OPINION OF ADVOCATE GENERAL KOKOTT delivered on 18 July 2007 [1]

I — Introduction

1. Italian law provides for an effective method for preserving and obtaining evidence to prove intellectual property right infringements. On an application by the holder of the right, the competent court may order — even before proceedings in the main claim are brought and on an ex parte basis — that a 'description' (descrizione) be obtained of the object giving rise to the alleged infringement. The description is performed by a bailiff, accompanied, where appropriate, by an expert, who inspects and documents the object and may seize documents and samples relevant thereto.

2. The Tribunale Civile di Genova (Civil District Court, Genoa, Italy) addressed a request for judicial assistance to the competent body in the United Kingdom, with a view to the latter taking evidence in respect of evidential material situated in the United Kingdom. The requested court refused to perform the request, however, on the ground that such measures were not in keeping with its practices.

3. By its reference for a preliminary ruling, the Tribunale now seeks clarification as to whether a measure such as that for obtaining a description of goods as provided for in Italian law may be categorised as the taking of evidence, the performance of which the court of one Member State may request of a court of another Member State, pursuant to 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. [2]

4. As is evident from the observations submitted by the Member States, different views exist in the national legal orders as to the requirements which apply to the taking of evidence and the role played by courts in that regard. Those circumstances result also

1 — Original language: German.

2 — OJ 2001 L 174, p. 1.

in diverging views on the scope of Regulation No 1206/2001, which falls to be interpreted for the first time by the Court in the present proceedings.

II — Legal framework

A — *International conventions*

5. The Hague Convention of 18 March 1970 on the Taking of evidence abroad in civil or commercial matters ('the Hague Evidence Convention') applies only as between 11 Member States of the European Union, including Italy and the United Kingdom. [3] Article 1 of the Hague Evidence Convention provides:

'In civil or commercial matters a judicial authority of a Contracting State may, in accordance with the provisions of the law of that State, request the competent authority of another Contracting State, by means of a Letter of Request, to obtain evidence, or to perform some other judicial act.

A Letter shall not be used to obtain evidence which is not intended for use in judicial proceedings, commenced or contemplated.

The expression "other judicial act" does not cover the service of judicial documents or the issuance of any process by which judgments or orders are executed or enforced, or orders for provisional or protective measures.'

6. Article 50 of the Agreement on trade-related aspects of intellectual property rights (TRIPs Agreement) [4] lays down the following rules concerning provisional measures in the event of intellectual property right infringements:

'1. The judicial authorities shall have the authority to order prompt and effective provisional measures:

(a) to prevent an infringement of any intellectual property right from occurring, and in particular to prevent the

3 — See the list of Contracting States of the Hague Conference on Private International Law available at 'www.hcch.net'.

4 — The TRIPs Agreement (Agreement on Trade-Related Aspects of Intellectual Property Rights) constitutes Annex 1C to the Agreement establishing the World Trade Organisation (WTO Agreement), approved on behalf of the Community, as regards matters within its competence, by Council Decision 94/800/EC of 22 December 1994 (OJ 1994 L 336, p. 1).

entry into the channels of commerce in their jurisdiction of goods, including imported goods immediately after customs clearance;

(b) to preserve relevant evidence in regard to the alleged infringement.

2. The judicial authorities shall have the authority to adopt provisional measures *inaudita altera parte* where appropriate, in particular where any delay is likely to cause irreparable harm to the right holder, or where there is a demonstrable risk of evidence being destroyed.

...'

B — *Community law*

7. Regulation No 1206/2001, [5] which in accordance with Article 21 thereof, in matters to which it applies, prevails over the Hague Evidence Convention, provides in Article 1 for the Regulation to have the following area of application:

'1. This Regulation shall apply in civil or commercial matters where the court of a Member State, in accordance with the provisions of the law of that State, requests:

(a) the competent court of another Member State to take evidence; or

(b) to take evidence directly in another Member State.

2. A request shall not be made to obtain evidence which is not intended for use in judicial proceedings, commenced or contemplated.

...'

5 — 'The United Kingdom and Ireland, in accordance with Article 3 of the Protocol on the position of the United Kingdom and Ireland annexed to the Treaty on the European Union and to the Treaty establishing the European Community, have given notice of their wish to take part in the adoption and application of this Regulation' (21st recital in the preamble to Regulation No 1206/2001).

8. Chapter II of that regulation governs transmission and execution of requests. The relevant provisions of that chapter are worded as follows:

'*Article 4*

Form and content of the request

1. The request shall be made using form A or, where appropriate, form I in the Annex. It shall contain the following details:

(a) the requesting and, where appropriate, the requested court;

(b) the names and addresses of the parties to the proceedings and their representatives, if any;

(c) the nature and subject-matter of the case and a brief statement of the facts;

(d) a description of the taking of evidence to be performed;

(e) where the request is for the examination of a person:

— the name(s) and address(es) of the person(s) to be examined,

— the questions to be put to the person(s) to be examined or a statement of the facts about which he is (they are) to be examined,

— where appropriate, a reference to a right to refuse to testify under the law of the Member State of the requesting court,

— any requirement that the examination is to be carried out under oath or affirmation in lieu thereof, and any special form to be used,

— where appropriate, any other information that the requesting court deems necessary;

(f) where the request is for any other form of taking of evidence, the documents or other objects to be inspected;

(g) where appropriate, any request pursuant to Article 10(3) and (4), and Articles 11 and 12 and any information necessary for the application thereof.

...

Article 7

Receipt of request

1. Within seven days of receipt of the request, the requested competent court shall send an acknowledgement of receipt to the requesting court using form B in the Annex. Where the request does not comply with the conditions laid down in Articles 5 and 6, the requested court shall enter a note to that effect in the acknowledgement of receipt.

2. Where the execution of a request made using form A in the Annex, which complies with the conditions laid down in Article 5, does not fall within the jurisdiction of the court to which it was transmitted, the latter shall forward the request to the competent court of its Member State and shall inform the requesting court thereof using form A in the Annex.

...

Article 10

General provisions on the execution of the request

...

2. The requested court shall execute the request in accordance with the law of its Member State.

3. The requesting court may call for the request to be executed in accordance with a special procedure provided for by the law of its Member State, using form A in the Annex. The requested court shall comply with such a requirement unless this procedure is incompatible with the law of the

Member State of the requested court or by reason of major practical difficulties. If the requested court does not comply with the requirement for one of these reasons it shall inform the requesting court using form E in the Annex.

...

Article 13

Coercive measures

Where necessary, in executing a request the requested court shall apply the appropriate coercive measures in the instances and to the extent as are provided for by the law of the Member State of the requested court for the execution of a request made for the same purpose by its national authorities or one of the parties concerned.

Article 14

Refusal to execute

...

2. In addition to the grounds referred to in paragraph 1, the execution of a request may be refused only if:

(a) the request does not fall within the scope of this Regulation as set out in Article 1; or

(b) the execution of the request under the law of the Member State of the requested court does not fall within the functions of the judiciary; or

...

3. Execution may not be refused by the requested court solely on the ground that under the law of its Member State a court of that Member State has exclusive jurisdiction over the subject matter of the action or that the law of that Member State would not admit the right of action on it.

...'

9. In addition, Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of

intellectual property rights,[6] which the Member States were required to transpose by 29 April 2006,[7] contains, in Chapter II, procedures and remedies for enforcing intellectual property rights. In that connection, Article 7 of the Directive provides as follows:

'1. Member States shall ensure that, even before the commencement of proceedings on the merits of the case, the competent judicial authorities may, on application by a party who has presented reasonably available evidence to support his/her claims that his/her intellectual property right has been infringed or is about to be infringed, order prompt and effective provisional measures to preserve relevant evidence in respect of the alleged infringement, subject to the protection of confidential information. Such measures may include the detailed description, with or without the taking of samples, or the physical seizure of the infringing goods, and, in appropriate cases, the materials and implements used in the production and/or distribution of these goods and the documents relating thereto. Those measures shall be taken, if necessary without the other party having been heard, in particular where any delay is likely to cause irreparable harm to the rightholder or where there is a demonstrable risk of evidence being destroyed.

Where measures to preserve evidence are adopted without the other party having been heard, the parties affected shall be given notice, without delay after the execution of the measures at the latest. A review, including a right to be heard, shall take place upon request of the parties affected with a view to deciding, within a reasonable period after the notification of the measures, whether the measures shall be modified, revoked or confirmed.

...'

C — *National law*

10. The Codice della Proprietà Industriale (Industrial Property Code, 'the CPI')[8] governs, inter alia, judicial protection of intellectual property. Article 128 of the CPI provides that the right holder may demand that a description (descrizione) of an infringing object be obtained. The description comprises evidence for the alleged infringement and the extent thereof. By way of an order not open to challenge, the judge who is competent to hear the substantive claim determines that a description is to be obtained. He adopts measures aimed at protecting confidential information and may authorise also the seizure of samples. The application may be heard on an ex parte

6 — OJ 2004 L 157, p. 45, corrigendum in OJ 2004 L 195, p. 16.

7 — See Article 20 of Directive 2004/48.

8 — Decreto Legislativo (legislative decree) No 30/05 of 10 February 2005.

basis in order to avoid prejudicing performance of the order. If the application for obtaining a description was made before the proceedings in the main claim were brought, the court sets a time-limit of 30 days at the most within which those proceedings are to be brought.

11. Under Article 129 of the CPI, the right holder may also apply for seizure of the infringing goods.

12. Article 130 of the CPI provides, inter alia, that description and seizure measures are to be performed by a bailiff — assisted by an expert, to the extent necessary — making use of technical equipment such as cameras and other tools. Authorisation may be given for the applicant, his representatives or designated technicians to be present during performance of the measures.

III — Facts and questions referred for a preliminary ruling

13. On 21 March 2005, Mr Alessandro Tedesco made an application to the Tribunale Civile di Genova for an order of description pursuant to Articles 128 and 130 of the CPI against the firms Tomasoni Fittings Srl ('Tomasoni'), established in Genoa, and RWO (Marine Equipment) Ltd ('RWO') established in Essex, United Kingdom.

14. He claimed to be the inventor of a harness system which he has protected by filing a patent application. RWO, which operates in Italy through the distributor Tomasoni, has, according to Mr Tedesco, marketed a harness system with identical technical features which is the subject of a patent application, filed after the application concerning his product.

15. On 5 May 2005, the Tribunale Civile di Genova ordered ex parte that a description be obtained of the products giving rise to the alleged infringement. First, a description was performed at the premises of Tomasoni in Italy. On 20 June 2005, acting on the basis of Regulation No 1206/2001, the Italian court sent a request to the office of the Senior Master of the Queen's Bench Division of the Supreme Court of England and Wales. The requested court was asked to perform a description of RWO's product at that firm's premises, in accordance with Italian law.

16. The description was to encompass also other evidence of the contested conduct, such as 'by way of example, however, not

exhaustively': invoices, delivery notes, payment orders, commercial offer letters, advertising material, computer archive data and customs documents. In addition, the Tribunale authorised the use of all technical means, the assistance of an expert and the removal of items as samples. Those actions were to be confined to the measures necessary for the investigation. The applicant, his lawyers and his technical advisors were denied access to the documents.

17. By way of an informal note, the Senior Master communicated his refusal to perform the request for description on the ground that search and seizure of goods and documents fell outside the practice of the agents of the Senior Master and that the matter could not be dealt with under the Letter of Request procedure.

18. By order of 14 March 2006, the Tribunale Civile di Genova referred the following questions to the Court of Justice for a preliminary ruling:

'(1) Is a request for obtaining a description of goods under Articles 128 and 130 of the Codice della Proprietà Industriale (Italian Code of Industrial and Intellectual Property), in accordance with the formal terms of the order made by this court in the present case, one of the forms of the taking of evidence prescribed by 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 and commercial matters by which the courts of one Member State may, on the basis of that regulation, request that the competent court of another Member State should itself take that evidence?

(2) If the answer to question 1 is yes and the request for obtaining a description is incomplete or fails to comply with the conditions under Article 4 of the regulation, is the court to which the request is made under an obligation to:

— send an acknowledgment of receipt in accordance with the conditions laid down by Article 7 of the regulation?

— indicate any respect in which the request may be incomplete so as to enable the requesting court to complete and/or amend its request?'

19. Before the Court, Mr Tedesco, the Italian, Finnish, Swedish, Slovenian, Greek and Spanish Governments, Ireland, the Government of the United Kingdom and the Commission of the European Communities submitted written and oral observations.

IV — Assessment

A — *Admissibility of the reference*

20. The reference submitted by the Tribunale Civile di Genova concerns questions on the interpretation of Regulation No 1206/2001 which was adopted on the basis of Article 61(c) EC and Article 67(1) EC. Under Article 68(1) EC, within the framework of Title IV of the EC Treaty references are admissible only from national courts against whose decisions there is no judicial remedy under national law. The Commission and the Spanish Government harbour doubts as to whether that is the case here.

21. According to the case-law on the third paragraph of Article 234 EC, the categorisation of a court as one against whose decisions there is no judicial remedy relies on a case-specific approach, that is to say, lower courts whose decisions in the particular proceedings cannot be challenged also constitute courts of last resort for the purposes of the third paragraph of Article 234 EC. [9] The obligation on national courts to refer is intended to ensure the uniform interpretation and application of Community law and, in particular, to prevent a body of national case-law that is not in accordance with the rules of Community law from coming into existence in any Member State. [10] That risk would exist even if, *in a specific case*, a court against whose decisions there was no judicial remedy were entitled to resolve in a definitive manner uncertainties on points of Community law without any obligation to refer the matter to the Court.

22. Those principles are all the more applicable within the framework of Article 68(1) EC, since in those circumstances only courts of last resort are entitled at all to make references for preliminary rulings to the court. In that regard, the problematic nature of the restriction reserving the right to refer to courts of last resort becomes apparent precisely in connection with Regulation No 1206/2001 governing judicial assistance in the taking of evidence. Findings of facts are typically the task of the lower courts and not of courts of last resort. For Regulation No 1206/2001 to be made in any way

9 — See Case 6/64 *Costa* v *ENEL* [1964] ECR 585; Case C-337/95 *Parfums Christian Dior* [1997] ECR I-6013, paragraph 25; and Case C-99/00 *Lyckeskog* [2002] ECR I-4839, paragraphs 14 and 15.

10 — *Lyckeskog*, cited in footnote 9, paragraph 15.

susceptible to interpretation by the Court, the concept of 'court against whose decisions there is no judicial remedy' within the meaning of Article 68(1) EC must not be interpreted too strictly. In particular, it is inappropriate to treat only the highest courts as being empowered to refer.

23. In the main proceedings, the Tribunale Civile di Genova granted an application for a description of goods. That procedure constitutes a measure aimed at preserving and/or obtaining evidence, imposed by way of an order which cannot be challenged. [11]

24. The Commission argues, however, that the procedure for ordering a description to be obtained has by way of execution — even if only partial — already been concluded by the court to which the request was made. The Tribunale has now moved on to the substantive claim, which will be determined by a judgment amenable to judicial remedy.

25. However, it must be observed that, to date, the request has not in fact resulted in evidence being preserved or obtained in the United Kingdom. The referring court considers the description of the taking of evidence to be clearly imperative. Before making a fresh request (or resuming the initial request) to the court in the United Kingdom, however, it wishes to obtain clarification as to whether a measure such as obtaining a description within the meaning of Articles 129 and 130 of the CPI falls within the scope of application of Regulation No 1206/2001.

26. Admittedly, it does not follow that every procedural measure which a court adopts as an order and which cannot be challenged makes that court one against whose decisions there is no judicial remedy for the purposes of Article 68(1) EC. Rather, that interim decision which is incapable of challenge must conclude an independent procedure or a particular stage of the proceedings and the question referred must concern precisely that procedure or stage of the proceedings.

27. To the extent that it can be determined from the case-file, obtaining the description of an infringing object constitutes a special procedure. That conclusion follows not least from the fact that an application for such measure may be made before proceedings in the main claim are brought. [12] The procedure for preserving and/or obtaining evidence is completed only when the description has in fact been obtained or when the court which made the order for description dispenses with the performance thereof, for example, for reasons of practical impossibility.

11 — Article 128(4) of the CPI.

12 — See Article 128(5) of the CPI.

28. The first question referred is intended precisely to clarify whether the description mechanism may be implemented through a request to a court of another Member State to take evidence on the basis of Regulation No 1206/2001. Accordingly, that question is closely connected to the separate procedure for preserving and/or obtaining evidence through description. Since that procedure is completed by way of an order which is incapable of challenge, the Tribunale is empowered to make a reference to the Court under the combined provisions of Article 68(1) EC and Article 234 EC. The first question referred is, therefore, admissible.

29. In my opinion, the second question referred is, however, inadmissible.

30. In accordance with settled case-law, in the context of the cooperation between the Court and the national courts provided for by Article 234 EC it is solely for the national court, before which the dispute has been brought and which must assume responsibility for the subsequent judicial decision, to determine in the light of the particular circumstances of the case both the need for a preliminary ruling in order to enable it to deliver judgment and the relevance of the questions which it submits to the Court. Consequently, where the questions submitted for a preliminary ruling concern the interpretation of Community law, the Court is, in principle, bound to give a ruling. [13]

31. However, the Court has also stated that, in exceptional circumstances, it is for the court to examine the conditions in which the case was referred to it by the national court, in order to assess whether it has jurisdiction. [14] It is settled case-law that a reference from a national court may be refused only where it is quite obvious that the interpretation of Community law sought by that court bears no relation to the facts of the main action or its purpose, or where the problem is hypothetical or the Court does not have before it the factual or legal material necessary to give a useful answer to the questions submitted to it. [15]

32. By its second question, the referring court seeks to clarify what obligations apply to the *requested* court if the request is incomplete or does not meet the requirements of Article 4 of Regulation No 1206/2001, in particular, whether it must send an acknowledgement of receipt within the period and in accordance with the

13 — See, inter alia, Case C-415/93 *Bosman* [1995] ECR I-4921, paragraph 59, and Joined Cases C-295/04 to C-298/04 *Manfredi and Others* [2006] ECR I-6619, paragraph 26.

14 — *Manfredi*, cited in footnote 13, paragraph 27.

15 — See, inter alia, *Bosman*, cited in footnote 13, paragraph 61, and Case C-344/04 *IATA and ELFAA* [2006] ECR I-403, paragraph 24.

requirements of Article 7 of that regulation and whether it must indicate any respects in which the request is incomplete.

33. The answer to that question has no bearing on the decision handed down by the referring court in the context of the procedure for preserving evidence. Rather, it concerns acts of the requested court alone. Should doubts exist as to the latter's obligations, it is a matter for that court, where necessary, to make a reference to the Court on the interpretation of Regulation No 1206/2001.

34. Not only is the second question irrelevant to the main proceedings, it also concerns a hypothetical situation. There is material in the case-file indicating that the requested court did in fact acknowledge receipt of the request within the prescribed period using form B.[16] There is nothing to indicate that the requested court would not duly acknowledge receipt of a new request. Nor is it evident that the earlier request or any future request was or will be incomplete such as to necessitate the request of supplementary information using form C.[17]

B — *The first question*

35. The first question must be interpreted in the light of the Senior Master's rejection of the request for judicial assistance. It must be concluded from the requested court's brief reply that it takes the view that the measure does not fall within the scope of application of the regulation.

36. The Senior Master's reply could also be interpreted also as relying on the ground of refusal set out in Article 14(2)(b) of Regulation No 1206/2001. According to that provision, execution of a request which, under the law of the Member State of the requested court, does not fall within the functions of the judiciary, may be refused. Since the Tribunale Civile di Genova called

16 — The United Kingdom Government includes form B, dated 11 July 2005, in Annex 2 to its observations. However, the Tribunale Civile di Genova does not mention that document in its order for reference, but indicates that receipt of the request was 'at least acknowledged [by the requested court] in its note of 20 September 2005'. Thus, the actual fate of form B remains uncertain.

17 — Where the reason for refusing to execute a request is the fact that the requested measure does not fall within the scope of Regulation No 1206/2001 — seemingly the view taken by the requested court — the Regulation provides, however, for the use of form H. That form may, however, also be used to communicate other grounds of refusal, for example, when the request does not fall within the functions of the judiciary. If a court considers itself prevented from taking evidence in accordance with a special procedure provided for by the law of the Member State of the requesting court (see Article 10(3) of Regulation No 1206/2001) the requesting court must be informed thereof using form E. Seemingly the English court to which the request was addressed did not make use of any of those forms.

for the request to be executed in accordance with a special procedure provided for by Italian law (Article 10(3) of the Regulation), [18] the proviso set out in the second sentence of Article 10(3) could, in addition, come into play.

37. In order to provide the national court with a useful answer to the first question, it is necessary to consider whether a request to obtain a description of an object allegedly infringing a patent including the search, documentation and/or removal of the relevant commercial documents and the seizure of samples falls within the scope of application of Regulation No 1206/2001 and, if so, whether one of the grounds for refusal listed precludes the execution thereof.

1. Scope of application of Regulation No 1206/2001

38. According to Article 1(1)(a) of Regulation No 1206/2001, that regulation must be applied in civil or commercial matters where the court of a Member State, in accordance with the provisions of the law of that State, requests the competent court of another Member State to take evidence. It further follows from Article 1(2) that the evidence which it is requested to take must be intended for use in judicial proceedings already commenced or contemplated.

39. I intend to consider below, first, the interpretation of the concept of taking evidence and then the particular circumstances and legal norms which are important in the context of judicial protection against infringement of intellectual property rights. Thereafter, I will examine the objections to the application of Regulation No 1206/2001.

(a) Interpretation of the concept of taking evidence

40. The expression 'to take evidence' within the meaning of Article 1(1)(a) of Regulation No 1206/2001 is not defined in any greater detail by the Community legislature.

18 — See form A, point 13 of the request, which is attached to the observations of the United Kingdom as Annex A 1.

41. In its case-law on the Brussels Convention [19] the Court has developed the principle that the Convention concepts must be interpreted independently. [20] As regards the definition, relevant for the scope of application of the concept of civil and commercial matters within the meaning of Article 1 of the Brussels Convention, the Court has held, inter alia, that, as far as possible, the rights and obligations which derive from the Brussels Convention for the Contracting States and the persons to whom it applies must be equal and uniform. Accordingly, the terms of that provision could not be interpreted as a mere reference to the internal law of one or other of the States concerned. [21]

42. The same considerations also apply by analogy to the concept of taking evidence, the interpretation of which is decisive for determining the scope of application of Regulation No 1206/2001. Therefore, its meaning and scope must be determined independently having regard to the wording, legislative history, scheme and purpose of the Regulation.

43. Regulation No 1206/2001 is intended to contribute to the proper functioning of the internal market by improving, notably by simplifying and accelerating, the cooperation between courts in the taking of evidence, in particular the simplification and acceleration thereof, as evidenced by the second recital in the preamble thereto. That aim is facilitated if the simplified mechanism for judicial assistance provided for by Regulation No 1206/2001 is applied to as many judicial measures for obtaining information as possible. Therefore, the concept of taking evidence should not be interpreted too strictly.

44. In that regard, it follows from the interaction of Article 1(1) and Article 4(1)(e) and (f) of Regulation No 1206/2001, first, that the subject-matter of a request to take evidence is not strictly limited to the taking of evidence. [22] Above all, requests are not limited to the hearing of witnesses.

19 — 1968 Brussels Convention on jurisdiction and the enforcement of judgments in civil and commercial matters (OJ 1972 L 299, p. 32) as amended by the Convention of Accession of 9 October 1978 of the Kingdom of Denmark, of Ireland and of the United Kingdom of Great Britain and Northern Ireland (OJ 1978 L 304, p. 1) and — amended text — p. 77) of 25 October 1982 on the accession of the Hellenic Republic (OJ 1982 L 388, p. 1) of 26 May 1989 on the accession of the Kingdom of Spain and the Portuguese Republic (OJ 1989 L 285, p. 1) and of 29 November 1996 on the accession of the Republic of Austria, the Republic of Finland and the Kingdom of Sweden (OJ 1997 C 15, p. 1) ('the Brussels Convention').

20 — See Case C-266/01 *Préservatrice foncière TIARD* [2003] ECR I-4867, paragraph 20, on the concept of 'civil and commercial matters' and Case C-265/02 *Frahuil* [2004] ECR I-1543, paragraph 22, on the concept of 'matters relating to a contract'. The Court has also applied that case-law in respect of Council Regulation (EC) No 44/2001 of 22 December 2000 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters (OJ 2001 L 12, p. 1); see Case C-103/05 *Reisch Montage* [2006] ECR I-6827, paragraph 29.

21 — *Préservatrice foncière TIARD*, cited in footnote 20, paragraph 20.

22 — The Commission, too, attaches a broad interpretation to the concept of evidence in its practice guide for the application of the regulation on the taking of evidence. It sets out that the concept of 'evidence' includes, for example, hearings of witnesses of fact, of the parties, of experts, the production of documents, verifications, establishment of facts, expertise on family or child welfare (see point 8 of the practice guide accessible at http://ec.europa.eu/civiljustice/evidence/evidence_ec_guide_en.pdf).

Rather, it follows from Article 4(1)(f) that the taking of evidence may include also documents or other objects which may be visually examined or inspected by experts. The possibility of obtaining expert evidence is confirmed, moreover, by the first indent of Article 18(2), which governs the reimbursement of fees paid for experts.

45. The objects which are listed in the measure of inquiry ordered by the Tribunale Civile di Genova, that is, examples of the harness system and the sales and purchase invoices, delivery notes, payment orders, commercial offer letters, advertising and promotional material, data stored in computer archives and relevant customs documents, constitute documents and/or objects which a court itself is capable of visually examining or which it may subject to expert analysis. Accordingly, the objects listed in the measure of inquiry are, in principle, liable to be the subject-matter of taking of evidence for the purpose of Regulation No 1206/2001.

(b) Preserving and obtaining evidence in cases of intellectual property right infringements

46. The reference for a preliminary ruling must be situated in the context of a request for judicial cooperation within the framework of a special procedure for preserving evidence in the case of an intellectual property right infringement. For those procedures, both at international level and under Community law, specific rules exist which take into consideration the particular requirements of right protection in that situation. Those rules must be taken into account in the broader interpretation of Regulation No 1206/2001.

47. The taking of evidence generally presupposes that the party with the burden of proof must specify the matter to be proved and the evidence to be adduced in support thereof. However, the holder of an intellectual property right who becomes aware of an infringement of his right is often faced with the difficulty of being unable to specify the evidence in support of the allegation or to have access to it, since it is in the possession of the party responsible for the infringement or a third party. Moreover, in most such cases urgency is of the essence in order to limit the harm arising from the infringement and to preserve the evidence before it can be compromised.

48. In order to ensure effective protection of intellectual property, therefore, Article 50 of the TRIPs Agreement grants courts the authority to order prompt and effective provisional measures both to prevent the

entry into circulation of infringing goods and to preserve evidence of an alleged infringement.

49. Article 7 of Directive 2004/48 builds on that provision of the TRIPs Agreement. [23] Under that provision, judicial authorities 'may ... order prompt and effective provisional measures to preserve relevant evidence in respect of the alleged infringement'. Those measures may 'include the detailed description, with or without the taking of samples, or the physical seizure of the infringing goods, and, in appropriate cases, the materials and implements used in the production and/or distribution of these goods and the documents relating thereto'.

50. In Italy, Article 128 et seq. of the CPI implements those requirements of the Directive in national law. Other Member States make use of similar instruments. [24] In the United Kingdom, section 7 of the Civil Procedure Act 1997, taken together with rule 25.1(1)(h), permits the issue of a search order. Those provisions codify the Anton Piller Order, [25] an instrument developed through the case-law. [26]

51. The provisions and aims of Directive 2004/48 ought to be taken into account in the interpretation of Regulation No 1206/2001 even though, according to the 11th recital in the preamble thereto, the Directive itself does not aim to establish harmonised rules for judicial cooperation. [27] There are, as is stated further in the recital mentioned, 'Community instruments which govern such matters in general terms and are, in principle, equally applicable to intellectual property'.

52. That consideration suggests that, in order to ensure effective protection of intellectual property rights also in cross-border situations, the possibility of judicial cooperation in accordance with Regulation No 1206/2001 ought to be available in procedures to preserve evidence provided for by Directive 2004/48.

23 — See the fourth, fifth and seventh recital in the preamble to Directive 2004/48. For a more in-depth discussion, see McGuire, 'Die neue Enforcement Directive 2004/48/EG und ihr Verhältnis zum TRIPS-Übereinkommen', *Österreichische Blätter für gewerblichen Rechtsschutz und Urheberrecht*, 2004, p. 255 and Ibbeken, A., *Das TRIPS-Übereinkommen und die vorgerichtliche Beweishilfe im gewerblichen Rechtsschutz*, Cologne, 2004.

24 — See, for example, in France the 'saisie-contrefaçon' provided for in Article L. 615-5 of the Code de la propriété intellectuelle (Intellectual Property Code). For a comparative study of German, French and English law, see Ibbeken, A., cited in footnote 23.

25 — See *Anton Piller KG* v *Manufacturing Processes Ltd* [1976] 1 All ER 779.

26 — See Zuckerman, A., *Zuckerman on Civil Procedure*, 2nd edition, London, 2006, point 14.175; for a detailed account of the development, see Ibbeken, A., cited in footnote 24, p. 111 et seq.

27 — Having regard to the facts of the main proceedings, however, account must be taken of the temporal scope of Directive 2004/48. It entered into force on 22 June 2004 and transposition was required by 29 April 2006 (see Articles 20 and 21 of Directive 2004/48). Before the period for transposition of a directive expires, only a limited obligation exists to have regard to its requirements (see Case C-212/04 *Adeneler and Others* [2006] ECR I-6057, paragraph 117 et seq.).

(c) Objections to the application of Regulation No 1206/2001

(i) Inapplicability of Regulation No 1206/2001 to orders for search and seizure?

53. Whilst most of the parties are in favour of applying Regulation No 1206/2001 to situations such as those in the present proceedings, the Greek Government, Ireland and the United Kingdom Government oppose the Regulation's application, arguing essentially as follows:

54. The United Kingdom Government argues that an order to obtain a description of goods includes orders for search and seizure which do not fall within the area of application of Regulation No 1206/2001. In its view, the taking of evidence must be distinguished from investigatory measures prior to the actual act of obtaining evidence. Moreover, the Regulation contains no provisions protecting the rights of the persons concerned in the event of search and seizure.

— Orders seeking a description of goods constitute orders for search and seizure which are not covered by the Regulation.

55. The taking of evidence consists of the sensory perception and appraisal of an item capable of constituting evidence. The testimony of a witness is heard, documents are read and other objects are examined. Judicial cooperation extends to all those acts, as is clear from Article 4(1)(e) and (f) of Regulation No 1206/2001.

— Like the Hague Evidence Convention, the Regulation does not cover provisional and protective measures.

— The application for the preserving measures sought must be made to an English court, on the basis of Regulation No 44/2001.

56. A precondition to the taking of evidence is that the court or a person authorised by the court, for example, an expert, possibly also a party's representative in the proceedings must have access to the evidence. An order to obtain the description of goods or a search order requires the holder of the evidence to grant access thereto. Such orders are therefore inextricably linked with the

taking of evidence. That is also the case where the court does not inspect the items on site, but engages another person to document the objects or to remove samples and the documentation (photocopies, photographs, data stored on relevant media or similar items) or the sample is produced directly to the court only at a later time.

57. Measures to preserve evidence also provide for protection of the rights of persons concerned. Within the framework of judicial cooperation, such orders are usually performed in accordance with the law of the Member State of the requested court (Article 10(2) of Regulation No 1206/2001). That ensures observance of the procedural standards in force in the place where the evidence is taken. Those standards protect the rights of the opposing party and the rights of third parties in possession of evidence.

58. If, exceptionally, the taking of evidence is performed in accordance with a special procedure provided for by the law of the Member State of the requesting court (Article 10(3) of Regulation No 1206/2001), the opposing party or third parties may find themselves confronted with a foreign procedural law in the place where the evidence is taken.

59. Measures for preserving evidence of an infringement of intellectual property rights have been harmonised, however, in Directive 2004/48. Assuming correct transposition of the Directive, the procedural laws of the Member States in this area are now liable to diverge from one another only to the extent that flexibility in the Directive's transposition is allowed. For the remainder, national laws must comply with principles of general application, such as, for example, the right to fair hearing and protection of home and property, as guaranteed by the European Convention for the Protection of Human Rights and Fundamental Freedoms (ECHR).

60. If the taking of evidence in accordance with the foreign procedural law should nevertheless prove to be incompatible with national law or impossible due to major practical difficulties, the only remaining solution is for the request to be dismissed (second sentence of Article 10(3) of Regulation No 1206/2001). As a less radical measure, however, the requested court must first attempt to execute the requested order in a modified manner, thereby observing the guarantees provided for by national law. [28]

61. Finally, I wish to point out that my foregoing observations relate to the situation

28 — For a more detailed discussion of this issue, see below in point 111.

in which the holder of the evidence co-operates voluntarily with the evidence-taking. It is only when the person concerned does not allow access to the evidence that coercive measures have to be taken, where appropriate, in order to take evidence. Under Article 13 of Regulation No 1206/2001, such interferences of a more serious nature affecting the rights of the person concerned are determined exclusively in accordance with the lex fori of the requested court.

62. Applying those considerations to the present case, that means that the English court must, in principle, perform the order for description as requested in accordance with to the special procedure provided for by Articles 128 and 130 of the CPI unless it puts forward any grounds for refusal. In that regard, the taking of evidence consists, first, in the documentation of the harness system and of the relevant documents and data. It may include also the removal of documents and objects to the extent necessary for appraisal by an expert or for production to the requested or requesting court for a direct examination of the evidence. Regard must be had throughout to the principle of proportionality.

63. In addition, Article 7 of Directive 2004/48 requires that protection of confidential information must be ensured. That obligation applies both to the requested and to the requesting court. Accordingly, whilst the Tribunale Civile di Genova did consent to the presence of the applicant and his representative in the proceedings during the taking of the description, it did not allow them to inspect the documents divulged and requested that the documents be dispatched in a sealed envelope. It is conceivable, for example, that the Tribunale would admit the sensitive commercial documents into the proceedings only where, on the basis of the documentation, it is convinced that a patent infringement exists. Only in that case is knowledge of the sales figures necessary in order to determine the extent of the loss.

64. If RWO does not voluntarily release the objects, Article 13 of Regulation No 1206/2001 allows for coercive measures. If English law allows for such and they are essential to the taking of evidence, a sample of the harness system, for example, could be seized.

65. Accordingly, it is incorrect to assert in such general terms that the measures requested by the Tribunale Civile di Genova, as search and seizure orders, do not fall within the scope of application of Regulation No 1206/2001.

(ii) Prohibition on pre-trial discovery

66. The reservations expressed by the United Kingdom Government concerning the

extension of judicial cooperation to cover measures for the preservation of evidence at a pre-trial stage are evidently connected to the issue of pre-trial discovery, repeatedly discussed within the framework of the Hague Conference. [29]

67. As a preliminary point, it must be borne in mind that, under Article 1(2) of Regulation No 1206/2001, a request to take evidence may not be made if the evidence is not *intended for use in judicial proceedings, commenced or contemplated.* The question of whether the request fully meets those requirements raises some doubt in the case of an order requiring a description to be obtained of other evidence of the contested conduct, including, by way of example but not exhaustively: invoices, delivery notes, payment orders, commercial offer letters, advertising material, computer archive data and customs documents.

68. Unlike the Hague Evidence Convention (Article 23), Regulation No 1206/2001 does not contain any explicit proviso with regard to pre-trial discovery. However, when Regulation No 1206/2001 was adopted, the Council issued the following Statement 54/01: [30] 'The scope of application of this Regulation shall not cover pre-trial discovery, including the so-called "fishing expeditions"'.

69. According to settled case-law, a statement in the Council minutes may be taken into account in the interpretation of a legal act inasmuch as its content is referred to also in the wording of the legal act and if it serves to clarify a general concept. [31] In the context of the present proceedings, the statement in the minutes clarifies the condition concerning the 'use of evidence in judicial proceedings, commenced or contemplated' within the meaning of Article 1(2) of Regulation No 1206/2001.

70. In that regard, the exclusion of pre-trial discovery referred to in the statement cannot be interpreted as precluding every procedure aimed at establishing facts prior to the bringing of proceedings in the main claim. That position is precluded by the wording of Article 1(2). Rather, the statement indicates

29 — The exact scope of that reservation under Article 23 of the Hague Evidence Convention has not been clarified definitively. Interpretation of the concept of pre-trial discovery has been the subject-matter of explanatory declarations made by the Contracting States and of several discussions at the Hague Conference (see *Conclusions and Recommendations adopted by the Special Commission on the practical operation of the Hague Apostille, Evidence and Service Conventions* (28 October to 4 November 2003), points 29 to 34, accessible at: http://hcch.e-vision.nl/upload/wop/lse_concl_e.pdf; see also Nagel, H., and Gottwald, P., *Internationales Zivilprozessrecht*, 6th edition, Cologne 2006, para. 8, point 68 et seq.). At issue, in principle, are measures permitted under the common law, especially American law, at a pre-trial stage for the purposes of obtaining information which is in the possession of the other party to the proceedings.

30 — See monthly summary of Council acts, Document No 10571/01, p. 16 of 4 July 2001.

31 — See Case C-292/89 *Antonissen* [1991] ECR I-745, paragraph 18; Case C-368/96 *Generics (UK) and Others* [1998] ECR I-7967, paragraphs 26 and 27; and Case C-402/03 *Skov and Bilka* [2006] ECR I-199, paragraph 42.

that the evidence must be described with a sufficient degree of precision that the link to the proceedings commenced or contemplated is evident and that the judicial cooperation may relate only to the items themselves which are capable of constituting proof and not to circumstances which are linked only indirectly to the judicial proceedings.

71. In order to prevent the other party to the proceedings from having to comply with excessive requests for discovery (so-called fishing expeditions), in the case of orders for the discovery of specific documents a distinction must be drawn in the following manner.

72. An order to produce documents is inadmissible if the documents whose discovery is sought lead only to the identification of items which are capable of serving as evidence but which do not in themselves serve an evidential function in the proceedings (a so-called 'train of enquiry' — the inadmissible search for material which may be relevant as evidence). In such cases, the evidence is used merely indirectly. Accordingly, the condition '[for] use in judicial proceedings' is not satisfied.

73. On the other hand, an order to produce documents which are discovered only upon execution of the order is admissible, if such documents are specified or described with sufficient precision and are directly linked to the subject-matter of the dispute. Only in this manner can the excessive gathering of material — to the detriment of the other party to the proceedings — going beyond the matter in dispute be avoided.

74. In the main proceedings, the order of the Italian court requiring a description to be obtained of the sales and purchase invoices, delivery notes, payment orders, commercial offer letters, advertising material, data stored in computer archives and customs documents, serves the purpose of discovery of that evidence. Using those documents, the plaintiff in the main proceedings intends to prove the existence of a patent infringement as such, the extent thereof and, accordingly, to quantify his damages claim. To the extent that that evidence is intended to be used in proceedings pending or contemplated, the request of the Italian court is admissible.

75. However, the passage in that order of the Italian court by which it requests further unspecified documents ('by way of example, however, not exhaustively') is inadmissible. What is lacking in that passage is a precise description of the other types of documents.

(iii) Delimitation of the taking of evidence and of provisional and protective measures

76. Unlike the other parties, the Greek Government, Ireland and the United Kingdom Government take the view that measures to obtain a description of goods, including the seizure of documents and removal of samples, constitute provisional and protective measures and not the taking of evidence within the meaning of Regulation No 1206/2001. That argument rests on two premises: first, that provisional and protective measures fall outside the scope of application of the Regulation and, second, that the measures to preserve evidence at issue in this case constitute such provisional and protective measures. I concur with the first premise but not with the second.

— Provisional and protective measures fall outside the scope of application of Regulation No 1206/2001

77. Prior to the adoption of Regulation No 1206/2001, the Hague Evidence Convention was essentially the basis for reference for judicial cooperation in the taking of evidence — at least between the Contracting States to the Convention which included, however, only 11 of the Member States. [32] The Regulation is intended to create a common basis for judicial cooperation throughout the whole Community (with the exception of Denmark) and to ensure the further simplification thereof. [33]

78. The initiative proposed by the Federal Republic of Germany with a view to adopting a Council regulation on cooperation between the courts of the Member States in the taking of evidence in civil and commercial matters [34] aligned its definition of the scope of application with the corresponding wording of Article 1 of the Hague Evidence Convention. Accordingly, the regulation was intended to apply to requests to obtain evidence or perform some other judicial act, except the service of judicial or extrajudicial documents and *provisional and protective measures*. [35] Such measures are, in fact, already covered by Council Regulation (EC) No 1348/2000 of 29 May 2000 on the service in the Member States of judicial

32 — See the sixth recital in the preamble to Regulation No 1206/2001.

33 — Berger, C., 'Die EG-Verordnung über die Zusammenarbeit der Gerichte auf dem Gebiet der Beweisaufnahme in Zivil- und Handelssachen (EuBVO)', *Praxis des Internationalen Privat- und Verfahrensrechts — IPRax* 2001, p. 522.

34 — OJ 2000 C 314, p. 1.

35 — The English translation of the German initiative — on which the Government of the United Kingdom relies — appears to be incorrect on this point, as the German passage 'Maßnahmen der Sicherung oder Vollstreckung' is reproduced as 'measures for the *preservation of evidence* or enforcement'. On the contrary, the French version, like the German original version, is aligned directly with the wording of the Hague Evidence Convention and speaks of 'mesures conservatoires ou d'exécution'. Following the same approach the English version should have read 'orders for provisional or protective measures'.

and extrajudicial documents in civil or commercial matters [36] and by the Brussels Convention, as mentioned in the seventh and eighth recitals in the preamble to the German initiative.

79. Unlike the initiative, Regulation No 1206/2001 dispenses with the inclusion of 'other judicial acts' in its scope of application and refers only to the taking of evidence. Accordingly, it is superfluous also expressly to exclude provisional or protective measures from the scope of application since they may be regarded only as other judicial acts but not as the taking of evidence. It is therefore correct to assert that provisional or protective measures fall outside the scope of application of the Regulation.

— Does a procedure for preserving evidence constitute a provisional or protective measure?

80. That does not mean, however, that the second premise may also be regarded as correct, namely, that a measure for preserving and obtaining evidence, such as the order for a description of goods sought in the main proceedings, constitutes a provisional or protective measure to which neither the Hague Evidence Convention nor Regulation No 1206/2001 — which builds thereupon — applies. Thus, the connection in terms of legislative history between Regulation No 1206/2001 and the Convention fails to be of any further assistance in delimiting the taking of evidence from provisional or protective measures.

81. Two types of provisional measures must be distinguished by reference to the aim pursued: orders aiming to secure the judgment itself, on the one hand, and measures for the preservation and obtaining of evidence, on the other, as may be illustrated by the example of the present proceedings before the Tribunale Civile di Genova.

82. If the plaintiff in the main proceedings is successful, the judgment will require the defendant to discontinue the rights infringement and, if necessary, to pay damages. An effective measure to secure the right to discontinuance consists in the seizure of the infringing goods or of the equipment used in the production thereof.

83. The present case, however, does not concern a measure of that kind, aimed at securing execution of the judgment at a later time, thus, for example, seizure of all existing stocks of the harness system in order to

36 — OJ 2000 L 160, p. 37.

prevent the distribution thereof. That measure would have had to have been based on Article 129 of the CPI. Instead, the referring court requested the English court to proceed with a measure for the preservation of evidence in accordance with Article 128 of the CPI.

84. Article 7 of Directive 2004/48, unfortunately, confuses those two types of provisional measure. By way of introduction, the provision refers, in fact, to measures for the preservation of evidence, under which are included, however, the physical seizure of the infringing goods, and, in appropriate cases, the materials and instruments used in the production and/or distribution of those goods and the documents relating thereto. As I have already explained, they are not really measures for the preservation of evidence, but rather provisional measures intended to secure the main claim.

85. A strict separation of the measures within the framework of Directive 2004/48 may well be unnecessary. It is, however, of considerable importance for the determination of the scope of application of Regulation No 1206/2001. The Regulation is wholly inapplicable to provisional measures aimed at securing the main claim, but does apply to measures for the preservation of evidence.

86. This understanding of the concept of provisional and protective measures is also confirmed by a schematic examination of the concept's function within the legislative context of the Hague Evidence Convention. The exclusion of such measures is intended to ensure in their scopes of application the mutual delimitation of that convention and the Brussels Convention. That objective expressly underlies the German initiative behind the Regulation. [37]

87. Inasmuch as the United Kingdom Government asserts that provisional and protective measures which fall within the scope of application of Regulation No 44/2001 must be excluded also from the concept of taking evidence within the meaning of Regulation No 1206/2001, since in that regard the same need for delimitation exists, that view must be upheld.

88. Ireland and the United Kingdom Government go further, however, arguing that the measures for the preservation of evidence at issue here could have been sought directly before an English court on the basis of Article 31 of Regulation No 44/2001, thereby excluding any recourse to Regulation No 1206/2001.

89. Article 31 of Regulation No 44/2001 provides, in a manner analogous to Article 24 of the Brussels Convention, that 'application may be made to the courts of a Member

37 — See the seventh and eight recitals in the preamble to the initiative.

State for such provisional, including protective, measures as may be available under the law of that State, even if, under this Regulation, the courts of another Member State have jurisdiction as to the substance of the matter'.

90. In *St. Paul Dairy Industries,* the Court held that Article 24 of the Brussels Convention did not apply to independent measures for obtaining and preserving evidence prior to the commencement of proceedings. [38]

91. In support of that conclusion, the Court held, inter alia, that the expression 'provisional measures' within the meaning of Article 24 of the Brussels Convention is to be understood as referring to measures which, in matters within the scope of the Convention, are intended to preserve a factual or legal situation so as to safeguard rights the recognition of which is otherwise sought from the court having jurisdiction as to the substance of the case. [39] Thus, that provision applies to measures which are intended to preserve the substantive claim in law, not, however, to the performance of procedural measures such as the taking of evidence. [40]

92. Moreover, the Court pointed to the risk that the rules on judicial cooperation in the taking of evidence set out in Regulation No 1206/2001 could be circumvented if, on the basis of Article 24 of the Brussels Convention, measures for the taking of evidence could be sought directly before a court not having jurisdiction as to the substance of the case. [41] The Court thus indicated implicitly that independent measures for preserving and obtaining evidence must be characterised as the taking of evidence within the meaning of Regulation No 1206/2001.

93. Thus, in the light of the Court's case-law, the possibility, based on Article 31 of Regulation No 44/2001, of having evidence preserved directly by a court in the place in which the evidence is situated, considered by Ireland and the United Kingdom to be the preferred approach, cannot be entertained. [42] Accordingly, nor does any problem of delimitation arise if measures for the pre-

38 — Case C-104/03 *St. Paul Dairy Industries* [2005] ECR I-3481, paragraph 25. See also Geimer, R., and Schütze, R.A., *Europäisches Zivilverfahrensrecht,* 2nd edition, Munich, 2004, section A 1 — Article 2 of Regulation No 44/2001, point 92, and Article 31 of Regulation No 44/2001, point 32.

39 — *St. Paul Dairy Industries*, cited in footnote 38, paragraph 13.

40 — In the same vein, see *CFEM Facades SA* v *Bovis Construction Ltd* [1992] I.L. Pr. 561 QBD and Schlosser, P., *EU-Zivilprozessrecht,* 2nd edition, Munich, 2003, Article 32 of Regulation No 44/2001, point 7 and Article 1 of the Hague Evidence Convention, point 4.

41 — *St. Paul Dairy Industries*, cited in footnote 38, paragraph 23.

42 — One can certainly discuss whether the applicant ought not to have the option of both possibilities, the taking of evidence by means of judicial cooperation or the taking of evidence by a court in the place in which the evidence is situated. The second route might possibly be more swift, but is subject to the risk that the evidence gathered abroad is not recognised by the court with jurisdiction as to the substance of the case. (For views critical of the Court's approach, see, for example: Mankowski, P., 'Selbständige Beweisverfahren und einstweiliger Rechtsschutz in Europa', *Juristenzeitung* 2005, p. 1144 and Hess B., and Zhou, C., 'Beweissicherung und Beweisbeschaffung im europäischen Justizraum', *Praxis des Internationalen Privat- und Verfahrensrechts — IPRax* 2007, p. 183). Irrespective of whether and, if so, under what circumstances, application of the Brussels Convention or Regulation No 44/2001 to independent procedures for obtaining evidence is desirable, the authors cited do not question the fact that in all cases those procedures are governed by Regulation No 1206/2001.

servation of evidence are considered to be cases to which Regulation No 1206/2001 applies. Rather, the exclusion of such measures from the area of application of Regulation No 44/2001 requires precisely the existence of judicial cooperation in accordance with Regulation No 1206/2001 in order to permit the preservation of evidence in another Member State on the basis of Community law.

(d) Interim conclusion

94. Thus, by way of interim conclusion, it may be observed that the description of goods within the meaning of Articles 128 and 130 of the CPI, the performance of which is sought by the Tribunale Civile di Genova, constitutes a measure for the taking of evidence in accordance with Article 1 of Regulation No 1206/2001. The requested court ought to perform that request, provided that the measures are described with adequate precision such that the link between the evidence to be taken and the proceedings (where applicable, contemplated) can be identified and no grounds for refusal exist.

2. Grounds for refusal

95. Article 14 of Regulation No 1206/2001 governs the grounds on which the requested court may refuse to perform a request. According to Article 14(2)(a) the requested court may refuse to execute a request, in particular, if the request does not fall within the area of application of the Regulation as set out in Article 1. In the present case, however, the subject-matter falls within the Regulation's area of application, as I have set out above. Furthermore, execution of a request may be refused on the basis of Article 14(2)(b) if, under the law of the Member State of the requested court, such execution does not fall within the functions of the judiciary.

96. The second sentence of Article 10(3) of Regulation No 1206/2001 contains, in addition, a public policy proviso which applies to requests which are to be executed in accordance with the law of the requesting court. The referring court made use of that possibility in requesting that a description of goods be performed in accordance with Articles 129 and 130 of the CPI. In general, the requested court must comply with such a requirement, too, unless that procedure is incompatible with the law of the Member State where it is situated or due to major practical difficulties.

97. Both possibilities for refusal make reference to the requirements of the law of the Member State of the requested court. The Court may not interpret those national provisions with a view to determining what powers the judiciary possesses under

national law or what forms of taking evidence are incompatible with national law or cannot be performed for practical reasons. Those are questions for the requested court to determine.

98. It follows from the Court's case-law, however, that where a Community provision refers to national legislation and practice, Member States cannot adopt measures likely to frustrate the objective of the Community legislation of which that provision forms part. [43] The Regulation imposes external limits on the national legislatures' freedom which may be exceeded if the national law in question undermines the practical effectiveness of the Regulation. In that context, it is incumbent on the Court to interpret the Regulation with a view to ensuring observance of those limits.

99. In that regard, it should be borne in mind, as a general guideline, that in order to secure the effectiveness of the Regulation the possibility of refusing to execute the request for the taking of evidence should be restricted to narrowly-defined exceptional situations, as mentioned the 11th recital in the preamble to Regulation No 1206/2001.

100. According to the United Kingdom Government, the requested court rejected the request because it did fall outside the scope of application of Regulation No 1206/2001. The requested court did not rely on any possible grounds of refusal. [44] However, the United Kingdom takes the view, also shared by Ireland, that in any event performance of the requested measures also falls outside the functions of the English judiciary.

101. They argue that under the common law, obtaining evidence is not a task for the court or judicial agencies. Rather, the parties themselves must obtain the evidence. Whilst the supervising solicitor who, under section 7 of the Civil Procedure Act 1997, serves and performs a search order, is an officer of the court, he is not, however, a court agent.

102. By contrast, in response to a question from the Court, the Swedish and Finnish Governments and the Commission put the argument — in my view, correctly — that a distinction must be drawn between *ordering* a measure for evidence to be taken and the *performance* thereof. Execution of a request to obtain evidence cannot be refused simply on the basis that performance of certain

43 — Case C-385/05 *CGT* [2007] ECR I-611, paragraph 35, which refers to Case C-151/02 *Jaeger* [2003] ECR I-8389, paragraph 59.

44 — That view is supported by the fact that the requested court returned the request without making use of form E or H.

forms of taking evidence does not fall within the scope of judicial activities. The decisive factor, however, is that courts are entitled to order the requested measures. Section 7 of the Civil Procedure Act 1997, taken together with Part 25 of the Civil Procedure Rules, appears, in principle, to grant English courts the appropriate powers. [45]

103. Moreover, as the Commission correctly points out, nor is it an imperative requirement that judicial functions may be exercised only by persons who, in organisational terms, are part of the court system. A supervising solicitor who is engaged by the court — albeit on the application of a party — to ensure the proper service and performance of a search order may be regarded also as exercising judicial functions. That view is supported by the fact only certain particularly experienced solicitors are entrusted with this function. [46] Moreover, in order to ensure the necessary neutrality in the execution of their task, they are not permitted to belong to the same firm of solicitors as the applicant's legal representative. [47]

45 — It appears that, in practice, the courts' use of this instrument is somewhat sparing. It is seemingly more usual to require disclosure by the parties themselves of the documents and items in their possession. Only where the disclosure procedure is deemed inadequate for the preservation of evidence does the issuance of a search order fall to be considered (see Zuckerman, *Zuckerman on Civil Procedure*, 2nd edition, London, 2006, point 14.177).

46 — Practice Direction 25 — Interim injunctions, paragraph 7.2.

47 — Practice Direction 25 — Interim injunctions, paragraph 7.6.

104. Were only the taking of evidence as performed by the court itself to be treated as falling within the ambit of judicial functions, the practical effectiveness of the Regulation would be excessively impeded. Such an interpretation would also preclude, for example, the obtaining of expert reports which, likewise, are not drawn up by the court itself, but by an expert.

105. Accordingly, refusal to perform cannot be justified by the lack of judicial power in a situation where a measure for the preservation of evidence, such as an order for description of goods within the meaning of Articles 128 and 130 of the CPI, in accordance with the law of the requested Member State, is not performed by the court itself but by an independent institution of the justice system (officer of the court) engaged by the court.

106. The objection that, under the common law, responsibility for obtaining evidence lies with the parties could be regarded also as a reference to the proviso set out in the second sentence of Article 10(3) of Regulation No 1206/2001. Under that proviso, the requested court may refuse the performance of a request in accordance with a procedure provided for by the law of the State of the requesting court if that procedure is incompatible with the law of the Member State where it is situated or due to major practical difficulties.

107. In that regard, it must be observed, first, that such a proviso does not come into

play simply because the requested foreign law measure does not correspond exactly with domestic law and national practice. [48] Otherwise Article 10(3) of Regulation No 1206/2001 would be deprived of all practical effect. To that extent, the wording of the Regulation's proviso is of an expressly more limited nature than Article 9(2) of the Hague Evidence Convention, which permits refusal in cases where the request to take evidence in accordance with a special procedure does not comply with internal practice in the requested State.

108. Instead, the requested court must, first, make all possible efforts, as far as the available means permit, to put into practice the measure governed by the law of the requesting State.

109. In that regard, account must be taken of the fact that the essence of judicial cooperation under Regulation No 1206/2001 consists in the possibility for a court of one Member State directly to approach the court of another Member State with a request to take evidence. Judicial cooperation may not be rendered excessively difficult by imposing too broad an obligation on the parties to the proceedings before the requesting court when taking evidence in the State of the requested court. [49]

110. Moreover, under Article 18(1) of Regulation No 1206/2001, in principle, no taxes and costs may be claimed for the execution of a request. Under Article 18(2), the requested court may require merely the reimbursement of fees paid to experts and interpreters and the costs occasioned by the taking of evidence according to a special procedure under Article 10(3) and (4).

111. If it proves impossible due to conflicting provisions of domestic law or major practical difficulties to carry out the foreign law request according to the letter, the request may not simply be returned unexecuted in its entirety. Rather, according to the required interpretation of Regulation No 1206/2001, which favours judicial cooperation, the requested court must perform the measure sought in a modified manner so as to comply with domestic law requirements. [50] Where even that approach is impossible, there remains the possibility of applying an analogous procedure in accordance with domestic law. [51]

48 — See Rauscher, T., and v. Hein, J., *Europäisches Zivilprozessrecht*, 2nd edition, Munich, 2006, Article 10 of Regulation No 1206/2001, point 13.

49 — Where witnesses are examined pursuant to a request for judicial assistance under Regulation No 1206/2001, Practice Direction 34 — Depositions and Court Attendance by Witnesses, paragraph 11.3, for example, provides expressly for the Treasury Solicitor to assume the applicant's role before the requested court. On that point see also Layton and Mercer, *European Civil Practice*, 2nd edition, London, 2004, point 7.062.

50 — See Rauscher T., and v. Hein, J., cited in footnote 48, Article 10 of Regulation No 1206/2001, point 22 et seq.

51 — See Huber, S., in: Gebauer, M., and Wiedmann, T., *Zivilrecht unter Europäischem Einfluss*, Stuttgart, 2005, Chapter 29, point 133.

112. At the present stage of the proceedings, however, the Court is not called upon to deliver a definitive interpretation on the relevant provisions of the Regulation setting out possible grounds of refusal or provisos. Instead, it is a matter, first, for the requested court to address those questions. Should it harbour doubts as to the ambit of the provisions it is entitled and required, as a court of last resort, to make a reference to the Court, which could then, having knowledge of the legal and factual situation, adopt a more specific position on the interpretation of Article 14(2)(b) and Article 10(3) of Regulation No 1206/2001.

V — Conclusion

113. In the light of the foregoing analysis, I propose that the Court should answer the first question of the Tribunale Civile di Genova as follows:

'Measures for the preservation and obtaining of evidence such as an order for the description of goods in accordance with Articles 128 and 130 of the Italian Codice della Proprietà Industriale constitute measures for the taking of evidence which, in accordance with Article 1 of 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, fall within the scope of application thereof and which at the request of the court of one Member State a court of another Member State must execute, unless grounds for refusal exist.'