

## Bringing evidence of infringement in France after the Enforcement directive: the *saisie-contrefaçon* and other available tools

ÖV-Expertengespräch

"IP-Rechtsdurchsetzung in Europa: Gut, besser ... und morgen?"

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### Overview

- Provisions of the IP Enforcement Directive (IPED) and of the French Intellectual Property Code (IPC)
- Overview of the means of evidence used in France
- *Saisie-contrefaçon*
- Protection of confidential information
- Use of the information gathered during the *saisie-contrefaçon*
- Right of information and rendering of accounts

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## IPED: a minimum

### Art. 2 : Scope

*“Without prejudice to the means which are or may be provided for in Community or national legislation, **in so far as those means may be more favourable for rightholders**, the measures, procedures and remedies provided for by this Directive shall apply, in accordance with Article 3, to any infringement of intellectual property rights as provided for by Community law and/or by the national law of the Member State concerned.”*

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## IPED: fairness and proportionality

### Art. 3 : General obligation

*“1. Member States shall provide for the measures, procedures and remedies necessary to ensure the enforcement of the intellectual property rights covered by this Directive. Those measures, procedures and remedies shall be **fair and equitable** and **shall not be unnecessarily complicated or costly**, or entail unreasonable time-limits or unwarranted delays.*

*2. Those measures, procedures and remedies shall also be **effective, proportionate and dissuasive** and shall be applied in such a manner as to avoid the creation of barriers to legitimate trade and to provide for safeguards against their abuse.”*

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## IPED: Compulsory production of evidence

### Art. 6 : Evidence

"1. Member States shall ensure that, on application by a party which has presented reasonably available evidence sufficient to support its claims, and has, in substantiating those claims, specified evidence which lies in the control of the opposing party, the competent judicial authorities may **order that such evidence be presented by the opposing party**, subject to the protection of confidential information (...).

2. Under the same conditions, in the case of an infringement committed on a commercial scale Member States shall take such measures as are necessary to enable the competent judicial authorities to order, where appropriate, on application by a party, the **communication of banking, financial or commercial documents under the control of the opposing party**, subject to the protection of confidential information."

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## IPED: Measures for preserving evidence

### Art. 7: Measures for preserving evidence

"1. Member States shall ensure that, even before the commencement of proceedings on the merits of the case, the competent judicial authorities may, on application by a party who has presented reasonably available evidence to support his/her claims that his/her intellectual property right has been infringed or is about to be infringed, order **prompt and effective provisional measures to preserve relevant evidence in respect of the alleged infringement**, subject to the protection of confidential information. Such measures may include the detailed description, with or without the taking of samples, or the physical seizure of the infringing goods, and, in appropriate cases, the materials and implements used in the production and/or distribution of these goods and the documents relating thereto (...)"

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## IPED: Right of information

### Art. 8 : Right of information

“1. Member States shall ensure that, in the context of proceedings concerning an infringement of an intellectual property right and in response to a justified and proportionate request of the claimant, the competent judicial authorities may order that **information on the origin and distribution networks of the goods or services which infringe an intellectual property right** be provided by the infringer and/or any other person who (...)”

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## French IPC: Saisie-contrefaçon

### Article L. 615-5

(not amended in the framework of the implementation of IPED in France)

“The infringement shall be proven by any means.  
For that purpose, **any person** with authority to bring an action for infringement **shall be entitled**, on an ex parte order issued by the competent civil court, **to direct any bailiff if necessary accompanied by experts appointed by the claimant**, to proceed in any place with either the detailed description, with or without the taking of samples, or the physical seizure of the allegedly infringing articles or processes as well as any related document. The order may authorise the physical seizure of any document relating to the allegedly infringing products or processes in the absence of these products or processes.”

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## French IPC: Compulsory production of evidence

### Article L. 615-5-1-1

*"The court may order, automatically or at the request of any person with authority to bring an action for infringement, all the investigative measures legally admissible even if a saisie-contrefaçon has not been ordered previously under the conditions provided for in Article L. 615-5."*

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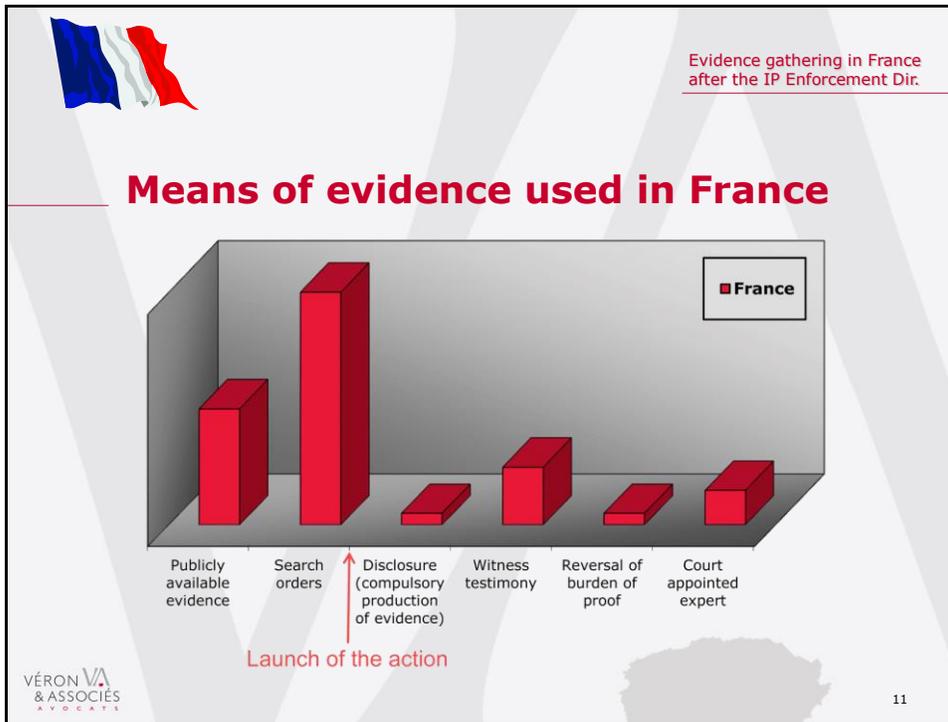
## French IPC: Right of information

### Article L. 615-5-1-2

*"If so required, the court hearing on the merits or in preliminary proceedings shall order, under penalty of a daily fine if necessary, **in order to determine the origin and the distribution networks of the allegedly infringing goods or processes which prejudice the claimant's rights, the communication of any document or information held by the defendant** or by any person who was found in possession of allegedly infringing goods or goods implementing allegedly infringing processes or who provides services used in allegedly infringing activities or was reported to take part to the production, manufacturing or distribution of such products, the implementation of such processes or the supply of such services."*

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**Comparison**  
**The French *saisie-contrefaçon* and the IPED "Measure to preserve evidence"**

<p><b>France</b>  <i>Saisie-contrefaçon</i></p> <p>Intellectual Property Code              Article L. 615-5              Articles R. 615-2 to R. 615-4</p>	<p><b>IP Enforcement Dir.</b>  <i>Measure to preserve evidence</i></p> <p>Article 7.1 to 7.4</p>
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## Obtaining the order: theoretically easier under French law

### France

- According to the IPC, a *saisie* order is a right for the patent owner (“... shall be entitled...”): the applicant is not required by law to present evidence of infringement; but, in practice, the judges require *prima facie* evidence of infringement
- the other party is never heard nor informed before the *saisie*

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### IPED

- the applicant must present “reasonably available evidence to support the claim that the patent has been infringed or is about to be infringed”
- “measures shall be ordered, if necessary without the other party having been heard, in particular where any delay is likely to cause irreparable harm to the proprietor of the patent, or where there is a demonstrable risk of evidence being destroyed”

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## Casting of the *saisie-contrefaçon*

### France

- the applicant shall not be present itself
- the *saisie* is conducted by a bailiff (a variety of public officer) chosen by the applicant
- the bailiff may be assisted by experts chosen by the applicant; they must be “independent” (usually the applicant’s patent attorney who is assumed to be ethically independent)

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### IPED silent

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## Measures to be implemented during the *saisie-contrefaçon*

### France

- Detailed description, with or without the taking of samples
- Physical seizure of the allegedly infringing articles or processes as well as any related document
- Physical seizure of any document relating to the allegedly infringing products or processes in the absence of these products or processes.

### IPED

- Detailed description, with or without the taking of samples
- Physical seizure of the infringing goods
- In appropriate cases, physical seizure of the materials and implements used in the production and/or distribution of these goods and the documents relating thereto

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## Report on the *saisie-contrefaçon*

### France

- The person subject to *saisie* receives a copy of the order authorizing the *saisie* just before it takes place
- The same receives a copy of the bailiff's report immediately after the *saisie*
- The petitioner receives a copy of the bailiff's report immediately after the *saisie* (subject to confidential information)

### IPED

- Where measures to preserve evidence are adopted without the other party having been heard, the parties affected shall be given notice, without delay after the execution of the measures at the latest

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## The aftermath

### France

- The person subject to *saisie* or the defendant in the proceedings on the merits can ask the judge who signed the order authorizing the *saisie* to withdraw it
- The petitioner has 20 working days or 31 calendar days (whichever is the longer) to institute an action on the merits
- The defendant can ask for the nullity of the bailiff's report in the proceedings on the merits if the order has not been implemented properly

### IPED

- A review, including a right to be heard, shall take place upon request of the parties affected with a view to deciding, within a reasonable period after the notification of the measures, whether the measures shall be modified, revoked or confirmed
- Measures to preserve evidence are revoked or otherwise cease to have effect if the applicant does not institute, proceedings leading to a decision on the merits of the case before the competent judicial authority within a period not exceeding 20 working days or 31 calendar days, unless provided otherwise by national law

## Liability of the petitioner

### France

- The petitioner is never requested to lodge a security before the *saisie*
- But the *saisie* is implemented at its own risks
- The petitioner is liable if abusive *saisie* harmed the seized party (e.g. disclosure of confidential information)
- Rare decisions holding the petitioner liable (because, in practice, *saisie* carried out carefully in most cases)

### IPED

- Measures to preserve evidence may be subject to the lodging by the applicant of adequate security or an equivalent assurance intended to ensure compensation for any prejudice suffered by the defendant
- Where the measures to preserve evidence are revoked, or where they lapse due to any act or omission by the applicant, or where it is subsequently found that there has been no infringement or threat of infringement of an intellectual property right, the judicial authorities shall have the authority to order the applicant, upon request of the defendant, to provide the defendant appropriate compensation for any injury caused by those measures

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## Protection of confidential information

### France

- When the person subject to *saisie* alleges that a document contains confidential information, the bailiff puts it in a sealed envelope
- The documents under seal will be reviewed by parties' counsels for redaction of information not useful for evidence of infringement
- Where parties disagree, the court decides, often on the basis of the report of a court appointed expert

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### IPED

- Protection of confidential information under paragraph (20) of the preamble: "*The procedures should have regard to the rights of the defence and provide the necessary guarantees, including the protection of confidential information.*"
- Protection of confidentiality also arises from principle of proportionality (Article 3)

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## Used of seized documents abroad

### France

- Unless otherwise provided by the order, the bailiff's report and the seized documents and samples can be use in parallel foreign proceedings
- A few decisions have recently held that, pursuant to the principle of proportionality, the confidential documents shall not be used abroad before a decision on the merits, even if these documents are useful to evidence the infringement

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### IPED

- Protection of confidential information under paragraph (20) of the preamble: "*The procedures should have regard to the rights of the defence and provide the necessary guarantees, including the protection of confidential information.*"
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## Rights of information and rendering of accounts: new measures implemented into French law after the IPED

- Because *saisie-contrefaçon* allows to gather accounting information to assess the volume of the infringement, compulsory production of financial information was rarely ordered
- Since implementation of IPED provisions into French law, French courts often orders the defendant:
  - ▶ to communicate information on the channels of distribution, in the course of the proceedings
  - ▶ to render accounts, in the judgement on the merits (financial experts now rarely appointed)

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[www.saisie-contrefacon.fr](http://www.saisie-contrefacon.fr)

## The film "*Saisie-contrefaçon*"

This 15-minute film aims to provide a brief introduction to the French *saisie-contrefaçon*, which allows holders of industrial property rights to obtain evidence of an infringement of such rights. It gives non-specialists a quick and simplified overview, which cannot reflect the diversity of the situations and the legal complexity of the measure.



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## Trilingual website [www.saisie-contrefacon.fr](http://www.saisie-contrefacon.fr)



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## The trilingual book "Saisie-contrefaçon"



Includes a chapter  
on the order to  
preserve evidence  
at the Unified  
Patent Court

[www.bookshop-saisie-contrefacon.fr](http://www.bookshop-saisie-contrefacon.fr)

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**Thank you**

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