

# Collecting Evidence in Patent Cases - The Power of Saisie-Contrefaçons

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Here at the Kluwer Patent Blog we are thrilled to have had the opportunity to interview Benjamin May on collecting evidence in patent cases and have him address issues on the power of seize and search orders, the harmonisation efforts of Directive 2004/48/EC and the future of seizures, prior to his presentation at CS's [Pharma & Biotech Patent Litigation Conference](#) in Amsterdam.

## What are "saisie-contrefaçons"? How are These Beneficial When Collecting Evidence in Patent Cases?

*Saisie-contrefaçons* are *ex parte* proceedings available to any patent holder. Their purpose is to seek from the Court an authorization to have investigations carried out at the infringer's place or at any place where the infringing goods may be found (office, factory...).

As the goal is to collect evidence for the infringement and the quantum of the prejudice, the seizure may include samples of infringing goods and any technical information or any financial, accounting or commercial documents needed for the assessment of the prejudice suffered by the patentee.

As they are *ex parte*, *saisie-contrefaçons* usually catch the infringer by surprise, which avoids the dissimulation of proof. Formally under the control of a bailiff, *saisie-contrefaçons* are usually performed by a task force composed of patent attorneys, IT experts and sometimes the police. In most countries the attorneys are not allowed to participate, not to mention the staff of the claimant. The purpose of this safeguard is to preserve and protect the confidentiality and the trade secrets of the targeted company.

*Saisie-contrefaçons* are a particularly powerful tool in patent cases where evidence of infringement may be difficult to collect without entering the premises of the infringer.

## Is the Use of Seizures Uniform Across the EU Countries which have Implemented It?

The objective of the Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights was to "approximate legislative systems so as to ensure a high, equivalent and homogeneous level of protection in the Internal Market"<sup>[1]</sup>.

The purpose of the Directive was notably to harmonize the methods of collection of evidence and conservation in matters of infringement by means of provisions<sup>[2]</sup>, which are basically a reflection of pre-existing mechanisms in some Member States such as *saisie-contrefaçons* in France. For example, France was known to offer a system of obtaining evidence through *saisie-contrefaçons* favorable to patentees which is used in most of the patent cases.

However, the European legislator left some discretion to Member States to implement arrangements more favorable to patentees and, besides, this option has not been used by all of them. As a result, there are differences remaining in national practices within the EU:

- *Saisie-contrefaçons* are effectively available only in some countries (e.g. France, Belgium, Netherlands, Italy).
- The conditions to obtain the authorization for a search and seizure may vary from one country to another: the required level of *prima facie* evidence of infringement is higher in Belgium than in France and the Netherlands where reasonably accessible evidence of infringement is sufficient. It is so high in Germany that the *saisie-contrefaçons* is not used in effect.
- In Belgium, an expert appointed by the Court conducts the investigations and carries out the description while the bailiff is only assisting. In France, the investigations are carried out by a bailiff, who can be assisted by an expert (patent agent) appointed by the patent holder.

## Why Has This Power Not Yet Been Adopted in Some Countries (e.g. Germany, the UK)? What is the Impact of This?

Despite the harmonization effort of the Directive 2004/48/EC, some Member States have chosen not to adopt, among their pre-existing measures of collecting evidence, an equivalent of *saisie-contrefaçons*.

For instance, in the UK (England and Wales), the most common procedure for obtaining evidence of infringement in patent litigation is the *disclosure* (which already existed prior to the Directive 2004/48/EC) whereby a Court may order a party to produce internal information and documents regarding the infringement.

In Germany, *ex parte* pre-action search orders are available only if the applicant shows in particular (i) a "certain degree of probability" of the patent infringement<sup>[3]</sup> otherwise, the Court may decide to hear the alleged infringer, and (ii) that there is no other means of proving the infringement.

## What Do You See as The Future for Seizures?

In France, *saisie-contrefaçons* are widely and increasingly used but still have their shortcomings: there is some hazard in the "surprise effect" and many orders authorizing the seizure and seizures themselves are challenged by the adverse party later in the proceedings.

Within the EU, the construction of a harmonized seizure equivalent to *saisie-contrefaçons* is unfinished. Still, the current situation allows claimants to perform *saisie-contrefaçons* in a country and use the collected evidence in a case pending before the Courts of another country. In some cases, it is even possible to obtain a court order for *saisie-contrefaçons* based on a patent in force in another country.

Finally, the Unified Patent Court (UPC)<sup>[4]</sup> provides for interim measures to preserve evidence and to inspect premises, which may be accompanied by sample collection or seizures of material<sup>[5]</sup>. This measure may be authorized without hearing the defendant under certain circumstances. As a result, *saisie-contrefaçons* are open for a significant extension within the frame of the UPC.

[1] Directive 2004/48/EC, Recital 10.

[2] Directive 2004/48/EC, Art. 7.

[3] Courts may order an alleged infringer (or a third person) to present or have inspected certain objects which they have in their possession.

[4] Which is set up to deal with infringement cases of Unitary patents and European patents.

[5] Agreement on a Unified Patent Court 2013/C 175/01, Article 60 (Order to preserve evidence and to inspect premises) and Rules of Procedure of the Unified Patent Court, 18<sup>th</sup> draft of 19 October 2015, Rules 196 to 199.