



## WHITE PAPER

June 2025

### Orders to Preserve Evidence (“*Saisies*”) at the Unified Patent Court: Two-Year Roundup and Early Insights

Evidence is a key battleground in virtually all patent litigation cases. As a Court designed to combine the best and most efficient features of the main EU national patent litigation systems, the Unified Patent Court (“UPC”) logically includes the possibility to request and perform infringement seizures—also called “*saisies*,” “dawn raids,” or “orders to preserve evidence”—in order to search for and secure evidence of alleged acts of infringement in virtually any location and against any party, under conditions that draw heavily from the French “*saisie-contrefaçon*” and the Italian “*descrizione*.” Two years after the entry into force of the UPC in June 2023, a critical mass of *saisie* orders have been issued, the study of which provides valuable insights on the best practices and issues at stake for litigants at both ends.

## TABLE OF CONTENTS

|  |           |
|--|-----------|
| <b>DETAILED ANALYSIS AND INSIGHTS</b>                              | <b>2</b>  |
| <i>Saisie</i> vs. Inspection                                       | 2         |
| <i>Ex Parte</i> vs. <i>Inter Partes</i> : A Low Threshold          | 3         |
| Urgency  | 4         |
| Main Requirements: <i>Prima Facie</i> Evidence and Proportionality | 5         |
| Proportionality/Balance of Interests                               | 6         |
| Patent Validity  | 7         |
| Duration of <i>Saisie</i> Request Proceedings                      | 7         |
| Location/Seized Party(ies)   | 8         |
| Attendees  | 9         |
| Deadline for the Execution of the <i>Saisie</i>                    | 9         |
| Execution of the <i>Saisie</i> / Search Measures Granted           | 10        |
| <i>Saisie</i> Report   | 10        |
| Deadline for the Subsequent Action on the Merits                   | 11        |
| Security   | 11        |
| Defending a <i>Saisie</i>  | 11        |
| <b>CONCLUSIONS</b>   | <b>11</b> |
| <b>LAWYER CONTACTS</b>   | <b>12</b> |

While the concept of “inspection proceedings” in cases of unclear infringement is already well-known and practiced in several UPC member states (e.g., German ‘*Besichtigung*’, Dutch ‘*bewijsbeslag*’), the concept of performing an unannounced “*saisie*” in order to secure evidence in view of an action on the merits is more specific to the French, Belgian and Italian legal traditions. The latter option is however now available in the UPC and can be performed in any participating Member State.

The early infringement seizure orders and proceedings show that UPC *saisies* are gaining momentum and are being increasingly used by litigants to support cases, including before UPC divisions and judges previously less familiar with *saisies* (Munich, Copenhagen, The Hague). These first proceedings confirm that *saisies* authorizations can be obtained relatively easily at the UPC, when needed, through *ex parte* proceedings that are usually handled by the court within a matter of days, and that the scope of permissible search measures is very broad, subject to sufficient substantiation within the *saisie* request as to why each measure is required. Despite this overall ease of access, these proceedings highlight the importance of a thoroughly reasoned request to meet all of the court’s standards, particularly concerning *prima facie* evidence of the alleged infringement, urgency and proportionality. Finally, they also demonstrate the need for patentees to pay close attention to the execution of the *saisie* including assembling an efficient and strategic team of attendees (usually a bailiff, a patent attorney and a computer forensics expert), to the conditions under which they will gain access to the *saisie* report and evidence, and to the aftermath of the *saisie* (deadlines for initiating subsequent proceedings on the merits, potential requests for review, etc.).

Once all local and regional UPC divisions become familiar with *saisies* under the UPC Rules of Procedure—a development likely spurred by the early pioneering orders already issued and discussed below—they could become an important feature of UPC litigation practice and act as a “gold standard” among other means of gathering evidence (forced production of evidence, right to information, affidavits, hearing of witnesses) some of which are subject to stricter requirements under the UPC’s current case law.

## ROUNDUP OF UPC SAISIE PROCEEDINGS

During the first two years of the UPC, at least 17 cases have involved a *saisie* request (though the actual number may be higher considering *saisies* requests that were withdrawn by the applicant, denied by the court without publication, or arose in the context of proceedings that are not yet public), i.e.:

Fourteen cases in which one or several *saisie* orders have been granted *ex parte*:

1. **Milan** LD, 13-14 June 2023, *Oerlikon Textile v. Himson Engineering, Bhagat Group* (UPC\_CFI\_240-241/2023)
2. **Brussels** LD, 21 September 2023, *Jozef Frans Nelissen v. OrthoApnea S.L.* (UPC\_CFI\_329/2023)
3. **Milan** LD, 25 September 2023, *Progress Maschinen & Automation v. AWM and Schnell* (UPC\_CFI\_286-287/2023)
4. **Paris** LD, 14 November 2023, *C-Kore System Limited v. Novawell* (UPC\_CFI\_397/2023)
5. **Copenhagen** LD, 26 August 2024, *Hybridgenerator ApS v. HGSystem ApS, Infotech Concept ApS, Rune Eilertsen* (UPC\_CFI\_492/2024)
6. **Milan** LD, 11 September 2024, *Primetals Technologies Austria GmbH v. Danieli & C. S.P.A., Danieli Automation S.P.A.* (UPC\_CFI\_337/2024)
7. **The Hague** LD, 25 September 2024, *Data Detection Technologies Ltd v. Doytec Automation Ltd* (UPC\_CFI\_554/2024)
8. **Düsseldorf** LD, 18 October 2024, *Bekaert Binjiang Steel Cord v. Siltronic, Hinterberger* (UPC\_CFI\_539/2024)
9. **Paris** LD, 23 December 2024, *Tiru v. Valinea Energie, Maguin* (UPC\_CFI\_813-814/2024)
10. **The Hague** LD, 22 January 2025, *Mammoet Holding B.V. v. P.T.S. Machinery B.V.* (UPC\_CFI\_16/2025)
11. **Munich** LD, 3 February 2025, *Nanoval GmbH v. ALD Vacuum Technologies GmbH* (UPC\_CFI\_63/2025)
12. **Milan** LD, 18 March 2025, *Prinoth Spa v. Xelom Srl* (UPC\_CFI\_127/2025)
13. **Düsseldorf** LD, 26 March 2025, *OTEC Präzisionsfinish GmbH v. Steros GPA Innovative* (UPC\_CFI\_260/2025)
14. **Milan** LD, 19 May 2025, *3V Sigma S.p.A. v. A.G.A. S.r.l., ACEF S.r.l.* (UPC\_CFI\_342/2025)(order not yet publicly available)

One *ex parte* case in which the *saisie* request was denied:

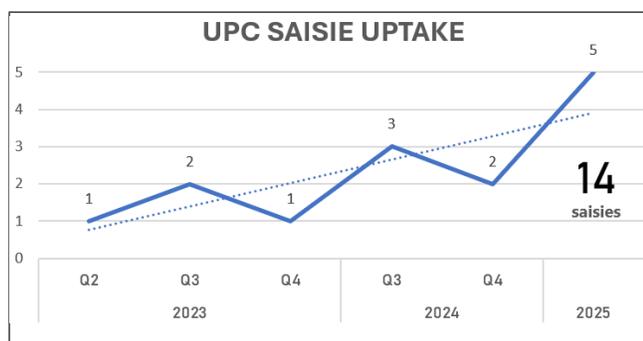
15. **Mannheim** LD, 3 March 2025, *Centripetal Limited v. Palo Alto Networks, Inc.* (UPC\_CFI\_142/2025)

Two cases concerning *inter partes* proceedings, in which either the *saisie* request was denied or withdrawn:

16. **Munich** LD, *Swarco Futurit Verkehrssignalsysteme GmbH v. Yunex GmbH* (UPC\_CFI\_156/2024)
17. **Nordic-Baltic** RD, *Imbox Protection A/S v. Brunngård Group AB, Paul Brunngård Group AB* (UPC\_CFI\_527/2024)

As the heat map shows, UPC *saisie* practice is so far mostly concentrated in UPC local divisions seated in countries that were already familiar with *saisies* in patent matters (France, Italy, Belgium), but it has already started spreading to other divisions and jurisdictions, in particular the Munich, Copenhagen, and The Hague local divisions. The orders issued by these divisions show that they are now fully up to speed with such proceedings and ready to grant full-blown *saisies* orders.

A careful review of the orders issued (or, in some instances, denied) thus far provides valuable insight (for readers seeking a more in-depth understanding, the *saisie* proceedings relevant to each topic under discussion are indicated in brackets).



## DETAILED ANALYSIS AND INSIGHTS

### Saisie vs. Inspection

At the UPC, both *saisie* (R.192) and inspection (R.199) orders can be requested. The scope of each measure differs:

- A *saisie* has the broadest scope: it allows the bailiff and/or expert to perform a “detailed description, with or without the taking of samples” of the accused products, “physical seizure of allegedly infringing goods” and of “the materials and implements used in the production and/or distribution of these goods and any related document,” and the “preservation and disclosure of digital media and data” (R.196). This list is, however, not limitative and the *saisie* judge may order any other measures that would be necessary to the gathering and preservation of the relevant evidence, it being specified that R.193.3 recalls that for these purposes the judge has “all necessary powers of the court”: the *saisie* order may thus include instructions to, e.g., ask specific questions to relevant individuals or representatives, dismantle an accused product in order to access a specific part thereof and study it, perform experiments, tests or even manufacture of a sample accused product, etc.;
- An R.199 inspection has a more reduced scope and is specifically and solely designed to allow “inspection of products, devices, methods, premises or local situations *in situ*.” This provision addresses in particular the need for the court to be able to inspect accused objects located in private premises and/or that cannot be brought directly before it (industrial installations or processes, heavy machinery, fragile or hazardous products, fields/crops, etc.). See in

particular Milan CD, 15 May 2025, *Maschio Gaspardo S.p.A. v. Spiridonakis Bros GP* (UPC\_CFI\_513/2024) for an *inter partes* inspection of a tool used on agricultural machines, performed by the judges of the Milan local division at the premises of the claimant.

An R.192 *saisie* order can include measures directed at inspecting a product in the sense of R.199, but the opposite is not true: an inspection order can not include measures to preserve and seize evidence such as documents, digital data, and the like.

This partial overlap in scopes has led to some hesitations from parties: all of the orders/proceedings discussed in this *White Paper* are *saisie* orders, i.e., based (at least) on R.192, but in some instances, the applicant also added the second legal basis of R.199 (inspection), sometimes apparently as a precaution (i.e., in case the court would deem that an *ex parte* request to preserve evidence should also, or instead, be based on this Rule), or because it truly differentiated between the two legal basis in its request.

There was some hesitation also from the court, which either ruled mostly based on R.192 but referencing R.199 in some places—even when the applicant had only used R.192—or ordered both measures clearly and distinctly, or even disregarded the issue and only made reference to the R.192 requirements.

### Takeaways

- Applicants should take advantage of the large scope of the *saisie* and the non-limitative list of R.196, in order to tailor the requested measures to the necessities of their case.
- While a dual-based R.192/R.199 request may for now be the safest route in order to cover all bases if the *saisie* includes an inspection of the accused products, all of the requirements set by R.192 to R.198—discussed below—need to be met in all cases since they also apply, *mutatis mutandis*, to R.199 inspection requests (see R.199.2).

### Ex Parte vs. Inter Partes: A Low Threshold

At the UPC, *saisies* orders can be obtained either through *inter partes* proceedings or, upon justification of the need to proceed without hearing the other party, through an *ex parte* request (R. 192.3). This marks a departure, in particular

from the French *saisie-contrefaçon* which is always, by right, requested *ex parte*.

**The threshold for an *ex parte* order** has, thus far, been set relatively **low**, with judges noting in particular that this threshold is met whenever: (i) digital data is involved and is at risk of being deleted or tampered with (“it is generally accepted that digital data can be easily hidden or erased if defendants are given previous notice of this kind of application”) (see *saisies* No 1/3/4/5/6/7/9/10/12); (ii) a test purchase cannot be performed or is prohibitively expensive to carry out (8/11/12/13); or (iii) there is a risk that the accused products may be removed from the premises (4/8/11/13) or that their inspection may otherwise be obstructed (9).

To date, the fact that a defendant may be legally bound to retain invoices or specific documents or information for reasons of compliance with applicable regulations or contractual obligations has not been considered (8/9) as ensuring that it will necessarily comply with such provisions or that it will not alter, even partially, or otherwise obstruct the search for such documents on the day of the seizure.

*Saisies* requested in the context of upcoming or ongoing trade fairs have also been easily granted *ex parte* (1/2/3/7/9/12/13), based on allegations of urgency, especially when the defendant was from a non-UPC jurisdiction (1/7/13).

Of note, in the five instances where prior contacts or exchanges had occurred between the applicant and the seized party (4/5/8/10/11), this did not negatively affect the ability to obtain an *ex parte* order, which reinforces the recommendation that applicants should disclose any such facts, along with any circumstances that may influence the court’s decision.

One *saisie* (11) was granted despite a protective letter filed by the defendant, in a case that perfectly illustrates how a weak or incomplete protective letter is worse than none.

The first *saisie* proceedings were eagerly awaited in this respect and some observers had anticipated that it might be more difficult to obtain *ex parte saisies* at the UPC than before national courts.

On the contrary, the low threshold that has been set and the fact that all of the *saisies* ordered thus far have actually been

issued *ex parte* confirm that in most circumstances applicants will be able to benefit from the element of surprise when carrying out UPC *saisies*. This should help lower the risk of evidence removal or tampering by the defendant.

Interestingly, the *inter partes* nature of the two proceedings that took place before the Munich (16) and Nordic-Baltic (17) divisions was due either to a lack of need to keep the *saisie* request secret (since the accused products were in any case located in the public domain and would not be destroyed or removed (16)), or to a *saisie* being requested before a judge (Mr. Stefan Johansson, who is also a judge at the Stockholm District Court) who was less familiar with such proceedings and may have deemed it preferable to hear the other party's arguments before deciding on the request (as is the judge's discretion under R.194.1(a))(17). In this last case, the applicant had initially requested the *saisie ex parte* but agreed to its conversion to *inter partes* (under R.194.5), which shows that the applicant considered this option preferable to no *saisie* at all and that the lack of the element of surprise is not always a deal-breaker in *saisie* matters.

### Takeaways

- At the UPC, patentees can reasonably expect to be able to easily obtain *ex parte saisie* orders in order to keep the element of surprise at a maximum level. This is especially true when digital data is to be seized, and regardless of prior exchanges between the parties as long as these are disclosed to the court. The request should nonetheless be well-reasoned on this point.
- From the defendant's standpoint: a weak protective letter will cause more harm than none.
- Applicants filing *ex parte saisie* requests should be prepared for a potential conversion to *inter partes* proceedings especially: (i) before divisions that are, for the time being, less familiar with *saisies*; and (ii) if they have reason to suspect that the defendant may have previously filed a protective letter, as this may lead the judge to consider that an *ex parte* order is not warranted since the defendant would appear to be already aware of the likelihood of a *saisie*.
- In the case of (*ab initio* or converted) *inter partes* proceedings, the discussion will likely focus on the scope of the measures to be ordered and will probably not involve a discussion on the patent's validity. The *saisie* request should therefore be particularly well-reasoned on the former point.

### Urgency

Unlike with preliminary injunctions ("PIs") – where applicants must act (very) quickly once they have (or should reasonably have had) knowledge of an alleged infringement or imminence thereof—urgency is not a requirement for obtaining a *saisie* order under the UPC RoP.

Urgency is only listed by R.194.2 (a) and R.197.1 as one of the factors that the judge shall or may take into account when deciding that an *ex parte* (as opposed to *inter partes*) *saisie* order is appropriate to prevent any irreparable harm to the applicant (in particular when the longer duration of *inter partes* proceedings might jeopardize the success of the *saisie*, e.g., in the context of trade fairs).

Accordingly, several of the *ex parte saisie* orders issued have specifically mentioned urgency as a decisive factor in granting an *ex parte* order, most of them issued in the context of trade fairs (1/3/7/12/13). Other circumstances deemed urgent and thus justifying an *ex parte* order were that the accused products to be inspected were stocked by the defendant only in a limited quantity that would be quickly depleted (8), or where the accused products (waste incineration furnaces) would become almost un-inspectable once put into operation (9).

However, it should be noted that in several cases—including the most recent ones—where the success of the *saisie* did not truly depend on the speed with which it needed be performed, the court nonetheless—and surprisingly—examined whether the applicant had been diligent in requesting the *saisie* once it had had knowledge of the alleged infringement (6/8/9/10).

Even if the test applied was undeniably less strict than the one used when deciding on PI requests (where applicants are required to act within one to three months of gaining knowledge of the alleged infringement or its imminence), this still appears to be a misreading of the UPC RoP.

The reason why urgency is not (or at least should not be) a requirement for obtaining a *saisie* but merely a factor *influencing* the ability to obtain such measure *ex parte*, is easy to understand: unlike with PIs—where urgency is justified by the fact that if the plaintiff has not acted swiftly upon becoming aware of the infringement or its imminence, he can be deemed capable of waiting for a decision issued on the

merits—in *saisie* matters the need to gather evidence will be and remain justified whenever there is a suspicion of infringement and an intent to act on the merits (absent which the *saisie* becomes void), and when the plaintiff demonstrates the need to gather evidence through a *saisie*, notably when such evidence is not available or is insufficiently available through other means. The authors therefore think that there are very few situations in which the assessment of opportunity (based on criteria examined hereunder) to grant and perform a *saisie* in order to gather or supplement evidence of infringement, should be influenced by the time taken by the plaintiff to make a decision in this respect. Holding that the patentee is no longer entitled to gather evidence of infringement after a certain period would be tantamount to adding an additional hurdle akin to statutes of limitation, which clearly has no legal basis. In particular, the patentee must be afforded time to observe and assess potentially infringing acts in detail and to try to obtain information independently. Conversely, they should not be pressured into filing a *saisie* request solely out of fear of not meeting a deadline or urgency requirement.

### Takeaway

Under the UPC Rules, patentees enjoy a significant amount of preparation time before requesting a *saisie* and should make the most of it by observing and assessing potentially infringing acts in detail and by trying to obtain evidence independently, before filing a *saisie* request. This will help them meet the *prima facie* evidence requirement discussed below, and a lack of urgency should not preclude an *ex parte* order if other reasons for not hearing the other party can be advanced (e.g., digital data that is at risk of being easily hidden or erased). However, patentees should be aware that some local divisions currently apply a stricter test regarding urgency.

### Main Requirements: *Prima Facie* Evidence and Proportionality

The UPC's decision to grant a *saisie* request mainly hinges on two critical factors: (i) the *prima facie* evidence provided by the applicant; and (ii) the proportionality of the measures requested.

#### *Prima Facie* Evidence

The *prima facie* evidence requirement is set by Article 60(1) UPCA, which provides that the applicant must present “reasonably available evidence to support the claim that the patent has been infringed or is about to be infringed.”

This threshold has, to date, been rather low at the UPC, with most *saisies* being ordered on the basis of credible though sometimes limited prior evidence provided by the applicant to substantiate the alleged infringement (in some instances (4/6/13) a portion of this evidence was collected outside the UPC territory (Ireland, United States, Turkey)):

- (1) Two technical and commercial leaflets concerning the accused product, a technical opinion by the applicant's patent attorney, four photographs of the infringing machine taken during a trade fair, a copy of a poster displayed at the trade fair stand, a video of the machine referred to by the QR code imprinted on a business card found at the defendant's trade fair booth.
- (2) Not detailed in order (“The applicant claims that the defendant's NOP product infringes EP 036. For an explanation of the patent and its alleged infringement, see the petition to be attached to this decision.”).
- (3) Explanations of the claimant included in the application, website screenshots, and a YouTube video “showing a height adjustment of the upper cord”; the applicant also specified what it was missing: “Claimant indicates that a cutting device for cutting the upper chord and a device for height adjustment of the upper chord during the continuous production of the lattice girder and the corresponding operations are not visible in this video. This is the reason why the applicant needs an order for gathering more evidence to be able to prove the alleged infringement.”
- (4) Pictures of the accused product extracted from the defendant's website and the defendant's brochure.
- (5) A demonstration of the infringement provided by the applicant, examples of the defendant's posts on Facebook and LinkedIn.
- (6) Photographs of the accused machine component, taken at the premises of the U.S. client of the seized party (included in written witness statement from the applicant's employee that visited a plant where the accused products were located), a report presented by defendant at an international conference held in the United States, illustrating the contents of the design of the U.S. client's plant, an expert report prepared by applicant to demonstrate the likelihood of infringement.

- (7) Written testimony from two of the applicant's employees (including photographs taken during the first day of a trade fair and a report of a conversation with the defendant's representative at the fair confirming the suspicion of alleged infringement).
- (8) A statement by the applicant that it found remains of the accused product at a disposal site used by a client of the alleged infringer, and that further investigation revealed an infringement of the patent, an indication that the defendant refused to provide information on distribution and procurement channels as well as the identity of the supplier of the accused product, and did not deny the use thereof.
- (9) A video and detailed and commented images taken from a bailiff report.
- (10) A copy of a LinkedIn post of the defendant's general director, showing the accused device; a copy of the subsequent cease-and-desist letter sent by applicant to defendant and admission of the defendant that it has sold it to at least one party; evidence of previous relations between the parties (defendant had manufactured an essential part of the invention for the applicant).
- (11) Defendant's product brochure; declarations and technical drawing adduced by the seized party in the context of prior European Patent Office ("EPO") opposition proceedings; testimony of the applicant stating that, during a trade fair, a representative of the defendant sought to license the patent.
- (12) Defendant's product brochure; user manuals, photos of accused product, commercial technical data sheet; evidence of use of the accused device in ski resorts; screenshots of Internet website; video of interview of defendant's representative; claim chart demonstration of infringement by a private expert.
- (13) Photographs of the allegedly infringing machine taken during a trade fair and a supporting affidavit; prior investigations by the applicant, including a test report of a machine bought in Turkey; a product brochure and a product video available on YouTube.

It is interesting to note that in the only *saisie* request denied on its merits (15), the *prima facie* evidence requirement was determinative. Although this order was published in a heavily redacted form, it appears that in this case, the applicant grossly failed to bring a minimum amount of evidence or demonstration of the alleged infringement, with the court noting that "the question [remained] completely open."

The test set out in this matter by the Mannheim LD (15) appears to be close—if not slightly more demanding—to that unaniously applied by French courts (i.e., that "the applicant does not have to prove the infringement, since that is precisely the objective of the infringement seizure that is the subject of the request, but only has to provide elements that are reasonably accessible, suggesting the possibility of an infringement of the patent being claimed") and well-balanced in order to avoid a misuse of *saisie* proceedings:

[The applicant must show] "that there is a sufficient degree of probability that infringement of the asserted claim combination can be found (...), with a sufficient degree of substantiation"; "an order to preserve evidence and to inspect premises can only be rendered, if the applicant establishes a certain degree of plausibility of infringement or the threat thereof. In consequence, mere allegations of infringement as such are insufficient"; "this means that it is insufficient just to set out why infringement cannot be excluded"; "if a certain technical result can be achieved in multiple ways, the applicant will have to submit facts supporting that the technical result is achieved by applying the technical solution as enshrined in the features of the patent claim. At least, the applicant will have to set out that there are factual circumstances, which point into the direction of the patented solution being implemented."

This being said, it should be noted that inspection requests are notoriously difficult to obtain before the German courts located in Mannheim, which could suggest that this practice could survive to a certain extent before the Mannheim LD.

### Takeaway

*Saisies* can be obtained even with limited and/or foreign-sourced *prima facie* evidence, as long as the applicant establishes a reasonable likelihood of infringement or a threat thereof. Overall, the approach taken by the UPC in respect of the *prima facie* evidence requirement is consistent with the French and Italian practices in *saisie* matters, and upholds the spirit and purpose of this evidentiary mechanism. This tool is indeed designed to allow for the gathering of litigation-grade evidence necessary to fully demonstrate an alleged or suspected infringement, with a view to initialing legal proceedings.

### Proportionality/Balance of Interests

In a majority of cases (1/2/3/4/7/8/9/12/13), the court performed a balance of interests and granted the *saisie* concluding that

the threat of the definitive destruction of the evidence faced by the applicant and the resulting irreparable damage prevailed over the defendant's exposure to the enforcement of the requested measures.

In some cases (10/11/13), the court stressed that the defendant's business was not likely to be substantially affected by the *saisie* ("The inspection and the preservation of evidence can also be carried out without major interventions in the ongoing operation; significant impairments to the operation of the respondent are not to be expected") and that the confidentiality of its potential trade secrets was protected by the restrictions imposed in the *saisie* order (10/13).

On the other hand, in one instance the Milan LD (12) granted only some of the measures requested to limit the scope of the *saisie* to what was necessary for the applicant to gather relevant evidence. In particular, it denied (i) the search for accounting documentation, (ii) the authorization to perform tests on the accused device that would have required the use of a bridge crane and a load cell, which the court deemed invasive and not immediately instrumental to the purpose of the *saisie*, (iii) the parallel *saisie* requested at the premises of the parent company of the accused infringer, and (iv) the seizure of the software running on the accused device.

### Takeaway

While the proportionality requirement will often be fulfilled as a result of meeting the *prima facie* and/or urgency requirements, applicants should not fail to specifically address proportionality in their request. They should also tailor the requested measures as close to what is needed to demonstrate the alleged infringement and design the *saisie* to be the least disruptive of the defendant's operation.

### Patent Validity

Although assessing the patent's likely validity is not listed as a requirement for granting a *saisie*, this point is almost always reviewed by the court, albeit superficially, and can be linked to the *prima facie* and/or proportionality requirements.

However, because the *saisie* is solely a measure for the preservation of evidence, the threshold in this regard is understandably much lower than for instance in PI matters and the patent enjoys a significant presumption of validity.

As a result, the court will:

- Always at least look at whether the applicant appears to be the rightful owner of the patent (as evidenced by the relevant patent register and/or any assignment agreement provided) and that it has not been opted-out (or that any opt-out has been withdrawn);
- In most cases, look at whether the patent is or was subject to EPO opposition proceedings (1/3/4/6/7/8/9/10/11/12/13) or a revocation action brought before national courts (6/7/8/11/12/13). Although no *saisie* request has yet been made in which this would have been the case, the orders issued show that this would not necessarily prevent a *saisie* from being granted, unless there are additional circumstances raising significant doubts as to the patent being ultimately held valid.

Upon review of the *saisie* orders issued in the *Tiru* case (9), where the defendant argued that it was disloyal for the applicant not to have disclosed in its *saisie* request a particular piece of prior art that it should have had knowledge of, the court confirmed that, at the *saisie* request stage, patent validity shall not be discussed in more detail than described above: "The patent holder cannot be required, at the stage of the request for the preservation of evidence, to respond in advance to possible attacks on the validity of the patent."

### Takeaway

For *saisies* purposes, the grant of a patent is usually considered as sufficient proof of its validity, provided that no particular reason to doubt its validity is brought to the court's attention. Applicants should disclose any past or pending EPO or national revocation proceedings, along with any other circumstances that may influence the court's decision.

### Duration of *Saisie* Request Proceedings

The first *saisie* proceedings show that, just like for PI proceedings and proceedings on the merits, the UPC is keeping its promise in terms of efficiency and speed: As shown below, *saisie* requests are processed very swiftly across all local divisions (within two weeks on average), and many *saisie* orders have even been granted on the same or next day of the request in cases of extreme urgency:



In several instances, this speed of execution was made possible thanks to the involvement of the “standing judge,” before whom extremely urgent *saisie* requests can be made in accordance with R.194.4.

The ability to swiftly obtain a *saisie* order is in particular critical for dawn raids performed during trade fairs. Such events, which usually last only a few days, are in some cases the only place and time where evidence will be easily (or at all) available, in particular with regard to: (i) foreign defendants that do not have any presence in the EU jurisdiction(s) where infringement occurs; or (ii) new products that are being advertised by the defendant for the first time (worldwide).

### Takeaways

- While the UPC can deal with and grant *saisie* requests on an extremely urgent basis, applicants should also themselves be prepared to react quickly by anticipating with their counsel, in particular when attending trade fairs, in the event where it would appear necessary to perform a *saisie* at a competitor’s booth. In turn, defendants should be aware that a lack of *saisie* on the first day(s) of a fair does not mean that it will not be performed against them up until the very last day(s) of the event.
- Applicants also need to be ready for the subsequent action on the merits that must be lodged once the *saisie* is performed.

### Location / Seized Party(ies)

As previously mentioned, several *saisies* have been requested and performed in the context of trade fairs (1/2/3/7/13). This is not surprising since such events, which usually last only a few days, are in some cases the only place and time where evidence will be easily (or at all) available.

When performing a *saisie* during a trade fair, it is even more advisable to limit the amount of disruption that the *saisie* will cause to the defendant’s marketing activities during the fair, in particular by instructing the team in charge of the *saisie* to ideally perform any inspection and testing of the accused products and/or computer search measures within a private booth, away from attendees’ eyes.

Most other *saisies* have been requested in order to be performed within the private premises of the defendant (4/5/6/8/9/10/11).

The *saisie* ordered by the Düsseldorf local division (10) is noteworthy in that it was granted against two third parties (i.e., a client of the patentee, and the logistics company it used for storage) in order to inspect a competitor’s accused products.

In the same spirit, the Copenhagen local division upheld upon review a *saisie* (6) granted against several linked defendants that were headquartered at the same location, holding that the evidence brought by the applicant had shown “that there could be a close intermingling of the parties in question at the applicant’s premises, and that it could therefore not be deduced in advance with which party potentially relevant evidence was located.”

On the contrary, the Milan LD (12) has denied a parallel *saisie* that was requested to be performed at the parent company of the accused infringer (subject to the granted *saisie*), holding that since the applicant had not included this parent company as a defendant party to the *saisie* request, it would suffer the effects of the measure without benefiting from the guarantees of the right of defense.

Finally, the *saisie* requested (but denied) before the Munich local division (9) stands out, since it concerned publicly accessible accused products (optics installed on public lighting infrastructure).

### Takeaways

- *Saisies* can be performed (virtually) everywhere (private or public company premises, trade fairs and other symposiums, domicile of private individual, public location) in any location where evidence of infringement may be located, including at third-parties’ premises.

- If premises are shared by several defendants acting as different legal entities, the *saisie* request must address this point very specifically and substantiate the reasons why there is uncertainty as to which party is involved in, or holds evidence of, the infringement.
- Industry-specific use cases will inevitably arise, such as in the pharma (*saisie* at regulatory authorities), SEP (*saisie* at standard-setting organizations), or defense/military sectors (where restrictive national rules will apply in many jurisdictions; e.g., Article L. 615-10 French IP Code).

### Attendees

The UPC RoP leave some discretion to applicants and judges regarding the team in charge of performing the *saisie* and the individuals that may attend it as observers.

In this respect, R.196.5 simply requires the *saisie* to be performed by “a professional person or expert, who guarantees expertise, independence and impartiality” and state that this person may be “a bailiff or assisted by a bailiff,” but R.196.4 provides that the *saisie* must be performed in accordance with the national law of the place where it is executed. It thus follows that in some countries, such as France, the involvement of a bailiff is mandatory (see in particular (4)).

In most cases (1/2/3/4/6/7/8/9/11/12/13), the person chosen to be in charge of performing the *saisie* was a patent attorney, assisted by a bailiff. Two cases from the Copenhagen (5) and The Hague (10) local divisions stand out in which it was the bailiff who was in charge of the *saisie*, assisted by an expert (patent attorney or IT expert). In either situation, such team has in any case proven to be extremely effective in French *saisie-contrefaçon* and Italian *descrizione*. Some applicants have included suggestions of experts in their request for the court’s consideration; when this was not the case, the court appointed the expert it deemed most appropriate, based on technical qualifications and/or a review of national lists of court experts.

IT experts have also been called upon in a few cases where data capture was the most critical search measure ordered. Assistance of locksmiths and law enforcement has also been authorized, where needed.

On the applicant’s side, the UPC rules authorize one or several of the applicant’s representatives to attend the *saisie*.

Since the RoP provide that this person cannot be an employee or director of the applicant, this possibility has so far been limited to one (1/2/3/4/9) or two (6/8/11/12/13) of the applicant’s attorney(s)-at-law and/or patent attorney(s), who are bound by strict confidentiality obligations (with penalties of up to €200,000 per offense (11)).

### Takeaways

- Applicants should carefully select the team of individuals they request the *saisie* to be performed by, most importantly, the person who will be legally in charge of the *saisie*: In this respect, they should not underestimate the importance of selecting someone with prior experience of the very specific context of *saisies* and other dawn raids, in particular a bailiff with such prior experience.
- The representatives that the applicant elects to name to attend the *saisie* should also be carefully selected, since they will be bound by strict confidentiality obligations preventing them to disclose to the applicant and its counsel the confidential elements of the *saisie*; it may often be preferable that the main attorney in charge of the case does not attend the *saisie* in order not to conflict him for the rest of the proceedings.

### Deadline for the Execution of the *Saisie*

Unlike, for instance, in the French *saisie-contrefaçon*, in which the plaintiff is usually granted a two-to-three-month deadline to have the *saisie* performed once the *saisie* order is issued, the UPC RoP do not provide for any such deadline and almost all of the UPC *saisie* orders issued have thus been granted as such (which also supports the fact that urgency should not be a requirement for granting a *saisie*).

The only exception relates to two twin orders of the Paris local division (9), which specified that the *saisie* should be performed before a particular date that was within approximately four weeks of the issuance of the order. Although this would appear to be the result of an influence of the French practice, the deadline set in this particular case appears more connected to the facts at hand: The accused products (waste incineration furnaces) were about to be put into operations—which would have made the inspection extremely difficult if not impossible at all—which most probably explains the deadline set by the court.

## Execution of the *Saisie* / Search Measures Granted

UPC *saisie* proceedings offer a very wide range of search measures, as the non-limitative list of R.196 outlines:

- (a) “preserving evidence by detailed description, with or without the taking of samples;
- (b) physical seizure of allegedly infringing goods;
- (c) physical seizure of the materials and implements used in the production and/or distribution of these goods and any related document;
- (d) the preservation and disclosure of digital media and data and the disclosure of any passwords necessary to access them.”

The *saisie* orders issued have already made use of all of the above examples; reference is made to the *saisie* orders for full details of the kind and scope of search measures granted.

The court has already made it clear that the list of R.196 is not limitative and that, for instance, if there is a corresponding interest in preserving evidence, the *saisie* order may also include the seizure of delivery notes and invoices to prove individual acts of infringement and the structuration of the supply chain (8).

Interestingly, two orders of the Milan local division (6/12) limitatively listed the keywords that could be used during computer searches, which is very reminiscent of French *saisie* practice.

The second order of The Hague local division (10) contained extremely deterrent provisions against noncompliance by the seized party, holding that: “If and to the extent that carrying out the order is only possible with the help of PTS, e.g., by providing passwords and/or access codes to servers off site and/or cloud storage accounts, a penalty payment, payable directly to the court is ordered, of EUR 5,000 per hour during which such access is not granted, up to a maximum of EUR 100.000.”

### Takeaways

- Subject to requesting the appropriate measures and convincing the court that they are justified under the circumstances, the UPC *saisie* is an extremely powerful tool for plaintiffs to gather evidence.
- A custom-made (and thus narrower) *saisie* is more efficient and robust against further challenges than an unnecessarily far-reaching *saisie*. It is also easier to perform.

- Defendants undergoing a *saisie* should comply with the terms of the order and avoid any obstruction. They should, however, refrain from actively helping the bailiff or expert in charge of the *saisie* beyond the specific requests that he will make, or from providing spontaneous declarations.

### *Saisie* Report

#### Deadline to Provide the *Saisie* Report to the Court

In most cases, the *saisie* report will have to be drafted by the bailiff or expert and provided to the court within a very short time following the performance of the *saisie* (within one day (1/3/13), two days (6/7/12), seven days (2/4/9/11), 10 days (10), or two weeks (5/13)).

Only one case stands out (8) in which the deadline to file the *saisie* report was significantly longer (three months), which can be explained by tests that possibly needed to be performed by the expert on the seized accused products, after the *saisie*.

**Takeaway:** This highlights the need for the bailiff or expert in charge of the *saisie* to have prior experience of *saisies* and study the factual and technical aspects well before the performance of the *saisie*.

#### Access to the *Saisie* Report and Protection of Confidential Information

After the performance of the *saisie*, the expert or bailiff must draft a written report and provide it directly to the court (R.196.4), and it is then up to the plaintiff to request access thereto. If the seized party considers that any of the seized elements and/or contents of the report is confidential and should not be disclosed to the plaintiff (at all or only within a confidentiality club), it must file a dedicated R.262A request at any time, but preferably very soon after the *saisie*. Such request is specific to confidentiality and must be made independently of any previous or subsequent request for review of the *saisie* order (R.198).

Interestingly, the majority of the *saisie* orders issued include provisions allowing the *saisie* report to be made available to the plaintiff’s attorneys-at-law under a strict confidentiality regime (in particular, preventing any disclosure to the plaintiff), even before the court has decided whether and under which conditions it can be made available to the plaintiff.

In several cases (4), the parties' attorneys reached an agreement regarding access to all or part of the seized documents.

**Takeaway:** Seizure of confidential information that is not directly relevant to the alleged infringement should in most cases be avoided as it will slow down and/or hinder access to the *saisie* report by the plaintiff. In turn, amicable sorting out of the seized documents between the parties' attorneys—a process also very frequently used in French national proceedings—can greatly simplify and speed up this process, partially or fully avoiding to have to wait for a decision of the court in this respect.

### Use of the *Saisie* Report

In almost all cases, the *saisie* orders granted recalled the wording of R.196.2, which provides that the *saisie* report may only be used in support of the UPC proceedings on the merits of the case.

**Takeaway:** While UPC *saisie* proceedings cannot be used in support of foreign parallel litigation, the opposite is not true, and several national evidentiary mechanisms may be used in support of UPC litigation (in particular, the U.S. Section 1782 discovery and the French *saisie-contrefaçon*).

### Deadline for the Subsequent Action on the Merits

As R.198 provides, a *saisie* order is revoked if the plaintiff does not initiate UPC proceedings on the merits of the case by a certain deadline.

It is now well-settled that this deadline, which must not exceed 31 calendar days or 20 working days, whichever is the longest, from the date specified in the court's order, cannot start running before the date of the disclosure of evidence to the plaintiff or from the date on which the court has made a final decision not to grant the plaintiff access to the evidence (as held by the UPC Court of Appeal in its ruling of 23 July 2024 issued in the *Progress Maschinen & Automation v. AWM, Schnell* case (UPC\_CoA\_177/2024)).

This represents a significant shift from the French *saisie*, under which the plaintiff must in any case initiate proceedings on the merits within 31 days of the *saisie*, even if they have not gained access to the full *saisie* report or to the complete seized information by then.

### Takeaway

Plaintiffs need to prepare for the subsequent action on the merits that must be lodged once the *saisie* is performed, but they are under less time pressure than in some national proceedings.

### Security

Although *saisies* orders are enforceable immediately (R.196.3), the court retains the discretion to require that a certain amount of security be filed by the successful applicant before executing the *saisie*, to cover any legal costs of the seized party or any damage that it may suffer as a result of the *saisie*.

In *ex parte* proceedings, the court *must* do so, unless it finds special circumstances going against such a requirement (e.g., the urgency of a trade fair (13)).

The court has ordered a security deposit in most cases (3/4/5/6/8/9/10/11/12), ranging from €7K to €75K.

In extremely urgent cases (in particular in the context of trade fairs), the court may order that security be provided but allow it to be filed *after* the execution of the *saisie* (1), or even determine that no security is appropriate (13).

### Defending a *Saisie*

While prior training is ideal and should be prioritized to establish appropriate protocols in advance, parties subjected to a *saisie* should in any case immediately contact legal counsel to best manage its effects and the information provided to the bailiff and/or expert. This is particularly crucial to prevent any overreach and to safeguard any potential trade secrets and/or confidential information.

After the execution of the *saisie*, judicial review should be requested whenever it appears appropriate, and preparations to defend against the subsequent action on the merits should begin.

## CONCLUSIONS

- UPC *saisies* (possibly combined with an inspection request) are an extremely effective tool for gathering litigation-grade evidence of an alleged infringement wherever this evidence may be located and from any party holding it.

- These proceedings are gaining momentum and are being increasingly used by litigants to support their cases, including before UPC divisions and judges who were not previously familiar with *saisies* (Munich, Copenhagen, The Hague). Combined with the prior experience of the judges from the Paris, Milan and Brussels local divisions, a significant portion of the UPC territory has now been tried and tested regarding *saisies*.
- The access threshold for these measures is relatively low compared to their far-reaching effects. If a well-reasoned request is submitted, along with the sufficient *prima facie* evidence of the alleged infringement demonstrating a reasonable likelihood of infringement or a threat thereof, *saisie* orders can typically be obtained *ex parte*, usually within a few days or weeks.
- Careful selection and preparation of the *saisie* team (usually a bailiff, a patent attorney and a computer expert) are also crucial to the success of the *saisie*.
- The significant powers afforded to the plaintiff entail commensurate responsibilities at both the request and execution stages of the *saisie*.

For these reasons, seeking legal advice from experienced *saisie* attorneys-at-law is highly recommended for both sides.

## LAWYER CONTACTS

### Thomas Bouvet

Paris

+33.1.56.59.39.39

[tbouvet@jonesday.com](mailto:tbouvet@jonesday.com)

### Gerd Jaekel

Munich/Düsseldorf

+49.89.20.60.42.200/+49.211.5406.5500

[gjaekel@jonesday.com](mailto:gjaekel@jonesday.com)

### Dr. Christian Paul

Munich/Düsseldorf

+49.89.20.60.42.200/+49.211.5406.5500

[cpaul@jonesday.com](mailto:cpaul@jonesday.com)

### Lamberto Schiona

Milan

+39.02.7645.4001

[lschiona@jonesday.com](mailto:lschiona@jonesday.com)

*Colin Devinant, an associate in the Paris Office, contributed to this White Paper.*

Jones Day publications should not be construed as legal advice on any specific facts or circumstances. The contents are intended for general information purposes only and may not be quoted or referred to in any other publication or proceeding without the prior written consent of the Firm, to be given or withheld at our discretion. To request reprint permission for any of our publications, please use our "Contact Us" form, which can be found on our website at [www.jonesday.com](http://www.jonesday.com). The mailing of this publication is not intended to create, and receipt of it does not constitute, an attorney-client relationship. The views set forth herein are the personal views of the authors and do not necessarily reflect those of the Firm.