THE ANTON PILLER ORDER 2 DECADES LATER: THE BALANCING ACT GOES ON

INTRODUCTION

In December 1975 the English Court of Appeal handed down its decision in *Anton Piller KG* v *Manufacturing Processes Ltd*[1]. Since then, much water has flowed under the bridge. During this period the boundaries of the Anton Piller order have progressively been extended. Also, what was envisaged by the Court of Appeal to be a remedy that would be available only in extreme cases has since become nearly common-place with courts readily granting applications for such orders. This in turn led to the nearly inevitable rise of abuses by some of those litigants granted such orders with the resultant "clamp-down" by the courts. And so the saga continues.

As a common-law remedy the Anton Piller order has gone through considerable changes and one wonders whether the original judges of the Court of Appeal who pioneered the grant of the order in *Anton Piller KG* v *Manufacturing Processes Ltd.* would ever have envisaged the way the order has since developed.

In view of the draconian nature of the order, the Court of Appeal in *Anton Piller* was particularly concerned to see that restrictions be placed on the circumstances under which Anton Piller orders are granted and safeguards imposed to protect the interests of defendants.

This paper will consider the issue of the continuing conflict between the demands on courts to ensure that the restrictions are adequate whilst not being overly restrictive and the continuing conflict between ensuring adequate safeguards against defendants' rights being abused and the practical operation of Anton Piller orders. Given the ever increasing number of court cases dealing with Anton Piller orders and the ever increasing number of articles and books written on the order[2] this paper must of necessity be restricted to these two issues rather than attempting to review the entire area of law and its development.

The two issues considered are at different stages of the operation of Anton Piller order, the first being at the stage of application for the grant of an Anton Piller order and the latter being at the stage of service of the order.

1 [1976] Ch. 55.

2 see "Anton Piller Relief — Palatable in Europe?" — K Puri S I.P.J. December 1994 347, whore he notes at page 371 footnote 81 that he has come across more than 70 legal articles and a lew books written on this topic. That was in 1994. No doubt there have been more articles written since then.

In considering these two issues the original order of the court in *Anton Piller* will be revisited and the two recent instances of the courts' "clamp-down", namely *Columbia Picture Industries* v *Robinson*[3] and *Universal Thermosensors* v *Hibben*[4] will be examined in conjunction with the subsequent practice directions issued by courts in various countries in response to *Universal Thermosensors*. In particular, this paper will consider the continued attempts at balancing the interest of both parties to a dispute in what is essentially a high risk high stake environment where Anton Piller orders are concerned. This paper will also consider some difficulties arising from the restrictions and safeguards imposed in these latest court decisions and practice directions.

Experience in the past 22 years signals that improper issue of Anton Piller orders coupled with voracious and abusive procedures employed in executing them has caused excessive violations of defendants' rights. Unless this powerful and exceptional form of relief is regulated by legislation or constrained by appellate courts, there is the risk that this very useful weapon could fall into disrepute.

Amongst other things, unscrupulous plaintiffs with the assistance of their solicitors can exploit the procedure to drag out the defendant's case and to gain access to the defendant's confidential trade and commercial information, or simply to carry out fishing expeditions. This paper will look at the safeguards imposed by the courts to prevent further abuses.

NATURE OF THE ORDER

The order's name is derived from *Anton Piller KG* v *Manufacturing Processes*. The purpose of the order is to prevent a defendant interfering with discovery and frustrating trial, by destroying documents or evidence, such as copies of the plaintiff's products, which might show his wrongdoing.

The Anton Piller order along with the Mareva injunction have been described as the "nuclear" weapons in the litigation arsenal[5]. Whilst this may describe to some extent the decisive effect of its use, it may be more accurate to compare these two weapons to the hypothetical situation of the Japanese having the atom bomb and using it at Pearl Harbour. In other words, not only is the use of these two weapons decisive but, as has been pointed out[6] the key to these two weapons is the element of surprise which the order offers by virtue of it being obtained ex parte.

3 [1986] FSR 367, [1987] 1 Ch. 38, [1986] 3 WLR 542, [1986] 3 All ER 338.
4 [1992] FSR 361, [1992] 3 All ER 257 (Ch. D.).
5 per Donaldson L.J. in *Bank Mellat* v *Nikpour* [1985] FSR 87 at 92.
6 E.J. Gaze "The Anton Piller Order — A Review of its development and scope" (1985) 13 Aust. Bus. L. Rev. 354 at 357.

Whilst the use of a nuclear weapon may well decide the outcome of a case (unless the weapon has been improperly obtained or used) being surprised by its use (indeed even by the fact of its existence) serves only to increase the chances of not just capitulation but capitulation at an early stage of the case. This is supported by the fact that most cases are settled without going to trial[7] and that the first case involving an Anton Piller order that went to full trial was *Columbia Picture Industries Inc.* v *Robinson* which was well over 10 years after the order was first granted.

The Anton Piller order permits the plaintiff to demand entry to the defendant's premises, business or residence to search them, and to remove for a short time documents or other items which might form evidence in his or her action or proposed action against the defendant. Generally the order will provide that it must be served by an independent solicitor in the company of the plaintiff's solicitor. The plaintiff's solicitor then executes the order, supervised by the independent solicitor. Alternatively, the order may provide for service and execution by the plaintiff's own solicitor without supervision[8].

Anton Piller orders may be granted in the same order as a Mareva injunction and the court may also grant other ancillary orders at the same time e.g. an order restraining the defendant from leaving the jurisdiction[9].

The three principal areas in which Anton Piller orders are used are:

a. infringement of Intellectual Property rights

b. anti-competition cases

c. matrimonial proceedings

This list is non-exhaustive. But doubt has now been thrown on whether Anton Piller orders should be restricted to Intellectual Property cases only by the development of the doctrine of self-incrimination[10].

THE UNIQUE FEATURES OF ANTON PILLER ORDERS

In granting the order, the Court of Appeal in *Anton Piller* made it clear that such orders were to be the exception rather than the rule. According to Lord Denning such orders "should only be made where it is essential that the plaintiff should have inspection so that justice can be done between the parties"[11].

7 see Ough, "The Mareva Injunction and Anton Piller order" at page 55.
8 Ibid.
9 *Bayer AG* v *Winter* (No. 1) [1986] 1 WLR 497, CA.
10 see *Tate Access Floors Inc* v *Boswell* [1991] Ch 512 per Sir Nicholas Browne-Wilkinson VC at 530E.
11 n. 1 at page 61.

Ormrod LJ added that such an order "is at the extremity of this Court's powers. Such orders, therefore, will rarely be made, and only when there is no alternative way of ensuring that justice is done to the applicant"[12].

Thus, the first of the three unique features of Anton Piller orders as enunciated by the Court of Appeal in *Anton Piller* is the fact that such orders may only be made in extraordinary circumstances where there is no other way of ensuring that justice can be done. Unfortunately, the Court of Appeal, in identifying this unique feature, passed up the opportunity to say what would make a case exceptional with the consequence that 20 years later we still have no guidelines to aid us in deciding whether any particular case does or does not fall within the term "exceptional".

The second unique "and perhaps, the most significant"[13] feature is that the orders purported to cover inspection and removal of documents and other property and they are mandatory in form and are designed for immediate execution.

Scott J has gone on to say in *Bhimji* v *Chatwani*[14] that:

> "[I]t is fundamental to the theory of Anton Piller type orders that a civil court in civil proceedings has no power to give one citizen the right to enter a house or premises of another citizen. These orders are *in personam* orders directed to the defendants. The defendants are ordered to allow entry and to allow search. The plaintiff's right and their solicitors' right to enter and search is derived, on this theory of the law, from the defendant's permission given to them to do so. It is not derived from the power of the court to confer the right. The court does not have that power."

One of the important safeguards an innocent defendant has is to apply to discharge an order on the ground that it was wrongly granted. But the fact remains that setting aside the Anton Piller order cannot undo what has already been done since it is impossible in practice to reverse the physical effects once it has been executed[15].

The third unique feature is that these orders are made on an ex-parte application, thus ensuring the element of surprise for the plaintiff.

12 n. 1 at page 61.
13 per Scott J in *Columbia Picture* [1987] Ch. 38 at page 71.
14 (1991) 1 AH E.R. 705 at 708.
15 See for instance *Alertext Inc.* v *Advanced Data Communications Ltd* [1985] 1 W.L.R. 457 at 461.

A. THE CIRCUMSTANCES UNDER WHICH AN ANTON PILLER ORDER MAY LEGITIMATELY BE SOUGHT.

The essential pre-conditions for a grant of an Anton Piller order

As Anton Piller orders are a form of *ex parte* injunction, the requirements for grant of an *ex parte* injunction are equally applicable so that, for instance, the applicant must show that he or she has a cause of action subsisting at the time of the application[16].

In allowing the plaintiff's appeal and granting the order in *Anton Piller KG* v *Manufacturing Processes* the Court of Appeal set several "essential pre-conditions" (per Ormrod LJ) for making an Anton Piller order. According to Ormrod LJ there must be three "essential preconditions"[17]. These are:

a. there must be an extremely strong prima facie case;

b. the damage, potential or actual, must be very serious for the applicant; and

c. there must be clear evidence that the defendants have in their possession incriminating documents or things, and that there is a real possibility that they may destroy such material before any application *inter partes* can be made.

According to Dockray and Laddie[18] Lord Denning M.R. in effect added a 4th pre-condition when he said that an order should only be made if "the inspection would do no real harm to the defendant or his case"[19]. However, this fourth pre-condition is not universally recognised and many writers, even if they do refer to it, do not treat it as of equal importance as Ormrod LJ's three pre-conditions[20]. Indeed, had greater heed been given to this fourth pre-condition many of the cases involving wanton abuse of the *Anton Piller* procedure may never have arisen.

An examination of the pre-conditions

It is difficult not to agree with Dockray and Laddie's view[21] that "it is true that none of the preconditions is free from ambiguity". One needs to look no further than the first of these preconditions (that there must be an extremely strong prima facie case) to see the difficulty as the standard

16 *Veracruz Transportation Inc.* v *V C Shipping Co. Inc and Den Norske Bank A/S, The Veracruz* I [1992] 1 Lloyd's Rep 353, CA.
17 n. 1 at page 62.
18 'Piller Problems' (1990) 106 LQR 601 at 605.
19 n. 1 at page 61.
20 See for instance Gaze n. 6.
21 n. 18 at page 605.

required would, of necessity, have to be subjective to avoid the sort of restrictiveness the Anton Piller order was designed to avoid. However, having a subjective standard must mean the possibility that what one judge may reject as insufficient may well be sufficient to another. After all, is this not what happened when the order in *Swedac Ltd* v *Magnet & Southern Plc*[22] was granted when subsequent events proved the situation to be a case which was plainly without merit? The original judge hearing the application for an *Anton Piller* order in *Swedac* must have believed that in his or her subjective opinion there was an extremely strong *prima facie* case.

Indeed, Harman J. in his judgement in *Swedac*[23] stated,

> 'Judges who have not spent their professional lives dealing with these problems raised by what is called "Intellectual Property Law' cannot be expected to be familiar with such matter'.

This statement must be equally applicable to judges unfamiliar with anti-competition cases or matrimonial proceedings, as those are the other areas in which Anton Piller orders are granted. Certainly, this statement must be particularly applicable in those countries or jurisdictions with a small number of judges. This is all the more so in countries with few judges with experience in hearing Anton Piller applications. Again, this may be further aggravated by the local conditions in such countries, conditions which may mean that whilst not unpopular there may be insufficient instances justifying an application for an Anton Piller order with the result that both the Bar and the Bench may be less experienced and thus apply widely differing standards.

Added to this is Dockray and Laddie's observation[24] that in practice "it is rare for courts to consider expressly whether the plaintiff's case really is extremely strong; or whether damage to the plaintiff is very serious and orders often seem to have been made (at least where commercial piracy was alleged) on a mere suspicion and without any direct evidence that incriminating evidence would be destroyed if proceedings were commenced openly." In their view the impression from reported and unreported cases is that orders are routinely made in cases in which the spirit and letter of Ormrod LJ's three preconditions are not satisfied.

There is much to be said for their contention that this state of affairs is due to the fact that affidavits are not always drafted and applications not always made in such a way that the attention of the court is drawn to each of the separate preconditions and that, faced with applications made in this way, the court does not always raise the issue of its own motion, but may simply respond to the application as presented.

22 [1989] FSR 243.
23 Ibid at page 245.
24 n. 18 at page 605.

Then again the "way" in which such applications are made is not unique to applications for Anton Piller orders. After all our system of justice is an adversarial system. Indeed, it is for this reason that the law has made it a requirement that the applicant makes full and frank disclosure for otherwise it would be naive to expect an applicant to inform the court of anything at all which may prevent his or her application from being granted.

Regrettably this requirement for full and frank disclosure has not prevented orders from being made only in cases which meet the separate preconditions set out in *Anton Piller* and where the order is really necessary. As a prerequisite for the grant of an order it is more illusory than real. As Scott J. pointed out in *Columbia Picture Industries Inc.* v *Robinson*[25]*:*

> "The solicitor does not, and cannot be expected to present the available evidence from the respondent's point of view."

Despite this criticism, Dockray and Laddie's suggestion that the preconditions be embodied in legislation has not led to the suggestion being taken up and indeed Nicholls V-C. in his judgment in *Universal Thermosensors*, whilst referring to and adopting some of Dockray and Laddie's suggestions[26], remained silent on the need for legislation to embody these preconditions.

Could it be that Nicholls V-C.'s silence on this point is due to his disagreement with it? If we did adopt Dockray and Laddie's suggestion would we not risk the very problem which in the first place gave rise to the Anton Piller order, namely the rigid legislative and judicial procedures failing to meet the requirements of a commercial world faced with ever developing new technology which permit pirates to infringe intellectual property rights with impunity? Indeed, the problem with setting out something in legislation will always be the need to update it constantly to keep up with developments in the modern world. The problem may be more acute when we consider the fact that the nature of intellectual property rights is such that the state of the art is developing at an increasingly quicker rate.

The approach that has now been adopted with the Practice Directions[27] on Anton Piller orders is a sort of midway point between the suggestion to embody the preconditions in legislation and leaving it all to the courts. It allows for greater flexibility whilst not leaving matters entirely up to individual judges to decide.

Regrettably these Practice Directions have failed to address the situation with the preconditions, dealing only with the safeguards. So we are left for

25 n. 13 at p. 75.
26 [1992J 3 All ER 257 at page 276.
27 see page 183 and n. 51.

the moment with Ormrod L.J.'s three preconditions and Denning's fourth precondition and subsequent pronouncements by courts on the ambit of these preconditions in order to determine where the balance lies.

In doing so it should be added that two additional preconditions have now been recognised by the courts in subsequent cases. The first is that the plaintiff has a duty to make full and frank disclosure of all matters within his knowledge[28].

The second is that the plaintiff's cause of action against the defendant must be crystallized. The Anton Piller Order is not permitted to be used as a fishing expedition to determine whether or not the plaintiff has a cause of action[29].

Thus, the restrictions on the circumstances under which Anton Piller orders may be granted remains substantially rooted in case law pronouncements and will, for the foreseeable future, develop through such pronouncements.

B. THE LIMITATIONS OR SAFEGUARDS IMPOSED BY THE COURT IN RESPECT OF SUCH ORDERS.

Why it is necessary for safeguards to be imposed?

Anton Piller orders are not just offensive weapons. They are much more. After all they have been described as one of the two nuclear weapons in the litigation arsenal. Thus the harm that they can cause to undeserving defendants is potentially both serious and extensive. A defendant on whom an *ex pane* Anton Piller order is served, in the face of a demand for immediate entry, is likely to feel strong emotional reactions: shock, anger, confusion, a sense of violation and powerlessness are common recollections, even when orders are served by sensitive and tactful solicitors[30].

In the most cases, they expose the defendant to a stigma, and loss of business and goodwill. Hoffman J in *Lock International plc* v *Beswick*,[31] talks of "the humiliation and family distress which that frequently involves".

Occasionally, Anton Piller orders are sought by former employers for the alleged purpose of protecting trade secrets (e.g. list of customers) and other information of confidential nature. There is a grave risk that this

28 *Thermax Ltd* v *Schott Industrial Class Ltd* [1981] FSR 289; *Booker McConnel* v *Plascow* [1985] RPC 425.

29 *Hytrac Conveyors Ltd* v *Conveyors International Ltd* [1983] FSR 63 and see also *The Veracruz* n. 16.

30 see eg. the complaint of the applicant in *Chappell* v *U.K., European Commission of Human Rights*, Applic. No. 10461/83, Report of the Commission adopted on October 14, 1987, at p. 44; decision of the European Court of Human Rights (17/1987) March 30, 1989, noted (1990) 106 L.Q.R. 173.

31 [1989] 1 W.L.R. 1268.

process may be used, or rather abused, to prevent the employees from making legitimate use of the knowledge and skills gained during their employment[32].

As Dockray and Laddie point out "the execution of an order may cause severe, sometimes irreparable, physical disruption to a defendant's business or daily life: the process may take hours to complete. Files may be ransacked, trade disrupted and staff frightened and demoralised. An order may positively demand physical disruption as where the seizure of filing cabinets, equipment and trading stock is ordered or when computer records are required to be copied. It would be naive to believe that this is never one of the motives behind an order. An order may also cause irreparable harm to reputation"[33]. This description is not an inaccurate description of the execution of an Anton Piller order and an examination of the reported cases will reveal instances which support this description.

> "It has to be accepted that a common, perhaps the usual, effect of service and execution of an Anton Piller order is to close down the [defendant's] business ..."[34].

Indeed, the possible hidden motive of closing down the defendant's business is perhaps far more prevalent than applicants care to admit. After all, if the applicant thinks that his or her rights are being unjustifiably infringed what could be better than to stop it not just for the one instance but permanently? The instances of applicants delaying the prompt prosecution of the action once the incriminating evidence is seized may just be a symptom of this covert intention to close down the defendant's business.

In *L.T. Piver Sari* v *S. & J. Perfume* Co.[35], the drastic nature and the risk of abuse of the order was recognised:

> "[I]t is most necessary that Anton Piller orders are not allowed to become oppressive. In the hands of some solicitors one knows that in the past they have become oppressive to the point of shutting down genuine businesses because they have in fact erred and strayed in minor ways. It is therefore most important that the material which is obtained upon execution of an Anton Piller order ... should be immediately photocopied and returned"[36].

The past 20 years have shown that improper issue of Anton Piller orders together with voracious and abusive procedures employed in executing them have caused excessive violations of defendants' rights. Unless this powerful and exceptional form of relief is regulated by legislation or

32 see for instance *Lock* v *Beswick* and *Universal Thermosensors.*
33 n. 18 at page 603.
34 per Scott J. in *Columbia Picture* n. 13 at page 73.
35 [1987] FSR 159.
36 Ibid, at p. 160 per Walton J.

constrained by appellate courts, there is little chance that this forceful and otherwise effective remedy would be able to bring about justice to all parties.

Safeguards imposed by *Anton Piller*

The Court of Appeal in *Anton Piller* when granting the appeal recognised the risk that such an order could be an instrument of oppression but thought the risks acceptable in very limited circumstances and so long as certain safeguards were in place. The safeguards which the Court of Appeal imposed were:

a. limiting Anton Piller orders to extreme cases only

b. requiring the order to be executed by a Solicitor of the Supreme Court

c. every opportunity must be afforded to the defendant to protect himself and seek to discharge the order if he thinks it was wrongly obtained.

Dockray and Laddie[37] argue that these three primary safeguards do not now have the same effect that they were intended to have when they were set out in *Anton Piller*.

In *Universal Thermosensors*, Sir Donald Nicholls V-C, whilst referring to Dockray and Laddie's article, regrettably did not comment on this view, preferring to concentrate his attention on the service and execution safeguards as set out in *Anton Piller*. Presumably, his view is that by addressing the safeguards for service and execution the balance will be sufficiently tilted back in favour of the defendant. This issue will be considered later.

Safeguards imposed by *Columbia Picture Industries Inc.* v *Robinson*

In *Columbia Picture Industries Inc.* v *Robinson* Scott J.[38], set out certain guidelines for materials seized in execution of an Anton Piller order. These are:

(1) Once the plaintiff's solicitors have satisfied themselves what material exists and have had an opportunity to take copies thereof, the material ought to be returned to its owner. The material need to be retained no more than a relatively short period of time for that purpose.

(2) It is essential that a detailed record of the material taken should always be required to be made by the solicitors who execute the

37 n. 18 at page 604.
38 n. 13 at p. 76–77 Scott J.

order before the material is removed from the respondent's premises. So far as possible, disputes as to what material was taken, the resolution of which depends on the oral testimony and credibility of the solicitors on the one hand and the respondent on the other hand, ought to be avoided. In the absence of corroboration of a respondent's allegation that particular material, for instance, divorce papers, was taken, a solicitor's sworn and apparently credible denial is always to be preferred. This state of affairs is unfair to respondents. It ought to be avoided so far as it can be.

(3) No material should be taken from the respondent's premises by the executing solicitor unless it is clearly covered by the terms of the order. In particular, it is wholly unacceptable that a practice should have grown up whereby the respondent to the order is procured by the executing solicitor to give consent to additional material being removed. In view of the circumstances in which Anton Piller orders are customarily executed, Scott J. stated that he would not be prepared to accept that an apparent consent by a respondent had been freely and effectively given unless the respondent's solicitor had been present to confirm and ensure that the consent was a free and informed one.

(4) Seized material, the ownership of which is in dispute, should not be retained by the plaintiff's solicitors pending the trial. If the proper administration of justice requires that material taken under an *Anton Piller* order from defendants should, pending trial, be kept from the defendants then those responsible for the administration of justice might reasonably be expected to provide a neutral officer of the court charged with the custody of the material. In lieu of such officer, and there is none at present, the plaintiff's solicitors ought, as soon as solicitors for the respondent are on record, be required to deliver the material to the respondent's solicitors on their undertaking for its safe custody and production, if required, in court.

(5) The nature of *Anton Piller* orders requires that affidavits in support of applications for them ought to err on the side of excessive disclosure. In the case of material falling into the grey area of possible relevance, the judge, not plaintiff's solicitors, ought to be the judge of relevance.

Following the decision in *Columbia Picture* it was claimed by some[39] that "there is no doubt that the decision in *Columbia Picture Industries* v

39 see for instance "Anton Piller orders — Towards a more restrictive approach" V. 6 Civil Justice Quarterly P.10 case note (1987).

Robinson represents a turning of the tide against the near automatic grant of Anton Piller orders on ex parte application"[40]. Whether or not this was true at the time the claim was made in 1987, the fact is that barely 3 years later the decisions in *Swedac Ltd* v *Magnet & Southern Plc*[41] and *Lock International Plc* v *Beswick & Others*[42] proved that "whilst it may have been assumed that courts would be exercising rather more scrutiny in the granting of these orders" it was still "possible however to obtain wide-ranging Anton Piller relief in what appeared to be demonstrably weak cases"[43].

Thus, in the same way the next case, *Universal Thermosensors Ltd* v *Hibben*, has led to claims by some that perhaps the pendulum has swung too far[44]. If this view is readily accepted and the latest common law safeguards ignored we may well find ourselves back again to the unacceptable situation of abuses being perpetrated by unscrupulous plaintiffs.

Safeguards imposed by *Universal Thermosensors Ltd* v *Hibben*

Universal Thermosensors Ltd v *Hibben*[45] set down new guidelines for the execution of Anton Piller orders. These are:

1. Anton Piller orders normally contain a term that before complying with the order the defendant may obtain legal advice, provided this is done forthwith. This is an important safeguard for defendants, not least because Anton Piller orders tend to be long and complicated, and many defendants cannot be expected to understand much of what they are told by the solicitor serving the order. But such a term, if it is to be of use, requires that in general Anton Piller orders should be permitted to be executed only on working days in office hours, when a solicitor can be expected to be available.

2. If the order is to be executed at a private house, and it is likely that a woman may be in the house alone, the solicitor serving the order must be, or must be accompanied by a woman. A woman should not be subjected to the alarm of being confronted without warning by a solitary strange man, with no recognisable means of identification, waving some unfamiliar papers and claiming an entitlement to enter her house and, what is more, telling her that she is not allowed to get in touch with anyone (except a lawyer) about what is happening.

40 Ibid. at page 15.
41 n. 22.
42 n. 31.
43 John Hull "Anton Piller Abuses" [1989] 10 EIPR 382.
44 see Fiona Russell "Anton Pillers after Universal Thermosensors: Has the Pendulum swung too far" [1992] 7 EIPR 243.
45 n. 4.

3. In the present case a dispute arose about which documents were taken away, and from which of the premises visited. Understandably, those who execute these orders are concerned to search and seize and then get away as quickly as possible so as to minimise the risk of confrontation and physical violence. Nevertheless, in general Anton Piller orders should expressly provide that, unless this is seriously impracticable, a detailed list of the items being removed should be prepared at the premises before they are removed, and that the defendant should be given an opportunity to check this list at the time.

4. Anton Piller orders frequently contain an injunction restraining those on whom they are served from informing others of the existence of the order for a limited period. But an injunction for a whole week is far too long.

5. Anton Piller orders should provide that, unless there is good reason for doing otherwise, the order should not be executed at business premises save in the presence of a responsible officer or representative of the company or trader in question.

6. In cases where an Anton Piller order is taken out by a party against his competitor, there should be some means, appropriate to the facts of the case, to prevent the applicant executing the order himself and taking the opportunity to carry out a thorough search of his competitor's business.

7. When making Anton Piller orders judges should give serious consideration to the desirability of providing, by suitable undertakings and otherwise,

   (a) that the order should be served, and its execution should be supervised by an independent solicitor;

   (b) that the solicitor serving and supervising the order should be an experienced solicitor having some familiarity with the workings of Anton Piller orders, and with judicial observations on this subject;

   (c) that the solicitor should prepare a written report on what occurred when the order was executed;

   (d) that a copy of the report should be served on the defendants; and

   (e) that in any event and within the next few days the plaintiff must return to the court and present that report at an inter partes hearing, preferably to the judge who made the order.

Sir Donald Nicholls V-C readily acknowledged that "of course this procedure would add considerably to the cost of executing an Anton Piller

order"[46] thus making clear that these safeguards were being adopted after what must surely have been a very careful balancing of the competing interests of parties. He went on to add that "if plaintiffs wish to take advantage of this truly Draconian type of order, they must be prepared to pay for the safeguards which experience has shown are necessary if the interests of defendants are fairly to be protected"[47].

Almost immediately after this decision was reported came calls that these seven guidelines could cause the balance to swing too far in favour of the defendants[48].

For instance, fears are being expressed that, interpreted too rigidly by the judiciary, these safeguards could drain the Anton Piller order of much of its efficacy.

On the other hand others[50] have been far more critical of the seven guidelines.

On 28 July 1994, following widespread criticism of the scope of both the Anton Piller and Mareva orders the English Lord Chief Justice issued a practice direction incorporating a new form of both the *Anton Piller* order and *Mareva* injunctions. The new practice direction to some extent takes into account the guidelines given in *Universal Thermosensors* and *Columbia Picture* and also comments received following the consultation paper on Anton Piller practice circulated by the Lord Chancellor's Department in July 1993.

One immediate result of the practice direction is likely to be a greatly increased willingness on the part of the courts to grant such orders. In view of the inherent difficulties in the new scope of order, in particular the poorly developed but crucial role of the supervising solicitor, problems may yet arise. The new form of order raises, and attempts to deal with in a standard form, issues with which the courts have grappled since the relief was devised, issues which are perhaps too much to attempt to resolve through practice directions. By institutionalizing the form of order, the courts' flexibility to devise more satisfactory solutions to inherent difficulties may have been stultified.

In Singapore, the Supreme Court has issued a Practice Direction[51] which substantially follows the English Practice Direction.

46 n. 4 at page 276–277.
47 n. 4 at page 277.
48 see Fiona Russell "Anton Pillers after Universal Thermosensors: has the Pendulum swung too far" and Ian Craig "Anton Pillers after Universal Thermosensors" Solicitors Journal 30 October 1992 1078.
49 Craig n. 48 at page 1078.
50 see for instance Russell n. 44.
51 The Supreme Court Practice Directions. Practice Direction No. 1 of 1995.

At the same time in Australia on 8 April 1994 the Federal Court adopted a practice direction of its own which adopted most of the Vice-Chancellor's seven guidelines with some differences. Other common law countries which have accepted *Anton Piller* and *Mareva* injunctions will no doubt adopt variants of these guidelines to suit its own needs.

Some comments on the seven guidelines set out by *Universal Thermosensors*

The Defendant's Right to obtain legal advice

It has been argued[52] that difficulty will arise in the case of execution against one or a number of ex-employees who are salesmen and now work for a competing company. If the execution has to take place after 9 a.m. or 9.30 a.m. and before 5.30–6 p.m., then there must be some cases in which it will be impossible to levy execution. Following from this, it is argued that the courts should allow execution before or after business hours on giving a full explanation of the circumstances and the necessity for allowing execution at such times.

According to another view[53], if the order has to be served outside normal office hours when the defendant's solicitors may be unavailable the plaintiff's solicitors "should draw this shortcoming in the proposed order to the attention of the court" and leave it to court to decide whether or not the order should be granted.

Further, if an order is to be served before business hours, it will be open to the plaintiff's solicitors to wait with the defendant until such time as its solicitors' offices open and it can obtain legal advice. This suggestion is now incorporated as part of both the English and Singapore Practice Directions.

Both these two views differ only in form as ultimately it will be up to the court to decide. After all, Nicholls V-C[54] in referring to the time for service of Anton Piller orders did qualify his statement by using the term "in general" so as to leave open the possibility for service outside of these hours.

The real issue may not be so much whether service outside of office hours is still permissible but whether, if permitted it should be before or after office hours. The unanswered question that still remains, despite the cases and the practice direction, is what happens if the search is incomplete at 5.30 pm and whether the search team must leave the premises[55]. It may be

52 Russell n. 44 at page 244.
53 Craig n. 48 at page 1078.
54 [1992] 3 All ER 257 at page 275.
55 see Susan Hall "Anton Piller Orders: A Doorstep too far" [1995] 1 EIPR 50 at 51.

that in appropriate cases the answer may lie in the court permitting service before office hours rather than after office hours. This is especially so if service is on residential premises and also in light of that part of the English practice direction that the defendant must allow the plaintiff's solicitor and the supervising solicitor access to the premises before the defendant takes legal advice. This way, the defendant need only to wait a few hours before being able to take legal advice rather than wait till the next morning for it.

On the other hand, if the service is to be on business premises which operates after the normal business hours (such as a night club) then the court should be asked to permit service after normal business hours.

In other words, the time for service should depend on the circumstances of the case even though the rule from now on is that it should be during office hours.

A minor point of interest is the slight variation of time for service used in the different jurisdictions. Whilst the English practice direction sets the usual time for service as between 9.30 am and 5.30 pm, the Singapore practice direction has chosen to limit the time of service between 9.00 am and 5.00 pm instead whilst the Australian Federal Court has chosen to use the undefined expression "business hours" as the time for execution. This slight variation no doubt reflects and takes into account the different situations in different countries rather than it being blindly copied by the courts in different countries.

The Lone Woman

Russell[56] asks how is a plaintiff to know beyond all reasonable doubt that a woman is likely to be alone in a private house adding that no amount of pre-execution investigation can categorically confirm that point. She further asks if it is going to be necessary, where execution is on a private house, to ensure that a woman is always present, concluding that the answer is in the affirmative.

With respect to Russell she may be missing the point of the guidelines set out by Nicholls V-C which is that the dangers of serious unwarranted injury that may be caused by the service and execution of an Anton Piller order requires a detailed and thorough degree of investigation and enquiry by the applicant and that it will not do for an applicant to say that this is a point that is impossible to determine and since the guidelines have made it impossible to avoid this safeguard he or she will comply with it grudgingly. The possible injury to an unsuspecting woman should outweigh any

56 n. 44 at page 245.

consideration of inconvenience of having to include a woman in the plaintiff's party.

Personably, the idea of including a woman in the plaintiff's party may not be a bad thing regardless of whether or not there is a likelihood of a lone woman in the premises. It may have the positive effect of tempering any over-zealousness or intemperate conduct by an all-male group serving an Anton Piller order.

Interestingly enough the Australian Federal Court practice direction requires the attendance of a woman during service only where service is on a residence and the applicant is aware at the time at which the service of the order is effected that the occupant is likely to be a woman rather than "it is likely that a woman may be in the house alone" which is the expression used by the Vice-Chancellor in *Universal Thermosensors*. Presumably this means that knowledge has to be actual rather than constructive.

The other limiting factor seems to be that the operative period of such knowledge is "at the time of service" rather than before the application. Presumably the plaintiff need not show that all efforts have been made to attempt to discover the sex of the occupant, only that just before the order is served he or she did not know that the premises were occupied by a lone woman. Again, presumably, if the plaintiff discovers just before the service that the premises are in fact occupied by a lone woman then the service should be delayed until a woman is able to join the search team. All this may mean that at the end of the day plaintiffs should, from now on, always include a woman in their search teams, especially if the order is being executed on a residential property.

An officer of a Defendant business to be present on execution

It has been suggested that this requirement may cause considerable difficulty for the solicitors executing the order. One of those making this suggestion is Russell[57] who argues that:

> "in cases where, for example, only a small staff is present and the director is out, this is likely to make the execution of an Anton Piller order extremely difficult. Does the Vice-Chancellor envisage that execution will not be permitted in the absence of the responsible officer?

What happens if all the directors are elsewhere at a Board meeting, on holiday, at meetings or simply not in the office? Once the executing solicitor has arrived, word is quite likely to leak out and the plaintiff's rights may well be dissipated. Again no amount of pre-execution investigation can ensure that the necessary responsible officer will be present at execution."

57 n. 44 al page 245.

It is submitted that the better view is that "the Vice-Chancellor's proposal regarding service on companies has to be adopted if Anton Pillers are not to fall into disrepute, no matter what difficulties it might present for the plaintiff" since "the overriding principle of the Anton Piller is that it is not an order to allow the solicitors to search and seize, but rather to enter, with the consent of the defendant, who withholds its consent at its peril"[58]. Indeed this is what should matter.

With respect to Russell, the view put forward by her is the sort of view that has prompted Dockray and Laddie's comment that in their view Ormrod's three primary safeguards "do not now have the same effect that they were intended to have when they were set out in Anton Piller"[59]. After all the third safeguard stated by Ormrod was that "every opportunity must be afforded to the defendant to protect himself". How can a defendant do this if a plaintiff were to be allowed to proceed with the search in the absence of a responsible officer just because "no amount of pre-execution investigation can ensure that the necessary officer will be present at execution"[60]?

Unfortunately for defendants both the English practice direction and the Singapore practice direction now permits the search to proceed in the absence of a responsible officer if the supervising solicitor exercises his discretion to abrogate this restriction or the restriction on removal of items before a list of them has been taken and confirmed with the defendant if it appears 'impracticable' to comply with these requirements[61].

Susan Hall notes that "these restrictions were introduced through case law, and abrogating them is a serious concern"[62]. She also notes that no guidance is given as to how the supervising solicitor is expected to exercise this important discretion[63] and goes on to argue powerfully:

> "Is it, for example, incumbent on the supervising solicitor to devise the best substitute protection for the defendant in the absence of these safeguards? It is of no help to rely on the fact that the supervising solicitor must act as an officer of the court in discharging these duties: the same is equally true of the plaintiff's solicitor. If the court regarded this duty as sufficient to ensure the plaintiff's solicitor behaved properly there would be no need for a supervising solicitor".

This aspect of the practice direction is mystifying and will only serve to encourage plaintiffs to seek out supervising solicitors who may be

58 Craig n. 48 at page 1078.
59 n. 18 at page 604.
60 Russell n. 44 at page 245.
61 see paragrapli 2 (7).
62 n. 55 at page 51.
63 n. 55 at page 51–52.

sympathetic to its cause if the need arises for such discretion to be exercised. Where then would this much vaulted "independence" lie? As things are, there is anecdotal evidence that suggests that the "ideal" supervising solicitor is seen to be a solicitor of another firm that usually acts for plaintiffs serving Anton Piller orders. There is as yet no recorded rush to appoint as supervising solicitor one with a record of opposing an Anton Piller order nor is there likely to be.

It is submitted that this aspect of the practice direction should be revised and the two restrictions suggested by Nicholls V-C be restored.

The List of items Removed

One can only agree with the Vice-Chancellor's guide-line on the making of a list for the items removed as such a procedure is merely reiterating what is already a common and good practice even before the Vice-Chancellor's comments. This is probably one of the two most widely accepted of the guidelines, the other being the next guideline.

As stated[64], both the English and Singapore practice directions give the supervising solicitor the discretion to abrogate this requirement.

The Competitor

Russell[65], whilst stating that she sees the logic of preventing the search to be conducted by a director of the plaintiff company if the plaintiff is in competition with the defendant, nonetheless asserts that the search could be severely hampered in the absence of the plaintiff's director as it is "quite usual for solicitors to rely, sometimes heavily, on the presence of a member of their client company so that that person can identify documents which are relevant and within the terms of the order. If the executing solicitor cannot have access to that type of information, it may increase the risks of documents being wrongly removed. This must be an even greater risk if the executing solicitor has to be an independent solicitor and not the plaintiffs".

Craig[66] also points out the value of having someone accompany the solicitors serving the order to help in the identification of the items to be seized saying that:

> "past experience of executing Anton Piller orders in the field of video piracy has shown the necessity of bringing along an expert able to recognise specific titles. Such expertise may not be available in every type of action. In cases where it is not, it is incumbent upon the

64 n. 61.
65 n. 44 at page 245.
66 n. 48 at page 1078.

> solicitor who is going to execute the order to familiarise him or herself with the precise nature of the documentation which is the object of the search".

Having said this Craig then goes on to add that "the alternative of enlisting a director or officer of the plaintiff company is quite inappropriate. If documents are missed, so be it. At least the defendant will not feel that the order was simply an excuse for a business competitor to get around its offices and filing cabinets".

The English and Singapore practice directions state that the order does not require the person served with the order to allow access to anyone 'who could gain commercially from anything he might read or see on the premises if the person served with the order objects'. Provision is made for a named exception, obviously needed where the technical subject-matter of the order is such that the solicitors themselves are not capable of ascertaining sufficiently effectively whether or not an item is covered by the order, thus taking in the concerns of critics such as Craig and Russell.

Yet this does not seem to satisfy Hall who argues[67] that the right to object seems likely to allow an unscrupulous defendant considerable scope for delaying the search while objections are made. One wonders how valid such a concern is, given that defendants are often in shock, or confused or feel a sense of powerlessness[68].

One wonders whether a defendant, especially one faced with several strangers waving a court order and accompanied by police officers, would have the presence of mind to consent to everyone except one or two of the plaintiff's party on the ground provided in the practice direction. Surely not. Much less is it likely that the defendant would have the presence of mind to object to entry of the entire team so as to delay the search as Hall suggests. Anyway, even if one or two of the teams is denied access there is no reason why the search cannot proceed in the meantime.

However, if the defendant is a true recalcitrant and possibly experienced in *Anton Piller* matters then perhaps the Australian Federal Court's practice direction would be more appropriate. It merely requires that "safeguards should be included in the order that will prevent applicants in person searching for and examining the documents of a trade rival." This apparent vague reference to "safeguards" and lack of particularity may be intentional and may be an attempt at treading the middle path but it certainly is not sufficiently narrow as to cause difficulties for plaintiffs faced with experienced or repeat offenders and who no doubt will make this known to the court and have the necessary safeguards put in place.

67 n. 55 at page 52.
68 see n. 30.

Otherwise, if the English practice direction is to be followed it must be remembered that experience has shown that the risk of unwarranted advantage for a plaintiff attending the execution of the order is most acute in anti-competition cases such as in *Universal Thermosensors*. Solicitors applying for orders in anti-competition cases will do well not to include the plaintiff's directors or officers in the search team to reduce the chances of objection by the defendant.

In addition, it must be remembered that the risk of seizing the "wrong" document, as Russell fears, may not present much of a problem in that such documents will be held by the plaintiff's solicitor or the supervising solicitor, both of whom is less likely to gain from perusing a "prohibited" document than if the plaintiff's directors were allowed to roam free in the premises of a defendant who is a trade rival and to view sensitive documents.

The Independent Executing Solicitor

Whilst this requirement is undoubtedly going to increase the plaintiff's costs, it is difficult to see how the independent solicitor is going to carry out the order adequately without knowing just as many facts as the plaintiff's solicitor himself.

But the issue of increased costs was already acknowledged by the Vice-Chancellor when he said in his judgment (in reference to all and not just one of the safeguards) that:

> "[of] course this procedure would add considerably to the cost of executing an Anton Piller order"[69] and later "it is important therefore that these orders should not be allowed to fall into disrepute. If further steps are necessary to prevent this happening, they should be taken. If plaintiffs wish to take advantage of this truly Draconian type of order they must be prepared to pay for the safeguards which experience has shown is necessary if the interests of defendants are fairly to be protected"[70].

The Vice-Chancellor's view carries great force of merit as, after all, it may be better to continue to have a procedure still available to plaintiffs than to have one that is continually abused to a point of disrepute or which forces the courts to act on the Vice-Chancellor's warning that if necessary additional safeguards will be imposed.

In any case, it must be remembered that one of the three pre-conditions mentioned by Ormrod is that there must be clear evidence and since there must be a risk of irreparable damage before an injunction will be granted the issue of higher costs should never be the overriding factor. After all we are talking about an act which has the potential to destroy a defendant's

69 n. 4 at page 276.
70 n. 4 at page 277.

business. At the same time whilst the Vice-Chancellor did not intend it, this requirement may have an unexpected benefit in the delicate balancing act between competing interests, namely that it will bar impecunious plaintiffs from obtaining Anton Piller orders as in fact happened in the *Magnet case*[71].

Moreover, if we go back to Denning's statement that the order should be granted only if it "would do no real harm to the defendant or his case" no one ought to complain about these safeguards despite the added cost. As it is the Vice-Chancellor's guidelines countenance the possibility of cases where harm may occur without the safeguards being observed yet the order may be granted with these safeguards in place. Is this not an improvement for plaintiffs' rights?

In addition to his point on increased costs, Craig doubts the usefulness of this requirement, submitting that this requirement does not overcome the problem of ensuring that executing solicitors are first and foremost officers of the court. He thinks that it is possible that "even if a solicitor, independent of the plaintiff, executes the order, he or she may still act over-zealously. Mistakes can be made and misunderstandings can arise in relation to precisely what it is that may be taken under the terms of the order. An independent solicitor coming into the action at the very end of its preparation, simply to execute the Anton Piller, is likely to be unfamiliar with the subject matter of the order and so be at a major disadvantage. To familiarise himself with the details of the case would be expensive, and there is no guarantee that he or she will be better at the job than the plaintiff's own solicitors"[72].

He suggests that to avoid this problem, a supervising solicitor may be brought into the picture but that without further guidance or even training for supervising solicitors this could amount to nothing more than an expensive exercise in the blind leading the blind.

One noteworthy suggestion of Craig's is that if justice is to be done the profession (or Parliament) must consider appointing solicitors in their capacity as officers of court to be licensed Anton Piller executors. These solicitors would owe their first duty to the court and a plaintiff, who upon advice concluded that an Anton Piller order was necessary, would have to instruct someone from their ranks to prepare and execute the order.

It may be that the better solution is for a variation of Craig's suggestion to be adopted. Right now with the various practice directions it is the plaintiff or its solicitors who choose the "independent" solicitor to serve and execute the order. How independent can one be if one owes one's appointment to the plaintiff or its solicitors?

71 n. 22.
72 n. 48 at page 1079.

Why not have a list of approved solicitors and have the applicant inform the court of say, three solicitors who have indicated their availability and leave it to the court to pick one? Whilst not perfect it reduces the link between the plaintiff and the executing solicitor.

Alternatively, the court could simply choose an executing solicitor from the approved list (with possibly a reserve choice) on the basis that those who put themselves up for appointment agree to make themselves available to execute such orders upon being chosen by the court unless unable to do so for legitimate reasons.

Once the appointment is removed from the hands of plaintiffs the executing solicitor may well be unshackled from the burden of having in some way to please those that appointed him or her so that he or she will be reappointed again in other cases. An executing solicitor appointed by court will have good reason to see that the order is properly and fairly executed in order to be reappointed by the court as opposed to one who has to ensure that the plaintiff and its solicitors are not too dissatisfied with his or her "performance".

It may be that local Law Societies may need to have a list of qualified Anton Piller executing solicitors consisting of solicitors who have sat for and passed an examination and they can be retested regularly to ensure that they keep up to date with developments.

The way ahead

Russell, Craig and Hall all have their own views on the way forward but of these Craig's views are the most constructive.

In Russell's view, the provision of an execution report is an extremely good idea but again she argues that this will substantially increase costs for the already beleaguered plaintiff. Whilst she acknowledges the Vice-Chancellor's statement that if the plaintiff wishes to take advantage of the draconian Anton Piller order, then they must be prepared to pay for safeguards, she submits that "the plaintiff's rights are slowly but surely eroded"[73].

Perhaps Russell may have forgotten that the plaintiff's "rights" as she calls them did not exist before 1975. What is more, many of these "rights" were obtained through a lack of adequate control by the courts and furthermore much was obtained in the absence of opposition by the defendant. One needs only look back at the fact that the first Anton Piller case to be reconsidered at full trial was in fact *Columbia Picture* some full 10 or 11 years after the order first came to prominence. According to Ough[74] the hundreds of previous Anton Piller orders had all been settled.

73 n. 44 at page 245.
74 n. 7 at page 55.

Could it be that these "rights" which Russell clings to are in fact no more than mere conventions allowed by the courts rather than substantive law? In any case, as an Anton Piller order is a discretionary order, the courts will always be able to allow for whatever variations as arc suitable from case to case.

As for Russell's other complaint that the appointment of an independent solicitor prevents a plaintiff from exercising his or her right of choice of the solicitor for executing the Anton Piller order and the right to see that solicitor, could it be that Russell has not accepted the basic premise that whilst most Plaintiff's solicitors may act appropriately when executing Anton Piller orders, this requirement of an independent solicitor goes further to ensure that the independent solicitor, unlike the plaintiff's chosen solicitor, is not under direct or indirect pressure by the plaintiff to do anything that may not be permitted?

Could it also be that her argument that the plaintiff will not be able to ensure that his rights can be adequately protected unless he or she is present for the execution also missed the point that this "right" to attend execution is not so much a right as a practice that grew up over time simply because no court had been asked to rule on it previously? Would anyone be able to say with confidence that had the Court of Appeal in *Anton Piller* had its attention drawn to the fact that the plaintiff was a trade rival of the defendant it would have, without a doubt, still made an order allowing the plaintiff to be present for the execution? Even if the Court of Appeal would have agreed to this, would it have done so if the case was an anti-competition case and not an Intellectual Property case?

Anyway, why does the plaintiff have to be present? Does he or she not trust his or her own lawyers or experts? Does he or she not trust that his or her own solicitors will ensure that the independent solicitor hear and consider the plaintiff's solicitors' views on everything including, for instance, the reasons for deciding to abrogate the requirement for a responsible officer of a defendant company to be present to consent to the search before it can begin? Which is more likely to cause unnecessary injury or loss, the fact that a search can be done in the absence of a responsible officer from the defendant company or that the plaintiff cannot be present at the execution of the order and to perhaps gloat over the defendant?

On a different note, Craig suggests that initially, licensed Anton Piller executors should be drawn from people who have had experience in the preparation and execution of the order without any complaint being upheld against them. Whilst generally a good idea, it may be that the qualification chosen by Craig fails to consider the fact that no complaint does not equate with no history of abuse as abuse may go unreported. Again we need to remember the 10 years lapse before an Anton Piller order complaint was heard at a full trial. So, absence of complaint may be an inappropriate criteria.

It may be better that Craig's suggestion that after the initial pool of licensed executors are appointed that thereafter licenses be granted by the Law Society once suitable training has taken place, be varied so that the initial pool of executors be appointed only after passing a test set by the local Law Society in the same way that specialists are accredited by some Law Societies.

As for Craig's view that the defendant's protection will come from the fact that if any complaint against the executing solicitor is upheld, he or she would be removed from the list and would be open to the full rigours of any sanctions which the licensing body may wish to impose, it must be wondered whether this is more illusory than real for unless the independent executing solicitor is appointed by court and acts purely as a court official and is entitled to court immunity against actions, sanctions will be irrelevant if the defendant can simply sue the independent solicitor just as plaintiff's solicitors have been sued previously.

C. THE LIMITATIONS OR SAFEGUARDS IMPOSED BY THE JUDICIARY THROUGH PRACTICE DIRECTIONS IN RESPECT OF ANTON PILLER ORDERS.

Apart from those restrictions in the new practice directions that have already been mentioned, there are a few other restrictions that bear closer examination.

Hall makes several points about the new English practice direction one of which is that it may be that in future Anton Piller orders may only be served by partners rather than assistant solicitors[75]. This begs the question whether partners are any more well-versed with Anton Piller procedure and judicial pronouncements on the topic and whether partners are any less inclined to act in a manner that would be in breach of the defendant's rights or the order and the safeguards.

Hall[76] also notes that supervising solicitors are now required in all except very unusual cases and that the supervising solicitors must give undertakings personally and actually serve the order. She comments that:

> "until a clearer statement of the principles which guide selection of and performance by the supervising solicitor is made there is clear scope for the argument about such issues as division of responsibility between the plaintiff's solicitor and the supervising solicitor; the role of the supervising solicitor in the actual search; and the degree to which the supervising solicitor should take into account the plaintiff's comments in finalising the supervising solicitor's report"[77].

75 n. 55 at page 52.
76 n. 55 at page 51.
77 n. 55 at page 52.

Hall's view is that the responsibilities of the supervising solicitor are onerous but the undertakings supporting them are only to explain the order in ordinary language and to make a report and serve it on the plaintiffs solicitors.

Her submission that if the supervising solicitor's role is to be so extensive, more adequate undertakings are desirable dealing with the form and content of the report and the terms on which the abrogation of the order's safeguards are carried out is most valid and should be looked at closely by those responsible for issuing the practice directions.

D. OTHER SAFEGUARDS

Apart from the safeguards already mentioned, both case law and the new practice directions have set out other safeguards. For instance, the most important safeguard is that the defendant may, where there are good grounds, apply to court for the Anton Piller to be discharged.

In addition, the new practice directions have added further safeguards by requiring the plaintiff, its solicitors as well as the supervising solicitors all to give undertakings to the court.

There is also the safeguard of requiring the applicant in appropriate cases to insure any items removed from the defendant's premises.

There will always be other safeguards which may be added. Indeed nothing stops a judge from ordering additional safeguards peculiar to a case. For instance, to prevent the not uncommon problem of plaintiffs choosing not to prosecute their cases expeditiously after the Anton Piller order has been successfully executed, it would not be out of place for a judge hearing the application to order as a pre-condition of making the order that the plaintiff will have to meet specific set date-lines for taking the required procedural steps for the case to be heard, eg to do discovery by a set date. In addition the court can make as part of the order a self-executing requirement that unless these set dates are met the action will be struck off. This way the plaintiff will have no choice but to have the matter settled expeditiously or else get on with the case.

E. SOME OTHER COMMENTS

One point which has never been directly addressed by writers on this topic is the issue of the quality of control by judges hearing applications for Anton Piller orders.

In the *Magnet* case, Harman J explained the lapse by the judge that heard the application on the basis that intellectual property was something that the judge was unfamiliar with[78].

78 n. 22 at page 245.

The most direct has been Hull who says that the high standards for solicitors should be matched by equally high standards of scrutiny when such orders are granted by the courts in the first place[79].

Puri[80] suggests, as a good example where the Court's scrutiny was up to "high standards", the Australian Federal Court's decision in *Television Broadcasts Ltd.* v *Thi Phuong Nguyen*[81]. In this case, the orders sought included an order requiring the defendant to disclose the names and addresses of persons and companies responsible for supplying the defendant with copies of infringing video recordings. Lee J., granting the order, held that the facts placed before the Court were not sufficient to permit the exercise of the Court's discretion to require the defendant to disclose the names and addresses of persons or companies responsible for supplying the defendant with infringing copies of the video recordings. Further, the plaintiff's access was limited, for the purpose of inspection, to the displayed material only and that too in the trading area of the premises and the offices thereof, and the right to search was not extended to any part of the premises used for private occupation. Also, the right of inspection was not extended to general inspection of the defendant's business documents but limited to any relevant documents on open display[82].

CONCLUSION

Since the decision in *Universal Thermosensors* and despite the new Practice Directions, there remains critics that still assert that the latest safeguards are more than adequate and have in fact gone too far to the extent that Plaintiffs' "rights" are being denied. No doubt, it is easier to find far more solicitors who would prefer that the tide be rolled back and the scope of Anton Filler orders extended as easily as has been done before *Universal Thermosensors* and even before *Columbia Picture* than to find solicitors who would oppose such a view. However, we need to consider whether such critics may not just be the vocal minority.

It is not difficult to find a significant number of lawyers in support of rolling back the tide as invariably they would be from the large city law firms that frequently act for plaintiffs who are the most common users of this procedure. It is rather more difficult to identify a group of solicitors who have acted for defendants in Anton Piller proceedings. It may be that there are in fact a considerable number of solicitors in the second category but because they each act in so few cases, there has never been the urge to voice concerns once his or her immediate Anton Piller case is disposed of.

79 n. 43 at page 387.
80 n. 2 at page 375.
81 (1988) 15 I.P.R. 97.
82 Ibid at page 103.

This brings us to the need to ask ourselves just how effective is the safeguard that the defendant be given the chance to obtain legal advice. Could it be that such a safeguard is also illusory? Considering that plaintiff's solicitors have been found wanting in the service and execution of Anton Piller orders so that courts have to direct that such orders be served only by experienced solicitors, how is it that we can say with confidence that by letting the defendant have the opportunity to take legal advice, that the advice also does not fall short of what would be considered as adequate?

If, as we now know, inexperienced solicitors may fail to act within the required standards, how can we say that solicitors who are asked to advise defendants at the time the order is being served will give advice of the requisite standard? Is there a group or even an individual solicitor who can lay claim to the dubious honour of being an experienced Anton Piller defendant's solicitor so that every defendant served with an Anton Piller order will say without hesitation, "Of course, let me call Mr/Ms. X, my very experienced Anton Piller solicitor to advise me whether I should consent to entry"? Or could it be that the average defendant served with an Anton Piller order, being already in a state of shock, will simply call his or her regular solicitor (assuming that he or she does have one) who may not even be a litigation solicitor and who has never had practical experience in Anton Piller orders, having left it all behind when he or she left law school? As we know that anyone who does not practise regularly in an area of law will eventually lose the skills that have been acquired previously, it is no answer to say that such a solicitor ought to know what advice to give. The truth may be that such a solicitor, despite studying it in law school, may never even have seen an actual Anton Piller order before then.

So, if it is true that the safeguard of legal advice for defendants is less than perhaps sufficient, should we allow the balance to tilt back in favour of plaintiffs and lessen the safeguards or should we go the other way, perhaps adopting Dockray and Laddie's suggestion of an *amicus curate*[83]? One wonders whether an independent solicitor, had one been appointed in the *Magnet* case, would have had the courage to refuse to serve the order and on his or her own volition gone back to court to draw the court's attention to its shortcomings. If assuming such a courageous and contentious solicitor existed, would plaintiffs or its solicitors want to nominate that solicitor as the independent solicitor?

Given the effect Anton Piller orders have on defendants and their business it is submitted that the balance has not tilted back nearly enough in favour of defendants and further consideration should be given to suggestions such as an *amicus curiae*.

83 n. 18 at pages 607–608.

No doubt, *Universal Thermosensors* and the Practice Directions will not be the end of the story and we will see again another case of over-zealous plaintiff'ssolicitors or even independent solicitors abusing defendants' rights despite the new guidelines. Where rules have been made people have managed to break them and so it will be with the latest safeguards[84].

PETER NG LEE TONG*

84 Readers should also refer to the excellent book by Stephen Gee, "Mareva Injunctions and Anton Piller Relief" which regrettably I was unable to get a copy of at the time I was writing this paper for my Advanced Civil Procedure course for my LLM.

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