

Questionnaire April 2005

Q185 - Enforcement of IP Rights

Answer in the name of the French Group

- I. Article 43 TRIPS Agreement and Article 6 of the IP Directive**
- 2. Questions to be answered regarding content, requirements and extent**
 - a. Does your country already provide for a mechanism in compliance with Article 43 (1) of the TRIPS Agreement and/or Article 6 (1) of the IP Directive.**

Yes – In France according to Articles 10, 11 and 142 and seq. of the New Code of Civil Procedure (NCPC), the Courts may under certain circumstances order that evidence be produced if this evidence is sufficiently identified.

However in practice concerning evidence of infringement of Intellectual Property Rights, the claimant usually uses the specific proceedings of saisie-contrefaçon (infringement seizure) as defined in the Intellectual Property Code (CPI) (see herebelow the comments relating to Article 7 of the IP Directive).

- b. How does your system work and what are its specific requirements, in particular:**
 - **Are these mechanisms arranged differently as to the different types of IP (i.e. patents, utility models, design models, trademarks, copyright).**
 - **According to Article 43 (1) of the TRIPS Agreement and Article 6 (1) of the IP Directive, the claimant must present *reasonably available evidence sufficient to support the claim*: Is there a comparable requirement in the laws of your national system? If yes, it will be interesting to know the extent to which the infringement must already be proven beforehand by the claimant.**

- **How (clearly) and to what extent must the claimant “specify” the means of evidence to be produced that is within the control of the opposing party?**
- **Are there other requirements which must be fulfilled?**

The measures provided in the New Code of Civil Procedure are generally applicable to all kinds of civil procedures and there is no difference according to the different types of IP rights which are concerned.

The claimant must only provide some convincing argument ("well founded grounds" according to Article 145 of the NCPC) that there exists some identifiable document which could be useful for proving the infringement.

No other specific requirement must be fulfilled.

c. Regarding the extent and enforcement of the order:

- **Is it possible to get such an order only in view of proving the infringement or can the order also be focused on evidence which may be relevant for the determination of the extent of damages?**
- **Can such order also be used to identify the possible existence of evidence, i.e. are there any means in your system that enable the claimant to search for evidence?**
- **How can the order be enforced?**
- **Is it possible by means of such an order to effectively enter the private sphere of the opposing party (for instance premises)?**
- **What are the consequences if the order is not complied with by the opposing party. For example: Shift of burden of proof, or a solution comparable to the solution of Article 43 (1) of the TRIPS Agreement?**
- **Can such order be obtained in your country based on an IP right registered in another country but not registered or even applied for in your country?**

The measures provided by the New Code of Civil Procedure being of general application, they are not restricted to evidence of the existence of infringement and an order may also be obtained for evidence which may be relevant for the determination of the extent of damages.

However the claimant who wants to identify the possible existence of evidence ("search for evidence") preferably requests an Order to conduct a "saisie-contrefaçon" rather than relying on general provisions of the Civil Procedure Law. A French Court may also consider that a plaintiff who is entitled to use the specific procedure of a saisie-contrefaçon to obtain evidence of infringement should preferably use this specific procedure rather than request an order for some preliminary investigation of the case based on general civil procedural law.

An order that evidence be produced by the opposing party may be subject to summary proceedings under Article 808 of the NCPC.

The judge may define a daily fine for delay in producing the requested document.

It is possible by means of an order issued according to the general rules of the civil procedural law to effectively enter the private sphere of the opposing party.

If the order is not complied with by the opposing party the solution in France is comparable to the solution of Article 43(2) of the TRIPS Agreement, but there is not shift of burden of the proof.

French courts can apply international agreements concerning measures for obtaining evidence abroad.

Thus, a French Court may refer to Council Regulation No. 1206/2001 of 28 May 2001 on cooperation between the courts of the Member States in the taking of evidence in civil or commercial matters, provided a formal request has been filed.

France is also party to the Hague Convention of 18 March 1970 on the taking of evidence abroad in civil or commercial matters.

A judge may thus issue letters rogatory to a foreign magistrate, provided the evidence thus obtained is used in a pending or future procedure.

Articles 733 and seq. of the French Civil Procedure Code further authorize a judge to issue letters rogatory to foreign courts or French consular or diplomatic authorities.

- d. Does your system provide for legal presumptions comparable to the stipulation of the second sentence of Article 6 of the IP Directive. This provision apparently refers to a problem arising in cases where a large amount of infringing items such as optical discs are to be seized. Requiring detailed proof of copyright for each infringing item would lead to loss of time, effort and money by the right holder.**

At present the French civil procedural law does not provide for legal presumptions comparable to the stipulation of the second sentence of article 6 of the IP Directive.

However in practice a Court may deal with an infringement case even if only one or a small number of infringing items are provided as evidence.

When a “saisie-contrefaçon” is carried out, only a few infringing items are usually seized or described as initial evidence of infringement, in particular in patent matters, and the actual scope of infringement is established in a second step. However, the effective seizure of a complete stock of infringing items during a saisie-contrefaçon is possible if the Order is based on a Trademark right.

e. Questions regarding procedural aspects:

- i) What is the competent court? Who makes the decision, an administrative or a judicial body?**

A judicial body makes the decision. The court before which the case is pending is competent to issue such orders.

- ii) How costly and time-consuming are these proceedings?**

Proceedings concerning preliminary investigation of a case based on general procedural law are not expensive and not time-consuming if compared with the main proceedings.

- iii) Is the order subject to appeal? by whom? within what time limit? on what grounds? before what court?**

In ex parte proceedings the claimant may file an appeal within 15 days from the date of the order if the request is not accepted (Article 496 of the NCPC).

When the request is accepted, anybody may ask during the action on the merits that the order be modified or rescinded (Article 497 of the NCPC).

In inter partes proceedings, the appeal is made before the same judge if it is lodged by the opponent or before a court of appeal if it is lodged by the claimant or if the order is issued in a summary proceedings.

- iv) What kind of counter-arguments may successfully be asserted against such an order, or what counteractive measures can be taken by the respondent in order to lift the order?**

The grounds for an appeal may be e.g. the absence of legitimate grounds or a need for confidentiality or the absence of a link with either the subject matter of the litigation or the parties.

v) What are the implications if either claimant or respondent or both parties are foreigners?

The deadline for appearance before the court differs if one of the parties is a foreigner. More generally the rules of international private law are applicable.

vi) Is the order enforceable even if an appeal is pending.

Yes the order is enforceable as soon as it is granted.

3. Questions to be answered regarding limits

a. Whether and how and through what procedures can secret information (business information, know-how etc.) of the opposing party be protected in the laws of your system?

The defendant may ask that the secret information may be placed in a sealed enclosure to be examined by a neutral expert.

b. In particular, are there in your system procedural possibilities to restrict the access to the information to specific persons involved in the proceedings (attorney only, neutral expert)? If so, how is this restriction legally implemented and ensured?

Yes. In a summary procedure, it may be requested that the neutral expert examining the secret information is entitled to meet only the attorneys or patent attorneys.

c. How can abuses be prevented?

The fact that some documents may be inserted in a sealed enclosure to avoid direct access by the claimant may prevent some abuses.

d. Is it possible for the opposing party to rely on privileges such as attorney/client privilege?

- **If so, are there different types of privileges?**

- **What are the possible consequences if a fact cannot be proven due to the invocation of a privilege?**

The opposing party can allege that certain information or documents are privileged and confidential so that it can avoid disclosing them. However,

such position can be contested and brought before the Judge who will decide whether or not such confidentiality is grounded, or if the access to these information or documents has to be limited to a certain category of individuals.

There exists different kind of privileges: corporate secrecy, confidentiality of correspondence, professional secrecy, state secret...

In case a fact cannot be proved due to confidentiality or secrecy rightfully opposed by the defendant, the plaintiff's claims may be rejected, should no other evidences be provided.

e. What are the consequences if it turns out that the order was unjustified?

A court may allow damages to compensate for the losses due to the consequences of such order.

f. Is the order subject to a security bond?

This is possible.

4. Questions to be answered regarding future improvements

a. According to the opinion of your National Group, are there ambitions or motivations to further develop or improve your system?

In the opinion of the French Group, there are no motivations to further develop the present rules of the French procedural law which appear satisfactory and provide a well-balanced equilibrium between the rights of the plaintiffs and the rights of the defendants.

b. Are there any governmental or public ambitions in your country to improve or to change the existing systems?

It is merely intended to introduce in the Intellectual Property Code additional clauses which correspond to the content of Article 6 of the IP Directive, although the present procedural law appears to already include the relevant provisions.

c. The following question is particularly addressed to the National Groups within the European Union: Do you think that the laws of your national systems are already in compliance with the said provisions of the IP Directive?

We believe that the French law is already in compliance with the provisions of article 6 of the IP Directive.

II. Article 50 TRIPS Agreement and Article 7 of the IP Directive

2. Questions to be answered regarding content, requirements and extent

a. Do you have in your national law measures which could be deemed analogous to or comparable with the measures described above?

In France, the provision of Article 7 may be implemented through saisie-contrefaçon (infringement seizure) which is possible for copyright (Article L332-1 of the French Intellectual Property Code or CPI), trademarks (Article L716 of the CPI), designs (Article L521-1 of the CPI) and patents (Article L615-5 of the CPI).

b. If so, what are the differences?

Only a valid property right is required.

c. Regarding content, requirements and extent: Reference is made to the catalogue of questions under B. I., which may equally apply to the measures according to the above provisions and which may be taken as a guideline for describing content, requirements and extent of the available means, in particular:

i) Are there differences as to the types of IP?

An order authorizing the saisie-contrefaçon must be delivered by a judge if the saisie-contrefaçon is based on an industrial property right.

By contrast for copyright matters, the author may directly request a police commissioner to conduct a saisie-contrefaçon to seize copies constituting an unlawful reproduction of the work protected by copyright. However, a special authorization must be obtained from a judge if the seizure will have the effect of suspending public performances.

ii) To what extent must the infringement already be proven beforehand by the claimant?

There is no requirement that the infringement already be proven by the claimant.

iii) How (clearly) and to what extent must the claimant “specify” the means of evidence to be produced?

The means of evidence to be produced may be stated in a general manner. It is not required that details be specified.

iv) Are there other requirements which must be fulfilled?

No. In particular, an order authorizing a saisie-contrefaçon may be obtained without necessarily demonstrating that there is a risk that evidence may be destroyed.

v) Is the measure only applicable in view of proving the infringement or is it possible to apply it to evidence relevant for the extent of damages?

During a saisie-contrefaçon, it is possible to seize documents proving the infringement as well as documents relevant to the extent of damages.

vi) Can such an order also be applied to identify the possible existence of evidence, i.e. are there any means in your system enabling the claimant to search for evidence?

Yes. A bailiff accompanied by an expert is authorized to search for evidence and it is not necessary that the specific means of evidence to be seized be already known to the claimant, even if in practice the claimant usually already has some circumstantial evidence of the infringement.

vii) How can the order be enforced? For instance, is it possible by means of such an order to enter the private sphere of the opposing party (for instance premises) and/or to effectively seize suspected “infringing” products? Who is entitled to enter the respondent’s private sphere?

As mentioned above a bailiff and an expert (who is usually the patent or trademark attorney of the claimant) are authorized to enter the private sphere of the opposing party, whereas a claimant’s employee is not authorized to accompany the bailiff.

viii) What are the consequences if the opposing parties refuse access?

This is considered as an act of rebellion.

d. What experiences have been made in the past with such measures?

The procedure of saisie-contrefaçon has been widely used in France for years. The procedure is usually carried out by the professionals (bailiff and patent attorneys) with great carefulness to avoid that the saisie-contrefaçon be later deemed void. In patent matters, the saisie-contrefaçon comprises a detailed description of the allegedly infringing articles or processes and also possibly the effective seizure of some samples whereas in trademark matters the whole stock of allegedly infringing products may be seized.

The formalities concerning a saisie-contrefaçon are very strict and some infringement seizures are later deemed void for formal reasons (such as

for example the fact that a copy of the order authorizing the seizure has not been given to the defendant before the seizure is carried out).

Moreover in France proceedings on the merits should be instituted before a Court within 30 days for copyright matters (Article L332-3 of the Code of Intellectual Property) or within 15 days for software (Article L332-4 of the CPI), designs (Article L521-1 of the CPI), patents (Article L615-5 of the CPI) or trademarks (Article L716-7 of the CPI).

3. Questions to be answered regarding limits

As the focus of the measures regarding the question whether and how and by means of what procedures secret information (the opposing party's business information, know-how etc. may be protected) is the same as indicated above in section B. I, reference is made to the catalogue of measures in B. I (3), Limits). This also relates to the extent and limits of the measure, including the question of how privileges such as attorney/client privileges are to be taken into consideration in your national system, i.e. the questions should be taken as a guideline for describing the limits of the means.

The answers concerning limits and protection of secret information are the same as above in relation to item 3 dealing with Article 6 of the IP Directive.

4. Questions to be answered regarding future improvements

a. Does your system comply with the TRIPS Agreement?

Yes.

b. Are there ambitions or motivation for further developments, improvements etc.?

Not particularly.

c. Are there any governmental or public ambitions in your country to change the existing systems in the near future?

The government intends to slightly amend the Intellectual Property Code to put it in full agreement with the wording of Article 7 of the IP Directive.

In particular, the time limit for instituting proceedings on the merits should be modified and harmonized for all types of saisies-contrefaçons.

d. The following question is particularly addressed to the National Groups within the European Union: Do you think that the laws of your national systems are already in compliance with the said

provision of the IP Directive or is there an immanent need for legal change?

The laws of our national system are already substantially in compliance with Article 7 of the IP Directive and only cosmetic changes should be contemplated.

III. Article 47 TRIPS and Article 8 of the IP Directive

2. Questions to be answered regarding requirements, extent and enforcement

a. It would be interesting to know whether and how Art 47 of the TRIPS Agreement is implemented in the laws of your system?

The French law does not include any provision which could be deemed analogous to the provisions mentioned in Article 8 of the IP Directive except for the measure which has been introduced in Article L615-5-1 of the Intellectual Property Code for patents relating to processes, this measure introducing a reversal of the burden of proof.

However as mentioned in connection with Article 6 of the IP Directive, the general procedural law already authorizes in some circumstances measures against third parties (see Articles 138 to 141 of the New Code of Civil Procedure). Moreover a saisie-contrefaçon may also be conducted in the premises of a third party who is not a direct infringer and may enable to obtain similar information.

b. Do you think that the right holder must first prove that his property right is infringed in order to be entitled to assert this right?

The right holder having already initiated an infringement suit, there does not seem necessary to have additional conditions for asserting the right of information.

c. Art. 8 of the IP Directive may also be directed against third parties if the activity is on a “commercial scale”. Consequently it would be interesting to know if any experiences have been made in your country regarding requests which are directed against third parties.

As mentioned above, information may be obtained from third parties within the frame of a saisie-contrefaçon.

d. Do you think that this right should also be enforceable in preliminary injunction proceedings?

Yes.

e. Are there any ambitions in your country to change the law in view of complying with the TRIPS Agreement?

A new article corresponding to Article 8 of the IP Directive should be introduced in the Intellectual Property Code.

3. Questions to be answered regarding limits and future improvements

The assertion of a right of information according to the abovementioned provisions may also be in conflict with the opposing party's confidential information. In this respect reference is made to the questions listed in B. I. 3. and B. II. 3. These questions may be taken into consideration in order to illustrate the limits to the enforcement of the right of information.

See above.

The same applies to the questions under B I. 4. and B II. 4 as to the description of any national ambitions in view of improving the legal system.

The introduction in the Intellectual Property Code of an article similar to Article 8 of the IP Directive should expressly mention that the request of the claimant should be justified and proportionate and that the confidentiality of information sources or the processing of personal data should be protected.

IV. Miscellaneous questions

The National Groups are invited to comment on any additional aspect which they find relevant with regard to the foregoing questions and the specific aspects of the production of evidence.