

Enforcing process patents in Europe

When a patentee wishes to enforce its rights, it must first establish that the alleged infringer is in fact commercially exploiting a product or process that falls within the scope of protection. This may sound straightforward, but what if the alleged infringer is using an apparatus or a process in secret? What options are available for patentees to safeguard their rights?

When a process claim is validly granted, the patentee has the right to prohibit others from using the patented process in or for their business. In Europe, the scope of protection for such claims also extends to the use, marketing, reselling, hire or delivery of any product directly obtained from the patented process, in or for a business.

Reversing the burden of proof

Although patent law differs from country to country, most legal systems may reverse the burden of proof when a process claim is the subject of a judicial procedure. In particular, when the product resulting from the process is novel, it will be assumed that all such products have been manufactured using the novel, patented process and are thus infringing (e.g.,

Article 34(1)(a) TRIPs). The alleged infringer will be exonerated only if it can prove that it used a different process.

Also, in some countries the burden of proof may be reversed if an alleged infringer manufactures a product that is identical to the product obtained from the patented process, but the patentee was unable, despite reasonable efforts, to establish whether the process was actually used (e.g., Article 34(1)(a) TRIPs: “if there is a substantial likelihood that the identical product was made by the process and the owner of the patent has been unable, through reasonable effort, to determine the process actually used”). This applies in France and Germany, but does not appear to be the case in other jurisdictions, such as the United Kingdom and the Netherlands.

Obtaining and safeguarding evidence during a pending court case

Article 6 of the EU IP Rights Enforcement Directive (2004/48/EC) stipulates that if a patentee presents sufficient evidence during court proceedings to support its claim that a competitor is infringing its patented process and subsequently specifies evidence in possession of that competitor, then the court may order the competitor (subject to the protection of confidential information) to present the specified evidence. However, implementation of the directive differs slightly between EU Member States.

In the United Kingdom, a court may issue a disclosure order forcing a party to disclose anything that is relevant, such as a process description. Witnesses are subjected to direct

examination and cross-examination, making it difficult for them to deny the court access to the facts.

In Germany, the decision in Restschadestoffentfernung permitted an order for producing evidence in the course of proceedings when the patentee was unable to provide the necessary evidence, but the alleged infringer could easily do so.

In France, the president of a court may order any measure to complete evidence during a case. If evidence is incomplete regarding the possible infringement of a process claim and the product obtained from the process is novel, or it is highly likely that it was obtained using the patented process, then the burden of proof is reversed.

Obtaining and safeguarding evidence before a court case

Before commencing court proceedings and in preliminary injunction proceedings, rules other than Article 6 apply to determine whether and how to acquire information that may be used as evidence.

One measure is given in Article 7 of the directive: before commencing court proceedings on the merits of the case, if a patentee presents reasonably available evidence to support its claim that its (process claim) patent has been infringed or is about to be infringed, the competent authorities may order a prompt provisional measure to preserve the relevant evidence. Such an order may, if necessary, be obtained without hearing the alleged infringer, in *ex parte* proceedings, especially when there is a demonstrable risk that evidence might otherwise be destroyed. However, Article 7 has been implemented differently in different Member States.

In the United Kingdom, a search order is an *ex parte* procedure which permits the bailiff of a patentee to access the alleged infringer's premises for documents and information where the patentee suspects that the alleged infringer may destroy evidence. However, the bailiff is not permitted to disclose this information to the patentee, but must supply it to the court. The court will then decide whether the information is relevant and should be made available. In order for search orders to be granted, the case must be strong and carry a high risk of irreparable damage if no such order were given. Furthermore, such search orders require compelling evidence to establish dishonesty and a real possibility that the evidence may be destroyed. It is therefore quite difficult to obtain a search order in the United Kingdom. Any information obtained by a search order may not, in principle, be used in foreign procedures.

In Germany, an *ex parte*, pre-trial court order can be used to obtain such evidence in a procedure known as *selbständiges Beweisverfahren*. The patentee must file a request with the Düsseldorf Patent Court to issue an order for taking evidence. The requirements as to evidence to support the allegation for this seem lower than in the United Kingdom. The request must nominate an expert competent to investigate the factory. The expert will be treated as a court-appointed, neutral expert and cannot disclose any of the acquired information to the patentee. The court will decide whether to disclose information to the patentee. If it does, the opinion can then be used in subsequent infringement proceedings as evidence.

In the Netherlands, the court can provide an *ex parte* order for a bailiff to preserve evidence by seizing, describing and/or taking samples of it. Although case law is not yet conclusive, it appears that these orders are limited to preserving

evidence and cannot be used for fishing expeditions. The preserved evidence must be secured by the bailiff, who is supported only by an independent expert, and must not be disclosed to the patentee. The seizure and description must include the infringing products and/or process; in addition, it may include details of the alleged infringer's administration so that the scale of any infringement may be established, and suppliers and distributors identified. The order may also be directed to goods possessed by third parties.

France already had the *saisie-descriptive and saisie-contrefaçon* in place. A *saisie* is an authorization given by the court to a patentee to obtain any information that may be relevant to an infringement. To obtain such authorization, the patentee files a request to the court, shows that it owns the patent and that the patent is in force, and indicates what relevant material is likely to be discovered by a *saisie*. The authorization allows a bailiff, together with an expert (usually a patent attorney), to enter the premises of an alleged infringer to search for any relevant information. The patentee may not be present itself. An expert will then select the information that is relevant for establishing infringement. All other material will be returned. Any non-confidential material thus obtained may, in principle, be used in any court procedure, both within and outside France.

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