Heymanns Intellectual Property

Aloys Hüttermann

Unitary Patent and Unified Patent Court

Wolters Kluwer

Chapter 32: Comparison with French Law

Contents Para

The Unified Patent Court system inherits many features of the French national patent litigation system. Therefore, it is to be expected that French patent judges and litigators will feel at ease with the new system with minor adjustments. 1783

I. Structure

In France, since 2009, the "tribunal judiciaire de Paris" (the new name of the "tribunal de grande instance" since 1st January 2020) has been granted an exclusive jurisdiction for patent cases; it deals with hundreds of patent cases each year (the other 163 ordinary courts of first instance in France have no jurisdiction for such matters). Hence a difference with the UPC which will probably have more than 15 local or regional divisions in addition to the Paris seat and the two sections of the central division: in France, with a single court sitting in Paris having jurisdiction for the whole country, there is no issue of proper venue or forum shopping. 1784

The tribunal judiciaire de Paris has jurisdiction to decide on both validity and infringement in the same proceedings (the alleged infringer may either raise an invalidity defence or lodge a counterclaim for revocation). With a single court for the whole of France having jurisdiction on validity and infringement, the bifurcation issue does not exist. 1785

The appellate jurisdiction of the tribunal judiciaire de Paris is the cour d'appel de Paris. 1786

The only possible recourse against the rulings of the cour d'appel de Paris is the pourvoi en cassation (appeal on a point of law) brought before France's highest court for civil matters, the Cour de cassation. When such appeal is lodged, the Cour de cassation will only assess whether the law has been correctly interpreted and applied and will not question the facts as found by the cour d'appel de Paris. If the Cour de cassation finds that the cour d'appel correctly applied the law, it will reject the appeal on a point of law. If not, the decision of the cour d'appel will be quashed. In patent cases, when the judgment of the cour d'appel de Paris is quashed, the case is remanded to the same cour d'appel which must, however, be composed of different judges. 1787

1788 A major and obvious difference is that the judgments of the UPC's Court of Appeal will be final, no recourse before a higher court being possible against them[1].

II. Composition

1789 All the judges of the tribunal judiciaire de Paris are legally qualified (there are no technically qualified judges in the tribunal). The judges belonging to the IP section of the court (known as the 3rd chamber) have an interest in intellectual property law as they have to apply to join this section, and they gain experience in patent law by sitting for several years in that section.

1790 The IP section of the tribunal judiciaire de Paris currently consists of 9 judges sitting in 3 panels of 3 judges (the situation will be different in the UPC when the validity of the patent is at issue, with 4 judges sitting in a panel: 3 legally qualified judges and 1 technically qualified judge).

1791 The IP section of the cour d'appel de Paris comprises 6 judges sitting in 2 panels of 3 judges (a further difference with the UPC, as the panels of the UPC's Court of Appeal will include 5 judges: 3 legally qualified judges and 2 technically qualified judges).

1792 At the Cour de cassation, two highly experienced IP senior judges (conseillers) and two junior judges (conseillers référendaires) are in charge of patent cases.

III. Representation

1793 The parties to a dispute pending before the tribunal judiciaire de Paris or the cour d'appel de Paris must be represented by an attorney-at-law member of the Paris Bar (Article 751 FR CPC and Article 899 FR CPC). Before the Cour de cassation, representation by an attorney-at-law admitted before this court (avocat au Conseil d'Etat et à la Cour de cassation) is mandatory (Article 973 FR CPC). The Paris Bar and the Cour de cassation Bar are different: an attorney-at-law cannot be a member of both.

1794 This is a difference with the UPC where parties may be represented not only by an attorney-at-law but also by a patent attorney (Article 48 UPCA).

IV. Jurisdiction

1795 While the UPC's jurisdiction is strictly limited by Article 32 UPCA to those actions specifically listed under subparagraphs (a) to (i) (infringement, declaration of non-infringement, provisional measures, revocation, counterclaim for revocation,

1 The only recourse against a final decision of the Unified Patent Court is the "rehearing", with the permission of the Court of Appeal, on discovery of a new and decisive fact that was held by a national court to constitute a criminal offence, or in the event of a fundamental procedural defect (Article 81 UPCA and Rule 247).

compensation for provisional protection conferred by a published European patent application, prior use, compensation for licence of right, decisions of the European Patent Office about unitary patents), the tribunal judiciaire de Paris, being an ordinary court, has a wider, unlimited jurisdiction on patent matters; it may also deal with claims related to ownership (notably rei vindicatio), compensation for employees' inventions, joint R&D, transfer and license agreements, etc.; when seized with a patent case, it may also deal with related claims like unfair competition or infringement of other intellectual property rights (trademarks, designs, copyrights).

V. Procedural Principles

The proceedings before the tribunal judiciaire de Paris and before the UPC share many common procedural principles, with nuances as to their application: 1796

- the adversarial ("accusatoire") system, by which the burden of proof is borne by the litigants who have to convince judges who remain independent (Article 17 UPCA), impartial and will not investigate the case themselves;
- the principle of party disposition ("dispositif" principle), under which the subject-matter of an action is delimited by the parties' claims and judges cannot rule infra or ultra petita (Article 76 (1) UPCA);
- the "contradictoire" principle, according to which the parties have to exchange every element of fact and law (Article 76 (2) UPCA) and must never communicate privately with the Court (Rule 8.3);
- the front-loading principle set out in the Preamble of the UPC's Rules of procedure ("Parties shall… set out their full case as early as possible in the proceedings") and in Rule 9 (2) ("The Court may disregard any step, fact, evidence or argument which a party has not taken or submitted in accordance with a time limit set by the Court or these Rules") is, however, stronger than the French rules of Article 15 FR CPC ("Parties must disclose in due time to one another factual arguments supporting their claims, the means of evidence they produce and the legal arguments they rely upon so that each party may organise his defence") and Article 135 FR CPC ("The court may disregard the documents which have not been adduced in due time"). The only obligation before French courts is to refrain from raising new arguments or producing new evidence at the last minute; there is no direct and explicit obligation to put anything on the table up-front. This is, however, somewhat theoretical as clever patent litigators usually set out their case in details as early as possible;
- an encouragement towards an amicable settlement (Article 52 (2) UPCA and Rule 11; the recently modified Article 56 FR CPC now places any French litigant before commencing legal proceedings under the obligation to provide evidence that he has previously tried to reach an amicable solution to the dispute);
- attorney-client privilege ("secret professionnel") from disclosure (Article 48 and Rule 287);
- legal aid ("aide juridictionnelle") for parties unable to meet the costs of proceedings (Article 71 UPCA and Rule 375) is available for natural persons in France.

1797 The UPC system is also similar to the French national patent litigation system with regard to what it does not allow litigants to seek or claim, such as:

- pre-trial discovery: Article 59 UPCA and Rule 190 only allow for very limited and content-specific orders to produce evidence, which in no way compares with common-law-style discovery or disclosure; similarly Article 138 FR CPC (also applicable to documents held by the parties) provides that "If, during the proceedings, a party wishes to rely on… a document held by a third party, he may request the judge, to whom the matter is referred to, to order the production… of the document"); however, the current French judicial practice is extremely restrictive; it only allows such production when a party can identify a document and show that it is crucial to the outcome of the case; it is absolutely impossible to compare this to discovery;
- cross-examination: live-testimony of witnesses is theoretically allowed under French law in civil cases (Article 203 FR CPC), but it is never used in practice (usually this is replaced by a written testimony); cross-examination of witnesses by the parties' attorneys is strictly forbidden before French courts where only the judges may ask questions (Article 214 FR CPC); before the UPC, Article 53 (1) (d) and (2) in fine UPCA and Rules 176, 178.5 and 181 make a limited cross-examination possible, but under the control of the court.

VI. Similarites and Differences

1798 Similar traits between the UPC and the French patent litigation procedural system are numerous:

- a written procedure (Article 52 UPCA and Rule 12);
- electronic submission of pleadings, which will be the rule before the UPC, has been the standard practice in the tribunal judiciaire de Paris for many years (Article 44 UPCA, Rule 170.1 d) and Rule 178.6);
- the burden of proof lying in principle with the claimant, with the possibility of reversal for patents protecting a process to obtain a product (Article 55 UPCA, similar to Article L. 615–5-1 FR IPC);
- order to preserve evidence and to inspect premises (Article 60 UPCA and Rule 192, similar —albeit less easily accessible —to the "saisie-contrefaçon" of Article L. 615–5 FR IPC);
- provisional and protective measures (Article 62 UPCA and Rule 206), similar to the preliminary injunction proceedings of Article L. 615–3 FR IPC;
- an interim case management phase similar to the French "mise en état" (Article 52 UPCA, Rule 104 and Rule 239), during which parties must exchange their submissions in a timely and fair manner (Rule 36), under the supervision of a designated judge-rapporteur (Rule 18);
- the Court's power to appoint independent experts to assist with a technical question in relation to the case (Article 57 UPCA and Rule 185);
- a similar one-day oral hearing (Rule 113), as a hearing in a patent case before the tribunal judiciaire de Paris usually does not last more than two or three hours;

– the determination of the amount of damages ("dommages-intérêts") can be the subject of separate, further, proceedings in France, as it may be in the Unified Patent Court (Rule 125);
– no suspensive effect of the appeal: UPC appeals do not have a suspensive effect unless the Court of Appeal decides otherwise (Article 74 UPCA); in the same way, in France, since 1st January 2020, an appeal has no suspensive effect unless otherwise ordered by the lower court or by the court of appeal.

The differences between the Unified Patent Court and the French patent litigation procedural system are not that many: 1799

– language of proceedings: the French patent litigation system is 100 % in French, statements of claims, submissions, evidence and oral pleadings must always be made or given in French; all the documents or exhibits must be translated into French (relevant parts only; no sworn translation generally needed); this is the result of the most antique statutory provision of French law, known as Ordinance of Villers-Cotterêts signed into law by King Francis I of France on 25 August 1539; the language regime of the Unified Patent Court is much more complex (the official language of the Contracting Member State hosting the relevant division or the EPO official language designated by this State; at the central division, the language in which the patent concerned was granted);
– duration of proceedings: it is intended to be around one year at the Unified Patent Court (Preamble of the Rules, paragraph 7), whereas in France it usually is between 18 and 24 months;
– protective letters (shields against preliminary measures which could be granted without the alleged infringer being heard); they are accepted at the Unified Patent Court (Rule 207); they cannot be lodged before the tribunal judiciaire de Paris, but this has no practical consequence because this court would generally not order preliminary measures without the alleged infringer being heard;
– freezing orders (Article 61 UPCA): these are not ordered by French courts;
– publicity of justice (Rules 115 and 262): before the UPC, "written pleadings, written evidence lodged at the Court shall be available to the public upon reasoned request to the Registry"; however, "a party may request that certain information of written pleadings or evidence be kept confidential and provide specific reasons for such confidentiality"; the hearings are open to the public unless the Court decides to make a hearing confidential in the interest of one of the parties or both parties, or third parties, or in the general interest of justice or public order. By contrast, in France, the written pleadings and written evidence are not available to third parties. The hearings are, as a rule, open to the public, but the court may order to make a hearing confidential. The decisions are available to the public (however, when the decision contains confidential information, a party may request that only a redacted copy where such information is masked be available to the public);
– dissenting opinions: these are allowed by Article 78 (2) UPCA and Rule 350.3, but forbidden by Article 448 FR CPC which provides that "the deliberations of the judges are secret";

– appeal proceedings: the cour d'appel de Paris reviews the case de novo both in fact and in law; new claims are generally not admissible before the cour d'appel, but new legal grounds may be put forward in some cases; new legal arguments and new documents are admissible (the cour d'appel does not decide only on the documents brought before the tribunal); by contrast, new evidence may not be admissible before the UPC Court of Appeal (Rule 222.2).

VII. Costs of Proceedings

1800 Article 36 UPCA sets out the principle that the Court should be self-financed ("The budget of the Court shall be financed by the Court's own financial revenues and, at least in the transitional period referred to in Article 83 as necessary, by contributions from the Contracting Member States. The budget shall be balanced"). In France, the principle of free justice as a public service (Article L. 111–2 of the French code de l'organisation judiciaire), means that litigants only pay nominal fees —— around €100 —— to cover administrative costs;

1. Decisions on costs

1801 The decisions on costs (be it court costs ("dépens") and attorney's fees and other legal expenses "frais irrépétibles") are given in France at the same time as the judgment on the issue decided; they are never the subject-matter of separate proceedings, unlike before the UPC (Rule 150);

2. Recovery of costs and attorney's fees:

1802 The cap for recoverable costs before the UPC should be as high as €5,000,000 (for proceedings where the value at stake exceeds €50,0000,000 that are particularly complex or involved multiple languages, according to Article 2 of the decision of 25 February 2016 of the Preparatory Committee of the UPC on the scale of recoverable costs ceilings). In France, legal costs and attorney's fees in the amount set by the court are borne by the losing party. Decisions on costs are less elaborate and there is no theoretical cap on how much attorney fees a party can recover. The largest amount granted in first instance was about €300,000. During the same period, the average amount of costs ordered by the cour d'appel de Paris in patent cases was around €50,000 while the largest amount was €300,000.