VI. Evaluative Comparison of the Procedures' Strengths

As the above expositions of Rule 34 discovery and the Saisie demonstrate, both fact-gathering procedures accommodate issues particular to the patent infringement context. While in some instances the U.S. approach proves more effective, efficient, and considerate, the French mechanism prevails in other areas. The Saisie dominates regarding its ability to preserve quality evidence, deterring overproduction, and reducing costs and duration associated with enforcement of patent rights as well as its ability to translate well into the international context. Rule 34's discovery mechanism, on the other hand, is preferable for its heightened trade secrets protection and its sensibility to other communications and information transmitted within certain privileged contexts.

With regard to the Saisie's strengths, the first and most noteworthy lies in its ability to secure evidence catching infringers in the act and, thereby, foreclosing them from destroying or concealing infringement proof and evading enforcement of the patent laws.[339] This preservation capacity results from the Saisie's *ex parte* nature and the surprise effect this creates for the alleged infringer. While the European legislator has interpreted the need for effective enforcement of intellectual property rights to embrace a right to such *ex parte* civil searches,[340] the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS)[341] does not *per se* require such *ex parte* measures. It more vaguely instructs World Trade Organization Members to implement effective enforcement procedures[342] and compel, in appropriate cases, the production of evidence while, simultaneously, protecting trade secrets.[343] Thus, while the United States does not seem to violate TRIPS' enforcement provisions by lacking a realistically available ex parte measure,[344] the implementation of such measures all across Europe and countries such as Canada[345] reflects a heightened international standard for patent enforcement.

Although Rule 34 discovery is broad, it does not prevent destruction or concealment of probative evidence as long as this occurs pre-suit or at least before the potential defendant has notice.[346] It seems that a defendant who willingly engages in patent infringement may not hesitate to make traces of his illegal conduct disappear when he anticipates the possibility of legal action. An infringer could, then, destroy or hide evidence, just before receiving reasonable notices of the suit and, under the current spo-

339 *See supra* Part III, A-B.
340 Enforcement Directive, *supra* note 308, art. 7.
341 Art. 39, Apr. 15, 1994, 33 I.L.M. 81 (1994).
342 *Id*. at art. 41.1.
343 *Id*. at art. 43.
344 Courts so rarely grant preliminary Rule 27 requests that rightholders can not rely on this discovery device for securing evidence pre-suit.
345 *See supra* Part IV, E.
346 *See supra* Part II.

liation standard stand a good chance of avoiding punishment for patent infringement.[347]

Second, the Saisie more effectively avoids and deters overproduction – the infringer purports to comply with discovery requests, but does so by producing a file dump consisting of excessive volumes of documents and information to hide damaging documents.[348] Discovery is known for having this problem.[349] The Saisie avoids such abuse, because the requesting party, rather than the producing party, more closely designates the evidence to be gathered.[350] Discovery-style overproduction not only makes the fact gathering more expensive, but also diminishes the procedure's effectiveness by potentially preventing relevant information from being found.

Third, the Saisie's speedy process and relative cheapness better serve the effective enforcement of patent law across a wider spectrum of rightholders than expensive and prolonged discovery.[351] Enforcing a valid patent should be a realistic possibility for every rightholder. However, if large amounts of cash and the patience to litigate for years constitute prerequisites for such enforcement, then not every rightholder can afford to enforce his patent. Such a realistic inability to enforce a patent essentially robs the patent of its value, at least in the hands of that rightholder. Thus, a procedure requiring significant expenditures of time and money discriminates against small patentholders, because those typically have less money and work on shorter time schedules.

Fourth, the Saisie better serves international comity and export interests.[352] This is because it is less aggressive in that it does not apply extraterritorially and fits better into both civil and common law contexts than discovery does. As noted above, the Saisie, unlike Rule 34 discovery, does not permit French courts to order Saisie-style production outside the territorial jurisdiction of the court.[353] Such geographically restricted jurisdiction necessarily forecloses the Saisie from conflicting with other courts' jurisdictions outside of France. Thus, the Saisie can not be forced upon foreign sovereigns. If a non-French tribunal wishes to use the proceeds of a French Saisie it is free to do so, but the Saisie-ordering court has no power to effect such a decision.

Rule 34 discovery, on the other hand, often violates foreign sovereignty in that it applies extraterritorially in the same manner it does domestically.[354] Because civil law countries have reserved evidence gathering for their judiciaries, they perceive the unilateral imposition of party-driven discovery as excessively aggressive and offensive. And justly so; after all, why allow foreign attorneys to perform activities that not even

347 *See supra* Part III, A, 4.
348 *See e.g.* Kuo-Chang Huang, *Mandatory Disclosure: A Controversial Device with No Effects*, 21 PACE L. REV. 203, 218 (2000) (explaining that overproduction of information constitutes an undesirable phenomenon under discovery).
349 *See supra* Part II; *see also* Lee H. Rosenthal, *A Few Thoughts on Electronic Discovery after December 1*, 2006, 116 YALE L.J. POCKET PART 167 (2006) (stating that overproduction increases the cost, burden, and time required to review and produce information.)
350 *See supra* Part III, A.
351 *See supra* Part III.
352 *See supra* Part V, E.
353 *See supra* Part V, E.
354 *See supra* Part V, E.

locally-licensed lawyers are permitted to engage in? In light of the fact that sovereign nations are generally free to enact laws applicable within their own borders,[355] discovery is too aggressive in the international realm, due to its failure to involve foreign judicial and legal systems.

The Saisie also fits better within the civil and common law contexts, while discovery only translates well into other common law jurisdictions. The Saisie, as a procedural construct of the French legal system, naturally suits civil law norms. Civil law judges are more able to comprehend the Saisie's context, because they are trained in civil law procedure. The context and concept of discovery, however, differ starkly from those familiar to civil law judges. Due to this unfamiliarity, discovery is received with skepticism by civil law judges. The Saisie, conversely, does not offend common law legal systems, because, as shown above, it does not unilaterally impose itself.

Discovery, on the other hand, imposes itself extraterritorially as it does domestically. The combination of such an aggressive extraterritorial approach, which bypasses the civil law mandate of judicial oversight, and civil law judges' ignorance of common law procedure in general makes discovery difficult to export into civil law jurisdictions. While other common law jurisdictions familiar with the general concept of discovery may prove more sympathetic, most jurisdictions in which significant numbers of patent cases are litigated have civil law regimes and, therefore, discovery tends to face skepticism in cross-border patent litigations. Accordingly, extraterritorial patent discovery is predisposed to clash, offend and be received with skepticism, while the Saisie is respected by and appeals to foreign courts adjudicating infringement actions.

Discovery under Federal Rules, however, proves preferable and more sophisticated than the Saisie in other respects. Its collaborative atmosphere and *ex ante* protection of trade secrets and privileged communications more aptly accommodate patent policy and establish certainty.[356] Extensive judicial involvement in fact-gathering taxes the State for the resolution of legal disputes which only distantly benefits society and would better be borne by the litigants themselves.[357] Thus, discovery's default of letting the parties gather evidence cooperatively seems a better-suited cost-allocation that, at least theoretically, should induce the parties to avoid excessive litigation. In the U.S. system, parties have to bear their own discovery costs, which helps encourage settlement. In the French Saisie system, where no lawsuit exists at the time of the Saisie, allocating more pre-trial costs to the parties would deter the filing of under-substantiated lawsuits.[358]

Unlike the Saisie, discovery properly accommodates trade secrets.[359] Article 39 of TRIPS requires protection of trade secrets.[360] Because trade secrets typically accom-

355 *See e.g.* R.M.S. Titanic, Inc. v. Haver, 171 F.3d 943, 964 (4th Cir. 1999); U.S. v. $734,578.82 in U.S. Currency, 286 F.3d 641, 660 (2002); *see also* RESTATEMENT (THIRD) OF FOREIGN RELATIONS LAW § 206 (1987) ("a state has sovereignty over its territory and general authority over its nationals.")

356 *See supra* Part II.

357 Commercial competitors, unlike other members of society, could understand litigation costs as a cost of doing business.

358 This is because the lawsuit is filed only after the saisie-gathered evidence becomes available to the potential plaintiff.

359 *See supra* Part IV.

360 TRIPS, *supra* note 341 at art. 39.

pany patents, patent-directed evidence-gathering must extend special consideration to the protection of trade secrets. Discovery jurisprudence has established multi-factor analyses to evaluate whether certain trade secrets merit protection *before* Rule 34 production threatens their confidentiality. Such *ex ante* judicial interception better accommodates trade secrets from needless divulgation. The Saisie only provides for *ex post* inquiries into whether and to what extent harm was done.[361] Rather than prevent the disclosure of trade secrets, it simply compensates for losses after such divulgation already occurred.

Lastly, discovery better accommodates confidential communications and information and, thereby, creates a better environment for prosecuting and defending valid patents.[362] Frank exchanges between inventors and their legal representatives lead to better-drafted patent applications.[363] Such communications also assist in defending against wrongful claims of invalidity or infringement and help identify and challenge invalid patents. The patent laws necessitate such lawsuits in order to maintain patent quality. Therefore, evidence gathering procedures should encourage open and frequent exchanges between inventors and their lawyers by shielding their contents from needless divulgation.

Discovery extends *ex ante* protection to privileged materials qualifying under the attorney-client privilege and the work product doctrine.[364] United States courts enforce such privileges by way of protective orders if the parties cannot agree on an item's privileged nature.[365] The Saisie does not exclude information on similar bases. Because privileges help foster frank communications and active cooperation between inventors and their legal advisors and representatives, discovery better promotes a procedural environment encouraging patent quality, validity and innovation in general. In that regard, Rule 34 discovery serves patent policy more proficiently than the Saisie does.

361 *See supra* Part III.
362 *See supra* Part II, B, 1.
363 *See* In re Spalding Sports Woldwide, 203 F.3d at 805 – 807.
364 *See supra* Part II, B, 1.
365 *See supra* Part II, B, 2.