

# Amount of evidence required for obtaining a preliminary injunction in Europe

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## 0. Introduction

The present paper will focus on provisional measures in patent litigation proceedings in Europe, and more particularly on preliminary injunctions in Europe.

Such measures are said to be provisional because they take place before a final Court decision is taken.

Such provisional measures arise in circumstances where it is essential to at least one of the parties of a litigation that a fast decision be taken relating to a specific point of the litigation.

Preliminary injunctions, also known as “*interim injunctions*” or “*interlocutory injunctions*” (and “*interdiction provisoire*” in France) may be granted by Courts on demand of claimants in certain conditions, which will be examined thereafter.

More specifically, we will focus on the “*amount*” of evidence that has to be given by the claimant to the Court in order to obtain a preliminary injunction.

We will approach this question in several European countries, namely Germany, United Kingdom, France, the Netherlands, Italy and Spain, and will then look at this question in light of the UPCA<sup>1</sup> and its Rules of Procedure.

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<sup>1</sup> Agreement on a Unified Patent Court : under this Agreement, which is undergoing a process of ratification by the States of European Union, a Unified Patent Court will be installed soon, with its Central Division in Paris. This Court will be competent for rendering judgments on validity and infringement of European Patents that will be enforceable in all signatory Member States. “European Patents” are not only classical European Patents that have been validated in a selection of countries of EPC (European Patent Convention), but also European Patents with Unitary Effect, i.e. taking effect as a single patent in all signatory Member States of UPCA.

# 1. Evidence for obtaining a preliminary injunction: approaches of the national Courts

## European harmonization

The approaches of the national Courts have been harmonized by the DIRECTIVE 2004/48/EC OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL of 29 April 2004, which relates to the enforcement of intellectual property rights:

“CHAPTER II

Section 4

*Provisional and precautionary measures*

Article 9

*Provisional and precautionary measures*

1. Member States shall ensure that the judicial authorities may, at the request of the applicant:

(a) issue against the alleged infringer an **interlocutory injunction intended to prevent any imminent infringement of an intellectual property right**, or to **forbid**, on a provisional basis and subject, where appropriate, to a recurring penalty payment where provided for by national law, **the continuation of the alleged infringements of that right**, or to make such continuation subject to the lodging of guarantees intended to ensure the compensation of the rightholder;

.....

3. The judicial authorities shall, in respect of the measures referred to in paragraphs 1 and 2, have the authority to **require the applicant to provide any reasonably available evidence in order to satisfy themselves with a sufficient degree of certainty that the applicant is the rightholder and that the applicant's right is being infringed, or that such infringement is imminent.**

.....”

This European Directive has been since then implemented in European national laws (in France, this was in October 2007), and aimed in particular at changing the level of evidence to be given to the Court in support to a request for preliminary injunction.

Generally speaking, before this European Directive, most European national laws provided that preliminary injunctions could be granted only if:

- there was a pending action on the merits, and
- this action on the merits was serious, and
- the preliminary injunction was introduced shortly after the claimant had knowledge of the infringement (in case law, “*shortly*” generally meant between 1 and 6 months).

It results from above that, in the “*ancien régime*”, i.e. before said Directive, the Court had in particular to take a close look at the validity of the patent under consideration, in order to assess the “*seriousness*” of claimant’s demand.

With the “*nouveau régime*” provided by said Directive, there seems to be no longer obligation for the Court to assess the merits of the patent, i.e. its validity in view of prior art. This alleviates the evidence that is to be provided by the claimant in order to obtain a preliminary injunction.

The “*short*” delay after knowledge of infringement has also been removed from the Directive, so that evidence regarding this point has also been removed from claimant’s burden.

It results in particular from points 1. and 3. of Chapter II, Section 4, Article 9 of the Directive that the only remaining evidence that has to be given to the Court by the claimant when requesting for a preliminary injunction is:

- that he is the rightholder of the patent, and that
- his patent is being infringed, or will imminently be infringed.

This seems to limit examination of evidence by the Court merely to formal points, which could lead to a much higher allowance rate of preliminary injunctions.

In the following, we will take an overview of the current practice regarding this question in several European countries, before focusing on UPCA provisions relating to preliminary injunctions.

Both national and UPCA approaches keep their whole interest, since national Courts and UPC will operate simultaneously, and will have to take decisions on requests for preliminary injunctions for patents under their respective competences.

Namely, national Courts will have to take decisions on requests for preliminary injunctions for national and opted-out “*classical*” EP patents, and UPC will have to take such decisions for non opted-out “*classical*” EP patents and EP patents with unitary effect.

## Germany

It seems that Courts in Germany have an “*ancien régime*” approach of preliminary injunctions. In other words, they pay much attention both to the questions of validity and infringement before granting a preliminary injunction.

As a rule of thumb, if they have any doubt regarding validity or infringement, they do not grant the preliminary injunction.

Regarding **validity**, the following facts can help to convince the Court that there is no doubt:

- patent which has survived an opposition,
- patent which is licensed to another party (the party must have checked the validity before taking the license),
- patent granted since long (the fact that it has never been challenged can be interpreted as a sign of validity).

Regarding **infringement**, the standard of evidence is lower than in the main proceedings: it is enough that the Court finds the alleged facts to be more likely true than not.

Nevertheless, anything that will contribute to demonstrate that there is a *prima facie* case of infringement of independent claims, will help to obtain a preliminary injunction.

For example, it might be very useful to bring a sample of the alleged infringing product before the Court, in order to show that independent claims clearly read on this product.

In cases where infringement is not straight-forward, for example in cases of infringement by equivalence, it is likely that the Court will not grant preliminary injunctions.

Last, preliminary injunctions in Germany can be obtained only for granted patent, and only if they are requested short time after knowledge of infringement.

Although this is not explicitly mentioned in German law, “*short time*” means between 1 and 2 months – which is very short indeed.

Preliminary injunctions in Germany can be obtained - in most cases (this remains at the discretion of the Court) - *ex parte*, which means without the other party being involved in the discussions with the Court. Thus, in case of failure to obtain a preliminary injunction, the defendant will not be informed, and this should not influence the main proceedings.

## United Kingdom

The Courts of UK have a different approach from that of the German Courts, which still requires quite a lot of evidence to be provided by claimant in support to the request of preliminary injunction.

The Courts of UK request evidence by written witness statement that there is an arguable case that an infringement is occurring or will occur.

In taking their decision regarding preliminary injunctions, the Courts of UK take into consideration a number of other factors which are outside the mere questions of validity and infringement.

Namely, these factors include:

- whether granting a preliminary injunction is necessary in view of irreparable harm that would be caused to the claimant by continuing infringement - this being balanced with any harm that would be caused to the defendant;
- ability of the claimant to pay damages to defendant, in case the final decision does not admit infringement;
- whether there is a serious issue to be tried;
- whether damages as a remedy is not enough - so that no injunction is needed;
- any delay in seeking the injunction: typically, only a few months are admitted between knowledge of infringement and request for preliminary injunction.

Last, like in Germany, preliminary injunctions in UK can be obtained only once the patent is granted.

It results from above that in UK, the Courts take into consideration many factors that are not explicitly mentioned in said Directive, and that quite a lot of evidence is required to address all these factors.

The amount of evidence needed may depend on whether the action is before the IP Enterprise Court (for simpler cases - lower standard of evidence), or at the High Court (for more complex cases - higher standard of evidence).

## France

Since the transcription of above Directive in French law (Article L. 615-3 of Code de la Propriété Intellectuelle), there have been diverging practices in Courts which were asked to deliver preliminary injunctions in France.

Before patent litigation was concentrated in the Paris Court (*i.e.* before year 2009), Courts of Lyon and Strasbourg (first instance) granted preliminary injunctions in strict accordance with the text of the Directive.

Namely, these Courts only checked that the claimant was the rightholder of the patent, and that evidence submitted by the claimant clearly showed that there was a case of actual or imminent infringement.

No verification was made regarding the validity of the patent under consideration, beyond mere *prima facie* lack of validity.

After concentration of patent litigation in the Paris Court (*i.e.* after year 2009), a trend of “*ancien régime*” showed up again, and in some decisions the Court requested that validity of the patent be discussed with both parties, before deciding to grant or not grant a preliminary injunction.

Nevertheless, a rather recent decision of the Court of Appeal of Paris (year 2012) clearly states that it is not within the Court’s responsibility to assess whether the request for preliminary injunction is serious or not, *i.e.* to assess the validity of the patent.

This decision has also set that only *prima facie* invalidity of the patent should lead the Court to reject the request for preliminary injunction for lack of seriousness.

This recent decision seems to show that French case law is converging to the “*nouveau régime*” set by said Directive, where no assessment on the merit of the patent is to be provided by the Court that has to rule on a request for preliminary injunction.

The only criteria set by this Directive, and apparently followed by recent French case law, is whether it is likely that the rights of the patentee are or will be imminently infringed.

This means that the only evidence that is to be given by the claimant is that he is the patent rightholder, and that there is an actual product or process that is implemented or likely to be implemented very soon, and which reproduces the features of independent claims of the patent.

Said article L. 615-3 contains no restriction as whether the patent must be granted or not, and whether the request for preliminary injunction has to be filed shortly after knowledge of actual or imminent infringement.

Nevertheless, in practice, French Court will prefer to wait for the patent to be granted before accepting to deliver a preliminary injunction.

## The Netherlands

In the Netherlands, preliminary injunction, known as “*kort geding*”, is an *inter partes* procedure including oral hearing, where the Court gives a full preliminary review on the merits.

In other words, the validity of the patent is looked at closely, although the Court that has to rule on a request for preliminary injunction, cannot declare a patent invalid.

A preliminary injunction may be granted only if the Court comes to the preliminary opinion that there is no serious chance that the patent will be declared invalid in proceedings on the merits, and if the Court believes there is an infringement.

The parties can use written evidence, such as affidavits or witness declarations. Experts and witnesses can be brought at the oral hearing, although it is at the Court’s discretion to hear them or not, and to ask them questions or not.

Regarding time frame, recent case law has established that even in cases where infringement has been known for a long time, preliminary injunctions can be obtained: in such cases, the claimant must prove that infringement is of continuous and systematic nature.

## Italy

In Italy, a preliminary injunction can be requested in the writ of summons or at a later stage of the proceedings on the merits.

In order to support a request for a preliminary injunction, the claimant will have to prove to the Court that the patent is clearly valid and infringed.

Such evidence can be provided for instance by the written opinion of an expert.

As regards validity, any objective facts such as a patent granted after examination (e.g. EP patent having parallel granted patents in other states like US, JP, etc.) is favorable evidence in support to a request for a preliminary injunction.

## Spain

In Spain, a preliminary injunction can be asked for before the proceedings on the merits.

No examination regarding validity is made by the Court - the claimant merely has to prove that there is preliminary infringement evidence.

All means can be used to provide such evidence, and in particular investigations from a private detective showing that there is producing/offering/storing/selling/exporting of the infringing product/process.



## 2. Evidence for obtaining a preliminary injunction: the approach of UPC (Unified Patent Court)

In UPCA (Agreement on a Unified Patent Court), the relevant Rule of Procedure regarding the amount of evidence to obtain a preliminary injunction, is Rule 211(2), which provides that : *"In taking its decision the Court **may** require the applicant to provide reasonable evidence to satisfy the Court with a sufficient degree of certainty that the applicant is entitled to commence proceedings pursuant to Article 47 and that the patent in question **is valid and that his right is being infringed, or that such infringement is imminent**".*

This Rule gives to future judges of UPC a very large degree of freedom ("*may require*") as regards evidence they will ask for ruling on requests for preliminary injunctions.

In particular, this Rule leaves open the amount of evidence that will be asked by the judges of UPC regarding validity and infringement of patents.

It seems that, in this way, UPCA has been made compatible with said Directive and with national practices of all Member States in terms of evidence necessary for obtaining a preliminary injunction.

Yet, much concern has been expressed, in particular by associations like AIPPI, on this discretionary power of the judges to grant preliminary injunctions (see in particular AIPPI's Comments and Recommendations of AIPPI on Preliminary set of provisions for the Rules of Procedure of the Unified Patent Court - 15th draft of 31 May 2013, which proposed to replace "*the Court **may** require the applicant to provide reasonable evidence to satisfy the Court with a sufficient degree of certainty*" by "*the Court **shall** be satisfied with a high degree of certainty*").

In fact, this discretionary power could leave the door open to very easily-obtained and offensive preliminary injunctions taking effect in all Member States of UPCA.

Such offensive injunctions could arise in particular from patent trolls, which would find here a very powerful way to compel their targets to quick financial settlements.

Such situations would clearly lead to cases of abuse of rights, which is obviously not what was wished by the authors of UPCA.

It is commonly believed that such extreme situations could be avoided by Rule 211(3) UPCA, which repeats Article 62(2) UPCA which states that "*The Court shall have the discretion to*

*weigh up the interests of the parties and in particular to take into account the potential harm for either of the parties resulting from the granting or the refusal of the injunction.”*

This means that even if the Court requests very little evidence regarding validity and/or infringement, it should not grant easily preliminary injunctions in cases where it would harm the defendant in an un-balanced manner.

A typical example of such un-balanced harm that could be caused to the defendant could be a preliminary injunction granted to a patent troll without careful examination of evidence relating to validity and infringement.

In other words, one should rely on Court’s common sense and experience for not interpreting Rule 211 UPCA in an un-controlled and harmful manner: this particular point illustrates why recruitment of very high standard legal judges at UPC is of essence.

Last, and noticeably enough, there seems to be no provision in UPCA regarding the time period which separates knowledge of infringement and request for preliminary injunction: as a consequence, according to UPCA, the Court will not have to assess the urgent character of the injunction, and no evidence to this end will have to be provided by claimant.

Only practice and case law will tell if UPC will adopt national practices where said time period is taken into consideration.

It can be noted that AIPPI (see above-referenced document) highly recommended that the assessment of the urgent character of preliminary injunction be mentioned in UPCA.

### 3. Conclusion

As a sum-up of this paper, the following table is a recap of the points which are assessed by the Courts for ruling on requests for preliminary injunctions, and which need to be evidenced by claimant. This table covers the various laws that have been discussed above, i.e. said European Directive, national laws of DE, GB, FR, NL, IT, ES, and UPCA:

*Table : Points assessed by the Courts for ruling on requests for preliminary injunctions*

	<b>Entitlement</b>	<b>Validity</b>	<b>Infringement</b>	<b>Balance of interests</b>	<b>Urgency</b>
<b>2004/48/EC</b>	Yes	No	Yes	No	No
<b>DE</b>	Yes	Yes	Yes	No	Yes
<b>GB</b>	Yes	Yes	Yes	Yes	Yes
<b>FR</b>	Yes	No <i>(except prima facie lack of validity))</i>	Yes	No	No
<b>NL</b>	Yes	Yes	Yes	No	No
<b>IT</b>	Yes	Yes	Yes	No	
<b>ES</b>	Yes	No	Yes	No	
<b>UPC</b>	Yes	At discretion of the Court	At discretion of the Court	Yes	No

As a conclusion, this overview of requirements for obtaining preliminary injunctions shows that the amount of evidence to be provided for, varies from one country to another, despite European Directive 2004/48/EC which has been transcribed in national laws.

UPCA has been drafted in a manner leaving a lot of liberty to the Court regarding the amount of evidence it will require to rule on requests for preliminary injunctions effective in all Member States of UPCA where the European Patents (both “*classical*” and with unitary effect) under consideration, will be in force.

Therefore, it is difficult to forecast whether the UPC will be likely to adopt a rather liberal attitude like in France for instance (no examination of validity of patent, no assessment of time between knowledge of infringement and request for preliminary injunction), or a more conservative attitude like in Germany or Great Britain (validity taken into consideration, as well as time between knowledge and request), for ruling on a request for a preliminary injunction.

Nevertheless, due to the “*weighing up of interest of parties*” provided in UPCA, one can believe that preliminary injunctions should not be granted unexpectedly easy by the judges of UPC.

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