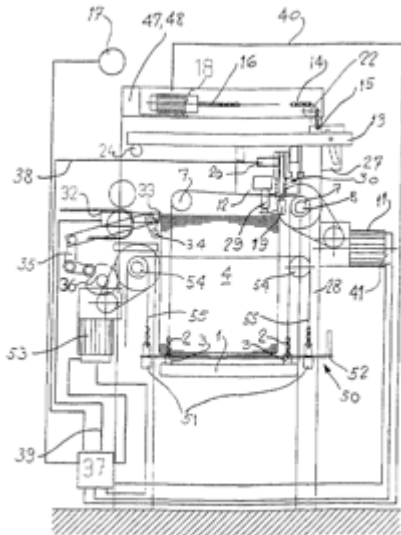


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The gathering of evidence abroad in support of French infringement proceedings

Pierre Véron (Véron & Associés) · Tuesday, October 11th, 2011

The Swiss company Bobst (hereinafter referred to as “Bobst”) is the holder of European patent No. 1 170 228 relating to a “*device for controlling the means for feeding sheets in a machine*”.



After having had a *saisie-contrefaçon* carried out on 17 December 2007 in Fellmann Cartonages’ premises in Soultz, in Haut Rhin (French administrative division), Bobst served a summons before the *Tribunal de Grande Instance* of Paris for infringement upon the German company Heidelberg Postpress Deutschland (hereinafter referred to as “Heidelberg Postpress”) for having marketed in France a machine reproducing the characteristics of claims 1 and 3 of its patent.

The *Tribunal de Grande Instance* of Paris, in a judgment handed down on 27 May 2009, dismissed in particular the arguments in support of the invalidity of the *saisie-contrefaçon*, the arguments on the invalidity of claims 1 and 3 and held the existence of the alleged infringement. Consequently, the *Tribunal* enjoined Heidelberg Postpress, under penalty, from continuing the marketing of the machine in dispute, ordered expert investigations to assess the damage and ordered the defendant to pay to Bobst, in addition to compensation in the amount of €50,000, an interim payment of €200,000.

Heidelberg Postpress then lodged an appeal against this decision.

In support of its appeal, Heidelberg Postpress invoked in particular its arguments in support of the invalidity of the *saisie-contrefaçon* (I), as developed before the *Tribunal*, and tried to dispute the materiality of the alleged infringement requesting the Cour d'Appel to hold invalid a *saisie conservatoire* ordered by a Dutch Judge and carried out in the Netherlands where had finally been transported the machine subject of the French *saisie-contrefaçon* (II).

I) The French *saisie-contrefaçon*

Heidelberg Postpress alleged that the *saisie-contrefaçon* has to be held invalid because it has been requested by Bobst on the basis of two patents one of which, subsequently held invalid, must be considered as having never existed. That would be likely, according to Heidelberg Postpress, to retroactively deprive the *saisie-contrefaçon* of all valid basis, the fact that the second patent remains being of no consequence since the *saisie-contrefaçon*, initially based on the two titles, should be held indivisible.

The *Cour d'Appel* of Paris did not follow this reasoning and decided that the *saisie-contrefaçon*, duly carried out on the basis of two titles which were valid at the time, remains valid despite the subsequent invalidity of one of the two invoked patents since it remains based on the other patent which is still valid and in respect of which it is not disputed that Bobst's action for infringement was admissible.

The *Cour d'Appel* of Paris merely extends by analogy an idea that the French case law already had the opportunity to develop in relation to other intellectual property rights: when the *saisie-contrefaçon* is requested and carried out on the basis of two different intellectual property rights, the *saisie-contrefaçon* report remains useful as a means of evidence insofar as it remains valid with regard to one of these two titles at least.

The French case law had already had the opportunity to develop such an idea with regard to copyright and design right. Because of the French theory of “*unity of art*” (the refusal to make any distinction between “*pure art*” and “*industrial art*”), taken from the work of the French author Eugène Pouillet, which is absolute in French law, a same aesthetic creation applied to industry can be protected cumulatively by copyright and design right. As regards the *saisie-contrefaçon*, it follows that it is possible (and even recommended as we shall see) to request from the civil court having jurisdiction the *saisie-contrefaçon* order not only on the basis of the copyright (which results from the mere fact of the creation of the original work) but also on the basis of the design right (granted on registration). However there is a great difference between these two *saisies-contrefaçon*. The *saisie-contrefaçon* carried out on the basis of a design right will be void if it is not followed by the initiation by the claimant of an action on the merits before the court having jurisdiction within a certain time limit. On the contrary, the *saisie-contrefaçon* carried out on the basis of a copyright remains valid even if it is not followed by such an action on the merits. And many times, the French courts have decided, in cases where the time limit to commence proceedings, as legally required, had not been respected, that the *saisie-contrefaçon* ordered and carried out on the double basis of copyright and industrial design right continued to be a valid means of evidence because copyright law does not require such an action on the merits (CA Paris, 6 July 1994, PIBD 1994, No. 577, III, 586; TGI Paris, 12 June 1996, PIBD 1996, No. 618, III, 506). In other words, even if the *saisie-contrefaçon* report would be deprived of validity with regard to design law, it nevertheless remained valid thanks to the other intellectual property right on the basis of which it had also been established, the copyright.

The problem thus solved by this French case law in literary and artistic property is very similar to the problem addressed by the *Cour d'Appel* of Paris in the present case. The loss of validity of the *saisie-contrefaçon* report with regard to only one of the intellectual property right on the basis of which it was established (two different patents) does not bring into question its usefulness as a means of evidence if it can still be valid with regard to the other intellectual property right. And we can only approve of the *Cour d'Appel* for having adopted such reasoning and for having set such a valuable precedent. To our knowledge, no French court had ever had the opportunity to rule on this issue in patent law.

II) The Dutch *saisie conservatoire*

The machine (of more than 35 tons) alleged to reproduce the characteristics of claims 1 and 3 of the European patent of Bobst and which has precisely been the subject of the French *saisie-contrefaçon* mentioned above, had been subsequently moved to the Netherlands. Bobst had then obtained from the Dutch Judge the authorisation to carry out a *saisie conservatoire* in this country. And thanks to this *saisie conservatoire* Bobst had obviously obtained some documents that it intended to use before the French court as evidence of the materiality of the alleged infringement (this *saisie conservatoire* was particularly useful in that it demonstrated that the alleged infringing machine was equipped with a sensor similar by its nature and function to the sensor described in claim 1 of the European patent).

Heidelberg Postpress did not request that the *Cour d'Appel* exclude from the discussion these documents but requested that the *Cour d'Appel* hold invalid this *saisie conservatoire* which, according to it, the Dutch Judge had no jurisdiction to authorise since this operation, which was merely the continuation of the *saisie-contrefaçon* of 17 December 2007, could only be ordered by the Presiding Judge of the *Cour d'Appel*, before which this dispute was referred to, pursuant to Regulation EC No. 1206/2001 relating to the cooperation between the courts of the Member States in the taking of evidence in civil or commercial matters.

The *Cour d'Appel* of Paris dismisses this request of Heidelberg Postpress by questioning the fact that it has jurisdiction to hold invalid the decision rendered by a foreign court, and above all by deciding, against the arguments of Heidelberg Postpress, that Regulation EC No. 1206/2001 “*the object of which (Article 1 Scope) is to provide, with the sole purpose of facilitating the taking of evidence, that it should be possible for the Judge of a Member State to request ‘a) the competent court of another Member State to take evidence; or b) to take evidence directly in another Member State’*, does not result in prohibiting the concerned party from performing itself all taking of evidence which it considers useful to assert its rights in a foreign State pursuant to the law applying in that State”.

We should first approve the court to have decided that it obviously does not have the power to hold invalid a decision rendered by a foreign court. Beyond the Dutch *saisie conservatoire* and the documents resulting from it, it was the Dutch Judge’s decision that the German company asked the French Judge to appreciate on the specific issue of the international jurisdiction of this Dutch court. But the only reasonable possibility for a French court with regard to a foreign decision is to accept or refuse it to produce effects in France but in no way to appreciate the validity of this decision rendered by a foreign judicial system.

The other aspect of the decision is particularly interesting because it addresses a serious and tricky issue for both the French judges and the judges of any other country of the European Union (except

Denmark) which are bound by the Regulation EC No. 1206/2001.

Does the system of judicial cooperation established by this Regulation now prohibit the direct referral to the judge of another Member State, where evidence are located, asking for measures provided for in its law? In other words, is the system of judicial cooperation of the Regulation exclusive or not? Yes, argued Heidelberg Postpress. No, replied the Cour d'Appel of Paris in this decision of 29 June 2011.

The issue is complex and this cannot be discussed in detail in this post but we should finally note that some authors have considered this issue and have expressed divergent opinions.

Two authors (A. Nuyts, "Le règlement communautaire sur l'obtention des preuves : un instrument exclusif ?", *Rev. crit. DIP* 2007; L. Demeyre, "Commercial litigating in the European Union. A changing landscape", *RDAl/IBLJ*, 2008, No. 4, p. 481 et seq., p. 494-495, 504-505) have considered this issue having regard to the ECJ's decision *St Paul Dairy* (ECJ, 28 April 2005, *St Paul Dairy Industries*, case C-104/03, ECR 2005, I-03481, *Rev. crit. DIP* 2005, p. 742, note Pataut). And one of them gave the following answer: it should be possible to put aside the mechanisms of the Regulation and to directly refer to the Judge of another Member State, where evidence are located, asking for measures provided in its law, provided that it has been demonstrated that the European procedure of taking evidence on the initiative of the court having jurisdiction on the merits would be ineffective or insufficient to protect the interests of individuals (A. Nuyts, p. 83).

According to this author, the principle would be contrary to that adopted by the *Cour d'Appel* of Paris on 29 June 2011. In principle, the system of the Regulation would have priority. And it would be only exceptionally possible to circumvent it, by requesting directly the foreign judge for the taking of evidence according to its national law, because of the ineffectiveness or failure of this system of judicial cooperation of the European Union.

Three opposite opinions are given which are in line with the *Cour d'Appel* of Paris. Regulation EC No 1206/2001 is not exclusive and would not prohibit an individual to directly refer to a foreign court in order to take evidence according to its local law (D. Lebeau et M.L. Niboyet, "Regards croisés du processualiste et de l'internationaliste sur le règlement CE du 28 mai 2001 relatif à l'obtention des preuves civiles à l'étranger", *Gaz. Pal.* 20 February 2003, No. 51, p. 6-19, note 19; A. Mourre, *Droit judiciaire privé européen des affaires*, Bruylant 2003, No. 787, p. 426 ; Y. Le Berre et E. Pataut, "La recherche de preuves en France au soutien de procédures étrangères au fond", *RDAl/IBLJ*, 2004, No. 1, p. 53 et seq., p. 65-66).

[Original French decision.](#)

[English translation .](#)

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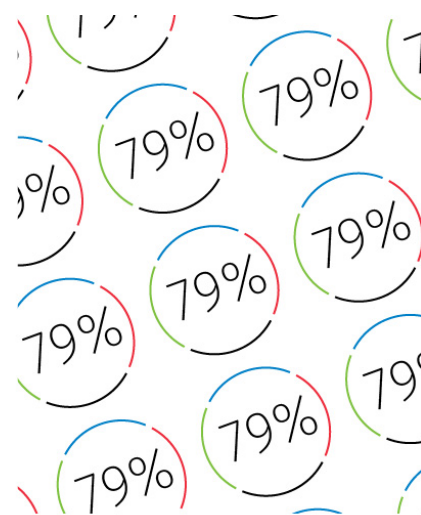
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