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Saisie-contrefaçon: a measure for preserving evidence even after expiry of the patent

Pierre Véron (Véron & Associés) · Friday, June 11th, 2010

Paul Schlagmuller is the holder of a French patent, filed on 28 June 1985, entitled “volet roulant de protection pour ouvertures dans les murs”, that is, in English “Protective roller blind for openings in walls” and on which he granted an exclusive licence to the company Jean Deprat (hereinafter referred to as “Deprat”).

Deprat, having learned that another company allegedly had automatic locking devices reproducing the claims of the patent, requested and obtained on 23 May 2005 the authorisation to carry out a *saisie-contrefaçon*, which was carried out on 24 June 2005. This first seizure having revealed the existence of a catalogue which allegedly offers for sale infringing locking devices, Deprat requested on 29 June 2005 the authorisation to carry out a new *saisie-contrefaçon* on this company’s premises, adding that the patent “expires on 28 June 2005”. Duly authorised, Deprat carried out a second seizure on 1 July 2005.

Arguing that this second seizure would demonstrate that the products listed in the catalogue were marketed by the company Zurfluh Feller, Deprat, with the consent of the patentee, brought proceedings against Zurfluh Feller on 8 July 2005 before the *Tribunal de Grande Instance* of Paris for the infringement of the patent and Paul Schlagmuller voluntarily intervened to the proceedings on 17 October 2005.

On 6 July 2006, the *Tribunal de Grande Instance* of Paris decided that Deprat had the capacity to take action for infringement, since the patentee intended to allow the licensee to institute an action, and declared the second *saisie-contrefaçon* procedure to be void, the patent having expired at the date of the request for authorising this seizure. And, on 13 July 2007, the *Tribunal de Grande Instance* of Paris held that claim 1 of the patent was invalid for lack of novelty and dismissed Deprat and Schlagmuller’s infringement claim considering that proof of infringement had not been produced.

Deprat and Schlagmuller then lodged an appeal against these decisions.

The *Cour d’Appel* of Paris in its [3 March 2010 decision](#), on the one hand, affirmed that Deprat as exclusive licensee had the capacity to take action for infringement on the ground that it results from the wording of Articles L. 615-2 and L. 615-5 (before as well as after Act No. 2007-1544 of 29 October 2007 was introduced) that the rule according to which the exclusive licensee shall take action for infringement or request a *saisie-contrefaçon* only if, after formal notice, the patentee did

not himself take action, is non-mandatory since Article L. 615-2 expressly admits contrary provisions of the licence agreement. So, the consent given in this case by the patentee to the exclusive licensee – the patentee expressly requested on 12 February 2005, *i.e.* before the seizures and the commencement of the proceedings, that Deprat “initiate a legal action” – was sufficient to confer to Deprat, exclusive licensee, the capacity to take action. The *Cour d’Appel* takes care to explain that the only fact that the patentee undertook to contribute to the exhaustively listed financial expenses does not demonstrate that he intended to take action as the main claimant and that Article 10 of the licence agreement simply specifying that “the proceedings will be initiated with common expenses and profits” does not require a joint institution of the proceedings and does not exclude that the licensee could bring an infringement action on his own with the consent of the patentee.

On the other hand, the *Cour d’Appel* reversed the judgment because it held the second *saisie-contrefaçon* procedure carried out on the basis of a request lodged on 29 June 2005, the patent having already expired at that date, to be void.

Pertinently, the *Cour d’Appel* was inspired by the evidential nature of the *saisie-contrefaçon*. In industrial property, the *saisie-contrefaçon* has exclusively an evidential nature which has been expressly affirmed with the reform Act of 29 October 2007 implementing EC Directive 2004/48 into French law. First, the *Cour d’Appel* has reminded that a *saisie-contrefaçon*, even carried out after the expiry of the patent, could perfectly allow to collect pieces of evidence likely to prove infringing acts committed prior to the expiry of the patent. Secondly, the *Cour d’Appel* reminded that it is possible to bring an infringement action after the expiry of the patent if it is intended to claim reparation for infringing acts committed when the patent could be asserted against third parties, not yet covered by the limitation period. And the *Cour d’Appel* has explained that there was no logical reason for justifying that a person who retains the right to proceed against acts committed prior to a patent expiry be deprived of a means of obtaining evidence to establish them. And in the present case, Deprat had in all honesty requested the authorisation to carry out the second *saisie-contrefaçon* having clearly indicated that the patent set out had expired on 28 June 2005 and the seizure was requested for the purposes of “confirming the reality [...] of the sale of allegedly infringing products [...] sale recorded during the first *saisie-contrefaçon* carried out on 24 June 2005” (that is, at a date when the patent had not yet expired). And the *ex-parte* order did indicate that the description and the seizure were authorised so as to prove the alleged infringements “prior to 29 June 2005”.

In the present case, nothing was to prevent pieces of evidence seized on 1 July 2005 from being taken into account, where necessary, which would demonstrate the implementation of characteristics of the patent before it expired (two days earlier).

This decision relating to French *saisie-contrefaçon* will certainly be of interest to practitioners of other Member States of the European Union since Article 7 of EC Directive 2004/48, which had to be implemented into the national laws before 29 April 2006, requires the Member States of the European Union to introduce into their national law “measures for preserving evidence”, using as models the French *saisie-contrefaçon* and the Anton Piller order. This decision which finds no contradiction in Article 7 of EC Directive 2004/48 and which is essentially based on the evidential nature of the *saisie-contrefaçon*, may therefore be extended to the “measures for preserving evidence” set up into the laws of the different Member States of the European Union.

[Original French decision.](#)

English translation (extracts).

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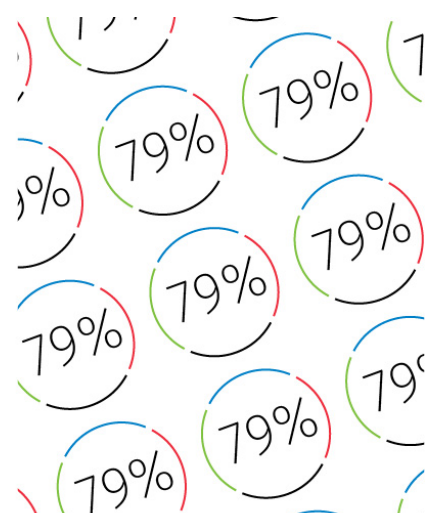
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