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SYNOPSIS OF PRESENTATION

This paper is concerned with the initial stages in a patent infringement action: finding evidence of an alleged infringement. The second stage, proving that what is found indeed infringes, is not the direct concern of this paper. But the burden of proof rests with the proposed claimant/plaintiff- so he has got to get it right

What follows is not intended to provide an exhaustive treatment of the subject and will be supplemented during my address.

The onus rests on the Claimant to prove each type of infringement alleged - to the normal civil standard. This includes adequate details of the quality of the act (e.g. making, selling etc) and of its nature (eg time and place of infringement etc). These matters will have to be summarily recorded in the Claim Form and in more detail in the main pleading [Particulars of Claim]

Evidence sufficient to satisfy the requirements of The Rules of Court, Part 63 may be obtained as follows:

Open Purchase

Gathering sufficient evidence to initiate Patent Infringement proceedings is usually not too difficult. Indeed the most common evidence is that of a simple test purchase of a *product* in the open market followed if necessary, by its analysis or by evidence given as to how it works. For pleading purposes the detail is not necessary: that can come when the expert produces his expert's report.. Problems are much more likely to occur if the claims in issue relate to a process, a method of doing something and especially with a product- by-process claim. Having purchased a product in open market, it is perfectly in order for a would-be defendant on being asked to say: prove for yourself that this product was made by an infringing process.

In many pharmaceutical cases the patent holder actually develops a regime of scientific proof to deal with infringements. Thus, in one case in which I was involved at the Bar, the presence of unconverted intermediate, the tell-tale sign of the use of the infringing process, was detected in the final product by means of an NMR spike on the analysis graph,

Trap Order

If the patentee wishes to obtain evidence of infringement without the knowledge of the potential defendant (which may often be necessary to avoid concealment or tampering with products thereafter –or to benefit from sheer surprise) it may be necessary to set up a trap order using arranged or even false identities. There is

nothing illegal as such in so proceeding. A person makes a test purchase under false pretences and provided that the purchase is done fairly, that may be acceptable evidence.

Norwich Pharmacal Procedure.

This procedure¹ is used when a third party (who is usually completely innocent of IP wrongdoing) becomes involved, accidentally or in the course of business, in the wrongdoing (here, patent infringement) of another. This is what happened in the leading case where the innocent party was a Government department –the Customs. Many of these cases are cases of importation.

The patentee goes to court with circumstantial and prima facie evidence of infringement to obtain an order requiring the third party to give the patentee specific evidence relating to the infringement which he alone knows about – such as details of the exporter the importer, the quantity involved and so on.. The patentee will always be asked to pay the costs and expenses of the third party

Search and seizure Order².

This allows the successful applicants' representatives in extreme cases to enter and search the premises (or even the car) of a proposed (or actual) defendant without notice and seize documents, entire filing cabinets and/or allegedly infringing articles considered by those representatives to be relevant to the action –or proposed action. Such an order is extreme in Common Law tradition and is justified on the basis that in its absence, evidence relevant to infringement might be destroyed, modified, disposed of or otherwise put beyond use – and justice will be defeated.. Those seeking such orders bear a heavy responsibility if anything goes wrong. Moreover the execution of the order must be carried out in accordance with established modalities. Defendants' rights tend to be well protected in these circumstances (such as giving him time to get legal advice) and the defendant may raise any irregularities on the first return adte.

Using the Border Agencies: Customs Seizure Council Regulation (EC)1383/2003 Article 13

What happens is this. The right holder informs the Border Agency (BA) of its specific rights – patent, trade mark etc. It gives the BA its contact particulars and any other details it may think relevant.

On suspicion of infringement, the goods are detained in bond by the BA for up to 10 days (extendible) and the contact person is informed. He will be given details of the consignment with the named consignee and his address. Often a sample of the suspect product will be sent to the Representative. Thereafter, the right holder must move quickly. He must initiate proceedings for infringement forthwith and obtain an appropriate court order for the BA to continue detaining the goods – at the expense of the rights holder.

These cases come into my court every week -sometimes dozens of them. In about 90% of the cases the consignee makes no response to the commencement of proceedings; the goods are then removed from BA control and are destroyed by and the expense of the right holder. If on the other hand, the consignee disputes the claim,

¹ Named after a famous case in the House of Lords *Norwich Pharmacal v Customs* [1974] AC 133

² This used to be called an 'Anton Piller' order – again after the name of the first case *Anton Piller v Mfg Process* [1976] 1 All Eng 779.

the parties will come to some agreement about what to do with the goods pending trial.

Rights holders seldom obtain more out of a customs seizure than a load of useless goods and often a bill for costs from the BA – and from the lawyers.. But since it is usual to demand from the infringer the name and address of his supplier, some good may come out of the matter. There is also of course the deterrent value of the procedure.

Product Description

A defendant must provide a product or process description well before trial. This must provide full particulars of the product or process alleged to infringe including if necessary, drawings or other illustration sufficient to enable all issues of infringement to be resolved. The court will prevent the product description being used for collateral purposes and confidentiality orders in respect of these descriptions may be made at the request (and proof) of the party likely to be affected.

Unless a product description is agreed, the party putting it forward will be expected to prove it – usually by expert evidence.

Experiments

It is common in patent infringement actions for parties to perform experiments to prove or disprove infringement. Again, there are rules laid down for the timely and orderly performance of experiments which will be explained.

Preparing for trial

Further particulars of any pleading may be ordered. The claimant must identify which claims are said to be infringed.

Thereafter, the primary evidence of infringement obtained by seizure etc may be ‘perfected’ by procedural means of admissions, disclosure, ordering an accurate product/process description, inspection inter partes etc. Various secrecy/confidentiality protection regimes may be put in place in this connection (‘The Confidentiality Club’).

Provision may also be made for the trial of an infringement issue as a preliminary point.