

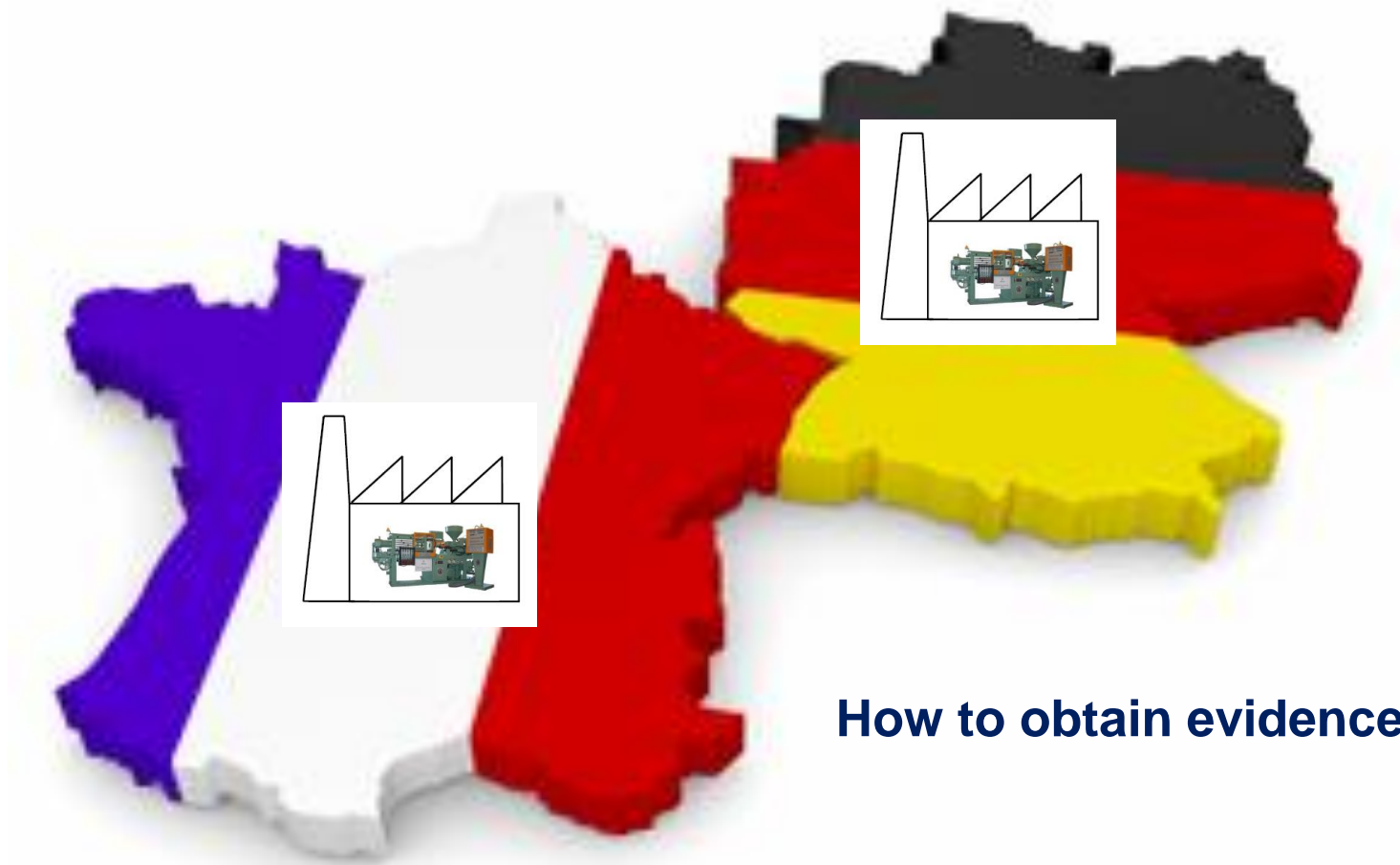


## **Right to inspection claims in Germany and France**

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22 November 2016

# **I. The Scenario**

## No public access to allegedly infringing embodiment



**How to obtain evidence?**

## European legal framework

- EC Regulation 2004/48 of 28 April 2004 on the Enforcement of IP rights harmonized evidence preservation measures in the EU (**Enforcement Directive**), in particular:
  - **Article 7:**

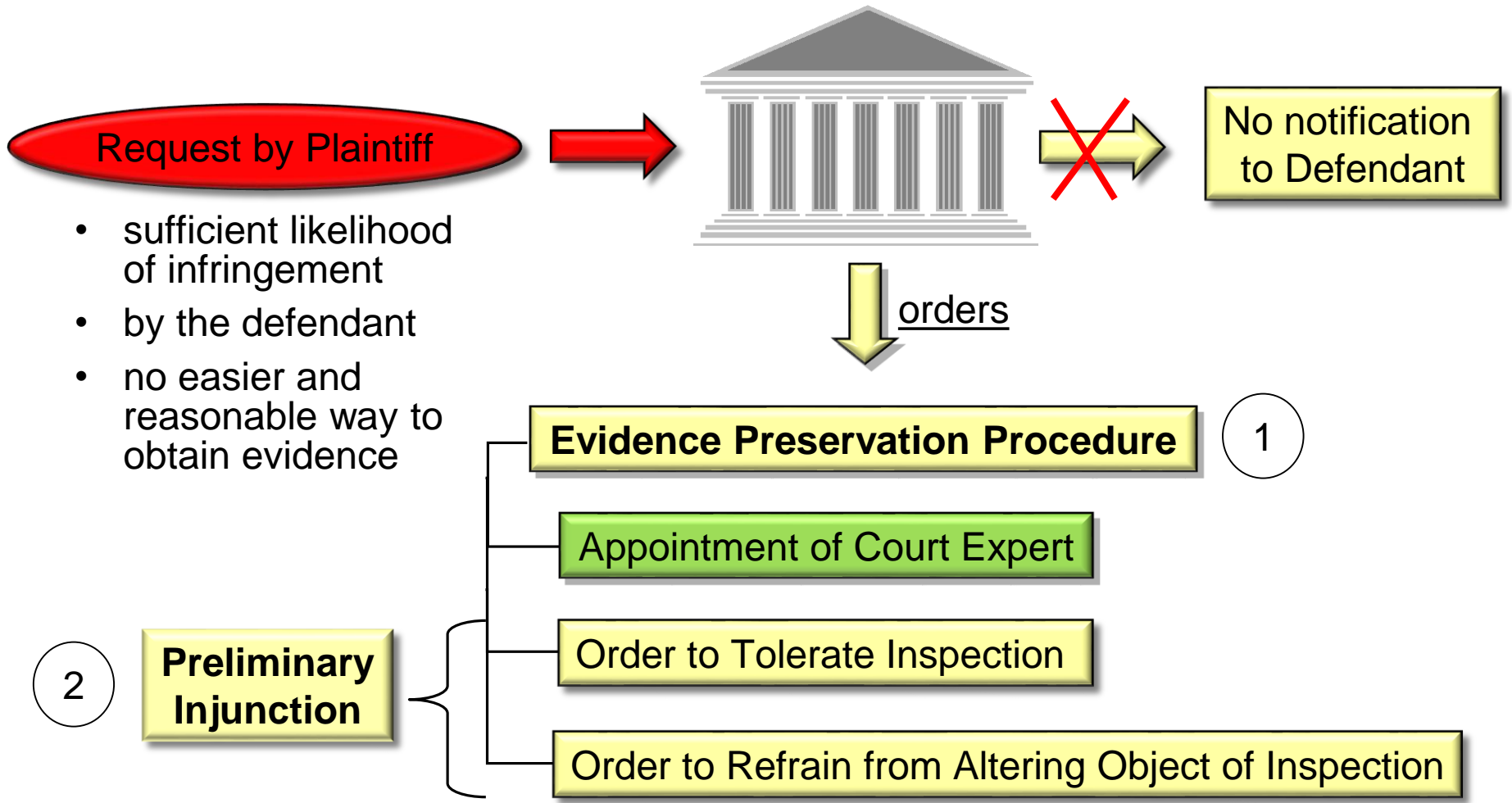
The judicial authority may order prompt and effective provisional **measures to preserve relevant evidence** in respect of the alleged infringement, subject to the **protection of confidential information**, notably the detailed **description**, with or without the **taking of samples**; those measures shall be taken, if necessary without the other party having been heard.
- Inspired by the French **Saisie-contrefaçon** procedure

## **II. Evidence Preservation in Germany**

## Sec. 140c German Patent Act – Evidence Preservation

- Transposition of the Enforcement Directive on **September 1, 2008**:
    - **Sufficient likelihood of a patent infringement;**
    - claim for **production of a document** or **inspection** of an item or of a process;
    - **necessary for** the purpose of **establishing claims;**
    - **unless** such claim is **disproportionate;**
    - also by means of an **injunction;**
    - **without a prior hearing** of the opposing party
    - appropriate **measures to ensure confidentiality.**
  
  - Legal procedure to enforce claim for evidence preservation was developed by the Duesseldorf patent courts (**‘Duesseldorf Practice’**)
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# The ‚Duesseldorfer Practice‘



## Competences of the Court Expert

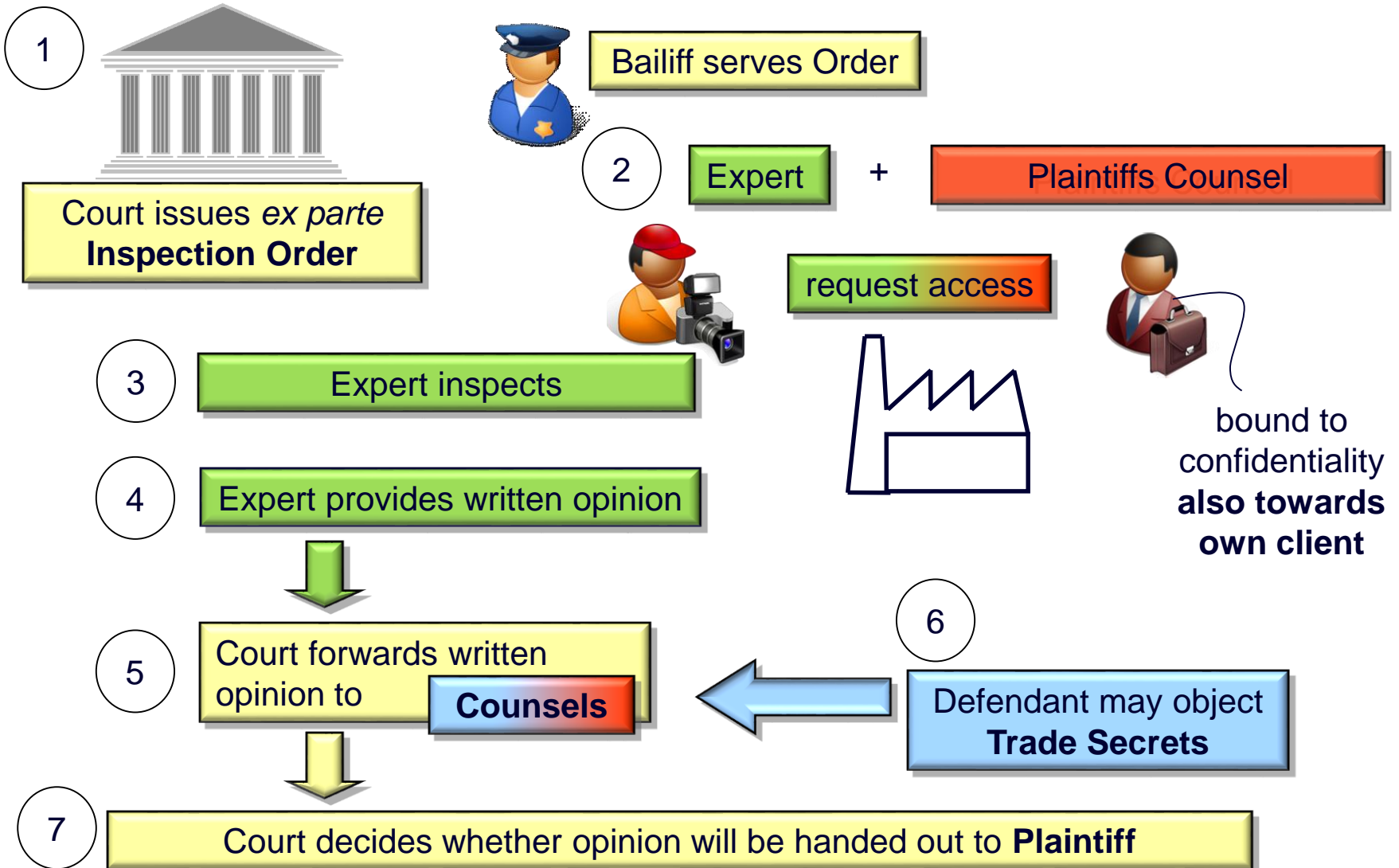
- Broad interpretation of the term „description“.
  - „Any measure that – according to the specific character of the object of inspection and the facts which need to be established – allows for reaching certainty over the presence of an infringement“
- Court order needs to list all measures allowed to the expert.
- Generally, Defendant can be obligated to **tolerate measures** only. Exceptionally, **obligations to cooperate** (e.g. enter passwords, dismantle machine, open doors etc.).
- If necessary: **auxiliary persons** (=> bound to confidentiality!).
- **Examples** of measures:
  - Inspecting procedures and/or devices
  - Dismantling covers, blinds or else,
  - Removing or disassembling of parts of complex devices,
  - Starting or switching off of machines and the like,



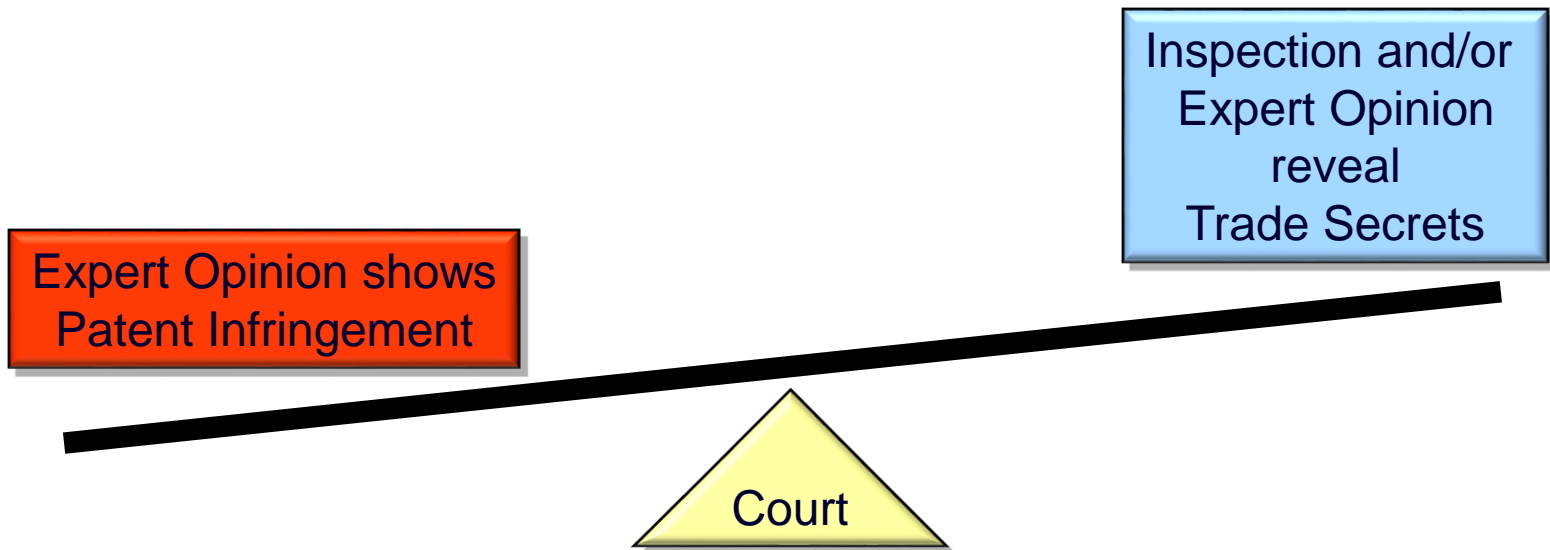
## Competences of the Court Expert

- Taking of photos, films, screenshots, copies (including electronic copies)  
[=> (P) Use of copying devices of the Defendant?]
  - Using a dictaphone,
  - Taking samples for analysis purposes,
  - Reading out machine memories and making copies thereof, etc.
- 
- Also **submission of documents** and **surrender of data** to the court expert  
e.g.:
    - Technical documentations, manuals,
    - manufacturing instructions, specifications of materials,
    - drawings etc.
- => No case of evidence presentation under Art. 6 of the Enforcement Directive because the documents/data is handed out to the court expert for his report only.

# Inspection and Expert Opinion



## Balance of Interests

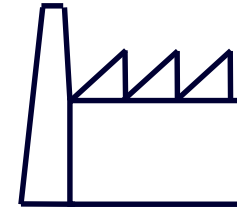


# Counter Measures

...when



request access



1

Consult legal counsel



~ 2 hours grace period

2

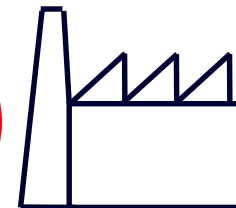
Object

against

Inspection Order

3

Deny access to premises



Until search warrant is obtained

4

Observe inspection of Expert

## Legal remedies against ‘Duesseldorf Practice’

- **Inspection order**
  - No right to appeal against decision to grant inspection.
  - Decision to deny inspection is subject to immediate appeal.
- **Preliminary injunction to tolerate inspection**
  - Subject to objection proceedings
  - Even successful objection is unlikely to stop court expert report!
- **Surrender of the court expert report to the Plaintiff**
  - Immediate appeal against decision
    - to hand out the report entirely
    - to hand out a blackened/shortened version of the report
    - not to hand out the report.

## How Can the Expert Report be Used?

- **Full fledged evidence in proceedings on the merits in Germany**
  - Use *ex officio* in proceedings against Defendant (§§ 493, 411 ZPO).
  - Use in proceedings against other Defendants is possible (§ 411a ZPO).
  
- **Evidence in proceedings on the merits in other countries?**
  - Competent 'Duesseldorf Practice' procedure is the court for the proceedings on the merits (incl. international jurisdiction)
    - No evidence preservation in Germany exclusively for foreign lawsuit,
    - Maybe: Request for judicial assistance to a court of another EU Member state to take evidence under EU-Regulation No 1206/2001 (See Opinion of Attorney General Kokott in ECJ, C-175/06 – Tedesco)
  - Whether German court expert report is admissible evidence in foreign jurisdiction is decided by *lex fori*.

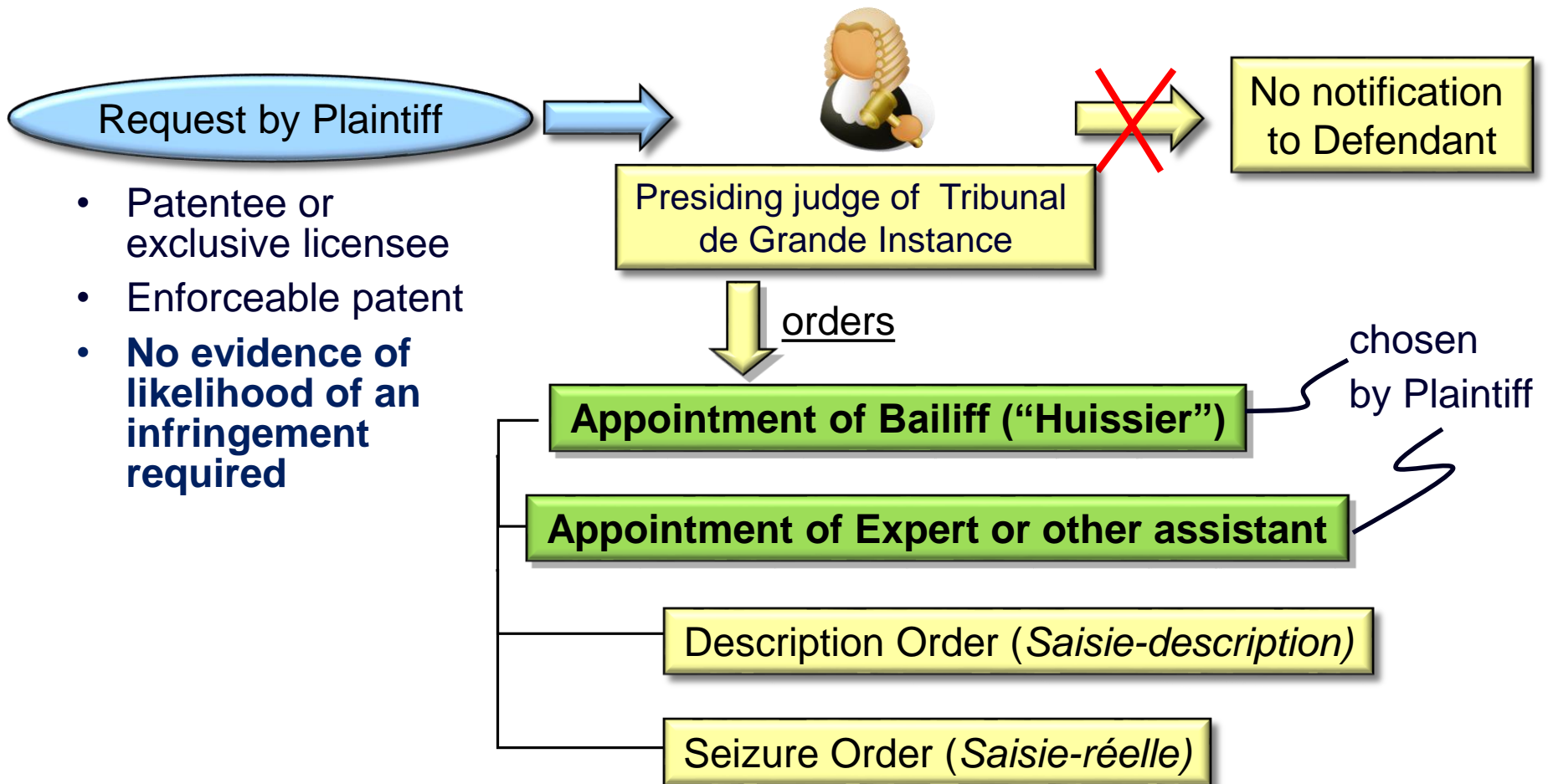
## **II. Saisie-contrefaçon in France**

## Fundamentals of the *saisie-contrefaçon*

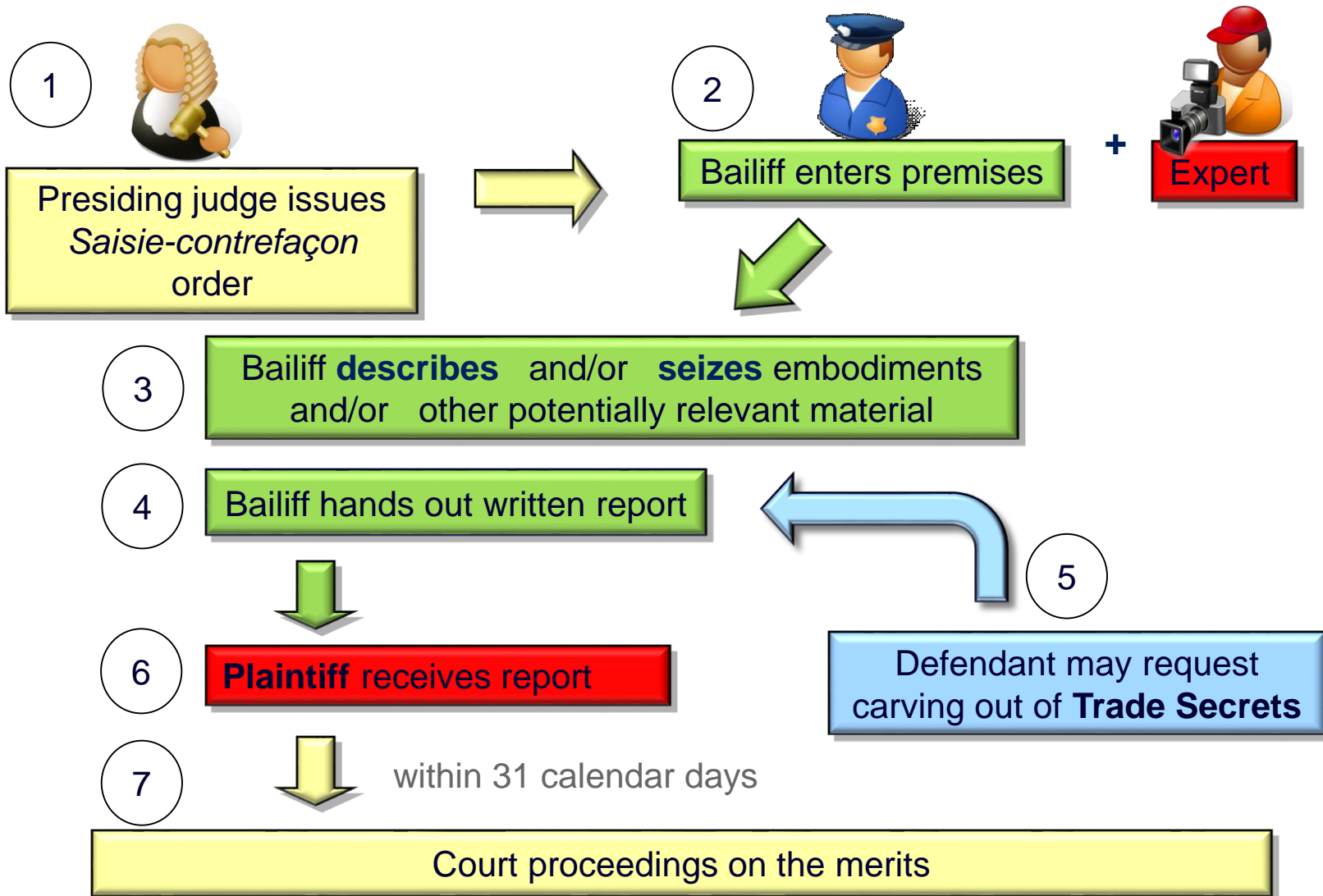
- **Saisie** is part of the French Civil Law since the **19<sup>th</sup> Century**
- Enforcement Directive 2004/48/EC was transposed into the French law on **29 October 2007**
- **Main features** of the *saisie-contrefaçon*:
  - Means for gathering of evidence;
  - Without prior hearing of the opponent (*ex-parte* proceedings);
  - No measure for seizure of stock;
  - No preliminary injunction;
  - Obligation to lodge complaint on the merits.



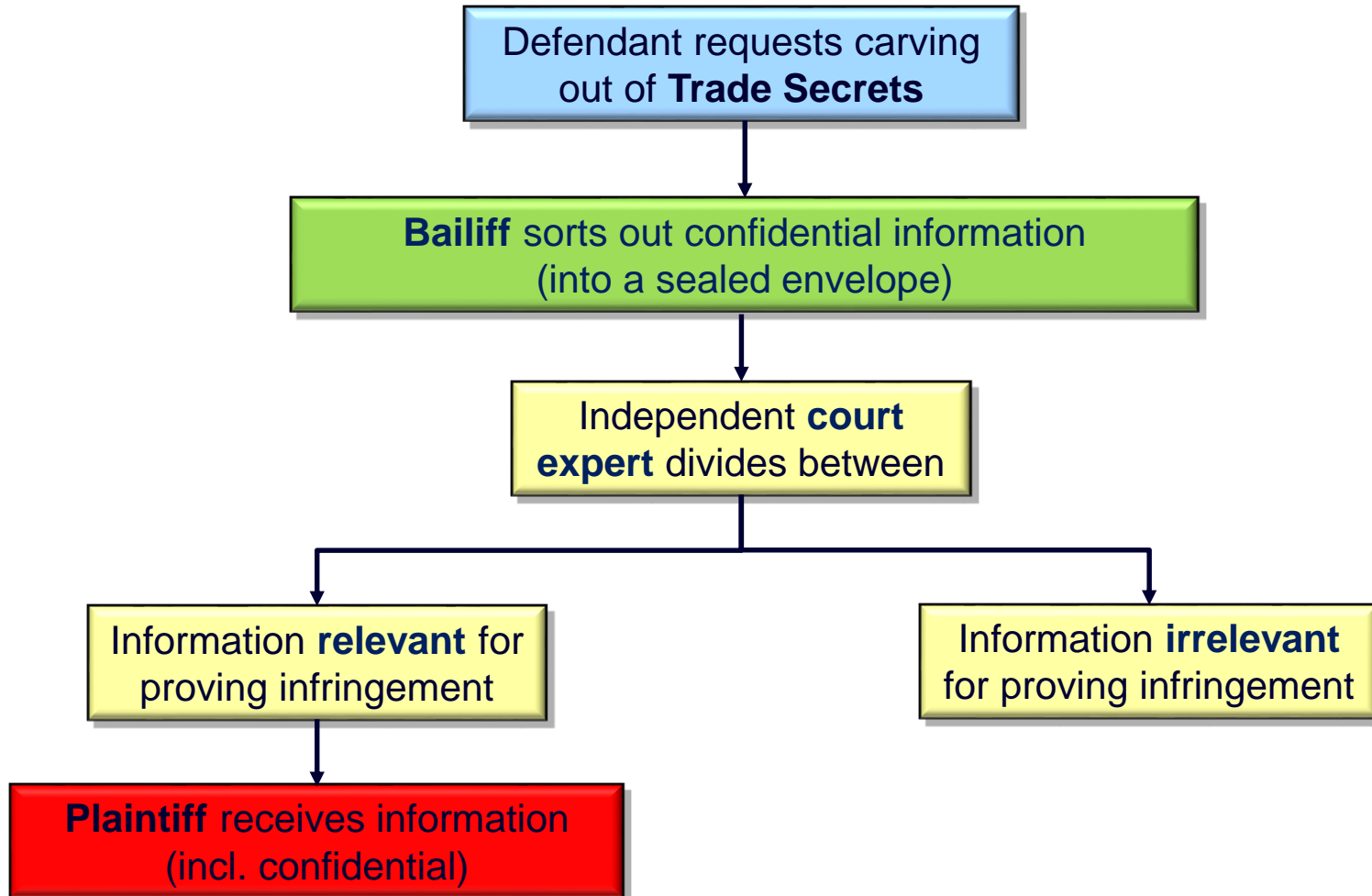
# The Saisie-contrefaçon



# Inspection and Expert Opinion



# Protection of Trade Secrets



## Competences of the Bailiff ('huissier de justice')

- Enter the Defendant's premises;
- describe the allegedly infringing product or process;
- copy any relevant document (drawings, specifications, commercial or administrative or regulatory documents);
- describe the extent of the infringement and seize accounting documents;
- seize samples of the products or means used to manufacture the product;
- seize supporting documents, catalogues, price lists, manuals etc.;
- run the process;
- dismantle the product / machine;
- and other appropriate means.

## Legal Remedies in Saisie-contrefaçon Proceedings

- **Against the ordered *saisie***
  - Challenge the grant or the extend of the order before the Judge who granted it (*'action en rétractation'*).
  - Challenge the validity of the saisie before the court on the merits (*'action en nullité de la saisie'*).
  
- **Against the decision not to order a *saisie***
  - Subject to appeal
  - Defendant will not be informed (*ex-parte* proceedings)

## How Can the Expert Report be Used?

- The report drafted by the bailiff during the saisie-contrefaçon can be used:
  - For one or several French procedures regarding the same IP right (TGI Paris January 18, 2006; CA Paris, November 24, 2000).
  - In parallel foreign proceedings:
    - To show the likelihood of an infringement pursuant to sec. 140c German Patent Act (OLG Karlsruhe, judgment of 16 Oct. 2012 – 6 W 72/12).
    - As documentary evidence.
    - The court expert can be interrogated as a witness.
  - For a unique foreign procedure?
    - despite the absence of case law, it seems possible to start the action on the merits abroad, e.g. if the defendant is based abroad.

## Questions? – Please contact me

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