



A I P P I

**ASSOCIATION INTERNATIONALE
POUR LA PROTECTION DE LA PROPRIETE INTELLECTUELLE**

**INTERNATIONAL ASSOCIATION
FOR THE PROTECTION OF INTELLECTUAL PROPERTY**

**INTERNATIONALE VEREINIGUNG
FÜR DEN SCHUTZ DES GEISTIGEN EIGENTUMS**

ExCo

Berlin, Germany

September 24 to 29, 2005

Report

Special Committee Q185

**Enforcement of Intellectual Property Rights
Exercice des droits de Propriété Intellectuelle
Durchsetzung von Rechten des Geistigen Eigentums**

Report Q185

Enforcement of Intellectual Property Rights

by Alexander HARGUTH (Germany)

I. Introduction

On April 26, 2005, a Questionnaire was sent to the National Groups. The Questionnaire is aimed at an analysis of the specific aspects of producing evidence in IP proceedings of the various national systems. The scope of the analysis includes in particular the provisions of the IP Directive Article 6 "*Evidence*," Article 7 "*Measures for protecting evidence*", Article 8 "*Right of Information*" and the respective homologues of the TRIPS Agreement (Articles 43, 47 and 50 of the TRIPS Agreement).

Until the editorial deadline of the present Report the Special Committee has received 31 answers containing comprehensive and extensive descriptions of the national legal frameworks. Several National Groups have promised answers, but are still in the process of preparing them. All answers are published on the AIPI Website.

The EU Member States shall implement the Directive 2004/48/EC of the European Parliament and of the Council of April 29, 2004 on the enforcement of Intellectual Property Rights (hereinafter: IP Directive) by April 29, 2006. Due to this tight time schedule and the fact that for the time being the involved authorities in the EU Member States are particularly concerned with the implementation of the IP Directive, the study of the Special Committee deals first with the EU Member States. The non-EU Member States have not been integrated in the present Report, as at the moment of the editorial deadline the overall analysis had not yet been completely finalized.

The following Summary Report is not aimed at repeating the content of the extensive descriptions contained in the answers but, rather, is focused on highlighting still existing gaps as to the standards set by the IP Directive and/or the TRIPS Agreement and elucidating existing differences between the national systems.

II. EU Member States

The Committee has received answers from the following EU Member States: Czech Republic, Denmark, Germany, Greece, Hungary, Italy, Poland, Portugal, Slovenia, Spain, Sweden, The Netherlands and United Kingdom.

1. Article 6 of the IP Directive / Article 43 of the TRIPS Agreement

a) Implementation status

At least as to Article 6 (1) of the IP Directive there was an unexpected large affirmation that the national frameworks already provide for mechanisms being generally in compliance with this provision and that only a few amendments will be necessary, if any at all.

Even in countries in which an amendment of the national laws seems not to be necessary, governmental efforts are currently in progress in view of a possible more appropriate implementation of the IP Directive. Such is the case for UK, where the government has issued a consultation paper to determine whether changes still need to be made in order to implement the IP Directive.

Italy appears to be in a very advanced stage. The Italian Group states that the national law is already amended by reference to the IP Directive.

Other National Groups report that a proposal for an amendment of the concerned laws is currently being prepared, or at least is being considered by the governmental bodies (the Netherlands, Denmark and Germany). In Germany, the Ministry of Justice has already prepared a draft act but has not yet published it. In this connection, it should be noted that the German legislators when ratifying the TRIPS Agreement assumed that the German law was in full compliance with the standards of the TRIPS Agreement; in particular, with the provisions concerning the collection of evidence. Thus, at that time, the German legislators did not believe that an amendment of the laws was necessary. This approach will prospectively not be applied in view of the IP Directive.

The Spanish Group – although indicating that Spanish national laws provide for provisions similar to the IP Directive – has indicated that the actual system does not yet comply with Article 6 of the IP Directive. At present the Ministry of Justice is preparing a draft act.

According to the response of the Portuguese Group, notwithstanding the necessity to rectify some details of national law, the present subject matter is not yet under discussion at governmental level. The same applies to Hungary and Greece. Special attention has to be paid to an attempt by the Greek Group, which has asked the Government to arrange a meeting with the Group's President and Secretary in order to discuss the problems associated with the IP Directive and its implementation. Also, the Czech Group, which believes that current national laws are not yet in compliance with the IP Directive, may not report on any respective activity by the competent national bodies. The Polish Group reports that the standards of the TRIPS Agreement are already applicable in Poland as the TRIPS Agreement is considered to be direct law in Poland; also, supplementing domestic legislation exists.

b) As to the requirements and the content of the available measures

Based on the answers of the National Groups, it seems that the applicable provisions of the various countries generally do not treat the different kinds of property rights in different ways; that is, the same procedural rules basically apply regardless of which specific property right (copyright, patents, utility models, registered designs, trademarks, etc.) is in issue. The answers of the National Groups also generally suggest that there essentially seems to be no need to set up different rules for the various property rights when implementing the IP Directive.

The available mechanisms are based either on the general provisions of civil procedure (for instance in Germany, Portugal, the Netherlands, Denmark, and Slovenia) or are part of intellectual property laws such as in Italy, where the legislators were already responsive to the IP Directive.

According to Article 6 (1, first sentence) of the IP Directive, a means for gathering of evidence is conferred on a party *which has presented reasonably available evidence sufficient to support its claim, and has, in substantiating those claims specified the evidence which lies within the control of the opposing parties*. It is commonly admitted that the grant of this order should not depend on the burden of proof.

(1) Generally national systems do not enable the applicant to search for evidence which is not concretely specified in the claimant's request. It also seems to be generally admitted that so-called "*fishing expeditions*" should not be allowed.

Nevertheless, according to the UK system, a deeper insight into the opposing party's sphere – as compared with most of the continental systems – is possible due to additional mechanisms. Under the UK law, through what is known as "*standard disclosure*," which

is automatically made on a case management conference, the parties need to give disclosure of documents. The claimant does not need to specify the means of evidence to be produced by the opposing party. The parties exchange a list of disclosable documents in their control and then mutually permit the inspection of such documents. Disclosable documents are defined as those on which that party relies, those which adversely affect that party's case and those which either support or adversely affect the other party's case.

The Danish system provides for a mechanism (known as an informal request) according to which a party can in a submission to the court request that the opposing party to the trial answers questions or submits information, evidence, arguments or other relevant material. Further, in the Netherlands, a provisional witness hearing may be used to identify the possible existence of evidence.

The other European systems in the present analysis do not provide for such mechanisms, which can be used in view of identifying still unknown means of evidence within the opposing party's sphere.

In Italy, the claimant must provide the court with precise reference to the documents and information under the control of the other party that the claimant would like the other party to disclose.

Comparable standards seem to apply in Portugal, Hungary, Spain and Germany. These national systems have in common that they do not have any comparable means to permit the identification of evidence not yet known.

A generally accepted answer to the question of the degree to which the requested means of evidence should be specified in order to be proper, however, can not be deduced from the answers. It is a question which definitely depends on the specific case and an appraisal of the conflicting interests between the parties differing from case to case.

(2) Regarding the prerequisite that the claimant has "*presented reasonably available evidence sufficient to support its claim,*" it appears from the answers that the national systems do not require a high degree of proof of the underlying claim for the success of such request:

In Portugal, a successful request requires the claimant to show, "*as clearly as possible,*" the facts that he expects to prove by means of the requested document. The court would then decide whether the facts that the party intends to prove are relevant to the action, whereby it may apply a discretionary power; other requirements need not be fulfilled. In the Czech Republic, it is also considered necessary for the claimant to at least explain why the requested document is important for the proceedings.

In Germany, the law provides for means authorizing the court – even without any request by the parties – to order that certain documents or objects be produced by a party to the proceedings, whereby the granting of the order depends upon the discretion of the court. There is, however, no requirement that the claimant's claim must already be proven or substantiated to a certain degree before the court can issue such an order. The German Group suggests in this respect that the wording of the IP Directive should not be understood to the effect that a degree of proof sufficient to support the claim must already have been submitted to the court before it is entitled to issue such order.

In other national systems it is admitted that at least a minimum of proof as to the underlying claim must be provided. In Italy, a disclosure order is available to the party that has provided serious evidence ("*seri indizi*"). Also, according to the Greek law, it seems to be necessary to first present reasonable available evidence. In other legal systems, such as in Spain, the respective requirements are more indeterminate. Or, as in Denmark, at least "a certain likelihood" is required before obtaining such an order.

Although it appears from the answers that the success of such orders should be dependant upon a specific degree of proof of the underlying claim, it should be noted that the effectiveness of the mechanism can only be take from a general appraisal of its functionality within the whole national legal system in which it is embedded. A recommendation as to the degree of proof suitable for obtaining such orders can therefore not be given.

c) Enforcement

As to the enforcement of such order, differences can be identified in the national systems. In several systems such as in Spain and The Netherlands the order may effectively allow entry to premises and, if necessary, supported by the police.

In Portugal, Poland and UK, the failure to comply with the order is contempt of court which can be punished by the entry of judgement against the party in contempt and by fines and/or imprisonment.

In other countries, such as Denmark, the order can not be enforced in such a way, but if a party refuses to fulfil the court's request to present documents, the court may, at its discretion, let such non-compliance have an effect favourable to the party requesting the non-disclosed evidence. The situation is comparable in Germany, Italy, Slovenia, Greece, Poland and Hungary, where the non-compliance of the opposing party with such order may also be evaluated in favour of the other party to proceedings, which results in a situation close to the reversal of proof.

More effective enforcement measures, which may better compensate the right holder's interests, are dealt with below in section II. 2, "Article 7 of the IP Directive / Article 50 of the TRIPS Agreement".

d) Protection of secret information

A sensitive issue is the protection of secret information.

(1) Almost all national systems already provide for a variety of means for the protection of secret information. In UK for instance, it may be requested to order that identified documents alleged to contain secret information be treated in confidence, and disclosed to only a limited group of people. Moreover, the disclosure is subject to a so-called "implied undertaking" not to use the evidence for any purpose other than the litigation in which the evidence is disclosed.

Comparable legal means are – according to the answers of the National Groups – also available in other countries. In Denmark, Poland and in Germany it appears to be legally possible to "close the doors" and to render the proceedings confidential. The choice of the suitable means mainly depends on a case-by-case assessment and in particular on a balancing of the mutual interests of the parties.

The Italian Group reports, that under the Italian law, it is possible that secret information is only disclosed to the attorneys and consultants and not to their clients. This apparently requires that the attorneys and/or consultants are bound to a secrecy obligation preventing them from disclosing the secret information to their clients.

It is evident that there is a relationship between the enforcement of such orders and the necessity for specific means to protect the secrecy interests. In countries such as Germany, where the order is not enforceable (that is, where a non-compliance of the order may only lead to unfavourable conclusions by the court), a party trying to protect the secret can at least decide between either losing the lawsuit by choosing not to introduce the requested evidence or lifting the veil of secrecy in order not to lose the chance of winning the lawsuit.

Overall, it follows from the answers of the National Groups that there is a need for specific provisions and mechanisms enabling a suitable protection of secrecy interests. The conditions for such secrecy provisions will mainly depend upon the specific case in issue and the involved conflicting interests. Also, when establishing such secrecy protection mechanisms, the surrounding legal framework and its possibilities (which may be limited by constitutional requirements) should be considered. It is, however, not possible to identify a best practice or a specific desirable way to most efficiently solve this conflict between the parties.

(2) Of concern in connection with the treatment of secret information will be the question whether the parties may rely on privileges, such as attorney–client privileges. Generally, such privileges are at least construed as professional secrecy obligations which can also be invoked.

From the answers from National Groups whose countries have only reduced evidence gathering means, the question whether privileged information can be invoked does not have the same significance than in those countries, such as UK, where the current legal system allows greater means to gather evidence.

The more the national authorities widen the possibilities for the right holder to obtain evidence from the opposing party the more these authorities have to consider the conflict which may arise if subject matters of attorney–client relationship are concerned.

(3) The IP Directive does not contain a definition or explanation of the term “secret information”. This may result in different approaches in the EU Member States. A clarification of the meaning of the term “secret” could lead to a better harmonisation of the enforcement proceedings within the European Union.

e) Legal presumption according to the 2nd sentence of Article 6 (1) of the IP Directive

This provision apparently refers to a problem arising in cases where large amounts of infringing items such as optical discs are to be seized. Requiring detailed proof of infringement of each item would lead to loss of time, effort and money by the right holder.

The National Groups have reported that their systems do not contain an explicit provision in the sense of the 2nd sentence of Article 6 of the Directive according to which a reasonable sample of a substantial number of copies of a work or any other protected object is to be considered to constitute reasonable evidence.

Nevertheless, the German and Italian Groups state that it is part of their practice in IP litigation that the plaintiff is only required to substantiate his claim with respect to one infringing item. These statements primarily concern injunctive relief.

The provision poses a question as to the aim of this presumption. In this connection, the Polish Group points out that, on the one hand, it could be sufficient that one copy may be enough for proving the existence of an infringement; however, on the other hand, such presumption would not be acceptable for determining the scope of infringement, in particular in view of quantifying a damage claim.

As the 2nd sentence of Article 6 represents a “may” provision the national legislators will not be strictly obliged to establish such a presumption within national law. Accordingly, one has to wait and see whether the national legislators will integrate into the national laws far reaching means that allow the effective seizure of a complete stock of infringing items. The latter is, for instance, possible under French law by means of the “saisie contrefaçon” as to trademark and design model issues.

f) Article 6 (2) of the IP Directive

According to Article 6 (2) of the IP Directive, it should be possible to order the communication of banking or financial documents provided that the infringement is committed on a commercial scale.

It appears that this provision is aimed at ensuring access to information contained in such documents by means of which the claimant would be able to identify the beneficiaries of the infringement (on different distribution levels). Taking this into consideration it appears that the majority of national systems do not yet have any provisions that comply with Article 6 (2) of the IP Directive. The German Group is even of the opinion that this provision is "*much too wide*", as the documents concerned may contain a huge amount of confidential information. The national authorities will have to solve the problem stated by means of adequate measures that secure the secret information of these documents.

g) Unjustified order

In a majority of countries, the judge may award damages arisen to the party due to the unjustified order. Further, the costs of proceedings have to be reimbursed by the claimant of the unjustified order. In some countries the order may be linked with a guarantee covering damages that suffers the party as a result of the unjustified order.

As to the consequences of an unjustified order, the German Group points out an interesting aspect. It is stated that, if the opposing party has produced a document although the order was unjustified, the document is on the files and if it proves the fact for which the document was cited, the court will probably still use the document as evidence.

This means that according to German law the consequence of an unjustified order will not be that the acquired piece of evidence (for instance, a document), will be excluded from the proceedings.

2. Article 7 of the IP Directive / Article 50 of the TRIPS Agreement

a) Implementation status

According to Article 7 of the IP Directive, the measures for obtaining evidence should explicitly be applicable *even before the commencement of proceedings* on the merits (or preliminary injunction proceedings).

Accordingly, the right holder may initiate either a detailed description, with or without the taking of samples, or the seizure of infringing goods and, in appropriate cases, should also have access to the materials and implements used in the production and/or distribution of these goods and the documents relating thereto. In exceptional cases this should even be granted in "*ex parte*" proceedings. This provision has – as is specifically indicated in the Explanatory Memorandum to the proposal for the IP Directive¹ – been modeled on provisions such as the UK's *Anton-Piller* order and the French *saisie contrefaçon*.

According to the Danish Group, its laws are already to a considerable extent in compliance with Article 7 of the IP Directive and provide for a mechanism that is available even *ex-parte*. However, in contrast to the IP Directive, these rules do not apply where the infringement is only imminent or about to be infringed. Nor, furthermore, is the physical seizure of infringing goods yet possible under Danish law. Moreover, the Danish Group has noted that the actual rules do not apply to patent, utility models and semiconductor topography rights for the production process, machines or other production equipment. This has been criticized by the Danish Group. It also recommends that an explicit provision as to the seizure of infringing goods be introduced in the Danish law.

¹ COM(2003) 46 final, page 21.

Advanced and close to the targets set by Article 7 of the IP Directive are the laws of the Netherlands, for which reason the Dutch Group considers that the currently available legal mechanism provides for sufficient possibilities for obtaining evidence prior to the legal proceedings. A slight difference to Article 7 of the IP Directive has been identified by the Dutch Group, namely that *inaudita altera partes* proceedings exists only in the context of a (descriptive) seizure of infringing products and not as to documents.

The Italian Group also reports that the Italian law provides for a search order which is "widely considered ... highly effective" and is available even on an ex parte basis. This is certainly associated to the fact that the Italian laws have already been amended in view of the EU Directive as mentioned above.

Also, the UK Group is of the opinion that its national laws generally comply with Article 7 of the IP Directive and that there is only a need to relax the requirements of the "search and seizure order". Notwithstanding, as already indicated above, the UK Government is at the moment inquiring by means of a consultation whether there is still a need for further improvements.

According to the Hungarian Group the measures under current law do not entirely comply with Article 7 of the IP Directive or Article 50 of the TRIPS Agreement because there is no time limit for the claimant to initiate the proceedings on the merits and there are no clear provisions ensuring compensation of damages for the opposing party should there be no infringement. An advanced situation can be, however, identified in Slovenia. Its Group believes that the existing rules are sufficient and no implementation will be necessary.

The Spanish Group reports that the measures under current law are only available before the commencement of the proceedings, but once the proceedings have started. Also for this reason, it is considered that there is a need for the implementation of Article 7 of the IP Directive, which is to be achieved by a forthcoming amendment of law, which is currently being prepared by the Ministry of Justice.

The Greek Group reports that its national laws do not have any instruments according to Article 7 of the IP Directive or Article 50 of the TRIPS Agreement and that there are ambitions to further develop and improve its system.

The German Group reports that – despite the fact that the German legal system meets most of the requirements of the IP Directive – the legislators are willing to specifically adopt the provisions of the IP Directive.

The Portuguese Group believes that, although its national system already provides for general provisions which could be considered as being sufficient to meet the requirements of Article 7 of the IP Directive, specific IP provisions should be established.

In Poland at least the TRIPS standards – through their direct legal application – are already part of national law. The implementation of the IP Directive has not yet been carried out.

The Czech Group is of the opinion that the national system does not even comply with the TRIPS Agreement. For the time being, there are in particular no means aimed at the seizure of infringing items.

b) As to the requirements and the content of the available measures

In addition to the differences between the IP Directive and the national systems indicated in the previous section, the following particularities can be deduced from the answers.

In UK a so-called "search and seizure order" is available which depends – according to the UK Group – on three essential pre-requisites; namely, a extremely strong prima facie case, secondly, serious actual or potential damage faced by the applicant, and finally,

clear evidence that the respondent has in its possession incriminating documents or things and that there is a real possibility that the respondent may destroy this material before any application *inter partes* can be made. According to the UK Group, since these pre-requisites apparently set higher hurdles than the Directive, it appears these pre-requisites need to be relaxed.

It should be noted that the French “*saisie contrefaçon*” seems to apply an even more open approach requiring only a valid property right, whereby it is left to the discretion of the judge whether and to what extent the infringement must be proven. A certain probability that the right is infringed, however, need not be demonstrated.

The Italian search order requires *inter alia* that the claimant proves to have serious evidence of the soundness of its claims. Similar to the UK approach, the Italian Group recommends for the purpose of a successful request that the order is urgently needed to prevent a rapid change of the factual background and/or the disappearance of existing evidence.

Hungarian law also knows a comparable limitation requiring the likelihood that the taking of evidence would be endangered in the course of the civil action or in a later phase thereof. The same results from the Portuguese law.

In the Netherlands a more flexible approach seems to be applicable. According to the Dutch Group, the claimant should render the “beginning of proof” that there has been an infringement and for the rest the decision of the court is then based on an assessment of the interests of both parties.

In Denmark, the order requires that the infringement is “*substantiated*”. Furthermore, the infringement must have been committed as part of a “*commercial activity*” or, alternatively, is “*not unsubstantial*”. The latter requirement – even assuming that one of both cases nearly always applies – cannot be found in the other systems analysed.

A common position which can be identified in the national laws is that the order cannot be used as a so-called “*fishing expedition*”. In all legal systems it is necessary to specify the means of evidence which should be subject to the disclosure. In this respect, as indicated in connection with Article 6 of the IP Directive, account must be taken of the fact that some countries such as the UK (for instance by means of the “*standard disclosure*”) or in Denmark (informal request) may allow inquiries which do not necessarily require the specific means of evidence to be already known to the claimant.

In Poland such measures for obtaining evidence are available as temporary measures and the claimant has “*only to prove that the infringement is probable*”.

Other National Groups such as the Czech Group – although there are general means that could or should be considered in the present context – report that these means are rather toothless due to limited enforcement possibilities. They are also rarely used. For this reason, the Czech Group is of the opinion that there is definitely a need to amend the actual law in view of the IP Directive.

c) Enforcement

From the replies it follows that the means of enforcing the order (if already available in the system) does not appear to be of particular concern. The national systems provide for different enforcement mechanisms such as fines, penalties and/or police force, which may be applied if for instance access to the premises is refused. In general, they are considered to be sufficient in order to achieve the objectives of the order. Of special concern is rather the question of who is entitled to enter the sphere of the opponent. It is a question that is to be considered in connection with the mechanism that ensures a sufficient protection of

confidential and secret information (see below). In Germany, where the available measures only permit the inspection of the infringing object, it is not yet possible to effectively seize objects.

d) Protection of secret information

In particular in cases in which it is necessary to enter the opponent's premises or factory, it is doubtful whether and how confidential information can be sufficiently protected. In all the systems that are the subject of the present analysis, legal mechanisms are available by which means a compromise may be found to the conflicting interests of the two parties – namely the interests of the alleged infringer not to have to disclose his secrets to his competitors (including often the right holder) and the interests of the right holder to prove the infringement of his intellectual property right and to win the case.

Generally, a weighing of the conflicting interests is considered the starting point for the determination of the suitable measure to be applied for ensuring the secrecy interests.

In this – according to Italian Group – the court determines the adequate measure, which may be a disclosure of the secret information to the attorney only. This would consequently require the attorney to be bound by a secrecy obligation preventing him from disclosing this information to his client.

In UK the said secrecy interests may be satisfied by the appointment of an independent "supervising solicitor", whose role is to ensure that the order is carried out properly. Moreover, all disclosures are subject to an "implied undertaking" not to use the disclosed documents for any purpose other than the proceedings in which they are disclosed. In the Netherlands it is possible to hold the proceedings on a confidential basis.

According to the German Group, under German law the inspection may be carried out by a neutral expert appointed by the court. During the inspection, which may take place in the premises of the opposing party, the right holder/plaintiff can be excluded; only the attorneys will be admitted but are, however, obliged to keep all information about the inspection secret, even with respect to their client, the plaintiff. The expert then establishes a report regarding the inspected object, which is first presented only to the opposing party, enabling him to assert any interests in secrecy. The court has then to decide whether secret interests are involved and to what extent, if justifiable secret interests are indeed involved, the report can be delivered to the plaintiff.

It appears from all the replies that the protection of secret information is a delicate issue to which special importance is attached. However, the specific implementation of a suitable mechanism must be solved and embedded within each system, and adapted to the surrounding national legal particularities.

Some of the mechanisms described above have already been described in section II. 1. d) above in connection with Article 6 of the IP Directive.

3. As to Article 8 of the IP Directive / Article 47 of the TRIPS

a) Implementation status and content of available remedies

A considerable number of countries (Denmark, Spain, Greece, and Portugal) have not yet implemented rules in accordance with Article 8 of the IP Directive / Article 47 of the TRIPS Agreement. As Article 47 of the TRIPS Agreement seems to be optional, an implementation obligation for these countries results thus from Article 8 of the IP Directive.

The other national systems that are the subject of the present study have implemented or directly apply the standards set by Article 47 of the TRIPS Agreement, such as Germany, Czech Republic, Poland, Hungary, the Netherlands, and Italy (with the exception of copyright).

However, it has been reported that measures against third parties (non-infringers) are not yet available to the extent stipulated in Article 8 (1). The German Group does not see a particular concern as to the cases (a) to (c) of Article 8 (1), as they describe situations in which the third party will most probably also have infringed the IP right according to German law. However case (d) appears to be more delicate, as any person who has been indicated as being involved in infringing activities could be exposed to such disclosure and this regardless of whether this person has acted illegally or not. The German Group is therefore of the opinion that such a claim could conflict with the principles of fairness and the foreseeability of the law.

b) Enforcement of the right of information

The majority of the National Groups are of the opinion that the right of information should be enforceable by means of preliminary injunction proceedings. The Hungarian Group however indicates that the enforcement of a right to information in preliminary injunction proceedings conflicts with the basic principles of preliminary injunctions due to their temporary nature and the fact that if the right to information is enforced by means of preliminary injunction proceedings, the effect would be irreversible.

In addition, the Spanish Group recommends that – if the right of information is enforced in preliminary injunction proceedings – it should be necessary that at least *prima facie* evidence is presented that the underlying IP right has been infringed.

In Germany, where the right holder may take recourse to a right of information, it is already accepted case law to enforce this right by means of preliminary injunction proceedings. However, judicial practice makes high demands on the degree of *prima facie* proof as to the soundness of the underlying claim.

c) Protection of secret information

Also in the context of Article 8 of the IP Directive, the protection of secret information has been identified by the National Groups as an area of particular concern. The right to information according to Article 8 of the IP Directive is focused on information such as customer names and other retailer-related data which is in most cases to be considered as confidential. The IP Directive seems to solve the obvious conflict between the right holder's interests and secrecy interests in favour of the rightholder. According to the German Group, German law also solves this conflict in favour of the right holder. The right to information is, however, not unlimited and the weighing of the conflicting interest may lead to its denial.

As to the protection of secret information, most of the replies refer to their statements in connection with Article 6 ad 7 of the IP Directive, which have been summarised above in Sections II. 1. d) and II 2) d).

4. Conclusions

It may be concluded from the answers that the functionality and effectiveness of the mechanisms at issue depend on a plurality of factors which are particularly associated with the surrounding legal national framework; this is, the implication of the civil law, in particular the civil procedural law and even the constitutional law of the EU Member States will play an essential role when integrating the mechanisms into national laws. This specific national context, which differs from country to country, bearing particularly in mind that common law concepts contrast with the continental concepts, will significantly influence the specific construction of the measures.

Against this background, it seems to be inappropriate for the time being to identify particular best practices. In addition, given that according to the National Groups the implementation process is at an advanced stage and is close to finalisation, it seems at present to be inappropriate to formulate general recommendations going beyond the standards set by the IP Directive.

In this respect the work of the Committee will be concentrating on the final outcome of the implementation process, which will be expected at the latest, if the EU Countries comply with the deadline set in the IP Directive, in April 2006.

III. Further work of the committee

The Committee will be continuing the study as indicated above. In a next step, a Summary Report will be drawn up, in which particular concern is to be given to the countries which have not yet been considered in the present report. The Committee has received replies from the following countries, namely from (EU applicant countries and other European countries): Bulgaria, Romania Switzerland and from (countries outside Europe): Argentina, Australia, Brazil, China, Egypt, Indonesia, Israel, Japan, Malaysia, Mexico, Paraguay, Philippines, South Africa, Thailand, USA.

The Members of the Committee will meet during EXCO 2005 in Berlin for further detailing of the Committee's future programme.