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UPC “saisie-contrefaçon” Part I: the texts

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The “*saisie-contrefaçon*“, that French-style “Anton Piller Order”, but obtained in the blink of an eye, to such an extent that the whole world is still in awe; our Marilyn of French patent law has made her discreet entry into the JUB. It may come as a surprise to the reader that I use the expression “*saisie-contrefaçon*“, when the UPCA text specifically provides for measures to preserve evidence. But never mind, I’m not afraid of being branded an irreducible Gallic, I’m used to it and, after all, “*saisie-contrefaçon*” is a pot I fell into when I was “little”.

It must be admitted, however, that behind the new terms lies a procedure whose philosophy is diametrically opposed to that of French seizure. Indeed, evidence preservation measures (or *saisie-contrefaçon*) before the new jurisdiction have raised and continue to raise questions, particularly, strangely enough, for those who, like yours truly, like to practice it assiduously. I will therefore devote a series of posts to explaining this new system (**UPC “saisie” Papers Series**), starting today with some comments of the texts.

As a reminder, under French law, a applicant can obtain a “*saisie-contrefaçon*” order on request (i.e., *ex parte*), which can then be enforced on the seized party’s premises at any time. The Bailiff will generally be authorized to describe and seize products and will be accompanied by a Patent Attorney (who may be that of the seizing party) and a computer expert, who will be tasked with carrying out searches on the seized party’s computers.

It’s worth noting that the French *saisie-contrefaçon* procedure is designed to provide evidence, which explains why, in principle, proof of title alone (e.g., the patent) should be sufficient to obtain an order. However, for several years now, since Directive 2004/48, the courts have also been requiring “*reasonably accessible evidence*” (art. 7 of the Directive). It is a demonstration of the famous requirement of the principle of proportionality: the measures granted to the applicant should not exceed the scope of his right and unreasonably prejudice the seized right. Without going into detail on the subject, I would simply like to point out that I remain dubious about this solution (from a fundamental point of view): the right of ownership is the basis of the applicant’s prerogative, and the purpose of this prerogative is probative. Here, we are asked to provide hints of infringement, which in practice could be confused with proving anything. Moreover, the French legislator has not transposed this part of the directive. Jurisprudence has had to come to terms with ill-conceived texts, because even if proof of the right justifies seizure, the fact remains that the seizer must not abuse his right: *abusus* is the exhaustion of one’s right, not abusing it for a purpose that is not one’s own. In other words, it would be more appropriate to provide for an adjustment of the measures in the texts, as the UPCA does in article 62.2, although we shall see that the

decoupling eligibility of the request (60.1 with the hints) with the balance of interests (62.2) should not be read independently of each other. But then again, that's not the point here, even if we will see it is, in fine, interesting when we look at the way the texts are applied. At the end, the fact remains that orders are almost systematically granted by French judges, often adjusted (in terms of the scope of the measures), effectively enforced, and often contested (on the pretext of trade secrets protection). Nevertheless, the applicant is obliged to bring an action on the merits within one month (31 civil days) or 20 working days (whichever delay is the longer) of the operation. A recourse against the order itself is possible and is used more often now that it is essential to maintain seals which may have been affixed during the seizure (under the pretext of protecting trade-secrets protection).

Let's return to our "UPC saisie". It is mentioned in article 60 of the UPCA. Already, its first paragraph is directly in line with the difficulty raised above and since settled (in its own way) by French case law: reasonably accessible evidence is required. In short, there's nothing surprising here: we're in line with European Union law. As in French law, measures may include detailed description, with or without taking samples, or physical seizure of the contested products and related documents (art. 60.2). An appeal is available to the seized party (art. 60.6). It is also worth noting that, as in the old French law, this recourse is not mandatory to protect trade-secrets, and that the applicant may from the outset provide for the setting up of a confidentiality circle to sort out the situation after the operations.

However, there are a number of differences: the claimant can base his claim not only on infringement, but also on imminent infringement (art. 60.1); the text indicates from the outset that the measures must be carried out subject to the protection of trade-secrets (although the procedure for its protection is not expressly provided for as in French law) (art. 60.1); a security may be required from the patentee (art. 60.7).

But these are not the most striking differences. Three stand out.

Firstly, article 60.5: "*Measures shall be ordered, if necessary without the other party having been heard, in particular where any delay is likely to cause irreparable harm to the proprietor of the patent, or where there is a demonstrable risk of evidence being destroyed*". This text is bound to be of interest to the French jurist. Indeed, you must read between the lines, but it is clearly implied here that measures will only be ordered *ex parte* (i.e., "*without the other party being heard*"), notably if there is a risk of irreparable harm to the patentee or if evidence could be destroyed. Rule 194 d) specifies that the court will then consider urgency, the apparent basis for the measures invoked and the likelihood of destruction of the documents. In other words, we are talking about an exception here, i.e., if there are no specific conditions such as the one mentioned, an order would have to be made *inter partes*. In short, we would potentially lose the main advantage of the "*saisie-contrefaçon*": the element of surprise. Let's be clear: a *saisie-contrefaçon* without the element of surprise is like a gift-wrapped package with nothing inside it's a pretty order with no future. However, the rules of procedure (rule 194.5) provide that the applicant may withdraw his application without the defendant being informed if the *ex-parte* application is unsuccessful. Despite rule 194.5, there is a clear inversion of principles here: the *ex parte* principle becomes the exception, derogation from this principle must be justified, and even then, the application can be rejected. When you consider the amount of time required to prepare a large-scale seizure, this can be discouraging.

Secondly, a representative of the applicant may be present on site (art. 60.4), in addition to an

expert (60.3). In short, instead of an industrial property attorney accompanying the bailiff, as is the case in France, we will have most of the time two people with the bailiff, in principle also industrial property attorneys, but it is not out of the question for the applicant's representative to also be a lawyer, which has been impossible until now under French law. A team with one bailiff and one representative is possible, but not plausible according to the logic of the system. Thus, in fact, in addition to the increase in seizure costs represented by the multiplication of participants, we can also foresee that a debate between experts could already take place during the seizure, which should not be the place for it, and the result would inevitably suffer in terms of evidence. It should be remembered, however, that in principle, the seizure is carried out by the bailiff, who takes note of the facts, and is not supposed to transform his report into a contradictory expert report. The most obvious risk is that the expert will take the Bailiff's place, and that the Bailiff will no longer carry out the measurements, whereas it is his capacity as a ministerial officer that enables the order to be enforced. Moreover, French case law is consistent on this point: a patent attorney should only accompany the Bailiff to help him, but must not replace him and carry out the operations.

Thirdly, article 62 sets out the measures that may be granted, specifying that the court must take account of the interests of the parties: in other words, it is an application of the criterion of the proportionality of measures through the balancing of the interests involved. In this way, proportionality operates in two stages: there must be reasonable evidence (art. 60.1) and the measures must be proportional to the interests of the parties involved (art. 62.2). The only difficulty here is that it must be clearly understood that this balance can only be correctly applied in the light of the probability of the infringement, and therefore of the evidence provided. However, with this two-stage system, the text could result in a low threshold for 60.1 (few indicia) and a necessarily misleading threshold for 62.2, since the indicia are likely to be virtually non-existent: we shall see that this is unsurprisingly what emerges from the initial case law.

At the end of the day "UPC saisie" should be more expensive: request with more explanations, possible inter-partes debate despite these explanations (or no debate but costs spent for nothing), appointment of an expert in addition to the Bailiff and a potentially party's representative. All this for an a priori less efficient result: the Bailiff could be caught between two experts, if a party representative is appointed (one of whom is supposed to be neutral); it would not be surprising for the Bailiff to find disagreements between them (even if we can't ignore and hope that, conversely, they work in concert) ; the absence of a procedure for the protection of trade secrets leads to the systematic use of a confidentiality circle (which also constitutes additional costs by the way) and inevitably subjects all seized items to said circles (even when there is no reason to consider that they constitute trade secrets).

A clear impression emerges from a mere reading of the texts: the evidence preservation measures provided for by the UPC are not based on the same philosophy as the French *saisie-contrefaçon*. The latter, despite the restrictions imposed by the judges, remains particularly aggressive, and therefore pro-patent. Once again, it was designed with this in mind: it is a prerogative of the right-holder, otherwise deriving from his or her right, without him or her having in principle to demonstrate any indication of infringement. On the other hand, the measures envisaged by the UPC, while commendable, follow a different logic: that of the mistrust inspired by the seizure of counterfeit goods abroad. And it's a safe bet that, for some time to come, these measures will be required mainly countries who were already familiar with a seizure system (e.g., France or Italy). This has already been demonstrated by the first decisions, which I will comment on in my next posts...

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