
I. Proving infringement

1.1. Discovery

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

There is no discovery process in France.

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 is exceptional.

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*").

1.2. Reversal of burden of proof after TRIPs in France

French Law has been changed to comply with the TRIPs guidelines in connection with evidence of infringement of process patent.

Hereafter are the texts of Article L 615-5-1 French Intellectual Property Code and Article 34 of TRIPs.

Article L 615-5-1 French Intellectual Property Code
(as amended by Act of December 18, 1996)

" *If the subject matter of a patent is a process for obtaining a product, the court may order the defendant to prove that the process used to obtain an identical product is different from the patented process.*

If the defendant fails to bring such evidence, any identical product manufactured without the consent of the owner of the patent will be deemed to have been obtained by the patented process in the following two cases :

a) the product obtained by the patented process is new ;

b) the likelihood that the identical product was obtained by the patented process is great, and the owner of the patent could not, through reasonable efforts, determine the process actually used.

In the adduction of proof to the contrary, the legitimate interests of the defendant in protecting his manufacturing and business secrets shall be taken into account."

TRIPs Agreement

Article 34: Process Patents: Burden of Proof

" 1. *For the purposes of civil proceedings in respect of the infringement of the rights of the owner referred to in paragraph 1(b) of Article 28 above, if the subject matter of a patent is a process for obtaining a product, the judicial authorities shall have the authority to order the defendant to prove that the process to obtain an identical product is different from the patented process. Therefore, Members shall provide, in at least one of the following circumstances, that any identical product when produced without the consent of the patent owner shall, in the absence of proof to the contrary, be deemed to have been obtained by the patented process :*

(a) if the product obtained by the patented process is new

(b) if there is a substantial likelihood that the identical product was made by the process and the owner of the patent has been unable through reasonable efforts to determine the process actually used.

2. Any Member shall be free to provide that the burden of proof indicated in paragraph 1 shall be on the alleged infringer only if the condition referred to in sub-paragraph (a) is fulfilled or only if the condition referred to in sub-paragraph (b) is fulfilled.

3. In the adduction of proof to the contrary, the legitimate interests of the defendant in protecting his manufacturing and business secrets shall be taken into account."

1.3. How to obtain evidence - seizure orders

1.3.1. What is infringement seizure ?

The infringement seizure 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 seizure 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.

1.3.2. How to get an order for an infringement seizure ?

The infringement seizure 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 himself, 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)...).

The filing of the petition is *ex parte* (the defendant is only informed of the Court order by the bailiff, upon his arrival to perform seizure).

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

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

1.3.3. Protection of confidential information

It happens that the seized party objects to the seizure of some information 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.

1.3.4. Schedule of events from the complaint until the trial

- The plaintiff must serve a complaint on the alleged infringer within 15 days from the date of the infringement seizure.

Failure to serve such complaint makes the seizure void.

- The plaintiff has the complaint recorded in Court ; a Judge in charge of supervising the progress of the proceedings is appointed ; this Judge will fix the dates of the different steps of the proceedings, which are referred to hereafter.

The plaintiff produces evidence to support his complaint.

The defendant files an answer, which may include a counterclaim, and produces evidence to support his contentions.

The parties pursue their exchange until they consider the discussion exhausted, which means, practically, until one party does not ask to reply ; the Judge has also the power to declare the exchange closed.

- The case is argued in Court.

For patent cases, the trial usually takes place between one to three years after the filing of the complaint.

The final oral hearing lasts between two hours and a whole day (2 days in exceptional cases) according to the difficulty of the issues.

The Court is a panel of three Judges, who are always professional Judges ; there are no jury in civil cases.

This hearing consists of two speeches : first the statement of the plaintiff's counsel and, afterwards, the statement of the defendant's counsel.

The Judges can ask questions or make comments if they wish to, but usually they intervene very little. There is no examination of witnesses. Usually, the parties are not invited to give explanations to the Court.

1.3.5. Motion for preliminary injunction

The preliminary injunction was introduced in French Patent Act of January 2, 1968 by an amendment of June 27, 1984.

Since the amendment of November 26, 1990, the conditions for a preliminary injunction are, under article L 615-3 of Intellectual Property Code :

1. A prompt infringement suit : the plaintiff has to sue the alleged infringer without delay after he has become aware of the alleged infringement. The critical period of time seems to be, according case law, about six months.
2. Likelihood of success on the merits, which implies that neither the validity of the patent nor its infringement appear seriously challengeable.

Preliminary injunctions are not frequently granted.

1.4. Doctrine of equivalents

Literal and narrow construction of claims is not a French tradition.

It should be kept in mind that French patents include claims only since 1968 ; beforehand, the patent owner was permitted to seek protection for whatever was included in the patent specification, provided that it was new ; the Court had just to check that what was "claimed" in the suit was actually described in the specification ; such system has given an early tradition of purposive construction and of doctrine of equivalents.

Doctrine of equivalents has therefore always been part of French case law.

Two means are equivalent when, although of a different shape, they perform the same function to achieve a similar result.

This criterion is of daily use in patent infringement litigation :

" two means of a different shape are equivalents when they achieve the same function, i.e. the same principal technical effect, to achieve a similar result..."

Court of Appeals of Paris - 11 September 1996
SMBP v. NOVEMBAL

" the nut of the allegedly infringing device, although of a different shape of the patented screw, is a technical equivalent of this screw since it performs the same pressure function to achieve a result of the same nature."

Court of Appeals of Paris - 27 September 1996
SOFAMOR and COTREL v. JBS

" It cannot be disputed that the structure of the various elements of the patented device, on the one hand, and the allegedly infringing device, on the other hand, are different :

- *patent covers a metal spike with a sharpened end,*
- *allegedly infringing device is an hollow tube in which is inserted a rod, longer than the hollow tube, so that the sharpened end of the inner rod creates a sharpened end to the tube.*

However, those two systems perform the same function and achieve a result of the same nature"

Court of Appeals of Paris - 30 October 1996
NIJAL v. EMSSENS

Needless to say, French Courts do not always accept the equivalence :

" The means used by the defendant do not achieve the function of those described by the claim : the side walls of the allegedly infringing device do not reduce the distance between the conduits whereas the patented device purpose is to reduce the room occupied by said conduit"

High Court of Paris - 11 October 1996
ARMOR-INOX v. KAUFLEER

As the doctrine of equivalents is long established in French law, it does not raise any further academic discussion.

In comparison to what can be decided on the same topic in other countries, the following statements can be considered as reflecting the present state of the law in France :

- although the construction of claim is generally broad, the test of equivalence will probably be conducted on a claim element - by - claim element basis rather than on the accused process as a whole,
- "*prosecution history estoppel*" had not the same importance in France where the French Patent Office powers are quite limited ; the situation is probably different when considering a European Patent designating France,
- the equivalence is certainly not limited to what is disclosed in the patent itself ; nor is it limited to what was known at the time of the patent ; in other words, equivalency will be evaluated at the time of infringement.

II. Contributory infringement

2.1. Can you drag in a parent company, subsidiary or sister company ?

This issue is not frequently raised in patent litigations in France.

However a distinction should be made :

- when the parent, subsidiary or sister company has taken a material role in the infringement, it will be easy to drag it in the suite against the principal infringer ; in such cases, French courts would certainly recognise easily a "*common design*",
- the parent, subsidiary or sister company could be also sued on the basis of a general company law principle according which several companies are liable of the debts of one company when they form a group of companies in which some to them has no autonomy in the conduct of their business and/or can be considered by third parties as a single entity.

It should also be mentioned that it could be possible to drag in the officers of the infringing company.

2.2. Suppliers of key components

Article L 613-4 French Intellectual Property Code :

" 1° It is forbidden, without the consent of the patent owner to supply or offer to supply in the French territory, a person other than those entitled to work the patented invention, with any of the means, relating to an essential element of the invention, for putting the invention into effect, when the person who supplies or offers to supply knows - or it is obvious to a reasonable person in the circumstances - that those means are suitable for putting and are intended to put the invention into effect in France.

2° Provisions of 1° above will not apply to the supplier of a staple commercial product, unless the person who supplies or offers to supply induces the person supplied (or, as the case may be, a person to whom the offer is made) to do an action which constitute a direct infringement of the patent.

3° The persons who do actions referred to in article L 613-5 (private and non commercial use ; experimental use ; preparation of a single unit of drug in a drugstore) are not considered as "entitled to work the patented invention", in the meaning of 1° above."

The case law on this article is limited.

However it has been decided that the supply of two herbicides belonging to the public domain was an infringement of a patent relating to the association of those herbicides, when the supplier recommended to its customers to use those products in association.

Court of Appeals of Paris - 14 February 1989

RHONE POULENC AGROCHIMIE v. ELI LILLY FRANCE

IV Stays of infringement proceedings

The situation is different depending on whether the European patent is the only patent covering France or whether there is also a French national patent for the same invention :

4.1. French national patent + European Patent

This situation is frequent for French companies who, usually, file, first, a French National patent and file, later, a European patent under the priority of the French application.

As the French national patent is usually granted much more quickly than the European patent, the patent owner will consider suing on the basis of the French patent, namely when no additional patentable subject matter has been added to the European patent and when the prosecution of the European patent has not led to substantial improvements in the wording of the claims.

Unfortunately, in such a case, the **French courts are obliged to stay the proceedings** until the European patent is granted and even until the end of opposition proceedings, if any.

This is explicitly stated by Article L 614-15 of French Intellectual Property Code.

In order to avoid this compulsory freezing of the proceedings for years, some patent owners prefer to withdraw the designation of France in the corresponding European patent.

The Court has therefore no longer any obligation to stay the proceedings based on the French patent.

There has been some discussion about the possibility of such withdrawal.

However the High Court of Paris admitted it (21 December 1995 - SODIAPE v. SURGELATION BRETONNE).

4.2. European Patent

When the infringement suite is based on a European patent which has no corresponding French national patent, French case law on stay of proceedings is divided :

- in the greatest number of cases (at least until 1996), French courts decided to stay ; some judgements referred to the lack of serious of the grounds of opposition ; but many judgements simply stated that "*any opposition can result in a revocation of the patent*", insisting on the difficult situation which could result of a judgement of infringement followed by a revocation of the patent ; it should be also mentioned that in many cases the stay was accepted by the patent owner himself,
- it seems, however, that the things are changing ; in several cases the High Court of Paris refused to stay, with a reference to the necessity of promptly and efficiently enforcing patent rights ; those judgements mention the weakness of the grounds of opposition and/or the length of the opposition proceedings.

High Court of Paris - 28 April 1993

L'OREAL v. ESTEE LAUDER

High Court of Paris - 27 March 1996

HOFFMANN-LA ROCHE AG/CIS BIO INTERNATIONAL

High Court of Paris - 26 March 1997

UNION CARBIDE/BP CHEMICALS

As a consequence of civil proceedings rules prohibiting appeal against judgement deciding not to stay, and requesting a special leave of the Court of Appeals before appealing a judgement deciding to stay, there are very few decisions of the Courts of Appeals on this topic ; it seems however that the Court of Appeals of Paris has always upheld the first instance judgements deciding a stay.