

Chapter 7

The Anton Piller Case and Its Legacy: *In Search of a Balance in Civil Search*

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The *Anton Piller* case¹ is certainly a leading case in the enforcement of intellectual property (IP) in the UK. It is also, however, a prominent precedent that has special resonance for many IP practitioners and experts outside the UK who associate permission for an ex parte inspection of an alleged infringer's premises with an Anton Piller order. Although enshrined in English law, *Anton Piller* thus also belongs to the 'passive vocabulary' of many IP lawyers even if in practice they are more aware of the 'saisie-contrefaçon' (France), 'saisie-description' (Belgium), the 'beslag inzake namaak' (Netherlands and Belgium), the 'Düsseldorf Practice' and the recent codification as 'Anspruch auf Vorlage und Besichtigung' (Germany), etc.

As with other cases discussed in the present volume, the Anton Piller decision is a judicial response to 'extraordinary circumstances'.² This 'mother decision' and its relations or heirs in other countries are there to deal with situations in which the normal ways to collect evidence are barred and where a special search is needed to preserve evidence of a possible IP infringement.

1. *Anton Piller KG v. Manufacturing Processes Ltd* [1976] Ch 55 [1976] *Reports of Patent Cases* 719.

2. See the introduction to this book.

This chapter is divided in three parts:

- (1) In the first part, we will present the Anton Piller case. It is not only the facts and the ruling of this case (decided in 1976) which are worth remembering, but also the people who played the main roles in the birth of this new type of order. The early success of the Anton Piller order led to a misuse, which was criticized at the end of the 1980s. We will briefly sum up these criticisms.
- (2) In the second part, we will see how the Anton Piller orders or, rather, the search orders, look today in the UK, since they were given statutory force by section 7 of the Civil Procedure Act 1997 and the 1998 Civil Procedure Rules (CPR).
- (3) The third part is devoted to the legacy of the Anton Piller case outside the UK and will focus on whether it can be held to have served as a model for the 2004/48/EC Enforcement Directive.³ For this purpose, we will review some of the national rules concerning civil search orders throughout the EU.

As an outline for this paper, we will investigate whether the rules and the practice regarding the civil search adequately take into account the need for proportionality in the response to IP infringements. Indeed, the Anton Piller orders have been coined as one of the law's 'two nuclear bombs' (along with the Mareva, or Freezing, Injunctions) by Donaldson, LJ,⁴ and it is important that the use of this rather intrusive legal instrument respects what is imposed by proportionality, a core principle grounded in Community law and in European law on human rights. We, therefore, remain *in search of a balance in civil search*.

1. *ANTON PILLER KG V. MANUFACTURING PROCESSES LTD*

1.1. *WHEN LORD DENNING MEETS HUGH LADDIE QC*

According to Lord Denning (1987),⁵ the development of the Anton Piller order, coupled with the Mareva Injunction, was as 'revolutionary an invention as the Action on the Case was long ago'. Lord Denning was the 'revolutionary' mind behind the Anton Piller order because he drafted, 'in clear "Denning" English',⁶ the key judgment in the Court of Appeal decision in *Anton Piller*. In England, the revolution thus comes from the Bench (not from the street as in less-civilized

3. Directive 2004/48/EC on the Enforcement of Intellectual Property Rights, OJ L 157, 30 Apr. 2004 0045–0086.

4. *Bank Mellat v. Nikpour* [1985] FSR 87 at 92 per Donaldson, LJ.

5. Foreword to the first edition of the book of St Gee and G. Andrews, *Mareva Injunctions & Anton Piller Relief* (Longman, 1987).

6. A. Kelman, 'Seizure of Infringing Copies and Counterfeit Articles: The Anton Piller Order', in *Beslag inzake namaak – La saisie-description – Anton Piller Orders*, ed. F. Gotzen (Story Scientia, 1991), 81.

countries). To create a new order, judges can rely on a Latin maxim: *ubi jus ibi remedium*, or, ‘where there is a right there is a remedy’. If the plaintiff has a right, he must have a remedy if he is injured in the enjoyment of it. This maxim also offers an easy shield to justify the judge’s competence in broadening the law. Judges cannot create new rights from the Bench, only Parliament can. Yet some ‘revolutionary’ judges like Lord Denning believe they are entitled to create new remedies to protect existing rights.⁷ In *Anton Piller*, Denning summarized in plain English the need for thinking ‘outside of the box’ of precedents:

What is the argument on the other side? Only this, that no case has been found in which it has been done before. That argument does not appeal to me in the least. If we never do anything which has not been done before, we shall never get anywhere. The law will stand whilst the rest of the world goes on; and that will be bad for both.

To give birth to the *Anton Piller* order, Lord Denning relied on a prolific ‘midwife’:⁸ Hugh Laddie QC, who has since then deeply influenced the shape of IP law in the UK and beyond, as a judge, and later as a distinguished but opinionated academic, always representing a strong dissenting voice. Sir Hugh Laddie would not hesitate to dissent from what his own creation later became, as he did with the *Anton Piller* orders in a very critical paper.⁹ As Sir Hugh Laddie recently passed away, we will remember him by quoting below some of his most incisive criticisms of the *Anton Piller* orders.

To develop the power to ‘permit’ inspection *ex parte*, Laddie relied on several nineteenth century authorities¹⁰ which allow one to ‘preserve property during litigation’, and on Order 29 Rule 2 of the Rules of the Supreme Court which deals with ‘Detention, preservation, etc. of subject-matter of cause or matter.’

1.2. *ANTON PILLER*: IS IT A SEARCH WARRANT FOR CIVIL CASES?

The opening words of Lord Denning in *Anton Piller* set the scene:

During the last 18 months the judges of the Chancery Division have been making orders of a kind unknown before. They have some resemblance to search warrants (. . .) The judges have been making these orders on *ex parte* applications (. . .) On appeal to us, Mr Laddie appears for the plaintiffs. He has appeared in most of the cases and can claim the credit – or the responsibility – for them (. . .) But at the outset I must state the facts, for it is obvious that such an order can only be justified in the most exceptional circumstances.

7. *Ibid.*, 79.

8. To use the expression of Kelman, *supra* n. 6, 80.

9. H. Laddie & Martin Dockray, ‘Piller Problems’, L.Q.R. 106 (October 1990): 601–620.

10. See *United Company of Merchants of England, Trading to the East Indies v. Kynaston* (1821) 3 Bli. (O.S.) 153 at 163–164 quoted by Kelman, *supra* n. 6, 81.

Denning drew a distinction between the order granted in the Anton Piller case and a search warrant by making it clear that Anton Piller does not authorize the claimant to enter the defendant's premises against the latter's will. In the words of Denning: the order:

does not authorize the plaintiff's solicitors or anyone else to enter the defendants' premises against their will. It does not authorize the breaking down of any doors, nor the slipping in by a back door, nor getting in by an open door or window. . . . The plaintiffs must get the defendants' permission. But it does do this: It brings pressure on the defendants to give permission. It does more. It actually orders them to give permission – with, I suppose, the result that if they do not give permission, they are guilty of contempt of court.

The defendant might thus feel compelled to permit entry due to the consequences of refusal: he might be found guilty of contempt of court or adverse inferences may be drawn against him at the subsequent trial. Nonetheless, consent is a prerequisite to entry and inspection.

1.3. WHAT ARE THE EXCEPTIONAL CIRCUMSTANCES PARTICULAR TO THE *ANTON PILLER* CASE?

The defendants in the case, Manufacturing Processes Ltd and its directors (MP), were the UK agents for the German company Anton Piller KG (Piller), which manufactured frequency converters for computers. Piller had been reliably informed by employees of MP that MP had been disclosing Piller's confidential information to Piller's competitors in the German market in order to facilitate competitors making a prototype with exactly the same features as the Piller product. Piller was in possession of written documentation which stated that MP was in communication with the German competitors to arrange an inspection of Piller's products. Piller was poised to produce a new product and therefore wanted to prevent the disposal of documents by MP and consequently applied for an order for permission to enter MP's premises to inspect all such documents and to remove them.

The Court of Appeal granted the interim order pending trial based on the following preconditions: (i) an extremely strong *prima facie* case was established; (ii) there was very serious actual and potential damage to the applicant; and (iii) there was clear evidence that the defendants possessed vital material which they might destroy before an application *inter partes* could be made. In granting the order the Court made it clear that such orders would *be rarely made, and only where there is no alternative way of ensuring that justice is done to the applicant*.

Thus, such orders are to be used when there is a high probability that incriminating evidence may be destroyed and honest discovery is likely to be unsuccessful.

1.4. *ANTON PILLER ORDERS: DISQUIET ABOUT THEIR SUCCESS*

The ex parte inspection which can result from an Anton Piller order is susceptible to being used in an oppressive way. Such misuse was already predicted by J. Brightman who, at first instance in *Anton Piller*, granted an injunction, but refused to order the inspection:

Otherwise, it seems to me that an order on the lines sought might become an instrument of oppression, particularly in a case where a plaintiff of big standing and deep pocket is ranged against a small man who is alleged on the evidence of one side only to have infringed the plaintiffs' rights.

The success of the Anton Piller order was rapid. In the words of Hugh Laddie and Martin Dockray, it *entered the procedural lexicon of common law jurisdiction throughout the world*.¹¹ At the same time, the risks associated with this procedure became apparent from a number of cases. For instance, in *Helliwell v. Piggott-Sims* (1980), the British Phonographic Industry kept the tapes seized at the defendant's premises, a man who was 'into rock and roll' (not a near-criminal), even though BPI was ordered to return the tapes. Another issue associated with Anton Piller orders is the ancillary order forcing the defendants to disclose the names and addresses of all the persons who had supplied them with material.

In a case involving an alleged infringement of copyrights on films, *Rank Film Distribution v. Video Information Centre*,¹² an Anton Piller order had been granted but the defendant argued that by disclosing the documents and answering the interrogatories, he might expose himself to criminal proceedings.¹³ Somewhat reluctantly, the House of Lords held that the defendant could rely on the privilege against self-incrimination (in a criminal case) but Lord Russell of Killowen also advocated the removal of the privilege. This happened with the adoption of section 72 of the Supreme Court Act. As nicely put by A. Kelman, the near fatal illness caused by this privilege was thus promptly cured by the medicine of statute.

Still other criticisms remained. In a quite strong statement, Hugh Laddie and Martin Dockray compared the Anton Piller order with torture:

Like torture, Piller orders have attractions for those who prefer to obtain their evidence with the minimum of effort. Unlike torture, there are some circumstances in which Piller orders are justified. But those circumstances are limited.

Piller orders are offensive weapons which are able to harm:

Service of an ex parte order coupled with a demand for immediate entry into premises is likely to produce strong emotional reactions; shock, anger, confusion, a sense of violation and powerlessness are common recollections [. . .] The execution of an order may cause severe, sometimes irreparable, physical

11. H. Laddie & M. Dockray, *supra* n. 9.

12. *Rank Film Distribution v. Video Information Centre* [1982] AC 380.

13. We follow here Kelman, *supra* n. 6, 85.

disruption to a defendant's business or daily life: the process might take hours to complete. Files may be ransacked, trade disrupted and staff frightened and demoralised.¹⁴

Other particular issues associated with an Anton Piller order¹⁵ include the fact that there is no check of necessity (the judge does not check whether there is an alternative way to do justice) and that the orders are executed by the claimant's solicitor, who might be tempted to exert some pressure on the defendant. This makes the original Anton Piller orders different from the civil search available in some civil-law countries where the search is conducted by, and under the authority of, a third party, the bailiff (see below under section 3).

2. THE ANTON PILLER ORDERS TODAY: THE SEARCH ORDERS IN THE UK

In the late 1990s the Woolf reforms sought to improve the civil justice system in the UK through the introduction of the 1998 Civil Procedure Rules (CPR). Section 7 of Chapter 12 of the Civil Procedure Act 1997, which created the CPR and their accompanying Practice Directions, placed Anton Piller orders on a statutory basis. Despite being officially named 'search orders', these statutory orders are still widely known as Anton Piller orders.

A search order is made to preserve evidence and permits the applicant to enter premises and carry out a search for, or inspection of, anything described in the order. The applicant can seize evidence by retaining for safe keeping anything described in the order or, alternatively, making or obtaining a copy, photograph, sample or other record of the same. The requirements for granting a search order mirror the essential preconditions laid down by L.J. Ormrod in the Anton Piller case, namely that:

- the claimant has an extremely strong prima facie case on the merits;
- the defendant's activities cause very serious potential or actual harm to the claimant's interests;
- there is clear evidence that incriminating documents or items are in the defendant's possession; and
- there is clear evidence that there is a real possibility that such material may be destroyed before an application on notice can be made.

2.1. PROCEDURE FOR APPLICATION

In order to ensure its effectiveness, an application for a search order is undertaken on an ex parte basis without notice being given to the defendant. This necessitates a

14. Laddie & Dockray, *supra* n. 9.

15. See also S. Hall, 'Anton Piller Orders: A Doorstep Too Far', EIPR (1995): 50–53.

high standard of evidence being provided by the applicant in support of the application and an affidavit must be submitted to the court, as opposed to a simple witness statement. A search order application must be accompanied by a standard form search order, a template for which can be found in CPR Practice Direction 25. An ex parte hearing will then determine whether the order should be granted. If granted, the order is valid with immediate effect from its date of signature by the hearing judge, until the date the case is set to return to court. The return date is usually set for about a week after the initial ex parte hearing and, where possible, it will be before the same judge.

2.2. BUILT-IN SAFEGUARDS TO AVOID MISUSE
AND PROTECT THE DEFENDANT

Guidelines have developed through case law and have been translated into statutory provisions that address the criticisms of the early 1990s by requiring today's post-CPR search order applicants to include certain undertakings in the search order and to observe safeguards in their execution of the order.

The case of *Universal Thermosensors Ltd v. Hibben*,¹⁶ involving the faulty execution of an order that was served at 7.15 a.m. on a woman who was alone in the house with a child, laid down guidelines designed to safeguard the defendant during the execution of the order. These include the following:

- (i) the order should be served, and its execution supervised, by a solicitor other than a member of the firm of solicitors acting for the plaintiff (claimant or applicant) in the action, and he or she should be an experienced solicitor having some familiarity with the working of such orders. A list of supervising solicitors is kept updated by the law society. The solicitor should prepare a written report concerning the execution of the order and this should be served on the defendant and presented at an *inter partes* hearing in the days following the execution of the order;
- (ii) orders should only be executed in working hours, that is 9.30 a.m. to 5.30 p.m. Monday to Friday, when a solicitor can be expected to be available to allow the defendant to obtain legal advice prior to complying with the order;
- (iii) if an order is to be executed in a private house, and it is likely that a woman may be alone in the house then the supervising solicitor serving the order must be accompanied by a woman;
- (iv) a detailed list of items being removed from the premises should be prepared prior to their removal and the defendant should be given an opportunity to check the list at this time; and

16. *Universal Thermosensors Ltd v. Hibben* [1992] 1 WLR 840.

- (v) unless there is good reason for doing otherwise, an order should not be executed at business premises unless a responsible officer or representative of the company or trader in question is present.

An order is also required to include undertakings for the applicant to compensate the defendant and third parties for any loss they may suffer as a result of the order. Aggravated and exemplary damages may become due if the order is exercised in an excessive or oppressive way. The defendant's business and property are also protected, as the applicant undertakes not to inform any third party of the proceedings until the return date and to insure any items removed from the defendant's premises. In order to prevent applicants from going on what might be called a 'fishing expedition', an applicant also undertakes to use only the items seized for the purposes of the claim, unless the court grants express permission for them to be used in other proceedings and the defendant is extended a privilege against self-incrimination.

Despite responding to criticisms voiced concerning the potential misuse of Anton Piller orders, these safeguards substantially increased the cost of executing Anton Piller orders, sparking fresh criticisms and perhaps ultimately leading to their neglect by UK practitioners.

2.3. IS THE DEFENDANT FORCED TO COMPLY WITH THE ORDER?

When served with an order, a defendant essentially has three options. The defendant can elect to seek legal advice and is given a reasonable period of time in which to do so. Nonetheless, advice should be sought as soon as the order is received. Depending on the advice received, the defendant then has to choose between the two remaining options – to allow the search, or to refuse entry. The supervising solicitor is obliged to clearly explain the terms and effect of the order in everyday language and must inform the defendant that legal advice may be sought before entry is permitted and of the defendant's right to vary or discharge the order.

Where the defendant chooses to allow the search, he should be mindful that only the items listed in the order can be inspected or removed and that he should be given the opportunity to check this list. Should the defendant choose to refuse entry, he should take into consideration the risks. First and foremost, by refusing to comply with a search order the defendant may be held in contempt of court. In addition, this may lead to adverse inferences being drawn against the defendant in the subsequent trial. The defendant can apply to discharge or vary the order if one or more of the basic conditions are not satisfied. The usual ground relied upon to vary an order is that the order has been drawn too widely. On challenging the order the defendant will be required to give an undertaking not to remove or destroy any items covered by the order whilst the counter-application is being made.

Changes to the UK law have made Anton Piller orders less attractive to modern practitioners. Strangely, their counter-parts in Continental Europe, and in particular the ‘saisie-contrefaçon’ in France and Belgium, have been widely used over the last two decades to get the right evidence in IP cases. The success of the saisie-contrefaçon might have prompted its incorporation in the civil enforcement measures listed in the 2004 European Enforcement Directive (the 2004 Directive).

3. TOWARDS A GLOBAL RECOGNITION OF CIVIL
SEARCH OR ANTON PILLER ORDER IN EUROPE
AND BEYOND?

Before analysing the European rules on civil search, a quick reference to the international framework makes sense.

3.1. ARTICLE 50 OF THE TRIPS AGREEMENT DEFINES
THE MINIMUM AT INTERNATIONAL LEVEL

The WTO’s 1986–1994 Uruguay Round saw the negotiation of Article 50 of the Agreement on Trade-Related Aspects of IP Rights (TRIPs), which deals with provisional measures. The article permits provisional measures to be adopted on an ex parte basis to preserve relevant evidence in regard to an alleged infringement, where appropriate. This includes, in particular, situations in which any delay is likely to cause irreparable harm to the right holder, or where there is a demonstrable risk of evidence being destroyed. Where provisional measures are adopted on an ex parte basis, the parties affected must be given notice without delay, after the execution of the measures at the latest. The defendant can thereafter request a review, including a right to be heard, to establish whether the measures should be modified, revoked or confirmed. As shown below, those requirements are reflected in the European framework for the measures aiming at preserving the evidence, and should also be in place in other countries that have joined the WTO.

Before the adoption of the 2004 Directive, the question arose in Europe as to whether individuals could directly rely on Article 50 of TRIPs. Despite clarifying its competence to interpret Article 50 of TRIPs, the European Court of Justice (ECJ) did not rule on the agreement’s direct applicability in the *Hermès* case.¹⁷ This was discussed in the later *Dior* case, where the ECJ ruled that Article 50 of TRIPs is not directly applicable.¹⁸ It did, however, set out a requirement for Member States to apply national rules as far as possible in light of the wording of Article 50 of TRIPs when ordering provisional measures for the protection of

17. ECJ, Case C-53/96, *Hermès International v. FHT Marketing Choice BV*, 16 Jun. 1998.

18. ECJ, Joined Cases C-300/98 and C-392/98, *Parfums Christian Dior SA v. Tuk Consultancy BV and Others*, 14 Dec. 2000.

IP rights. Consequently, Member States may or may not elect to allow individuals to rely directly on Article 50 of TRIPs. Since then, the situation has changed within the European Union as EU nationals can directly rely on the Article 7 of the 2004 Directive. A review of the legislative process that resulted in the adoption of this provision is needed in order to assess whether Article 7 indeed is a true offspring of the UK Anton Piller order.

3.2. THE LEGISLATIVE PROCESS LEADING TO ARTICLE 7
OF THE 2004 ENFORCEMENT DIRECTIVE: SOME EVIDENCE
OF THE LEGACY OF ANTON PILLER

In October 1998, the European Commission published a Green Paper entitled ‘Combating Counterfeiting and Piracy in the Single Market’.¹⁹ This paper started the process of addressing the shortfalls in the ability of EU Customs legislation and TRIPs to comprehensively address the growing global phenomenon of counterfeiting and piracy. It sought specifically to review existing legislation, identify problems and proffer solutions where necessary. Among the proffered solutions were sanctions and other enforcement methods. The information-gathering element of the paper focused specifically on two questions in this area: whether and what measures are needed to supplement the TRIPs provisions; and whether national measures exist that could be extended to the Community. In relation to the latter, the questions posed in the paper explicitly mentioned the possibility for a right holder to obtain a pre-trial order for the seizure of goods, as is provided for in French law (*saisie-contrefaçon*) or in English law (Anton Piller order).²⁰

Many of the industry responses to the Commission’s consultation highlighted the high cost and complexity of obtaining an Anton Piller order and the consequent negative effect on its utility. Some explicitly highlighted the distinction between the order’s effectiveness at its conception and the resulting cumbersome and expensive procedure, which later rendered the order inefficient. A response prepared by the software industry estimates that due to the complex paperwork, affidavits, court time and the requirement for an independent solicitor, the cost of a search at a commercial company could typically lie between GBP 30,000 and GBP 50,000 (and this was back in 1998). The same report, on the other hand, credits the French ex parte search order with being the most effective in Europe due to the liberal approach of the French courts in granting such orders and the lower threshold for evidentiary requirements. This praise for the *saisie-contrefaçon* procedure was also reflected in other responses from industry.²¹

19. COM(98)569, 15 Oct. 1998.

20. COM(98)569, 15 Oct. 1998, 21: *do you think that [...] the possibility for the rightholder to obtain on request, before bringing an action on the substance of the matter, an order for the seizure of goods, as is provided for in French law (saisie-contrefaçon) or in English law (Anton Piller order), are measures which should be applied in every Member State?*

21. For example, see the response prepared by the International Federation of the Phonographic Industry (IFPI), January 1999, unpublished submission.

In its follow-up Communication, the Commission reported that stakeholders generally complained about the diversity and inadequacy of national measures for collecting evidence and undertook to propose a Directive to provide for approximated civil measures and procedures for search and seizure.²² This proposal was finally adopted in 2003.²³ The proposal references the criticisms in relation to the Anton Piller order and recognizes that the Doorstep order, a simplified form of the Anton Piller order, is deemed to be effective.²⁴ The Doorstep order, recognized in *Universal City Studios*,²⁵ provides for requests for documents and objects to be presented without the right to enter premises. Hugh Laddie, then QC, appeared for the claimants in this case and distinguished the case from *Anton Piller* by the absence of a demonstration of bad faith on the part of the defendant. In *Anton Piller* it was clear that the defendants were acting in bad faith, whereas in *Universal City Studios* bad faith on the part of the defendant had not been proven and could not be assumed, therefore a less stringent order was requested and granted. Despite being praised for being effective and less draconian, the Doorstep order, of course, carries with it the risk that the defendant destroys the material subject to the order whilst the applicant is on the doorstep.

The relevant provisions in the Commission's proposal are cited to be modelled on the Anton Piller order, the Doorstep order, the *saisie-contrefaçon* and Article 50(7) of TRIPs. Once the 2004 Directive was adopted the EU Member States had to take steps to implement it into national law. In the UK, a consultation was launched in 2005 to gather suggestions and comments on the proposed implementation.²⁶ This consultation sets out each of the provisions in the proposed Directive and the action that needs to be taken to implement the proposed provision into UK law. The conclusion in relation to Article 7 of Directive is 'no action required'. This is clearly indicative of the fact that Article 7 mirrors the UK provisions put in place by virtue of section 7 of the Civil Procedure Act 1997 and the CPR. The same appears true in France where the rules on the '*saisie-contrefaçon*' were only marginally changed when the French law Nr 2007-1544 of 29 October 2007 transposing the Enforcement Directive was adopted.

3.3. OBJECTIVES AND BUILDING BLOCKS OF ARTICLE 7 OF THE 2004 ENFORCEMENT DIRECTIVE

The objectives of the 2004 Directive proceed from two *raisons d'être*: (1) combating counterfeiting and piracy; and (2) harmonizing national legislation on civil remedies for IP infringement. The Commission had presented the latter as an

22. COM(2000) 789, 30 Nov. 2000, 14, 15, 21, 35 and 36.

23. COM(2003) 46 final, 30 Jan. 2003.

24. COM(2003) 46 final, 30 Jan. 2003, at 14.

25. *Universal City Studios Inc. v. Mukhtar & Sons* [1976] F.S.R. 252.

26. The Patent Office, Consultation Paper, The UK implementation of the Directive on the enforcement of intellectual property rights (2004/48/EC), undated, at Annex B.

ostensible means of tackling the former.²⁷ In fact, behind the rhetoric surrounding the fight against counterfeiting and piracy, the 2004 Directive aims mainly to reduce of 'the still major disparities' between the Member States 'as regards the means of enforcing intellectual property rights'.²⁸ This applies in particular to civil search: according to Recital 7 of the 2004 Directive, 'the arrangements for applying provisional measures, which are used in particular to preserve evidence, [...] vary widely from one Member State to another'. This statement was only partially true: As indicated, no great difference existed between the measures available in the UK and France, which both served as a model for Article 7, but a significant divergence remained with other Member States, in particular Germany.

As other provisions of the Directive, Article 7, entitled 'Measures for preserving evidence' applies equally to all IP rights. Article 7(1) states that:

judicial authorities may [...] order prompt and effective provisional measures to preserve relevant evidence', including a 'detailed description with or without the taking of samples, or the physical seizure of the infringing goods.

Description and physical seizure are both governed by a single regime under the Directive. Because physical seizure is a more far-reaching measure than description, it may be argued that it should have a stricter scope subject to more stringent conditions. Some Member States (e.g., Belgium) impose more restrictive conditions for the execution of a seizure than for the description of the allegedly infringing goods. Indeed, the physical seizure can in practice have a 'blocking effect' quite similar to an injunctive order, and it is therefore justified to apply a higher threshold requirement for granting this measure. The subject of these measures is not limited to allegedly infringing goods. Where appropriate, the subject of these measures also includes 'materials and implements used in the production and/or distribution of these goods and the documents relating thereto'.

If necessary, 'in particular where any delay is likely to cause irreparable harm to the right holder or where there is a demonstrable risk of evidence being destroyed', measures can be taken on an ex parte basis. The use of the expression 'in particular' indicates that Member States are entitled to provide for other cases where the prior hearing of the defendant is not required. However an ex parte procedure will require notice to be given to the parties affected 'without delay after the execution of the measures *at the latest*'. This implies that Member States might provide that the notice shall be given before the measures are conducted, thus depriving the search and inspection of most of its 'surprise effect'. Thereafter, within a reasonable period after the notification, the affected parties may then request a review with a hearing 'with a view to deciding [...] whether the measures shall be modified, revoked or confirmed'. The measures may be authorized in any place within the court's jurisdiction (on and off business premises in buildings, cars, etc.).

27. See the Explanatory Memorandum to the Draft Enforcement Directive, COM(2003) 46 final at 3.

28. Recital 7 of the 2004 Enforcement Directive.

Article 7(3) requires the applicant, within a reasonable period of time, to institute proceedings leading to a decision on the merits. This period is determinable by the judicial authority ordering the measures or, in the absence of a determination, shall be deemed to be ‘a period not exceeding twenty working days or thirty-one calendar days, whichever is the longer’. If the applicant does not institute proceedings within the required period of time it is the Member States’ responsibility to ensure that measures to preserve evidence are revoked or otherwise cease to have effect. Where measures are so revoked or lapse or, alternatively, where it has been found that there has been no infringement or threat of infringement the defendant should be appropriately compensated for any injury caused by the measures under Article 7(4). Article 7(2) requires the applicant to lodge adequate security or an equivalent insurance to ensure this compensation. Finally, Article 7(5) requires Member States to take measures to protect witnesses’ identities.

The framework for civil search delineated by Article 7 of the 2004 Enforcement Directive appears balanced, as it incorporates several safeguards: the requesting party must present ‘reasonably available evidence to support his claims that his intellectual property right has been infringed or is about to be infringed’; the civil search is subject to the protection of confidential information; the *ex parte* aspect can be justified if it is ‘necessary’; a notice must be sent to the *inaudita altera parte* ‘without delay after the execution of the measures’; etc. The unbalance, or the Devil, as always in legal matters, remains in the details of the civil search procedure, as implemented in national law, or even in the practical application of those rules.

3.4. SOME UNRESOLVED ISSUES AND OPEN QUESTIONS IN RELATION TO THE IMPLEMENTATION OF ARTICLE 7 OF THE 2004 ENFORCEMENT DIRECTIVE

3.4.1. Protection of Confidential Information

Although the Directive mentions the need to protect confidential information (Article 7(1)), it does not put in place any further rules to ensure the civil search is not (mis)used to obtain useful information from a competitor. In relation thereto, it is worth stressing that Article 7 does not enumerate the people who are entitled to conduct the description of the seizure and the people who are allowed to attend the inspection of the defendant’s premises. This is important in practice: to allow the presence of an employee of the applicant might, for instance, increase the risks of a breach of confidentiality. It is up to Member States to further rule on this issue.

3.4.2. Persons Participating to the Search

The protection of the defendant’s interest also depends on the person who is conducting the civil search. This again is left to the Member States, and there are some notable differences between the jurisdictions.

In the original *Anton Piller* orders, the solicitor of the claimant was implicitly allowed to conduct the search and inspection. True, solicitors are bound by strict professional rules, but they might nevertheless be tempted to put the interests of their clients above the requirements of justice and the right of defence. This was corrected when the *Anton Piller* was codified – it is now an independent solicitor (the supervising solicitor) appointed by the court who must perform the search. As well as the supervising solicitor, the applicant's solicitors, as well as non-lawyers such as computer experts or translators, can be allowed to participate to the execution of the order, but the applicant is not allowed to accompany his solicitor.

In France, the civil search must be performed by a bailiff ('huissier de justice'), that is a public officer who is, in principle, independent from the parties involved. In practice, however, other persons are present when the search and inspection is performed. In patent cases, for instance, an expert (often the applicant's patent agent), an accountant or a photographer will usually help the bailiff to describe the infringing product (or process) and to find the relevant data. A police officer is also often present to prevent any opposition to the performance of the search, in particular in cases involving piracy. The same rules more or less apply to the 'saisie-description' in Belgium (as provided for in Article 1369*bis*/1 onwards of the Judicial Code).

3.4.3. Persons Granting the Civil Order

According to the terms of Article 7(1) of the Directive, 'the competent judicial authorities' may order the provisional measure to preserve evidence. In the UK, France (for industrial property rights) or Belgium, a judge is competent to grant such an order. There is however a notable exception that remains in France, even after the implementation of the 2004 Enforcement Directive – in the civil search in the field of copyright and related rights, the police authority ('commissaires de police'), at the request of right holders, are allowed to seize the infringing copies (Article L. 332-1 of the Intellectual Property Code). In France, the rules on civil search are thus not completely harmonized between the various IP rights and copyright remains a strange exception which at first sight raises some issue of compatibility with the European framework.²⁹

3.4.4. The Evidence Needed to Obtain a Civil Search

To obtain a search order, the Directive requires that the requesting party present 'reasonably available evidence to support his claims that his intellectual property right has been infringed or is about to be infringed' (Article 7(1)). Although this language is not very precise about what kind of evidence must be shown, the requirements for obtaining an *Anton Piller* order in the UK are in line with this condition (and arguably are even more demanding than the threshold set by the

29. In the present broad review of *Anton Piller* and its legacy, we have not had the opportunity to explore the various issues linked to the implementation of the European framework.

Directive) – the applicant must have an extremely strong *prima facie* case, he must show a serious potential or actual damage to its interests and provide clear evidence that the incriminating items are at the defendants' premises and could be removed if an *inter partes* application is made.

Such preliminary evidence is, in principle, not required to obtain a measure to preserve evidence in France, and the Directive thus appears more stringent than the French law on the 'saisie-contrefaçon'.³⁰ According to some commentators who in turn rely on some preparatory documents,³¹ the French law, in force before the implementation of the Directive, remains applicable because it is more favourable to the right owners.³² If this is further confirmed by the court decisions on the conditions for granting this civil search,³³ then the French 'saisie-contrefaçon' differs significantly from similar mechanisms available in other countries, and in a sense, Article 7 of the 2004 Directive is not in line with the French model (and vice versa).

3.4.5. The Possibility to Modulate the Evidence Threshold for the Description and for the Physical Seizure

It is worth mentioning that under the new Belgian rules, as incorporated in Article 1369*bis*/1 onwards of the Judicial Code, a different threshold is imposed to grant the more far-reaching measure, that is, the physical seizure: for the description, the right holder has only to establish (i) the *prima facie* validity of the IP right involved; and (ii) the indices from which it appears that an infringement has taken place or risks to take place; for the physical seizure, not only must (i) the *prima facie* validity of the title be proven, but also that; (ii) 'the infringement of the intellectual property right involved cannot reasonably be contested'; and (iii) that, 'after a balancing of the interests at stake, including the public interest, the facts and, possibly, the evidence on which the claimant relies are likely to reasonably justify the seizure whose purpose is to protect the claimed right' (compare Article 1369*bis*/1, § 5 to Article 1368*bis*/1, § 3 of the Judicial Code). More caution

30. See Lakets-Josse on the 2004/48 Enforcement Directive in Concise International and European IP Law – P. Véron & Th. Cottier (eds), *TRIPS, Paris Convention, European Enforcement and Transfer of Technology* (Kluwer, 2008), 471. See also J.-Chr. Galloux, *Les mesures probatoires, provisoires et conservatoires* (Recueil Dalloz, 2008), 711.

31. Including a document from the legal service of the EC Council confirming that an approach more favourable to the right holder was compatible with the 2004 Directive.

32. Galloux, *supra* n. 30, text accompanying fn. 43 and 44.

33. Further prudence is needed here as some recent French decisions (applying the law in effect before the implementation of the 2004 Directive) appear to impose a slightly higher evidence threshold, at least for patent cases where the transfer of the patent title is for instance to be demonstrated for the granting of the search order (see French Supreme Court, 29 Jan. 2008, n° 07-14709; Com.com. électr., March 2008, note C. Caron and the commentary of M. Abello, *Requêtes aux fins de saisie-contrefaçon: le requérant doit justifier de ses droits!*, *Propriétés intellectuelles*, July 2008, Nr 28, 276).

is thus required from the judge in the case of a request for a physical seizure³⁴ which also explains why the judge, before ordering the seizure, can also request the defendant to appear (In such circumstances, the judge must first warn the requesting party, who can then decide to modify the request and drop the claim for a seizure so as to allow the surprise effect linked to the *ex parte* aspect of the procedure.). Modulation of the standard for the seizure and for the description can ensure that the right balance between the different interests is struck.

4. CONCLUSION: FROM *ANTON PILLER* TO THE MODERN
CIVIL SEARCH IN EUROPE, *IN SEARCH OF THE
BALANCE OF CIVIL SEARCH*

Is the order granted in *Anton Piller*, later redesigned by statute in the UK, and further recognized in other countries, a balanced mechanism to ensure the preservation of evidence in IP cases? The response is yes, although this positive statement must be qualified by the usual ‘it depends’ of which lawyers are fond. The response must consider the varying modalities of the search order. It thus depends on those modalities (and in particular on the persons allowed to grant the order or to participate in the search, on the evidence threshold for obtaining such order, etc.; see above). It also depends on the intended use of this means for enforcing IP rights: if it is used to impose illegitimate pressure on a defendant who runs an honest business, it can go too far; however, against malevolent repeat infringers, the various conditions imposed following the codification of the civil search in the UK can make the procedure somewhat cumbersome and expensive, thus prompting the right holders to rely more on the searches that the police can perform in the framework of a criminal investigation. It also depends on the type of right and proceeding involved. For those involved in patent infringement proceedings between honest businesses, the civil search as it is available in certain countries might be overreaching, at least in relation to the seizure aspect that is able to seriously disrupt the operations of the defendant. For those focused on fighting the growing problem of piracy, in particular of copyrighted and trademarked items but also counterfeit medicines, the civil search might not offer the effective and low-cost tool necessary. Again, the whole balancing issue is due to the fact that the same measures are applicable to the (unintentional) infringements resulting from the normal behaviour between competitors and to the intentional violations of IP by malevolent counterfeiters. Nobody has ever been able to trace a clear line between these two situations, and more or less the same instruments are applicable to both, thus raising opposite, yet equally justified, concerns that the measures ‘go too far’ or that ‘they are ineffective and unaffordable’.

34. F. de Visscher & P. Bruwier, *Preuve des atteintes aux droits de propriété intellectuelle: impact de la transposition en droit belge de la Directive 2004/48/CE relative au respect des droits de propriété intellectuelle*, in *Nouveautés en matière d’expertise et de propriété intellectuelle*, ed. P. Jadoul & A. Strowel (Larcier, 2007), 107–108.