

International

Securing evidence across borders in EU patent litigation

By Peter de Lange, VO

Technical evidence is often essential for enforcing patents, in particular patents for processes. Accordingly, patent protection in the European Union would be seriously impaired if the borders between member states vanished for infringers, while remaining a barrier against obtaining evidence for rights holders. While this is still the case in certain situations, recent developments have strengthened the position of rights holders.

At the root of the problem is the fact that patents are national rights and are thus territorially limited. This is hardly compatible with a single market. Although the future unitary patent system may finally provide the possibility of a patent for (almost) the whole EU single market, current European patents and future European patents without unitary effect are still merely a bundle of national patents, at least as far as enforcement is concerned. In addition, most rights holders choose to validate granted European patents in only a small number of EU member states – usually no more than four countries, typically including Germany, France and the United Kingdom. In theory, obtaining injunctions in these countries is enough to block an infringer from the whole of the European Union. However, matters are more complicated in practice – for instance, if an infringer is based in another EU country, this means that crucial evidence is located in a country where the patent is not in force.

One would expect the EU legal system to have addressed such a situation. After all, it is hardly exceptional in a single market and can occur for patents as well as for IP rights such as trademarks and copyright.

The EU Enforcement Directive (2004/48/EC) even goes so far as to declare that IP protection is an essential element for the success of the internal market. Accordingly, it sets out that member states must establish provisional measures to preserve evidence in respect of alleged infringements. These may include circulating detailed descriptions of the infringing goods, taking samples or physically seizing infringing goods and, where appropriate, materials and implements used in their production and/or distribution, as well as any related documents. These measures can be ordered by the courts without the alleged infringer being heard (in *ex parte* proceedings) and also before the commencement of proceedings on the merits of the case. Based on the French *saisie-contrefaçon*, it is generally held that these measures are sufficient to allow for the effective enforcement of patents, although their implementation in different member states differs.

However, it is not entirely clear whether these measures are available in cases of alleged infringement where the patent is in force in another EU member state. The view in various member states seems to differ. Courts in the Netherlands, for instance, have accepted that it follows from the Enforcement Directive that the evidentiary measures should be available irrespective of the EU member state in which the patent originates. Starting with *Synthon v Astellas* in 2007, Dutch courts have held that it would be contrary to the directive if no use could be made of the (enforcement) possibilities set out in the national laws of another member state for enforcing a patent in a first member state in cases of cross-border infringement. In contrast, *saisie-contrefaçon* in France is not available for foreign patents.

Of course, these views cannot both be correct. However, the text of the Enforcement Directive does not seem *prima facie* to require member states to make the provisional measures prescribed available where foreign patents are infringed. In fact, in a curious turn of phrase, the directive's scope of application is defined as "any infringement of intellectual property rights as provided for by Community law and/or by the national law of the member state concerned". This is ambiguous enough to apply only to the infringement of patents as provided for by the national law of the member state concerned.

The Dutch courts expressed a more nuanced view in *Rhodia v VAT* (2011 and 2012). In this case, VAT vehemently opposed the evidence seizure of certain products that were produced in China and stored in the Netherlands. The seizure was based on the alleged infringement of Rhodia's patents in Germany. Although the district court first indicated that referring prejudicial questions to the European Court of Justice (ECJ) would be desirable, this was not considered appropriate at that stage of the proceedings. Later, the appeal court considered that the Enforcement Directive allows member states to provide stronger protection than the minimum set out by the directive. It then based the availability of seizure of evidence on the implementing Dutch law and its explanatory memorandum, rather than on the directive. Accordingly, it found that the availability of evidence measures in cross-border cases depends on the national law of the member state concerned.

Possible conflict with EU Evidence Regulation

To complicate matters further, it has been argued that granting evidence measures based on the infringement of foreign patents is not permissible under another EU instrument – the EU Evidence Regulation (1206/2001).

Alleged infringer Heidelberg took this position in the French case of *Heidelberg v Bobst* (2011). Bobst owned a European patent for a feeder device in paper-processing machines, which it had validated in France and Germany, but not in the Netherlands. It alleged that Heidelberg had infringed its patent by

marketing a machine comprising the protected paper feeder in France. It had a *saisie-contrefaçon* carried out in France and obtained a report describing the allegedly infringing device in some, but insufficient detail, allowing Heidelberg to deny that a specific feature of the claims was present in the printing press. In the meantime, the machine had been transported to the Netherlands, where a Dutch court granted an evidence seizure for it. In the French proceedings on the merits, Heidelberg argued that this evidence should be excluded in the French main proceedings because the Dutch seizure was contrary to the EU Evidence Regulation.

The regulation provides for two ways of obtaining evidence across EU borders. The direct method allows a judge of one member state to collect evidence in another state either directly or through a designated person (eg, an expert). This is limited to voluntary acts with no coercive measures and therefore does not seem to allow for an *ex parte* evidence seizure. The other method is indirect, wherein a court with jurisdiction in the main proceedings (the requesting court) sends a request "for the performance of the taking of evidence" to a competent court of the member state where the evidence is located (the requested court). Although the regulation is mostly used for hearing witnesses, a request for an expert to inspect documents and other objects is also possible.

In *Heidelberg v Bobst*, Heidelberg argued that Bobst should have followed the procedure set out in the Enforcement Regulation, and that the evidence seizure was therefore invalid. However, the French court refrained from deciding on the validity of the Dutch seizure and merely accepted the evidence obtained from it. More recently, the ECJ has clarified that the Evidence Regulation is not exclusive (C-170/11 and C 332/11). Nevertheless, the coexistence of the Evidence Regulation and the Enforcement Directive permits the argument that the cross-border aspects of securing evidence within the European Union raise an issue of judicial cooperation, which is addressed by the Evidence Regulation. Accordingly, the Enforcement Directive may not address these issues. This seems to be supported by Recital 11 of the directive, which

indicates that it does not aim to establish rules for judicial cooperation as there are already EU instruments governing such matters in general terms, which are equally applicable to intellectual property. Indeed, French courts seem to consider the procedures of the Evidence Regulation to form the only appropriate way to perform a *saisie*-like procedure in France on the basis of a foreign patent.

Does EU Evidence Regulation provide a solution?

This would be alright if the Evidence Regulation ensured the effective cross-border application of the evidence measures, as provided for in the national law of the member state of the main proceedings. In fact, the regulation's procedure can be attractive for rights holders, as it allows them to rely on the evidence measures provided in the major EU member states in which most patents are validated and to obtain evidence in other member states as necessary. For example, it could be favourable for patentees if a French court could order a *saisie-contrefaçon* to be carried out in another member state where the evidence was located based on a French patent, in particular if the courts of that member state were less familiar with such evidence measures. However, not all courts appear prepared to accept such requests.

Although the general rule is that the requested court carries out the request in accordance with its own law, the Evidence Regulation allows the requesting court to call for the taking of evidence to be carried out in accordance with a special procedure provided for by its national law (Article 10) – the various evidence measures set out in the Enforcement Directive are regarded as such special procedures. The regulation further provides that the requested court shall comply with a request for a special procedure, unless this is incompatible with its own law or would cause major practical difficulties.

However, the first case before the ECJ on the Evidence Regulation showed that not every court is prepared to accept such requests. In *Tedesco/Tomasoni* (C-175/06, 2007), which related to the infringement of a patent for a harness system, an Italian court had requested

a UK court to carry out a descriptive seizure. The UK court refused. The Greek and Irish governments supported the United Kingdom's position that it was allowable to refuse such requests. Although this raised some highly relevant questions for rights holders, the parties settled, so unfortunately the ECJ had no opportunity to answer these. The opinion of Advocate General Kokott is nevertheless available and is considered to provide the most authoritative guidance on these issues so far. In his opinion, the advocate general concluded that, precisely because the Enforcement Directive defers to the Evidence Regulation on the issue of securing cross-border evidence, the possibility of securing such evidence according to the Evidence Regulation ought to be available in procedures provided for by the Enforcement Directive, such as the Italian descriptive seizure procedure. This should include orders to grant access to the evidence and for a designated person to take samples and seize documents.

However, as an advocate general's opinion does not represent case law, it can be concluded that EU legislation provides no guaranteed way of securing evidence across borders for patent infringement. Rights holders thus need to adapt their strategy depending on the country which the evidence is located. Courts in some countries may grant evidence measures only through a request under the Evidence Regulation. However, courts in other countries are prepared to grant them directly for infringement of foreign patents, based on their national law.

Securing evidence worldwide

This situation is mirrored on a global level, where the Agreement on Trade-Related Aspects of Intellectual Property (TRIPs) prescribes that all members of the World Trade Organisation should make available prompt and effective provisional measures to preserve relevant evidence with regard to alleged infringements (Article 50). In contrast to the Enforcement Directive, infringement is not expressly restricted to IP rights under the national law of the respective member states. In fact, a Dutch court held in one case (*ABB/Turboned*, 2012) involving a Japanese and US patent that TRIPs requires the evidence

measures to be available for the infringement of patents of other non-EU member states. Although this reasoning has yet to be followed by other courts, it is an interesting argument, as the Enforcement Directive must be interpreted in a TRIPs-compliant way.

Similarly, the Evidence Regulation is mirrored by the 1970 Hague Convention on the Taking of Evidence Abroad in Civil or Commercial Matters. This is the precursor to the Evidence Regulation and still applies in relation to the 20 or so non-EU contracting states, which include India, China and the United States. Like the Evidence Regulation, the convention provides for the taking of evidence by a court at the request of a foreign court. Although the convention's procedures are frequently criticised as slow and cumbersome, they may be the only way to secure evidence in certain cross-border infringement cases.

Conclusion

Effectively securing evidence of patent infringement across national borders in the European Union is by no means guaranteed by the present state of EU legislation and case law. Patentees must depend on national law and national interpretations of EU legislation, which continue to differ on crucial points between member states. It is to be hoped that the ECJ will soon have an opportunity to explain the relevant provisions of the Enforcement Directive and the Evidence Regulation. In the meantime, rights holders and their advisers must adapt their strategies for securing evidence of infringement of foreign patents depending on the particular member state. Rights holders should also take this situation into account when deciding in which EU member states to validate their European patents. **iam**

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