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Measures for preserving evidence under Article 7 of the Directive No. 2004/48 on the enforcement of intellectual property rights: the French situation

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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 documents.

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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

The French situation

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

The saisie-contrefaçon (search and seizure for infringement)



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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

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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 ✓

The taking of the measures

- Directive: if necessary without the other party having been heard
- French law: other party never heard ✓
 - Authorisation by the President of the 187 local Courts of first instance (only 10 regional Courts for patent matters since 2004)
 - Petition filed by the counsel for the plaintiff
 - Defendant informed just at the beginning of the performance of the *saisie*



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)



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The measures preserving evidence

- Detailed description (including photographs, video recordings, drawings) ✓
- Taking of samples ✓
- Seizure of the infringing goods (French law: trademark only) ✓
- Seizure of the production/distribution material (French law: copyright only) ✓
- Seizure of documents (copy) ✓



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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 ✓

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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



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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)

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

**Thank you for your
attention**