

## Question Q.236

**National group:** France

**Title:** Relief in IP proceedings other than injunctions or damages

**Working group:** Pierre GENDRAUD (chairman), Stefan NAUMANN (Reporter), Stéphanie LEGRAND, Elise MALOT, Caroline LEVESQUE, Marta MENDES MOREIRA, Hélène CORRET, Marie WORMSER, Isabelle BERTAUX, Albane LAFRANCHÈRE, Caroline CASALONGA, Sabine AGÉ, Ninon RETORE, Pauline VAN HERWIJNEN, Enrico PRIORI, Yves BIZOLLON, Gaston VEDEL, Thibault LANCRENON, Dominique SEILLIER, Bertrand LOYER, Olivier LEGRAND, Francis HAGEL

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### Introduction

In its working guidelines for question Q.236, the AIPPI asks the national groups to carry out an inventory of relief in intellectual property proceedings other than injunctions or damages. The working guidelines for this question specify that provisional measures, compulsory licences, *ex parte* injunctions and punitive damages are excluded, as well as criminal sanctions and border measures.

The working guidelines also specify that question Q.236 is limited to measures which may be ordered in legal proceedings between parties or in administrative procedures when civil remedies may be ordered in such administrative procedures.

The French Group notes that, in principle, relief excludes measures which may be ordered before any imposition of relief, in particular evidentiary measures.

However, under French law, certain evidentiary measures are ordered *ex parte*, and not in proceedings between parties (infringement seizures), whereas others may be ordered before a judgment on the merits with regard to an infringement of an intellectual property right (right to information).

From a procedural point of view, under French law these measures could therefore not be part of the responses to question Q.236.

Nevertheless, the non-exhaustive list of additional relief, which is part of the working guidelines, describes orders for inspection in a way which is highly similar to infringement-seizure orders. Likewise, orders to provide information as described in the guidelines is similar to the right to information as it was introduced into French law by the incorporation of EC directive No. 2004/48 on the protection of intellectual property rights.

The French Group considers that although the infringement seizure and the right to information are evidentiary measures and not relief under French law, it is of interest bringing them to the attention of the AIPPI within the framework of question Q.236, which provides that orders for inspection and orders to provide information are part of this question. Moreover, the right to information takes on a dual role (prevention and relief) when this measure is ordered after an infringer is condemned.

Amongst the other additional relief, the French Group notes that a number of these enforcement measures are new in French law.

The working guidelines invite the national groups to complete table in Annex B of the guidelines with other forms of relief and other intellectual property rights (IPRs) under their national laws.

Under French law, it is appropriate to add five types of IPRs (rights related to copyright, database producer's right, protection of semi-conductor products, geographical indications and protection of plant varieties), and four types of relief (cancellation of a later IPR, recall/withdrawal from channels of commerce and the claiming of ownership of an IPR).

With regard to the refusal of registration of a later IPR, the French group considers that an opposition may result in a decision by an administrative authority to refuse registration of an IPR, which does not constitute a civil penalty or a measure to repair a damage, and that this procedure is therefore outside the scope of question Q.236.

Trade names, signs, company names and personality rights mentioned in Article L.711-4 of the IPC, as well as image rights and the protection of privacy, which do not appear in the IPC, are not included in the IPRs covered by TRIPS, and are not discussed in the present report or in the table in the Annex.

## Questions

### *I. Analysis of current law and case law*

**Groups are invited to answer the following questions under their national laws:**

- 1) What forms of Additional Relief are available in IP proceedings?**
- 2) Are those forms of Additional Relief available for all types of IPRs? If not, please indicate what types of Additional Relief are available for what types of intellectual property rights.**

See two tables in the Annex:

Additional Relief of Q236

Additional Relief Outside the Scope of Q236

- 3) Having regard to the types of Additional Relief available addressed by questions 1 and 2, what are the criteria for the grant of that relief? There may be different criteria for the different types of Additional Relief identified. Hence, the Groups are asked to address the individual criteria for each type of Additional Relief that is available in IP proceedings in their country.**

### Declaratory relief

Under French law, no IPR provides the possibility of obtaining declaratory relief, except that, in patent matters, Article L.615-9 of the IPC allows what is known as a non-infringement declaration action under strict conditions.

### Delivery up/destruction

- Copyright and neighboring rights, database producer's right

Article L.331-1-4 of the Intellectual Property Code (IPC) paragraph 1 provides that, in the

event of civil sentencing for infringement, violation of a right to copyright (neighboring right) or of database producer rights, the courts may order that the objects violating these rights, the means used to gather illegally extracted data and the materials and instruments which were principally used to produce or manufacture the infringing goods are withdrawn from the channels of commerce, definitively removed from these channels, destroyed or confiscated in favour of the injured party. These measures are ordered at the expense of the infringer.

The confiscation of a work in dispute may be ordered when it is likely to remedy the infringement of the moral rights of the creator (Paris Court of Appeal, 28 October 2011), or on the contrary be refused when the applicant does not provide proof that the infringing goods were still offered for sale (Versailles Court of Appeal, 28 May 2009).

Judges may also consider that an injunction is sufficient to prevent the repetition of the acts of infringement, so that it is not necessary to add a measure of confiscating and destroying the stock (Paris Court of Appeal, 9 October 2009).

- Designs

Recall from the channels of commerce, destruction and publication are apparently only ordered in cases where the infringement is of a certain magnitude or when the right which has been infringed enjoys a certain reputation. For example, a recent judgment dismissed the publication of the decision “*having regard to the number of cups in dispute*” (Paris first level civil court, 31 January 2013, RG 11/13119; the decision is under appeal). These measures, which are however being increasingly ordered, are *a priori* considered to be severe and irreversible, which sometimes leads the courts of first instance to refuse their provisional enforcement (“*ORDERS the provisional enforcement of the present decision with the exception of the legal publication and destruction measures*”; Paris first level civil court, 18 November 2011, RG 11/01636).

- Patents, semi-conductor products, plant varieties

With regard to patents, semi-conductor products and plant varieties, this measure is granted repeatedly and in a discretionary manner, except that the confiscation of the instruments used to commit the offence is granted as of right in criminal matters when the sentenced party is a legal person (Art. 131-9 of the French Criminal Code). There are no particular conditions for the measure to be allowed (as was the case before the law of 2007, where confiscation could only be ordered if it was necessary to ensure the effectiveness of an injunction). It does not appear that the value of the objects confiscated in favour of the injured party is deductible from the compensation, as was the case before the law of 2007.

Grounds for refusal are:

- that the confiscation is not necessary or that the injunction text that is ordered is sufficient (Paris first level civil court, 14 January 2011; Paris first level civil court, 21 May 2010); but the Paris Court of Appeal recently judged on the contrary that a confiscation measure is not dependent on the need to ensure the effectiveness of an

injunction (Paris Court of Appeal, 7 November 2012),

- that the goods are apparently not sold in France, for example an infringement displayed during a trade fair (Paris first level civil court, 10 October 2011; Paris first level civil court, 28 January 2010),

- that it has not been demonstrated that the acts of infringement are continuing (Paris Court of Appeal, 14 November 2012).

Confiscation is most often accompanied by the destruction of the infringing goods. It is rare that the confiscation of the instruments used in their creation or manufacture is requested and, hence that it is ordered.

A confiscation measure most often concerns the infringing party's stock, and is limited *a priori* to the goods in its possession (Paris first level civil court, 16 December 2011; Paris Court of Appeal, 27 October 2010 (extension to a party joined to the proceedings)).

- Trademarks, geographical indications

Article L.716-15 of the Intellectual Property Code does not set any criteria for granting this type of measures. The same goes for its equivalent for geographical indications, Article L.722-5 of the IPC.

The examination of decisions rendered by the French courts shows that the grounds relating to the granting or refusal of such additional relief are often brief (or even non-existent) and it is therefore difficult to determine specific criteria.

We have been able to identify a few criteria implemented by the French courts.

Certain decisions rule out confiscation and destruction as such measures appear "*unnecessary*" taking into account the fact that an injunction was granted (Paris first level civil court, Chamber 3-4, 25 November 2010, Mandar; Paris first level civil court, Chamber 3-2, 04.12.09, RG 08/11063 (Ernie Ball / Centrale occasion de la musique); Paris first level civil court, Chamber 3-2, 27.11.09, RG 2008/15672 (ID group and Okaidi/ La Halle)).

Destruction is also ruled out when it is found that a withdrawal measure constitutes "*an effective measure for bringing an end to the infringement*" and that, in addition, "*it has not been demonstrated that the infringing designations and presentations are not likely to be withdrawn with a view to possible lawful re-use of the offending goods*" (Orléans Court of Appeal, 1 July 2010).

Recall and withdrawal measures may be refused "*insofar as the complainants have not established that other litigious goods have been commercialised*" (Paris first level civil court, Chamber 3-3, 8 February 2013, adidas).

Another decision, which is subject to criticism, considered that the measures of withdrawal from the channels of commerce, withdrawal from the market and destruction of the infringing goods could not be ordered "*for lack of proof of the existence of a commercial loss*" (Paris Court of Appeal, Chamber 5-1, 30 January 2013, PPG).

### Rectification

Copyright, neighboring rights and the database producer's right do not provide the possibility of obtaining rectification.

For registered IPRs, rectification is not based on any criterion other than a decision amending the ownership of or right to use an IP right or establishing its invalidity.

### Alteration of infringing goods

- Copyright and neighboring rights, database producer's right

Copyright, neighboring rights and the database producer's right do not expressly provide the possibility for a court to order the alteration of infringing goods. To remedy infringements of the moral right of an author, courts have nevertheless ordered a company, which undertook to build a work in accordance with the plans and models of an artist and had interrupted the construction of that work, to finish the construction (French Supreme Court, 16 March 1983). Modifications of future editions or re-editions of books were likewise ordered for remedying infringements of moral or property rights of the authors. The courts thus ordered the withdrawal of infringing passages in future editions of a book (Paris Court of Appeal, 11 June 1999).

- Designs

Alterations of infringing goods and modifications of technology are theoretically possible since the holder of the right may request "*any measure*", in particular in summary proceedings. If such measures have been ordered, and we have not found any trace of this with regard to designs, they undoubtedly had to be linked to the search for a balance between the need to respect the rights of the holder of an IP right and the lack of need to cause the infringing party irreparable damage with regard to the issue of the infringement.

- Patents, semi-conductor products, plant varieties

No text expressly mentions such a measure. However, that is also true of injunctions, which result indirectly from Article L613-3 of the IPC ("*are prohibited, for lack of consent of the patentee...*"). It is therefore possible to consider the same Article L613-3, or Art. L615-7-1, paragraph 1 (withdrawal from the channels of commerce), would lead a judge to order the alteration of a product in order to bring an end to the infringement, for example to recall machines to replace a patented component. In practice, this would most often result from a voluntary action of the infringing party to comply with an injunction.

- Trademarks, geographical indications

Courts have refused the destruction of the goods judged to be infringing where “*the withdrawal constitutes an effective measure to bring an end to the infringement and it has not been demonstrated that the infringing designations and presentations are not likely to be withdrawn with a view to possible lawful re-use of the offending goods*”, thus taking into consideration the alteration of infringing goods (Orléans Court of Appeal, 1 July 2010).

### Modification of technology

Under French law, no IPR expressly provides the possibility for a court to order a modification of technology.

### Corrective advertising

- Copyright and neighboring rights, database producer’s right

Copyright, neighboring rights and the database producer’s right do not expressly provide the possibility for a court to order corrective advertising. Nevertheless, to remedy infringements of the moral right of an author the courts have ordered affixing self-adhesive labels and/or changing the covers of books not yet sold and future editions (Seine Civil Court, 6 December 1923; Paris Court of Appeal, 9 Dec. 1992), the publication of an error notice in the following issue of a magazine where the editor had published a reproduction of a painting attributing that painting to someone who was not the author (Paris first level civil court, 17 January 1990), the placement of an insertion in the stock of books already printed and in future editions of a novel in order to inform the readers of the sources which had been omitted, and sending of an insertion to all bookstores at which a novel was available, as well as to five hundred public libraries (Paris first level civil court, 10 October 1984), the insertion in a book of a correction of the illustrations mentioning the name of the photographer of a picture on the back cover (Paris Court of Appeal, 17 September 2009), and the insertion in the credits of a film of the name of a composer of the music where it had been omitted (Paris first level civil court, 30 May 1984).

- Designs

Corrective advertising is theoretically possible since the holder of a right may request “*any measure*”, particularly in summary proceedings. If such measures have been ordered, and we have not found any trace of this with regard to designs, they undoubtedly had to be linked to the need to protect the health or safety of consumers.

- Patents, semi-conductor products, plant varieties

Under the terms of Art. L.615-7-1, paragraph 2, a court “*may order any appropriate measure of advertising the judgment ... according to the methods which it specifies*”. Publication of a judgment in full or by excerpts are only provided by way of example (“*in particular*”).

It is therefore possible to consider that Art. L615-7-1, paragraph 2 authorizes a certain form of corrective advertising.

- Trademarks, geographical indications

See observations below regarding the publication of the judgment.

#### Publication of the judgment

- Copyright and neighboring rights, database producer’s right

Paragraph 2 of Article L331-1-4 of the IPC expressly provides for the advertising of the judgment, in particular by posting notices or by publication in full or by excerpts in newspapers or on online public communication services at the expense of the infringer of the right.

With regard to the publication of the judgment, judges may justify the refusal to order the publication by the length of time elapsed since the acts occurred or the cessation of the marketing of infringing goods, so that awarding damages constitutes adequate and sufficient relief (Paris Court of Appeal, 17 September 2009; Paris Court of Appeal, 27 February 2013), or on the contrary consider that a publication is justified by the nature of the acts of infringement at issue (French Supreme Court, 12 July 2012).

- Designs

See observations under question 4 below.

- Patents, semi-conductor products, plant varieties

Publication measures are the most frequently ordered measures of additional relief. They are granted in a discretionary manner by the courts, and grounds are rarely given for their decision. The possibility of granting publication on the Internet introduced by the law of 29 October 2007 may indicate a form of corrective advertising, in particular when it is ordered on the defendant’s website (Paris first level civil court, 19 March 2008). The Paris first level civil court has also authorized a right holder to display a publication on the defendant’s stand during trade fairs (Paris first level civil court, 3rd chamber - 3rd section, 16 September 2011).

The courts determine the proportionality and justified nature of the measures they order (Paris Court of Appeal, Division 5, ch. 1, 14 November 2012 and Paris Court of Appeal, Division 5, ch. 1, 19 December 2012), and refuse to order a publication in the following situations:

- where the patent has expired;
- where the infringement has ceased;
- where the defendant is undergoing court ordered liquidation;
- where the defendant is in default;
- where the infringing product was presented on a single occasion, during a trade fair.

Even in the absence of these circumstances, a court may refuse a publication measure if it considers it to be unnecessary.

- Trademarks, geographical indications

The measure of publication of the judgment is considered by case law to be a form of additional relief (Paris Court of Appeal, Division 5-1, 23 January 2013, BTSG; Paris first level civil court, Chamber 3-2, 22.01.10, RG 08/09863, Lancôme). It is therefore only ordered if the right holder's loss is not sufficiently remedied by other measures, particularly damages.

The proportionality of that measure in relation to the circumstances of the case is particularly taken into account (Paris first level civil court, Chamber 3-3, 22 February 2013, AFNOR; Pau Court of Appeal, Chamber 2-1, 31.03.10 (RG 2008/03826) Brod'matic / Cloud's). Therefore, the fact that the contentious acts have ceased may be a reason to refuse the measure (Paris Court of Appeal, Division 5-1, 20 February 2013, Nova; Pau Court of Appeal, Chamber 2-1, 31.03.10 (RG 2008/03826) Brod'matic / Cloud's) or else with regard to the length of time since the acts of infringement occurred (Pau Court of Appeal, Chamber 2-1, 31.03.10 (RG 2008/03826) Brod'matic / Cloud's).

### Order for inspection

See observations on the infringement seizure in the Introduction.

- Copyright and neighboring rights, database producer's right

Under French law, an infringement seizure constitutes an evidentiary measure rather than relief, except with regard to copyright, neighboring rights and databases, for which it may constitute additional relief.

With regard to copyright and neighboring rights, the police may seize and the courts may order the seizure of the items which constitute an unlawful reproduction of a work or

which infringe violate technical protection measures (Article L.332-1 of the IPC). With regard to software and databases, the chief judge of a first level civil court may order the real seizure of unlawfully manufactured objects and of the materials and instruments used to unlawfully produce or distribute a software or database (L.332-4 of the IPC).

In practice, the courts rarely order the real seizure of all of the unlawfully manufactured objects, and order the withdrawal of such a real seizure when it would result in the neutralization of a competitor of the seizing party, whose fault has not yet been established (Paris Court of Appeal, 23 April 1990).

- Patents, semi-conductor products, plant varieties

The Intellectual Property Code does not provide for the possibility of requesting to order of allow after sentencing inspection of the premises of an infringing party in order to verify whether an injunction has been complied with.

In theory, it nevertheless seems possible to turn to the judge in charge of monitoring the enforcement of judgements, on the basis of general rules of civil procedure, for the purpose of appointing a bailiff who would determine whether or not the infringing party is complying with the injunction ordered against it. There are no recent decisions granting such a measure.

#### Order to provide information

- Copyright and neighboring rights, database producer's right

Following the transposition into French law of the Directive on the protection of intellectual property rights, a court hearing a civil case such as, in particular, a case involving infringement or violation of a copyright, neighboring right or database producer's right may order, under penalty in the event of a violation, the production by the defendant of documents and information relating to the names and addresses of the producer, manufacturer, supplier, and any other holder of goods or services prior to the defending party in the proceeding, as well as of the wholesaler and retailer which would be the recipients thereof, the quantities produced, sold, delivered, received or ordered as well as the price obtained for those allegedly infringing goods or services (Article L.331-1-2 of the IPC).

This right to information of the plaintiff holder of a copyright, neighboring right or database producer's right may be ordered by the pre-trial review judge in the course of proceedings if there is no legal bar. Well-established case law considers that the pre-trial review judge may order the production of items pursuant to the right to information without waiting for the court to rule on the merits with respect to the infringement (Paris Court of Appeal, 17 February 2010). On the other hand, only the civil court dealing with the merits of the infringement action has jurisdiction to order the communication of information, to the exclusion of judges in summary proceedings (Paris Court of Appeal, 6 November 2012).

Article 146 of the French Code of Civil procedure prohibits the courts from making up for the shortcomings of a party in the production of evidence. The courts therefore consider that when applicants have dispensed with providing an expert report and do not demonstrate that they have previously taken measures such as infringement seizure operations in order to submit evidence of the alleged infringement, there is no reason for the court to accommodate a request for information (Paris Court of Appeal, 9 October 2009). They likewise do not grant a request for information when it is intended to allow the defendant to determine the amount of a loss, where an infringement seizure operations would have made it possible to obtain information showing such loss, and where the request for information was based on assumptions (Paris Court of Appeal, 17 February 2012).

- Designs

With regard to designs, an order to provide information is generally based either on the silence maintained by the infringing party during the proceedings, or on indications that the infringing party is concealing items of evidence, or on the need to carry out additional investigations or expert evaluations to precisely determine the magnitude of the infringement, and more generally on the applicant being unable to provide evidence of the material nature or substance of the infringement after, however, endeavouring to carry out available evidence gathering measures (in effect, case law makes the granting of information measures dependent on the prior carrying out of infringement seizures).

An order to provide information may be given against third parties which are not party to the lawsuit and which have been found in possession of infringing goods or have been reported as being involved in the production, manufacture or distribution of such goods or services.

- Patents, semi-conductor products, plant varieties

The order to provide information above all constitutes an evidentiary measure intended to determine the origin and scope of the infringement, but it may be perceived by the infringing party as relief in that it compels it to disclose information which is sensitive with regard to its activity.

The information relates for example to *“the name and address of the producers, manufacturers, distributors, suppliers and other previous holders of the allegedly infringing goods as well as of the wholesalers, recipients and retailers as well as the quantities produced, sold, delivered, received or ordered”* (Paris first level civil court, 14 May 2009).

- Trademarks, geographical indications

With regard to trademarks, the information right is aimed at the compulsory production of

*"all documents and information held by the defendant or by any person who has been found in possession of infringing goods or who provides services used in infringing activities or who has been reported to be involved in the production, manufacture or distribution of those goods or the provision of those services"* (Article L.716-7-1 paragraph 1 of the IPC).

This measure is aimed at determining the origin and the networks of distribution of the infringing goods. Certain decisions have specified that it cannot be used to establish the size of the loss suffered by the holder of rights (Paris Court of Appeal, Division 5-1, 30 January 2013, PPG; Paris first level civil court, 25 March 2011, PIBD 2011 III-566).

Article L.716-7-1 of the IPC, paragraph 2, provides that this production may be ordered *"if there is no legal bar"*.

The measure may be refused for example when:

- the court considers that it has enough information to rule on the loss (Paris first level civil court, Chamber 3-3, 30/11/12, Moulin Rouge).
- the infringing party has been placed in judicial liquidation (Paris first level civil court, Chamber 3-4, 7 February 2013, Kenzo).

#### Account of profits

- Copyright and neighboring rights, database producer's right

When a party has been sentenced for infringement of copyright or violation of a neighboring right or of a database producer's right, the courts may (i) set the damages by considering in particular the profits made by the condemned party, and alternatively and at the request of the injured party (ii) set damages in the form of a lump sum which cannot be lower than the amount of the royalties which would have been owed if the condemned defendant had requested an authorization to use the right which it infringed (L.331-1-3 of the IPC). The courts may also order the confiscation of the revenue obtained through the infringement or violation of a related right, or the database producer's right, to be handed over to the injured party (L.331-1-4 of the IPC).

An isolated case, which may be open to criticism, considered that the amount of revenue had to be determined by the plaintiff to order its confiscation (Aix-en-Provence Court of Appeal, 20 October 2010), which would have the effect of blocking any request for confiscation unless an infringement seizure had revealed that information.

Confiscation of revenue may be considered as a civil remedy, the amount of which is taken into account for the overall compensation owed to the holder of the copyright (Nancy Court of Appeal, 3 March 2004). The French Supreme Court clarified that revenue was defined according to its meaning under French criminal law, and therefore designates the profit generated through the infringement, and not the turnover achieved with the acts of infringement (French Supreme Court (Cassation), mixed chamber, 5 November 1976; Versailles Court of Appeal, 1 April 2010). This additional measure does not apply to the holders of other IPRs.

- Designs

With regard to designs, the return of profits or operating revenues remains an exception and seems to be reserved to cases in which the bad faith, concealment or manoeuvres of the infringing party are particularly established. With regard to the principle of full compensation for the loss, theoretically prohibiting any form of punitive damages, the return of profits would have to be related to a loss suffered by the plaintiff.

- Patents, semi-conductor products, plant varieties

See table in the Annex.

- Trademarks, geographical indications

See table in the Annex.

#### Reasonable royalty

- Copyright and neighboring rights, database producer's right

Article L.331-1-3 of the IPC allows the holder of the right to alternatively request damages in the form of a lump sum which cannot be lower than the amount of the royalties which would have been owed if the sentenced party had requested authorization to use the right which it has infringed.

The courts may therefore set damages by considering either the negative economic consequences suffered by the injured party, or the royalty which would have been owed if an authorization had been requested, when this is requested by the injured party. But even when the latter makes that request, the judge is not obliged to choose this second option. Judges may also justify awarding a lump sum corresponding to the amount of the royalties by the fact that the defendant has not taken any serious action towards allowing the evaluation of the magnitude of the infringement (Paris Court of Appeal, 4 January 2012).

- Designs

See table in the Annex.

- Patents, semi-conductor products, plant varieties

See table in the Annex.

- Trademarks, geographical indications

See table in the Annex.

#### Cancellation of the later trademark and entry in the National Register of Trademarks

Judges may punish trademark infringement by pronouncing the invalidity of the later trademark and sending the French Trademark office (INPI) the decision for entry in the National Register of Trademarks (Paris Court of Appeal, Division 5-1, 30 January 2013, PPG; Paris first level civil court, Chamber 3-3, 30/11/12, Moulin Rouge; Paris first level civil court, 4th chamber, section B, 1 March 2002, Tiffany). The same applies with respect to trademarks infringing an indication of origin (Paris first level civil court, Chamber 3-3, 6 January 2012, Champallain; Paris first level civil court, Chamber 3-1, 27 January 2009, Champallal).

However, a recent decision rejected a request for the cancellation of a later trademark on the basis that the infringement is not constituted by the mere filing of a trademark (Paris first level civil court, Chamber 3-4, 21 February 2013).

#### Deletion of a trademark

Courts have ordered the deletion of a trademark which infringed an indication of origin pursuant to Article L.643-1 of the Rural Code.

#### Withdrawal of a trademark

When a trademark filing was held to be an infringement, by way of penalty, a court pronounced an order to withdraw certain goods from the list of goods and services of the application for registration of the trademark (Paris first level civil court, Chamber 3-4, 25 November 2010, Mandar).

#### Cancellation of an earlier trademark

The public order status attributed to indications of origin by French case law has led to the cancellation of trademarks which were registered prior to the recognition of the indication (French Supreme Court, 1 December 1987, Romanée Conti; Paris Court of Appeal, 12 September 2001, Bains de champagne).

#### Transfer of a domain name

By way of additional relief, a judge may order the transfer of an infringing domain name to the holder of the trademark right (Paris first level civil court, Chamber 3-4, 22 November 2012, Revlon).

The Paris first level civil court has refused to order such a measure because the domain name whose transfer had been requested (figaro.com) was "used internationally and not just in France" and "was registered with a foreign organization which was not a party to the proceedings" (Paris first level civil court, Chamber 3-1, 8 November 2000, Figaro).

#### Withdrawal of a domain name

Following an injunction based on trademark infringement, a court demanded that the infringing party prove the withdrawal of the contentious domain name (Versailles Court of Appeal, 12th chamber, 15 January 2013, Sequoia). A deletion of the domain name was thus ordered so as to "*bring an end to the damage resulting from the use of the [contentious] domain name*" (Paris first level civil court, Chamber 3-3, 28.11.11, No. 11/03545, Filipacchi - confirmed on appeal, Paris Court of Appeal, Division 5-2, 18 January 2013). Such a measure is also found with regard to indications of origin (Paris first level civil court, Chamber 3-2, 27 January 2009, Champallal).

#### Modification of a website

Even though in the case at issue, the modification of the website was not ordered due to the lack of accessibility of the site to the French public, such a measure appears possible with regard to trademark infringement (Paris first level civil court, Chamber 3-3, 07/12/12, Nutella).

#### Change of company name

Following an injunction, the court demanded that the infringing party prove the change of company name (Versailles Court of Appeal, 12th ch., 15 January 2013, Sequoia).

#### **4) *Is there any element of judicial discretion in relation to the grant of any form of Additional Relief addressed in questions 1 and 2? If so, how is that discretion applied?***

- Copyright and neighboring rights, database producer's right

With regard to copyright, neighboring rights and the database producer's right, there is an element of judicial discretion in relation to the grant of additional relief. The French Supreme Court (Cassation) confirmed that judges have sole authority make determinations with respect to both the evaluation of the loss and the granting of

additional relief (Cass. 1st civ., Chamber 12 July 2012).

These determinations are made on a case-by-case basis, and although grounds must be provided for every judgment, the decisions rendered often contain brief grounds or sometimes no grounds at all with regard to the additional relief which they order or refuse.

The courts regularly order the publication of their decisions without providing specific grounds as to why that additional measure is ordered (Pau Court of Appeal, 6 April 2010).

The same holds true with respect to the measures of withdrawal from the channels of commerce and of destruction of infringing goods and of all commercial documents and media embodying said goods, and of the measures of restitution to the author, which may be ordered without particular grounds (Paris Court of Appeal, 10 June 1998; Douai Court of Appeal, 15 December 2011; Paris Court of Appeal, 27 February 2013).

- Designs

With regard to designs, in the large majority of cases, the criteria for granting additional relief are not clearly set out in the court rulings. The only incontestable criterion results from Article 5 of the Code of Civil Procedure according to which “*the judge must make a ruling on everything which is requested and only on what is requested*”. Additional relief may therefore only be ordered if it has been requested by the holder of the IP right.

The criteria for granting measures are completely dependent on the facts of each case, as some measures may prove to be well founded in theory but without justification in practice, as shown by the following example:

*“The request for withdrawal of the infringing goods from the channels of commerce and for destruction of the goods withdrawn shall be rejected as the company AXE has already withdrawn the objects from sale and the court does not have any other information on the importing of other cups into France; [...]*

*The request for information filed against the company AXE is groundless as the latter has already provided all the useful document, and [the request for information] filed against Mr NIEVES MUNOZ GOMEZ who lives in Spain for the sole acts of importing is unfounded since the infringement seizure operations revealed the origin of the goods” (Paris first level civil court, 31 January 2013, RG 11/13119; this decision is under appeal).*

The same element of judicial discretion exists in relation to the grant of any form of Additional Relief, except to some extent for a “rectification”, which results from any final decision changing the ownership or invalidating an intellectual property right.

This discretion is clear from the wording of numerous court rulings, which adopt or reject additional relief without meaningful discussion:

- *“As the entire loss has thus been repaired, this is cause to reject the additional requests for judicial publication”* (Paris first level civil court, 29 March 2012, RG 12/00199);
- *“It is appropriate to grant insofar as necessary the injunction and destruction measures under the terms specified in the present judgment, and to reserve the right to liquidate the penalties ordered”* (Paris first level civil court, 5 June 2012, RG 10/13720);
- *“The circumstances of the case in point do not justify ordering judicial publication measures”* (Paris first level civil court, 5 June 2012, RG 10/15787);
- *“Finally, in consideration of the method of evaluation adopted for evaluating the loss actually suffered by the respondent, the first judges were right to consider that there was no reason to add thereto the payment of a royalty calculated on the basis of the destroyed infringing bags”* (Bordeaux Court of Appeal, 18 October 2012, RG 11/018/89);
- *“The requests for prohibition, withdrawal and destruction of the cups already seized from the company AXE shall be granted as necessary since the cups have already been withdrawn from sale by the defendant, without ordering a penalty* (Paris first level civil court, 31 January 2013, RG 11/13119; this decision under appeal);
- *“Considering that it is appropriate to order, in accordance with the provisions of Articles L.331-1-4 and L.521-8 of the Intellectual Property Code, the withdrawal from the channels of commerce and the destruction, at the expense of SA F.ERRARIE, of all the infringing clothing designs (sweaters and sweater dresses) as well as of all the commercial documents and media showing said infringing designs”* (Paris Court of Appeal, 27 February 2013, RG 11/11980).

- Trademarks, geographical indications

With regard to trademarks and geographical indications, the additional relief pronounced is at the judge’s discretion, regardless of the form of relief. This results particularly from the use of the verb "be able to" in the provisions relating to this additional relief (Articles L.716-7-1, L.716-13, L.722-5, and L.722-7 of the IPC).

**5) Are any particular forms of Additional Relief invariably ordered in certain circumstances? If so, what types of Additional Relief and in what circumstances? Does that occur pursuant to mandatory statutory regulations, or by reason of the practice of the relevant court (or applicable administrative body)?**

With regard to IPRs, there is in principle no additional relief which is invariably ordered in certain circumstances insofar as there is an element of judicial discretion in relation to the granting of additional relief. Nevertheless, evidentiary measures and publication of the judgment are regularly ordered by reason of the practice of the courts.

- Designs

Under the law of 14 July 1909 (Article 11, paragraphs 5 and 6), ordering the confiscation of the objects held to be infringing in favour of the plaintiff was compulsory, even when the responsibility of the holder of such objects was not found (former Article L.521-3 IPC).

Since the entry into force of law No. 85-660 of 3 July 1985, there is no longer a statutory rule that requires the ordering of a particular type of Additional Relief in certain circumstances.

However, although the case law has not established automatic or systematic ordering of such measures in certain circumstances, and judicial discretion is maintained for ordering such measures depending on the requests of the parties and the circumstances of each case, certain measures appear to be used in the majority of cases to remedy certain specific damages. These include, for example, publication measures, often used to remedy damage to the applicant's image.

**6) Are there any specific considerations relevant to particular IPR holders? If so, what considerations are relevant and in respect of what IPR holders?**

- Copyright and neighboring rights, database producer's right

Article L.211-1 of the IPC provides that neighboring rights must not violate the author's rights, and that their protection cannot be interpreted as limiting the exercise of the copyright (see observations under question 9 below).

- Designs

With the exception of the provisions of the law of 14 July 1909 (Article 11, paragraphs 5 and 6, compelling the judge to order measures of confiscation of the objects held to be infringing – see above, question 5°), repealed by law No. 85-660 of 3 July 1985, there do not appear to be any specific considerations relevant to the holders or licensees of a design.

- Trademarks, geographical indications

A specific feature will be noted with regard to geographical indications. The provisions relating to indications of origin are public policy, which allows those which are able to take advantage thereof or the organization defending them to have a trademark, even a trademark registered prior to a decree recognizing an indication of origin, cancelled for infringing that indication of origin (see decision cited above).

**7) Can a court (or applicable administrative body) order any form of Additional Relief directly against a non-party to an IP proceeding?**

In principle, a person cannot be sentenced without having been heard and given notice to defend itself (Article 14 of the French Code of Civil procedure and case law decided on the basis thereof).

The IPC nevertheless includes provisions allowing the courts to order additional relief directly against third parties that are not party to the IP proceedings (right to information) or likely to directly affect third parties (withdrawal of goods).

Directive 2004/48/EC of 29 April 2004 on the enforcement of intellectual property rights, transposed in France by law of 29 October 2007 No. 2007-1544, contains certain indications in particular in:

- Preamble 24 *"Corrective measures [in particular the recall and definitive removal from the channels of commerce, or destruction, of the infringing goods and of the materials and instruments principally used in the creation or manufacture of these goods] should take account of the interests of third parties including, in particular, consumers and private parties acting in good faith";*
- Article 10 (corrective measures) paragraph 3 *"In considering a request for corrective measures, the need for proportionality between the seriousness of the infringement and the remedies ordered as well as the interests of third parties shall be taken into account".*

### The right to information

- Copyright and neighboring rights, database producer's right

An order to provide information may be issued by a court against third parties which are not party to a lawsuit and which have been found in possession of goods infringing copyrights or neighboring rights, or reported to be involved in the production, manufacture or distribution of such goods or services (Article L.331-1-2 of the IPC).

- Designs

See observations under question 3, order to provide information, above.

- Patents, semi-conductor products, plant varieties

See observations under question 3, order to provide information, above.

- Trademarks, geographical indications

An order to provide information may be issued against third parties that are not party to a lawsuit, and that have been found in possession of goods infringing / undermining a

geographical indication or which provided services used in activities infringing / undermining a geographical indication or which have been reported to be involved in the production, manufacture or distribution of those goods or the provision of those services (Articles L.716-7-1 and L.722-5 of the IPC).

The right to information is defined as being aimed at “*determining the origin and the networks of distribution of the goods*”; as well as the production of information about the identity of the producers, manufacturers, distributors, suppliers, former holders, wholesalers, retailers and distributor. However, it also allows the court to order the production of information on the quantities produced, sold, delivered, received or ordered and the price obtained.

The court must ensure that there is no legal bar to the disclosure of the information.

### The withdrawal of goods

- Copyright and neighboring rights, database producer’s right

See observations under question 4 above.

- Designs

See observations under question 4 above.

- Patents, semi-conductor products, plant varieties

With regard to patents, the question arises in the case of a withdrawal measure since Article L.615-7-1 of the Intellectual Property Code specifies that the infringing goods may be withdrawn “*from the channels of commerce*”.

Such channels may include third parties.

If a withdrawal measure may be ordered regardless of the hands in which the infringing goods are found, such additional relief seems to weigh on the infringing party, against which the relief has been ordered, and not on third parties directly. In addition, compulsory enforcement of the decision directly against third parties seems difficult to implement.

Under the terms of a recent judgment, the Paris Court of Appeal indicated that a withdrawal measure (and that of destruction of the goods withdrawn) must be proportionate, and that it is not proportionate if, with regard to the particular facts, the injunction subject to a penalty in the event of violation, the judicial publication measures and the damages are sufficient to bring an end to and prevent the acts of infringement (Paris Court of Appeal, 19 December 2012).

When the infringing goods are in the hands of a third party:

- the withdrawal of the goods is sometimes expressly ordered regardless of the hands in which they are found (Paris first level civil court, 30 September 2008);
  - such an order is sometimes expressly refused against a party against which no judgment on the merits was rendered (Paris first level civil court, 22 November 2011).
- Trademarks, geographical indications

The IPC also includes other provisions allowing the courts to order Additional Relief that, even though not directly ordered against a third party that is not a party to the IP proceedings, is likely to directly affect such third parties.

This mainly involves the withdrawal from the channels of commerce: the court may order that the goods recognized as infringing goods be withdrawn from the channels of commerce (Articles L.716-15 and L.722-7 of the IPC), which may **compel** the party that has been declared guilty of infringement to take back the infringing goods which have already been placed on the market from third parties such as its distributors, retailers, etc.

The cancellation of a later IPR or the transfer of an IPR should also be noted: the measure ordered against the holder of the IPR may affect third parties that have acquired rights in that IPR, in particular licensees, leading to the invalidity, annulment or cancellation of the licence agreement (as well as the resulting impossibility of continuing to use the IPR).

**8) If yes to question 7:**

**a) in what circumstances;**

The court may order third parties that are not party to the lawsuit and that have been found in possession of infringing goods to provide information in order to determine the origin and the networks of distribution of those goods and services. In practice, case law shows that the right to information is generally requested by plaintiffs against defendants in order to force them to provide information on third parties, and not against third parties directly (Versailles Court of Appeal, 28 May 2009; Paris Court of Appeal, 9 October 2009).

**b) what forms of Additional Relief may be ordered; and**

As well as the circumstances mentioned in question 8 (a), the courts may order providers of access to an online public communication service which are not party to the criminal proceedings instigated by Hadopi against Internet users prosecuted for illicit downloading, to suspend the Internet access of said Internet users for a maximum duration of one year, together with a ban on taking out another contract for the same period (L.335-7 of the IPC). When the suspension decision is binding, it is notified to the provider of access to the online public communication service, which will have to carry out the suspension, subject to a fine. This is additional relief under criminal law which is therefore in principle outside of Q.236.

**c) in respect of what types of IPR infringement?**

As indicated in reply to question 7, a measure of withdrawal of infringing goods from the channels of commerce is likely to concern third parties, for any type of IPR, without this measure being pronounced or enforced directly against the third parties.

**9) Is a court (or applicable administrative body), in making an order for Additional Relief against an IPR infringer who is a party to the IP proceeding, obliged to consider the impact of such an order on any non-party? If so, how does the court (or applicable administrative body) fulfil that obligation?**

- Copyright and neighboring rights, database producer's right

Article L.211-1 of the IPC provides that neighboring rights must not violate the author's rights and that their protection cannot be interpreted as limiting the exercise of copyright. Courts must therefore take account of the copyrights in a work when they are asked for an additional measure by a holder of a neighboring right, such as a performance artist, phonogram producer or the like. Mention may also be made of Article L.331-4 of the IPC which provides that copyrights, neighboring rights and database producer's rights cannot prevent acts necessary for the performance of a parliamentary control, judicial or administrative procedure undertaken for public safety purposes. The courts could not therefore order additional measures which would impede the performance of one of the procedures provided for in that article.

Although measures under criminal law are outside question Q.236, it is appropriate to mention that the infringement of copyright may constitute a criminal offence, as may the violation of a neighboring right, and that, among the additional measures under criminal law, the courts may order the total or partial, definitive or temporary closure of the establishment which was used to commit the offence. This criminal law text specifies that the temporary closure may not lead in particular to cancellation or suspension of employment contracts or to any financial loss for the employees concerned.

- Designs

With regard to designs, the interests of third parties not in the IP proceedings who are likely to be affected by the Additional Relief are taken into account for the refusal to grant Additional Relief (see, for example, Paris first level civil court, 17 March 2010, PIBD, No. 922, III, 305, refusing to grant a request for dismantling of infringing bus shelters installed in the scope of the performance of a public contract).

- Patents, semi-conductor products, plant varieties

With regard to patents, courts are not obliged to take account of the impact of the relief ordered on third parties.

Nevertheless, Article 10 paragraph 3 of Directive 2004/48 provides that *“In considering a request for corrective measures, the need for proportionality between the seriousness of the infringement and the remedies ordered as well as the interests of third parties shall be taken into account”*.

Although this provision has not been incorporated as such into Article L. 615-7-1 of the IPC, the interest of third parties may be taken into account by the courts in the scope of their final assessment.

- Trademarks, geographical indications

With regard to right to information, Articles L.716-15 and L.716-22 of the IPC reserve the case of *“legal bar”*: this may be, for example, a case where the production requested relates to confidential third party data.

**10) If yes to question 7 or 9, is the court (or applicable administrative body) obliged to give any relevant non-party an opportunity to be heard? If so, how is that effected?**

Article 141 of the Code of Civil Procedure provides, for obtaining items held by a third party, (i) that the third party may request the amendment or retraction of the decision ordering it to produce those items if there exists a material difficulty or legal bar, and (ii) that the third party may appeal the new decision rendered after it has been heard by the judge. This rule of procedure applies in particular to productions ordered on the basis of the right to information in IP proceedings insofar as the specific texts do not provide a different procedure or rule.

Therefore, if a third party that is not a party to the Intellectual Property proceedings is likely to be affected by a measure of withdrawal from the channels of commerce, it is not heard by the court before the measure is ordered.

However, any third party demonstrating an interest may file an appeal ex post, called third party opposition, against a decision which ordered the additional relief for the purpose of a re-judgment, in fact and in law, of the facts underlying the relief ordered.

## **II. Proposals for harmonization**

***Groups are invited to put forward proposals for the adoption of harmonized rules in relation to Additional Relief in IP proceedings. More specifically, the Groups are invited to answer the following questions:***

***11) What forms of Additional Relief should be available in IP proceedings, and for what types of IPRs?***

The French Group considers that harmonization of the additional relief for the different types of IPR such as that brought about by Directive 2004/48/EC of 29 April 2004 on the enforcement of intellectual property rights would be satisfactory and sufficient.

***12) What should the criteria be for the grant of the types of Additional Relief identified in response to question 11?***

The French Group is satisfied with additional relief being granted or not on a case-by-case basis and in a discretionary manner by the courts, but considers that, in return, the courts should provide a full and detailed explanation of the reasons which led them to grant or refuse an additional measure.

***13) Should there be any specific considerations relevant to particular IPR holders? If so, what should those considerations be and in respect of which IPR holders?***

The French Group does not wish for generalization of specific considerations relevant to particular IPR holders such as non-producing patent holders, in order to determine or influence the availability of additional relief.

***14) Should any particular form of Additional Relief be mandatory in certain circumstances? If so, what types of Additional Relief and in what circumstances?***

The French Group suggests that harmonized rules in relation to additional relief in IPR proceedings provide that said additional relief be granted or not on a case-by-case basis by the courts, but considers that, in return, the courts should provide a full and detailed explanation of the reasons which led them to grant or refuse an additional measure.

***15) Should a court (or applicable administrative body) be empowered to order any form of Additional Relief directly against a non-party to an IP proceeding?***

Apart from the measures presented in the report (rectification order, right to information),

the French Group does not wish for the adoption of a harmonized rule empowering the courts or applicable administrative bodies to order additional relief directly against third parties that are not a party to an IPR proceeding.

**16) If yes to question 15:**

- a) in what circumstances;**
- b) what forms of Additional Relief should a court (or applicable administrative body) be empowered to order; and**
- c) in respect of what types of IPR infringement?**

Not applicable

**17) Should a court (or applicable administrative body), in making an order against an IPR infringer who is a party to the proceedings, be obliged to consider the impact of such an order on any non-party? If yes, how should the court (or applicable administrative body) fulfil that obligation?**

The French Group (i) does not wish for the adoption of a harmonized rule which provides that a court or applicable administrative body would be obliged to consider the impact, on any third party that is not a party to the proceedings, of an order against an IPR infringer who is a party to the proceedings, and (ii) considers that ex post appeals would be adequate.

**18) If yes to question 15 or 17, should the court (or applicable administrative body) be obliged to give any relevant non-party an opportunity to be heard? If so, how should that be effected?**

Not applicable

**19) Please provide any other proposals in respect of harmonization as to the types of Additional Relief that should be available in IP proceedings and the conditions in which such relief should be ordered.**

See observations under number 11.

**ANNEX**

**Additional Relief of Q236**

Relief	Patent	Trademark	Copyright, neighboring rights and database producer's rights	Design	Confidential information / trade secrets	Semi-conductor product	Plant variety	Database producer ( <i>sui generis</i> )	Geographical indication
Declaratory relief	<p>YES</p> <p>Article 615-9 provides for declaratory relief - non-infringement declaration actions. However, strictly speaking, this is not relief, as the patentee is the <i>defendant</i> in the action.</p>	NO	NO	NO	NO	<p>NO</p> <p>as L622-7 does not refer to L615-9</p>	NO	NO	NO

Delivery up/destruction	YES L.615-7-1, para. 1	YES L.716-15, para. 1	YES L.331-1-4, para. 1	YES L.521-8, para. 1	NO	YES L.615-7-1, para. 1 by reference to Article L.622-7	YES L.623-28-1, para. 1	YES L.343-5, para. 2	YES L.722-7, para. 1
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Rectification (as consequence of the cancellation, of the claim or of the order for withdrawal)	YES L.613-9, R.613-53 to R.613-59  Following a patent claim action, but not following an infringement action.	YES L.714-7, R.714-2 and R.714-3  Ex: Paris Court of Appeal, 4th ch., 21 January 2000 (PIBD) orders entry of trademark cancellation decision	NO	YES L.513-3, R.512-13-2, R.512-14	NO	YES R.613-53 to R.613-59 by reference to Article R.622-6	YES R.623-38 to R.623-42  Same comments as for patents	NO	YES Paris District Court, Chamber 3-1, 27 January 2009, Champallal (transcription to the National Register of Trademarks)
Alteration of infringing goods	YES/NO  See question 3	YES  See discussion	YES  Case law decisions	NOT provided for by a specific text Possible in theory (L.521-6 "any measure")	NO	YES/NO  Same comments as for patents	YES/NO  Same comments as for patents	NO	NO
Modification of technology	YES/NO  See question 3	NO	YES  Case law decisions	NOT provided for by a specific text Possible in theory (L.521-6 "any measure")	NO	YES/NO – cf. patents	NO	NO	NO

Corrective advertising	YES	NO Note, however, Nanterre District Court, 18 January 1999: decision where the court ordered the infringing party to insert on its website a hypertext link to the site of the holder of the trade mark (PIBD No. 673-III-147)	YES Case law decisions	NOT provided for by a specific text Possible in theory (L.521-6 "any measure")	NO	YES/NO – cf. patents	YES/NO – cf. patents	NO	NO
Publication of judgment	YES L.615-7-1, para. 2 See "corrective advertising" above	YES L.716-15, para. 2	YES L.331-1-4, para. 2	YES L.521-8, para. 2, L.521-11 Display or publication	NO	YES L.615-7-1, para. 2 by reference to Article L. 622-7	YES L.623-28-1, para. 2	YES L.343-5, para. 3	YES L.722-7, para. 2
Order for inspection	YES: L.615-5 (infringement seizure)  However, the infringement seizure only has an evidentiary purpose and does not constitute relief.	YES L.716-7 (infringement seizure - detailed description)	YES L.332-4, para. 4 (software and database - description seizure)	YES L.521-4 (infringement seizure - detailed description)	NO	YES L. 615-5 by reference to Article L.622-7	YES L.623-27-1 (infringement seizure - detailed description)	YES L.343-1 (detailed description)	YES L.722-4 (infringement seizure - detailed description)
Order to provide information	YES: L.615-5-2  Here too, the measure only has an evidentiary purpose and does not constitute relief.	YES L.716-7-1	YES L.331-1-2 L.331-21 (HADOPI)	YES L.521-5  Information right (documents and information relating to the origin, the substance and the networks of distribution of the infringing goods).	NO	YES L.615-5-2 by reference to Article L.622-7	YES L.623-27-2	NO	YES L.722-5

Account of profits*	<p>YES (element of assessment of the loss)</p> <p>L.615-7, para. 1: the profits are taken into account in the fixing of the damages with the loss of earnings of the injured party and its moral damage.</p> <p>Nevertheless, this does not constitute additional relief. The provision is not very clear: it seems to allow the judge to go beyond the principle of "full compensation", but without necessarily going as far as account of profits.</p>	<p>YES (element of assessment of the loss)</p> <p>L.716-14, para. 1: the profits are taken into account in the fixing of the damages with the loss of earnings of the injured party and its moral damage.</p>	<p>YES (element of assessment of the loss)</p> <p>L.331-1-4, para. 4 Also L.331-1-3, para. 1: the profits are taken into account in the fixing of the damages with the loss of earnings of the injured party and its moral damage.</p>	<p>YES</p> <p>(subject to the principle of full compensation for the loss)</p> <p>L.521-7, para. 1: the profits are taken into account in the fixing of the damages with the loss of earnings of the injured party and its moral damage.</p>	NO	<p>YES (element of assessment of the loss)</p> <p>L.615-7, para. 1 by reference to Article L.622-7</p>	<p>YES (element of assessment of the loss)</p> <p>L.623-28, para. 1: the profits are taken into account in the fixing of the damages with the loss of earnings of the injured party and its moral damage. But no additional relief with the loss of earnings of the injured party and its moral damage</p>	NO	<p>YES (element of assessment of the loss)</p> <p>L.722-6, para.1: the profits are taken into account in the fixing of the damages with the loss of earnings of the injured party and its moral damage.</p>
Reasonable royalty*	<p>YES</p> <p>L.615-7, para. 2 (lump sum by way of damages which may not be lower than the amount of the royalties which would have been owed in the event of authorization. However, it seems to be able to be higher – this is the opinion of at least some scholars (Pollaud-Dulian. versus: Mathély, but on the basis of a different law))</p> <p>The measure can only be pronounced at the request of the injured party.</p>	<p>YES (form of damages)</p> <p>L.716-14, para. 1 (the loss of earnings approach includes the case of the non-exploiting holder, compensated in the form of a compensatory royalty)</p> <p>L.716-14, para. 2 (lump sum by way of damages which may not be lower than the amount of the royalties which would have been owed in the event of authorization)</p>	<p>YES (form of damages)</p> <p>L.331-1-3, para. 2 (lump sum by way of damages which may not be lower than the amount of the royalties which would have been owed in the event of authorization)</p>	<p>YES (form of damages)</p> <p>L.521-7, para. 2 (lump sum by way of damages which may not be lower than the amount of the royalties which would have been owed in the event of authorization)</p>	NO	<p>YES (form of damages)</p> <p>L.615-7, para. 2 by reference to Article L.622-7</p>	<p>YES (form of damages)</p> <p>L.623-28, para. 2 (lump sum by way of damages which may not be lower than the amount of the royalties which would have been owed in the event of authorization)</p>	NO	<p>NO</p> <p>L.722-6, para. 2: there is only provision for the possibility of lump-sum compensation</p>
Relief	<p>YES</p> <p>L.615-1 to L.615-11 (civil) L.615-12 to L.615-16 (criminal)</p> <p>(The notion of relief is too broad)</p>	<p>YES</p> <p>L.716-1 to L.716-15 (civil / criminal)</p> <p>(The notion of brief is too broad)</p>	<p>YES</p> <p>L.331-1 to L.331-4 (civil) L.335-1 to L.335-10 (criminal)</p> <p>(The notion of brief is too broad)</p>	<p>YES</p> <p>L.521-1 to L.521-18 (civil / criminal)</p> <p>(The notion of brief is too broad)</p>	<p>YES</p> <p>L.621-1 (reference to Article L.1227-1 of the labour code) Article 1382 of the civil code</p> <p>(The notion of brief is too broad)</p>	<p>YES</p> <p>L.615-2, L.615-3, L.615-5, L.615-5, L.615-7, L.615-7-1, L.615-8, L.615-10 and L.615-17 by reference to Article L.622-7</p> <p>(The notion of brief is too broad)</p>	<p>YES</p> <p>L.623-25 to L.623-35 (civil / criminal)</p> <p>(The notion of brief is too broad)</p>	<p>YES</p> <p>L.343-1 to L.343-7</p> <p>(The notion of brief is too broad)</p>	<p>YES</p> <p>L.722-1 to L.722-8</p> <p>(The notion of brief is too broad)</p>

<p>Cancellation of a later IPR</p>	<p>NO L.613-25: the infringement is not a cause of invalidity. Quite the reverse, L613-15 (indirectly) sets down the principle of the validity of an improvement patent.</p>	<p>YES L.714-3 L.711-4 and L.714-3; Paris CA, 4th ch., 15.01.2001 (PIBD) confirming Paris first level civil court, 18.01.2000: cancellation of later trademark / Paris CA, 4th ch., 21.01.2000 (PIBD) / Paris Court of Appeal, 30.01.2013 (RG No. 11/07435) / versus Paris first level civil court, 21.02.13</p>	<p>NO</p>	<p>YES L.512-4 Possible accumulation of the invalidity action and the infringement action, but different bases however.</p>	<p>NO</p>	<p>NO – cf. patents</p>	<p>NO – cf. patents</p>	<p>NO</p>	<p>NO L.711-4 and L.714-3 IPC and L.643-1 Rural Code  Article 14 of EC regulation No. 510/2006 of 20 March 2006 + Article 23 of EC regulation No. 110/2008</p>
<p>Cancellation of an earlier IPR</p>	<p>NO</p>	<p>NO</p>	<p>NO</p>	<p>NO</p>	<p>NO</p>	<p>NO</p>	<p>NO</p>	<p>NO</p>	<p>YES Case law: Cass Com, 01.12.87 Romanée Conti (due to the public order status of indications of origin)</p>
<p>Transfer order</p>	<p>NO</p>	<p>YES Case law on ordered transfer of domain names, for example: Paris first level civil court, Chamber 3-4, 22 November 2012 (RG12/01959) / Nanterre first level civil court, 2nd ch., 10 January 2000 (Daloz 2000, p.117) in connection with a well-known trademark</p>	<p>NO</p>	<p>NO</p>	<p>NO</p>	<p>NO</p>	<p>NO</p>	<p>NO</p>	<p>NO</p>

Withdrawal order	NO	YES Paris first level civil court, 25 November 2010: infringing party ordered to partially withdraw a trademark registration application / Versailles Court of Appeal, 15 January 2013: withdrawal of a domain name, under	NO	NO	NO	NO	NO	NO	NO
Order to change company name	NO	YES Versailles Court of Appeal, 15 January 2013: part of the prohibitory measure "the company (defendant) having to prove the change to its company name"	NO	NO	NO	NO	NO	NO	NO
Modification of the infringing party's website	NO	YES Paris first level civil court, Chamber 3-3, 7 July 2012 (Nutella)	NO	NO	NO	NO	NO	NO	NO
Deletion of domain name, of trademark	NO	YES Paris Court of Appeal, Division 5-2, 18 January 2013, Filipacchi (domain name)	NO	NO	NO	NO	NO	NO	YES L.643-1 Rural Code / Paris first level civil court, Chamber 3-1, 27 January 2009 Champallal (deletion of
Recall/Withdrawal from channels of commerce	YES L. 615-7-1, para. 1 Optional – see Confiscation above The destruction is at the expense of the infringer – see Confiscation above.	YES L.716-15, para. 1	YES L.331-1-4, para. 1	YES L.521-8, para. 1	NO	YES L.615-7-1, para. 1 by reference to Article L.622-7	YES L.623-28-1, para. 1	YES L.343-5, para. 1	YES L.722-7, para. 1
Claiming of the IPR / transfer	NO (L.611-8, but unrelated to infringement)	YES L.712-6	YES L.121-1 (right to paternity)	YES L.511-10	NO	NO - cf. patents L.622-3	NO - cf. patents	NO	NO

**Additional Relief Outside the Scope of Q236**

Relief	Patent	Trademark	Copyright, neighboring rights and database producer's rights	Database producer ( <i>sui generis</i> )	Design	Confidential information / trade secrets	Semi- conductor product	Geographical indication	Plant variety
Action for cessation with a technical intermediary	NO	NO	YES  L.336-1 and L.336-2	NO	NO	NO	NO	NO	NO
Fine (criminal)	YES  L.615-12 to L.615-16	YES  L.716-9 to L.716-11 and L.716-12	YES  L.335-2, L.335-2-1; L.335-3-1, L.335-3-2, L.335-4 to L.335-4-2, L.335-8	YES  L.343-4, L.343-6	YES  L.521-10 L.521-12	YES  L.621-1 (reference to Article L.1227-1 of the labour code)	NO, as L622-7 does not refer to L615-12 – L615-17: no possible criminal sanctions	Not according to the IPC, but Cons C. (L.115-22 in particular)	YES  L.623-32
Dissolution, prohibition of performance, placing under surveillance	YES  L.615-14-3	YES  L.716-11-2	YES  L.335-8	YES  L.343-6	YES  L.521-12	NO	NO	NO	YES  L.623-32-2
Imprisonment	YES  L.615-13 to L.615-16	YES  L.716-9 to L.716-11, L.716-11-2 and L.716-12	YES  L.335-2, L.335-2-1, L.335-3-1, L.335-3-2, L.335-4 to L.335-4-2	YES  L.343-4	YES  L.521-10	YES  L.621-1 (reference to Article L.1227-1 of the labour code)	NO, as L622-7 does not refer to L615-12 – L615-17: no possible criminal sanctions	NO	YES  L.623-32 L.623-35

Closure of the establishment by the criminal court	YES L615-142-2 referring to Art. 131-39 Pen. C. (additional penalties applicable to legal persons). In particular, Art. 131-9 4° Comment: Art. 131-39 Pen. C. (as well as Art. 131-6 for natural persons) provides a large number of additional penalties; therefore some appear inappropriate for patent infringement (confiscation of an animal...), but others could in principle be pronounced: - dissolution of the legal person (Art. 131-9 1°)  - prohibition on performing certain professional activities (Art. 131-9 2°; Art. 131-6 11°; Art. 131-6 15°)  - placing under legal surveillance (Art. 131-9 3°)	YES L.716-11-1 and L.716-11-2	YES L.335-5	NO	YES L.521-10	NO	NO, as L622-7 does not refer to L615-12 – L615-17: no possible criminal sanctions	NO	Yes: L623-32-2 referring to Art. 131-39 of the Criminal Code.
Summary proceedings (provisional measures)	YES L.615-3	YES L.716-6	YES L.336-1 and L.336-2	YES L.343-2	YES L.521-6	YES 808 and 809, 872 and 879 of the code of civil procedure	YES L.615-3 by reference to Article L.622-7	YES L.722-3	YES L.623-27
Withholding by customs	YES Regulation (EC) No. 1383/2003	YES L.716-8 to L.716-8-6	YES L.335-10	NO	YES L.521-14 to L.521-18	NO EC Regulation No. 1383/2003 does not concern semi-conductor topographies	NO	YES Regulation (EC) No. 1383/2003	YES Regulation (EC) No. 1383/2003

Seizure of allegedly infringing goods  (provisional measures)	YES  L.615-5  See "order for inspection" above. Evidentiary purpose and does not constitute relief.	YES  L.716-7	YES  L.332-1 L.332-4 (software)	YES  L.343-1	YES  L.521-4	NO	YES  L.615-3 by reference to Article L.622-7	YES  L.722-4	YES  L.623-27-1
Precautionary seizure of the moveable or immovable property of the alleged infringing party, including the freezing of its bank accounts and other assets  (provisional measures)	YES  L.615-3 - reference to ordinary law (law of 9 July 1991 and decree of 31 July 1992 "circumstances likely to threaten recovery")	YES  L.716-6 para. 2 - reference to ordinary law (law of 9 July 1991 and decree of 31 July 1992 "circumstances likely to threaten recovery")	YES  L.331-1-1 - reference to ordinary law (law of 9 July 1991 and decree of 31 July 1992 "circumstances likely to threaten recovery")	NO	YES  L.521-6- reference to ordinary law (law of 9 July 1991 and decree of 31 July 1992 "circumstances likely to threaten recovery")	NO	YES  L.615-3 - reference to ordinary law (law of 9 July 1991 and decree of 31 July 1992 "circumstances likely to threaten recovery")	YES  L.722-3 para. 2 - reference to ordinary law (law of 9 July 1991 and decree of 31 July 1992 "circumstances likely to threaten recovery")	YES  L.623-27- reference to ordinary law (law of 9 July 1991 and decree of 31 July 1992 "circumstances likely to threaten recovery")
Removal of the right of election/eligibility	NO	NO	NO	YES  L.343-7 (for commercial courts, territorial chambers of commerce and industry and chambers of trade and industrial tribunals)	NO	YES  L.621-1 (reference to Article L.1227-1 of the labour code - prohibition of civic, civil and family rights)	NO	NO	NO
Suspension of access to an online public communication service	NO	NO	YES  L.335-7 to L.335-7-2	NO	NO	NO	NO	NO	NO

\* Please see paragraphs 31), 33) and 34) of these Working Guidelines and observe the note under question 2 in Part I of the Questions.  
Note: The provisions mentioned relate to the Intellectual Property Code, unless otherwise indicated.

## SUMMARY

1. The inventory of relief in IP proceedings other than injunctions or damages available under French law shows that the various measures of Additional Relief described in the Working Guidelines of Question Q.236 are or are not available according to the type of IPR, and that some of the measures described in the Working Guidelines as Additional Relief resemble certain evidentiary measures available under French law that may be ordered *ex parte* and/or may be ordered before a judgment on the merits with regard to an infringement of an IPR (respectively infringement seizures and right to information).

Under French law, it is appropriate to add to the inventory of Additional Relief in IP proceedings (i) five types of IPRs (rights related to copyright (neighbouring rights), the database producer's right, protection of semi-conductor products, geographical indications and protection of plant varieties), and (ii) four types of Additional Relief (cancellation of a later IPR, recall/withdrawal from channels of commerce and the claiming of ownership of an IPR). Trade names, signs, company names and personality rights mentioned in Article L.711-4 of the French Intellectual Property Code (IPC), as well as image rights and the protection of privacy, which do not appear in the IPC, are not included in the IPRs covered by TRIPS, and are not discussed in the report for France or in the table in the Annex to the report.

The willingness of French courts to grant a particular form of Additional Relief is not dependant on the identity or class of IPR holder seeking the relief except with respect to the holders of neighbouring rights. Although an order granting Additional Relief may under French law impact persons who are not parties to an IP proceeding, French rules of civil procedure provide such persons the possibility of challenging the order *ex post*.

2. The French Group considers that harmonization of the Additional Relief for the different types of IPR such as that brought about by Directive 2004/48/EC of 29 April 2004 on the enforcement of intellectual property rights would be satisfactory and sufficient.

The French Group is satisfied with additional relief being granted or not on a case-by-case basis and in a discretionary manner by the courts, but considers that, in return, the courts should provide a full and detailed explanation of the reasons which led them to grant or refuse an additional measure.

The French Group does not wish for generalization of specific considerations relevant to particular IPR holders such as non-producing patent holders, in order to determine or influence the availability of additional relief.

The French Group suggests that harmonized rules in relation to additional relief in IPR proceedings provide that said additional relief be granted or not on a case-by-case basis by the courts, but considers that, in return, the courts should provide a full and detailed explanation of the reasons which led them to grant or refuse an additional measure.

Apart from rectification orders and the right to information, the French Group does not wish for the adoption of a harmonized rule that would empower the courts or applicable administrative bodies to order additional relief directly against third parties that are not a party to an IPR proceeding.

The French Group (i) does not wish for the adoption of a harmonized rule requiring a court or applicable administrative body to consider the impact on any third party that is not a party to the IP proceedings, of an order against an IPR infringer who is a party to the IP proceedings, and (ii) considers that *ex post* appeals would be adequate to preserve the rights and interests of said third parties.

## RÉSUMÉ

1. L'inventaire des Mesures de réparation autre que les injonctions et les dommages et intérêts disponibles en droit français montre que les diverses Mesures de réparation supplémentaires décrites dans les Orientations de travail pour la Question Q.236 sont ou ne sont pas disponibles selon les types de DPI, et que certaines Mesures décrites dans les Orientations de travail comme Mesures de réparation supplémentaires ressemblent à certaines mesures probatoires disponibles en droit français qui peuvent être ordonnées *ex parte* et/ou avant un jugement au fond condamnant une atteinte à un DPI (respectivement les saisies contrefaçon et le droit à l'information).

En droit français, il convient d'ajouter à l'inventaire des Mesures de réparation supplémentaires dans les procédures de PI (i) cinq types de DPI (droits voisin du droit d'auteur, droit du producteur de base de données, protection des produits semi-conducteurs, indications géographiques et protection des obtentions végétales), et (ii) quatre types de mesures de réparation (annulation d'un DPI postérieur, rappel/retrait des circuits commerciaux et la revendication de propriété d'un DPI). Les noms commerciaux, enseignes, dénominations sociales et, droit de la personnalité mentionnés à l'article L.711-4 du Code de Propriété Intellectuelle (CPI), ainsi que le droit à l'image et la protection de la vie privée qui ne figurent pas dans le CPI, ne font pas partie des DPI couverts par l'Accord sur les ADPIC, et ne sont pas discutés dans le rapport français ou dans le tableau en Annexe du rapport.

A l'exception des détenteurs de droit voisin, la volonté des tribunaux français d'accorder une forme particulière de Mesure de réparation supplémentaire ne dépend pas de l'identité ou du type de détenteur de DPI demandant la réparation.

Bien qu'une décision ordonnant des Mesures de réparation supplémentaires puisse en droit français avoir un impact sur des tiers à la procédure de PI, les règles de procédure civile françaises prévoient que ces tiers peuvent contester la décision *ex post*.

2. Le Groupe français considère qu'une harmonisation des Mesures de réparation supplémentaires pour les différents types de DPI telle que celle effectuée par la Directive 2004/48/CE du 29 avril 2004 relative au respect des droits de propriété intellectuelle serait satisfaisante et suffisante.

Le Groupe français est satisfait de ce que les Mesures de réparation supplémentaires soient accordées ou non au cas par cas et de manière discrétionnaire par les juridictions, mais considère qu'en contrepartie les juridictions devraient motiver de manière complète et détaillée les raisons les ayant conduits à accorder ou refuser une mesure supplémentaire.

Le Groupe français ne souhaite pas la généralisation de considérations spécifiques propres à certains détenteurs de DPI tels que des détenteurs de brevets non producteurs, pour déterminer ou influencer sur la disponibilité de Mesures de réparation supplémentaires.

Le Groupe français suggère que des règles harmonisées en matière de Mesures de réparation supplémentaires dans les procédures DPI prévoient que lesdites Mesures de réparation supplémentaires soient accordées ou non au cas par cas par les juridictions, mais considère qu'en contrepartie les juridictions devraient motiver de manière complète et détaillée les raisons les ayant conduits à accorder ou refuser une mesure supplémentaire.

En dehors des ordonnances de rectification et du droit à l'information, le Groupe français ne souhaite pas l'adoption d'une règle harmonisée habilitant les tribunaux ou organes administratifs compétents à ordonner des Mesures de réparation supplémentaires directement à l'encontre de tiers non parties à une procédure DPI.

Le Groupe français (i) ne souhaite pas l'adoption d'une règle harmonisée qui prévoit qu'un tribunal ou un organe administratif compétent serait tenu d'examiner l'impact sur tout tiers non-partie à la procédure d'une ordonnance à l'encontre d'une personne ayant enfreint un DPI qui est partie à la procédure, et (ii) considère que des recours *ex post* seraient adéquats afin de préserver les droits de ces tiers.