

## Taking evidence in IP/IT matters

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Council Regulation (EC) No 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 Directive 2004/48/CE of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights (OJ L 157, 30.4.2004, p.45)*

*ECJ of April 28, 2005 in case C-104/03 St Paul Dairy Industires NV v Unibel Exser BVBA [2005] I-3481*

1. The first step when starting any IP litigation consists in gathering evidence of the alleged infringement. This operation is rendered considerably more difficult by borders. The international nature of an IP dispute dictates that elements of proof are often situated in a territory different that of the court seized of the proceeding on the merits. To obtain such evidence therefore suppose the ability to carry out investigation in a territory not under the same sovereignty as the judge trying the case. The judicial<sup>1</sup> gathering of evidence throughout Europe may be based on two community instruments. On one hand the intellectual property rights owners can search evidence of the infringement through proceedings allowing the order of provisional measures on grounds of article 24 of Brussels Convention/31 Brussels I Regulation.<sup>2</sup> As it is pointed out in recital 7 of the Enforcement Directive,<sup>3</sup> these proceedings vary widely from one Member State to another. For this reason, the abovementioned directive harmonizes measures for preserving evidence and obliges the Member States to ensure, even before the commencement of proceeding on the merits, the availability for the parties of measures shaped on *saisie description* – procedure existing already in Belgium, France and Italy. However, a serious doubt

<sup>1</sup> As opposed to purely voluntary search of evidence by the parties. This question will not be developed in the present paper, however it is suggested to cover this issue, as well as the question of blocking statues in the further research. See : LE BERRE, Y., PATAUT, E. *La recherche de preuves en France au soutien de procédures étrangères au fond*, RDAI/IBLJ, No.1, 2004 pp.53-71, in particular 55-57. MEYER-FABRE, N. “Obtention des preuves à l'étranger” Trav. Com. Franc. DIP. Années 2002-2004 pp. 199-219, in particular p.207

<sup>2</sup> As the wording of those provisions is almost identical, any time we will use the use the Regulation numeration, is shall be understood as referring to article 24 of the Convention and vice versa.

<sup>3</sup> Directive 2004/48/CE of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights (OJ L 157, 30.4.2004, p.45)

arises as to the feasibility of this tactic in the light of a recent European Court of Justice ruling in the *St Paul*<sup>4</sup> case. In fact, the Court would seem to suggest in this decision that the notion of provisional measure and the purpose of preliminary procedure is somehow narrow.

On the other hand the Council Regulation (EC) No 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 (1206/2001 regulation or Evidence Regulation),<sup>5</sup> which came into force on 1 January 2004 facilitates and accelerates the search of evidence through the channel of judicial cooperation. This instrument permits a court in a Member State to request a court in a different Member State to take evidence, or even to take evidence directly, whenever such measures are intended for use in judicial proceedings, commenced or contemplated. According to article 10.1 of the 1206/2001 regulation the requested court shall execute the request without delay, at the latest, within 90 days of receipt of the request. It is interesting to add that, to the best of our knowledge, the very first examples of application of the Regulation 1206/2001<sup>6</sup> come from the intellectual property litigation.

Following remarks shall than be divided into two parts, the first one relating to taking of evidence in intellectual property matters through provisional and protective measures, in particular the *ex parte* seizure, the second one to taking of evidence in accordance with the 1206/2001 Regulation.

### **I. Taking of evidence in intellectual property matters through provisional and protective measures**

2. Arrangements for gathering information vary widely from one Member State to another. Even if some solutions existing in civil law systems bear resemblances,<sup>7</sup> there are important divergences between civil law and common law procedural systems.<sup>8</sup> Those differences are rooted in the different organization of the civil procedure, the scope of the powers of the judge to control the investigation and divergent techniques of taking of oral testimony. It should be said from the outset that in civil law countries, there is nothing corresponding to a common law “trial”. A trial, once started, cannot be interrupted, except in very rare circumstances. Therefore all evidential material needed for the trial must have been collected prior to it, so as it can be submitted to the judge. Hence it was unavoidable to provide for access to information in a pre-trial phase of the litigation. Instead, civil law civil proceedings consist of a sequence

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<sup>4</sup> Judgment of April 28, 2005 in case C-104/03 *St Paul Dairy Industires NV v Unibel Exser BVBA* [2005] I-3481.

<sup>5</sup> JO L 174 of 27.6.2001, p. 1.

<sup>6</sup> See High Court, Chancery Division, Patents Court of March 16, 2004, in case *Dendron GmbH v The Regents of the University of California, E.I.P.R.* N-137-138. In this case Laddie J. had to decide whether the Regulation permitted collateral use of material requested under it in other proceedings before foreign courts and before European Patent Office.

<sup>7</sup> For more detailed comparative analysis see for instance : DESPRES, I. *Les mesures d’instruction in futurum*, Dalloz, 2004, p. 566 point 899, PERTEGAS-SENDER, M. *Cross-border enforcement of patent rights doctoral dissertation KULeuven* 2000, p. 262, GOTZEN, F., ed. *Beslag inzake namaak – Saisie-contrefaçon – Anton Piller orders, Story-scentia*, 1991.

<sup>8</sup> SCHLOSSER, P. observed that „There is no field where the civil law and common law procedural systems are more divergent than in the context of obtaining information”; see *Jurisdiction and international judicial and administrative co-operation RCADI* 2000 t. 284. See also MEYER-FABRE, N. “Obtention des preuves à l’étranger” *Trav. Com. Franc. DIP. Années 2002-2004* pp. 199-219, in particular p.199. ; BUXBAUM, H., *Improving Transatlantic Cooperation in Taking of Evidence in International Civil Litigation in Europe and relations with Third States* NUYTS, A., WATTE, N., (ed.) *Bryulant* 2005 pp. 343-379

of exchanges of written statements, to which very often various material are enclosed, following by an oral hearing. At any phase of the proceedings subsequent to the initial exchange of extensive written statements, the judge may request to take evidence, even abroad, and he may await the execution of the request before continuing with proceedings.

3. However, even in the civil law countries pre-trial, or rather pre-litigation, measures are often used. In fact, in the domain of protection of intellectual property the key issue is to act by surprise and rapidly so as to find the counterfeiting goods and to prevent damages. For this reason one of the most powerful and useful way to obtain evidence are provisional measures allowing the holder of the right to enter without warning the premises of the alleged infringer and seize the infringing goods, even before the commencement of the procedure on the merits. In Belgium and in France for instance, this type of *ex-parte* measure, a *saisie-description* (descriptive seizure/beslag inzake namaak <sup>9</sup>), is the preferred instrument of intellectual property rights holders.<sup>10</sup> By the same token the so called Anton Piller orders are used to preserve the evidence of the infringement of intellectual property rights in common law countries.<sup>11</sup>
4. The effectiveness and utility of the preliminary measures consisting in description, accompanied if necessary, by a physical seizure of infringing goods and other materials used to perpetrate the infringement was confirmed by the Enforcement Directive, according to which such a measure shall be accessible on application for any holder of the intellectual property right, if necessary, without other party having been heard.
5. The issue of evidence is regulated by articles 6 and 7 of the Enforcement Directive and recitals 20 and 21. The main objective of these provisions is to strike a reasonable balance between the paramount aim of establishing the infringement and the rights of the defense, as well as the need of protection of confidential information. Thus, the Directive provides for measures aimed at *preserving relevant evidence*,<sup>12</sup> to the exclusion of measures amounting to what is usually called “fishing expeditions” i.e. Further, the Directive distinguishes between an ordinary infringement and an infringement committed on a commercial scale. In the first case national courts can order the disclosure and deliverance of specified evidence which lies in the control of the opposing party. Where the infringements are committed on a commercial scale,<sup>13</sup> a court can also require the disclosure of financial and commercial documents, subject

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<sup>9</sup> See. for example articles L.521-1, L. 615-5, L.623-27, and L.716-7 of the French Code of Intellectual Property or articles 1481 and 1488 of Belgian Code of Civil Procedure. The are two prerequisites for obtaining descriptive seizure : strong prima facie IP right and suspicion of first indices of infringement.

<sup>10</sup> MIGNOLET, O KAESMACHER La saisie en matière de contrefaçon : le code judiciaire à le rencontre des droits intellectuels J.T. 2004 pp. 57-71 ; GLAS, G., La saisie-description en matière de brevets d'invention en Belgique in Jura Vigilantibus Antoine Braun, Larcier 1994, pp. 193-204.

<sup>11</sup> Anton Piller K.G. v. Manufacturing Process Ltd [1976] Ch. 55 (C.A.). This judgment rendered in a copyright infringement case set out a threefold test of application of the measure : a) strong prima face case of infringement, b) grave danger to applicant's interests and c) real possibility of destruction of evidence. Today those prerequisites apply to so called 'search order's. See: Civil Procedure Act 1997 (U.K.) c.12, s.7; GOTZEN, F., ed. Beslag inzake namaak – Saisie-contrefaçon – Anton Piller orders, Story-scentia, 1991

<sup>12</sup> Article 7.1. Emphasis added.

<sup>13</sup> According to recital 14 of the Enforcement Directive, acts carried out on a commercial scale are those carried out for direct or indirect economic or commercial advantage; this would normally exclude acts carried out by end consumers acting in good faith.

to protection of confidential information.<sup>14</sup> In cases where any delay in proceeding might cause irreparable harm, a court can proceed *ex parte* on application by a right owner, but notice has to be given to the opposing party without delay after the execution of the measures at the latest. If formal infringement proceedings are not instituted within a reasonable time, the provisional measures are to be revoked or cease to have effect upon a request of the defendant. In order to prevent an abusive use of measures, the order of measure may be subject to the lodging by the applicant of adequate security or equivalent assurance in order to secure possible prejudice suffered by the defendant due to unfounded application of measures.<sup>15</sup>

6. For the sake of clarity it worth recalling that measures aimed at obtaining information may be ordered either on the request of the party, in general before the commencement of the proceedings (*mesures d'instruction in futurum*), or in the course of proceedings by the judge having jurisdiction as to the substance of the case. As far as the latter situation is concerned, the European Court of Justice held in *Van Uden*<sup>16</sup> that a court having jurisdiction as to the substance of the case may order any provisional and protective measure, without its jurisdiction being subject to any further conditions, among others, the condition of territoriality.<sup>17</sup> However, where the evidence is located abroad the powers of a judge may be limited by the foreign judicial sovereignty.<sup>18</sup> The solution to this problem was provided by the adoption of international conventions, like the Hague Conventions on Civil Procedure of 1954 and on the Taking of Evidence Abroad in Civil and Commercial Matters of 1971 (hereinafter the "Hague Convention 1970").<sup>19</sup> Within the European Judicial Area these conventions were replaced by the Evidence Regulation, which allows to a court seized with proceedings to search assistance of the foreign courts. As for the possibility of searching for evidence by the parties to a litigation themselves on grounds of article 24 of Brussels Convention (31 of the Brussels Regulation), it has for the long time remained a delicate issue,<sup>20</sup> the more so because in practice the measures are often requested before bringing of any proceedings in the court having jurisdiction as to the substance of the case. Although the Commission tried to address this issue in its Proposal of 1997 modifying some provisions of the Brussels Convention,<sup>21</sup> any substantial

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<sup>14</sup> Article 6 of the Directive.

<sup>15</sup> Article 7.2 and 7.4 of the Directive.

<sup>16</sup> Judgment of November 17, 1998 in case C-391/95 *Van Uden Maritime BV v Deco-Line e.a.* [1998] I-7091.

<sup>17</sup> Point 22 of the judgment.

<sup>18</sup> MOUGENOT, D., *Le règlement européen sur l'obtention des preuves* J.T. 2004 pp. 17-21, in particular p.17 ; BESSO, C., *Taking of evidence abroad : from the 1970 Hague Convention to the 2001 European Regulation*, in *International Civil Litigation in Europe and relations with Third States* NUYTS, A., WATTE, N., (ed.) Bryulant 2005 pp. 365-379, in particular p.365 and 377. This author gives references to several French, British and German decision ordering the extraterritorial taking of evidence without resorting to the Hague Evidence Convention, than applicable; MEYER-FABRE, N. "Obtention des preuves à l'étranger" *Trav. Com. Franc. DIP. Années 2002-2004*, pp. 199-219, in particular p.213. According to this author searching of the evidence abroad by means of an injunction is limited to evidence in possession of the parties to litigation. Thus, if the evidence is in possession of a third party the "reasonable limits of jurisdiction to order an injunction" (*limites raisonnables de la compétence d'injonction*) are attained and a recourse to instruments of judicial cooperation seems to be necessary.

<sup>19</sup> The Hague Convention of March 1, 1954 on Civil Procedure and the Hague Convention of March 18, 1970 on the Taking of Evidence Abroad in Civil and Commercial Matters. Available at [www.hcch.net](http://www.hcch.net)

<sup>20</sup> GAUDEMET-TALLON, H. *Compétence et execution des jugements en Europe*, Règlement n° 44/2001, Conventions de Bruxelles et de Lugano, Montschrétien, 3<sup>ème</sup> éd. n° 307, p. 247.

<sup>21</sup> According to the Proposal for a Council Act establishing the Convention of Jurisdiction and the Recognition and Enforcement of Judgment in Civil and Commercial Matters in the Member States of the European Union (COM (97) 609 final, JO C 33 of January 31, 1998) an article 18 *bis* was to be inserted on the place of the deleted article 24. It reads as follow

modification to the wording of article 24 has not been done till today. It was not clear than, whether measures aimed at gathering and preserving evidence are covered by the definition of protective and provisional measures given by the European Court of Justice in the *Reichert II*<sup>22</sup> and *Van Uden* rulings.

As far as French or Belgian descriptive seizure and similar measures in another Member States are concerned, some authors held that it is possible to apply to the court of the State where the evidence is located on the basis of article 31 of Brussels Regulation.<sup>23</sup> In Belgium for instance there is no doubt that a court may order on grounds of article 24 of Brussels Convention a provisional measure to secure the evidence of the patent infringement, even if there is no patent protected in Belgium and no Belgian courts having jurisdiction on the substance of the infringement proceedings. In an important judgment of September 9, 1999 the Belgian Cour de Cassation ruled the following:

«Attendu qu'en vertu de l'article 24 de la Convention [de Bruxelles] les mesures provisoires et conservatoires prévues par la loi d'un Etat contractant peuvent être demandées aux autorités judiciaires de cet Etat, même si, en vertu de la Convention citée, une juridiction d'un autre Etat contractant est compétente pour connaître du fond ;  
Que cet article se réfère aux dispositions nationales prévues en la matière et, ainsi que la Cour de justice des communautés européennes l'a décidé dans son arrêt rendu le 17 novembre 1998, requiert l'existence d'un lien entre l'objet de la mesure demandée et la compétence fondée sur des critères territoriaux de l'Etat contractant du juge saisi ;  
Qu'en examinant si, en vertu du droit national, la saisie contrefaçon pouvait être pratiquée sur des biens et documents se trouvant sur le territoire belge, le juge d'appel ne viole pas l'article 24 de la Convention précitée». <sup>24</sup>

This decision was welcomed by scholars and practitioners <sup>25</sup> and at the time being it is well rooted in the spirit of Belgian patent litigators. However, a question arose whether this established case law has not been challenged by a recent Court of Justice decision.

7. In a judgment of April 28, 2005 in case C-104/03 *St Paul* the Court of Justice had an occasion to shed some light on the issue of applicability of article 31 Brussels I Regulation to measures aimed at gathering information. In its judgment the Court ruled out the possibility to order the hearing of the witness

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“1. Where such provisional measures as are available under the law of a Contracting State are to be enforced in its territory, they may be sought in that State, irrespective of the place where they produce their effects, even if, under this Convention, the courts of another Contracting State have jurisdiction as to the substance of the matter. 2. For the purposes of this Convention, provisional, including protective measures means urgent measures for the examination of a dispute, **for the preservation of evidence** or of property **pending judgment** or enforcement, or for the preservation or settlement of a situation of fact or of law for the purpose of safeguarding rights which the courts hearing the substantive issues are, or may be, asked to recognize”. (Emphasis added).

<sup>22</sup> Judgments of March 26, 1992 in case C-261/90 *Reichert v Dresdner Bank* ECJ, [1992] I-2149, point 34.

<sup>23</sup> O'SULLIVAN, G, Cross-border jurisdiction in patent infringement proceedings, E.I.P.R. 1996.654-664 esp.658, PERTEGAS-SENDER, M. Cross-border enforcement of patent rights, Oxford University Press 2002, p. 142, point 3.167; GONZALEZ BEILFUSS, C. Nulidad e infracción de patentes en la Comunidad Europea, Madrid, Eurolex, 1996, pp.180-181.

<sup>24</sup> Rev. Droit. Comm. Belge 2000.130; this judgment confirmed previous case law for instance: Court of first instance Tournhout, November 12, 1981, Ing. Cons. 1982.31.

<sup>25</sup> PERTEGAS-SENDER, M. Litiges internationaux en matière de droits de la propriété intellectuelle : Une saisie-contrefaçon extraterritoriale ? comments to Cour de cassation of September 9, 1999, Rev. Droit Comm. Belge, 2000.132-136, VANDERMEULEN, B. “The next generation of cross-border litigators” *Managing IP Supplement Benelux IP Focus 2005* available at the site (as of April 10, 2006). <http://www.managingip.com/Default.asp?Page=17&ISS=14232&SID=495101> ; contra VAN BUNNEN, L. «Brevets d'invention. Examen de jurisprudence 1996-2001 » Rev. Crit. Jp. Belge 2001.407-467, in particular 433-436.

domiciled in another Member State prior to the commencement of the proceedings on the merits on grounds of article 24 of the Brussels Convention.<sup>26</sup> The justification of this decision is sometimes confusing, however, for some commentators, it allows conclusion that all the measures aimed at gathering information are excluded from the scope of the autonomous definition of the provisional and protective measures.<sup>27</sup> However, such a large interpretation of this ruling seems to be erroneous in the light of the specific character of the measure which was under discussion in the *St Paul Diary* case.

8. The facts of case were the following. Unibel and St Paul are Belgian companies disputing an issue whose nature remains obscure.<sup>28</sup> Unibel filed an application to the Haarlem Rechtbank so as the latter order the preliminary hearing of a witness domiciled in the Netherlands. At the moment of the filing of this application there were no proceedings pending between Unibel and St Paul, neither in Belgium, nor in the Netherlands. Haarlem Rechtbank ordered the requested measure and St Paul appealed against this decision, seeking an order setting it aside on the ground that the Netherlands courts lacked jurisdiction to order such a measure. Gerechtshof te Amsterdam (Regional Court of Appeal) referred 2 questions to the ECJ asking whether the “provision in Article 186 et seq. of the [WBR] concerning the ‘preliminary hearing of witnesses prior to the bringing of proceedings’ come within the scope of the Brussels Convention in light of the fact also that, as provided for in that legislation, it seeks not only to enable material evidence to be taken from witnesses shortly after the facts in dispute and to prevent evidence from being lost but also, and in particular, to provide an opportunity for persons involved in an action subsequently brought before the civil courts – those considering bringing such an action, those who anticipate that the action will be brought against them, or third parties otherwise concerned by such an action – to obtain advance clarification of the facts (with which they are perhaps not entirely familiar), so as to enable them better to assess their position, particularly also with regard to the issue of identification of the party against whom proceedings must be instituted”. In the second question the referring judge asked whether such a provision can constitute a measure within the meaning of [article 31 of the Brussels Regulation]. The wording of the question is very significant because it underlines the speculative character of the measure, aimed rather at obtaining a clarification of the facts, than at preventing evidence from being lost. The court suggested in this manner that the measure applied for might have a character of a fishing expedition.
9. According to the Court article [31 Brussels I Regulation] “must be interpreted as meaning that a measure ordering the hearing of a witness for the purpose of enabling the applicant to decide whether to bring a case, determine whether it would be well founded and assess the relevance of evidence which might be adduced in that regard is not covered by the notion of ‘provisional, including protective, measures’”. This conclusion was found on three arguments. First of them relates to the nature of the requested measure,

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<sup>26</sup>A reference for a preliminary ruling relating to a provisional hearing of the witness in question in *St Paul* had been made already in 1996 in *Saueressig GmbH c/Forbo-Krommenie BV* (Case C-99/95, removed from the register by order of April 29, 1996). The reference for a preliminary ruling in that case was made by the Hoge Raad der Nederlanden and the referred question had almost the same wording as the questions in *St Paul* case (see OJ C 137 of June 3, 1995).

<sup>27</sup>PATAUT, E. Comments to *St Paul* Rev. Crit. DIP 2005 pp.743-753, in particular 750.

<sup>28</sup>As the AG Ruiz-Jarabo Colomer indicated in his opinion, there was a disagreement as to the quantum of damages payable by reason of the malfunctioning of machinery installed by Unibel at an industrial plant belonging to *St. Paul*.

the second to the prevention of the forum shopping and the principle of legal certainty and the last one to the circumvention of the Evidence Regulation.

10. First, the Court recalled the *Reichert II/Van Uden* definition of “provisional, including protective measures” referring to measures which are intended to preserve a factual or legal situation so as to safeguard rights the recognition of which is otherwise sought from the court having jurisdiction as to the substance of the case. Court added that the granting of this type of measure requires on the part of the court, in addition to particular care, detailed knowledge of the actual circumstances in which the measures are to take effect, which means that generally, the court must be able to make its authorization subject to all conditions guaranteeing the provisional or protective character of the measure ordered. Then it held that the measure in question in the context described in the order for reference was not intended to preserve a factual or legal situation but to establish facts on which the resolution of future proceedings could depend and in respect of which a court in another Contracting (Member) State has jurisdiction. The Court underlined that the grant of the measure in question is not subject to any particular conditions and that the measure is intended to enable the applicant to decide whether to bring a case, determine whether it would be well founded and assess the relevance of evidence which might be adduced in that regard.<sup>29</sup>
11. Secondly, the Court of justice held that the grant of the requested measure could easily be used to circumvent, at the stage of preparatory inquiries, the jurisdictional rules set out in article 2 and 5 to 18 of the Convention [2 and 5 to 24 of the Brussels I Regulation] and that may also lead to a multiplication of the basis of jurisdiction in relation to one and the same legal relationship, which is contrary to the aims of Convention. In other words, by invoking the principle of legal certainty, the Court proved its intention to prevent the forum shopping.
12. Finally, the third argument of the Court was that an application to hear of a witness in circumstances such as those in the main proceedings could be used as a means of sidestepping the rules governing the transmission and handling of applications made by a court of a Member State intended to have an inquiry carried out in another Member State, determined in the Evidence Regulation.<sup>30</sup> In other words the Court seems to be inclined in favor of the gathering evidence through measures of judicial cooperation rather than by the parties themselves.
13. It is proposed to examine the impact of the *St Paul* decision on practice of obtaining evidence abroad through the preliminary measures similar to the descriptive seizure. The interest of such analysis lies in the fact, that while the Enforcement Directive introduces preliminary *ex parte* measures into the legal orders of all Member States, the argumentation of Court transposed to the context of the descriptive seizure is quite confusing. On the one hand, some features of this measure are exactly the same as the features of the preliminary hearing of a witness pointed out by the Court, namely the establishment of facts and the intention to enable the applicant to decide whether to bring a case, determine whether it would be well founded and assess the relevance of evidence which might be adduced in that regard. It is in the nature of things that, as long as the IP rights holder does not have any description or any specimen of the allegedly

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<sup>29</sup> Points 13, to 16 of the judgment.

<sup>30</sup> Point 23.

infringing goods, he cannot assess the relevance of the evidence nor decide whether to bring the case. He cannot assess the scope of the infringement either. On the other hand, there are features of the descriptive seizure which make it sensibly different from the measure in question in the *St Paul* case, namely its provisional character. There is, therefore a need for a further study of the question at hand, assessing the arguments underpinning the *St Paul* decision, as well as the impact of this judgment on practice of taking of evidence abroad in intellectual property matters.

## **II. Taking of evidence in accordance with the 1206/2001 regulation**

14. The Evidence Regulation entered into force on 1 July, 2001 and become fully applicable on January 1, 2004. This is an important instrument aimed at simplifying and accelerating cooperation in taking of evidence between the courts of the Member States. The Regulation removes the need to transmit the request to the central authority which will, in turn, forward it to the court: the judge of a Member State, where the process is pending (or is “contemplated”), directly asks the judge of another Member State where the evidence is located, to collect it.<sup>31</sup> It is furthermore possible for the judge of one Member State to collect the evidence in another State <sup>32</sup> either directly or through other designated person. The direct evidence taking is considered to be the most innovative feature of the Regulation,<sup>33</sup> since it implies the renunciation of the principle of the territoriality as to the evidence taking. This possibility is, however, limited to spontaneous action of the individual without the need for coercive measures. Further to simplifying the acts, the procedure is accelerated by fixing the time limits for the execution of the activities: for instance, the taking of evidence by the requested judge must be concluded within 90 days and the authorization allowing the requesting judge to directly collect the evidence must be either given or denied within 30 days.
15. The rules relating to the transmission and execution of requests between cooperating courts, in general, due to their technical character, do not give rise to any particular problems. It does not mean that the application of this Regulation in practice do not provoke any hesitation. At least two interesting issues relating to the application of the Evidence Regulation arise in the context of intellectual property protection. The first one concerns the problematic application of the Regulation in pre-trial phase of litigation. The second was brought to the fore in a patent litigation case *Dendron GmbH v The Regents of the University of California*, where Laddie J. had to determine whether and to what extent evidence obtained from other courts within the EU and in the United States could be used by the claimant in further EU Member State court proceedings.

### (i) Application of Evidence Regulation in pre-litigation phase

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<sup>31</sup> Article 10.

<sup>32</sup> Article 17. Direct taking of evidence by the requesting court may only take place if the request is accepted by the central authority, which may refuse direct taking of evidence only “if it is contrary to fundamental principles in its Member State.

<sup>33</sup> MOUGENOT, D., *Le règlement européen sur l’obtention des preuves* J.T. 2004 pp. 17-21, in particular p.20, point 22 ; NIBOYET, M.L., LEBEAU, D., *Regards croisés du processualiste et de l’internationaliste sur le règlement CE du 28 mai 2001 relatif à l’obtention des preuves civiles à l’étranger*, *Gazete du Palais*, 2003, p.221.

16. According to article 1, Evidence Regulation shall apply in civil or commercial matters where the court of a Member State requests the competent court of another Member State to take evidence or to take evidence directly in another Member State. It is underlined in the second paragraph of this article that a request shall not be made to obtain evidence which is not intended to be used in judicial proceeding, commenced or contemplated. It is therefore possible for a judge in a Member State to proceed to investigation in another Member State for the purposes of a contemplated judicial proceeding i.e. in a pre-litigation phase.<sup>34</sup> The wording of this article gives rise to a confusion, because of a declaration of June 20, 2001 relating to the Evidence Regulation the Council of the European Union stated that the scope of application of the Evidence Regulation “shall not cover the pre-trial discovery, including the so-called ‘fishing expeditions’”.<sup>35</sup> This declaration brings back the discussion relating to article 23 of the Hague Convention 1970, according to which Contracting States “may at the time of signature, ratification or accession, declare that it will not execute Letters of Request issued for the purpose of obtaining pre-trial discovery of documents as known in Common Law countries”. It is to be noted that nearly all parties to the Convention have lodged such reservations which were limited somewhat after, following a Report of a Special Commission. This Report explained the issue and presented it as a kind of transatlantic imbroglio.<sup>36</sup> In fact, the source of the provision is a pure misunderstanding of what the *common law* pre-trial discovery is. If it is true that in U.S. civil litigation the pre-trial discovery is particularly extensive, allowing for, inter alia, obtaining discovery of the existence and description of documents relevant to the dispute, even if parties cannot at that point identify such documents with particularity,<sup>37</sup> in other common law countries such a measure would be considered as amounting to a ‘fishing expedition’.<sup>38</sup> At the time being, and to the best of our knowledge, there is no reported example of the application of the Evidence Regulation within a context of *contemplated* proceedings. The issue does not seem to be purely theoretical though and is worth to be examined in the further study.

(ii) Collateral use of the gathered evidence

17. The second issue concerning the application of the Evidence Regulation appeared in relation to a common law procedural rule, according to which material disclosed in execution of a search order can be used only in proceedings in question. In *Dendron GmbH v The Regents of the University of California*<sup>39</sup> claimant was seeking revocation of the defendant’s patent owing to alleged prior public use of the invention. The

<sup>34</sup> MOUGENOT, D., Le règlement européen sur l’obtention des preuves J.T. 2004 pp. 17-21, in particular p.18 point 6.

<sup>35</sup> Adendum au process-verbal doc. No. PV/CONS 26 JAI 42 ; point 6: Déclaration du Conseil «Le champs d’application de ce règlement ne couvre pas la ‘pre-trial discovery’, notamment les ‘fishing expeditions’ ». The English term was used in all the versions of the declaration.

<sup>36</sup> BUXBAUM, H., Improving Transatlantic Cooperation in Taking of Evidence in International Civil Litigation in Europe and relations with Third States NUYTS, A., WATTE, N., (ed.) Bryulant 2005 pp. 343-379, in particular p. 351-352, MEYER-FABRE, N. “Obtention des preuves à l’étranger” Trav. Com. Franc. DIP. Années 2002-2004 pp. 199-219, in particular p.205-207.

<sup>37</sup> See in particular rule 26 of Federal Rules of Civil Procedure, available at <http://www.law.cornell.edu/rules/frcp/Rule26.htm>

<sup>38</sup> MEYER-FABRE, N. op. cit. p.206. BESSO, C., Taking of evidence abroad : from the 1970 Hague Convention to the 2001 European Regulation, p. 368 : “The controversy over taking of evidence abroad is not one that pits common law against civil law, but rather one that pits the United States against the rest of the world”

<sup>39</sup> High Court, Chancery Division, Patent Court of March 16, 2004, E.I.P.R. 2004.N-13

defendant counterclaimed for infringement. The evidence for a public prior use was being, or had been obtained in various places (namely in Germany and United States) by search orders made in previous English proceedings. Those search orders has been made subject to the material not being used in anything other than the English proceedings in question, although Dendron wished it to be also in other proceedings which it had or was going to either underway. In consequence Patents Court had to determine whether the material obtained through requests could be used in those proceedings. Dendron argued that it should be permitted to use the material in any way it liked, including for the purposes of European Patent Office (EPO), Dutch and German proceedings, all related to patent in suit. As the request made to the German court was under the 1206/2001 Regulation, Laddie J. had to judge whether the Regulation permitted collateral use of material requested under it. In his view, the request procedure was not intended for the purposes of obtaining evidence for use in non-judicial proceedings, such as opposition proceedings at the EPO. Barring any higher authority, Laddie J. restricted the purpose of the Regulation to the limited use of material only for the requesting court. Any further use of the material would be prohibited unless expressly permitted by the requesting court or the person or parties from whom the evidence was sought. According to the first comments<sup>40</sup> this judgment did not established any general rule, each case having to be decided on its own facts.

18. It is to be noted that the question of a collateral use of the evidence may reappear in a Belgian case, even though in a different manner than in the *Dendron* case. Still, the *Steps Holding v D. Berenbaum and Calzificio Franzoni*<sup>41</sup> case gives first and foremost an interesting example of the influence of judicial cooperation instruments on the carrying out of parallel proceedings. In *Steps Holding*, a Dutch owner of a European patent claimed that Calzificio Franzoni infringed his patent in Belgium. The claimant had acquired patent rights in 1993 from an Italian inventor – M. Pedrini, the administrator and sole shareholder of an Italian company called Calzificio Gi-Emme de Pedrini. The defendant in the Belgian action challenged the validity of the patent for lack of novelty, and claimed that he had acquired the technology in question from the Italian inventor before the latter deposited a patent request in EPO. The Brussels Court of Appeal requested an investigation in Italy (by the court of Brescia), namely, a witness statement by the Italian inventor. In parallel to the Belgian proceedings, other proceedings tending to declare the nullity of the patent in question were brought by the defendant in the Belgian action (*Calzificio Franzoni*) in Brescia. However, these proceedings had been stuck for years in a slow judicial machine. As the requested court has under the Regulation only 90 days for the execution of the measure, the Belgian request may have the effect to accelerate the Italian proceedings. But in the first place the Italian court will have to decide whether witness evidence gathered for the purposes of the Belgian proceedings may be directly used to decide over the Italian litigation or if it is necessary to hear the witness another time.
19. The problem of the collateral use of evidence, as presented in the cases above, is twofold. First, it raises an interesting issue as to the scope of the law applicable to the taking of evidence. In other words one has to

<sup>40</sup> PEARCE, D., E.I.P.R. 2004.N-13, REESE, S., A wider net : The EC's Regulation on cooperation in the taking of evidence and the US Supreme Court decision in Intel have provided new disclosure tools to litigants. Patent World, July/August 2005, [www.ipworldonline.com](http://www.ipworldonline.com), as of April 20, 2006.

<sup>41</sup> Brussels Court of Appeals of February 15, 2006 (case 2004/AR/178), unreported.

decide whether the restriction on the collateral use of evidence is to be assessed in the light of the Regulation or national law. Only then it shall be possible to consider whether such restriction exists and, in affirmative, assess its consequences.

20. This issue deserves a further analysis because of its practical implications. While the restriction on the collateral use of the evidence is justified by the aim of preserving the confidential information, which is particularly important in the domain of intellectual property, the drawbacks of such a restriction are evident. It is enough to look at the *Dendron* case to find an eloquent example of its awkward consequences. In the German revocation proceedings which followed the English ones, the witness, irritated, simply did not want to answer the same questions for a second time.

### **III. Concluding remarks**

21. A study devoted to the question of cross-border taking evidence in IP matters should cover both the gathering of evidence by the parties to litigation via provisional and protective measures and by a judge through the channels of judicial cooperation. It is important to bear in mind the harmonization of measures aimed at gathering information operated at the Community level by the Enforcement Directive. This Directive diminishes considerable differences between legislations of the Member States as to the methods of obtaining and preserving evidence in IP matters. As the use of preliminary proceedings is one of the characteristic features of the IP litigation an emphasis should be laid on the issue of the relation between this method of gathering information and the gathering of evidence through the channel of judicial cooperation. The problem of fishing expeditions and measures adopted in order to curtail this practice should also be covered by a further study. By the same token, a very interesting question of the collateral use of the evidence obtained in application of 1206/2001 Regulation need to be analyzed in depth.