

# The French "*saisie-contrefaçon*"

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The French *saisie-contrefaçon*

## A French icon


- The most efficient way to gather evidence of infringement in France
- Used in 80% of infringement actions
- 600 *saisies* ordered each year by the Court of Paris (probably 1500 in France each year) for all IP matters



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## The *saisie-contrefaçon* in a nutshell

- The *saisie* is a way to gather evidence of infringement, not a preliminary injunction
- Upon authorization granted *ex-parte*, a bailiff assisted by experts chosen by the claimant may enter any premises where proof of infringement might be found to perform the authorized investigations
- The report handed to the claimant is later exhibited to the Court

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## Article L. 615-5 Intellectual Property Code

*"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 the order issued upon request by the competent civil court, to direct any bailiff, accompanied by experts appointed by the claimant, to proceed in any place with either the detailed description, with or without taking samples, or the effective seizure of the allegedly infringing articles or processes as well as any related document.*

*The court shall order, for the same evidential purposes, the effective seizure of equipment and tools used to manufacture or distribute the goods or to implement the allegedly infringing processes.*

*It may condition the implementation of the measures it ordered to the furnishing by the claimant of security to ensure, if necessary, the defendant's compensation if the infringement action is subsequently held unfounded or the seizure is cancelled.*


*If the claimant fails to institute legal proceedings on the merits, either by civil action or criminal action, within a period of time set by regulation, the entire seizure, including the description, shall be void upon the defendant's request, without its having to motivate its request and without prejudice to the damages which may be claimed."*

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## The grant of the order: an *ex-parte* procedure



- The *saisie* must be authorized by the President of one of the seven *Tribunaux de grande instance* (civil courts) having jurisdiction over patent issues in the jurisdiction of which the alleged infringement can be evidenced
- The petition is submitted by the claimant's attorney-at-law
- The defendant is not informed of the petition, he is informed only when the *saisie* is performed

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## The *saisie*, a right for the owner

- The Judge **must** grant the order, if the claimant relies on:
  - ▶ a French or European patent in force
  - ▶ a published application of a French or European patent
  - ▶ a French or European application notified to the alleged infringer
- A *saisie* cannot be performed in France on the basis of a foreign patent
- No preliminary evidence required
- Judge can only restrict the terms of the petition or order the claimant to lodge a security or a bond

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## Who can request a *saisie*?

- Patentee
- Exclusive licensee, unless otherwise provided, after an unsuccessful notice to the patentee
- Non-contractual licensee, after an unsuccessful notice to the patentee


## Practical tips

- The aim of the *saisie* is to gather evidence, not to look for evidence
- It is vital to identify **before** the *saisie* information and documents needed to demonstrate infringement including origin and extent

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## Identification of the targets

- Manufacturing plants
- Places of storage
- Points of exhibition, of sale
- Hospitals
- Administrative bodies (AFSSAPS)
- Customs
- Accounting data




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## Simultaneous *saisies*



- It is sometimes necessary to perform simultaneous *saisies* (company headquarters, plants, suppliers, sellers...)
- Thus, it is essential to coordinate the *saisies* to keep the surprise


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**Who conducts the *saisie*?**

- The *saisie* is performed by a *huissier*, a public officer (bailiff)




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**Who may take part to the *saisie*?**



- An expert may help the bailiff to describe the infringing device
  - ▶ independent from the parties
  - ▶ generally a patent attorney
- Case law on the expert authorized to assist the bailiff in view of article 6 of ECHR on the right to a fair trial:
  - ▶ *Cour de Cassation*, July 6, 2000 (software): the employee of the plaintiff is not independent and is therefore not allowed to assist the bailiff
  - ▶ *Cour de Cassation*, March 8, 2005 (trademark): the trademark attorney (*conseil en propriété industrielle*) is considered as independent from his client and can therefore assist the bailiff

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### Who may take part to the *saisie*?

- A police officer (or squad if appropriate)
- Any other person whose technical skills may be useful: a photograph, a computer expert, a locksmith, an accountant...
- To perform a *saisie* in a hospital a representative of the medical doctors official association (in case access to individual medical data is required)



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### Evidence to be gathered


- Description and photographs of the accused device
- Copy of technical and commercial documents and accounting data
- Copy of program software



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## Physical seizure

- Seizure of samples (to be paid according to the defendant's price list)
- Seizure of equipment and tools to manufacture or distribute the products or to implement the accused processes is allowed
- Seizure of the stocks: possible with special permission

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## Confidentiality issues

- The defendant may ask the bailiff to place confidential documents in a sealed envelop
- The Court usually appoints an expert to sort out:
  - ▶ documents (even confidential) useful to prove the infringement which are handed over to the claimant
  - ▶ documents not related to the infringement which are not handed over to the claimant even if they are not confidential


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**The aftermath :  
the plaintiff must start an action**



- The plaintiff must start proceedings within 20 working days or 31 calendar days (if longer) (article R. 615-3 Intellectual Property Code)
- Otherwise: the whole *saisie* is invalid

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**The aftermath:  
the validity of the *saisie* may be disputed**

- The defendant may challenge
  - ▶ the grant of the order
  - ▶ the validity of the *saisie*
- Courts are increasingly strict

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