

## Bringing Evidence before the Unified Patent Court Lessons from the French *saisie-contrefaçon*

Patentanwaltskammer Seminar  
"Das Verfahren vor dem Einheitlichen Patentgericht"  
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Evidence in  
the Unified Patent Court

### Overview

- Legal sources
- Means of evidence
- Order to produce evidence
- Protection of confidential information
- Order to preserve evidence and to inspect premises
- Comparison with the French *saisie-contrefaçon*

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## Legal sources

-  17 December 2012  
**Regulation** 1257/2012 enhanced cooperation creation of unitary patent protection
-  17 December 2012  
**Regulation** 1260/2012 (translation arrangements)
-  19 February 2013  
**Agreement** on a Unified Patent Court and draft Statute
-  19 October 2015  
Draft **Rules of procedure** Unified Patent Court (V18)



[http://www.upc.documents.eu.com/PDFs/2015-10-19\\_Agreement\\_UPC\\_DE-EN-FR\\_and\\_Rules\\_Procedure\\_UPC\\_DE-EN-FR\\_Draft\\_18.pdf](http://www.upc.documents.eu.com/PDFs/2015-10-19_Agreement_UPC_DE-EN-FR_and_Rules_Procedure_UPC_DE-EN-FR_Draft_18.pdf)

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## The main publicly available documents can be found on [www.upc.documents.eu.com](http://www.upc.documents.eu.com)



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**Chapter III**  
**UPC Agreement**

**CHAPTER III – PROCEEDINGS BEFORE THE COURT**

Article 52. Written, interim and oral procedures

➔ Article 53. Means of evidence

Article 54. Burden of proof

Article 55. Reversal of burden of proof

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**Chapter IV**  
**UPC Agreement**

**CHAPTER IV – POWERS OF THE COURT**

Article 56. The general powers of the Court

Article 57. Court experts

➔ Article 58. Protection of confidential information

➔ Article 59. Order to produce evidence

➔ Article 60. Order to preserve evidence and to inspect premises

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**Rules 169 to 202**  
**Rules of Procedure**

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**PART 2. – EVIDENCE**

Chapter 1 – Witnesses and experts of the parties  
(Rules 175-180)

Chapter 2 – Court experts (Rules 185-188)

Chapter 3 – Order to produce evidence and to communicate  
information (Rules 190-191)

Chapter 4 – Order to preserve evidence (*saisie*) and order for  
inspection (Rules 192-199)

Chapter 5 – Other evidence (Rules 200-202)

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**Article 53 (1) UPC Agreement**  
**Means of evidence**

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*"(1) In proceedings before the Court, the means of giving or  
obtaining evidence shall include in particular the following:*

- (a) hearing the parties;*
- (b) requests for information;*
- (c) production of documents;*
- (d) hearing witnesses;*
- (e) opinions by experts;*
- (f) inspections;*
- (g) comparative tests or experiments;*
- (h) sworn statements in writing (affidavits)..."*

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**(a) hearing the parties**

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**(b) requests for information**



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## (c) production of documents



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### Rule 170(1)

## Means of evidence and means of obtaining evidence

"1. In proceedings before the Court, the means of evidence shall include in particular the following:

- ▶ written evidence, whether printed, hand-written or drawn, in particular documents, written witness statements, plans, drawings, photographs;
- ▶ expert reports and reports on experiments carried out for the purpose of the proceedings;
- ▶ physical objects, in particular devices, products, embodiments, exhibits, models;
- ▶ electronic files and audio/video recordings."

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## (d) hearing witness

*"(2) The Rules of Procedure shall govern the procedure for taking such evidence. (see Rules 175-180)  
Questioning of witnesses and experts shall be under the control of the Court and be limited to what is necessary."*



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## (d) hearing witness



*"(2) The Rules of Procedure shall govern the procedure for taking such evidence. (see Rules 175-180)  
Questioning of witnesses and experts shall be under the control of the Court and be limited to what is necessary."*

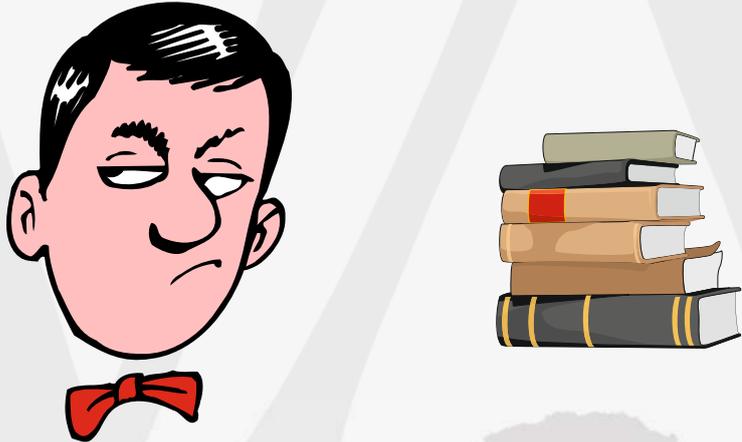


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**(e) opinions by experts**



A cartoon illustration of a man's face with a serious expression, wearing a red bow tie. To his right is a stack of five books of various colors (green, grey, orange, brown, dark blue). The background features a stylized sunburst pattern.

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**(f) inspections**



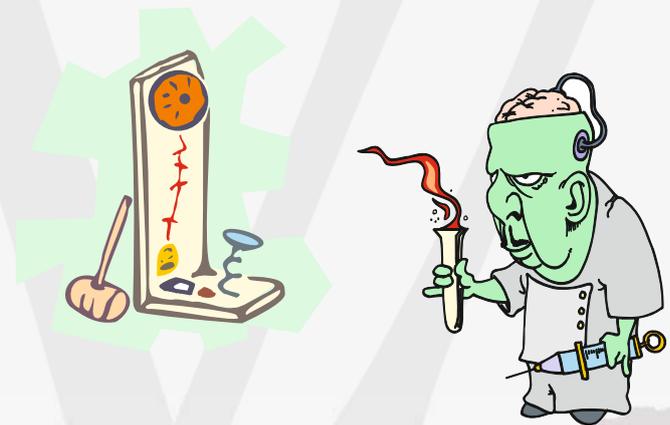
A black and white cartoon illustration of two men in trench coats and hats inspecting a vintage car. One man is standing by the open driver-side door, looking at a document. The other man is leaning over the front of the car, examining the engine compartment. The background shows a simple building with a fence.

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## (g) comparative tests or experiments



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## (h) sworn statements in writing

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## Rule 171

**Offering of evidence**

*"1. A party making a statement of fact that is contested or likely to be contested by the other party shall indicate the means of evidence to prove it. In case of failure to indicate the means of evidence regarding a contested fact, the Court shall take such failure into account when deciding the issue in question.*

*2. A statement of fact that is not specifically contested by any party shall be held to be true as between the parties."*

## Rule 172

**Duty to produce evidence**

*"1. Evidence available to a party regarding a statement of fact that is contested or likely to be contested by the other party **must be produced** by the party making that statement of fact.*

*2. The Court may at any time during the proceedings order a party making a statement of fact to produce evidence that lies in the control of that party. If the party fails to produce the evidence, the Court shall take such failure into account when deciding on the issue in question."*

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Rule 202

## Letters Rogatory



- Court may issue letters rogatory for the production of documents or the hearing of witnesses or experts by other competent courts or authorities outside the European Union
- The other court or authority shall follow its own procedures in executing such requests

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Article 58 UPC Agreement

## Protection of confidential information: general principle

*"To protect the trade secrets, personal data or other confidential information of a party to the proceedings or of a third party, or to prevent an abuse of evidence, the Court may order that the collection and use of evidence in proceedings before it be **restricted or prohibited** or that access to such evidence be restricted to specific persons"*

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## Rule 262

**Protection of confidential information:  
public access to written pleadings**

"1. ...*written pleadings, written evidence, decisions and orders* lodged at or made by the Court and recorded by the Registry **shall be available to the public, unless a party has requested that certain information be kept confidential** and provided specific reasons for such confidentiality. ... Where a party requests that parts of written pleadings or written evidence shall be kept confidential, he shall also provide copies of the said documents with the relevant parts redacted when making the request."

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## Rule 262 continued

**Protection of confidential information:  
public access to written pleadings**

"2. A member of the public may lodge an Application with the Court for an order that any information excluded from public access pursuant to paragraph 1 may be made available to the applicant.

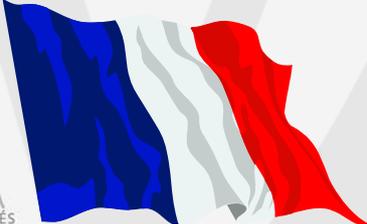
3. The Application shall contain [details, grounds, purpose]

4. The Court shall invite written comments from the parties prior to making any order.

5. The Court shall allow the Application unless legitimate reasons given by the party concerned for the confidentiality of the information outweigh the interest of the applicant to access such information."

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**Comparison**  
**The French *saisie-contrefaçon* and the UPC "Order to preserve evidence"**

<p><b>France</b>  <i>Saisie-contrefaçon</i></p> <p>Intellectual Property Code                  Article L. 615-5                  Articles R. 615-2 to R. 615-4</p> 	<p><b>Unified Patent Court</b>  <i>Order to preserve evidence and to inspect premises</i></p> <p>Unified Patent Court Agreement                  Article 60                  Rules of procedure 192-199</p> 
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**The French *saisie-contrefaçon***



**Code de la propriété intellectuelle  
 Article L. 615-5**

*"The infringement shall be proven by any means. For that purpose, **any person** with authority to bring an action for infringement **shall be entitled**, on the ex parte order issued by the competent civil court, **to direct any bailiff if necessary accompanied by experts appointed by the claimant**, to proceed in any place with either the detailed description, with or without the taking of samples, or the physical seizure of the allegedly infringing articles or processes as well as any related document. The order may authorise the physical seizure of any document relating to the allegedly infringing products or processes in the absence of these products or processes."*

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Article 60 UPC Agreement

## Order to preserve evidence and to inspect premises

(1) At the request of the applicant which has presented reasonably available evidence to support the claim that the patent has been infringed or is about to be infringed the Court may, **even before the commencement of proceedings on the merits of the case**, order prompt and effective provisional measures to preserve relevant evidence in respect of the alleged infringement, subject to the protection of confidential information.

(2) Such measures may include the **detailed description, with or without the taking of samples, or the physical seizure of the infringing products**, and, in appropriate cases, the materials and implements used in the production and/or distribution of those products and the documents relating thereto.

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Article 60 UPC Agreement

## Order to preserve evidence and to inspect premises

(3) The Court may, even before the commencement of proceedings on the merits of the case, at the request of the applicant who has presented evidence to support the claim that the patent has been infringed or is about to be infringed order the **inspection of premises**. Such inspection of premises shall be conducted by **a person appointed by the Court** in accordance with the Rules of Procedure. (see Rules 192-199)

(4) At the inspection of the premises **the applicant shall not be present itself but may be represented by an independent professional practitioner** whose name has to be specified in the Court's order.

(5) Measures shall be ordered, if necessary without the other party having been heard, in particular where any delay is likely to cause irreparable harm to the proprietor of the patent, or where there is a demonstrable risk of evidence being destroyed... "

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## Obtaining the order much easier in France than at UPC

France	Unified Patent Court
<ul style="list-style-type: none"> <li>■ a <i>saisie</i> order is a right for the patent owner: the applicant is not required by law to present evidence of infringement</li> <li>■ the other party is never heard nor informed before the <i>saisie</i></li> </ul>	<ul style="list-style-type: none"> <li>■ the applicant must present "<i>reasonably available evidence to support the claim that the patent has been infringed or is about to be infringed</i>"</li> <li>■ "<i>measures shall be ordered, if necessary without the other party having been heard, in particular where any delay is likely to cause irreparable harm to the proprietor of the patent, or where there is a demonstrable risk of evidence being destroyed</i>"</li> </ul>

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## Conduct similar in France and at UPC

France	Unified Patent Court
<ul style="list-style-type: none"> <li>■ the applicant shall not be present itself</li> <li>■ the <i>saisie</i> is conducted by a bailiff (a variety of public officer) chosen by the applicant</li> <li>■ the bailiff may be assisted by experts chosen by the applicant; they must be "independent" (usually the applicant's patent attorney)</li> </ul>	<ul style="list-style-type: none"> <li>■ "<i>the applicant shall not be present itself</i>"</li> <li>■ "<i>inspection of premises shall be conducted by a person appointed by the Court</i>" : expert or bailiff or expert + bailiff or patent attorney (not involved in the case)</li> <li>■ "<i>the applicant ... may be represented by an independent professional practitioner whose name has to be specified in the Court's order</i>"</li> </ul>

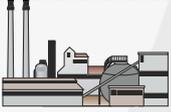
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**Article L. 615-5 IPC**  
**The French *saisie-contrefaçon***  
**The casting**





**Bailiff chosen by the applicant conducts the inspection**

A police squad may assist if the bailiff feels it appropriate





**Expert chosen by the applicant. Must be "independent" (usually the applicant's patent attorney)**



**The Applicant is not permitted to attend in person**



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**Article 60 UPC Agreement - Rules 192-199**  
**Order to preserve evidence and to inspect premises**  
**The casting**





**Person appointed by the court to conduct the inspection:**

- ▶ expert
- ▶ or bailiff
- ▶ or expert + bailiff
- ▶ or patent attorney (not involved in the case)

*"in accordance with the national law of the place where the measures are executed"*





**Independent professional practitioner representing the applicant (applicant's patent attorney)**

**The Applicant is not permitted to attend in person**



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## The same things can be done in France and at UPC

### France

"1. The Court may order, in particular, the following:  
a) preserving evidence by detailed **description**, with or without the **taking of samples**;  
b) **physical seizure** of allegedly infringing **goods**;  
c) **physical seizure** of the **materials** and implements used in the production and/or distribution of these goods and **any related document**;  
d) the preservation and disclosure of **digital media and data** and the disclosure of any passwords necessary to access them."

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Rule 196 – Order on the Application for preserving evidence

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## Protection of confidential information in France and at UPC

### France

- when the person subject to *saisie* alleges that a document contains confidential information, the bailiff puts it in a sealed envelope
- the document under seal will be examined by parties' counsels for redaction of information not useful for evidence of infringement
- where parties disagree, the court decides, often on the basis of a court appointed expert

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### Unified Patent Court

- "*For the protection of confidential information the Court may order that any of the above be disclosed only to certain named persons and subject to appropriate terms of non-disclosure*"

Rule 196 – Order on the Application for preserving evidence

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## Report of *saisie-contrefaçon* in France and at UPC

<b>France</b> <ul style="list-style-type: none"><li>■ the person subject to <i>saisie</i> receives immediately a copy of the report</li><li>■ The applicant also receives immediately a copy of the report (except when confidential information is at stake)</li><li>■ the report may be used for other proceedings (including foreign proceedings) unless otherwise provided</li></ul>	<b>Unified Patent Court</b> <ul style="list-style-type: none"><li>■ Rules of procedure do not specify that the person subject to <i>saisie</i> receive (immediately or later) a copy of the report</li><li>■ Rules of procedure do not specify that the applicant also receives immediately a copy of the report (the report is filed with the Registrar)</li><li>■ the report may not be used for other proceedings</li></ul>
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## How will this work in practice?



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## Localization

- Local divisions likely to follow their national practice until a UPC case law firmly establishes
- On hot topics the Court of appeal will have to set the tune

## More about *saisie-contrefaçon* and order to preserve evidence?

- Trilingual website  
[www.saisie-contrefacon.fr](http://www.saisie-contrefacon.fr)
- International conference
- Film "*Saisie-contrefaçon*"
- Trilingual book "*Saisie-contrefaçon*"

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**Trilingual website**  
[www.saisie-contrefaçon.fr](http://www.saisie-contrefaçon.fr)

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[www.saisie-contrefaçon.fr](http://www.saisie-contrefaçon.fr)  
**International conference  
 of 17 December 2012**  
**The saisie-contrefaçon in Europe**

For the 3<sup>rd</sup> edition of *Saisie-contrefaçon*, Véron & Associés held a conference on 17 December 2012 at the Palais de la découverte, in Paris, to present the equivalents to this means of proof of infringement in Belgium, the Netherlands, Germany and the United Kingdom.

Renowned specialists in patent litigation in these countries (Fernand de Visscher, Simont Braun, Brussels; Richard Ebbink and Ruprecht Hermans, Brinkhof, Amsterdam; Thomas Reimann and Martin Köhler, ROKH IP, Düsseldorf; Penny Gilbert and Alex Wilson, Powell Gilbert, London) answered many questions relating to the means of obtaining evidence in their respective country.

[View the conference PowerPoint presentation](#)

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[www.saisie-contrefacon.fr](http://www.saisie-contrefacon.fr)

## The film "Saisie-contrefaçon"

This 15-minute film aims to provide a brief introduction to the French *saisie-contrefaçon*, which allows holders of industrial property rights to obtain evidence of an infringement of such rights.

It gives non-specialists a quick and simplified overview, which cannot reflect the diversity of the situations and the legal complexity of the measure.



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## The trilingual book "Saisie-contrefaçon"



Includes a chapter on the order to preserve evidence at the Unified Patent Court

[www.bookshop-saisie-contrefacon.fr](http://www.bookshop-saisie-contrefacon.fr)

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**Pierre Véron**



Thank you

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