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Effective Measures for Securing Evidence have been Instituted

Thorsten Bausch (Hoffmann Eitle) · Wednesday, January 26th, 2011

In Germany, prior to the implementation of the “Enforcement Directive” EC/2004/48, measures to secure evidence in patent matters were difficult to realize under the law. With the Implementation Act of 2008, an explicit right to secure evidence was included as part of the IP laws. The number of requests to courts to grant a provisional injunction to secure evidence has thus significantly increased since then, in particular in patent and copyright cases, and there are already a large number of court decisions on various legal aspects of securing evidence in IP matters. According to a few of these, “urgency” is required for the issuance of a provisional injunction, i.e. the applicant must file the request within a certain short period of time subsequent to becoming aware of possible infringing acts.

In its decision of 20 October 2010 (Docket No. 21 O 7563/10), the Regional Court Munich had to decide on whether “urgency” is required for measures for securing evidence and, whether the request for measures for securing evidence must be rejected if the opponent is obliged to preserve the relevant documents, for instance pursuant to pharmaceutical or tax laws. The Court denied both questions and has therefore issued a decision which allows right-holders to effectively secure evidence.

The facts behind this precedent can be quickly summarized: The applicant had quite a few indications that the opponent was manufacturing tablets in Germany using an active ingredient falling under applicant’s patent. These included a paper copy of a manufacturing protocol showing the opponent’s company logo and listed product batch numbers and it also mentioned the active ingredient. This protocol was written in German, in compliance with German law. Further, the opponent only has sites in Germany as its site in China consists merely of office space. It was therefore to be assumed that the opponent produces in Germany. Applicant filed a request for a provisional injunction on 16 April 2010, requesting to secure documents relating to the manufacture of products with said batch numbers in Germany. On 28 April 2010, the Regional Court Munich granted the request for securing evidence and appointed an attorney at law specialized in pharmaceutical law to prepare an expert opinion. On 19 May 2010, the provisional injunction was enforced and evidence proving patent-infringing acts was secured.

The opponent filed an objection against the grant of the provisional injunction, stating that it should not have to bear the costs of the proceedings, since the provisional injunction had been wrongly issued. The opponent asserted that there was no urgency for the issuance of a provisional injunction since the applicant had been aware of the indications for patent infringement for more than 8 months. The opponent further alleged that the applicant could have obtained the relevant

documents in main proceedings and that there was no danger that the documents would disappear since the opponent could not legally destroy the documents under the German Regulation on the Manufacture of Pharmaceutical Products and Active Ingredients and also under the provisions of the German Tax Code. The opponent further asserted that an attorney at law was not competent to become an expert in these proceedings.

The Regional Court in Munich decided on 20 October 2010 that the grant of the provisional injunction had been entirely justified and that the opponent had to bear the costs of the proceedings. The Court confirmed that the applicant had presented enough indications to assume that there was a “sufficient degree of certainty” of the use of the patent on a commercial scale and that proceedings to secure evidence could be applied to secure the pertinent documents. The Court further decided that urgency must be assumed under the law, i.e. no special time limits must be observed by the applicant. The applicant had not lost its right to obtain a provisional injunction because it had waited some time to file the request for a provisional injunction after gaining knowledge of indications of patent infringement. It decided that securing evidence is for the patentee oftentimes the only way to obtain enough information to substantiate claims related to patent infringement. Therefore, courts must “reluctantly” apply the principle of “urgency”. If the Court were to have rejected the request to secure evidence, the patentee could have been precluded from enforcing its right. The right to secure evidence can only be rejected under the consideration of time in exceptional circumstances, e.g. the infringing act might be committed in the far future or the right holder has explicitly declared that it is not interested in pursuing its right speedily. The Court decided that when issuing provisional injunctions regarding the securing of evidence, it is inappropriate to require a strict one-month period within which a provisional injunction may be requested after the infringement has become known.

The decision also held that it cannot be assumed that the provisions of the pharmaceutical or tax laws might prevent an infringer from destroying or hiding evidence. The Court considered that the opponent was committing the patent-infringing acts on a commercial scale and that it therefore had a reason to destroy or hide evidence.

It was further held that an attorney at law who is familiar with documents in the pharmaceutical field can become a court expert to secure evidence.

The decision of the Regional Court Munich must be hailed as it is a decision that quite clearly rejects a requirement of “urgency” to obtain a provisional injunction for securing evidence. It follows in this regard the decision of the Higher Regional Court Duesseldorf of 30 March 2010 (Docket No. I 20 W 32/10, InstGE 12, 105), see post of Thomas Musmann of 21 October 2010. It is also clear in its ruling that legal obligations for preserving documents may not prevent a patent infringer to destroy documents and therefore such provisions are of no relevance when deciding on the grant of provisional measures for securing evidence.

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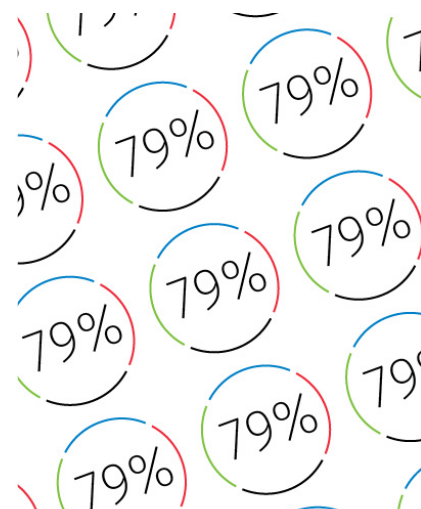
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