



Gathering evidence across Europe

Where to go for which evidence

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Outline of topics

- Hearing of witnesses
- Expert evidence
- Evidentiary seizure / discovery
- Confidentiality issues
- Cross-border use of evidence

Hearing witnesses - UK

- Witness evidence - written and oral - is a primary form of evidence during a trial involving a patent
- Choice of witness important - consider their proximity to facts in issue, general temperament and any potential credit issues
- Written evidence is usually most weighty when corroborated by other evidence (e.g. documents or other witnesses)
- Cross-examination very common in trials - purpose is to test the written evidence and determine issues of credibility, reliability and veracity
- Witnesses can be cross-examined on anything within their knowledge, not just what appears in the written evidence
- Lay witnesses are typically examined on their own, but expert witnesses are sometimes heard concurrently

Hearing witnesses - NL

- Not that common in patent cases
- Usually only pre-trial → preliminary witness hearing
- Very low hurdle to get witness hearing
- Dutch witnesses have obligation to appear in court
- Party asking for witnesses has to pay the costs, but can be reclaimed if it wins the subsequent case
- Judge asks the questions, counsel can address witnesses when judge is finished
- Summary transcript made at end of hearing

Hearing witnesses – FR & DE

FR

- Witness hearing is available pre-trial and during trial - on the judge's initiative or at a party's request
- In practice, witness hearing is almost never used in patent cases - written evidence tradition
- Written witness affidavits more commonly used

DE

- No provisions for hearing witnesses pre-trial
- Parties name witnesses in their briefs and court summons them if taking evidence is needed (not often the case)
- Witnesses have to appear in court - testimonies in writing are not admissible
- no cross-examination but parties can ask questions

Expert evidence – UK & NL

UK

- Parties are free to choose their expert(s)
- Experts should be independent of the parties
- Experts can only give evidence on the areas in which they have any expertise, anything outside their expertise is inadmissible
- Experts have a central role in establishing the state of the art at the priority date, issues of construction of the patent, infringement, novelty, obviousness etc
- Experts should be instructed appropriately

NL

- Usually party experts
- Try to find 'skilled person'
- Written declarations, as many as you like
- Can bring expert to court
- Experts can speak at hearing
 - No cross-examination
 - Can be asked questions by court
- No strict rules on how to approach experts
- Also relevant for seizures

Expert evidence – DE & FR

DE

- **Private expert opinions**
 - give allegations more credibility
 - Nevertheless, they are **no means of evidence** -> careful cost-benefit calculation is recommended
- **Court appointed expert**
 - admissible means of evidence
 - opinion submitted in writing - hearing (and questioning) in trial possible

FR

- Party appointed experts may be used to prove technical points but are not systematic. Choice of expert and form of the report are free
- The Court can appoint an expert which hands down a report after an *inter partes* debate - Rarely used in patent cases (except to assess damages)
- Opinion submitted in writing. Hearing of experts in trial possible but extremely rare

Evidentiary seizure / discovery - UK

- Notice to Admit Facts - gathering evidence the easy way
- Statement of Agreed Facts - useful way to establish CGK
- Product or process description - limits disclosure on e.g. obviousness
- Discovery/disclosure remains common - note Disclosure Pilot which commenced on 1 January 2019 (Initial disclosure v Extended disclosure)
- Pre-action inspection of property recently considered for the first time by the High Court in *Boehringer Ingelheim v Mylan* [2019] EWHC 584 (6 March 2019)
Experiments - time, cost and design factors

Evidentiary seizure / discovery - NL

Evidentiary seizure

- No discovery → afraid of fishing expeditions
- Only for 'specified documents'
- But Dutch seizure can be broad:
 - Digital documents, cloud, mailboxes, etc.
 - 'Any evidence'
- Low hurdle to obtain seizure
- Court appointed bailiff will enter premises
 - Potentially with IT and technical experts
 - Access to all locations
- Make a selection during seizure
 - Keywords, types of documents, etc.
 - Sometimes forensic copy for later selection

Access to / use of evidence

No direct access to evidence!

- Separate access proceedings required
- Higher threshold for access
 - Reasonable suspicion of infringement?
 - Lower than PI injunction, higher than seizure
 - Access to get evidence, so no conclusive infringement evidence required for access
- Common to use independent expert for selection / disclosure
- Also possible for evidence to be destroyed before access (e.g. privileged correspondence)

Evidentiary seizure / discovery - FR

- ***Saisie-contrefaçon*** (evidentiary seizure) performed in most patent cases :
 - Obtained *ex parte* before any proceedings
 - Low threshold: no legal requirement to prove plausibility of infringement - but available elements should be provided to the judge. In practice, judges do not refuse the seizure but can amend the scope of the authorized measures
 - Broad scope: operations in any authorized premises of the defendant or of any third party by a bailiff and possibly technical/IT experts
 - Broad range: Seizure of samples of products and accounting documents, questions to employees, access to the IT system are available
- Bailiff report in writing and direct access to evidence (in principle). The validity of the seizure can be challenged at any point in subsequent proceedings => Strict compliance with the seizure order is required

Evidentiary seizure / discovery - DE

Documents/Information

- no discovery
- claim for production of documents - specific documents must be identified

Items

- claim for inspection of an item

- Intention: enable patentee to clarify the facts of a claim and substantiate allegations of infringement
- Requirements: (1) sufficient probability of infringement and (2) provision/inspection must be proportionate
- As preliminary relief - also ex parte - available
- If it turns out that there is no infringement, defendant entitled to damages

Confidentiality issues - DE

“Düsseldorfer proceedings” = expedient proceedings for establishing facts and/or preserving evidence ensuring protection of confidential information

- **Phase 1:** patentee establishes requirements of claim for inspection
- **Phase 2:** court appointed expert and patentee’s counsel undertake inspection. Both are under obligation of confidentiality - in particular towards patentee.
- **Phase 3:** petitioner and patentee’s counsel (still under obligation of confidentiality) receive expert opinion and get opportunity to comment on confidentiality interests.
- **Phase 4:** court decides whether and to what extent the expert opinion is shared with patentee (blackened edition, further obligations of confidentiality, etc.)

Decision to share expert opinion can be appealed.

Confidentiality issues - FR

- In the context of a *saisie-contrefaçon* :
 - Seized party can request that confidential documents be placed under seal
 - Confidential documents will be sorted out in a subsequent procedure which may involve an expert and/or a confidentiality club
 - New provisions : the seizure order can provide that all seized exhibits will be placed under seal
- In the context of any patent proceedings:
 - New legal provisions implement specific procedures for the communication of confidential documents
 - A party can first submit the evidence to the judge who will decide to whom and in which conditions it can be communicated in the proceedings
 - Hearing behind closed doors and redacted judgments are available

Confidentiality issues - NL

- Measures above only granted insofar as confidentiality is safeguarded
 - Seizure → no direct access → inter partes proceedings.
 - Dow/Organik nice example (trade secret litigation):
 - Access through independent expert
 - Limitations on how evidence can be used (only to establish unlawful acts in legal proceedings)
 - Penal sum of EUR 1 million per violation, capped at 10 million
 - Privileged correspondence deleted prior to access
 - Decisions can be redacted
 - Hearings can be held behind closed doors
- New trade secret legislation → confidentiality pools → apply to patent cases?

Confidentiality issues - UK

- Open justice a fundamental principle of court system
- Note Article 6 of European Convention of Human Rights - right to fair trial
- *Harman* undertakings and CPR 31.22 - substantive legal obligations
- Confidentiality clubs common in IP cases and where the parties agree there is generally latitude to restrict access to information between the parties - but cannot undermine the open justice principle
- “Outside eyes only” confidentiality regime rejected by Mr Justice Henry Carr in *TQ Delta v Zyxel Communications* [2018] EWHC 1515 (but compare earlier decisions in *IPCom v HTC* [2013] EWHC 52 (Floyd J) and *Unwired Planet* [2017] EWHC 3083 (Birss J))
- Trade Secrets Directive (2018) - sits in parallel with confidential information

Cross-border use of evidence

UK

- *Evidence (Proceedings in Other Jurisdictions) Act 1975* - UK obliged to assist countries party to the Hague Convention on Taking of Evidence Abroad
- Cannot make orders against third parties
- But note impact of Brexit on Taking of Evidence Regulation (1206/2001)
- Evidence obtained in foreign proceedings will be considered by an English court if admissible under English law

FR

- Evidence obtained in a *saisie-contrefaçon* can be used in foreign proceedings - unless the judge ordered specific restrictions.
- In principle, not possible to carry out a *saisie-contrefaçon* in France on the basis of a foreign patent - other evidentiary measures may be available
- Evidence obtained in foreign proceedings will be considered by a French judge unless he has reasons to doubt its validity

Cross-border use of evidence

NL

- Explicitly addressed in case law
- Even if no intention to use evidence in Dutch proceedings, possible to conduct seizure to obtain evidence
 - Debatable where to claim access...
- Usually no other limitation than 'use of evidence to establish unlawful conduct in legal proceedings'

DE

German evidence in foreign litigation:

- Probability of infringement in DE trigger for claims of inspection
- No litigation in DE needed

Foreign evidence in German litigation:

- Exclusion of improperly-obtained evidence extremely rare
- Even evidence, that was obtained illegally abroad, may be used in German litigation

Summary conclusion

	UK	FR	NL	DE
Witnesses	Extremely common	Extremely rare	Relatively rare, but low hurdle	Extremely rare
Experts	Extremely common	Common but not systematic, no hearing of experts	Very common, declarations, access proceedings	Private expert opinion no means of evidence

Summary conclusion

	UK	FR	NL	DE
Seizure	Many options available depending on objective	Very common, low hurdle, broad scope	Common, low hurdle, but no direct access	Claim for production of documents/inspection
Confidentiality	Measures available but open justice paramount	Sufficient measures available	Sufficient measures available	Düsseldorfer proceedings
Cross-border	Import/export of evidence in principle permitted	Import/export of evidence in principle permitted	Import/export of evidence explicitly permitted	Barely any restriction to import/export of evidence



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