

Overview of case law on the collection of evidence in IP cases in France

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The collection of evidence in IP cases in France is a hot topic over the last two years or so. Several traps should now be avoided to have reliable evidence showing the alleged infringement before the courts.

French law shifts the burden of proof on the claimant and infringement may be demonstrated by any means.

Without being able to be totally exhaustive, different cases relate to bailiff reports, proof to be provided for having a *saisie-contrefaçon* (infringement seizure), and the assistance of the patent attorney in infringement seizure.

Bailiff report of purchase : Alleged infringed goods must be purchased by an independent third party

Legal principle and common practice involving the purchase of alleged infringed goods by an intern of the claimant's attorney-at-law

Mere trap purchases can be challenged before French courts.

Any entity seeking to demonstrate the infringement of one of its IP right (patent, trademark, copyright, design etc) may request a bailiff to establish a purchase report on the alleged infringing good. The bailiff is not allowed to perform the purchase but should report someone's purchase.

In practice, it was common that an intern of the claimant's attorney-at-law could perform such purchase, as an independent third party.

Common practice challenged by a 2017 ruling of the Cour de cassation

Such common practice has however been challenged by a 2017 decision where the *Cour*

de cassation considered that an intern could not be considered as independent from the claimant (Civ. 1e, 25 January 2017, 15-25210). The Court did not provide any clear justification but merely stated that such evidence is contrary to the principle of the production of fair evidence, regardless any disloyal act.

Assessment of the current situation

Further to this decision, the first instance judges adopted different views.

In some cases, the judges refused to apply such ruling, including regarding online purchases. Judges stated that it would significantly affect the claimant's situation that acted in good faith, in accordance with the law applicable at the time of the bailiff report, and that it would lead to cancel its sole evidence (TGI Paris, 1 December 2017, 16-12596; TGI Paris, 26 October 2018, 16-07672). The same applied where no disloyal act could be found and where the bailiff was able to report any fact occurring during the purchase (TGI Paris, 5 April 2018, 17-00612).

In other cases, the judges confirmed the *Cour de cassation* decision and cancelled purchase reports performed by an intern of the claimant's attorney-at-law, merely holding that such evidence is contrary to the principle of the production of fair evidence (TGI Paris, 22 December 2017, 16-07565; TGI Paris, 18 January 2018, 16-13110; TGI, 26 January 2018, 14-16389).

Consequently, French bailiffs should now find other independent third parties to purchase alleged infringing goods (either on-site or online).

This suspicion on attorneys-at-law and their interns is difficult to understand, particularly if we compare the French situation with the situations in some other European countries,

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where attorneys-at-law can perform mere trap purchases.

Infringement seizure: the necessary demonstration of a commencement of proof?

Legal requirement of a ‘reasoned’ request

French law provides for a highly effective tool for obtaining evidence: the *saisie-contrefaçon* (infringement seizure) in the premises of the seized party, based on surprise.

Any infringement seizure must be authorised by a judicial order granted based on a request of the claimant. Such request must be ‘reasoned’ (Article 494 Code of civil procedure).

Legal uncertainty on a judicial requirement of a ‘commencement of proof’

Although some cases expressly held that no ‘commencement of proof’ was required (CA Paris, 26 May 2017, 15-10201; CA Paris, 16 May 2017, 15-15693), some other earlier or later cases raised uncertainty on the abovementioned legal requirement.

Some cases expressly required a commencement of proof (TGI Paris, 4 July 2013, 13-08661; CA Paris, 25 September 2018, 18-04300), while other cases adopted a strict interpretation of the legal requirement without expressly mentioning the necessity of a commencement of proof.

In particular, a 2014 decision held that ‘the request must not be based on mere assertions or allegations not supported by a minimum of evidence’ (CA Paris, 28 January 2014, 13-08128).

In a 2018 ruling, the Paris Court of Appeal found that ‘the grounds alleged in support of the request are incorrect, (...) since they result in no suspicion of infringement or good reasons to assume’ an infringement. In such

case, the Court stressed the particular weakness of the claimant’s arguments, precluding from providing any document demonstrating that the alleged infringing process covered the patented steps of the process (CA Paris, 11 September 2018, 18-01099).

Clarifications on the expected level of proof

In two later 2018 decisions, the Paris Court of First Instance provided clarifications on the level of proof that is expected from the claimant.

The Court stated that the claimant is not requested to provide ‘a proof or a commencement of proof’ of the infringement, but is only required to demonstrate that its ‘mere allegations and assertions are supported by a minimum of evidence’ (TGI Paris, 5 October 2018, 18-07802). The Court notably considered as sufficient the demonstration of information and evidence presuming the infringement (TGI Paris, 5 October 2018, 18-07802 and 18-07207).

Such rulings can be seen as preserving the balance of interests and preventing too intrusive or abusive action, since the infringement seizure is an *ex parte* procedure.

Such clarifications regarding the expected level of proof can also be seen also more in line with the rationale of the infringement seizure ie collecting evidence in order to demonstrate an alleged infringement.

We thus hope that later decisions will confirm such recent rulings.

Infringement seizure: the assistance of a bailiff by a patent attorney

Legal principle and common practice of the assistance of a bailiff by the claimant’s patent attorney

During the infringement seizure operations, any expert designated by the claimant may assist bailiffs.

As a common practice in patent infringement cases, claimants designate their usual patent attorney(s), in particular to provide any technical help related to the alleged infringement or disassemble any alleged infringing good.

The impartiality of the claimant’s patent or trademark attorneys has long been admitted in any matter (Civ 1e, 8 March 2005, 03-15871 regarding the impartiality of trademark attorneys).

Impartiality of patent attorney challenged by a 2018 Court of Appeal ruling

In a 2018 patent infringement case, the Paris Court of Appeal overruled said case law and cancelled a judicial order that allowed an infringement seizure (CA Paris, 27 March 2018, 17-18710).

The Court stressed that the patent attorneys designated by the claimant, regardless their particular status and the ethical obligations they are subject to, could not be considered as impartial since the same patent attorneys previously issued a report in the same case for the claimant. The claimant ordered such report from the patent attorneys notably to describe the characteristics of the alleged infringed product and provided such report as evidence in support of its infringement seizure request as well as its writ of summons. This report therefore somehow constituted a ‘commencement of proof’ in order to avoid any strict judicial interpretation (cf above).

Return to the initial situation

In the same case, the *Cour de cassation* recently overturned the appeal decision, ruling that the issuance by a patent attorney of such a report does not preclude his/her further designation as an expert to assist the bailiff during infringement seizure operations (Com, 27 March 2019, 18-15005). The court held that patent attorneys’ mission during infringement seizure operations ‘is not subject to a duty of impartiality and is not an expertise in the meaning of Article 232 et seq of the Code of civil procedure’.

The CNCPI and ACPI, two IP attorneys French organisations, intervened voluntarily in the proceedings in support of the party that requested the infringement seizure. ■