receipt of the payment of annual fees.

The claimant must start proceedings within 31 calendar days following the *saisie*⁶. Absent the initiation of an action, the *saisie* is null and void.

Accordingly, the *saisie-contrefaçon* is a very efficient tool to gather evidence of infringement.

As stated above, the French rules regarding the *saisie-contrefaçon* have not significantly changed following the implementation of the Enforcement Directive. The only novelty concerns the possibility to seize equipment and tools to manufacture, distribute or implement the accused product or process.

2.1.3. Expert opinions and court appointed experts

The parties may exhibit expert opinions.

Experts which are registered on the list held by each Court, notably the Court of appeal of Paris or by the *Court de cassation* (the highest civil court) are bound by professional rules, which include the obligation to assist the Court.

Such opinions are given in writing adduced to the other party and to the court, like any other written exhibit.

Party-appointed experts are never heard by the court or cross-examined by the other party.

The use of party appoint expert is frequent but not as systematic as in other countries, the UK for example.

The Court may also appoint expert to obtain information on a fact (usually a technical issue); in such case, the expert hand its report to the Court, and is bound to be impartial.

French courts very rarely appoint experts to provide information or opinions with respect to patent validity or patent infringement.

They do so on very rare occasions, for example:

- ▶ when a *saisie-contrefaçon* is performed against a company holding information classified as official secret, in which case the *saisie* is converted into expert proceedings with an expert authorised to deal with official secrets;
- ▶ when the parties disagree on the result of technical measurements.

No general opinion, however, may be requested from an expert by French courts with respect to the validity or the infringement of the patent.

⁶ French law provides that the action must be started not later than 20 working days or 31 calendar days after the *saisie*, which ever is longer; because of the French rules on the computation of time periods, a 31 calendar day period is always the longest.

2.1.4. Compulsory production of evidence

Article 6 of the Enforcement Directive relates to the production of evidence by the opposing party.

This Article was not implemented in French law on the ground that the ordinary rules of the French Civil Code and the French Code of Civil Procedure provide for the compulsory production of evidence.

In practice, the compulsory production of evidence is rarely ordered by French courts. It is in fact ordered only when:

- ▶ the patentee was unable to gather evidence during the *saisie*; absent an attempt to get the document during the *saisie*, the compulsory production is usually refused;
- ▶ the requested document is clearly identified and its existence is demonstrated (no general or unspecified request is admitted).

One could expect that, because national provisions must be implemented in view of the European Directive, the French provisions regarding the compulsory production of evidence would be more frequently used.

However, no such tendency has been seen at this stage.

Some decisions ordered the compulsory production of documents for patent matter, shortly before the implementation of the Enforcement Directive:

- ▶ in *Schindler v. Otis* (TGI Paris, JME, 11 July 2007), the patentee could not obtain the accused product during the *saisie-contrefaçon* and the defendant refused to sell it. The judge in charge of the case management ordered the defendant to sell two samples of the accused product to the patentee.

However, this remains rare, even after the implementation of the Enforcement Directive:

- ▶ in *Newdeal v. Wright* (TGI Paris, JME, 8 October 2007), the judge in charge of the case management refused to order the defendant to exhibit a drawing of the accused product because the patentee decided not to perform a *saisie* and did not prove that the product is sold in France;
- ▶ in *Honda v. Wuxi Kipor, Narbonne Accessoires, Distri 24* (TGI Paris, JME, 12 March 2008), the judge in charge of the case management decided that "*when the saisie-contrefaçon is possible, the provisions of the French Code of Civil Procedure, notably regarding the compulsory production of evidence, are not applicable*".

2.1.5. Right of information

The right of information was introduced in French law by the implementation of the Enforcement Directive.

It appears to be a powerful tool to obtain information on the channel of distribution as well as the scope of the infringing activities.

Previously, this information could only be gathered through a *saisie-contrefaçon*.

Since the entry into force of this new provision, it has been applied on several occasions.

In *Textile Well v. C&A France, Hudson Kunert Vertriebs* (21 March 2008), the Judge managing the case of the *Tribunal de Grande Instance* of Paris ordered that a German company (with no representation in France) provides the names of the manufacturers, suppliers and holders of the allegedly infringing goods, as well as the amount manufactured, supplied, ordered and received on the French territory together with the alleged infringers' turnover and accounting documents.

In *SBM v. Playshare, Toh, Wright, Hilstead* (18 April 2008), the Judge managing the case of the *Tribunal de Grande Instance* of Paris decided that the defendants' annual accounts (including the gross turnover, operating charges, net result before taxes, profit margin...) should be exhibited under penalty.

In *Ebay v. Lancôme Parfums et Beauté and L'Oréal* (25 June 2008), the Judge managing the case of the *Tribunal de Grande Instance* of Paris ordered Ebay to exhibit the quantities of infringing products sold, as well as the amount of commissions received for these sales.

Controversy exists whether the right of information can be exercised during the action on the merits (*i.e.* in connection with the alleged infringement) or only after a decision has been issued on the infringement:

- ▶ TGI Paris, 3rd chamber, 2nd section, 21 March 2008: "*the new provisions apply to pending proceedings and the judge in charge of the case management has jurisdiction. The right of information can be exercised **before** a finding for infringement*";
- ▶ TGI Paris, 3rd chamber, 1st section, 26 March 2008: "*the right of information can **only** be exercised **after** a finding for infringement, because the new provisions refer to the infringing products and not to the allegedly infringing product.*"

2.2. Gathering of evidence in the UK

In the UK, the IP Rights Enforcement Directive (2004/48/EC) was implemented by the Intellectual Property (Enforcement, etc) Regulations 2006 (SI 2006/1028), which came into force on 29 April 2004. However, the Enforcement Directive has not had such a significant effect in England as in other European jurisdictions with regard to obtaining evidence. As one would expect from a common law jurisdiction, England already had wide ranging discovery procedures. In fact, all the procedures contemplated by the Enforcement Directive were previously available in England.

Gathering of evidence in the UK could be represented as follows:



The means of gathering evidence in the UK include:

- ▶ Disclosure (including 3rd party, pre-action and Norwich Pharmacal Orders);
- ▶ Search orders;
- ▶ Witness Statements of Facts;
- ▶ Expert opinion.

2.2.1. Disclosure

2.2.1.1. Standard Disclosure – CPR Part 31.6

The traditional method for obtaining evidence from another party in English proceedings is disclosure. Disclosure is governed by the Civil Procedure Rules 1998 (CPR) and the basic position is that parties to all litigation, including intellectual property litigation, are required to disclose documents which they rely on or which harm their case. This is known as standard disclosure. It is designed to allow the court to do justice between the parties with "all the cards on the table".

The meaning of "document" is broad and embraces anything in which information of any description is recorded, including electronic documents and metadata. A party is required to make a "reasonable" search for the documents, and factors such as the number of documents involved, the nature and complexity of the proceedings and the ease and expense of retrieval are considered.

Where *infringement* of a patent for a product or process is alleged, the potential infringer can avoid documentary disclosure on the issue of infringement by providing full particulars of the product or process alleged to infringe and drawings or other illustrations if necessary.

Where *validity* of a patent is put in issue, disclosure is limited, in the first case, to documents which came into existence within the period beginning two years before the earliest claimed priority date, and ending two years after that date.

If a party believes that another party's disclosure is inadequate he can apply to the court for an order for specific disclosure under CPR Part 31.12(1). The underlying purpose of specific disclosure is to ensure that one party does not have or obtain an unfair advantage or suffer an unfair disadvantage in litigation as a result of a document not being produced for inspection by way of standard disclosure.

2.2.1.2. Pre-Action Disclosure – CPR Part 31.16

Rule 31.16 of the CPR allows a prospective claimant to seek an order for specific disclosure of documents *before proceedings have started*. Pre-action disclosure is available where:

1. the respondent is likely to be a party to subsequent proceedings;
2. the applicant is also likely to be a party to those proceedings;
3. if proceedings had started, the respondent would have to disclose the document by way of standard disclosure, set out in rule 31.6;
4. disclosure is desirable in order to –
 - i. dispose fairly of the anticipated proceedings;



- ii. assist the dispute to be resolved without proceedings; or
- iii. save costs

However, the applicant must have an arguable case on merits and disclosure will be limited to what is necessary. Furthermore, the court has discretion as to whether it is "desirable" to order disclosure:

1. "roving inquisition" should not replace "focused allegations" unless there is real evidence of dishonesty or abuse;
2. competitors' secret designs should not be examined without convincing evidence

Hence, there is a "Chicken and egg" problem on the merits – disclosure needed to support a case, but real evidence of wrong-doing required first to support an application for disclosure.

Therefore, to increase the likelihood of the court agreeing to order pre-action disclosure, the applicant should ensure that the application is as focused as possible on key documents.

An applicant also needs to bear in mind that (in contrast to standard disclosure) even where the application is successful, they will usually still have to bear the cost of the defendant undertaking the requested disclosure exercise.

2.2.1.3. Third Party Disclosure – CPR Part 31.17

Once proceedings are under way, a claimant may also seek specific disclosure of documents *against a 3rd party* under CPR Part 31.17, where that 3rd party is likely to possess relevant documents. The application must be for documents which are likely to support the case of the applicant or adversely affect the case of one of the other parties, and must be necessary in order to dispose fairly of the claim or to save costs.

However, often third parties agree to give documents without an order of the Court.

It must be noted that disclosure sought under CPR 31.17 can only relate to documents; if the applicant wishes to obtain other information (e.g. the identity of a potential defendant) it will have to apply for a Norwich Pharmacal order (see below).

2.2.1.4. Norwich Pharmacal order

An IP right owner may in some instance apply for a Norwich Pharmacal order (*Norwich Pharmacal v Commissioners of Customs & Excise* [1974] AC 133).

The procedure is different from applications for disclosure under the CPR, and the order is usually sought when the criteria under CPR rule 31.16 or rule 31.17 cannot be satisfied. Thus, before proceedings are issued, a Norwich Pharmacal order may be sought where the applicant knows that the respondent will not be a party to the potential proceedings. Where proceedings have been issued and disclosure is sought from a non-party, the order should be sought where the applicant wishes to obtain information which cannot be obtained under CPR 31.17, such as the identity of a potential wrongdoer.

The English Court have summarised the requirements for a Norwich Pharmacal order in *Mitusi & Co v Nexen Petroleum UK Ltd* [2005] EWHC 625 (Ch):

1. An order will not be available if the patentee could obtain the information it required through, for example, third party or pre-action disclosure;

2. The subject of the application is likely to have relevant documents or information;
3. The subject of the application is 'involved' in the wrongdoing (though not necessarily culpable for it);
4. The "mere witness" rule is not infringed unless there is no other source of the information;
5. The order is necessary in the interest of justice.

The court's jurisdiction to grant Norwich Pharmacal orders is preserved in its entirety by CPR 31.18, which states expressly that CPR 31.16 and CPR 31.17 do not limit any other power which the court may have to order pre-action disclosure or disclosure against a person who is not a party to the proceedings.

2.2.2. Search Orders – "Anton Piller" Orders

The English Court can also make a so-called search & seizure order – previously known as an Anton Piller order. This order allows solicitors to enter a potential defendant's premises without notice and seize documents and samples of infringing goods.

However, in contrast to the similar "saisie contrefaçon" procedure routinely ordered in France, where no prima facie evidence of infringement is necessary, search orders are very difficult to obtain in the UK and are rarely granted. The applicant must show:

- (1) a very strong prima facie case of infringement on the merits;
- (2) a real danger of serious actual or potential damage to the applicant if the Order is not granted; and
- (3) a real danger that the respondent would destroy key incriminating material if notified.

This difference between France and England highlights one of the main issues with the Enforcement Directive; it is an attempt to create a minimum standard, rather than a single regime. Consequently, although all EU countries must have these procedures, when and how the procedures are ordered by the Court can vary widely.

2.2.3. Witness statements of Facts

Witness statements of facts are commonly used in UK proceedings, including intellectual property disputes. Such statements can be made by any person, including the parties, their solicitors and investigating agencies. A witness statement must include a statement by the intended witness that he believes the facts in it are true. Knowingly (or potentially even negligently) making an incorrect statement can lead to a punishable contempt of court.

Witness statements are often used to prove sale of infringing products or the content of websites, and in contrast to France, the monitoring of sales and the purchase goods to be assessed for IPR infringement do not need to be performed by a bailiff. In fact, it is common place to instruct a private investigation agency, which will produce a witness statement in relation to the monitoring activities and purchases made.

2.2.4. Expert Reports

In contrast to the position in France, IP and in particular patent proceedings in the UK rely heavily on the opinions of experts.

The expert evidence is to be given in a written report. Commonly, each party instructs its own expert, however, the court may in some instances direct that evidence is to be given by a single joint expert (this is, however, almost unheard of in patent cases). The duty of the expert is to help the court on the matter within his expertise; this duty overrides any obligation to the person from whom he has received instructions or by whom he is paid.

Experts have an obligation to attend court if called upon to do so, and are commonly extensively cross-examined by the other party.

In patent cases, the expert will provide his/her opinion with regard to the validity or infringement of the patent, and this opinion will play a significant role in the court's decision of a case.

3. Protective orders and use of information in parallel proceedings

This section discusses how evidence gathered in France (3.1.) and in the UK (3.2.) can be used abroad.

A specific focus should also be made on Regulation EC No. 1206/2001 regarding cooperation between member states on the taking of evidence (3.3.).

3.1. *How to use abroad information gathered in France?*

French rules of civil procedure contain no express nor implicit protective orders.

Information gathered in France, and evidence adduced by the other party, in France, can thus be used freely in parallel proceedings.

But these documents must be used only for evidentiary purposes; if documents adduced by the other party are used for other purposes (disparagement, use in proceedings unrelated to the patent infringement), the defendant may request compensation if damage is suffered.

In very rare cases, confidentiality measures can be agreed between the parties or imposed by the judge to limit access to information:

- ▶ to the parties (sometime a small number of individuals) and their attorney;
- ▶ to the parties attorneys-at-law and patent attorneys (extremely rare).

The parties may also request that the oral hearing take place in camera (non-public hearing). This measure, which requires both parties' consent, may be used in order to preserve trade secrets, according to Article 435 of the French Code of Civil Procedure.

But the judgement handed down is public, and it is impossible to have the French court issue redacted judgement.

The same is true for information gathered during a French *saisie-contrefaçon*.

When a *saisie-contrefaçon* is performed in France, for the purpose of a French action, the gathered information may be used in parallel actions. There is no protection (*i.e.* no implied protective order) attached to the information gathered through a *saisie*.

The use in foreign proceedings of the information gathered in France is rarely disputed.

Only very few decisions have addressed this issue or ruled on a request to obtain a protective order in relation to the information gathered in France. And the few decisions issued tend to confirm that the documents can be used without restriction:

- ▶ in *Monsanto v. Merck* (24 November 1997), the President of the *Tribunal de Grande Instance* of Paris ruled that documents which are useful to prove the infringement and not confidential may be used freely in foreign proceedings and the confidential documents which are useful to prove the infringement could also be used but with a limited access to the parties' lawyers and patent attorneys;
- ▶ in *Rhône-Poulenc Rorer v. Bristol Myers Squibb* (30 September 1998), the *Cour d'Appel* of Paris held that the use in foreign proceedings of confidential documents useful to prove the infringement could not be restricted by a preliminary order; the claimant was only prohibited from using the confidential documents which are not useful to prove the infringement; in this judgement, the court added that the claimant could use the documents at its own risks and in consideration of the defendant's statement that it would challenge, in the foreign litigation, the use of the documents seized in France;
- ▶ in *Quick Turn Design v. Meta System* (29 July 1999), the President of the *Cour d'Appel* of Paris, decided that:
 - non confidential documents useful to prove the infringement could be used freely by the parties, in current or future proceedings, be they domestic or foreign;
 - confidential documents useful to prove the infringement could be used in foreign proceedings only after a final judgement on the merits has found the infringement.

We consider that the orders of 1997 and 1999 are questionable and that there is no reason to restrict the use of documents useful to prove the infringement to French courts.

Note that a French *saisie-contrefaçon* may only be performed on the basis of a French patent, not on the basis of a foreign patent.

3.2. How to use abroad information gathered in the UK

In contrast to the position in France, information obtained through disclosure and evidence adduced by a party in English proceedings is limited for use in those proceedings and therefore cannot be freely used in parallel proceedings. An exception to this rule is where that evidence has been read out or referred in a public court hearing (unless a court order to the contrary is obtained at the time).

3.2.1. Use of disclosed documents

Under Rule 31.22 of the CPR, a party to whom a document has been disclosed may use the document *only* for the purpose of the proceedings in which it is disclosed, unless it is read out in court (or referred to at a hearing held in public), the court gives permission; or the other party consents.

The court may, however, make an order restricting or prohibiting the use of a document which has been disclosed, even where the document has been read out in court (or referred to at a hearing held in public).

3.2.2. Use of witness statements and expert reports

Under CPR Part 32.12, a witness statement may be used *only* for the purpose of the proceedings in which it is served, unless (a) the witness gives consent, (b) the court gives permission, or (c) the witness statement has been put in evidence at a hearing held in public.

Under CPR rule 32.14, a witness statement which stands as evidence in chief is open to inspection during the course of the trial unless the court otherwise directs, although any person may ask that a witness statement, or words or passages in it, are not open to inspection. However, the court will not make such a direction unless it is satisfied that a witness statement should not be open to inspection because of:

- (1) the interests of justice;
- (2) the public interest;
- (3) the nature of any expert medical evidence in the statement;
- (4) the nature of any confidential information in the statement; or
- (5) the need to protect the interests of any child of protected party.

Therefore, a party will usually not be able to use another party's witness statements in parallel proceedings until it has been put in evidence at a UK hearing held in public.

The status regarding the use of expert reports is less clear. In *L'Oreal v Bellure NC* [2006] EWHC 1503 (CH), May 24, 2006, unrep (Peter Smith J) it was held that the rule cited above in relation to witness statements does not apply to an expert report. However, *L'Oreal v Bellure* was an interim hearing judgement, which has not been tested at trial or on appeal. It is therefore uncertain whether it will be followed.

3.3. Regulation EC regarding cooperation between member states

It is important to remind that the EC Regulation No. 1206/2001 of 28 May 2001 on cooperation between the courts of the Member States in the taking of evidence in civil or commercial matters enables a court of a Member State to request the court of another Member State to perform a specific procedure for taking evidence.

In *Tedesco v. Tomasoni*, the ECJ had been asked to decide whether a UK court could refuse to perform an Italian *descrizione* in the UK for the purpose of an action for infringement of an Italian patent pending in Italy. The matter settled before the ECJ could issue its decision, but the *Avocat General* (18 July 2007) was of the opinion that the UK court should have arranged the *descrizione*.

The use of Regulation EC No. 1206/2001 is thus the only appropriate way to perform a *saisie*-like procedure, in France, on the basis of a foreign patent.



4. The timing of disclosure and information gathering in different jurisdictions

We will describe the practice of information gathering in France (4.1.) and in the UK (4.2.).

4.1. France

From the beginning of the proceedings, and even well before, when possible, the right-holder should gather evidence of infringement.

In France, most of the evidence is usually obtained before the launch of the action through bailiff reports and *saisies-contrefaçon*.

Often, bailiff reports (purchase and website reports) are arranged to record the sale or offer for sale of accused products or to obtain samples.

But French Law has gained a reputation of efficiency through *the saisie-contrefaçon*. The *saisie* is usually arranged at the very beginning of the proceedings in order to take the defendant by surprise. Several *saisies* may be arranged simultaneously or consecutively, for example on the manufacturer's premises and the retailer's premises if insufficient evidence is obtained in the first location.

In the pharmaceutical field a *saisie* is usually arranged at the French regulatory authority (Afssaps).

After a *saisie*, the claimant must start the infringement action; absent such an action, the whole *saisie* is null and void. But a *saisie-contrefaçon* may also be carried out during the course of legal proceedings.

Additional evidence may be obtained, after the initiation of the proceedings, through the right of information or the compulsory production of evidence during the proceedings on the merits. But as stated above, French courts are very strict on the compulsory production of evidence, in particular if it appears that evidence could have been obtained through a *saisie*. Accordingly, such measures are more likely to be ordered if a *saisie* was performed but insufficient information obtained.

4.2. UK

In the UK, only limited information is obtained before any proceedings for patent infringement are commenced, and typically consists of evidence of the infringing act, such as sale offers of the infringing product(s). In some instances, pre-action disclosure or a search order may be available, although as mentioned above, the court will be reluctant to make any such order. Instead, most evidence is obtained once the procedures have started, during standard disclosure.

A claimant will need relatively little evidence to commence an infringement action. However, the burden to prove infringement at trial is on the claimant. This means that although the initial pleading is brief, the evidence needed to establish infringement will be gathered through disclosure, witness statements of fact and expert evidence.

5. Tentative ideal strategy

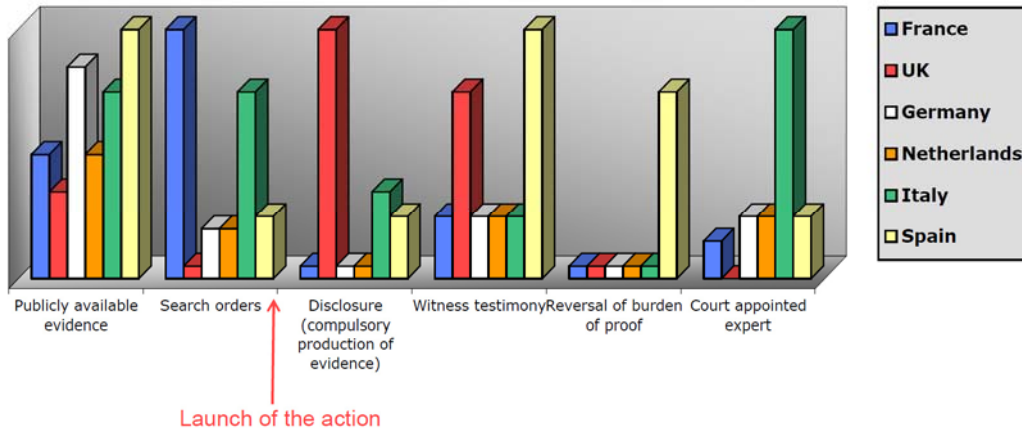
A tentative ideal strategy, when parallel proceedings are initiated in France and UK could be as follows:

France		UK
Witness statements and testimonies		
Bailiff reports of website or bailiff purchase		
<i>Saisie-contrefaçon</i>	➔	(use information gathered in France)
Inseption of the action on the merits		
Request for compulsory production of documents if necessary	➔	(use information gathered in France)
		Disclosure
(Use documents obtained from UK disclosure)	➔	Request for a leave of the protective order to use documents abroad
Request cooperation of foreign court		
Regulation EC No. 1206/2001 or Vienna Convention		
(Use information made public during oral hearing)	➔	UK trial
French trial		

6. Conclusion

Even with legal provisions harmonized on several occasions, the practice of gathering of evidence is very different from country to country.

The following chart compares the practice in France and UK, presented above with that of Germany, the Netherlands, Italy or Spain:



It confirms how different the practice is.

As a consequence, in order to obtain harmonized procedure before the procedure before the European patent Court, it will not be sufficient to have a common rules of civil procedure. The judges (in particular the *juge rapporteur*) will also need to harmonize their practice of civil procedure.