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No saisie-contrefaçon after the expiry of the intellectual property right?

Pierre Véron (Véron & Associés) · Saturday, March 26th, 2011

Daiichi Sankyo (hereinafter referred to as “Daiichi”) was the holder, for a drug whose active principle was pravastatine, of a supplementary protection certificate (SPC) granted on 26 August 1992 which expired on 10 August 2006.

This company claimed that Sandoz had, since July 2006, manufactured and put on the French market a generic drug of pravastatine, thereby infringing the exclusive right conferred by the SPC.

Daiichi, wishing to collect evidence of this last-minute infringement, had waited until 17 March 2009 to request and obtain from the president of the Tribunal de Grande Instance of Paris an order authorising it to carry out a *saisie-contrefaçon* on Sandoz’s premises.

After the *saisie-contrefaçon* was carried out on 20 March 2009, Sandoz served a summons upon Daiichi on 26 and 27 March 2009 to appear in a preliminary hearing, requesting that the Judge withdraw the *saisie-contrefaçon* order which he had rendered. The ground put forward for withdrawing the order was that on the date Daiichi had requested the authorisation to carry out a *saisie-contrefaçon*, the right on which the request was based was no longer in force since the SPC had expired since 10 August 2006.

And the president of the *Tribunal de Grande Instance* had in fact withdrawn its order on the ground that the capacity to carry out a *saisie-contrefaçon* presupposes that the claimant is the holder of a title still in force at the date on which the measure is requested.

Daiichi having appealed this decision, the *Cour d’Appel* of Paris rejected this solution in a 18 November 2009 decision (see also, in a similar case, *Cour d’Appel* of Paris, Division 5, Chamber 1, 3 March 2010, Docket No. 07/14488, *Deprat, Schlagmuller v. Zurfluh Feller*) on the ground that “although the claimant has to communicate in its request the exhibits justifying that its rights remained in force over the period during which the allegedly infringing acts were committed, the existence of the said rights at the time of the request is irrelevant if the request does not relate to this period”.

Sandoz then lodged an appeal against the decision of the *Cour d’Appel*.

In a 14 December 2009 decision, the Commercial Chamber of the French *Cour de Cassation* quashes and vacates the appeal decision on the grounds that “the only persons allowed to carry out a *saisie-contrefaçon* in the field of patents or supplementary protection certificates are those

enumerated in Article L. 615-2 of the French Intellectual Property Code, justifying not only the existence of the right on which their request is based but also the fact that it is still in force at the date on which the request is submitted”.

This solution results from a literal reading of Articles L. 615-5, L. 615-2 and R. 615-2 which are cited in the decision: may request an order to carry out a *saisie-contrefaçon* any person with authority to bring an action for infringement (L. 615-5), *i.e.* notably the “owner of the patent” or of the SPC (L. 615-2) who shall, at the date on which the request is submitted, produce the patent or the SPC (R. 615-2).

The *Cour de Cassation* infers therefrom that, as soon as the title has expired, the ex-holder has no longer the capacity to request authorisation to carry out a *saisie-contrefaçon*.

One may consider that this solution, given for patents and other related rights (SPC, utility certificate) can be applied generally to all other intellectual property rights.

However, it seems rather difficult to approve the solution of the 14 December 2010 because of its implications.

To prohibit the ex-holder of an expired right from carrying out a *saisie-contrefaçon* does not deprive him of all means to collect evidence of the alleged infringement. Since the infringement is only a fact, its proof remains free and all means of evidence, other than the bailiff’s *saisie-contrefaçon* report, may still be used.

But it must not be forgotten that there is now a strict equivalence between the capacity to request a *saisie-contrefaçon* and the standing to take action for infringement.

Since the reform introduced by Act No. 2007-1544 of 29 October 2007, implementing EC Directive No. 2004/48, regarding not only patents and related rights which are directly concerned by the 14 December 2010 decision (L. 615-5) but also the entire field of industrial property and part of the protection of literary and artistic works, the various articles relating to the *saisie-contrefaçon* (L. 521-4, L. 622-6, L. 623-27-1, L. 716-7, L. 722-4, L. 343-1 of the French Intellectual Property Code), defining the persons having capacity to request the *saisie-contrefaçon*, have referred to the list of the persons having standing to take action for infringement.

This textual bridge, of a legislative nature (which must then prevail over provisions of a regulatory nature as for example Article R. 615-2) creates an absolute identity between the persons who may take an action for infringement and the persons who may request an order to carry out a *saisie-contrefaçon*. The *Cour de Cassation*’s assertion according to which the holder of an intellectual property right, here the patent or the SPC, may no longer request an order to carry out a *saisie-contrefaçon* as of the expiry date of its right, necessarily means that the holder of an intellectual property right may no longer take an action for infringement as of the expiry date of its right.

It is hardly conceivable that the *Cour de Cassation* really wished to come to such a result.

As for patents, it is self-evident and has for a long time been admitted that the ex-holder may take an action for infringement after the expiry of its right provided that he does so before the proceedings for infringement are barred after three years from the acts concerned (Art. L. 615-8; see *Cour de Cassation*, Com. Ch., 20 December 1967, *Bull. civ.* IV, No. 427; *Cour d’Appel* of Paris, 25 January 1966, *Ann. propr. Ind.* 1966, p. 128; *Cour d’Appel* of Paris, 16 December 1971,

PIBD 1972, No. 83, III, 144; *Tribunal de Grande Instance* of Paris, 2 April 1991, *PIBD* 1991, No. 507, III, 533). The Commercial Chamber of the *Cour de Cassation* has also clearly adopted such a solution for trademarks (*Cour de Cassation*, Com. Ch., 2 June 1992, No. 90-17273, *Bull. civ.* IV, No. 233).

The acts committed without authorisation during the validity period of the intellectual property right are acts of infringement for which their author is civilly and criminally liable. This classification is definitive and is not challenged by the subsequent expiry of the right. As long as the ex-holder takes an action within the three years' time limit (which was precisely Daiichi's case), he shall obtain from the courts recognition of this situation and compensation for of the damage suffered. Another solution would divest of its substance the intellectual property right which is close to its expiry date.

Considering the European and national lawmaker's will to enable the holder to efficiently fight against infringement, it does not seem appropriate to hamper so much its collection of evidence of the infringing acts.

Since European law is mentioned, can some indication be found in the EC Directive No. 2004/48 in support of the opinion of the French *Cour de Cassation*? It does not seem so. On the contrary, one could underline the fact that Article 7 of that directive, implemented into French law by the Act of 29 October 2007, especially into Article L. 615-5 which is discussed here, provided that: "Member States shall ensure that, even before the commencement of proceedings on the merits of the case, the competent judicial authorities may, on application by a **party** who has presented reasonably available evidence to support his claims that **his intellectual property right has been infringed** or is about to be infringed...". This text precisely mentions the case of a party who claims that his intellectual property right has been, previously, infringed. It does not consider whether this intellectual property right is still in force and consequently does not require that this right be still in force. The title itself of Article 7 explains that it deals with "measures for **preserving** evidence"; the aim is to avoid that evidence of an infringement committed in the past be irreversibly lost, without considering whether the infringed intellectual property right is still in force. And if the national lawmaker may be more favourable to the holders of intellectual property rights than the Directive, the contrary is not true (see Article 2 §1 of EC Directive No. 2004/48). Should the *Cour de Cassation* turn to Article 4 of the Directive for some support? Article 4 provides that "persons entitled to seek application of the measures, procedures and remedies" referred to in the Directive are "the holders of intellectual property rights", "all other persons authorised to use those rights", "intellectual property collective rights management bodies", "professional defence bodies", and never mentions the ex-holders of intellectual property rights. But these ex-holders of intellectual property rights should then also be excluded from the benefit, for example, of Articles 10 to 15 of Directive No. 2004/48, that is, excluded from all the protection resulting from the sanctions of the infringement. Such a conclusion is as excessive as the conclusion of the French *Cour de Cassation* in the context of French law.

[Original French decision.](#)

[English translation.](#)

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