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## On the use and abuse of *saisie-contrefaçon*

Pierre Véron (Véron & Associés) · Monday, September 26th, 2011

Vetrotech Saint-Gobain (International) (hereinafter referred to as “Vetrotech”) is the holder of European patent No. 0 620 781 designating France, filed on 5 August 1993 and granted on 19 May 1999, entitled “*Light-transparent heat-protection element*”, and concerning the field of fire-protection glass and its manufacturing process.

Suspecting Interfer Sécurité (hereinafter referred to as “Interfer”) of manufacturing and marketing in France the glass obtained by using a process reproducing the characteristics of claim 11 of its patent, Vetrotech carried out a *saisie-contrefaçon* and then brought before the *Tribunal de Grande Instance* of Paris proceedings against Interfer for the infringement of claims 11 and 12 of its patent.

However, the *Tribunal de Grande Instance* of Paris, in a judgment handed down on 25 March 2009, decided that, in the absence of reproduction of all the characteristics of claim 11, the alleged infringement was not established and dismissed Vetrotech’s main claim for infringement.

In addition, the *Tribunal* found that the glass seized during the *saisie-contrefaçon* did not reproduce claim 1 of the asserted patent and consequently dismissed Vetrotech’s alternative claim for ordering the defendant to prove that the process it used was different from the patented process.

However, the first-instance judges accepted Interfer’s counterclaim seeking damages for the abusive *saisie-contrefaçon* considering that it had enabled Vetrotech to obtain a certain amount of information about its competitor’s manufacturing process. On this specific ground, the *Tribunal* ordered Vetrotech to pay €100,000 as damages to Interfer, according to the civil liability ruled by Article 1382 of the French Civil Code, because of the abusive *saisie-contrefaçon* and because Vetrotech had persisted in its judicial proceedings.

In the present decision dated 22 June 2011, the *Cour d’Appel* of Paris affirms this judgment in all its provisions. And especially, the *Cour* considers that the *saisie-contrefaçon* has been used as a pretext to carry out illicit investigations and that the first-instance judges rightly assessed the commercial damage suffered by Interfer since these proceedings have enabled Vetrotech, its competitor, to unduly obtain information on its manufacturing processes.

These two decisions are important because they illustrate the fact that the French *saisie-contrefaçon* is not a measure that can be used or misused with impunity. This aspect of the French *saisie-contrefaçon* seems relatively unknown, especially abroad where it is often presented as a

typical example of “*fishing expeditions*”.

The *saisie-contrefaçon* is indeed, in French law, a powerful tool in the hands of the owner of the patent (or any other intellectual property right) in order to collect the evidence of the alleged infringement. The *saisie-contrefaçon* is an extreme measure permitting an intellectual property right-holder to have investigations carried out at the premises of an alleged infringer with a view to obtaining proof of infringement.

The claimant must, however, refrain from abusing the procedure and must use the *saisie-contrefaçon* with restraint and discernment. The *saisie-contrefaçon* must remain an exclusively probative measure. It must not be used in order to cause commercial damage and harm to the defendant’s reputation, to obtain the competitor’s trade and industrial secrets by deception (as in the present case; see also in Belgium, Belgian Cour de Cassation’s judgment of 26 November 2009 in INEOS/Chevron, Docket No. C.08.0206.N.1, in which the Court held that the mere fact that a competitor had opposed the petitioner’s process patent with the EPO did not justify discovery at the competitor’s production site; the use of the *saisie-contrefaçon* to facilitate mere fishing expeditions is unacceptable) or to cause disruption of the competitor’s company. The exercise by an intellectual property right-holder of its right to carry out a *saisie-contrefaçon* shall be assessed under Article 1382 of the French Civil Code and thus civil liability.

Surely, the decisions that condemn the claimant for abusive *saisie-contrefaçon* are rare. But that is because practitioners remain cautious. The attorneys-at-law only seek what seems necessary and justified, while the judges also seek to regulate the *saisie-contrefaçon* within reasonable limits and also to set up guarantees for the defendant.

In the event that it finally appears the *saisie-contrefaçon* was abusive, sanctions are imposed. And these sanctions can be severe, as in the present case.

[Original French decision.](#)

[English translation .](#)

**Author: Nicolas Bouche, Head Legal Research and Literature, Véron & Associés, Paris, France**

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