



European IPR Helpdesk

Fact Sheet

Collection of evidence

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Introduction

The infringement of intellectual property (IP) rights through, among others, counterfeiting and piracy creates substantial losses to industry, as it undermines companies' investments in innovation and marketing.

Free-riding on the rights of others (e.g. trade marks, patents or designs) is illegal under European Union (EU) legislation and national legislations of the Member States. This legal framework provides the owners of IP rights - including individuals, SMEs or big corporations - the means to enforce their rights against infringers, that is, the means to stop infringements and to obtain economic compensation from such wrongdoings.

However, it is for IP rights owners to enforce their rights and chase infringers - they should not expect anyone else, such as national IP offices, to take this initiative on their behalf. In this sense, it is important to clarify that IP owners must have a very active role in the monitoring of infringements and the enforcement of their rights.

Collecting evidence to prove a given infringement is one of the first steps to be taken in the enforcement process. Solid evidence of the infringement is essential to prove (i) that the infringement has taken place, (ii) who the infringer is, and (iii) the damage suffered by the IP owner in order to quantify damages and compensation in the subsequent enforcement proceedings.

This Fact Sheet illustrates the importance of collecting evidence for the purposes of enforcing IP rights while providing an overview on the EU legislation which regulates collection of evidence, together with the most relevant and well-known methods and other important factors to take into account.

1. Evidence and intellectual property

Evidence is any proof which, according to the applicable laws, is provided by the parties in legal proceedings in order to demonstrate to the competent authority (e.g. the judge) certain facts that are essential to build up a case. Thus, parties to proceedings use evidence to prove what they believe is the truth and to, eventually, convince the deciding authority of the veracity or correctness of their version of the facts.

1.1. Types of evidence

Evidence can adopt different forms: documents, such as contracts or invoices; witness statements, known as affidavits; or objects, such as samples of the infringing goods. Evidence can be classified into two main categories: direct evidence and circumstantial evidence.

- **Direct evidence** proves or disproves an allegation of fact directly. The most well-known example of direct evidence is eyewitness testimony, where the witness describes what they saw.
- **Circumstantial or indirect evidence** consist of surrounding circumstances which prove or disprove an allegation of fact by connecting such circumstances with the fact in question. Some examples include objects or photographs.

1.2. Purpose of collecting evidence

In IP infringement cases, evidence plays a fundamental role in, among others, proving whether an infringement has taken place, who has committed the infringement, and the financial prejudice caused to the owner of the IP infringed. According to a report of the European Observatory on Counterfeiting and Piracy, “[i]n intellectual property cases, measures for obtaining, preserving and disclosing evidence are important tools that underpin the system for IP enforcement. Such evidence is required in order to **prove the infringement of IP rights; to identify individuals and entities that are responsible for the infringement or otherwise involved in the supply chain; to support claims for quickly bringing the infringement to an end; and to prove elements of a claim for compensation**”¹.

While evidence plays a fundamental role in proving the facts during infringement proceedings, both civil and criminal, it should be kept in mind that evidence is a tool to be used also before proceedings start. Informing an alleged infringer about the existence of certain incriminatory evidence in the context of a cease and desist letter² may have sufficient power to convince the alleged infringer of the fact that the IP owner in question has a strong case against them. As a result, the IP owner who uses evidence at this pre-contentious phase may be able to avoid going to court and achieve an early solution.

2. Regulation in the EU

Evidence needs to be in conformity with the applicable legislation and its interpretation by competent courts. The laws of the EU do not provide a harmonised regulation of the concept of evidence. In principle, it is for the laws of the Member States to regulate this matter and therefore, discrepancies may exist between what is admissible as evidence in one country to another.

Nevertheless, there are certain legislative instruments that harmonise certain aspects around this matter, in particular *Regulation 1206/2001 on cooperation*

¹ [Evidence and Right of Information in Intellectual Property Rights, European Observatory on Counterfeiting and Piracy \(2010\)](#).

² A cease and desist letter is a communication sent to the alleged infringer, asking them to put an end to a given infringing action. For further information, please, consult the European IPR Helpdesk Fact Sheet “IP enforcement: asserting your rights”.

*between the courts of the Member States in the taking of evidence in civil or commercial matters*³ and *Directive 2004/48/EC on the enforcement of intellectual property rights (IPRED)*⁴.

2.1 Directive 2004/48/EC (IPRED)

The EU Directive on the Civil Enforcement of Intellectual Property Rights (the “IP Enforcement Directive” or “IPRED”) requires all EU countries to apply **effective, dissuasive, and proportionate remedies and penalties against those engaged in counterfeiting and piracy**, and aims to create a level playing field for right holders in the EU. As a result, all Member States have a similar set of measures available for right holders to defend their IP rights but there are differences between the actual measures available due to variations in the law and practice of Member States.

The IPRED requires Member States to make certain measures available to right holders, including:

- (i) the ability to apply for an order compelling defendants to **disclose relevant material** (in some cases including samples of infringing product and financial records and documents): these materials may reveal information about the quantities of infringing products sold or distributed and the profits made by the infringer. This information is **crucial for calculating the damages or other compensation** to be claimed by the right holder to the relevant infringer.
- (ii) the ability to apply for **provisional measures** to preserve evidence: this allows right holders to prevent a potential destruction of the evidence by the infringer. Right holders can make this application for provisional measures **even without the infringing party being heard**, which is particularly useful considering that some types of evidence, such as digital documents, can be destroyed very quickly.
- (iii) the right to **obtain information**, from the infringer and third parties involved in the manufacture and distribution, regarding the **origin and distribution network of infringing items and infringing activities**: this information is essential to determine who are involved in the infringing activity in order to act against them, as well as to find out about the quantities infringed which, as explained above, is essential for the damages/compensation calculation.

In 2017, the European Commission adopted the Guidance Communication⁵ clarifying the provisions of IPRED where there have been differing interpretations

³ [Council Regulation \(EC\) No 1206/2001 of 28 May 2001 on cooperation between the courts of the Member States in the taking of evidence in civil or commercial matters.](#)

⁴ [Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights.](#)

⁵ [Communication from the Commission to the Institutions on Guidance on certain aspects of Directive 2004/48/EC of the European Parliament and of the Council on the enforcement of intellectual property rights.](#)

in EU countries. The guidance is based on rulings by the EU Court of Justice and best practice in Member States, and sheds some light on these differing interpretations, which might be related to its scope, rules on obtaining and preserving evidence, injunctions, or calculation of damages.

In particular, the European Commission recommends Member States:

- **Not to limit the disclosure of financial documents to commercial scale infringements** (as it is the case in some countries, such as Germany or Spain), and rather require defendants in all IP cases to disclose this type of evidence, which is actually essential to determine whether the infringement has a commercial scale or not.
- **Search and seizure orders** should be **available under national law in a simple, cost effective and expeditious manner**.
- **The provisions relating to search and seizure of computers should be updated**.
- **The right of information and data protection/data retention rules should be clarified** as, in some countries, right holders cannot obtain the identity of the infringer due to data protection rules which prevent disclosure of such data.
- There should be **general sanctions** for non-compliance with orders.

3. Methods

The success of an enforcement action depends on different factors, including the type of evidence provided by the right holder and the way in which the evidence has been collected. There are different ways of collecting evidence, including those below, and while some may seem fairly simple to execute, it is essential to know the legal specificities of enforcement actions in order to understand which method of collection of evidence is the most suitable and how it should be carried out. As a result, **it is essential to obtain professional advice**⁶ on the matter.

3.1 Monitoring

The great expansion of the internet in recent years has created both new opportunities and threats for businesses. As a result, companies should profit from these opportunities while keeping an eye on those infringers who try to take advantage of their success online.

Monitoring online infringements, which can be done thanks to the growing technologies available as well as the services of specialised companies, is an

⁶ For further information on how to find an IP professional, consult the European IPR Helpdesk Guide on "[10 steps to find a suitable IP professional](#)".

essential part of the IP enforcement strategy of any business⁷. In addition, the information gathered through this monitoring process has considerable intrinsic value as it may be used as evidence in the future. Therefore, it is highly recommended to draw all the profit from monitoring activities, thus storing any relevant information and data collected through the monitoring process in a systematic way so that it is easily available in case its use as evidence in the future becomes necessary.

3.2 Purchase

A most straightforward way of gathering evidence of counterfeited goods consists of **purchasing the allegedly counterfeited products** and using them as evidence together with any documents related to the sale, including purchase tickets and invoices. Nowadays, with the increasing popularity of online shopping, right holders should monitor online shopping websites as they have become the most common distribution channel of counterfeited goods. Gathering evidence from these sites is also recommended. Creating an account on the site where the counterfeited goods have been detected and purchasing a sample is a good way to gather evidence, while any documents related to the purchase, such as invoices and shipping documents, should be carefully kept to prove the origin of the goods (i.e. place of establishment of the seller) and the distribution channels.

This evidence may already be of use at a preliminary enforcement phase: copies of the relevant documents may be attached to cease and desist letters or to take-down notices. Using evidence at an early stage may reinforce the right holder's position and credibility, thus deterring the infringers from continuing the infringement.

3.3 Notarised purchase

A notarised purchase consists of a purchase where a notary public is present to certify that the purchase of a given product has taken place, where it has taken place (address of the seller's establishment), and when it has taken place. Notarised purchases are also possible when the goods are sold online. In this case, the right holder may purchase the goods online by himself and use the address of the notary public's office as a delivery address. The infringing goods will be received at the office of the notary, who will certify the purchase and reception of the goods.

While securing evidence through a notary public for the purposes of IP enforcement is usually not legally required in the EU, it may be advised in certain cases to provide extra support to the enforcement action. Notarised evidence has a high degree of certainty, which should be appreciated by the judge in charge of solving

⁷ For further information, please consult the European IPR Helpdesk Fact Sheet "IP enforcement: asserting your rights".

the dispute between the parties, due to the public faith certification provided by the notary public and, furthermore, is usually very complete and well-presented.

3.4 Enforcement raids and seizures

Enforcement raids and seizures consist of searches, which often take place by surprise. They are conducted by the police forces on the premises of the alleged infringer. The purpose of these raids consists of verifying that the alleged infringer is indeed in possession of the infringing goods, as well as confiscating the goods as evidence to be provided in the infringement proceedings.

Usually, this action requires the enforcer to file a criminal complaint and the competent authority to issue a warrant allowing the raid.

While enforcement raids and seizures are part of criminal proceedings, the evidence gathered may be used in civil proceedings to prove the infringement and to calculate damages and compensation.

3.5 At trade fairs

Trade fairs are mirrors of the market⁸ and therefore, a place to detect IP infringements. At trade fairs, right holders can obtain additional evidence to what they would obtain through the infringers' website or physical shops⁹.

Checking the online directory of exhibitors prior to a trade fair is highly advisable in order to prepare for possible action. Whenever infringing products at a trade fair are detected (i.e. as a result of checking the online directories, by monitoring the event for potential infringers or unintentionally at the trade fair), the right holder should collect evidence as one of the first measures to take in this situation. Such evidence can be collected by gathering brochures and catalogues at the concerned booth, by taking photographs¹⁰ of the infringing products at the booth of the infringer, and by placing a test order to purchase the infringing products. In case of doubt, it is useful to seek advice from the trade fair organiser on how to collect the evidence. Many exhibitions have a support scheme for such cases and provide advice or practical support.

This evidence may be used in subsequent legal proceedings, therefore it is essential to receive legal advice at this point, as not every piece of evidence has the same validity and relevance in front of a court.

Furthermore, the evidence gathered may also be of use immediately and even before the trade fair commences. However, gathering evidence during the set-up phase of the exhibition might be risky and it is possible that the evidence could

⁸ For further information on collection of evidence at trade fairs, consult the European IPR Helpdesk Fact Sheet on "[Intellectual property management at trade fairs](#)" and the Fact Sheet on "[IP considerations for trade fair organisers](#)".

⁹ This section has been developed in cooperation with the European Exhibition Industry Alliance and the European Major Exhibition Centres Association.

¹⁰ An official permit by the trade fair organisers may be required as photographing may be prohibited at the trade fair premises and the booth owner may take measures against this.

not be used later on. Therefore, if such a measure seems necessary, do seek advice from the trade fair organiser to obtain the relevant permission.

Trade fair organisers usually provide clauses in the general terms and conditions and stand contracts, and also offer advice and guidance in concrete cases, but usually cannot warn or exclude any exhibitor right away. Only right holders can take action. Remember that IP rights are territorial rights and that the rights claimed must always be protected in the country in which the exhibition takes place to allow for legal action. The above-mentioned seizures by public authorities, such as police or customs, may also be pursued during a trade fair and constitute an effective means to gather evidence, but however they entail a criminal claim.

4. Entrapment

Entrapment consists of a practice by means of which a law enforcer induces somebody into committing a crime which otherwise they would not have committed. In IP cases, this may happen when, for example, the law enforcer asks the infringer-to-be to do something that constitutes an infringement of IP in order to collect evidence to prove the infringement act. An example would be requesting an individual to provide an unlicensed copy of a software program, which constitutes copyright infringement. The infringer may, in these case, raise the so-called entrapment defence and such evidence may become inadmissible.

Conclusion

The enforcement of IP rights by their owners is essential in order to optimise the value of their IP assets. The process of enforcing and defending one's rights is a private matter for a business which has to be carefully and strategically considered.

Gathering evidence is an essential part of the enforcement process and IP owners must be aware of the different methods available and how the applicable laws assist them on this matter.

Finally, it is worth keeping in mind that although the threats posed by new technologies and avid infringers should not be underestimated, IP owners can and must benefit from today's technological revolution and related legal advancements as a weapon against those whose business model is based on riding on the rights of others.

Useful Resources

For further information, also see:

- Fact Sheet on "[IP enforcement: asserting your rights](#)"
- Fact Sheet on "[Defending and enforcing IP](#)"
- Fact Sheet on "[Intellectual property management at trade fairs](#)"
- Fact Sheet on "[IP considerations for trade fair organisers](#)"
- [*Evidence and Right of Information in Intellectual Property Rights, European Observatory on Counterfeiting and Piracy \(2010\).*](#)
- [Communication from the Commission to the Institutions on Guidance on certain aspects of Directive 2004/48/EC of the European Parliament and of the Council on the enforcement of intellectual property rights](#)

GET IN TOUCH

For comments, suggestions or further information, please contact

European IPR Helpdesk
c/o infeurope S.A.
62, rue Charles Martel
L-2134, Luxembourg

Email: service@iprhelphelpdesk.eu
Phone: +352 25 22 33 - 333
Fax: +352 25 22 33 - 334



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ABOUT THE EUROPEAN IPR HELPDESK

The European IPR Helpdesk aims at raising awareness of Intellectual Property (IP) and Intellectual Property Rights (IPR) by providing information, direct advice and training on IP and IPR matters to current and potential participants of EU funded projects. In addition, the European IPR Helpdesk provides IP support to EU SMEs negotiating or concluding transnational partnership agreements, especially through the Enterprise Europe Network. All services provided are free of charge.

Helpline: The Helpline service answers your IP queries within three working days. Please contact us via registration on our website – www.iprhelphelpdesk.eu – phone or fax.

Website: On our website you can find extensive information and helpful documents on different aspects of IPR and IP management, especially with regard to specific IP questions in the context of EU funded programmes.

Newsletter and Bulletin: Keep track of the latest news on IP and read expert articles and case studies by subscribing to our email newsletter and Bulletin.

Training: We have designed a training catalogue consisting of nine different modules. If you are interested in planning a session with us, simply send us an email at training@iprhelphelpdesk.eu.

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