



Gathering of Evidence and Evidentiary Hurdles in Judicial Proceedings

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IP Enforcement for Judges
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1. Introduction

- IP Enforcement necessitates effective tools for obtaining, preserving and disclosing evidence in front of the courts

- in order to prove
 - the infringement
 - the scope of the infringement (to support claims for quickly bringing the infringement to an end / claims for damages)
 - the supply chain of the infringement (origin of the infringement? What individuals/entities involved in the distribution?)

2. The Tools

- “Seizure-Description” Orders
- Orders to Disclose Evidence
- Other “Common” Tools
- “Right of Information”

2.1. “Seizure-Description”

- See TRIPS, Art. 50; EU Dir. 2004/48, Art. 7
- Provisional measures => even before the lodging of an action on the merits
- Purpose: to get evidence as to the existence of the IP infringement, its scope and/or its origin
- Unilateral procedure to ensure effectiveness, with right of review
- Obligation to lodge the action on the merits within a short time frame

2.1. “Seizure-Description”

- Concretely:
 - Request to proceed to description and taking of samples
 - Request filed by who? Right holder. *Quid* licensee? Other? See EU Dir., Art. 4
 - Adequate security or equivalent assurance
 - Competent judge to verify
 - *prima facie* validity of IPR
 - clues of the existence of an infringement/a threat thereof

2.1. “Seizure-Description”

- Where? Alleged infringer’s premises; fair; alleged infringer’s customers, ... (attention to abuses!)
- Detailed description, with or without taking of samples
- Description and taking of samples by who?
 - Independent expert (e.g., patent attorney)
 - Role of bailiff
 - Assistance, if need be, of police
- Presence of right holder? His patent/TM attorney? His attorney-at-law?

2.1. “Seizure-Description”

- Description/Taking of samples, documents, etc.
- Need for the competent judge to protect confidentiality
 - Example: accountancy documents
- Need for the order to be precise (=> importance of the request)
 - Example: documents stored on the hard-drive
 - OK to copy? On which support?
 - OK for the expert to be accompanied by an IT expert?
- Report to be submitted within timeframe set by the judge

2.2. Orders to Disclose Evidence

- See TRIPS, Art. 43; EU Dir. 2004/48, Art. 6
 - Within the framework of the procedure on the merits
 - On request by a party (applicant/defendant) having presented reasonably available evidence sufficient to support his claim + has specified evidence relevant to substantiate his claim in possession of the other party
 - => order to submit this evidence (careful: protection of confidential information)

2.2. Orders to Disclose Evidence

- EU Dir. 2004/48, Art. 6.2

- *“Under the same conditions, in the case of an infringement committed on a commercial scale, (...) the communication of banking, financial or commercial documents under the control of the opposing party, subject to the protection of confidential information”*

2.2. Orders to Disclose Evidence

- Which sanction if non-compliance to the order?
 - National procedural law (e.g.: recurring penalty payment)
 - TRIPS, Art. 43.2 => absence of co-operation does not prevent the Court to make preliminary and final determinations on the basis of the information presented to it (no waiver of respect of contradictory character/rights of defence).
 - But MS have to implement such provision (“*a Member may accord judicial authorities the authority to...*”)

2.3. Other “Common” Tools

- “Common” tools in the framework of the procedure on the merits
 - Expertise
 - Witnesses

2.4. Right of Information

- See TRIPS, Art. 47; EU Dir. 2004/48, Art. 8;
 - Court has determined that there is an infringement indeed
 - Right holder can apply for the Court to order the Defendant infringer (TRIPS) and/or any third party found in possession of the infringing goods/using infringing services on a commercial scale / found to be providing services on a commercial scale used in infringing activities / denounced as involved in the production, manufacture, distribution of the goods or the provision of the services (EU Dir.)

2.4. Right of Information

- ... to disclose information regarding the origin and distribution networks of infringing goods or services

=> Useful tool for tracking down source of IP infringement and remove infringing goods from the supply chain

2.4. Right of Information

- Counterbalance:
 - Principle of proportionality
 - Court's appreciation to avoid abuse of right
 - Confidentiality of information sources or processing of personal data (see: http://ec.europa.eu/internal_market/iprenforcement/docs/evidence_en.pdf)
 - No self-incrimination from third parties

3. Problematic issues

- Limitation of disclosure to “commercial scale” infringements
- Costs!
- Computer evidence
- Data retention and data protection laws
 - See CJEU, *Promusicae* (C-275/06) and *LSG* (C-557/07) cases:
“*fair balance to be struck between the various fundamental rights involved*”
- Recommendations – see http://ec.europa.eu/internal_market/iprenforcement/docs/evidence_en.pdf

THANK YOU FOR YOUR ATTENTION!



www.wipo.int/enforcement/en/