

Undiscovered “discovery”: Measures available in European civil law systems to obtain evidence in possession of the counterpart

1. Introduction.

One of the things that surprise most U.S. lawyers when dealing with patent litigation in civil law countries for the first time is how difficult it is to obtain evidence in possession of the counterpart. This may be an issue since most European countries require written evidence in possession of the interested party to be provided upfront, at the time of filing the initial lawsuit; only in certain exceptional circumstances can such evidence be provided at a later date. This is substantially different in the U.S., where there is a discovery process, and the evidence, also by written means, can be more flexibly construed and produced during the process.

Even though the approach to evidence is considerably different in both systems, there are many avenues available in most European civil law countries to obtain evidence prior to starting a Court action that are many times often underutilized.

The purpose of this article is not to analyze exhaustively all such solutions, which may differ in each jurisdiction, but, rather, to provide an overall picture of the common ground for obtaining evidence in possession of the counterpart in the E.U. civil law jurisdictions.

2. Origins.

Pre-trial activities aimed at obtaining evidence have their origins in the Roman-Canonical law, in particular, in the *interrogatio in iure* and the *actio ad exhibendum*, which allowed future plaintiffs to ascertain facts relevant to the trial in question. This was obtained pursuant to the interrogation of the other party and the exhibition of documents or items in possession of third parties. These pre-trial activities evolved differently in common and civil law systems. However, they face the same problem and offer solutions which can be closer than one might think.

Contrary to the U.S. discovery process (which can be said to have the heuristic purpose of gathering information to analyze and “discover” if there is something relevant for the litigation), the measures usually available in civil law jurisdictions appear to have more of a confirmatory purpose than an “investigatory” one. However, many times they have been understood in such broad and flexible terms, i.e., that they can be used to obtain information even when they are not only aimed at confirming an already-known fact.

3. Directive 2004/48/EC.

European Directive 2004/48/EC, acknowledging that evidence is an element of paramount importance for establishing the infringement of intellectual property rights, indicated that it was necessary to ensure that effective means of obtaining evidence are available in all European countries.

Article 6 of the Directive sets forth that European “*Member States shall ensure that, on application by a party which has presented reasonably available evidence sufficient to support its claims, and has, in substantiating those claims, specified evidence which lies in the control of the opposing party, the competent judicial authorities may order that such evidence be presented by the opposing party, subject to the protection of confidential information.*”

Article 7 is even more specific in relation to what can be obtained in the case of an infringement committed on a commercial scale. Should this be the case, the Directive specifies that “*Member States shall take such measures as are necessary to enable the competent judicial authorities to order, where appropriate, on application by a party, the communication of banking, financial or commercial documents under the control of the opposing party, subject to the protection of confidential information.*”

The Directive also noted the importance of the right to information, allowing precise information to be obtained on the origin of the infringing goods or services, the distribution channels, and the identity of any third parties involved in the infringement. Consequently, Article 8 of the Directive provides that Member States shall ensure that, in the context of proceedings concerning an infringement of an intellectual property right on a commercial scale, the competent judicial authorities may order that information on the origin and distribution networks of the infringing goods or services be provided by the infringer and/or any other person found in possession of the infringing goods or services (it can also be requested of anyone who is indicated as being involved in the production, manufacturing or distribution of the goods or services). This information shall include the names and addresses of the producers, manufacturers, distributors, suppliers and other previous holders of the goods or services, as well as the intended wholesalers and retailers. The information may include the quantities produced, manufactured, delivered, received or ordered, as well as the price obtained for the goods or services in question.

The Directive provides that these measures shall apply without prejudice to other statutory provisions that grant the right to receive fuller information. Consequently, it does not limit the measures available. However, it is interesting to see that it also indicates that there may be also an opportunity for refusing to provide information which would force the person to admit to his/her own participation or that of his/her close relatives in an infringement of an intellectual property right. We understand that this shows a substantially different approach from that of common law systems, where the obligation to provide information may exist even in such circumstances.

In spite of this, the Directive offers a *de minimis* framework of measures available to rights holders for obtaining information or evidence in possession of third parties which may be relevant for a future action. These measures were subject to required implementation by all European jurisdictions into their national laws.

4. Other measures usually available in national laws.

In addition to the set of minimal measures indicated by Directive 2004/48/EC, the national law of each jurisdiction typically offers additional measures to obtain evidence. For instance, most European countries offer search and seizure (“Anton Piller” type) orders which, in a nutshell, entitle a plaintiff to request the judge to order the entry of the defendant’s premises in order to inspect, remove, make copies of documents, etc. which may be relevant to evidence of a potential infringement. Also, they offer the possibility of anticipatory requests for evidence that would be solicited once the litigation has started, if there is a justified concern that such evidence might later become unavailable. Among the evidence measures that may be anticipated, many jurisdictions permit requesting certain documents and/or information of the party in question.

5. Unified Patent Court.

As we know, the European scenario of patent litigation will change radically once the Unified Patent Court (UPC) is implemented. The UPC will be a court common to the Contracting Member States and thus, part of their judicial system, having exclusive competence with regard to European patents and Unitary Patents (“Unitary Patents” refers to European patents which will be given unitary effect for the territory of the participating states, when this option become available). Consequently, it is worth investigating how the UPC is expected to approach these measures for obtaining evidence in possession of the counterpart or third parties.

The most recent version of the Agreement and the Rules of Procedure for the Unified Patent Court include certain provisions aimed at assisting parties in obtaining evidence before starting litigation, even if it is in possession of the counterpart. Article 67 of the Agreement entitles an applicant to order an infringer to essentially the same information indicated in the Directive 2004/48/EC (origin and distribution channels of the infringing product or process, quantities produced, manufactured, delivered, received or ordered, the price obtained, the identities of any third person involved, etc.). This information can also be requested from third parties involved in infringing activities. It is worth noting that Rule 191 of the current draft of the Rules of Procedure indicated that Article 67 refers to “such other information as is reasonably necessary for the purpose of advancing that party’s case.”

The Unified Patent Court is still in the process of ratification and the Rules of Procedure are yet to come under scrutiny by the European Commission for their compatibility of the Rules of Procedure with Union law. However, they give an idea of the options which will most likely be available to obtain evidence lying in possession of the counterpart, which seem to be quite in line with what is described in the Directive 2004/48/EC.

As can be seen, the options now available in civil law systems provide a broader scope than what has traditionally been considered. It would be unrealistic to pretend that the solutions briefly mentioned in this article achieve the same results that may be obtained through a full discovery. However, in the search for evidence under the control of the defendants, the above measures offer some limited but quite efficient “battering rams” for entering the defendant’s castle. Also, considering the perspective of the Anglo-Saxon lawyer, the costs for the plaintiff may be limited and the delays not significant. Ultimately, this would lead us to urge civil and common law lawyers to work together to consider the options available for the next case!

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