

Anton Piller Order in UK and its Possible Implications in India

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Concrete evidence is vital to substantiate one's claim and obtain relief in any case, including those revolving round infringement of intellectual property rights. To prevent situations where the defendants might destroy the evidences on being aware of the impending legal actions, the English Courts devised a new strategy - an *ex parte* interlocutory injunction which enables the plaintiffs' solicitors to enter the defendants' premises and obtain the offending materials or documents to produce them at the trial – called the *Anton Piller order*. However, due to its enormous power, if not used sparingly, the *Anton Piller order* can be abused to a large extent. The application of *Anton Piller order* in India is still in nascent stage and lot many questions are still left unanswered. This paper looks into the rights and obligations of the parties, risks associated with it and the possible solutions, in perspective of the intellectual property right infringement cases.

Keywords: *Anton Piller order*, *ex parte*, evidence, injunction, self incrimination

Intellectual property rights (IPR) are basically negative rights, which allow the right-holder to (i) utilize, (ii) dispose of his rights and (iii) initiate legal action against those who infringe them. Anybody who misappropriates the property is faced with civil and/or criminal consequences. While the traditional remedies include injunction, cost, damages, etc., what has assumed more popularity in these days is the non traditional forms of remedies like, *Anton Piller order*, interlocutory injunction, etc.

Anton Piller order is a very potent weapon in the plaintiff's arsenal. Often dubbed as the 'nuclear weapon', it has the power even to destroy the defendant's reputation and business. This potential of its being abused makes the order a force to reckon with. Generally, while granting an *Anton Piller order*, the Court has to balance between two conflicting interests- combating infringements of IPR and safeguarding the defendant's right to privacy and privilege against self-incrimination.

In this paper, various aspects of *Anton Piller order*, like jurisdictional aspect, requirements, safeguards against abuse, etc, through English cases are analysed. In the end, scope of the application of *Anton Piller order* in Indian legal system through discussion of cases and various Acts is examined.

***Anton Piller Order* in UK – An Overview**

The *Anton Piller order* is a form of discovery preservation granted on *ex parte* application. It can comprise of an injunction to restrain infringement, permission to enter defendant's premises to inspect documents and remove originals or copies of the originals, permission to remove allegedly infringing goods, and an injunction to restrain defendant from disclosing contents of the injunction to third parties for a specified period.¹ The purpose of the order was explained in *Yousuf v Salama*,² where Lord Denning MR observed that the order intends to prevent the danger of destruction of evidence.

History of *Anton Piller Order*

The first use of such order was made by Templeman J, in *EMI v Pandit*³ to protect the offending evidences from being destroyed. However, it was only after the case of *Anton Piller KG v Manufacturing Process*,⁴ that it gained recognition and popularity.

In *Anton Piller KG v Manufacturing Process*,⁵ Lord Denning and Lord Ormrod laid down both substantive standards for granting the order and service requirements accompanying the order and thus laid the foundations, over which subsequent cases have developed the law. After distinguishing the order from search order, Lord Denning took shelter in *United Company of Merchants of England, Trading to the East Indies v Kynaston*,⁶ where Lord Redesdale

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said that the impugned order in that case ‘.....is an order operating on the person requiring defendants to permit inspection, not giving authority of force, or to break down the doors of their warehouse.’, and held that there is justification to make an order compelling defendant to permit plaintiff to inspect, if justice so demands.

After this case, there have been a number of instances where *Anton Piller order* was sought and granted. In fact, in *Systematica Ltd v London Computer Centre Ltd and Idnani*,⁷ Whitford J warned against ‘rather too free a use’ of being made of *Anton Piller order* by the plaintiffs.

Characteristics of *Anton Piller Order*

Dockray and Ladley have noted three characteristics of *Anton Piller orders*:⁸

- 1 This is an extra-ordinary remedy, made in extra-ordinary circumstances where there is no other way of ensuring justice. However, the orders can be executed, not by force, but only after taking the consent of the person to whom the order is directed.
- 2 The orders cover both aspects – ‘inspection’ and ‘removal of documents and other properties’. ‘Consent to inspection’ implies that defendant must permit search and seizure.
- 3 The orders are made *ex parte*, without informing the respondents or giving an opportunity of hearing.

Substantive Requirements for an *Anton Piller Order*

In *Anton Piller KG v Manufacturing Process*,⁹ Lord Ormond and Lord Denning enumerated four prerequisites for the making of an *Anton Piller order*. These are:

- (1) A strong *prima facie* case against the defendant. The Court in *Rank Film Distributors Ltd v Video Information Centre*,¹⁰ referred to ‘clear and compelling evidence’ and a very strong *prima facie* case. However, in *Yousuf v Salama*,¹¹ the Court required only to prove that there is a *prima facie* case.¹²
- (2) That the potential or actual damage done to the plaintiff by the defendant is serious; However, since only the plaintiff’s evidence is taken and the defendant is not given a chance to contest the appeal, there remains serious doubts over the viability of this requirement. In fact, Scott J in *Columbia Picture Industries v Robinson*,¹³

emphatically remarked that the plaintiff’s solicitor cannot be expected to present the available evidence from the respondent’s point of view.

- (3) Clear evidence that the defendant has relevant and incriminating documents or items in his possession, and that there is a real possibility that the defendant would destroy such material before any *inter parties* application can be made; This can be achieved by ‘full and frank disclosure’ by the plaintiffs. Scott J in *Columbia Picture Industries v Robinson*, quoted with approval the observation of Whitford J, in the *Jeffrey Rogers Knitwear Productions Ltd v Vinola Knitwear Manufacturing Co*,¹⁴ that any plaintiff seeking an *Anton Piller order*, must place before the Court all the relevant information that points to the probability that in the absence of such an order material would be destroyed. However, in *Brink’s -- MAT Ltd v Elcombe and others*,¹⁵ it was held that the decision to set aside the order for non-disclosure is discretionary and will not always be exercised. However, in *Digital Equipment Corp v Darkcrest Ltd*,¹⁶ it was held that the plaintiffs do not owe any duty for full and frank disclosure to the defendants, but to the Court.
- (4) Should an order be made, it would do no real harm to the defendant or his case. However, the chief proponent of this requirement, Lord Denning, was himself not ready to give it much weightage, as was evident from his statement in *Yousuf v Salama*,¹¹ where he remarked ‘The *Anton Piller order* can do no harm to the defendant at all. If he is honest, he will produce the documents in any case. If he is dishonest, that is all the more reason why the order should be made’.

But what this view fails to recognize the potential threat such an order can pose, if it allows the plaintiff to appropriate the defendants’ even legitimate trade secrets.

When *Anton Piller order* is Granted

Whatever may be the pre-requisites for granting an *ex parte* order, what weighs most is the *bona fide* interest of the plaintiff and justice. For this, even defendants’ ignorance about the plaintiffs’ right is not a ground for refusing the order. This was so held in *Universal City Studios Inc v Mukhtar & Sons*,¹⁷ where Templeman J observed that, even if defendants were wholly ignorant of the plaintiffs’ rights they should

not object to handing over the infringing articles for safe custody. Since circumstances showed that a notice might enable them to destroy the articles, the Court allowed an *ex parte* order requiring defendant to hand over the infringing articles, subject to undertakings by the plaintiffs to preserve defendant's rights.

However, *Anton Piller order* is used in other context as well. In *EMI v Sarwar and Haidar*,¹⁸ the Court allowed a term to be added to the order which provided for the discovery of names and addresses of the defendants' suppliers and customers. In *Yousuf v Salama*,¹¹ the order was granted with respect to non-industrial property that was not itself the subject matter of the action.

Jurisdiction

While in *Anton Piller KG v Manufacturing Process*,¹⁹ Lord Denning had to rely on the inherent jurisdiction of the Court to allow the order, in *Ex Parte Island Records Ltd and Other*,²⁰ the Court located this power under its equitable jurisdiction to grant an injunction to protect a person who had a private right or interest which was being interfered with by a criminal act and who was thereby caused or threatened to be caused special damage over and above that suffered or likely to be suffered by the general public.

Rights and Obligations of a Plaintiff

Under an *Anton Piller order*, the plaintiffs get the right to enter premises of the defendants and search for the incriminating materials and documents.²¹ They also have the right to remove those articles for the safe-keeping, with the undertaking that once the initial purpose is served they will be returned to the defendants. In *EMI Ltd v Pandit*,³ it was held that placing of the defendants' documents in the safe custody of the plaintiffs' solicitors is really a part of the process of delivery.

Whether plaintiff can seek to cross-examine the defendants for the purpose of eliciting material was discussed in *RAC Ltd v Allsop* and it was decided in negative.²²

Similarly, they cannot insist on making available some confidential information to the Judge alone, without ever giving it to the defendants. This was discussed in *WEA Records Ltd v Visions Channel 4 Ltd*.²³ The Court answered in negative because the issue is to be considered only on the basis of evidence known to both the parties. The Court also rejected the

practice to prevent the defendant's solicitors from accessing the information, since they too are officers of the court who deserves the same treatment as the counsel.

The plaintiff also has a right to obtain necessary information to safeguard their business and in particular their trademarks and goodwill from a serious and sustained assault and that cannot be defeated even if there is a threat to the informing-defendant's life. This was held in *Coca-Cola Co v Gibley*.²⁴

The plaintiff also has an obligation to give cross-undertaking in the appeal for the order itself, so that if there are unwanted damages done to the defendant, he can be recompensated and an undertaking for the safe custody of the materials till the matter is disposed, vide *Customs and Excise Commissioners v A E Hamlin & Co*.²⁵ They also have a duty to ensure that the documents or materials that are recovered from the defendants' premises are not used for any ulterior purpose. The general rule, as was observed by Jenkins J in *Alterskye v Scott*,²⁶ was approved and adopted by Lord Diplock J in *Home Office v Harman*.²⁷ However, if justice so requires, Court can modify the undertaking as was held in *Crest Homes Plc v Marks and Others*.²⁸

Rights and Obligations of the Defendants

Apparently, the most important right in the defendants' armour is that they can refuse the entry. They retain the discretion whether to allow the plaintiff to enter their premises and seize the documents or materials. This volitional element is what makes the *Anton Piller order* different from a 'Search' order. However, they do this at their own peril. Lord Ormond, in *Anton Piller KG v Manufacturing Process*,⁴ was very clear about the fact that the order being an order *in personam*, the defendant has the discretion to refuse to comply with such an order, but at his peril of further proceedings for contempt of Court, if his application fails. The basis of the contempt is not related to the merits of the case but to disobeying a Court order. Potentially, even an innocent defendant opposing an improper *Anton Piller order* could be found guilty of contempt. In *Wardle v Myristis Ltd*,²⁹ Gouling J held that disobedience to an order was contempt even if the order was later discharged.

Another important right of the defendant is to consider and receive advice. This provision for taking legal advice was considered to be an important

safeguard by Nicholls V C, in *Universal Thermosensors Ltd v Hibben*.³⁰ To enable the defendants to take effective legal advice, the Court laid down that *Anton Piller orders* should be permitted to be executed only on working hours when a solicitor can be expected to be available.³¹

However, like plaintiff, the defendants too cannot insist on giving the confidential information to the judge alone to the exclusion of the plaintiffs. This was settled after the decision in *Coca-Cola Co v Gibley*.³²

Privilege against self-incrimination, issue was first brought in *Rank Film Distributors Ltd v Video Information Centre*,¹⁰ where the plaintiffs, obtained preemptory orders for discovery and interrogation requiring instant obedience and the defendants were informed by the penal notice on the order that disobedience would expose them to penal consequences. This was therefore no ordinary order for discovery or interrogatories where the party interrogated has the opportunity to consider and take legal advice before deciding whether to comply with the order. The Court of Appeal held that part of the orders requiring disclosure was contrary to the well-established principle of privilege against self-incrimination. This was again upheld by the House of Lords.³³

The decision led to the enactment of Section 72 of the Supreme Court Act, 1981, which provided for the withdrawal of the privilege in civil proceedings pertaining to infringement of intellectual property rights or passing off. But in cases to which Section 72 does not apply, the privilege remains intact. In *Tate Access Floors Inc v Boswell*,³⁴ this was approved. Section 72 withdrew the privilege from not only the intellectual property offences but also in relation to 'related offences'. What is the ambit of 'any offence' was discussed in *University City Studios Inc v Hubbard*,³⁵ where the Court had held that any offence' within Section 72(5)(b) was not restricted to any offence in connection with the infringement of copyright or passing off and can include even those cases, which are remotely related to copyright or trademark infringement.

In *A T & T Steel Ltd v Tully*,³⁶ Lord Templeman J, observed that privilege against self-incrimination exercisable in civil proceedings is an archaic and unjustifiable survival from the past, when the court directs production of relevant documents and requires the defendant to specify his dealings with the plaintiff's property or money. However, in *Tate*

Access Floors Inc v Boswell,³⁴ Browne-Wilkinson V-C, observed that when there is a real risk of a conspiracy charge, the courts do not make *Anton Piller orders*, even if it entails destruction of vital evidence.

So, in essence the defendant has generally no privilege against self-incrimination in case of intellectual property offence or other related offences. But there can be safeguard against this self-incrimination and this was provided in *IBM United Kingdom Ltd v Prima Data International Ltd*,³⁷ where, Sir Mervyn Davies QC held that an *Anton Piller order* which would expose a defendant to a real risk of criminal prosecution could only properly be executed if it contained a proviso which adequately protected the defendant's right to claim privilege against self-incrimination. For the execution of the order one has to prove that (i) the defendant had been informed of his right as preserved by the order, namely, that there would be no entry if he claimed privilege and (ii) the defendant then expressly declined to claim that right. In this case, the Court found that the order preserved the defendant's privilege against self-incrimination and its scheme had been faithfully observed. Basing on this fact, even when the director was in danger of criminal proceedings for conspiracy, the Court dismissed the appeal.

So, in essence, the case provides that unless some such mechanism, like the one provided in the proviso, is included in the order, the Court should not make an *Anton Piller order* including provisions likely to require the defendant to incriminate himself. If such an order is made, it is liable to be set aside.

Remedies Available to a Defendant

On successful discharge of the case, defendant, as a matter of right is entitled to claim compensation based on the cross-undertaking. In *Columbia Picture Industries v Robinson*,³⁸ Scott J found that preliminary order was obtained improperly. He, accordingly, awarded compensation and aggravated damages to the tune of £ 10,000 on the plaintiff's undertakings.

If consequent on the grant of the *Anton Piller order* the evidence shows that the order was not as strong as it ultimately become, can the *ex parte* order subsequently set aside- this issue was discussed in *WEA Records Ltd v Visions Channel 4 Ltd*.²³ Following *Hallmark Cards Inc v Image Arts Ltd*,³⁹ the

Court held that once the order has been executed, it becomes a spent force and hence it cannot be set aside. The only remedy in such cases would be to claim damages as provided in the counter-undertaking, but not in setting aside of the order.

Ab(use) of *Anton Piller* – The Problems and the Solutions

Anton Piller orders are often dubbed as the ‘nuclear weapons’ of the law which have tremendous power. It is well known that, ‘power corrupts and absolute power corrupts absolutely’- it too has the potential to be misused to detriment to the plaintiffs.

Fortunately, it was not long before that the English Courts started looking into this aspect. The hard reality showed them that *Anton Piller orders* can be misused and it has the potential to even disrupt the victim’s business or invade his privacy. And if any one is to be blamed for it, it surely would be the Court, which allowed the ‘[B]alance to swing too much too far in favour of the plaintiffs.....’³⁸ The main reasons for such may be because, the orders were granted too readily without any adequate safeguards for the respondents.

A number of aspects of the *Anton Piller order* raise concerns. Scott J, in *Bhimji v Chatwani*,⁴⁰ showed the difficulties encountered in the application and the implementation of the *Anton Piller order*. These are:⁴¹

- Involve the court in the hypocrisy of pretending that the entry and search are carried on because the owners of the premises have consented to it. We have already seen in the previous chapter that they do this but at the risk of being prosecuted for contempt of court. This is a serious problem for the defendants because reality has shown that in very few cases, defendants had sufficient resource to challenge the order and contest the plaintiff of ‘big standing and deep pocket’.³⁸ Moreover, as Dockray and Laddie had pointed out, there is problem even with the ‘consent’ procedure. They pointed out the difficulty, if the order allows the solicitor to serve it on the person in charge of the premises. The problem is that by doing so, you are actually taking the defendants’ agent’s or servant’s consent. Where as the orders are actually *in personam*, this practice makes it an order *in rem*, thus depriving the defendant of his choice to refuse and apply for the discharge of the order.⁴²

- Impose on the plaintiffs’ solicitors almost impossible task of describing fairly to non-lawyers, the true effect and nature of the orders. One of the reasons may be due to the lack of good working knowledge, as it is not a part of formal legal procedure.⁴²
- Present respondents with orders of great complexity and jurisprudential sophistication and give little time for decisions to be taken to the response to be made to them. This is again with respect to the dilemma faced by them to give consent or refuse it.
- Vest the plaintiffs, one side in what is usually highly contentious litigation, with the trappings of apparent administrative authority to carry out the search. The usual presence of a policeman adds to this illusion.

The potential of abuse of *Anton Piller orders* were noted by Scott J in *Columbia Picture Industries v Robinson*.³⁸ The main objection to *Anton Piller order* is that such an order often results in damaging and irreversible consequences, without allowing the defendant to contest by providing a chance for hearing. The matter worsens if the defendant is lacking means or strength of purpose to pursue for relief under the cross-undertaking.

The safeguards were provided in *Columbia Picture Industries v Robinson*, *Universal Thermosensors Ltd v Hibben*⁴³ and also by the Chief Justice,⁴⁴ the list of safeguards as follows:

Application Stage

- The application, where practicable, has to be lodged with the Judge at least two hours before the hearing.
- The plaintiff has to make a full and frank disclosure of all relevant facts and considerations.
- The application has to mention the experience and identity of the neutral solicitor.

Framing of Order

- Undertaking by the plaintiff to pay damages or security bond for damages.
- Items to be returned to their owner as soon as possible.
- The *Anton Piller order* must provide minimum extent which is necessary to achieve the purpose of collecting evidences which otherwise would have been destroyed.

- An undertaking that evidence will be used only in the proceeding for which the order is made.

Service of the Order

- Plaintiff has to be attended by a neutral and experienced solicitor.
- Defendant should be allowed to challenge by providing for a legal assistance.
- No forcible entry.
- Limitation on the number of persons that can enter the premises.
- Order to be served at normal office hours.
- Where the premises are likely to be occupied by an unaccompanied woman and the supervising solicitor is a man, he has to be accompanied by a woman.

Execution Stage

- Order to be executed during office hours.
- A detailed record of the materials removed has to be prepared.
- Only a neutral solicitor should execute the order.

Application of *Anton Piller Order* in Indian Legal System

Intellectual property law protects use of ideas and information that are of commercial value and prevents others, to the exclusion of the owner of the property, to commercially exploit the material without the owner's consent. With the rapid growth of industrialization and international trade, protection of this intellectual property and *vis-à-vis* to have sufficient safeguards, in the form of Rules or Statutes, has gained immense importance.

India can boast of a sound legal regime to deal with the intellectual property protection. The considerable number of statutes that India has, to deal with intellectual property issues, is itself an indication of her concerned attitude towards protection of intellectual property issues. The various Indian Acts are: Copyright Act, 1957, Trade Marks Act, 1999; Patents Act, 1970 (as amended by Patents [Amendment] Act, 2005), Designs Act, 2000; The Geographical Indications of Goods (Registration and Protection) Act, 1999; The Semiconductor Integrated Circuits Layout-Design Act, 2000 and last but not the least, Protection of Plant Varieties and Farmers' Rights Act, 2001.

Apart from laying down what are the rights available to the intellectual property owner, these

Acts also contain a sound mechanism to prevent infringement of IPR. The remedies available for protection of IPR are broadly classified into civil and criminal remedies. The orders in line of *Anton Piller order* are made under the head of civil remedies.

In India, Ordinance 39 of the Civil Procedure Code, 1908, authorizes court to issue orders in the line of *Anton Piller order*. Not only CPC, even the statutes like Trade Marks Act, 1999, The Geographical Indications of Goods (Registration and Protection) Act, 1999 specifically provide for such an order.

However, there have not been much case-laws debating over the aspects of *Anton Piller order*. One of the earliest case that dealt with the concept of *Anton Piller order*, though cursorily was *National Garments v National Apparels*.⁴⁵ Though, it was not a case under *Anton Piller* but under interlocutory injunction, for restraining the defendant from doing business under the trade name which is in dispute, the court cited with approval from Kerly's treatise that 'in extremely urgent cases an *ex parte* injunction may be obtained before full hearing of the motion or an *Anton Piller order*, for inspection of the defendant's premises without prior warning and discovery of his records, may be obtained. The Court also observed that *Anton Piller order* is similar to the *ex parte* interlocutory order to take an inventory of the articles etc. passed in an ordinary suit.⁴⁶

The importance of acting under good faith, full and frank disclosure in case of an order in the line of *Anton Piller order* was highlighted in the recent case, *Bucyrus Europe Ltd v Vulcan Industries Engineering Co Pvt Ltd*,⁴⁷ In this case, the appellant-plaintiffs were granted an *ex parte ad interim* order of injunction restraining the defendant from manufacturing, selling, stocking for sale, offering for sale, marketing, advertising and distributing in any other manner or dealing with the impugned product of the defendant having been produced from any of the drawings or any design substantially similar thereto by using engineering, design, shape and configuration and get-up of the appellant. The High Court allowed the order for a limited period of 14 days and appointed a learned Counsel as Special Officer to look over the proceedings. After the Special Officer filed his report, a full contested hearing took place on the question of grant and continuance of *ad interim* order. The learned Counsel for the defendant, submitted that the averments which have been made in the *ex parte* application for interim order, did not disclose the state

of affairs fully, in the sense that they suppressed the fact that the defendant had filed three applications for cancellation of the registration of designs of the appellant. Section 19 along with Section 22 of Designs Act, the defendant contended since those grounds for cancellation of design provide good defence, the Court ought to take note of the defendant's grounds for cancellation of registration. Since, the appellant suppressed the cancellation proceedings, the Counsel for the defendant contended that there was no ground for granting of the order. The plaintiff's attempts to bring the case under Copyright protection failed miserably, when the Court pointed out that 'design' as defined u/s 2(d) of Designs Act does not include any artistic work as defined u/s 2(c) of the Copyright Act.

While deciding the case, Ashok Kr Ganguly J, observed that an *Anton Piller order* can be passed in the following situations:

- (a) Where the plaintiff has an extremely strong *prima facie* case,
- (b) Where the actual or potential damage to the plaintiff is very serious,
- (c) Where it was clear that the defendant possessed vital evidence, and
- (d) There was a real possibility that the defendant might destroy or dispose of such material so as to defeat the ends of justice,
- (e) The purpose of *Anton Piller order* is the preservation of evidences.

The Court also mentioned about the safeguards that have to be provided while granting *Anton Piller order*, like undertaking by the plaintiff to compensate the defendant for the losses he wrongly suffered.

Regarding the validity of the *ex parte* injunction, the Court referred to *Bengal Club Ltd v Susanta Kr Chowdhury*,⁴⁸ where the Court had emphasized on the importance of good faith in the pleadings in the context of an *ex parte* application for injunction. Since at the application stage, there is no contested hearing, the Judge has to rest on the plaintiff's submission and hence good faith assumes much importance. Following this, the Court held that utmost good faith of the plaintiff is condition precedent for granting an injunction on the lines of *Anton Piller order*, and in the absence of such, it rejected the application.

This case has explained the requirements of an *Anton Piller order*. The Court while granting the

ex parte injunction tried to incorporate the safeguards evolved by English Courts in India. The judgment itself notes some of the safeguards, e.g., issue of the order for a limited period, appointment of a learned Counsel as Special Officer to carry out the execution, providing the defendant an opportunity to take legal advice, etc.

However, few questions were still left unanswered, like:

- In this case, the defendant fully co-operated with the solicitor. So, the question regarding whether a refusal would entail a proceeding against the defendant for contempt of Court is still unsettled.
- The case did not deal with the issue of cross-undertaking, the most important safe-guard for the defendant. The Court dismissed the case with costs and directed the costs to be paid in favour of Calcutta High Court Legal Services Authority and no mention was made of compensating the defendant. So, there are serious concerns regarding what would be the relief to the defendant, if he suffers damages from the order.
- The most critical question that was not dealt was regarding privilege against self-incrimination. Unlike England, in India there is a fundamental right, granted by Article 20(3) of the Constitution of India. So, regarding privilege against self-incrimination, whether any exemption, in the line of Section 72 of the UK Supreme Courts Act, 1981, could be culled out still remains unanswered.
- The Court did not lay down any guidelines regarding practice procedure, in the line of Practice Direction in UK. However, one can find solace in the fact that the Court has tried to incorporate practice, which has already been taken note of.

The application of *Anton Piller order* in India is still in nascent stage and lot many questions are still left unanswered. It is hoped that, taking clue from the English cases, the Indian Courts would apply the order only sparingly and with all the necessary safeguards.

However, researchers believe that it is high time that both Judiciary and Legislature should come forward to lay down substantive guidelines, covering all the critical aspects like, privileges against self-incrimination, nature of damages, contempt of Court, etc. to ensure more clarity in the whole proceedings.

Conclusion

To promote arts and sciences, to safeguard consumers, to protect investments, goodwill and trade-secret and last but not the least, for dissemination of knowledge, protection of IPR is a *sine-qua-non*. One of the ways of ensuring, and undoubtedly the most effective one, is by issuing an *Anton Piller order*- an extra ordinary relief in the form of an *ex parte interim order*, which allows the plaintiff to enter and search the defendant's premises, with his consent.

Anton Piller order is an important and a very potent weapon in the plaintiff's arsenal. Due to its enormous power, if not used sparingly, it can be abused to a large extent. English Courts, who were the propounder of this order, too became aware of its potential of being misused and have worked in tandem with the legislators to provide certain guidelines for its proper use. Lately, it is not the plaintiff's, but safeguarding of defendant's interest from the abuse of *Anton Piller order*, that has been taking the centre-stage. The various safeguards and Practice Direction, is a pointer towards that trend.

The application of *Anton Piller order* in India is still in nascent stage and lot many questions are still left unanswered. But with awareness of the possible misuse of this order and also the safeguards, the similar sort of abuses that took place in UK, can be prevented by following safeguards and using it sparingly. For that, there is a need for substantive guidelines, which would deal with all the relevant considerations like issue of self-incrimination, relief to be given to the defendant, plaintiff's rights and obligations, defendants' rights and obligations etc. Moreover, for its proper application, there is need to educate people about the pros and cons of this order, thereby ensuring proper functioning of *Anton Piller order*.

References

- 1 Perkins and Mills, Patent infringement and forum shopping in the European Union, *Fordham International Law Journal*, 20 (1996) 579.
- 2 (1980) 3 All ER 405 at 406. Lord Denning MR after remarking that the plaintiff's solicitor could take copies of the documents under an *Anton Piller order* remarked that,These files here are not the subject matter of the action. But they are the best possible evidence to prove the plaintiff's case. There is a genuine fear that, if the plaintiff waits till after the application is heard, the first defendant may destroy the documents before the date of the hearing. That is the sort of danger which the *Anton Piller order* is designed to prevent.
- 3 (1975) 1 All ER 418.
- 4 (1976) 1 All ER 779. The name '*Anton Piller*' was also derived from this case.
- 5 (1976) 1 All ER 779. In this case, the plaintiff, the German manufacturers of sophisticated electrical components, after discovering that the defendants, their UK agents, were passing the drawings and other confidential information to other German companies, sought an *ex parte* order to restrain them from infringing copyright and misusing confidential information. They also sought an *ex parte* order permitting them to enter the premises of the defendants for inspection of the documents etc.
- 6 (1821) 3 Bil 153.
- 7 (1983) FSR 313.
- 8 Dockray and Laddey, Piller problems, *Linear Quadratic Regulator*, 106 (1990) 601.
- 9 (1976) 1 All ER 779.
- 10 (1980) 2 All ER 273.
- 11 (1980) 3 All ER 405 at 406.
- 12 Godin, *Anton Piller orders* in an age of scepticism: Charter application and other safeguards for judicially-ordered searches, *University of Toronto Faculty of Law Review*, 54 (1996) 107.
- 13 (1986) 3 All ER 338.
- 14 (1985) FSR 184, 189.
- 15 (1988) 3 All ER 188.
- 16 (1984) 3 All ER 381. In this case, when the plaintiffs served their statement of claim in the action, the defendants served a counterclaim in which they raised three causes of action based on the *Anton Piller order*, but not arising out of the plaintiffs' cross-undertaking as to damages. The causes of action were (a) abuse of the process of the court by obtaining *Anton Piller order* on the basis of an implied representation that full and frank affidavit had been placed before the Court when that was not the case, (b) negligence arising out of a breach of a duty owed by the plaintiffs to the defendants to place full and frank evidence before the Court when seeking the order and (c) trespass in securing entry to the defendants' premises by means of a wrongfully obtained *Anton Piller order*. The defendants claimed exemplary damages on counterclaim. The plaintiffs applied to strike out the paragraphs of the counterclaim raising the three causes of action, on the ground that they disclosed no reasonable cause of action and were frivolous or vexatious. Their appeal was granted and the defendants applied against the decision before the Chancery Court.
- 17 (1976) 2 All ER 330.
- 18 (1977) FSR 146.
- 19 (1976) 1 All ER 779. In this case the Court, on the jurisdictional issue to grant an *Anton Piller order*, went to the extent that even if the statute is silent (in the instant case, the statute was Dramatic and Musical Performers' Protection Act, 1958) regarding the power to institute a civil right of action against unauthorized recorders, the Court has the jurisdiction to exercise such power.
- 20 (1978) 3 All ER 824.
- 21 However, this right is subject to the free consent of the defendant and unless the defendant so authorizes the plaintiff cannot forcibly enter the premises.
- 22 In this case, the plaintiffs were granted an *Anton Piller order* against the defendants who served affidavits in compliance

- with it. The plaintiffs were dissatisfied with them as being incomplete and inconsistent with what had been disclosed as the execution of the order. They sought leave to cross-examine the defendant, which was turned down by the Court.
- 23 (1983) All ER 589 at 591.
- 24 (1995) 4 All ER 711. In this case, the plaintiffs, succeeded in identifying certain individuals engaged in the activity and initiated suit against them for infringement of trade mark and passing off. Plaintiff was subsequently joined as a defendant and an *Anton Piller order* was duly made against him, requiring him to disclose all the relevant information as is needed to expose the other defendants. Plaintiff accepted that there was a *prima facie* case in respect of his involvement in the activities of the organization, but refused to disclose the information requested and applied to the Court to discharge the order in so far as it required him to do so. One of the grounds for plaintiff's refusal was that such disclosure would jeopardize his safety and that of his family. However, he agreed to give the information to the judge, on the condition that such would not be divulged to the plaintiffs, as such disclosure at any time would expose him to risk.
- 25 (1983) 3 All ER 654.
- 26 (1948) 1 All ER 469 at 470.
- 27 (1982) 1 All ER 532.
- 28 (1987) 2 All ER 1074.
- 29 (1984) FSR 263 at 271, cited with approval in *Columbia Picture Industries v Robinson* (1986) 3 All ER 338.
- 30 (1992) FSR 361.
- 31 In this case, the plaintiff entered the defendant's house at 7.15 am, and the defendant's wife could not seek legal advice as no one was present at that time in the morning.
- 32 (1995) 4 All ER 711.
- 33 (1981) 2 All ER 76.
- 34 (1990) 3 All ER 303.
- 35 (1985) 2 All ER 596.
- 36 (1992) 3 All ER 523 at 530.
- 37 (1994) 4 All ER 748.
- 38 (1986) 3 All ER 338.
- 39 (1977) FSR 150.
- 40 (1992) 4 All ER 912.
- 41 Khoury Amir H, Role of the Judiciary in intellectual property: A Focus on *Anton Piller orders*, <http://www.iipi.org> (12 December 2005).
- 42 Dockray and Laddey, Piller problems, *Linear Quadratic Regulator*, 106 (1990) 610-612.
- 43 (1992) 3 All ER 257.
- 44 (1994) RPC 617.
- 45 (1990) PTC 98.
- 46 Supreme Court's attitude on granting of an *ex parte* injunction can be inferred from *Morgan Stanley v Kartick Das*, where the Supreme Court indicated the factors which should weigh with a Court in the grant of an *ex parte* injunction:
- 1 Whether irreparable or serious mischief will ensue to the plaintiff;
 - 2 Whether the refusal of *ex parte* injunction would involve greater injustice than grant of it would involve;
 - 3 The Court will also consider the time at which the plaintiff first had notice of the act complained of so that the making of an improper order against a party in his absence is prevented;
 - 4 The Court will consider whether the plaintiff had acquiesced for some time, and in such circumstances it will not grant an *ex parte* injunction;
 - 5 The court would expect a party applying for *ex parte* injunction to show utmost good faith in making the application;
 - 6 Even if granted, the *ex parte* injunction would be for a limited period of time;
 - 7 General principles like *prima facie* case, balance of convenience and irreparable loss would also be considered by Court.
- 47 2005 (30) PTC 279.
- 48 2002 (3) CHN 322.