

Evidence of infringement: European convergence?



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Bringing evidence is the essence of a lawyer's task.

It is a particularly crucial issue for the patent litigator, who often has to show that a machine implements certain features or that a defendant operates a certain process, about which information is neither publicly nor readily available.

The ways of bringing evidence vary greatly from one country to another, making it a key feature of differentiation between the various national judicial systems.

This is not only a question of law: it is also a matter of judicial habits, difficult for an outsider to understand.

Practitioners having to manage complex parallel cases, where evidence is often spread over several countries, will therefore happily welcome a recent trend towards harmonization in this field in the main European jurisdictions, that is, the UK, Germany and France, which will be completed thanks to a recent EC Directive.

Bringing evidence used to be a lengthy and costly process in the courts of common law.

Discovery (now called disclosure in the UK) is a particularly time-consuming stage, and is sometimes perceived, from a continental point of view, as detracting energy from the substance of the trial.

Moreover, bringing evidence through the examination and cross-examination of expert witnesses during trial often leads to high litigation costs.

The new streamlined procedure, introduced in April 2003 in the English courts, has simplified to a great extent both the pre-trial phase and the trial.

When a streamlined procedure is ordered, all factual and expert evidence must be in writing, there is no requirement to give disclosure of documents, no experiments, and cross-examination is permitted only on the topics where it is necessary.

Although the main idea behind the introduction of the streamlined procedure was a reduction in the cost and timescale of English patent litigation, these changes have incidentally lessened the difficulties of bringing evidence.

Germany has followed the same trend of facilitating the bringing of evidence – or rather the taking of evidence.

The *Faxkarte* decision (issued in May 2002) has widened the scope of Article 809 of the German Civil Code (Bürgerliches Gezetzbuch, or BGB), enabling the holder of an intellectual property right, upon showing that a certain degree of probability of infringement exists, to inspect the accused device.

The Bundesgerichtshof construed Article 809 BGB in the light of Articles 43 and 50 of the TRIPs agreement, which require that a court may order that a party produce evidence, even through interlocutory measures.

This trend has been emphasized by the recent EC Directive 2004/48 on the enforcement of intellectual property rights.

According to its Article 7, the member states must ensure that a court can order prompt provisional measures to preserve evidence related to the infringement.

This provision goes into a lot of detail regarding the features of the measures at issue:

- these measures, which may be ordered *ex parte*, may include a detailed description of the infringement and taking samples;
- they may be subject to the lodging by the applicant of a security;
- the other party may lodge an appeal after execution;
- they should cease to have effect if proceedings on the merits are not instituted within a month;
- any abuse should be compensated by the applicant.

A French practitioner instantly recognizes the framework of one of France's most famous specialities: the *saisie-contrefaçon* (search and seizure order for bringing evidence of infringement).

This way of bringing evidence of infringement has proved to be so cheap, efficient and powerful for two centuries that, in complex cases, some patentees have considered launching an action in France almost only to benefit, for a foreign action, from the evidence that could be collected in France through a *saisie*.

These characteristics make it worthwhile to generalize it throughout Europe.

One should watch out for changes in the various national legislation, which will have to comply with the Directive.

Even before national provisions are enacted, courts will probably, as usual, construe the existing provisions in the light of the Directive, which might lead to quick and maybe substantial changes in national practices.

France, whose legislation is already in keeping with the Directive, should also seize this opportunity to introduce minor tweaks in its system (a transposition statute is awaited for the end of 2005).

Although some of the potholes on the road to transnational litigation will probably be filled by the harmonization to come, it must be borne in mind that this road remains a tricky one.

The experts cited in the following pages will probably be some of the best allies to guide you through it.