

***Non-binding Guidance
for the use of the
“General Template for Order – UPC CFI”***

Order to inspect premises and to preserve evidence

ORDER

of the Court of First Instance of the Unified Patent Court

Local division in ... / Regional division in ... / Central division (Paris Seat or Munich Section)

issued on ... [dd month in words yyyy]

concerning ... [EP/UP/SPC/EP application at issue]

HEADNOTES : ... [required by R. 67 RegR] [to be provided by the Judge-rapporteur]

KEYWORDS: ... [required by R. 67 RegR] [to be provided by the Judge-rapporteur] preservation of evidence; inspect premises; order issued *ex parte* / *inter partes*; application lodged before / after proceedings on the merits have commenced; reasonably available evidence to support claims; prompt and effective measures; protection of confidential information; detailed description / taking of samples / physical seizure of infringing products / materials and implements used in the production / distribution of infringing products; related documents; ... [non-exhaustive list for illustrative purposes]

REFERENCE CODE ECLI: ... [required by R. 67 RegR] [to be provided by the Deputy-Registrar]

Particular circumstances which should be taken into account

- Is the Application for inspection and/or for preserving evidence lodged after proceedings on the merits have been commenced before the Court?**
 - If yes, the present Order should indicate main action n°...
- Is the Application lodged before proceedings on the merits have been commenced before the Court?**
 - If yes, the present Order should inform Applicant that he must start proceedings on the merits of the case before the Court on ... [date] at the latest. (If proceedings on the merits are not started, the Court may order, upon request of the Defendant, that the present Order be revoked or otherwise ceases to have effect with due account to the date where the Report referred to in R. 196.4 RoP shall be presented [Art. 60(8) UPCA, R. 198, 199.2 RoP])
- Is the Order issued without having heard the Defendant (*ex parte*)?**
 - If the defendant has not been heard, a review of the present Order may be requested by the Defendant until ... [date] with a view to decide whether the Order is to be modified, revoked or confirmed [Art. 60(6) UPCA, R. 197.3, 199.2 RoP]
[time period: within 30 days after the execution of the measure] [R. 197.3, 199.2 RoP]
- Is the Order issued after having heard the Defendant (*inter partes*)?**

CLAIMANT:

... [name and postal address]

represented by ... [academic title (where applicable), name, national professional title, firm]

assisted by ... [academic title (where applicable), name, national professional title, firm]

DEFENDANT:

... [name and postal address]

represented by ... [academic title (where applicable), name, national professional title, firm]

assisted by ... [academic title (where applicable), name, national professional title, firm]

PATENT AT ISSUE (data to be retrieved in databases of the EPO)

European patent n° ... [hereafter referred to by its last three digits, e.g. EP 789]

[or European patent with unitary effect n° ... [e.g. UP 789]

[or Supplementary protection certificate ... [e.g. SPC 789]

[or European patent application n° ... (e.g. EP application 789)]

PANEL/DIVISION

Panel [in divisions having more than one panel number of the panel: ...] of the Local [or: Regional] Division in ... [or: of the Central Division (Paris Seat) or: of the Central Division (Munich Section)]

DECIDING JUDGES [R. 351.1(c) RoP]:

[in case the panel is issuing the Order]

This Order has been issued by the presiding judge ..., the judge-rapporteur ..., the legally qualified judge ... and the technically qualified judge ... [when proceedings on the merits have been already started and a technically qualified judge has been allocated, R. 208.3, 33, 37.3 RoP, or where else such allocation took place]

[or: ... by the presiding judge..., the judge-rapporteur ... and the legally qualified judge ...]

[in case the single judge is issuing the decision]

This decision has been issued by the single judge

SUMMARY OF FACTS

[Free text]

STATEMENT OF FORMS OF ORDER SOUGHT BY THE APPLICANT

[For Optional standard text see below at "a) Order to preserve evidence and/or inspect premises without having heard the Defendant"]

The Applicant seeks

- detailed description of the allegedly infringing goods or process [Art. 60(2) UPCA; R. 192, 196.1(a) RoP]
 - with the taking of samples
 - without hearing the Defendant [Art. 60(5) UPCA, R. 197 RoP]
- physical seizure of the allegedly infringing goods [Art. 60(2) UPCA; R. 192, 196.1(b) RoP]

- without hearing the Defendant [Art. 60(5) UPCA; R. 197 RoP]
- physical seizure of the material and implements used in the production and / or distribution of the allegedly infringing goods and any related document [Art. 60(2) UPCA, R. 192, 196.1(c) RoP]
 - without hearing the Defendant [Art. 60(5) UPCA; R. 197]
- the preservation and disclosure of digital media and data relating to the aforementioned product, material, implement or process and the disclosure of any passwords necessary to access them [Art. 60(2) UPCA, R. 192, 196.1(d) RoP]
 - without hearing the Defendant [Art. 60(5) UPCA; R. 197]

and/or

- inspection of premises or local situations, products, devices, or methods *in situ* [Art. 60(3) UPCA, R. 199.1 RoP]
 - without hearing the Defendant [Art. 60(5) UPCA, R. 197, 199.2 RoP]

[If *inter partes*]

The Defendant seeks

- dismissal of the request for preservation of evidence and/or inspection
- ...

POINTS AT ISSUE

[Free text]

a) Order to preserve evidence and/or inspect premises without having heard the Defendant, Art. 60(5), R. 192.3, 197 RoP

GROUNDS FOR THE ORDER

[Optional standard text]

- This order was adopted without the Defendant having been heard since
 - any delay is likely to cause irreparable harm to the Applicant
 - there is a demonstrable risk of evidence being destroyed or otherwise ceasing to be available
 - ... [any other reason, as specified by the Applicant, R. 192.3 RoP, and found appropriate by the Court]
[Art. 60. 5 UPCA, R. 197 RoP]

ORDER [R. 351.1(e) RoP]

- In respect of an [imminent] infringement of claim ... [number of the claim] of European patent ... [number of the European patent] which reads as follows:

... [wording of the patent claim]

it is ordered

- to preserve evidence at Defendant's premises in ... [address of premises] by
 - detailed description of the product or process ...
 - with taking of sample ...
 - physical seizure of the product ...
 - physical seizure of materials and implements used in the production and/or distribution of products ...
 - the physical seizure or photocopy of documents relating thereto ...
 - the preservation by print, copy or photocopy and disclosure of digital media and data relating to the aforementioned product, material, implement or process ... , and the disclosure or any passwords necessary to access them ...
[Art. 60(2) UPCA, R. 196.1 RoP]
[... all to be specified by the Applicant and found appropriate by the Court]

[and/or]

- to inspect Defendant's premises or local situation in ... [address of premises or local situation]
 - in order to establish whether the manufacturing facilities located at these premises or this local situation of Defendant are/is suitable for carrying out the process protected in claim ... of European patent ... *[number of the aforementioned European patent]*
[... all to be specified by Applicant and found appropriate by the Court]

[and]

- to present a written Report to the Court on the measures to preserve evidence and/or the findings of the inspection of premises with regard to the [imminent] infringement of claim ... of European patent ... [number of the aforementioned European patent] [R. 196.4 RoP]
[as specified by the Applicant and found appropriate by the Court]

□ The written Report and any other outcome of the measures to preserve evidence or the inspection of premises may only be used in the proceedings on the merits of the case [R. 196.2, 199 RoP]

□ As person to carry out this order ... [name and address of a professional person or expert, who guarantees expertise, independence and impartiality or a bailiff or other qualified person, if appropriate and allowed under applicable national law] is appointed [Art. 60.3 UPCA, R. 196.4-5, 199 RoP].

[... as found appropriate by the Court; suggestions by Applicant allowed when the requirements as to expertise, independence and impartiality of the professional person, expert or bailiff or other qualified person and the requirements of the applicable law are observed]

- As person to assist ... [person appointed to carry out the order] ... [name and address of the person, that may be a bailiff or other qualified person to assist the aforementioned professional person or expert, if allowed under applicable national law] is appointed [R. 196.5, 199 RoP].
[... as found appropriate by the Court; suggestions by Applicant allowed when the requirements as to expertise, independence and impartiality of the assisting person and the requirements of the applicable national law are respected]
- As representative of Applicant ... [name and address of one or more independent professional practitioner(s) as representative(s) of the Applicant] is/are allowed to be present during the execution of this order with regard to the preservation of evidence and/or the inspection of Defendant's premises or local situations.
 - ... [name of aforementioned representative(s) of the Applicant] is/are obliged to keep secret facts which come to his/her/their knowledge in the course of the execution of this order and which concern the business operation of the Defendant, also from the Applicant and its employees [optional as specified by the Applicant and found appropriate by the court]
 - ... [any other optional condition specified by the Applicant and found appropriate by the Court, Art. 60.3 UPCA, R. 196.4, 199.2 RoP]
- The Applicant himself [if Applicant is a natural person] or an employee or director of the Applicant are not allowed to be present during the execution of this order with regard to the preservation of evidence and/or the inspection of Defendant's premises [R. 196.5, last sentence, 199.2 RoP].
- Defendant is ordered
 - to allow the person appointed to carry out this order
 - to enter the aforementioned premises or local situations of the Defendant, to preserve evidence or to inspect the premises or local situations as determined in the aforementioned order
 - to take photographs or films for documentary purposes relevant to the ordered preservation of evidence or to the inspection ordered and to use a dictation device for taking notes.
 - to hand over to the person appointed to carry out this order
 - the following documents in copy relating to the ordered preservation of evidence or to the ordered inspection ...

[... all to be specified by Applicant and found appropriate by the Court taking into consideration the law of the Contracting Member State where the order will be carried and, possibly, will have to be enforced, Art. 82(3) UPCA]

- Any failure to comply with this order may render the Defendant liable to pay to the Court a penalty [Art. 82(4) UPCA , R. 196.3 last sentence RoP] of ...
 - up to ... EUR [or]
 - EUR per item [or]
 - EUR per day for each day the Defendant fails to comply with this order
 - ...

- The Defendant shall be invited to comment on any confidentiality interests that he might have after the written expert Report has been submitted by the person appointed to carry out this order. Representatives of the Applicant that were allowed to be present during the preservation of evidence or inspection of Defendant's premises or local situations must be heard. The court will only then decide whether and to what extent the expert Report is brought to the attention of the Applicant and whether the secrecy order obliging Applicant's representative(s) is lifted. [Art. 60(1) UPCA, R. 196.1 last sentence RoP]

The measures to preserve evidence and/or inspect premises shall be revoked or otherwise cease to have effect, at the defendant's request, if the applicant does not bring action leading to a decision on the merits of the case before the Court within a period not exceeding 31 calendar days or 20 working days, whichever is longer, after the written expert Report has been disclosed to the Applicant or the Court has decided by a final decision not to give access to the Report. (Art. 60(8) UPCA, R. 198.1)

- This order is
 - immediately enforceable [R. 196.3 RoP; a certified translation of the order in the official language of the Contracting Member State in which the enforcement shall take place may be required by the law of that State or useful for practical reasons].
 - ...

- The order shall become effective only after security by deposit or bank guarantee in the amount of ... € has been provided by the Applicant in favour of the Defendant. [R. 196.3 and .6 RoP]

[The Court shall consider ordering a security especially in case of ex parte proceedings, R. 196.3 and 6 RoP]

- This order shall be served personally at ... [place] by ... [representative of applicant] together with a copy of the application for the present order including exhibits and other materials relied upon in the application immediately at the time of the execution of this order as well as the Notice of Provisional measures and instructions for access to proceedings (provided by the CMS) [R. 197.2; 275, 276.1 RoP]

INFORMATION ABOUT REVIEW [Art. 60(6) UPCA, R. 197.3 RoP] Defendant may request a review of the present order to preserve evidence within 30 days after the execution of the measures.

Appendix to the Order

- Where provisional measures are ordered without the Defendant having been heard (*ex parte*), the Defendant shall be given notice, without delay and at the latest immediately at the time of the execution of the measures (R. 197.2 RoP).
- An Order issued by the standing judge shall set out the procedure to be followed on the Application, (R. 194.4 RoP).

INSTRUCTIONS TO THE REGISTRY, THE PARTIES AND THE PERSON CARRYING OUT THE PRESENT ORDER

- Where the applicant requests orders without hearing the defendant, the application shall not be entered on the register until notice has been given pursuant to R. 197.2 RoP. [R. 192.3 last sentence RoP]

b) Order to bring the expert Report to the attention of the Applicant

GROUNDS FOR THE ORDER

[Free text]

After having heard Defendant and Representatives of the Applicant that were allowed to be present during the preservation of evidence or inspection of Defendant's premises or local situations ...

ORDER [R. 351.1(e) RoP]

- It is ordered that
 - the expert Report is brought to the attention of the Applicant and the secrecy order obliging Applicant's representative(s) is lifted. [or]
 - the expert Report may not be brought to the attention of the Applicant and the secrecy order obliging Applicant's representative(s) is kept. [or]
 - the following parts of the expert Report may not be brought to the attention of the Applicant and the secrecy order obliging Applicant's representative(s) is kept to that extent: ... [to be specified by the Applicant's representative(s) and deemed appropriate by the court]

In all other respects, the expert Report may be brought to the attention of the applicant and the secrecy order obliging the Applicant's representative(s) is kept.
[Art. 60(1) UPCA, R. 196.1 last sentence RoP]

INFORMATION ABOUT APPEAL [Art. 73(2)(a), 60 UPCA, R. 220.1(c), 224.2(b) RoP]

The Defendant may bring an appeal against the present Order within 15 days of service of this Order.

c) Order to summon the Applicant to an oral hearing without the presence of the Defendant, R. 194.1 c RoP

GROUNDS FOR THE ORDER

[Optional standard text]

- Having regard to the reasons for not hearing the Defendant set out by the Applicant
 - urgency of the action
 - delay likely to cause irreparable harm to the Applicant
 - demonstrable risk of evidence being destroyed or otherwise ceasing to be available [R. 194.2, 197.1, 199.2 RoP]

Order [R. 351.1(e) RoP]

- The Applicant is summoned to an oral hearing without the presence of the Defendant on ... [date]

Follow-up:

[In case the Court, after having conducted an oral hearing, decides to grant an order to preserve evidence and/or inspect premises:

- continue as in a) Order to preserve evidence and/or inspect premises without having heard the Defendant]

d) Order not to grant inspection and/or preservation of evidence, as requested, without having heard the Defendant, Art. 60(5), R. 192.3, 197 RoP

GROUNDS FOR THE ORDER

[Free text]

Order [R. 351.1(e) RoP]

- The Court will not decide on Applicant's request without hearing the Defendant.
- Applicant may withdraw the application and request that this order and the application and the contents of the application remain confidential by ... [date] [R. 194.5 and 6, 199.2 RoP].
In case the application will not have been withdrawn by Applicant within the aforementioned deadline the Court will inform the Defendant on the Application,

and invite him to lodge an Objection to the Application and summon the parties to an oral hearing.

[follow-up order in case the application has not been withdrawn within the deadline]

- The Court orders
 - the Defendant shall be invited to lodge by ... [date] an Objection to the Application [R. 194.1(a), 199.2 RoP]
 - the parties are summoned to an oral hearing on ... at ... [date, place] [R. 194.1(b), 199.2 RoP]

[The Court shall in particular consider summoning parties to an oral hearing if a relevant Protective letter has been filed by the Defendant (R. 194.6, 199.2 RoP).]

[In case the Court, after [or without having conducted] an oral hearing, decides to grant an order for inspection]

- [continue as in a) above.]

An Order issued by the standing judge shall set out the procedure to be followed on the Application, see R. 194.4, 209.3 RoP.

e) Order to preserve evidence and/or to inspect premises where the Applicant has not requested an order without having heard the Defendant [Art. 60(5), R. 192.3, 197, 199.2 RoP]

GROUNDS FOR THE ORDER

[Free text]

Order [R. 351.1(e) RoP]

Order to preserve evidence or to inspect premises

- [continue as in a) above.]

Dismissal of application to preserve evidence or to inspect premises

- The Application is dismissed.

INFORMATION ABOUT APPEAL [Art. 73(2)(a), 60 UPCA, R. 220.1(c), 224.2(b) RoP]

The adversely affected party may bring an appeal against the present Order within 15 days of service of this Order.

f) Order on the Defendant's request for a review of the order to preserve evidence and/or to inspect premises without having heard the Defendant (Art. 60(6) UPCA, R. 197.3 and 4, 199.2 RoP)

GROUNDS FOR THE ORDER [MANDATORY, R. 351.2 RoP]

[Optional standard text]

- The Court, on ... [date], has ordered to preserve evidence and/or to inspect premises without hearing the Defendant ...

ORDER (OPERATIVE PART) [ART. 60(6) UPCA, R. 351.1(e) RoP]

[Optional standard text]

- On Defendant's request the order of ... is
 - revoked
 - modified as follows ... In all other respects, Defendant's requests are dismissed.
- It is ordered that
 - ... [Persons to whom confidential information has been disclosed] are obliged to keep this information confidential [R. 197.4 sentence 2 RoP]
 - the seized products, materials, implements, documents, ... shall be returned to the respondent
 - ...
- Defendant's request is dismissed.
- Cost decision in principle [Art. 69 UPCA]

INFORMATION ABOUT APPEAL (Art. 73(2)(a), 60 UPCA, R. 220.1(c), 224.2(b) RoP)

The adversely affected party may bring an appeal against the present Order within 15 days of service of this Order.

g) Order to revoke or otherwise cease to have effect of an order to preserve evidence and/or to inspect premises, because the applicant has not started proceedings on the merits of the case as provided in Art. 62(5), Art. 60(8) UPCA, R. 213 RoP

FOUNDATIONS FOR THE ORDER [MANDATORY, R. 351.2 RoP]

[Optional standard text]

- Since the Applicant did not bring an action leading to a decision on the merits of the case before the Court within a period of
 - 31 calendar days or
 - 20 working days [must be amended after the expert Report has been disclosed to the Applicant].

ORDER (OPERATIVE PART) [ART. 60(8) UPCA, R. 351.1(e) RoP]

[Optional standard text]

- The order of ... is
 - revoked.
 - ... [otherwise ceased to have effect]
- Cost decision in principle [Art. 69 UPCA]

INFORMATION ABOUT APPEAL (Art. 73(2)(a), 60 UPCA, R. 220.1(c), 224.2(b) RoP)

The Applicant may bring an appeal against the present Order within 15 days of service of this Order.

Issued [in the Defendant's absence] on ... [R. 351.1(b) RoP]

NAMES AND SIGNATURES	
<p>Judges <i>[Art. 8 UPCA, Art. 35(5) UPCS]</i> <i>[if the application for provisional measures is lodged before proceedings on the merits have been commenced before the Court – full panel or one judge only should sign, R. 193.1, 17.2, 18, 194.3 and .4 RoP:]</i></p> <p>Presiding judge ... Legally qualified judge ... Legally qualified judge ...</p> <p><u>Or:</u> Presiding judge ...</p> <p><u>Or:</u> Legally qualified judge ...</p> <p><i>[if main proceedings have already been commenced before the Court – full panel or one judge only should sign, R. 193.2, 194.3 and .4 RoP:]</i></p> <p>Presiding judge ... Judge-rapporteur ... Legally qualified judge ... <i>[if allocated to the panel]</i> Technically qualified judge ...</p> <p><u>Or:</u> Presiding judge ...</p> <p><u>Or:</u> Legally qualified judge ...</p>	<p>Deputy-Registrar <i>[Art. 35(5) UPCS]</i></p> <p>Deputy Registrar ...</p>

INFORMATION ABOUT APPEAL

See above at applicable procedural scenario. The Information about appeal should always be added after the signatures.

Information about enforcement (Art. 82 UPCA, Art. Art. 37(2) UPCS, R. 118.8, 158.2, 354, 355.4 RoP)

An authentic copy of the enforceable decision or order will be issued by the Deputy-Registrar upon request of the enforcing party, R. 69 RegR.