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THE DIVERSE WORLD OF EVIDENCE SUBMISSION FOR PATENT LITIGATION

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ABSTRACT

Enforcing a global patent portfolio is increasingly complex. Of the many factors contributing to these challenges, one of the most significant is the variety of widely divergent and sometimes inconsistent rules and procedures on gathering and submitting evidence applicable in patent litigation. Such divergences are mainly an outcome of the distinct legal systems prevailing in a specific jurisdiction. Some countries, such as the United States of America, have extensive discovery procedures involving a variety of tools, including document requests, interrogatories and depositions. In the United Kingdom, the system relies on one party making material available to the other. Countries like Germany, however, front-load the process, leaving limited opportunity for gathering evidence before trial and virtually no fact-finding activity. Others, such as China, do not provide a mechanism for pre-trial evidence gathering and instead require the patentee to collect evidence. Such systems rely heavily on notarization and evidence preservation. In Japan, the focus is on limited independent evidence collection by the parties. This contribution provides an overview of approaches to evidence gathering and submission for patent litigation in key jurisdictions, and strategies for minimizing the challenges arising from the various systems.

* The views expressed in this document are those of the author and not necessarily those of the Secretariat or of the Member States of WIPO.

I. EVIDENCE GATHERING AND SUBMISSION

1. Enforcement of a global patent portfolio has become increasingly difficult over the past several years. Among the many contributing factors is the plethora of varying rules and procedures for gathering and submitting evidence in patent litigation. Rules and procedures can vary significantly, depending on the legal system and practice in the jurisdiction. International intellectual property (IP) agreements provide little guidance: the major patent-related treaties, such as the Paris Convention for the Protection of Industrial Property, are silent on the question of enforcement. Only with the adoption of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement) was any real effort made to provide minimum standards for IP enforcement.

2. The goal of harmonizing international rules and practices related to the gathering and submission of evidence is yet to be achieved. Under Article 50(1)(b) of the TRIPS Agreement, judicial authorities have the power to “order prompt and effective provisional measures to preserve relevant evidence in regard to the alleged infringement”. Evidence gathering is a fundamental part of pre-trial discovery (i.e., disclosure of evidence that lies in the control of one party), but evidence may also be gathered in the course of the action on the merits. Article 43(1) of the TRIPS Agreement empowers judicial authorities to order that evidence be produced by an opposing party, where the party bringing an action “has presented reasonably available evidence sufficient to support its claims and has specified evidence relevant to substantiation of its claims which lies in the control of the opposing party”.

3. Furthermore, in certain circumstances, and insofar as World Trade Organization (WTO) Members have implemented this option, judicial authorities may also “order the infringer to inform the right holder of the identity of third persons involved in the production and distribution of the infringing goods or services and of their channels of distribution” (Article 47). The TRIPS Agreement notwithstanding, the variety of procedures and scope for gathering evidence in the pre-trial phase in jurisdictions around the world make a single, universal definition of discovery unlikely.

(i) Jurisdictions with narrow evidence-gathering procedures

4. Many countries prohibit or restrict pre-trial gathering of evidence. In Germany, the law does not provide for discovery as in the United States of America (see below). Rather, it provides for court-supervised evidence gathering and preservation. Only limited evidence gathering is possible via discovery, although the law does allow for an “inspection” claim by which document production or inspection may be requested. The law in France contains exhaustive provisions for evidence gathering: *saisie-contrefaçon* (pre-trial seizure) can be an effective tool to assist in gathering evidence before entering into litigation. In China, individual parties are responsible for providing evidence in support of allegations of infringement. There is no formal procedure for evidence gathering, and neither document production nor interrogatories are available as tools for evidence gathering. However, China does have an evidence-exchange process (*zhèngjù jiāohuàn*), whereby opposing parties produce evidence under a court-managed process. Thus, the front-loading of evidence through notarization and evidence preservation are critical in China, and Chinese courts have considerable latitude in ordering fact investigation and evidence collection.

5. The civil law system of Argentina does not provide for pre-trial evidence gathering. Before court proceedings, the patentee must gather evidence of the infringing act, including obtaining samples of the infringing article – a step sometimes necessitating court assistance, through which an order can be issued if entry into the infringer’s facilities is necessary. This formal step is designed to satisfy the relatively strict chain of evidence requirements.

6. In Brazil, given the absence of formal procedures for pre-trial evidence collection, the approach typically includes the report of a court-appointed technical expert, who evaluates the technology of the patent and analyzes the allegations of infringement. Documentary evidence includes reports obtained from an independent expert and testimony from hearings. Importantly, parties are under no obligation to divulge evidence, absent a court order. But even under circumstances where the court issues an order to disclose evidence, the discovery parameters are limited to evidence as exactly described, thus avoiding an overly broad investigation.

7. In Indonesia, the party alleging infringement must gather and submit evidence to support the allegation. That includes, at the very least, gathering comprehensive information on the patented invention and its specification, and the allegedly infringing product or process. However, the party alleging infringement has limited rights in terms of obtaining documentary and other evidence. Only limited mechanisms are available to compel document production by any party.

8. In Japan, the focus is on limited independent evidence collection by the parties prior to the party bringing an action. The evidence-gathering process is highly structured and similar to the civil law processes of many countries in Europe. Documentary evidence includes written declarations and required legal forms. Procedures are available to seize and safeguard evidence at risk of being hidden or destroyed.

9. In the Republic of Korea, evidence in the form of documents (such as expert reports, invoices and printed websites) may be submitted during hearings. Under Korean law, a court may issue an order allowing the plaintiff to engage an expert to search the defendant's premises. Courts may also issue orders to preserve evidence and to prevent it from being concealed. The parties involved also have the option of examining lay and technical witnesses.

110. Evidence gathering in South Africa does not follow either a typical common law or civil law approach, consistent with the fact that the country is not exclusively one or the other. Evidence collection ordinarily begins after the commencement of proceedings and includes witness affidavits and testimony. However, the South African system provides for Anton Piller orders, which allow the party bringing the infringement action to enter the defendant's premises to seize evidence of infringement and prevent its being hidden or destroyed.

(ii) Jurisdictions with broad discovery procedures

11. At the other end of the evidence collection spectrum are common law countries which typically provide highly developed discovery procedures. The United States has extensive discovery procedures involving a variety of tools, including document requests, interrogatories and depositions. A party involved in foreign litigation and requiring evidence may undertake narrowly focused discovery with the aid of United States federal courts. The system of litigation in the United Kingdom provides for a limited version of US-type discovery and relies on parties making documents and other material available to the others.

12. India takes a similar approach to that of the United States and the United Kingdom. It is standard to prepare for litigation by gathering evidence of infringement, including purchased products, user manuals and invoices. Affidavits and cross-examination of witnesses can also be used. The testimony of technical experts is frequently relied upon to prove infringement.

13. Kenya also has a well-structured system of evidence gathering and submission for use in patent infringement and validity cases. The patentee is responsible for gathering sufficient evidence to support the action, including complete market studies, the seizure of infringing products (with possible assistance provided by the country's Anti-Counterfeit Authority) and

verification of ownership of the infringing products. The testimony of expert witnesses is commonly used to evaluate the technology involved.

14. The pre-trial process for gathering evidence in Nigeria involves the plaintiff obtaining written materials verifying patent ownership, sworn witness statements and other evidence of infringement. The process also includes identifying and obtaining samples of infringing articles. Expert evidence is used to analyze the technology of the patented product or method.

(iii) International treaties and evidence collection

15. In an effort to harmonize and expedite international evidence collection and discovery proceedings, the Convention on the Taking of Evidence Abroad in Civil or Commercial Matters (Hague Evidence Convention) was adopted in 1970. The Convention provides for use of a designated “central authority” as part of a standardized evidence-gathering mechanism. That authority is charged with receiving, reviewing and, if appropriate, acting upon “letters of request” for evidence in that particular country. If approved, such requests are conveyed to the appropriate authority, usually a court, for action.

II. PREPARING AND PRESENTING EVIDENCE

16. Once gathered, the evidence must be prepared for presentation in the foreign court under the local rules of procedure. They generally require an extra layer of authenticity if the evidence originated from outside of the country. Frequently, several layers of evidence verification may be required, including notarization, authorization and legalization, a process that historically has involved embassy and consular assistance. To simplify the process of evidence authentication for use in foreign courts, many countries have become signatories to the Hague Convention Abolishing the Requirement of Legalization for Foreign Public Documents (1961). Known popularly as the Apostille Agreement, it enables parties in Member States to avoid the cost and complexity associated with document authentication and legalization. Other formalities, such as evidence notarization must still be observed and often differ from jurisdiction to jurisdiction.

(i) Evidence gathering – planning ahead

17. Anticipating and responding to evidence gathering and submission requirements between jurisdictions are critical steps in successfully enforcing IP rights (IPRs) on a global scale. It is critical to determine early on the sort of evidence that will be needed to support a claim of infringement of IPRs. Certain types of evidence may be more difficult to obtain, such as testimony gathered by way of a deposition in which the assistance of a foreign court may be necessary. Many countries, such as Germany and Japan, place restrictions on the taking of depositions or on where they may be taken. However, the TRIPS agreement obliges WTO members to, at least, provide for provisional measures to gather evidence even before an action on the merits is lodged under Article 50(1)(b). The TRIPS agreement is, however, silent on whether this obligation would also apply for the purpose of cross-border gathering of evidence.

(ii) Legal and cultural differences

18. A global enforcement strategy should also take into account the sometimes considerable differences in legal culture from one country to another. US-style discovery may be regarded as too intrusive in some legal systems. Regardless of the Hague Evidence Convention, differences invariably arise case by case. Attention must also be given to the recipient of the submitted evidence based on the legal system involved. For example, evidence presentations suitable for a juror under the US jury system may be very different from the type of evidence suitable for submission to a jury-free multi-member judicial body.

(iv) Prosecuting a patent application with an eye toward discovery

19. Often the patent applicant is so focused on the prosecution and grant of a patent application that little attention is given to the possible long-term negative consequences to the granted patent of the permanent record or file history being created. Before the patent application is even filed, the applicant needs to recall that there are two aspects to the patent – one aspect is the grant of the patent itself and the other is the grant of a durable patent, one that will survive a validity challenge. The file history may itself become an object during the discovery phase of litigation, so consideration must be given to the possibility of such a validity challenge.

20. Virtually every patent office allows the public to review the file history of a patent application. Prosecution procedures vary between jurisdictions, but some general strategies can be applied universally to establish and maintain a desirable patent application file history.

Universal strategies:

- Undertake a complete patent search.
- Prepare claims that are supported by the specification as filed and that are commensurate with the prior art, in order to minimize amendments during prosecution.
- Avoid both overly broad and overly narrow claims in the initial filing.
- When responding to an office action, avoid unnecessary arguments and restrict discussion to only what is needed to overcome the prior art rejection.
- Do not submit affidavits or declarations unless absolutely required, as they become part of the permanent record and can be used against the applicant.
- Confirm that patent office records are accurate and are consistent with the applicant's records.
- Accurately track how claims are amended during prosecution, from initial filing to allowance; such a record may be useful for claim construction in litigation.
- The “Background of the Invention” section can be a double-edged sword in patent applications.
- Use clear, concise and universally accepted terminology, particularly in the claims, to prevent confusion in translation.

Country-specific recommendations:

- In the United States, examiner interviews can be an effective approach and should be utilized when possible to minimize the written record; draft claims submitted for discussion purposes need to be identified as such with a request that they not be entered into the record.
- Interviews should be undertaken in those countries where they can be held, as they can minimize the written record. When a summary of the interview is entered into the record, the applicant must confirm that the summary accurately represents the interview.
- In China, arrange for in-person examiner interviews where possible, as prosecution is often complicated by poor translations. The likelihood of discovering translation errors is greater in a personal meeting. Also in China, claim language in amendments should exactly match the language of the specification as filed: China has stricter standards than most countries.
- In countries like the United States, where declarations/affidavits can be filed, only do so when absolutely needed, as they can be used against the applicant.

- In Japan, utilize the opportunity to interview patent examiners in order to minimize written responses.
- Japan has strict enablement requirements, and claims should be drafted accordingly.
- In India, the technical advancement must be set forth clearly and in detail in the specification.

III. PRACTICAL STRATEGIES FOR GATHERING AND SUBMITTING EVIDENCE

21. Artificial intelligence (AI) is already proving an effective tool in various aspects of evidence gathering (such as in identifying relevant evidence, invalidating prior art, and creating claim charts), there is no single, multi-jurisdiction approach to the effective gathering and submission of evidence for patent litigation. The importance of such evidence is broadly recognized, but different strategies are required for gathering evidence and submitting it before courts and administrative agencies around the world. Practices between jurisdictions vary, but it is possible to identify fundamental strategies. Select examples follow.

22. A cautionary note regarding the increasing use of AI in patent litigation is warranted. There have been several instances of “hallucinating” in patent litigation actions in the United States. Attorneys and individuals have been sanctioned for incorporating into briefs non-existent case law in support of a position. The use of AI has also been identified in the creation of fake data in patent matters. For example, a recent Decision of Reexamination (No. 1878153) in China disclosed that the original patent application did not provide data necessary to support the antitumor activity as claimed. The applicant submitted clinical data not originally included in the application. However, no record of the clinical trial data filed after the application was found, and the applicant was unable to explain this circumstance. Ultimately, the reexamination panel could only conclude that the post-filing data were falsified. It remains the responsibility of the party relying on AI-generated information to confirm the validity of the material so generated.

China

23. Evidence preservation is critical in China. Because of limited discovery, strategies involving securing and notarizing evidence must be proactively undertaken early to prevent the evidence from becoming unavailable. This is particularly true in the case of digital evidence, usually in the form of a website. Also, with respect to the gathering of digital evidence, a more recent development is the use of digital timestamping in evidence preservation. In the case of products themselves, a notary is engaged to both purchase and notarize at least two samples of the allegedly infringing article. One sample is retained for examination and the other for use in litigation or administrative proceedings. If evidence is known to be in the possession of the defendant, an order may be sought from the court to preserve it. Some types of evidence, such as ill-gotten profits, are typically more difficult to find, but they could be very useful in seeking compensation for infringing activities. The standard for sufficiency of evidence tends to be lower in the case of evidence submissions to administrative agencies than to Chinese courts.

France

24. In France, the *saisie-contrefaçon* is perhaps the most effective and widely used evidence-gathering mechanism available to a party harmed by infringing activity. Under this procedure, the bailiff is empowered by a court order to seize evidence of infringement (documents, products and other evidence). The *saisie-contrefaçon* order is granted *ex parte* on request. The bailiff is ordinarily accompanied by an expert, often a patent attorney, to help in the identification of evidence to be seized. As in China, the primary reason for taking advantage of the pre-trial seizure is to preserve evidence for use in legal proceedings. In France (and in other jurisdictions such as Brazil), there is a National Industrial Property Institute that produces

a search report that is usually issued within about nine months following filing and includes relevant art related to both novelty and inventiveness of the invention. Translation expenses can be considerable when dealing with French-language documents for use as evidence. Accordingly, and as in all situations where document translation may be necessary, translation costs can potentially be controlled by undertaking translation of only the most critical documents. Early engagement of experts can be helpful in assuring that only the most important evidence is submitted for use in proceedings.

Germany

25. Germany does not provide for US-type discovery but rather court-supervised evidence gathering and preservation. Under the German system, infringement and validity actions are conducted separately. Accordingly, evidence gathering and submission must be planned with this bifurcated system in mind. To keep costs low, samples of infringing products may be purchased conventionally from the public market; such purchases should be documented. The strategy also includes obtaining other publicly available information on the infringing party, such as trade fairs, business literature and published test information appearing on websites. In those instances where evidence is not available through public means, court-ordered site inspections can be a low-cost and effective way of identifying and potentially gathering important evidence. Submissions should be focused and concise so as to minimize the time needed by the court to review and evaluate the evidence. It is important in Germany to include all of the necessary evidence with the initial submission so as to avoid the risk of refusal of material submitted at a later stage.

United Kingdom

26. The United Kingdom in some respects provides more limited discovery than do other countries, but it does offer certain unique features that help with efficient evidence gathering and submission. Perhaps the most important mechanism is the Product and Process Description (PPD), a study prepared by the defendant and which provides a focused description of the allegedly infringing product or process. Properly prepared, the PPD document addresses and narrows down issues related to the infringement charge. It can be detailed and can thereby help to streamline the process for all parties involved. Prior art studies are frequently required for various types of litigation. As in many countries, the use of AI is playing an increasingly significant role in identification of potentially relevant prior art. AI is also being employed by patent practitioners in the United Kingdom to assist in document review and case-outcome predictive analytics, thereby helping users to plan efficient litigation strategy. The Civil Procedure Rules of the United Kingdom are relatively strict and require proper adherence, which may prove difficult for the unwary. Practitioners have found that the use of AI may be useful in organizing and prioritizing evidence for court submission.

United States of America

27. The United States has extensive discovery mechanisms. As noted, AI has had a broad impact on discovery procedures, including document analysis. In the United States, the use of AI was embraced early and, today, is a normal yet evolving part of document production. Document review has long been seen as a rite of passage for young associates just beginning their litigation careers. While AI does not necessarily replace the work undertaken by them (and the important lessons gained by document review), it does enhance the review process and allows the reviewers to consider and gather far more evidence in the same amount of time as would be the case without AI. In the case of possible patent invalidation, relevant prior art is often difficult to gather given the sheer volume of patent literature and non-patent literature, particularly in the pharmaceutical and software industries. In the United States, the use of AI in identifying relevant prior art within the overlapping and complex web of potentially relevant

references has significantly reduced investigation time while generating higher quality results. Submission of evidence to courts in the United States can be difficult, given the strict requirements of court and procedural rules such as are found in the Federal Rules of Evidence. Careful planning and evidence organization are critical early steps in a seamless evidence submission process.

CASE STUDY: THE IMPORTANCE OF BEING CREATIVE AND ADAPTABLE

An interesting and diverse international enforcement case involved a sporting goods manufacturer and one of their ranges of sneakers, some protected by design patents. An enforcement program focusing on those patents was developed with the client and associates abroad. Action was taken in various jurisdictions. Evidence collection and notarization was complex – mostly because the particular line of shoes was available in so many locations – but manageable.

The most important lesson was learned in China, where some of the company's shoe lineup was protected by design patents and, naturally, the infringers were focusing on the shoes that were not. One possible approach to the issue appeared to lie not in patent law, but in the applied art provision of the Copyright Act of China, which affords protection to articles that "possess sufficient originality and artistic value". A senior Copyright Office official, having examined a sample article of the footwear being copied, agreed that it could qualify as a work of applied art under the Act.

An associate then filed copyright applications for a number of articles of footwear. With the copyright registered, the purchase and notarization of infringing products was organized in the most popular markets in all of the big cities. The process of gathering and notarizing evidence was coordinated so as to prevent one seller from warning another of what was happening, and the ensuing raids were highly successful. The moral of the story is that it pays to be flexible in one's approach to national law and practice and the gathering of evidence.

IV. EVIDENCE AND MEDIATION

28. Depending on the circumstances of the case, the parties may need to seek a court-mediated settlement. The submission of evidence is handled differently in mediation, insofar as the evidence is intended to inform and educate the mediator, rather than to persuade a court. In mediation, evidence is usually submitted confidentially, thus allowing for greater candor. It is usually understood that such evidence may not be submitted in any subsequent court proceedings. International enforcement of a court-mediated settlement agreement requires the cooperation not only of the parties involved but also of the relevant judges.

V. CONCLUSION

29. Collecting and submitting evidence can prove one of the greatest hurdles faced in enforcing IP. Doing so effectively and efficiently requires meticulous planning, a solid understanding of the law and legal systems, good foreign counsel, and a basic working knowledge of procedural practices in the relevant jurisdictions.

[End of contribution]