

## PRIVILEGED AND CONFIDENTIAL INFORMATION AND ANTON PILLER ORDERS FOR SEARCH AND SEIZURE

Alexandra Steele\*  
**LEGER ROBIC RICHARD, L.L.P.**  
Lawyers, Patent and Trademark Agents  
Centre CDP Capital  
1001 Square-Victoria – Bloc E – 8th Floor  
Montreal, Quebec, Canada H2Z 2B7  
Tel. (514) 987 6242 – Fax (514) 845 7874  
www.robic.ca – info@robic.com

In the context of intellectual property litigation, an Anton Piller Order is an order of the Court which allows a plaintiff who knows, or has reason to believe, that a defendant has dealt in counterfeit or infringing products to search the defendant's premises and to seize and remove all infringing or counterfeit materials, including computer software and other items that have served to make the unauthorized products. In addition, the defendant is temporarily restrained from further dealing in the infringing or counterfeit products.

This procedure gets its name from the first such order issued in the U.K. in the case of *Anton Piller KG v. Manufacturing Processes Ltd.*, (1976) 1 Ch. D. 55 (C.A.). This is a very exceptional civil procedure and once it is granted, the lawyers for the plaintiff are entrusted with the enforcement of the order. If the order is not scrupulously followed, then the defendant can ask the Court to rescind the order and the plaintiff may be liable to pay damages to the defendant.

Amongst the many obligations resulting from an Anton Piller Order, the lawyers responsible for its enforcement must list all of the materials seized and a copy of the list must be given to the defendant before leaving the premises. This poses a practical problem when information is seized from a computer, as there are often countless files that cannot be individually examined at the time of the enforcement of the Order. This was the case in the matter of *Celanese Canada Inc. v. Murray Demolition Corp.* (2006 SCC 36 (S.C.C.), July 27, 2006) where despite an Anton Piller Order clearly requiring plaintiff's lawyers to list all the documents removed from the defendant's premises, the plaintiff's lawyers did not prepare such list and proceeded to

---

© CIPS, 2007.

\* Of LEGER ROBIC RICHARD, L.L.P., a multidisciplinary firm of lawyers, and patent and trademark agents. Published in the Winter 2007 issue (Vol. 11, No. 1) issue of our Newsletter. Publication 068.078E.

copy all of the electronic files and put them in a sealed envelope. In the days following the execution of the Anton Piller Order, the envelope in question was opened and the electronic files briefly examined in the absence of the defendant and its counsel.

The Supreme Court of Canada criticized plaintiff's lawyers for not fully complying with the obligations concerning the listing of seized materials, but it also noted that, for practical purposes, it was more efficient to copy the electronic data and examine it more closely after the enforcement of the order. In our view, this alternative to listing all of the electronic data at the time of the enforcement should be clearly set out in the Anton Piller Order.

The Supreme Court further admonished plaintiff's lawyers for opening the sealed envelope without opposing counsel being present, especially since there was no urgency to examine the documents. It was discovered that amongst the materials seized, there were communications between the defendant and its lawyers, and to which the plaintiff would not otherwise have had access were it not for the Anton Piller Order. The defendant had no guarantees that the plaintiff had not used, and would not use, the confidential and privileged information. All privileged and confidential information in the possession of the plaintiff was therefore ordered restored to the defendant and the plaintiff was ordered to destroy all copies of such information, including the electronic support on which the information had been stored or copied.

The Supreme Court therefore reaffirmed that it is a plaintiff's burden to show what information it has obtained further to an Anton Piller Order and what safeguard measures are in place to ensure that the information is not disseminated or misused to the defendant's detriment

