

# Kluwer Patent Blog

## Is saisie-contrefaçon dead? Long live saisie-contrefaçon?

Matthieu Dhenne (Dhenne Avocats) · Tuesday, October 22nd, 2024

The king is dead! Long live the king! An expression traditionally uttered at the death of a monarch to acclaim a new king on the death of his predecessor. Could it be applied to our traditional French *saisie-contrefaçon* at the advent of *saisie-contrefaçon* before the UPC?

This question came to mind last week during a trip to Munich, which gave me the opportunity to attend a *Global Patent Litigation* seminar organized by Forum (whom I would like to thank for the invitation, by the way). As regular readers of the blog know, the (essential) topic covered was one of my favorites: obtaining evidence in global patent litigations.

I was, to tell the truth, a little surprised to hear so much praise for the French *saisie-contrefaçon*, particularly from directors of foreign legal departments. Not that I was that surprised. To the contrary, I'm always in favor of seizures because I know how successful they can be (which also explains why I've carried out around thirty ones over the last three years). Nevertheless, in recent years I've had the strange feeling that I'm one of those diehard Gauls who still defend the queen of evidence-gathering methods. And this queen is often preceded by her reputation outside France. However, it is becoming less popular, mainly for two reasons: it is more complex than it used to be and, recently, it has had to face competition from its daughter, the UPC *saisie*.

Regarding the increasing complexity of the French seizure process, it is undeniable that the seizing party is faced with more challenges than in the past. Indeed, the application of the principle of proportionality (stemming from European Union law) by Courts now implies providing reasonable evidence of infringement (in other words, a sort of plausibility of infringement). However, the "plausibility" threshold is particularly low and only affects the scope of the measures and not the granting of the order, which is systematically granted. In addition, since the transposition of the 2016 directive on trade secrets, the seizure orders are regularly challenged to protect trade secrets seals. Eventually, the result is a growing number of seizures challenges, independently of challenges to the validity of the seizure report in the main proceedings.

However, despite these changes, make no mistake about it, the effectiveness of this procedure has not been affected: the authorized measures (including inspection by the bailiff assisted by the usual patent attorney of the seizing party, or the search into computer systems by an IT expert), the possibility of recovering financial data (which motivates more than one seizure), the surprise effect (since it is an *ex parte* procedure), and, it must be admitted, the total lack of preparation on the part of the seized companies for such an intervention are all keys to an almost inevitable success, or at any rate a source of certain damage for the target, both material and reputational (for the general

public, seizure-counterfeiting means counterfeiting, which is a very bad sign for the market).

Thus, my experience has taught me in particular that orders are systematically granted by the French judge (for my part, this was even the case on the basis of an unpublished patent application...), that, on the other hand, the scope of the measures may be adjusted depending on the reasonable evidence of infringement that orders are often subsequently challenged (in particular because since 2019, with the transposition of the directive on trade secrets, the maintenance of seals affixed during operations to protect so-called secrets requires the seized party to take action within one month of the seizure, otherwise the seals lapse automatically), and the vast majority of seized parties are not prepared for such an intervention, which can be very damaging (which is why I now systematically offer my clients preventive support).

Since the advent of UPC, a new challenge has arisen for our French seizure: seizure before UPC. Such a seizure has the advantage of preparing an action before UPC. That said, it is an *inter partes* system, *in principle*, since for the time being only two seizures have been subject to an *inter partes* discussion, especially since the seizing party can withdraw his application as soon as the judge warns him that he wants an *inter partes* discussion. In any event, this system also seems interesting, even if I can only advise (at least for the time being) that these applications be submitted to the judges who are used to it and who are undoubtedly more open to this particularly aggressive procedure, i.e. the French judges sitting in the Paris division of UPC.

I was somewhat comforted last Thursday and pleased to hear so much praise for my beloved seizure, and it seems to me that it still has a nice, long life ahead of it, whether at national level or before the UPC. In this regard, it should be born in mind that a national seizure, such as a French *saisie-contrefaçon*, may be preferred for transnational litigation, because one wants to use the evidence elsewhere in the world and it will be safer and less costly than a “UPC” seizure, or for benefiting from the assistance of the usual patent attorney of the seizing party during the *saisie*, or quite simply because France is the only or main territory where acts of infringement are committed. In short, with all these new strategies available to us, we can still exclaim: Long live *saisie-contrefaçon* (national or UPC)!

---

*To make sure you do not miss out on regular updates from the Kluwer Patent Blog, please [subscribe here](#).*

## Kluwer IP Law

The **2022 Future Ready Lawyer survey** showed that 79% of lawyers think that the importance of legal technology will increase for next year. With Kluwer IP Law you can navigate the increasingly global practice of IP law with specialized, local and cross-border information and tools from every preferred location. Are you, as an IP professional, ready for the future?

Learn how **Kluwer IP Law** can support you.

---

79% of the lawyers think that the importance of legal technology will increase for next year.

**Drive change with Kluwer IP Law.**

The master resource for Intellectual Property rights and registration.



2022 SURVEY REPORT  
The Wolters Kluwer Future Ready Lawyer  
Leading change

This entry was posted on Tuesday, October 22nd, 2024 at 10:40 am and is filed under [evidence](#), [France](#), [UPC](#)

You can follow any responses to this entry through the [Comments \(RSS\)](#) feed. You can leave a response, or [trackback](#) from your own site.