

A perfect arsenal

Over the last two centuries, France has developed an arsenal of laws against infringers of IP rights. French legislation has long provided an effective means of collecting evidence – infringement seizure proceedings (*saisie-contrefaçon*). Their value is now recognised by their generalisation in Europe with Directive 2004/48, the Enforcement Directive. Still, the measures and sanctions that could be imposed on infringers were not optimal. On October 29 2007, France changed its IP legislation to comply with the Directive, the aim of which is to strengthen IP rights. The amended French law reinforces provisional measures, creates a right of information to identify infringement networks, and improves the system of compensation for damages.

Seizure proceedings

In French infringement proceedings, the IP rights owner bears the burden of proof, as in other countries. To collect evidence of infringement, the IP rights owner may resort to any means. French legislation has well-established methods of collecting evidence, in particular the infringement procedure mentioned above. The Constituent Assembly authorised the first infringement seizure on January 7 1791. The details of implementation of article L615.5 of the Intellectual Property Code, which introduces the principle of the infringement seizure, are prescribed by the decree of February 15 1969. So French IP practitioners have much experience of these tricky proceedings.

The right to obtain an infringement seizure is granted to any owner of a valid IP title – a patent, patent application, filed design, copyright, trademark, software, or plant variety protection certificate. It should be noted that the amended French legislation allows infringement seizure proceedings to owners of semi-conductor products, rights of database producers and geographical indications. These proceedings are also open to licensees of an exclusive right of exploitation, and to holders of a licence of right, of a compulsory licence, or of an official licence, under special circumstances.

Infringement seizure, intended to establish the substantive nature of the alleged infringement, is not compulsory. But French courts have a strong preference for this mode of proof, since a judge controls it. To proceed with such a seizure, it is necessary first to obtain an order from the president of the *Tribunal de Grande Instance* (High Court) of the place of the alleged infringement. The petition and order submitted to the president of the court, drafted by the IP rights owner's attorneys, must indicate the person subject to the seizure, the place of the seizure and the type of seizure requested – a simple description of the relevant matter or its actual seizure. The petition must provide documents confirming the ownership of the property right. The order can be obtained without any difficulty, since it is an *ex parte* proceeding. The president of the *Tribunal de Grande Instance* cannot refuse the seizure, but can limit it to being descriptive, by forbidding the actual seizure of specimens.

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Now the judge can order the seizure of the alleged infringement products to avoid their introduction or circulation in the commercial circuits. Judges can also order the conservation of the personal properties of the alleged infringer (personal property, real estate, bank accounts).

Progress

The bailiff whom the plaintiff selects conducts the seizure. A specialist – generally an industrial property attorney (CPI) – assists the bailiff. A policeman, a photographer, a locksmith or any other person whose skills might be useful may also accompany the bailiff. But to preserve the privacy of the seized party the presence of the rights owner or of a member of the salaried staff of the plaintiff is not allowed.

Usually, the order issued by the president of the *Tribunal de grande Instance* authorizes the bailiff, accompanied by the specialist, to gather all the elements of proof that help to show the judge the origin, nature and extent of the alleged infringement. During the seizure the bailiff must first serve the order on the seized party with a copy of the IP title allegedly infringed, under penalty of nullity of the seizure. Then the bailiff must identify, describe, and optionally seize all the objects that can prove the infringement, and “any materials and implements used in the production and/or distribution of allegedly infringing goods”.

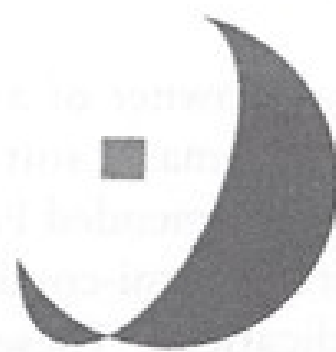
According to the amended law, it is possible to seize “all documents” that may prove the extent of the infringement (accounting documents, quantity of delivered goods, list of clients, prices, suppliers). Because of the diverse nature of

these documents, seizures are not necessarily carried out only on the alleged infringer’s premises; they may also take place on the premises of clients or suppliers. The industrial property attorney assisting the bailiff plays an active part in the selection of documents, papers or products to be taken. Seizure is not the confiscation of an entire production, but only of a small number of samples required for the plaintiff’s action. The bailiff must propose to pay the price of the seized products to the seized party. According to the pend-

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ing provisions in French law, the plaintiff must institute proceedings on the merits within 15 days of the date of the seizure, or the seizure (actual and descriptive) will be void. The maximum period of 15 days for instituting proceedings on the merits may be extended to comply with Directive 2004/48, which states that it should not exceed 20 working days or 31 calendar days, whichever is longer.

In recent decades, the infringement seizure proceedings have been a powerful way of collecting evidence for IP rights owners that want to act against alleged infringers. But although infringement seizure is widely used to prove infringement, many traps can affect its validity, and great care must be exercised during operations. French practitioners who specialise in IP litigation are already familiar with such proceedings.



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