IV. Comparing and Contrasting the Saisie and Rule 34

As the above explanation of Rule 34 discovery and the *Saisie-contrefaçon* demonstrates, the two fact-gathering mechanisms exhibit both striking similarities and differences. While the two procedures have the common objective of collecting facts probative to patent infringement, the manners in which they accomplish this diverge. What follows is an analysis of how the two procedures compare and contrast.

First, both fact-gathering mechanisms constitute codified procedural laws that have proven vital, in fact, indispensable to both domestic and cross-national patent infringement litigants. Second, both procedures as described herein are used as such only in civil cases, although both Rule 34 discovery and the Saisie have criminal counterparts in the respective legal systems.[236] Third, both procedures permit judicial intervention in pre-trial fact-gathering.[237] The extent and timing of such involvement differ; while the judiciary performs the Saisie *ab initio*, the adversaries themselves propel Rule 34 inspections and courts only intervene as a last resort.[238] Thus, U.S. judges' "tools" of protective orders, motions to compel, and sanctions may never come into play if the parties collaborate satisfactorily.[239]

Fourth, both Rule 34-discovery and the Saisie present only one of several ways in which patent infringement litigants collect proof. For example, in-court witness testimony commonly supplements the evidence generated via these procedures. Nevertheless, the Saisie is independently codified, while Rule 34 is codified as part of a series of discovery rules that help supplement it and, concurrently, define its boundaries. Fifth, because infringement evidence tends to be of a technical nature, patent cases often necessitate technically trained experts to identify relevant facts. Both Rule 34 and the Saisie respond to this need by including experts, such as scientists and engineers, in the evidence-gathering process, in appropriate cases.[240] Sixth, and most importantly, both Rule 34 and the Saisie exclusively authorize the inspection of the same physical subject matter; documents, tangible things, and inspection of premises.[241] Especially in patent infringement cases, relevant evidence seems to take the form of documents and items, because they often embody the infringing object or at least its traces.[242]

Rule 34 discovery and the Saisie diverge most prominently in the *way* they extract evidence, these differences seem more subtle than the similarities listed above. First,

236 However, under United States substantive law a claim for patent infringement may only be brought as a civil suit. France on the other hands allows criminal actions for patent infringement. *See* BIZOLLON ET AL., *supra* note 157, at 84 – 86. In those cases a police official, rather than a bailiff, executes the search order. *See* Art. L. 332-1.
237 *See supra* Part II and Part III.
238 *See supra* Part II, B, 2, 3.
239 *See supra* Part II, B, 2, 3.
240 *See supra* Part II, A, 2 and Part III, B.
241 *See supra* Part II, A, 1, 2, and Part III, B.
242 *See supra* Part I.

as mentioned previously, Rule 34 discovery is broad and the Saisie is narrow in manifold ways.[243] Most importantly perhaps, discovery's broadness encompasses even inadmissible information and information which is not itself directly relevant as long as it may lead to probative evidence.[244] On the other hand, the Saisie is comparatively narrow by authorizing only the inspection and sampling of evidence that may itself be probative to proving infringement.

Second, the basic concept of discovery bases on cooperation and preparation,[245] while the Saisie builds on the notion of compulsion and surprise.[246] This difference has several ramifications regarding the parties' actions, reactions and the entire procedure's performance. For example, the cooperation concept requires that the defendant receive notice and, consequently, an opportunity to respond in opposition to production requests. This is because discovery, generally, happens only after filing suit.[247] Service of process eliminates the defendant or seized party's surprise, but, in order to prevent the destruction of probative evidence, discovery imposes an affirmative obligation upon the parties to preserve evidence.[248] Although discovery anticipates that the parties collaborate absent judicial intervention, safeguards, compulsion and court interception are possible by way of orders for protection, orders compelling discovery and sanctions.[249] Unlike in the Saisie, these are not the default, but only come into play after conflicts arise and the parties do not produce evidence and collaborate voluntarily as foreseen by Rule 26.

The Saisie, on the other hand, constitutes a pre-summons mechanism. It requires less cooperation from the parties and instead operates under a concept of compulsion and surprise. As pointed out above, the seized party has little obligation to assist the bailiff in finding evidence as long as it does not directly block or deter the inspection.[250] The element of surprise is essential, principally because the Saisie lacks an obligation to actively assist the adversary in finding evidence.[251] Surprising the seized party with an inspection mandates *ex parte* proceedings by the plaintiff in applying to the tribunal for a Saisie order. This means the procedure must occur pre-summons and not provide the seized party with the option of being heard or notified and thereby enable him to destroy or hide probative evidence. Because a seized party in a Saisie is always surprised and never notified in advance, it has no opportunity to destroy probative evidence.[252] Thus, the Saisie does not impose an obligation to preserve documents. The absence of a preservation requirement also relates back to the non-collaborative nature of the Saisie.

Third, Rule 34's reach to anything within the opponent's "possession, custody, and control" is broader than the Saisie. Although French law does not elaborate on this,

243 *See supra* Parts I & II.
244 *See* FED. R. CIV. P. 26(b)(1).
245 *See supra* Parts II, D.
246 *See supra* Parts III, A – B.
247 Except in the rare cases where courts permit Rule 27 discovery, because otherwise evidence would run risk of disappearing. *See* FED. R. CIV. P. 27.
248 *See id*.
249 *See e.g.* FED. R. CIV. P. 26(c)(1); *see* FED. R. CIV. P. 37(a).
250 *See supra* Part III, B.
251 *See supra* Part III, B.
252 *See supra* Part III, A.

the Saisie only applies to information and items that are physically located on the premises searched and also listed in the order.[253] Those items are simply located on the authorized premises; whether the seized party legally possesses, has custody or controls those items is irrelevant to the Saisie. Thus, whether discovery or the Saisie is broader depends on the specifics of a given case and the location and control of relevant evidence.

Fourth, while discovery is sensitive to privileges, the Saisie does not make an inquiry about the nature of a communication incorporated in a document.[254] Again, as under point three above, anything physically located on the authorized premises, described in the Saisie order, and relevant to proving infringement of the alleged patent, is fair game.[255]

Fifth, a protective order may render otherwise discoverable information under Rule 34 nondiscoverable.[256] That, naturally, requires a judge to order such a safeguard, which, again, is not the default, but rather an exception that the party seeking such protection must actively prove.[257] The Saisie, on the other hand, does not foresee protective orders. Its safeguards for protecting sensitive information, although not the same kind of sensitive information as recognized under United States' privilege law, apply before and after the Saisie; with discovery such protections are provided during the process. Thus, the Saisie protects sensitive information through the judge's ability to limit a Saisie order to what is relevant.

253 *See supra* Part III, A, B.
254 *See supra* Part II, B, 1.
255 *See supra* Part III, A – B.
256 *See supra* Part II, B, 2.
257 *Id.*