
MULTINATIONAL ACTIONS AND TACTICS
Benefiting from National Procedures

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1. The principles governing the obtaining of evidence in France

1.1 Discovery

1.1.1 No discovery process in France

A key difference between French and common law judicial systems lies in the evidentiary process.

There is no discovery process in France.

The whole procedure is carried out in writing without resorting to testimonies, interrogatories...

Each party decides which evidence is worth producing.

As a result, the plaintiff cannot ask the defendant to produce information relating to the infringing product or process.

Likewise, the alleged infringer cannot ask the plaintiff to produce prior art : he has to search himself for the information he needs to challenge the validity of the patent.

The use of witnesses or expert witnesses, interrogatories of parties are exceptional.

It is sometimes said that the measures of preliminary investigation are in the hands of the judge in France and in the hands of the parties in Anglo-Saxon countries. If the laws are studied with attention, it is ascertained that this is a somewhat academic view. In effect, in both systems, the judge has considerable power. For example, French law offers, in theory, the possibility for the judge to order forced communication of the documents. The difference lies solely in the use that the judges make of these laws in accordance with their legal culture.

1.1.2 The methods of investigation employed in France

The matter is investigated mainly by the exchange of Statements of Claims (Pleadings) and the communication by each party of the documents that it considers useful for the success of its cause. It may be question of technical reports by experts, but this is rather rare.

In theory, it is possible to request the judge to order the Opposing side to communicate a document that it holds; however, this document must be identified and its usefulness for the case must be established.

It is theoretically possible for the judge to make a personal investigation and verification, but he does this very rarely in practice.

1.2 *Saisie*, a powerful tool for obtaining evidence

To enable the plaintiff to collect the necessary material to prove infringement, the French Industrial Property Code (article L 615-5) provides the patentee with the infringement seizure ("*saisie-contrefaçon*").

This procedure, specific to French and Belgian law, is designed to obtain evidence of the infringement. The Court of Appeal of Paris defined this procedure in a judgement of 4th November 1992, as "*an exceptional procedure allowing the patentee, before any action at law with arguments on both sides, to enter the alleged infringer's premises, without its consent, in order to proceed with investigations, verifications, even actual saisies tending to bring evidence of an alleged infringement, without the party seized having the possibility of opposing the course of the saisie operations*".

Article L 615-5 organises *saisie* as follows :

" The owner of a patent application or the owner of a utility certificate application or the owner of a patent or of a utility certificate shall have the possibility of furnishing proof by any means whatsoever of the infringement of which he claims to be a victim.

He shall further be entitled, on an order given by the President of the First Instance Court of the place of the presumed infringement, to direct any bailiffs, accompanied by experts of his own choice, to proceed with a detailed description, with or without effective seizure, of the allegedly infringing articles or processes. Such order shall be provisionally enforced. It may be subjected to a security on the part of the plaintiff. In that same order, the President of the Court may authorise the bailiff to carry out any enquiry required to ascertain the origin, nature and scope of the infringement.

The same right shall be enjoyed by the licensee of an exclusive right of working under the conditions laid down in the second paragraph of Article L. 615-2 and in the fourth paragraph of Article L. 615-2, by the holder of a license of right, a compulsory license or an ex-officio license in accordance with Articles L. 613-10, L. 613-11, L. 613-15, L. 613-17 and L. 613-19."

If the petitioner fails to institute proceedings before a Court within a term of 15 days, the seizure shall automatically be void, without prejudice to any damages.

1.2.1 What is *saisie* ?

Saisie does not consist in an injunction. It mainly permits a visit of the alleged defendant's premises by a bailiff, ("*huissier*"), a public officer, whose statements are deemed authentic.

The public officer can be accompanied by a policeman, a patent agent chosen by the patentee, a photographer, an accountant or any other person whose skills may be useful (e.g. a computer expert if the *saisie* is directed toward information stored in a computerised information system).

The public officer writes down the description dictated by the patent agent of the infringing device.

He can take photos or video, if appropriate, look into the accountancy books, review the technical and commercial documents and make copies of the relevant documents.

The public officer can also buy samples.

1.2.2 How to get an order for a *saisie* ?

The *saisie* has to be authorised by the presiding Judge of the local Court of First Instance ("*Tribunal de Grande Instance*").

For this purpose, counsel for the patentee drafts and files a petition defining the exact scope of the authorisation requested.

Typically, the petition indicates :

- the persons authorised to assist the public officer (a policeman, a patent agent chosen by him, a photographer...),
- the acts the public officer is authorised to perform (to be shown a machine, accountancy books, technical and commercial documentation, to make copies of some documents, to operate a machine, to acquire some samples of the infringing product(s)...).

1.2.2.1 The filing of the petition is *ex parte*

The filing of the petition is *ex parte* in order to guarantee a maximum effect of surprise: in effect, it is only when the bailiff, accompanied by the person skilled in the art, enters the premises of the alleged infringer, that the latter takes cognisance of the Order of the Presiding Judge of the Court (worded at the request of the patent holder), allowing the seizure of infringing items. The order can allow the extent of the infringement to be measured, even if it is only later that the damages will be assessed.

Exceptionally, the Judge restrict the terms of the petition, for example by adding that the *saisie* has to be carried out by a given date, or conditioning his authorisation upon the deposit of a bond by the petitioner.

But, usually, when the terms of the requested order appear reasonable, the Judge does not modify the petition.

1.2.2.2 Guarantees for the alleged infringer

In return for the unilateral nature of the procedure, the legislator has provided a certain number of guarantees for the alleged infringer.

It is possible, in the event of difficulty, to refer to the judge.

A second guarantee exists: an action for liability in the event of abusive *saisie*. In effect, if the *saisie* was initiated with the sole aim of harassing the alleged infringer or when it was carried out under circumstances prejudicial for the seized party, the seizing party's liability may be involved.

The seizure of infringing items must always be followed by a writ of summons for infringement within a period of 15 days. Failure to serve summons within 15 days causes the nullity of the *saisie* and the evidence thus found is lost.

1.2.3 Protection of confidential information

It happens that the defendant objects to the copy of documents alleged to be confidential.

In most cases, the dispute is solved by the appointment by the Court of an expert who is commissioned to listen to the parties and to sort out which documents (even confidential) are necessary to prove the infringement and which are not.

RHONE POULENC AGROCHIMIE (RPA) -v- MONSANTO France Lyon Civil Court (Tribunal de Grande Instance), May 11, 1998

RPA (now AVENTIS CROPSCIENCE) owns patents relating to genetic modifications of plants to make it resistant to the herbicide known as glyphosate.

MONSANTO, which developed a variety of genetically modified corn falling within the claims of the patents, was subject to a *saisie* and to an action for infringement of patent by RPA.

During the *saisie*, MONSANTO requested that confidential papers be put into sealed envelopes and that RPA could not gain access to these documents.

RPA then asked the Court to appoint an expert in order to determine which of the seized documents were necessary to bring evidence of the infringement.

MONSANTO opposed to the request for various reasons, the main one being that the accused activity was immune from infringement because it was experimental use.

The Court said that such defence was to be assessed in the course of the proceedings on the merits and appointed an expert in order to determine which documents were necessary to prove the infringement.

2. Can information obtained through procedures in one country be exported in another country?

A *saisie* is usually performed on the basis of a French patent.

Can a *saisie* be ordered in foreign countries to obtain evidence of infringement of a French patent ?

Conversely, is it permitted to use the papers obtained through a French *saisie* in parallel litigation in foreign countries ?

2.1 A *saisie* can be ordered in foreign countries in order to prove the infringement of a French patent

ARMOSIG v. BERNHARDT

Lille Civil Court (Tribunal de Grande Instance), June 4, 1980

With reference to article 24 of the Brussels Convention, the Court held valid a *saisie* ordered in Belgium on the basis of a French patent according to Belgium proceedings rules, under a Belgium *saisie* order.

SANAC v. VARIANTSYSTEMET

Belgium Court of Cassation, September 3, 1999

In this case, the Belgian Court of Cassation held that *saisie* can be ordered in Belgium even when the applicant does not have a patent in Belgium.

The Court held that Article 1481 of the Belgian Judicial Code and Article 24 of the Brussels Convention allow for *saisie* description proceedings based on a foreign patent.

In particular, the Court said that "*Article 1481 Jud. Code concerns a provisional and merely protective measure; Pursuant to Article 24 of the Brussels Convention a Belgian judge may grant provisional measures, and thus apply Article 1471 Jud. Code, even if the courts of another state have jurisdiction as to the substance of the matter.*"

2.2 In principle, information obtained in a French *saisie* may be used in a foreign litigation

RHONE POULENC RORER (RPR) v. BRISTOL MYERS SQUIBB (BMS) **Paris Civil Court (Tribunal de Grande Instance), September 30, 1998**

RPR, now AVENTIS PHARMA, owns a patent relating to "*a preparation process of Taxol*", a major anti cancer drug.

BMS, which marketed a drug allegedly infringing RPR's patent, was subject to *saisie* and to an action of infringement of patent by RPR.

BMS requested that the seized papers (marketing authorisation files) could not be used by RPR.

RPR asked the Court the authorisation to use those seized documents in all countries.

The Paris Court said that it has not to rule preventively on this issue and added that RPR was free to use the documents, subject to an action on the merits for improper use.

This decision can be interpreted as meaning that an information obtained in a French *saisie* may be used in a foreign litigation.

SEARLE & CO and MONSANTO -v- LABORATOIRES MERCK SHARP & DOHME-CHIBRET and MERCK FROSST CANADA

Paris Civil Court (Tribunal de Grande Instance), 3rd chamber, June 23, 1998

SEARLE and MONSANTO are co-owners of European patent 679 157 which relates to anti-inflammatory agents.

They conducted *saisie* in MERCK laboratories and brought an action for infringement.

During the *saisie*, MERCK requested that confidential documents be placed under a sealed envelop and moved to obtain that the Court appoints an expert in order to determine which documents were necessary to prove infringement.

After the expert had made such determination, MERCK moved again and asked the Court to prohibit SEARLE and MONSANTO from disclosing or making use of such documents.

The Court dismissed MERCK's request. It said that the plaintiff was permitted to use those documents useful for evidence of infringement.

Those two cases show that French Courts do not accept to restrict the use of documents obtained through a *saisie* for infringement only to the purpose of French litigation. There does not seem to exist any legal obstacle to the use of such documents in parallel litigation.

**US QUICKTURN DESIGN SYSTEMS Inc. v. MENTOR GRAPHICS (France and Netherlands), META SYSTEM and M 2000
Paris Court of Appeals, July 26, 1999**

This decision refines rules elaborated by the two former decisions.

The Court appoints an expert in order to determine if the seized papers contained confidential information.

The Court considered that :

- non confidential papers likely to prove infringement could be used freely by the parties in other litigation opposing those parties in France or in foreign countries
- necessary documents to prove infringement but containing confidential information could only be used in other French or foreign proceedings opposing the same parties, after a final decision recognising infringement.

3. The ways in which parallel proceedings in another country may affect national proceedings

3.1 *No res judicata*

Under the principle of autonomy of rights, there is no obligation for French Court to await the outcome of a foreign pending case.

If the case has already been decided in a foreign country, there will probably have an informal influence on the French Court.

MULLER and MUPRO GmbH v. HILTI France
Paris, Court of Appeal, 4th Chamber, section B, November 19, 1999

MULLER is the owner of European Patent 319 521 relating to a clamping ring.

He granted an exclusive licence to MUPRO GmbH.

HILTI France, which marketed in France similar clamping rings, was subject to an action for infringement of patent by MULLER and MUPRO GmbH.

Each party invoked foreign judgements in litigations opposing MULLER or MUPRO to HILTI DEUTSCHLAND and HILTI AKTIENGESELLSCHAFT SWISS in which the same products were accused of infringement of the German and Swiss part of the European Patent.

In Germany, HILTI DEUTSCHLAND was unsuccessful in challenging the validity of the patent.

The DUSSELDORF *Oberlandesgericht* (June 27, 1996) held the patent not infringed.

By judgement of March 2, 1999, the Bundesgerichtshof denied MUPRO's appeal.

In Switzerland, a first judgement of the Zurich commercial Court held the patent valid and infringed.

The Supreme Court quashed the commercial Court decision in 1998.

A second decision of the Zurich commercial Court held again the patent valid and infringed.

French judges carefully considered those foreign judgements.

The Court of Appeal of Paris held the patent valid and infringed (as did the Swiss Court, but contrary to the German Court).

3.2 No estoppel

There is no equivalent to the estoppel in France.

L'OREAL/ ESTEE LAUDER

Paris, Court of Appeals, 4th Chamber, section B, April 24, 1998

L'OREAL is the owner of European Patent 293 579 relating to a cosmetic composition.

ESTEE LAUDER marketed cosmetic products containing CuDIPS complex failing under the scope of L'OREAL's patent.

L'OREAL brought an infringement action against ESTEE LAUDER.

ESTEE LAUDER argued invalidity of the patent.

L'OREAL stressed that such defence was inadmissible because of the contradictory arguments asserted by ESTEE LAUDER sister companies in the parallel litigations before US PTO.

Indeed, in the French proceeding, ESTEE LAUDER tried to deny the patent validity even though during the US litigation, they tried to obtain the ownership of this patent.

The Court of Appeal denied this argument picking out that the French judge was not bounded by US proceedings ; the Court added that French and American proceedings did not have the same object.

Nonetheless the Court held the patent valid and infringed.

This case shows that there is no estoppel in France even if judges pay attention to foreign litigations.