Measures for preserving evidence
under Article 7 of the Directive No. 2004/48

on the enforcement
of intellectual property rights:
the French situation

Pierre VÉRON

VÉRON & ASSOCIÉS

53, avenue Maréchal Foch
F 60906 Lyon
Tel. Int'l + 33 4 72 69 39 39
Fax Int'l + 33 4 72 69 39 49
E-mail: pierne.veron@veron.com
Frankfurt am Main – May 26, 2005

6, square de l'Opéra Louis Jouvet
F 75009 PARIS
Tel. Int'l + 33 1 53 05 91 91
Fax Int'l + 33 1 53 05 91 98
http://www.veron.com

# Article 7 of the Directive (1/2) 1. Courts must have power to take provisional measures preserving evidence of infringement, in ex parte proceedings, before the commencement of proceedings on the merits, if reasonably available evidence is brought. Measures may include: detailed description, taking of samples,

physical seizure of infringing goods and

M:\PVE\971051\Measures for preserving evidence GRUR 26\_05\_2005.ppt

documents.

Pierre Véron - 26/05/2005

# Article 7 of the Directive (2/2)

- 2. The lodging of a security may be ordered
- 3. Proceedings on the merits must be instituted quickly; otherwise the measures can be revoked
- 4. If measures revoked or if no infringement, the defendant may be compensated for its damage
- 5.Member States may take measures to protect witnesses' identity

Pierre Véron - 26/05/2005

M:\PVE\971051\Measures for preserving evidence GRUR 26\_05\_2005.ppt 3

### The French situation

- Already in line with the Directive with the saisie-contrefaçon ✓
- Transposition in progress in order to improve or refine certain points

Pierre Véron - 26/05/2005

M:\PVE\971051\Measures for preserving evidence GRUR 26\_05\_2005.ppt

l



# The legal basis of the French saisie

- Article L. 615-5 Intellectual Property Code
- "The owner of a patent... shall... be entitled, on an order given by the President of the First Instance Court of the place of the presumed infringement, to direct any bailiffs, accompanied by experts of his own choice, to proceed with a detailed description, with or without effective seizure, of the allegedly infringing articles or processes "
- Articles R. 615-1 to -4 Intellectual Property Code

Pierre Véron - 26/05/2005

M:\PVE\971051\Measures for preserving evidence GRUR 26\_05\_2005.ppt

# The substantial requirements

#### Directive, art. 7.1:

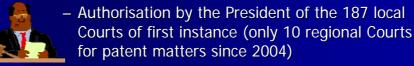
- Before proceedings on the merits ✓
- Reasonably available evidence: unlike German law (809 BGB, Faxkarte), not necessary under French law; if presented a valid title, the Judge must grant the order (however, the Judge may restrict the terms of the petition) ✓
- IP right infringed or about to be infringed ✓

Pierre Véron - 26/05/2005

M:\PVE\971051\Measures for preserving evidence GRUR 26\_05\_2005.ppt

### The taking of the measures

- Directive: if necessary without the other party having been heard
- French law: other party never heard ✓



- Petition filed by the counsel for the plaintiff
- Defendant informed just at the beginning of the performance of the saisie

Pierre Véron - 26/05/2005

M:\PVE\971051\Measures for preserving evidence GRUR 26\_05\_2005.ppt

8

# The performance: who may take part to the saisie? A bailiff (\* huissier\*\*) who performs the saisie An "expert" who helps the bailiff describe the infringing device: independent from the parties generally a patent attorney A police officer (or squad if appropriate) Any other person whose technical skills may be useful (e.g. accountant)



### **Confidentiality matters**



- Protection of confidential information (Directive, art. 7.1): no provision in French statutes; if an objection about the confidentiality of some documents is raised, they are nevertheless taken (under seal), but the Court usually appoints an expert to sort out:
  - which documents, even confidential, are useful to prove the infringement,
  - which documents are not related to the infringement.
- Witness protection (Directive, art. 7.5): no provision in French statutes, but not mandatory ✓

Pierre Véron - 26/05/2005

M:\PVE\971051\Measures for preserving evidence GRUR 26\_05\_2005.ppt

11

## The aftermath: the plaintiff must serve summons

- Directive: proceedings on the merits under:
  - reasonable period determined by the Court
  - 20 working days / 31 calendar days
  - otherwise: measures void upon request of defendant
- France:
  - Plaintiff must start proceedings against the infringer within:
    - 15 calendar days (patent, trademark) ✓
    - 30 calendar days (copyright) ✓
    - otherwise, saisie is void per se
  - Transposition project
    - 30 days in all matters
    - otherwise: saisie void upon request of defendant



M:\PVE\971051\Measures for preserving evidence -GRUR 26\_05\_2005.ppt 12

### The aftermath: possible challenges by the defendant

### The defendant may

- either challenge the grant of the order ✓
- or challenge the performance of the *saisie* ✓ (Directive, Art. 7.1, al. 2)

He may get compensation if the *saisie* was abusive ✓ (Directive, Art. 7.4)

Pierre Véron - 26/05/2005

M:\PVE\971051\Measures for preserving evidence GRUR 26\_05\_2005.ppt

13

### Conclusion

- The current *saisie* is a means of gathering evidence:
  - powerful
  - quick
  - cheap
  - already in keeping with art. 7 of the Directive
- The transposition of the Directive should only suppress minor discrepancies in French law

Pierre Véron - 26/05/2005

M:\PVE\971051\Measures for preserving evidence GRUR 26\_05\_2005.ppt

14

