

# Evidence collection tools UPC vs. IT, DE, FR, NL

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## **Structure of the presentation**

- I. What has to be evidenced
- II. Witnesses and experts of the parties
- III. Court experts
- IV. Order to produce evidence and to communicate information
- V. Order to preserve evidence (saisie) and order for inspection
- VI. Other evidence

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## I. What has to be evidenced?

### 1. The UPC approach



#### Rule 171.2 - 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. [...]
2. A statement of fact that is not specifically contested by any party shall be held to be true as between the parties.

#### Rule 284 - Duty of representatives not to misrepresent facts or cases

A representative of a party shall neither knowingly or negligently misrepresent cases or facts before the Court.

- ⇒ What will be level of detail required for “specifically” contesting facts?
- ⇒ What will be regarded as question of law and decided without recourse to (court) experts (esp. claim interpretation, obviousness, etc.)?

## I. What has to be evidenced?

### 2. In Germany



- **Strict differentiation between facts and questions of law**
- **Sec. 138 ZPO requires high level of detail (also for contesting!);**
  - (1) The parties are to make their declarations as to the facts and circumstances fully and completely and are obligated to tell the truth.
  - (2) Each party is to react in substance to the facts alleged by the opponent.
  - (3) Facts that are not expressly disputed are to be deemed as having been acknowledged unless the intention to dispute them is evident from the other declarations made by the party.
  - (4) A party may declare its lack of knowledge only where this concerns facts that were neither actions taken by the party itself, nor within its ken.
- **In most cases, facts related to infringement are undisputed and case is resolved on the basis of claim interpretation as legal question i.e. without recourse to evidence collection tools**

## I. What has to be evidenced?

### 3. In Italy

#### Article 115 Code of Civil Procedure – Availability of the evidence

*The judgment is based on the evidence brought by the parties and on the facts not specifically contested by the other party.*

Level of detail required for “specifically” contesting facts: not high (in the statement of defence)

#### Article 121.5 Industrial Property Code:

*The Court expert may receive the documents relating to the questions posed by the Court even if they have not yet been submitted in the case*

**Usually the court refers to the court expert also questions of law**



## I. What has to be evidenced?

### 4. In France

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- Each party must prove the facts necessary for the success of its claims  
(Article 9 of the French Civil Procedure Code; Article 1315 of the French Civil Code)
- But judges have powers too  
(Articles 10 and 11 of the French Civil Procedure Code; Article 10 of the French Civil Code)



## I. What has to be evidenced?

### 5. In the Netherlands

A party has to state all facts, sufficiently concrete, that are required for the legal consequence desired by such a party to enter into force. If not enough (concrete) facts are stated, the claim will be rejected.

Parties are obliged to bring forward the facts that are relevant for the decision completely and truthfully (Art. 21 DCCP).

Facts or rights alleged by a party that are not (sufficiently) contested by the opposing party, should be regarded as established by the Court (Art. 149 DCCP).

It depends very much on the circumstances of the case whether facts should be considered to have been sufficiently contested. If the alleged facts are brought forward in a very detailed and concrete manner, a mere denial thereof is not a sufficient contestation. If however the contestation is motivated very well, the alleged facts may subsequently also have to be stated in more detail (or the claim will be rejected) => communicating vessels.

If the alleged facts have been stated sufficiently concrete and have been sufficiently contested, the party invoking the legal consequence(-s) of the alleged fact(-s) has the burden of evidence to prove such fact(-s) (Art. 150 DCCP).




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## II. Witnesses and experts of the parties

### 1. The UPC approach

**ARTICLE 53 (1)(d)(e) UPCA - Means of evidence:**  
(2) The Rules of Procedure shall govern the procedure for taking such evidence. *Questioning of witnesses and experts shall be under the control of the Court and be limited to what is necessary.*

↓

**Written statement (175 RoP)**

Requirements

- Signature
- Statement to tell the truth
- Indication of the language
- Relationship between the witness and the party offering the evidence
- Actual or potential conflict of interest that may affect the impartiality of the witness.

WITNESS AND EXPERTS\*



↓

**Oral hearing (177 RoP)**

The Court may order that a witness be heard in person:

- of its own motion
- where a written witness statement is challenged by the other party; or
- on an application for the hearing of a witness in person.

**\*Rule 181 – Experts of the parties**  
**The RoP set out for the witness shall apply *mutatis mutandis* to experts of the parties.**  
The expert has a *duty to assist the Court impartially* on matters relevant to his area of expertise Which overrides any duty to the party retaining him.

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## II. Witnesses and experts of the parties

### 1. The UPC approach

#### Application for the hearing of a witness in person (Rule 176 RoP)

- the **reasons** why the witness shall be heard **in person** and;
- the **facts** which the party expects the witness to confirm; and
- the **language** in which the witness shall give evidence.



**Order of the Court** shall indicate the facts about which the witness is to be examined.

#### Steps of the hearing of witness and experts (Rule 178 - 112 RoP)

- **Identification** of the witness and declaration to tell the **truth**
- Giving of the **evidence** by the witness or **confirmation** of the witness statement
- Court and parties (under control of the presiding judge) may put **questions** to the witness
- Giving evidence by witness **through electronic means**, such as video conference is allowed
- Giving evidence in a **language other** than the language of proceedings is admissible.

#### Duties of witness and experts (Rule 179 RoP)

- **Pecuniary sanction** (failure to appear before the Court, refusal to give evidence)
- The Court may send a **letter rogatory** to the competent national court pursuant to Rule 202.
- **Report** to the competent authorities of the Member States in case of *false evidence*.

**Inability to give evidence as witness:** spouse, partner, descendant, sibling or parent of a party.

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## II. Witnesses and experts of the parties

### 2. In Italy (1)

#### WITNESSES

##### ➤ **Witness hearing**

- Only on request of the party
- The **summon of the witness** (served by the requesting party) does not indicate the facts about which the witness is to be examined;
- **Inability to give evidence as witness** occurs only when the witness has such an effective interest in the proceedings that he could take part to the proceedings as a party

##### ➤ **Written witness statement**

- Practically never used due to the complex formality requested by the law
- As alternative, usually the party files an informal affidavit (signed statement), asking the judge to granted the witness hearing of the person who made the affidavit in order to confirm the content of the statement.



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## II. Witnesses and experts of the parties

### 2. In Italy (2)



#### EXPERTS OF THE PARTIES

- The party expert cannot give witness on behalf of the party: the oral witness is limited to prove only the existence of specific facts and the witness cannot give a personal evaluation of the facts
- The alternative to the written statement is an opinion of the party expert (not under oath) often filed along with
  - the statement of complaint in order to prove the technical aspects of the patent infringement (in particular in the preliminary proceedings)
  - the statement of defence in opposition to the claims of the plaintiff
- The main aim of the party expert opinion is to define the elements (on validity and infringement) subject to the next court expert witness

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## II. Witnesses and experts of the parties

### 3. In Germany



- **Witnesses**
  - Witnesses are usually heard but court may order a written witness statement in specific circumstances (sec. 377 ZPO)
  - Affidavit not admissible in the proceedings on the merits (294 ZPO)
  - Rarely used for proving facts related to infringement; but necessary for other issues (e.g. undocumented (public) prior use)
- **Experts of the parties**
  - Written opinion of party expert regarded as submission of the party (sec. 414 ZPO)
  - Sometimes used for substantiating facts related to infringement and validity

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## II. Witnesses and experts of the parties

### 4. In France (1)

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- Witness statements of facts
- Amicable expert opinions
- Use of publicly available evidence
- Bailiff reports

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## II. Witnesses and experts of the parties

### 4. In France (2)

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- **Witness statements of facts**  
(Articles 200 to 203 of the French Civil Code)
  - related to any facts but mainly financial information
  - not heard by the court / not cross-examined
- **Amicable expert opinions**
  - mainly on specific technical issues
  - not heard by the court / not cross-examined
  - not systematic

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## II. Witnesses and experts of the parties

### 4. In France (3)



- **Use of publicly available evidence**
  
- **Bailiff reports (purchase report or website report)**
  - Strict, detailed rules to draft such reports (French standard NF Z67-147 of September 2010)
  - Advantages:
    - no information supplied to the potential defendant
    - no obligation to launch an action
    - backup in case other pieces of evidence are refused

## II. Witnesses and experts of the parties

### 5. In the Netherlands (1)



A witness statement can only serve as evidence, as far as it pertains to facts the witness knows from his own observation (Art. 163 DCCP).

Parties can act as witnesses as well. A statement of a party witness can only produce evidence to its own advantage, for as far as the statement serves to complement incomplete evidence (Art. 164 DCCP).

In principle, a witness is obliged to testify (if summoned properly) (Art. 165 DCCP).

A witness examination can be ordered at the request of parties and also *ex officio*. A witness examination has to pertain to facts that are (sufficiently) contested and can lead to deciding the case (Art. 166 DCCP).

A witness is obliged to appear, to give a statement, and to tell the truth. Not complying with such obligations can result in arrest and imprisonment of the witness, as well as in being liable for damages resulting therefrom (Art. 171–173, 177-178 DCCP).

Witness hearings are hardly ever applied in patent proceedings in the Netherlands. In most cases, it is probably possible to obtain the required evidence in an easier (less costly) manner.



## II. Witnesses and experts of the parties

### 5. In the Netherlands (2)

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Parties do often submit written declarations of party experts (with regard to technical subjects).

The Court can allow a party to have such party experts heard. A lot of the stipulations with regard to witness hearings are then also applicable (Art. 200 DCCP).

In patent proceedings however, another (less formal) route is normally followed:

On the basis of the ARPP, the Court can ask a party to bring a party expert (of who a written declaration was previously submitted) to the oral pleadings (Art. 14).

Parties can also announce themselves (four weeks before the oral pleadings) that they will bring such (a) party expert(-s) (Art. 15 ARPP).

The Court can then ask such a party expert questions during the oral pleadings, in a rather informal manner (Art. 16 ARPP).

In practice therefore, both parties have often brought their own expert(-s) to the hearing, and the Court will ask such experts to elaborate on their point of view while (or right after) the cases are being pleaded.

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## III. Court experts

### 1. The UPC approach (1)

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- **Appointment of a court expert:** (Article 57 of the UPCA)
  - What for?
    - To resolve a specific technical question or any other question (Rule 185.1 of the RoP)
  - By who?
    - On the court's own motion but after hearing the parties (Rule 185.1 of the RoP)
    - Not clear whether parties can ask for it (Rules 13-1(o) and 104(e) of the RoP)
  - How?
    - There is an indicative list of experts maintained by the Registry (Article 57.2 of the UPCA and Rule 185.9 of the RoP)
    - Parties can make suggestions regarding the identity, the technical background of the expert and the questions to be put to him (Rule 185.2 of the RoP)
    - By an order specifying facts, evidence submitted, questions put to the expert, time period to answer them (Rule 185.4 of the RoP)

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### III. Court experts

#### 1. The UPC approach (2)

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- **Duties of a court expert:**
  - Confirming his acceptance (Rule 185.6 of the RoP)
  - Carrying out his task by presenting a written report:
    - within the time period specified (Rule 186.1 of the RoP)
    - or else: sanctions (Rule 185.8 of the RoP)
  - Attending the oral hearing and answering questions from the Court and the parties (Rule 186.6 of the RoP)
- **Comments of the parties:** (Article 57.4 of the UPCA)
  - No obligation from the expert to contact the parties prior to the report; but if so, not without the presence or the consent of the other party (Rule 186.4 of the RoP)
  - Comments from the parties on the final report either in writing or during the oral hearing (Rule 187 of the RoP)

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### III. Court experts

#### 2. In Italy



- Appointment of a court expert:
  - To help the judge with the accomplishment of single act of the proceedings
  - Only on the court's own motion (it is not a typical mean of evidence)
  - The questions put to the expert and his scope of investigation are within the grounds for the claims and counterclaims (questions' proposals usually are submitted by the parties)
- The main steps of court expert witness
  - Fixation of a hearing in order to define the questions to be investigated
  - 90 days or more to file the final court expert opinion;
  - the court expert exchanges his preliminary opinion with the party experts and receives their comments (two deadlines for arguments and for replies);
  - discussion hearing on the expert opinion (only in few case the court requests the presence of the curt expert for clarification);
  - possible extension and renewal of the court expert witness;
  - during the technical phase any party is allowed to file new evidence limited to the issues dealt with in the technical opinion.

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### III. Court experts

#### 3. In Germany

- Court expert is selected by court (usually a university professor or a patent attorney) and usually deliver written report
- Role of the court expert
  - Court expert provides the court with expertise regarding technical questions (e.g. technical effect of elements of attacked embodiment)
  - However, questions of law have to be decided by the court (esp. the determination of the content of the patent and claim interpretation) whereby the court must give reasons for its the decision
- In first instance infringement and nullity proceedings court experts are rarely appointed (but in the past they were regularly appointed in nullity appeal proceedings by Federal Court of Justice)



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### III. Court experts

#### 4. In France (1)

- **The court may appoint an expert:**
  - mainly upon request of a party
  - to sort out confidential information (usually: information seized during a *saisie-contrefaçon*)
  - to obtain information on a fact:
    - usually on a technical issue (experiments)
    - no general opinion on validity or infringement
  - to assess damages (usually once a judgment on infringement is handed down)

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### III. Court experts

#### 4. In France (2)



- **Performance of the expert investigations**  
(Articles 263 to 286 of the French Civil Procedure Code)
  - The expert can request documents from the parties
  - The parties exchange submissions with the expert
  - The expert files a report before the court
  - The parties then file pleadings before the court to discuss the report
  
- **The judge is not bound by the findings of the expert**  
(Article 246 of the French Civil Procedure Code)

### III. Court experts

#### 5. In the Netherlands



The Court can appoint court experts in an interim judgment, at the request of a party or ex officio (Art. 194 DCCP).

Court expert is obliged to fulfill his task impartially and to the best of his abilities. Parties can give comments and submit requests to the court expert. Parties are obliged to cooperate with an investigation by a court expert (Art. 198 DCCP).

Not (or: hardly ever) applied in patent proceedings => surprising?

Party experts are always (to some extent) 'hired guns'. Most judges do not have a technical background themselves. Nevertheless, the Court apparently (almost) always considers itself capable to decide between two different technical points of view as presented by the parties and their experts.

Appointing independent court experts more often could perhaps be helpful (but would of course also lead to more delay and costs).

## IV. Order to produce evidence and to communicate information

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### 1. The UPC approach

One of the (many) means of obtaining evidence specified in the UPCA (Art. 53) and the RoP (Rule 170) is: *“Ordering a party or a third party to produce evidence”* (Rule 170 par. 3a).

The Court can - at its own discretion - order a party making a statement of fact to produce evidence in the control of that party (Rule 170 par. 2).

The Court can also, at the request of a party that:

- Presented reasonably available evidence sufficient to support its claims; and;
  - Specified evidence in the control of the opposing party or a third party;
- order the opposing party / third party to present such evidence (Art. 59 UPCA).

Further conditions for giving such an order are given in Rule 190 RoP.

The Court may further also give a party or third party an order to communicate information about e.g. distribution channels, produced quantities, third persons involved etc. (Art. 67 UPCA + Rule 191 RoP).

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## IV. Order to produce evidence and to communicate information

### 2. In Italy (1)



**ORDER TO PRODUCE EVIDENCE** - Article 121.2 IP Code and 210 Code of Civil Procedure

➤ The Court can order to produce evidence only at the request of a party that:

- has provided serious clues that its claims are grounded and
  - has identified documents, elements or information held by the other party that confirm those clues.
- Protection of the confidential information
- Admissible only during the proceedings on the merit
- The failure to comply with the order is duly taken in consideration by the Court as clue of liability

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## IV. Order to produce evidence and to communicate information

### 2. In Italy (2)

#### ORDER TO COMMUNICATE INFORMATION – Article 121bis IP Code

The information provided on the origin and distribution networks of infringing goods or services, by

- the author of the infringement and
- any other person in possession of the goods or involved in the infringement

The information may concern

- name and address of the producers, distributors, wholesalers, retailers
- the quantities produced, imported, delivered
- the price and the goods and services in question.

The refusal or false information are prosecuted as criminal offenses (as false witness), also for the defendant



## IV. Order to produce evidence and to communicate information

### 3. In Germany

#### • Order to produce evidence

- Sec. 140c PatG: Court may order production of documents related to infringement if infringement is “reasonably likely” (no “fishing expeditions”)
- Sec. 142 ZPO: Court may (even *ex officio*) order a party to present a document which are in the possession of that party (very rarely used)
- Sec. 810 BGB: Court has to order production of special types of documents, esp. documents proving existence of a contract

#### • Order to communicate information

- Sec. 242, 259 BGB: information necessary for calculating damages (e.g. prices, quantities, costs, etc.)
- Sec. 140b PatG: concerns inter alia information on distribution channels



## IV. Order to produce evidence and to communicate information

### 4. In France (1)

- Compulsory production of evidence
- Right of information

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## IV. Order to produce evidence and to communicate information

### 4. In France (2)

- **Compulsory production of evidence :**
  - Mainly upon request of a party
  - To obtain evidence held by:
    - third parties (Articles 138 to 141 of the French Civil Procedure Code)
    - a party (Article 142 of the French Civil Procedure Code)
  - Conditions:
    - evidence necessary to the proceedings
    - no legitimate impediment
  - Consequences if not communicated:
    - the judge can only take note
    - penalties

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## IV. Order to produce evidence and to communicate information

### 4. In France (3)

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- **Right of information:**

(Article L. 615-5-2 of the French Intellectual Property Code)

- How and when?
  - on the merits (before or after a decision on infringement)
  - in preliminary proceedings
- What for?
  - to determine the origin and the distribution networks (not for technical information)
  - to assess damages

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## IV. Order to produce evidence and to communicate information

### 5. In the Netherlands

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Anyone with a legitimate interest can claim inspection, copies or excerpts of specified documents / records pertaining to a legal relationship to which he is a party, from the person / legal entity that has these documents / records at its disposition (Art. 843a DCCP).

So, three cumulative requirements: 1) Legitimate interest; 2) *Specific* documents / records; 3) Claimant has to be a party to the legal relationship.

An obligation from one party to another arising out of the infringement of an IP right is considered to be a 'legal relationship' in the sense of Art. 843a DCCP. In that case, a party can also claim that the opposing party produces other evidence than documents / records (such as infringing objects). The Court will reject such a claim claim for as far as the protection of confidential information cannot be guaranteed (Art. 1019a DCCP, Art. 6 (1) IPRED).

The Court further has to judge whether there are (other) important reasons to deny the claim and / or whether there can also be a proper administration of justice without the evidence being produced. This evidence collection tool may not be misused for 'fishing expeditions' (i.e. to obtain all sorts of commercially interesting information from a competitor).

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## V. Order to preserve evidence and order for inspection

### 1. The UPC approach (1)



- **Object of order to preserve evidence** (Art. 60 (2) & Rule 196.1)
  - Detailed description, with or without the taking of samples;
  - Physical seizure of allegedly infringing goods, the materials and implements used in the production and/or distribution of these goods and any related document;
  - Preservation and disclosure of digital media and data and the disclosure of any passwords necessary to access them
  
- **Object of order for inspection** (Art. 60 (3) & Rule 199.1)
  - *“inspection of products, devices, methods, premises or local situations in situ”*

## V. Order to preserve evidence and order for inspection

### 1. The UPC approach (2)



- **Requirements of order to preserve evidence**
  - Reasonably available evidence to support the claim that patent has been infringed or is about to be infringed (Art. 60 (1))
  - Security for potential claim for damages (optional, Art. 60 (7) & (9) and Rule 196.6)
  - Initiation of infringement proceedings within 31 calendar days or 20 working days after the order (Art. 60 (8) & Rule 198)
  
- **Requirements of order for inspection**
  - Evidence to support the claim that patent has been infringed or is about to be infringed (Art. 60 (3))
  - Security for potential claim for damages (Rules 199.2, 198.2, 196.6)

## V. Order to preserve evidence and order for inspection

### 1. The UPC approach (3)



- **Proceedings:**
  - Before or during proceedings on the merits (Art. 60 (1) & (3))
  - Competent Court: court of (pending) infringement proceedings and standing judge in case of extreme urgency (Rules 192.1, 194.1, 199.2)
  - May be ordered in ex parte proceedings in cases of irreparable harm or risk of evidence being destroyed (Art. 60 (5) & Rule 197)
- **Execution of the measures:**
  - Measures to be carried out by “*professional person or expert, who guarantees expertise, independence and impartiality*” (Rule 196.5)
  - Applicant cannot be present during execution (Art. 60 (4) & R. 196.5)
  - Disclosure of acquired information may be limited to certain persons subject to appropriate terms of non-disclosure (Rules 196.1, 199.2)

## V. Order to preserve evidence and order for inspection

### 2. In Italy (1)



- **Order to preserve evidence may include the following measures:**
  - **Descrizione**
    - search order analogue to the French saisie-description;
    - granted by the President of the IP Court authorising the claimant to inspect and describe the allegedly infringing products/processes under the supervision of a bailiff;
    - used when the infringement is not so evident as to grant a seizure order;
    - collecting tool also for damages evidence (*entity* of the infringement);
    - results acquired by the judge within the proceedings on the merit.
  - **Seizure** of allegedly infringing goods, the materials and implements used in the production and/or distribution of these goods and any related document.

## V. Order to preserve evidence and order for inspection

### 2. In Italy (2)



- **Requirements of order to preserve evidence**

- **Descrizione**

- urgency, rule of thumb: within 6 month as of knowledge of infringement
- likelihood of infringement and validity: *sufficiently* clear
- no security for potential claim for damages
- Initiation of infringement proceedings within 31 calendar days or 20 working days after the order

- **Seizure**

- Same requirements for descrizione, with the exception of the high *fumus boni iuris*: the likelihood of the infringement and validity must be clear

## V. Order to preserve evidence and order for inspection

### 2. In Italy (3)



- **Proceedings (descrizione and seizure):**

- may be ordered in ex parte proceedings in cases of irreparable harm or risk of evidence being destroyed
- before or during proceedings on the merits
- the Descrizione is an efficient tool if granted ex parte (if not, better withdraw the application)
- the Descrizione is more easily granted ex parte due to its non invasive nature in relation to the possible damages suffered by the defendant from the execution of the measure
- at the end of the Descrizione procedure, if successful, the claimant may ask for the seizure and/or injunction.

## V. Order to preserve evidence and order for inspection

### 2. In Italy (4)



- **Execution of the measures (descrizione and seizure):**
  - measures to be carried out by a bailiff with the assistance of experts (technical and accounting) appointed by the court
  - applicant can be present during execution
  - all the documents collected during the procedures are classified by the bailiff
  - disclosure of acquired information must be authorized by the court during the proceedings on the merit and subject to appropriate terms of non-disclosure

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## V. Order to preserve evidence and order for inspection

### 3. In Germany (1)



- **Order to preserve evidence in sec. 485 seq. ZPO**
  - Object: Description of allegedly infringing embodiment by expert
  - Requirements: Possibility to avoid litigation or danger of evidence being destroyed and optionally deadline for initiating proceedings on the merits if requested by alleged infringer (sec. 494a ZPO)
- **Order for inspection in sec. 809 BGB and sec. 142c PatG**
  - Object: Duty to tolerate the inspection of specific objects but some assistance can be requested from infringer, e.g. entering passwords)
  - Requirements: Reasonable likelihood of infringement (i.e. suspicion based on concrete evidence); necessity (no other possibility to get information); proportionality (balance of interests)

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## V. Order to preserve evidence and order for inspection

### 3. In Germany (2)



- **Proceedings**
  - Before or during proceedings on the merits
  - Orders may be handed down in ex parte proceedings
  - Infringement courts are competent for the order
- **Execution**
  - Applicant cannot be present during inspection (=> only expert, legal representatives and bailiff)
  - If infringer access to his premises, an additional search order must be requested (sec. 758a ZPO, cannot requested before!)
  - Disclosure of expert opinion usually limited to legal representatives but court may order release to applicant after blackening of business secrets

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## V. Order to preserve evidence and order for inspection

### 4. In France (1)

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- **The *saisie-contrefaçon*:**  
(Article L. 615-5 of the French Intellectual Property Code)
  - Requested and issued in *ex parte* proceedings:
    - filed by the patentee or an exclusive licensee
    - based on a French or European patent in force in France (even a published application but not a foreign patent)
    - even against third parties (e.g. regulatory authorities)
    - no *prima facie* evidence of infringement legally required but often asked by the judges
  - An order is issued describing all investigations authorised

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## V. Order to preserve evidence and order for inspection

### 4. In France (2)

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- **The *saisie-contrefaçon*:**

- Performed by a bailiff (assisted by experts) to:

- describe the allegedly infringing product or process
- physically seize samples of the products
- copy any related document (drawings, specifications, commercial documents etc.)
- report on sales and seize accounting documents

- Confidential information:

- can be put into a sealed envelope upon request of the seized party
- sorted out by a confidentiality club or a court-appointed expert

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## V. Order to preserve evidence and order for inspection

### 5. In the Netherlands

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The PI judge can grant permission *ex parte* to take measures to protect evidence to a party that has made it sufficiently plausible that infringement was made or is imminent on its IP right(-s). Among these possible measures are: seizure of evidence, detailed description and taking of samples (by a bailiff) of allegedly infringing objects, materials and equipment used in the production thereof and documents pertaining to the infringement (Art. 1019b–d DCCP, Art. 7 (1) IPRED).

In order to get *access* to preserved evidence, a party will subsequently have to file a claim on the basis of Art. 843a, 1019a DCCP. (There's been some debate in jurisprudence recently about what the right threshold is to allow a claim on the basis of Art. 843a, 1019a DCCP.)

In order for a party to prevent measures to protect evidence from being taken against it, such a party can file a protective letter (with nullity and / or non/infringement arguments) with the Court of The Hague. If such a letter is filed (and the arguments it contains make sense) the chance is likely that such a party will first be heard by the Court before measures are taken against it => similar to Rule 207 RoP.

No specific stipulation about inspection in Dutch law similar to Art. 60 UPCA / Rule 190 RoP but could probably be based on Art. 1019b DCCP (which speaks of 'measures' in general, given examples are not exhaustive).

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## VI. Other evidence

### 1. The UPC Approach (1)



#### Letters rogatory (Rule 202 RoP)

- For the hearing of witnesses or experts by other competent courts or authorities
- The competent court or authority shall apply **national law** as to the procedures to be followed **in executing** such requests and, in particular, as to the appropriate **measures of compulsion**.

## VI. Other evidence

### 1. The UPC Approach (2)



#### Experiments ordered by the Court (Rule 201 RoP – Art. 53(1)(g) UPCA)

- *to prove a statement of fact*
- The request of the party shall contain at least *i) the identification of the facts* intended to be established, *ii) the description in detail* of experiments, *iii) the description of the reasons* of the request,
- Exchange of opinion between the parties on the subject and the expert of the experiments
- Order of the Court allowing the experiments shall contain *i) the specification* of the experiments, *ii) the Court's expert(s)*, *iii) timing* of the experiments and for the Court expert report
- Experiments may be carried out in the **presence** of the parties and their experts.
- **Comment** on the report of the experiment either *in writing* or *during the oral hearing*.
- The expert(s) may be summoned to the oral hearing.

## VI. Other evidence

### 2. In Italy



#### Experiments ordered by the Court

- Mean of evidence granted only ex officio by the Court on its own motion
- Usually the experiment is carried out directly by the Court expert during the court expert witness

#### Letters rogatory

- For the hearing of witnesses by other competent courts or authorities
- Transmission through diplomatic channels (Hague evidence convention)

## VI. Other evidence

### 3. In Germany



- Letters rogatory possible (sec. 363, 365 and 375 ZPO and Regulation 1206/2001)
- No explicit provision for order of experiments (but experiments could be requested from court expert)



## VI. Other evidence

### 4. In France

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- **Experiments:** see court experts
- **Letter of Request:**
  - To or from a foreign State  
(Articles 733 to 748 of the French Civil Procedure Code)
  - If to or from a Member State of:
    - The Hague Convention of 18 March 1970
    - EU: Council Regulation (EC) № 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

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## VI. Other evidence

### 5. In the Netherlands

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No specific stipulation about experiments ordered by the Court: no specific basis in Dutch law, but probably possible to give such an order within the existing framework (e.g. as part of the investigation performed by a court expert).

If a witness lives in another country, the Court can ask an authority in that country to perform the examination of the witness (Art. 176 DCCP).

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**End of the presentation**

**Thank you for your attention**

## **Annex**

### **Abbreviations**

ARPP	(Dutch) Accelerated Regime Patent Proceedings
BGB	German Civil Code (Bürgerliches Gesetzbuch)
EPC	European Patent Convention
DCCP	Dutch Code of Civil Proceedings
IPRED	Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights
PatG	German Patent Code (Patentgesetz)
RoP	Rules of Procedure (17 <sup>th</sup> version)
UPCA	Agreement on a Unified Patent Court
ZPO	German Code of Civil Procedure (Zivilprozessordnung)

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