

# Patents in Europe 2008

France

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# France

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## 1. What options are open to a European patent holder, whose rights cover your jurisdiction, when seeking to enforce its rights in your jurisdiction?

The holder of a European patent designating France enjoys the same rights as a French patent holder.

The European patent holder may bring a civil or criminal action to enforce its rights. However, criminal actions are rare in practice. The main purpose of such actions is to benefit from police investigations, under the supervision of an investigating judge, through which evidence of the infringement can be collected and infringers identified. Civil parties that file a criminal complaint must pay a certain amount of money to secure payment of a civil fine if the criminal complaint is later found abusive.

The statute of limitations for patent infringement is three years, starting from the date on which the acts of infringement occurred (Article L615-8 of the Intellectual Property Code).

## 2. Does your jurisdiction have specialist patent courts? If not, what level of expertise can a patent owner expect from the courts?

Patent disputes fall under the exclusive jurisdiction of seven courts of first instance designated by order (Article R631-2 of the Intellectual Property Code).

The competent courts are those of Paris, Marseille, Bordeaux, Strasbourg, Lille, Lyon and Toulouse, and the corresponding courts of appeal (ie, Paris, Aix, Bordeaux, Colmar, Douai, Lyon and Toulouse).

The Paris court hears the vast majority of patent cases (about 50%) and as such has specialised chambers. However, the judges sitting in these chambers have only a legal

background and no specialist technical knowledge.

The general trend is to continue to reduce the number of competent courts: the possibility of reducing their number from seven to three was recently discussed by the French Assemblies in order to ensure that the judges hearing patent litigation have even greater specialisation. The French Industrial Property Council advisory committee to the Ministry of Economy and Finance has suggested the following competent court options: Paris-Lyon-Bordeaux, Paris-Lyon-Toulouse or Paris-Lyon-Strasbourg.

## 3. Is it possible to cross-examine witnesses at trial? How far are proceedings based on written evidence? Are there restrictions on the use of evidence from experts?

It is not possible to cross-examine witnesses at trial in France. French law does not provide for cross-examination procedures. However, although rare, judges may nonetheless decide to hear a party. Proceedings are mainly based on written evidence. There is an oral hearing at the end of the preparatory stage, but usually only the attorneys are authorised to speak at it. In some patent cases involving complex technology, judges may sometimes allow a technical expert to assist the attorneys in their presentation.

Patent infringement can be proved by any means; there are no restrictions.

Expert evidence is often used. The parties can decide to appoint an expert to assist them or ask the expert to provide them with a written opinion on a particular question. The judges can also decide to appoint a court expert, whose task is precisely determined by the judge. However, court experts are designated more often to determine the amount of damages to be paid to the patent owner than to assist the court in determining whether the patent has been infringed.

#### **4. Are infringement and invalidity dealt with simultaneously? What level of proof is necessary to demonstrate one or the other?**

The questions of patent infringement and invalidity are dealt with in the same proceedings.

Invalidity is usually raised as a defence. It is therefore up to the defendant to demonstrate that the patent is invalid and up to the plaintiff to demonstrate that the patent has been infringed.

However, the Intellectual Property Code provides for a particular regime regarding patented processes. There is a presumption that a patented process has been used unless the defendant proves that the product in question was obtained using a process which does not infringe the plaintiff's patented process (Article L615-5-1 of the Intellectual Property Code).

#### **5. To what extent is pre-trial discovery permitted? If it is permitted, how is discovery conducted?**

There is a very efficient pre-trial procedure in France which allows the patent owner to obtain evidence of the infringement. The patent owner can easily obtain a court order authorising it to send a bailiff and possibly independent experts such as patent agents to the defendant's premises. The defendant is not informed of the order until its execution. This pre-trial procedure is called "infringement seizure".

Seizure by a bailiff consists of an official description of the infringing products or devices, as well as physical seizure of the infringing product or device and copying of invoices and any other documents that relate to the alleged infringement (eg, preparatory documents, technical specifications, descriptions, brochures or commercial documents). Under the new law of October 29 2007 against counterfeiting, the court can also order the seizure of equipment and tools used to manufacture or distribute the infringing products.

An official report of seizure is drafted by the bailiff and served on the plaintiff to prove the infringement.

The patent holder must file an action rapidly; otherwise, the seizure will be rendered null.

French law does not provide for discovery procedures. However, it is possible to seek disclosure of documents in the possession of a party or of third parties. The request must be made before filing of the court action or during procedural hearings, once the action on the merits has begun.

#### **6. To what extent does any doctrine of equivalents apply in an infringement action?**

In deciding whether a product has infringed a patent, the French courts will hold two means as equivalent when, although they have a different form, they achieve the same function in view of an identical or similar result.

The means at stake will be considered to perform the same function when they produce the same primary technical effect, which may be perceived as the immediate and direct effect produced by the implementation of the means.

#### **7. Are there certain types of patent right that may be granted by the EPO – biotech or computer software-related, for example – that are more difficult to enforce than others?**

Generally, there is no particular difficulty in enforcing a patent granted by the EPO.

The validity of biotech or computer-related patents will be carefully examined, considering that biotechnologies are patentable only to a certain extent under French patent law (ie, requirements of novelty, industrial application, inventive character and conformity with public policy), and software is patentable under neither French nor European patent law as such.

#### **8. To what extent are courts willing to consider, or bound by, the opinions and decisions of other courts that have dealt with similar cases?**

The doctrine of precedents is not recognised as such in France.

The French legal system differs greatly from that of common law countries, where a court must follow earlier judicial decisions when the same points arise in a subsequent litigation (*stare decisis*).

Decisions issued by French courts of appeal and the *Cour de cassation* (the highest court in the French legal system) often guide judges in their reasoning. However, judges need not follow either the reasoning or the outcome of such case law.

The general principles set out by courts and admitted by other courts over the years constitute what is called *jurisprudence constante* (well-established case law) and are usually followed.

#### **9. To what extent are courts willing to consider the reasoning given by foreign courts that have handed down decisions in similar cases?**

French judges have no obligation to follow

the reasoning of foreign courts. However, French judges usually consider foreign decision as an informational source.

#### **10. What options are open to a defendant seeking to delay a case? How can a plaintiff counter delaying tactics?**

A defendant may delay a case by always filing documents requested by the court at the very last minute or frequently requesting more time in which to file these documents. To remedy such inconvenience, the plaintiff must request the judge to issue an injunction against the defendant.

A defendant may also delay a patent infringement case by launching opposition proceedings before the EPO, which may compel the judge to consider staying the proceedings. Once the EPO has rendered its decision on the validity of the patent, the judge may resume the proceedings.

#### **11. How available are preliminary injunctions and how do you get them?**

Preliminary injunctions in patent litigation have always been difficult to obtain in France. Although it is possible to request a preliminary injunction to stop the manufacture and sale of allegedly infringing products, French judges are so reluctant to grant preliminary injunctions in relation to patents that very few summary proceedings have been accepted in patent cases.

However, new provisions were recently implemented into French patent law (the IP infringement law, dated 29th October 2007) which aim to allow patent holders to obtain preliminary measures in patent infringement cases more simply and swiftly.

A patent holder may now obtain a preliminary injunction under penalty of a daily fine imposed by the president of the court hearing the case in summary proceedings or acting upon a motion from the plaintiff (without the presence of the defendant) (Article L615-3 of the Intellectual Property Code).

Such preliminary injunction may aim to:

- Prevent an imminent prejudice;
- Prevent the carrying out of allegedly infringing acts (eg, by the seizure or handing over to a third party of infringing products in order to prevent their introduction onto the market); or
- Ensure the indemnification of the prejudice (eg, by seizure of the infringer's assets or the award of a provision on damages in the absence of serious grounds – this provision must be justified as necessary to preserve the assets of

the infringer or prevent it from dispersing them).

The plaintiff must be able to support its claim with reasonable accessible evidence showing that its patent rights have been or are likely to be infringed.

#### **12. How long does it take to get a decision at first instance? Is it possible to expedite this process?**

Usually, proceedings at first instance take around one and a half years to three years, depending on the case and the courts.

The *Tribunal de Grande Instance* of Paris is generally quite responsive and efficient compared to certain other courts. This is due to the fact that the Paris court is more specialised in this field, since it hears a large number of patent disputes.

The parties should normally conform to the schedule set by the judge and cannot expedite the proceedings.

#### **13. What avenues for appeal are open to the defeated party in a first instance case? What criteria are there for granting an appeal? How long does the appeal process take?**

The defeated party may lodge an appeal against any judgment before the corresponding court of appeal within one month of notification of the judgment (three months for parties residing abroad).

The appellant must designate, through his attorney at law (*avocat*), an "*avoué*" who has the exclusive power to represent the parties before the court of appeal. The *avoué* will formally file the written pleadings and related exhibits with the court of appeal, but will not draft these documents and plead the case. The pleadings and draftings are done by the attorney at law.

Usually, court of appeal proceedings last around two years.

If the appeal is dismissed, the case may be appealed to the *Cour de cassation*, which has jurisdiction to hear the case and decide whether the court of appeal applied the law correctly (representation by *avocats aux conseils* is required). However, the *Cour de cassation* will not examine the case on the merits.

#### **14. To take a case through to a first instance decision, what level of cost should a party to litigation expect to incur?**

The costs incurred by a patent dispute will cover attorneys' and experts' fees.

They will depend on the length of the proceedings, which in turn depends on the

complexity of the case, the opposing party's arguments and strategy, and whether it is necessary to translate documents. Usually, the parties must provide a French translation of all foreign-language documents produced in court.

A party may be liable for part of the other side's costs; however, the amount is usually limited by the court. Court fees are also usually payable by the losing party and depend on the value of the claim.

#### 15. Who can represent parties in court? Is a specialist representation required?

In France – unlike in other jurisdictions where only specially qualified attorneys can represent the parties in patent disputes – representation is permitted by an attorney at law specialised in intellectual property but not technically qualified in the relevant field. There are no technical or scientific background requirements.

Nevertheless, in view of the complex technical issues and high degree of expertise that characterise patent disputes, French attorneys at law usually work with patent agents (*"Conseil en propriété industrielle"*), who cannot plead at the court hearings, but can advise the parties and their attorneys.

#### 16. What remedies are available for infringement and how are these typically applied? Are punitive damages available and in what circumstances?

Under French tort law, courts have sole discretion when it comes to assessing the amount of damages and the method of compensation. They are obliged only to compensate the actual damage suffered by the injured party, which may include damages for lost opportunities.

The law of 29th October 2007 on IP infringement has introduced specific provisions regarding the way in which judges calculate damages in patent infringement cases. These new provisions have substantially changed the method of calculating damages in patent infringement cases.

The court must now take into account several factors to determine the amount of damages, such as the profits of the infringer and the moral prejudice and losses suffered by the victim (Article L615-7 of the Intellectual Property Code).

The patent owner is granted a choice between the evaluation of damages by the court or the award of a lump sum assessed on the basis of the royalties which would have been paid had the patent holder licensed its patent. Usually, the court appoints an expert for the evaluation of damages (to this end, the infringer must disclose all information necessary for completion of the expert's task).

Punitive damages are not available, as the principle behind the award of damages is to compensate the victim.

Parties may also request other measures



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from the court, such as destruction of the infringing products and tools used to infringe the plaintiff's rights and publication of the court's decision.

**17. Are there any realistic alternatives to litigation in cases relating to patent disputes?**

The parties may submit their patent disputes to arbitration or mediation. The International Chamber of Commerce (ICC) of Paris hears a reasonable number of disputes in this area: every year about 10% of the contracts giving rise to ICC arbitration relate to intellectual property (ICC, *Roadmap for business and policy makers*, 2007).

However, disputes directly affecting the existence or validity of a patent cannot be dealt with through arbitration and must be referred to the national courts, which have exclusive jurisdiction over such questions.

Therefore, a defendant's counterclaim in an arbitration proceeding based on the

invalidity of a patent must be heard by a national court and will entail a stay of the arbitral proceedings.

**18. Has your jurisdiction signed up to the London Agreement on Translations? If not, how likely is it that it will do so?**

France signed the London Agreement on Translations on 9th October 2007, becoming the 12th country to ratify the Agreement. Thanks to this ratification, the Agreement is now enforceable in all states that have already ratified it.

**19. Are there any other features of the enforcement system in your jurisdiction that you would like to point out?**

The new anti-counterfeiting tools introduced by the new law of October 2007 are likely to assist patent holders in enforcing their rights in France. Forthcoming case law and implementation orders are eagerly awaited by the legal profession.