

FRANCE

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I. Quick and effective obtention of evidence

1.1. Discovery

A key difference between French and common law judicial systems lies in the evidentiary process.

There is no discovery process in France.

Each party decides which evidence is worth producing.

As a result, the plaintiff cannot ask the defendant to produce information relating to the infringing product or process.

Likewise, the alleged infringer cannot ask the plaintiff to produce prior art : he has to search himself for the information he needs to challenge the validity of the patent.

The use of witnesses or expert witnesses is exceptional.

To enable the plaintiff to collect the necessary material to prove infringement, the French Industrial Property Code (article L 615-5) provides the patentee with the infringement seizure ("*saisie contrefaçon*").

1.2. How to obtain evidence - seizure orders

1.2.1. What is infringement seizure ?

The infringement seizure does not consist in an injunction.

It mainly permits a visit of the alleged defendant's premises by a bailiff, ("*huissier*"), a public officer, whose statements are deemed authentic.

The public officer can be accompanied by a policeman, a patent agent chosen by the patentee, a photographer, an accountant or any other person whose skills may be useful (e.g. a computer expert if the seizure is directed toward information stored in a computerised information system).

The public officer writes down the description dictated by the patent agent of the infringing device.

He can take photos or video, if appropriate, look into the accountancy books, review the technical and commercial documents and make copies of the relevant documents.

The public officer can also buy samples.

1.2.2. How to get an order for an infringement seizure ?

The infringement seizure has to be authorised by the presiding Judge of the local Court of First Instance ("*Tribunal de Grande Instance*").

For this purpose, counsel for the patentee drafts and files a petition defining the exact scope of the authorisation requested.

Typically, the petition indicates :

- the persons authorised to assist the public officer (a policeman, a patent agent chosen by himself, a photographer...),
- the acts the public officer is authorised to perform (to be shown a machine, accountancy books, technical and commercial documentation, to make copies of some documents, to operate a machine, to acquire some samples of the infringing product(s)...).

The filing of the petition is *ex parte* (the defendant is only informed of the Court order by the bailiff, upon his arrival to perform seizure).

Exceptionally, the Judge restrict the terms of the petition, for example by adding that the seizure has to be carried out by a given date, or conditioning his authorisation upon the deposit of a bond by the petitioner.

But, usually, especially when the terms of the requested order appear reasonable, the Judge does not modify the petition.

1.2.3. Protection of confidential information

It happens that the seized party objects to the seizure of some information alleged to be confidential.

In most cases, the dispute is solved by the appointment by the Court of an expert who is commissioned to listen to the parties and to sort out which documents (even confidential) are necessary to prove the infringement and which are not.

1.3. Schedule of events from the complaint until the trial

- The plaintiff must serve a complaint on the alleged infringer within 15 days from the date of the infringement seizure.

Failure to serve such complaint makes the seizure void.

- The plaintiff has the complaint recorded in Court ; a Judge in charge of supervising the progress of the proceedings is appointed ; this Judge will fix the dates of the different steps of the proceedings, which are referred to hereafter :
 - The plaintiff produces evidence to support his complaint.
 - The defendant files an answer, which may include a counterclaim, and produces evidence to support his contentions.
 - The parties pursue their exchange until they consider the discussion exhausted, which means, practically, until one party does not ask to reply ; the Judge has also the power to declare the exchange closed.
- The case is argued in Court.

For patent cases, the trial usually takes place between one to three years after the filing of the complaint.

The final oral hearing lasts between two hours and a whole day (2 days in exceptional cases) according to the difficulty of the issues.

The Court is a panel of three Judges, who are always professional Judges ; there are no jury in civil cases.

This hearing consists of two speeches : first the statement of the plaintiff's counsel and, afterwards, the statement of the defendant's counsel.

The Judges can ask questions or make comments if they wish to, but usually they intervene very little. There is no examination of witnesses or experts. Usually, the parties are not invited to give explanations to the Court.

1.4. Motion for preliminary injunction

The preliminary injunction was introduced in French Patent Act of January 2, 1968 by an amendment of June 27, 1984.

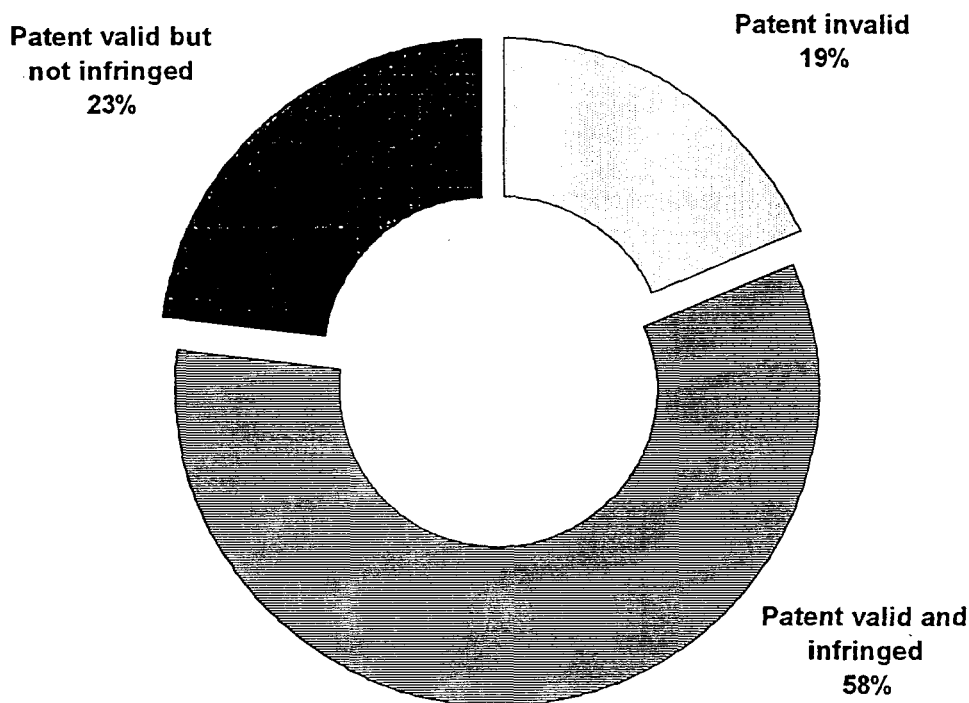
Since a further amendment of November 26, 1990, the conditions for a preliminary injunction are, under article L 615-3 of Intellectual Property Code :

1. A prompt infringement suit : the plaintiff has to sue the alleged infringer without delay after he has become aware of the alleged infringement. The critical period of time seems to be, according case law, about six months.
2. Likelihood of success on the merits, which implies that neither the validity of the patent nor its infringement appear seriously challengeable.

Preliminary injunctions are not frequently granted (less than 10 times since the change in Patent Act, in 1984).

II. Scope of the patent broadly interpreted

A recent survey of 294 patent cases decided by the High Court of Paris between 1990 and 1996 (involving 342 patents) has shown the following results :



Validity and infringement are generally appreciated as part of the same procedure : this leads to a consistent approach (2.1.).

Literal and narrow construction of claims is not a French tradition (2.2.).

2.1. Validity and infringement : one forum, a consistent approach

When it has to decide an infringement complaint, a French Court is always empowered to decide, first, over the validity of the patent.

Invalidity defence is almost a rule in patent infringement suites ; defences based only on non-infringement are exceptional.

Validity and infringement are dealt with simultaneously by the parties in their written pleadings and during the oral statements.

This leads to a very consistent approach of validity and infringement : it is difficult, for example, to the patent owner to give a narrow reading of his patent to avoid prior art and to claim for a broad scope of his claims minutes later...

In the same manner, the Court decides on both validity and infringement in the same judgement (there is not first a decision on validity and, then, a decision on infringement).

French lawyers like saying that it gives the patent a scope of protection customised to the actual invention.

2.2. Literal and narrow construction of claims is not a French tradition

It should be kept in mind that French patents include claims only since 1968 ; beforehand, the patent owner was permitted to seek protection for whatever was included in the patent specification, provided that it was new ; the Court had just to check that what was "claimed" in the suit was actually described in the specification ; such system has given an early tradition of purposive construction and of doctrine of equivalents.

2.2.1. Doctrine of equivalents has therefore always been part of French case law

Two means are equivalent when, although of a different shape, they perform the same function to achieve a similar result.

This criterion is of daily use in patent infringement litigation :

" two means of a different shape are equivalents when they achieve the same function, i.e. the same principal technical effect, to achieve a similar result..."
Court of Appeals of Paris - 11 September 1996 - SMBP v. NOVEMBAL

" the nut of the allegedly infringing device, although of a different shape of the patented screw, is a technical equivalent of this screw since it performs the same pressure function to achieve a result of the same nature."
Court of Appeals of Paris - 27 September 1996 - SOFAMOR and COTREL v. JBS

" It cannot be disputed that the structure of the various elements of the patented device, on the one hand, and the allegedly infringing device, on the other hand, are different :

- *patent covers a metal spike with a sharpened end,*
- *allegedly infringing device is an hollow tube in which is inserted a rod, longer than the hollow tube, so that the sharpened end of the inner rod creates a sharpened end to the tube.*

However, those two systems perform the same function and achieve a result of the same nature"

Court of Appeals of Paris - 30 October 1996 - NIJAL v. EMSSENS

Needless to say, French Courts do not always accept the equivalence :

" The means used by the defendant do not achieve the function of those described by the claim : the side walls of the allegedly infringing device do not reduce the distance between the conduits whereas the patented device purpose is to reduce the room occupied by said conduit"

High Court of Paris - 11 October 1996 - ARMOR-INOX v. KAUFLEER

As the doctrine of equivalents is long established in French law, it does not raise any further academic discussion.

In comparison to what can be decided on the same topic in other countries, the following statements can be considered as reflecting the present state of the law in France :

- although the construction of claim is generally broad, the test of equivalence will probably be conducted on a claim element - by - claim element basis rather than on the accused process as a whole,
- "*prosecution history estoppel*" had not the same importance in France where the French Patent Office powers are quite limited ; the situation is probably different when considering a European Patent designating France,
- the equivalence is certainly not limited to what is disclosed in the patent itself ; nor is it limited to what was known at the time of the patent ; in other words, equivalency will be evaluated at the time of infringement.

2.2.2. Acceptation of partial infringement

French Courts are so eager to give a purposive construction of the claims that sometimes they go too far and use doctrine of the partial infringement.

After much discussions, it seems now clear that partial infringement can be decided only when the patent has (improperly) put in a single claim several features which are not combined but merely juxtaposed.

In such a case, where the patentee should have put those elements in several claims, the French Courts accept to protect it when they are patentable per se.

On the contrary, it is now well established case law that when a patent claims - expressly or implicitly - a combination of features, there is no infringement when only one of the main features is not reproduced.

III. Affordable justice

France is not a country where the justice is very expensive by comparison with common law countries.

Since there is no discovery process, the preparation of the case for trial is far less time consuming.

The trial itself is much shorter since there is no witness or experts examination.

The costs of a patent infringement case in France are usually only a fraction of the costs of the same litigation in common law countries.