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France: Upset in practice of the seizure: withdrawal of the seizure order due to lack of impartiality of the patent attorneys

Francois Pochart (August Debouzy) · Wednesday, August 15th, 2018

On March 27th, 2018, the Court of Appeal of Paris issued a decision on withdrawal of the seizure order on the grounds that the principle of impartiality had been violated since the patent attorneys (“CPIs”) assisting the bailiff wrote a report on the probability of the infringement annexed at the seizure request.

It will thus be advisable to rely on a patent attorney which did not know the case at all in order to practice a seizure without taking the risk of a withdrawal of the order.

The French Supreme Court ruled on the debate regarding the patent attorneys’ independence when they assisted the bailiff during the seizure[1]. They finally considered that the profession of an IP attorney, as an independent profession, provided sufficient guarantees which allows an IP attorney, even the usual IP attorney of the seizing party, to assist the bailiff during the seizure. In the present case, the question that arises is the impartiality of the patent attorney regarding the seizing party.

By summons dated June 23, 2017, MANITOU BF (so-called “MANITOU”) requested the withdrawal of the seizure order of June 2, 2017 rendered at the request of JC BAMFORD EXCAVATORS Limited (so-called “JC BAMFORD”). MANITOU claimed that the request was presented unfairly since the patent attorneys designated to assist the bailiff were not impartial on the basis of article 6-1 of the Convention for the Protection of Human Rights and Fundamental Freedoms (ECHR) and Article 9 of the Code of Civil Procedure. According to MANITOU, the drafting of a private expert report – describing the characteristics of the allegedly infringing material – filed as supporting evidence for obtaining the seizure, by two patent attorneys designated for the seizure, suggested that the seizure will not be executed with impartiality. More specifically, in the case at stake, the expert report of patent attorneys has been drafted one month before the seizure, in the presence of the employees of the seizing party, on their site and with the means and assistance of the seizing party.

By an interim order of withdrawal of 5 October 2017, the Judge rejected the request of withdrawal of MANITOU since “*the industrial property attorneys, because of their ethics code of conduct, even if they are the usual counsel of the seizing party, are authorized to attend the seizure operations*”[2]. The Judge found that the unfair nature of the request for the seizure had not been demonstrated.

However, the Paris Court of Appeal overturned the above-mentioned order for interim relief on the

grounds that *“irrespective of their status, which imposes on them ethics obligations, patent attorneys cannot, without necessarily being violating the principle of impartiality required by Article 6 of the [ECHR], to be appointed as experts by the judicial authority whereas they had previously acted as experts on behalf of one of the parties in the same case”*[3]. The Paris Court of Appeal has thus withdrawn the entire interim order of June 2nd, 2017.

The decision of the Court was appealed. We will see if the French Supreme Court will follow the reasoning initiated by the Court of Appeal regarding the lack of impartiality of the patent attorneys who previously acted as experts in the context of the seizure.

The scope of this decision could be moderated since, in this case, several factual arguments on the drafting conditions of the expert report with the assistance of the seizing party were raised as reported above. In this context, if the patent attorney who prepared a preliminary report for the seizing party had access to some information about the alleged infringing material may not be considered impartial, we may ask ourselves what the measure of impartiality should be. The decision of the Court of Appeal does not set a clear limit on this point; it does of course reiterate that patent attorneys are independent and from that point of view are allowed to assist during seizures.

Therefore, in order to avoid withdrawal of a seizure order, the seizing party will not refer in its request to a patent attorney who intervened previously as an expert in the same case, e.g. as an expert having participated in a private expert report filed as supporting evidence for obtaining the seizure as in the present case. The risk would be the characterization of the impartiality of the designated patent attorney and, correspondingly, the possible withdrawal of the seizure order. Whether this position would extend to any type of private expertise is unknown; hopefully the Supreme Court will provide guidance.

We would recommend to use a patent attorney who had no relationship with the seizing party beforehand for assisting during seizures.

[1] French Supreme Court, Commercial chamber, 8 March 2005, appeal No. 03-15871

[2] Court of first instance of Paris, 3rd chamber, 4th section, interim order of withdrawal of 5 October 2017, Manitou vs. Bramford, docket No. 17/08818, page 8

[3] Court of appeal of Paris, Pole 5, Chamber 1, 27 March 2018, Manitou vs. Bramford, docket No. 17/18710, page 9

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This entry was posted on Wednesday, August 15th, 2018 at 10:05 am and is filed under [France](#), [Infringement](#)

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