

III. Saisie-Contrefaçon

The French Intellectual Property Code (*Code de la propriété intellectuelle*) (CPI) governs the process of evidence-gathering known as *Saisie-contrefaçon*¹⁴⁰ in patent infringement lawsuits in France. The Saisie is strictly regulated and is anything but broad. This narrowness springs from at least five conditions. First, the Saisie is reserved exclusively for intellectual property *infringement* actions. It is worth noting, however, that separate provisions authorizing saisies, in substantially the same form, for other intellectual property rights exist elsewhere in the CPI.¹⁴¹ Second, a Saisie can only be conducted on the basis of a French patent¹⁴² or a European patent designating France.¹⁴³ Third, the Saisie, as an extraordinary measure, proceeds under the strict control of the judiciary, the officials of which authorize, carry out and review the process.¹⁴⁴ Fourth, only patentholders or their exclusive licensees may initiate a Saisie.¹⁴⁵ Fifth, the subject matter subject to a Saisie is limited to the evidence that the judge ordered and which relates to proving infringement of a specific patent.¹⁴⁶

France has a typical civil law legal system, characterized by codified laws, judge-controlled litigation,¹⁴⁷ continually progressing hearings, no juries and, most importantly, the absence of discovery.¹⁴⁸ It also boasts a long-standing tradition of protecting patents under a natural rights theory.¹⁴⁹ In fact, France passed its first modern patent law as early as 1791.¹⁵⁰ While that version of the law did not explicitly authorize a Saisie, courts interpreted the rights to a patent as incorporating the confiscation

140 Literally, this means “seizure-infringement” or “infringement seizure.”

141 Saisie measures as applied to copyrights, computer rights, trademarks, and patents are codified at Art. L 332-1, Art. L 332-4, Art. L 716-7, Art. L 615-5 CPI, respectively.

142 It must be noted, however, that Saisies are available for granted patents and also for *pending* French applications. See Art. R 615-2 CPI.

143 Art. L 614-9 CPI. Note that any patent or patent application must have an available French translation in order to confer rights to a Saisie. *Id.*

144 See Art. L 615-5 CPI; see Art. R 615-2 CPI; see Art. R 615-4 CPI.

145 Art. R 615-2, ¶2 – 3 CPI.

146 See *infra* Part III, A.

147 French judges, like those in other civil law countries, are career-judges. Cathrine Elliott & Cathrine Vernon, *The French Legal System* (2000), reprinted in *CIVIL LITIGATION IN COMPARATIVE CONTEXT*, 192 – 201, at 76 – 82 (Oscar G. Chase & Helen Hershkoff eds., Thompson/West 2007). See JUNKER, *supra* note 12, at 84 – 86 (comparing U.S. and German federal judges).

148 See CHASE ET AL., *supra* note 12, at 4 – 15 (identifying the basic elements of civil law procedure, by explaining German, French and Italian procedure, and comparing them with the common law model).

149 The French Patent Act of 1791 reflects the natural rights theory of intellectual property, which deems the right to an invention as a natural and personal right independent of any government-granted a privileges. SUBCOMM. ON PATENTS, TRADEMARKS, & COPYRIGHTS OF THE S. COMM. ON THE JUDICIARY, 85TH CONG., AN ECONOMIC REVIEW OF THE PATENT SYSTEM, at 44 (Comm. Print 1958) (prepared by Fritz Machlup).

150 Philippe Mueller, *Ex Parte Search Orders for Securing Evidence of Infringement: Implementation Process of Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the Enforcement of Intellectual Property Rights*, MAS-IP Diploma Papers & Research Reports – Paper 26, 17 (2005), available at <http://www.bepress.com/ndsip/papers/art26>.

of infringing articles for subsequent use at trial.¹⁵¹ In 1844, this construction was codified.¹⁵²

The Saisie's popularity in France is unquestionable. Virtually all patent infringement suits debut with a Saisie.¹⁵³ Conventional wisdom in patent litigation practice has it that a Saisie benefits even rightholders who already have sufficient evidence of infringement.¹⁵⁴ French law deems the right to a Saisie as inherent in the patent itself.¹⁵⁵ This right, as most rights, can be waived.¹⁵⁶ Further, the Saisie merely enables pre-litigation fact-gathering that will, in an ensuing lawsuit, help to prove patent infringement. Thus, it is not aimed to provide the rightholder with a preliminary injunction.¹⁵⁷

The Saisie unfolds itself in what may be distinguished as three separate phases; the request for the Saisie order, the performance of the Saisie, and then, the filing requirement and appeal option. The following sections explain the Saisie by way of this chronological unraveling.

A. *Before the Saisie: Ex-Parte Application for Inspection*

The Saisie doubtlessly appeals to plaintiffs due to its relative simplicity and low cost.¹⁵⁸ The process of applying for a Saisie order that a rightholder must undergo is notably effortless and streamlined.¹⁵⁹ A rightholder suspecting infringement of his patent may request the president of a district court (*tribunal de grande instance*)¹⁶⁰ of the place of the presumed infringement to authorize a Saisie of an expected infringer or any third party with potentially relevant information.¹⁶¹ However, the jurisdiction to authorize a Saisie is separate from that of adjudicating infringement cases. Thus, the president of the district court issuing the Saisie order is not necessarily from the same court subsequently adjudicating the infringement action.¹⁶² In total, 168 district courts exist across France, which makes it relatively convenient to file a Saisie

¹⁵¹ *Id.*

¹⁵² *Id.*

¹⁵³ See e.g. Boval, *Sicherungs- und einstweilige Maßnahmen im Zusammenhang mit Patentverletzungsklagen in Frankreich*, GRUR INT. 1993, 377 – 378.

¹⁵⁴ E.g. Jochen Bühlung, Frieger Mes & Graf v der Groeber, *Obtaining Evidence When Preparing Patent Litigation*, available at http://www.buildingipvalue.com/06EU/172_175.htm. (“Even when there is already sufficient evidence, clients are often advised to obtain additional evidence in order to obtain an official statement of a court-appointed expert that can be used in court.”)

¹⁵⁵ Philippe Mueller, *supra* note 150, at 17.

¹⁵⁶ Art. L 615-5 CPI (“Infringement can be proven by any means whatsoever”) (translation by the author).

¹⁵⁷ BIZOLLON, ET AL., *SAISIE-CONTREFACON 2* (Véron ed., Dalloz 2d ed. 2005); see Art. L 615-5 CPI (addressing the aim of finding evidence but making no mention of preliminary injunctions).

¹⁵⁸ In fact, plaintiffs' attorneys authored most of the literature available on the Saisie. They tend to praise the procedure as a powerful, quick, and cheap investigation tool. See Pierre Véron, *The “Saisie-Contrefacon”: An Overview*, 139. (Véron).

¹⁵⁹ See Simon Cohen & Martin Kohler, *Disclosures in European Patent Litigation: Towards an Efficient Protection of Patent Owners*, IP LITIGATOR (March 1, 2005), available at <http://www.accessmylibrary.com>.

¹⁶⁰ See Art. D 631-2 CPI

¹⁶¹ Art. L 615-5 CPI.

¹⁶² BIZOLLON ET AL., *supra* note 157, at 32.

request.¹⁶³ In doing so, the applicant must only show two things: ownership of a valid patent right and a subjective apprehension of its infringement.¹⁶⁴ The patent right which may constitute the basis of a Saisie must be either a national French patent¹⁶⁵ or a French-part of a European patent.¹⁶⁶ Further, it can be an issued and not-yet expired patent or a still-pending application.¹⁶⁷

The plaintiff's attorney files a petition defining the precise scope of the requested inspection.¹⁶⁸ This petition, typically, requests that certain persons be allowed to participate in the Saisie and that particular acts be performed.¹⁶⁹ Concurrently, the attorney files a draft order reflecting the above conditions.¹⁷⁰ If the requirements of a valid patent right and apprehension of infringement are met, a court must permit the Saisie, although it may limit it so as to prevent spying as well as useless and harassing acts.¹⁷¹ Accordingly, if the draft order conforms to the standard form, the judge, after having reviewed it, usually signs it without changes.¹⁷²

The president issuing the Saisie does not examine the merits of the alleged infringement or assess the validity or probability of the rightholder's assertions.¹⁷³ This rather cursory *pro forma* review roots itself in the understanding that a Saisie constitutes an inherent right of the patentholder.¹⁷⁴ The applicant also need not show evidence of infringement, because it is the very purpose of a Saisie to generate such evidence.¹⁷⁵ Nevertheless, the judge has discretion to require the posting of a bond if that appears necessary to protect the defendant from abuse and damages which the seizing party may cause.¹⁷⁶

Most importantly, the Saisie's force springs from its *ex parte* nature.¹⁷⁷ While the plaintiff applies for and is granted the Saisie, no others are notified.¹⁷⁸ This aims to maximize the defendant's surprise and prevent him from hiding evidence of infringement. Thus, the Saisie's application process gives the defendant no right to voice his stance or make out a defense; he is typically notified of the Saisie only when the bailiff

163 While a Saisie may be requested in 168 fora, only 10 courts have jurisdiction to hear patent infringement cases.

164 Art. R 615-2, ¶ 2 CPI.

165 Meaning one issued by the French patent office. Interestingly, the French patent office does not conduct substantive examinations.

166 At this point it is worth noting that a European patent, granted by the European Patent Office (EPO), constitutes a bundle of national rights. That is, the EPO conducts a substantive examination of the patent application, but upon issuance the patent becomes a series of purely national rights in the countries designated in the application. Accordingly, the patent can be revoked in one country but remain in force in another. Moreover, the granted patent is subject to national law concerning both substance and procedure.

167 Art. R 615-2, ¶ 2 CPI.

168 Véron I, *supra* note 157, at 136.

169 *Id.*

170 CA Aix-en-Provence, 1^{er} déc. 1976, *PIBD* 1977, n° 186, III, 63, et *Ann. propr. ind.* 1978, 293.

171 *Id.*

173 See Art. R 615-2 CPI; Philippe Mueller, *supra* note 150, at 29 ("The judge has no right to assess the degree of probability of infringement.").

174 Véron I, *supra* note 157, at 136. ("The holder of a valid right is *entitled* to obtain a Court order authorizing the saisie") (emphasis added).

175 *Id.*

176 BIZOLLON ET AL., *supra* note 157, at 43 – 44.

177 Véron I, *supra* note 157, at 136.

178 Philippe Mueller, *supra* note 150, at 17.

pounds on his door in order to perform the inspection.¹⁷⁹ Although the seized party may appeal the decision to grant a Saisie, such an appeal lacks suspensive effect.¹⁸⁰ Thus, the seized party has virtually no means to legally prevent the Saisie.¹⁸¹ While being granted a Saisie is markedly simple for the rightholder, drafting an effective request, which hopefully will become the basis for an order, may prove more challenging.¹⁸² This is so because the Saisie, in contrast to discovery, does not require the parties to cooperate. Put differently, the defendant need not actively support his adversaries' search for evidence.¹⁸³ Thus, while the Saisie order grants access to inspect and search the defendant's premises, within the limits set out in the order, such admittance does not make relevant evidence magically appear. Instead, the right-holder must know where to search for evidence of possible infringement and specify so in the request. This task is not simple. After all, the parties are probably competitors and, thus, are unlikely to visit each other regularly so as to have some familiarity with the other's premises and operations.¹⁸⁴

B. During the Saisie: Carrying out the Order

In theory, the bailiff (*huissier de justice*) is the only person essential to execute a Saisie.¹⁸⁵ He performs the inspection by way of documenting information and gathering items while others, if present, merely assist.¹⁸⁶ Although the rightholder may choose the bailiff,¹⁸⁷ the bailiff is a public official who acts on behalf of the court. The United States' legal system does not engage a comparable judicial officer. While the bailiff is absolutely essential to performing a Saisie, he has little discretion regarding evidence.¹⁸⁸ This is because the order spells out precisely what he must do.¹⁸⁹ If his actions exceed what the order permits, the Saisie is susceptible to annulment later on.¹⁹⁰

In practice, a team of technical experts, police and others depending on the demands of the case, accompany the bailiff.¹⁹¹ Those persons often prove especially vital to the Saisie's success, because the seized party has little obligation to assist the bailiff in locating evidence and the bailiff tends to be unfamiliar with the specific infringement at hand. The rightholder also has a right to select the experts, although he may not

179 Véron I, *supra* note 157, at 136.

180 Cohen & Kohler, *supra* note 159.

181 *Id.*

182 *Id.* ("The real trouble for the patentee might start once the saisie-contrefaçon is granted and [...] the search for evidence is launched at the place of the defendant.")

183 *Id.*

184 *See id.*

185 *See* Art. L 615-5 CPI.

186 *See* Véron I, *supra* note 157, at 137.

187 Art. L 615-5 CPI; BIZOLLO ET AL., *supra* note 157, at 35 – 36 (stating that the plaintiff must not mention the bailiff by name, but can refer to any bailiff authorized to practice in the court's jurisdiction.)

188 BIZOLLO ET AL., *supra* note 157, at 43.

189 *Id.*

190 *See id.*

191 *Id.* at 36 – 37.