

## **Court of Milan: decision on the conditions and limits of an application for an interlocutory description order**

On 9 July 2021, the Court of Milan issued a decision in the context of an interlocutory procedural request (docket n. 25111/2021), clearly outlining the limits for the grant of a description order pursuant to articles 129 and 130 of the Italian Industrial Property Code (“IPC”).

In Italian patent infringement proceedings, an interlocutory description order is a pre-trial means of acquiring proof of infringement, and is considered to be a non-invasive measure. As such, the Court of Milan’s decision provides guidance on the circumstances and the requirements for application of a measure that, as a rule, is generally granted.

Having rejected the applicant’s request to grant the description *ex parte*, the parties appeared before the Court for a hearing. The Court then refused to grant the description measures, noting the lack of the requirement of a risk of irreparable damage, specifically indicating the lack of danger of theft, dispersal or alteration of the evidence identified in the application for the description order.

In the case at issue, the applicant complained of alleged patent infringement committed through the marketing, by the respondent, of various models of industrial printers that had been on the market for some time.

The Milanese Judge preliminarily emphasised the *sui generis* nature of the description order, which is a preliminary investigation measure that arises out of the procedural right to obtain evidence (i.e. the acquisition of elements necessary to substantiate the infringement in subsequent urgency proceedings or an action on the merits). Therefore, the request does not involve a determination of whether the substantive right at issue should be protected, as occurs for other types of precautionary proceedings.

As to the grounds for rejecting the applicant’s request for a description order, the Judge noted:

- i) on the one hand, the goods that would be subjected to the order had been on the market for some time or, in any event, were available on the market and, therefore, were not subject to the risk of being stolen, dispersed or altered;
- ii) on the other hand, there was no concrete evidence that it was impossible for the applicant to make the purchase independently, even temporarily.

As regards point (i), the Judge held that the concrete, tangible, or, in any event, probable risk of manipulation, deletion or modification of the evidence sought, or of a change to the factual situation from which the evidence may be obtained, pending the subsequent trial on the merits, is an essential requirement for the grant of a description order.

The absence of this condition, indeed, had already led the Judge to reject the request *ex parte* and to schedule a hearing for discussion. Moreover, the balance in favour of rejecting the application *ex parte* had also been tilted by the fact that the parties had already discussed the alleged infringement

out of court, and that the products that would be subject to the description order were very numerous and, at least in part, defined in a overly generic manner. Indeed, the latter circumstance had made it necessary to identify the scope of the description in advance, to prevent it from going beyond the applicant's actual need for protection.

With regards to point ii), the Judge pointed out that the high value of the goods and the related cost of acquiring them for the purposes of the trial – which, in any case, does not in itself affect the risk of theft, dispersal or alteration of the evidence itself – could justify the grant of the description measures only if this difficulty rises to the level of making the purchase prohibitive, and not simply burdensome. This is even more true in consideration of the fact that bearing these costs would be equivalent to undertaking an investment for the protection of the patent, which is recoverable at the trial stage, in the event the patent infringement claim is determined to be well founded.

Finally, the Judge held that the absence of risk of irreparable damage was supported by the fact that the applicant had come into possession of the manual and some technical data sheets of the printers in question. This had allowed the applicant to examine, albeit generically, one of the contested printers, thus acquiring sufficient information to draw up a technical opinion on the alleged interference of some of these printers with the claims of the patent.

Lacking the requirement of the risk of irreparable damage, the Judge did not enter into an analysis of the existence of the other principle requirement, the existence of a *prima facie* valid right. Interestingly, however, he did consider the existence of another element, the balancing of the parties' interests and, therefore, of the proportionality and fairness of the requested measures. In the Judge's opinion, in this case ordering the description measures would not be fair, equitable and proportionate, as provided for by Article 3 of the Enforcement Directive no. 2004/48/EC.

Indeed, the principle of proportionality between the interest of the owner of the industrial property right and the public interest is an element that is increasingly attracting the attention of the Courts when analysing applications for precautionary measures aimed at the protection of the substantive right. This trend is evidenced both in intermediate requests (as with the description procedures) and in requests for the Court to make immediate decisions on the substance (as, for example, with an injunction), such as to affect the final decision itself and to limit the perimeters of the same in a more or less stringent way.

At the time of publication, the applicant for description measures had just filed an appeal. Accordingly, this decision is not yet considered final. It will certainly be interesting to see how it turns out.

As it currently stands, however, this decision clearly established that, in order for an application for a description order to be granted, it is necessary for the applicant to demonstrate - in concrete terms, and thus not only potentially or abstractly - that the acquisition of the pieces of evidence at issue could not take place at a later stage, because of the tangible risk of that they will be lost, or that the factual situation will be modified, and to explain how the risk of manipulation, deletion or modification of the evidence might occur.

It is evident that, given these conditions and limits, description measures cannot be used merely as an instrument to put pressure on the respondent, or as an easy "shortcut" to obtain, often in a merely exploratory way and in circumvention of the burden of proof, evidence that the applicant could in fact obtain *aliunde*, even at a later stage.