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A saisie-contrefaçon is not a fishing expedition

Pierre Véron (Véron & Associés) · Wednesday, March 13th, 2013

The French *saisie-contrefaçon* is known to be an extremely powerful and effective tool to collect evidence of infringement of a patent (as of any other intellectual property right, see “Saisie-contrefaçon” on Wikipedia and also P. Véron *et alii*, *Saisie-contrefaçon*, Paris, Dalloz Action, 3rd ed. 2013-2014). It is a procedure that allows to request and obtain from the Presiding Judge of the *tribunal de grande instance de Paris*, an order authorizing the patentee to send a bailiff in order to make a descriptive seizure (which consists in a description by the bailiff’s report of infringing objects and of all facts that could prove the infringement) or physical seizure (where samples of the products alleged to be infringing are seized by the bailiff)(see also [a 15-minute film providing a brief introduction to the practical aspects of the French *saisie-contrefaçon*](#)).

The *saisie-contrefaçon* is effective because it is an *ex-parte* procedure. The defendant is not informed of the *saisie-contrefaçon* prior to it being carried out and, consequently, has not the possibility to move or remove the evidence of its infringing activity. In addition, it is not required to provide evidence of infringement in order to obtain a *saisie-contrefaçon* order. It is also powerful because the judge authorizes the bailiff to enter the premises of the defendant or even of any third party (when pieces of evidence of infringement are likely to be there), regardless of whether they are normally open to public or not, in order to carry out the *saisie-contrefaçon*.

However, this efficiency and power may be seen as possible sources of abuse. Some fear that the *saisie-contrefaçon* might permit “*fishing expeditions*” where the patentee, using the alleged infringement of his intellectual property right as a pretext, enters the premises of a competitor and discovers some of its trade secrets.

In fact, the *saisie-contrefaçon* is not so dangerous since there are some control mechanisms. All the articles of the French Intellectual Property Code (IPC) relating to *saisie-contrefaçon* provide that the judge may condition the implementation of the measures it ordered to the furnishing by the claimant of security to ensure, if necessary, the defendant’s compensation if the infringement action is subsequently held unfounded or the seizure is cancelled. These articles also provide mechanisms for maintaining the confidentiality of the seized documents. But the *saisie-contrefaçon* is also controlled by the courts which make sure that the *saisie-contrefaçon* does not leave the limits set by the order of the President and punish any abuse. This last point is confirmed by a 12 February 2013 decision of the French *Cour de cassation*. The bailiff’s *saisie-contrefaçon* report was partially cancelled in proportion to the abuse committed by the bailiff, and the patentee was obliged to compensate the damage suffered by the defendant because of this abuse.

Vetrotech Saint-Gobain International (hereinafter referred to as Vetrotech) is the holder of European patent No. 0 620 781 entitled “*Light-transparent heat-protection element*“. Suspecting the company Interfer sécurité (hereinafter referred to as Interfer) to manufacture and market in France the glass obtained by using an infringing process, Vetrotech requested and obtained from the Presiding Judge of the *tribunal de grande instance de Strasbourg* the authorisation to carry out a *saisie-contrefaçon* at Interfer’s headquarters.

However this *saisie-contrefaçon* was problematic because the officiating bailiff asked many questions to Interfer’s members about the process that the company was implementing to manufacture its products. The lower courts (*tribunal de grande instance de Paris*, 12 July 2006 and *cour d’appel de Paris* 16 February 2007) then pointed out that if the bailiff is granted the power to ask questions in the context of the *saisie-contrefaçon*, it may be only questions “*necessary for the accomplishment of his mission*” *i.e.* strictly necessary for the carrying out of the descriptive or physical seizure. The *saisie-contrefaçon* order does not give the bailiff or any person accompanying him investigative powers. The bailiff is not allowed to ask any question and, in the present case, questions about the process of Interfer.

Thus, the bailiff’s *saisie-contrefaçon* report was canceled on the grounds that the bailiff by asking these problematic questions had not complied with the *saisie-contrefaçon* order. But this cancellation was partial, limited to those parts of the report which were related to the problematic questions. The rest of the report remained valid and the items and documents regularly seized on this occasion were given back to Vetrotech.

Vetrotech was then able to bring an action for infringement against Interfer. However, this action was dismissed (*cour d’appel de Paris*, 22 June 2011), the alleged infringement has not been recognized, and Vetrotech was even ordered to pay Interfer a certain sum as damages for abuse of process. Vetrotech then lodged an appeal against this decision before the *Cour de cassation*.

Vetrotech essentially developed two arguments against the 22 June 2011 decision.

Firstly, Vetrotech criticized this decision for having deduced from the cancellation of the *saisie-contrefaçon* report, by decision of 16 February 2007, that Vetrotech could not use the written note given to the bailiff during the *saisie* by the Interfer’s administrative and financial director. Vetrotech argued that this note was not one of the “*statements induced by the twenty-four questions from the officiating bailiff who acted beyond his powers*” the removal of which had been ordered, but rather one of the “*seized items and documents*” which had been ordered to be given back to Vetrotech. According to Vetrotech, by refusing to take account of the written note, the *cour d’appel* thus ignored the *res judicata* of the 16 February 2007 decision.

The *Cour de cassation* rejected this argument. It notes that the 16 February 2007 decision had not said that the note in question was one of the “*seized items and documents*”, which were to be given back to Vetrotech. On the contrary, by ordering the removal of the statements induced by the questions asked by the bailiff who acted beyond his powers, the *cour d’appel* had necessarily referred to this written note, because it was precisely a statement given in response to one of these questions unduly asked by the bailiff.

Secondly, Vetrotech criticized the *cour d’appel* for having ordered it to pay Interfer a certain sum as damages for abuse of process, without really establishing the abuse allegedly committed by Vetrotech, and not the bailiff, in the carrying out of the *saisie-contrefaçon*, which had been only

partially canceled and validated for the rest.

The *Cour de cassation* also rejected this argument on the grounds that the *cour d'appel* had precisely identified a fault committed by Vetrotech: it had unduly obtained information on the manufacturing processes of a direct competitor on the occasion of the questions asked by the bailiff who acted beyond his powers.

Thus, a patentee must give up hope of benefiting from an abusive *saisie-contrefaçon*. Not only the *saisie-contrefaçon* is void, in whole or in part, in proportion to the abuse. But if the patentee obtains information to which he would normally not have access, he commits a fault and has to compensate the damage suffered by the defendant.

Original French decision.

English translation .

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