

QUESTION 90

Obtaining of evidence of the infringement of industrial property rights

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Q90

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Obtaining of Evidence of Infringement of Industrial Property Rights

Resolution

The AIPPI:

(A) Is concerned that it is difficult before proceedings are commenced for owners of industrial property rights to be able to obtain sufficient evidence of infringement of their rights. This is particularly the case where possibly infringing activities are being conducted on premises which are not accessible to the owners of industrial property rights.

(B) Considers that an effective procedure to obtain evidence of infringement should permit the execution of orders for inspection, taking samples, etc. without prior notice in appropriate cases, since the element of surprise makes it possible to prevent that evidence is removed.

(C) Recognises, however, that in seeking to provide a solution to the above problems, it is necessary fully to protect the rights and interests of third parties, especially with regard to their trade secrets.

The AIPPI accordingly resolves:

I. There is a need to provide a system to enable the proprietor of an industrial property right to obtain evidence of infringement (where it is not otherwise reasonably obtainable) before formal institution of legal proceedings.

II. Under such a system:

1. The proprietor would be entitled to apply to a Court or other competent authority

(hereafter referred to as the "Court") for an order for obtaining evidence (for example, but without limitation, for inspection of premises, examination and copying of documents and taking of samples).

2. The Court should decide, having regard to the material put before it by the proprietor, whether issuing the order without first hearing the alleged infringer or any person affected by the order would be justified. If the Court is not willing to issue the order without hearing or giving prior notice to the alleged infringer or such person, the proprietor should be entitled to withdraw his application, so that notice is not given to the alleged infringer or such person.
3. The Court shall take appropriate steps to protect the trade secrets of the alleged infringer or any person affected by the order, for example by excluding the proprietor or limiting those appointed to inspect to independent experts or attorneys who are subject to obligations of confidence.
4. A period should be fixed within which evidence obtained under the Court order should not be further disclosed, to give the alleged infringer or any person affected by the order an opportunity to apply to the Court for an appropriate further order protecting his rights or interests.
5. The Court shall ensure that appropriate safeguards are provided to compensate the alleged infringer or any person affected by the order for any damage that he may suffer unjustifiably.
6. The proprietor should not be obliged to institute infringement proceedings, but if he does not do so within a specified period, the alleged infringer or person affected by the order shall be entitled to apply to the Court for appropriate relief, including costs, and damages (if any).

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