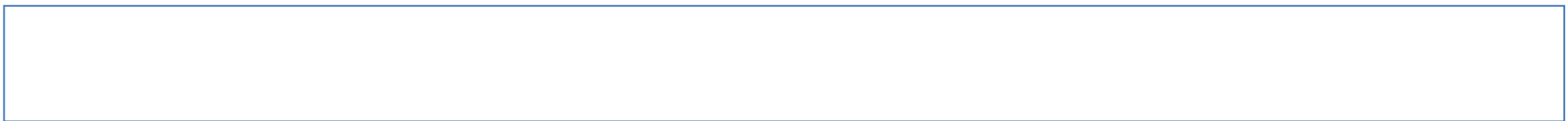


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# **AN OVERVIEW OF MEASURES FOR PRESERVING EVIDENCE IN EUROPE**



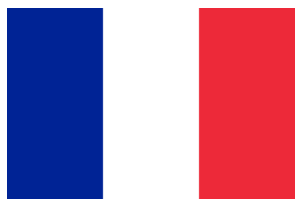
## State of the law regarding the preservation of evidence in Europe

- ✓ Towards a unification concerning measures for preserving evidence
- ✓ Directive 2004/48/EC of the European parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights

## The various legal systems

### Measures for preserving evidence in France

- ✓ The most common means of collecting evidence
- ✓ Key points to keep in mind



## “The most common means of collecting evidence”

### The french « saisie-contrefaçon »

*"Any person entitled to bring an infringement action is entitled to proceed in any place and by any bailiff, assisted by experts appointed by the applicant, under an order issued on request by the competent civil court, either a detailed description, with or without the taking of samples, or the physical seizure of the infringing products or processes alleged and all documents relating to it."*

### The bailiff's report on the Internet

*Order No. 45-2592 of 2 November 1945 concerning the status of bailiffs: being committed by Justice or at the request of individuals, they can make purely material reports, excluding any opinion on the implications of fact or law that may result.*

### The bailiff's purchase report

Legally prescribed or on request of an individual, the bailiff's purchase report lets to prove the sale of litigious goods.  
It can be performed on the Internet or outside, in a shop for example.

### The private expertise

It is possible in France to make private expertise on the alleged counterfeit goods, to prove counterfeiting.  
This expertise can be performed in a non-adversarial proceeding.

### The right to information

Introduced in 2007, this measure let to have access to information provided by third parties, in order to determine the origin and distribution networks of the goods and services possibly counterfeiting, to make possible their dismantling.

## “Key points to keep in mind”

The french « saisie-contrefaçon »

Anything that is not authorized by the order is not allowed

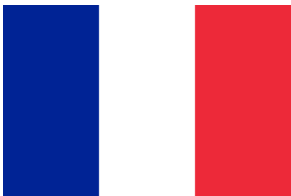
To avoid problems, it is appropriate to allow counsel for the parties, subject to confidentiality, to be present during the inspection

The entire seizure of counterfeit goods is canceled without entitlement to jurisdiction in a specified period

The bailiff's report on the Internet

Case law is strict: the bailiff has to comply with technical procedures

Bailiffs must also comply with the AFNOR NF Z67-147 September 2010 developing the procedure to a report on the internet made by a bailiff.



## “Key points to keep in mind”

The bailiff's purchase report

The bailiff has to decline his quality when he buys / opens the account on the Internet (CA Paris, 27 février 2013).

The judicial officer is obliged to restrict itself to material evidence.

The bailiff's purchase report

The most frequently identified issue with the private expertise is that such an expertise cannot fully support the decision of the judges.

It should ensure that the expert reports are drawn up contradictory (Cass. Com., n°11-28205, 29 janv. 2013).

The right to information

Although the law of March 11, 2014 provided clarifications, this practice still deserves to be framed, especially regarding compensation for damages when finally counterfeiting is nonexistent.

## Measures for preserving evidence in Belgium

- ✓ The most common means of collecting evidence
- ✓ Key points to keep in mind



## The most common means of collecting evidence

- On the party's initiative : purchase of infringing goods / printing web pages
- the bailiff's report on the internet
- The bailiff's purchase report
- The belgian "saisie-contrefaçon"
- The right of information





## The bailiff's report-1

- On request of a party
- Mixed status : independant and judicial officer
- Only material findings can be reported, excluding any opinion or judgement (he is not a judge)
- Often the first step to prove the existence of an infringement



## The bailiff's report -2

- no special rules for the bailiff for drafting a report on findings on the internet (not as in France)



## The right on information (other than via the “saisie-description”)

- the infringing party can be obliged to provide information (penalties if not respected)
- also third party can be obliged to do the same (ex. ISP)
- often obligation to have this ascertained by an accountant (to avoid costs of an expert)
- nomination of an expert in the proceedings at the bottom of the case



## The “saisie-contrefaçon”

-= counterfeit seizure proceedings

✦ Aim : description (gathering evidence) + seizure (blocking of the alleged infringing products)

-different conditions whether description or seizure

✦ Ex parte (unilateral) : surprise but preceding permission of the judge

✦ For all IPR : trade marks, patents, SPC's, copyrights and neighbouring rights, chips, breeders rights, design rights, geographical indications, producers of databases

✦ Not : know-how!



## Description measures

- a) Description of the infringement
- b) Determination of the origin, destination and quantity of the infringement



## Conditions to be established before the judge

- a) Investigation of the prima facie validity of the invoked right (in principle certificate of registration is sufficient for registrable rights at least),
- b) Indications of infringement (no proofs required; no phishing expedition allowed, see BSA case)



## Seizure measures

- Blocking of the goods
- Sealing of the goods
- Possibility of nominating an administrator
- Conditions are heavier to fulfill



## Conditions for obtaining seizure measures

- a) prima facie validity of the invoked right
- b) the infringement cannot reasonably be disputed
- c) Respective interests of parties will be taken into account (general interest can be important, ex. dangerous medicines or irreplaceable medicines)





## The report

- no contradictory proceedings
- no prereport with possibility to give remarks
- No opinion on the alleged infringement
- Confidentiality of the report
- Obligation to start proceedings to the bottom of the case within a term of one month
- Expert has to safeguard also the interests of the alleged infringing party (no arm of the right holder)



## Responsibility of the claimant

- When the IPR is invalid or the infringement is not recognised afterwards
- Only if seizure measures have been taken



# Opposition to the court order giving permission to execute the saisie contrefaçon

- Within one month after execution of the measures
- Everything can be disputed : conditions for obtaining the measure, expert mission, the guarantee, confidentiality of certain information (no spying)



## Measures for preserving evidence in Netherlands

- ✓ The most common means of collecting evidence
- ✓ Key points to keep in mind



## Measures for preserving evidence in Germany

- ✓ The most common means of collecting evidence
- ✓ Key points to keep in mind



## “The most common means of collecting evidence”

### Ordinary Means

*In an ordinary IP procedure the most common means of preserving evidence are documents, screenshots (printout), photos (printout), samples, witnesses and written expertise (private or ordered by the court).*

### Exceptions for Preliminary Procedures

As in Germany most IP matters are brought before the courts in a preliminary – often non-adversarial – procedure there is to bear in mind that some of the ordinary means are not admitted to this type of procedure, e.g. hearing of witnesses or independent written expertise.



## “The most common means of collecting evidence”

### Replacement for Exceptions

To replace those means of evidence not admitted to preliminary procedures the ordinary means might be replaced by affidavits (instead of witnesses), private expertise (instead court ordered) or – in case of a court hearing – present witnesses.

### Test Purchases and Photos

Purchasing for test and evidence reasons is generally admitted. Taking pictures or getting evidence by witness inspection is limited by the other party's interest in ordinary business (e.g. influence on other customers). The admissibility as evidence depends on the balance of interest.



## “The most common means of collecting evidence”

### Claim for Submission and Inspection

- Enforcement of Directive 2004/48/EC in specific IP-related laws (patent, trademark, design, etc.)
- Allows the applicant to have the infringement matter assessed in the alleged infringing party's sphere
- Condition precedent is a „reasonable likelihood“ of an infringement; the claim shall not be misused to generally investigate the opponents' business
- Claim is aimed at the presentation of supporting documents or the inspection of objects being under the control of the opponent





## “The most common means of collecting evidence”

### Claim for Submission and Inspection

- Court is obliged to ensure that confidential information of the opponent is protected (e.g. by restricting the disclosure to a bailiff)
- If the location of the documents or objects is unknown and the opponent refuses to provide information, a judge can order a search of premises
- If the opponent refuses to cooperate, the right holder is limited to ask for means of coercion, e.g. fines or coercive detention (which cannot hinder the change or disappearance of evidence means)



**“The most common means of collecting evidence”**

Claim for Information

- The alleged infringing party or third parties can be obliged to provide information about the origin, distribution networks, quantity and price of the litigious goods
- Preliminary injunctions are granted only in exceptional cases if there is an obvious infringement of rights



## “The most common means of collecting evidence”

### The “Düsseldorf Procedure”

- A combination of preliminary injunction and expert evidence
- Originally developed for patent proceedings by the regional court of Düsseldorf
- The court orders an independent procedure of taking evidence and at the same time grants a preliminary injunction against the infringer to tolerate the actions of an expert
- In case the infringer resists the inspection, a bailiff may use force (if expected, supported by the police)



## “Key Points to keep in mind”

Many Procedures ...

*...do not require specific measures to bring evidence in court*

Some Procedures ...

... require special evidence like affidavits, private expertise or present witnesses

Claims for Submission, Inspection and Information ...

... are not perfectly effective as they can be only enforced by an additional procedure that gives the infringer time to manipulate the evidence



## “Key Points to keep in mind”

The “Düsseldorf Procedure” ...

... combines a preliminary procedure with the take of evidence by an expert

... is the measure of choice in difficult cases

