

TAKING EVIDENCE IN PROCEEDINGS BEFORE THE UPC

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Having a patent does not guarantee that a product or process infringes a patent, and in an infringement case it is very important for each party to provide the court with sufficient and relevant evidence supporting its case.

The law provides certain guidelines to ensure that evidence presented to the court can be regarded as trustworthy. In Europe, the measures available to obtain evidence have varied from jurisdiction to jurisdiction. In 2004, in an effort to harmonise these measures, EU Directive 2004/48/EU on the Enforcement of Intellectual Property Rights came into force. However, there remain significant disparities in evidence-gathering procedures in patent jurisdictions in the EU.

Now, with the signing of the agreement on a Unified Patent Court (UPC) on February 19, 2013 and, at the time of writing, a 16th draft of the Rules of Procedure available, there is the prospect of new approaches to obtaining evidence applicable across all the UPC contracting states.

In disputes before the UPC, the parties can rely on any means of evidence they consider relevant to prove their case. A non-exhaustive list of means of giving or obtaining evidence is provided, and includes written evidence, eg, printed and drawn documents, photographs, expert opinions, statements, physical objects, and audio or video recordings.

The court has a responsibility to evaluate the evidence freely and independently but as the court can make decisions based only on grounds, facts and evidence on which the parties have had an opportunity to present their comments, it is relevant that all evidence is submitted as early as possible.

Proceedings before the UPC consist of a written, an interim and an oral procedure.

The aim of the written procedure is to provide the court with an exhaustive account of the facts, pleas and arguments of the parties, and the forms of order sought. The responsibility of presenting the evidence to prove its case lies with each party. A party contesting an issue presented by the opposing party will have to provide evidence of why the facts presented by the other party are not accurate.

An action for patent infringement will have any prospect of success only if the claimant is able to set out the infringement and prove it, if disputed. The contested product or process must therefore be one that can be presented with all the relevant details needed to prove infringement.

The UPC has provisions that ensure that each party has a duty to produce evidence that relates to contested facts. Even though the UPC has no provisions for providing a general disclosure, the court has the power to order

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the production of specified evidence within the control of the opposing party, or a third party, if a party has first presented reasonably available evidence sufficient to support its claims and has, in substantiating those claims, specified evidence that lies in the control of another party. The court may also order a party to take any step, answer any question or provide any clarification or evidence.

The aim of the interim procedure is to make all necessary preparations for the oral hearing so that it can be concluded effectively, preferably within one day. It is therefore important to identify the main issues, to determine which relevant facts are in dispute and, where appropriate, to clarify the position of the parties.

The judge-rapporteur, who is responsible for the interim procedure, can in principle make any decision or order s/he deems necessary for the preparation of the oral hearing.

The aim of the oral hearing is to give the parties an opportunity to explain their arguments. The UPC does not provide parties with the possibility of presenting additional evidence there.

There seems to be no automatic right to hear a witness or expert in person in the oral proceedings. In addition, a summons must indicate the facts on which the witness is to be examined, and cross-examination is said to be “under the control of the presiding judge” who may “prohibit any question not designed to adduce admissible evidence”. It will be interesting to see how the court handles cross-examination.

It is essential to create uniform practice among the divisions of the UPC and it is therefore relevant to have clear directions in the rules on how to conduct the proceedings. We hope that the UPC agreement and the rules of procedure will provide such directions. ■

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