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Saisies-contrefaçons and trade secrets: developments in France since the 2018 reform

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The transposition of the 2016 directive on trade secrets into French law by the law of 31 July 2018 and its implementing decree could have led to the expectation of difficulties with the so-called “saisies-contrefaçons”.

The main one to remember is undoubtedly the application of the new article R. 153-1 of French Commercial Code to intellectual property rights. Indeed, according to this text, “*the Judge may order ex officio the temporary sequestration of the requested documents, in order to ensure the protection of trade secrets*”. However, “*if the Judge is not seized of a request to modify or retract his order [...] within a period of one month from the service of the decision, the provisional sequestration measure mentioned in the previous paragraph shall be lifted and the documents shall be transmitted to the applicant*”. In short, since 2019, it is appropriate to provide, within the *saisie-contrefaçon* order, for the possibility of placing the documents under provisional sequestration under the pretext of trade secrets and if the request for conservation is not made within one month, the said documents are given to the seizing party.

This provision led to the expectation that many claims for the revocation of *saisies-contrefaçons* would be filed, including requests to maintain the sequestration measure. The conservation of the sequestration is then subject to two conditions which the seized party must prove: that the information contained in the sequestered document can be qualified as a trade secret (according to art. L. 151-1 of French Commercial Code) and, if the information is effectively confidential, that it is not necessary to prove the infringement. On the other hand, if the information is necessary to prove the infringement, it should be disclosed. However, we can see that the case law of the specialized French Courts is severe when it comes to establishing these two conditions.

The case law has focused more particularly on the criterion of disclosure: the need for proof of infringement. Thus, the Paris High Court (“Tribunal judiciaire”), in a judgment rendered on June 12, 2020, in the case of TEOXANE vs. VIVACY - confirmed by a decision of the Paris Court of Appeal - considered that a document relating to production batches (“*A4 sheet containing the number of production batches*”) was necessary for the resolution of the litigation, even though it provided information on

the seized company's production capacity, and despite the fact that two other documents already provided information on the infringing mass.

Similarly, in another decision rendered by the same Court on 27 May 2021 in WSOU vs. HUAWEI, it was decided that the patent purchase agreement, its annexes and riders, and the confirmation deeds, which nevertheless constituted trade secrets, had to be disclosed, because they were necessary to demonstrate the extent of the infringement.

This being the case, although a document is deemed necessary for the solution of the litigation, the Judge may, according to the 2019 texts (R. 153-5 et seq. of the French Commercial Code), opt for different options.

- The Judge shall refuse to disclose the document only if it is not necessary for the resolution of the case.
- The Judge shall order the disclosure of the document in its entirety if it is necessary for the resolution of the case.
- The Judge shall order the disclosure of the document in its entirety if parts of it are not necessary for the resolution of the dispute.
- And/or the Judge may order disclosure of the document only within the framework of a confidentiality circle (including certain representatives of the parties) which will be responsible for sorting out what is and is not secret.

In the end, despite the 2018 reform of trade secret, it must be noted that the case law restricts the possibilities of interference of secrecy with *saisies-contrefaçons*, so that the latter remains an effective tool for obtaining evidence, which the seizers will be able to use not only in France, but also abroad.



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