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# *Patents in Europe*

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# France



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## 1. What are the most effective ways for a European patent holder whose rights cover your jurisdiction to enforce its rights in your jurisdiction?

France is known for its very effective seizure procedure (*saisie-contrefaçon*), which allows patent holders to request, in *ex parte* proceedings, a seizure action at the defendant's place of business and any other place where the allegedly infringing products may be found or where the allegedly infringing process is carried on. The court generally authorises:

- the seizure of samples of the allegedly infringing products;
- a description of the allegedly infringing acts;
- photographs of the products or machines; and
- the seizure of any relevant documents (eg, invoices, orders and accounting documents).

A seizure is conducted by a bailiff with the assistance of a patent attorney. Confidential information is normally retained by the bailiff and sorted afterwards under the court's supervision. The patent holder must file a complaint before the court within 30 days of the seizure.

In addition, the court may grant a preliminary injunction against the use of the infringing products or processes within a very short timeframe – usually between two weeks and three months, depending on the urgency of the matter. Preliminary injunctions in patent matters are usually granted only in cases where:

- the patent has been maintained following an opposition procedure or previous infringement action in which a counterclaim of invalidity had been raised; and
- there are clear infringing acts.

An action on the merits involving validity, infringement and damages claims will take between 12 and 18 months at first instance. Damages granted without expertise or prior to the expertise being performed may be high. For instance, in 2012 the court ordered a company to pay €6 million in provisional damages for patent infringement.

## 2. What level of expertise can a patent owner expect from the courts in your jurisdiction?

All patent cases are heard by a single specialised IP court in Paris, both at first instance and on appeal.

## 3. How do your country's courts deal with validity and infringement? Are they handled together or separately?

The court handles validity and infringement claims together.

## 4. To what extent is cross-examination of witnesses permitted during proceedings?

There is no cross-examination of witnesses under the French system, resulting in a relatively inexpensive and efficient procedure.

## 5. What role can and do expert witnesses play in proceedings?

Each party may request expert witness opinions for the analysis of the allegedly infringing products or process. These opinions are not decisive to the proceedings. Expert witnesses may also be appointed by the court to advise on technical questions. If ordered by the court, such expert opinions will play a significant role in the proceedings and the court's decision. The court may also request the opinion of expert witnesses for the calculation of damages.

**6. Is pre-trial discovery permitted? If so, to what extent?**

There is no discovery under French law. However, as mentioned above, French law provides for infringement seizures that enable plaintiffs to obtain evidence of the infringement, as well as information on the origin and extent of the infringing acts. In addition, plaintiffs may ask the court to order the defendant to provide further evidence relating to the allegedly infringing acts and their origin.

**7. Do the courts in your jurisdiction apply the doctrine of equivalents?**

The French courts apply the doctrine of equivalents.

**8. Are certain patent rights (eg, those relating to business methods, software and biotechnology) more difficult to enforce than others?**

Business methods and software as such are not patentable in France, as in the rest of the European Union. Nevertheless, a patent relating to a computer-implemented invention in which a technical effect can be found is enforceable as any other patent before the courts.

The same can be said of patents relating to biotech inventions. In both cases, evidence of infringement can be obtained through an infringement seizure authorised by the court, in order to obtain technical information from the premises of the allegedly infringing party.

**9. How far are the courts bound by previous decisions in cases that have covered similar issues?**

French courts are not bound by previous cases that have covered similar issues. This is a general principle of the French legal system.

**10. Are there any restrictions on who parties can select to represent them in a dispute?**

Parties must be represented by a lawyer who is a member of the Paris Bar. The lawyer may be assisted by a patent attorney.

**11. Are the courts willing to consider the reasoning of courts in other jurisdictions that have dealt with similar cases?**

French courts will not consider the reasoning

of courts in other jurisdictions that have dealt with similar or identical cases. However, the Paris court with jurisdiction over patent cases generally follows the decisions of the European Patent Office (EPO).

**12. How easy is it for defendants to delay proceedings and how can plaintiffs prevent them from doing so?**

Once the court has scheduled hearings in a case, it is difficult for defendants to delay proceedings. However, defendants may try to do so by sending their briefs late. Plaintiffs can prevent them from doing so by always sending their briefs before the deadline set by the court.

**13. Is it possible to obtain preliminary injunctions? If so, under what circumstances?**

Preliminary injunctions may be requested in *ex parte* or *inter partes* proceedings. In patent cases, preliminary injunctions are rarely granted in *ex parte* proceedings, which are reserved for cases of extreme urgency where the infringing acts are so detrimental that to allow them to continue would cause irreparable harm to the patent holder (eg, during temporary exhibitions or fairs). Preliminary injunctions are generally granted in cases where the patent has been maintained after an opposition procedure or a previous court case in which a counterclaim of invalidity had been raised. The infringement must be obvious.

In *ex parte* proceedings, the decision is granted immediately by the judge. *Inter partes* proceedings take between one and three months. After the grant of the preliminary injunction order, the patent holder must file an action on the merits within 30 days.

**14. How much should a litigant plan to pay to take a case through to a decision at first instance?**

The costs of a patent infringement action include both validity and infringement claims. The costs depend on the type of patent, the amount of prior art cited and the number of exchanges between the parties. The average attorneys' fees in a patent infringement and validity action range between €50,000 and €90,000 at first instance, if an infringement seizure has been performed. There are no

court fees in France, resulting in comparatively cheap proceedings.

#### **15. Is it possible for the successful party in a case to obtain costs from the losing party?**

French courts always order the losing party to bear at least part of the costs of the successful party.

#### **16. What are the typical remedies granted to a successful plaintiff by the courts?**

The typical remedies granted to a successful plaintiff are as follows:

- permanent injunction;
- destruction of the infringing products;
- destruction of the moulds and machines used for the manufacture of the infringing products;
- recall of the infringing products;
- publication of the decision or extracts of the decision in magazines and newspapers;
- damages; and
- reimbursement of part of the attorneys' fees.

#### **17. How are damages awards calculated? Is it possible to obtain punitive damages?**

Since 2007 damages awards have been calculated in consideration of both the patent holder's lost profits and the infringer's profits. Accordingly, damages may be higher than the patent holder's lost profits if the infringer's profits are greater.

Alternatively, damages may be determined on the basis of a royalty fee. In many cases, the court will base the determination of damages on lost profits when the patent holder uses the invention in France by manufacturing the patented product or using the patented process. Damages based on a royalty fee will be applied when the patent holder does not use the invention in France or merely imports the patented products into France.

Punitive damages are prohibited under French law.

#### **18. How common is it for courts to grant permanent injunctions to successful plaintiffs and under what circumstances will they do this?**

In most cases, successful plaintiffs will obtain an order for permanent injunction from the first instance court. A permanent injunction is always

obtained if the decision is final (ie, there is no appeal) or if the plaintiff succeeds on appeal.

#### **19. How long does it take to obtain a decision at first instance and is it possible to expedite this process?**

A decision on infringement and the validity of the patent at first instance takes between 12 and 18 months. In urgent cases, plaintiffs may obtain a decision on the merits within four to six months. The expedited procedure with a fixed date for oral pleadings should be limited to very straightforward cases, as the plaintiff may not submit evidence other than that submitted with the brief of summons. This expedited procedure is not recommended in patent cases; preliminary injunction requests should be preferred.

#### **20. Under what circumstances will the losing party in a first instance case be granted the right to appeal? How long does an appeal typically take?**

There are no restrictions on the circumstances in which a losing party may appeal – a first instance decision may always be appealed. An appeal takes between 12 and 18 months.

#### **21. Are parties obliged to undertake any type of mediation/arbitration prior to bringing a case before the courts? Is alternative dispute resolution a realistic alternative to litigation?**

The parties have no obligation to undertake any type of mediation or arbitration prior to bringing a case before the court. Alternative dispute resolution may be an option where the parties want to keep the decision confidential.

#### **22. In broad terms, how pro-patentee are the courts in your jurisdiction?**

The courts tend to follow the decisions of the EPO. If a European patent has been maintained after opposition, the court will usually recognise the validity of the patent, unless more pertinent prior art is presented.

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

France signed the London Agreement on Translations on July 1 2001. The agreement entered into force on May 1 2008. **iam**

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Caroline Casalonga is a French lawyer, who specialises in IP litigation. She represents technology companies in patent litigation and in litigation involving other forms of intellectual property. She has extensive experience in litigation before the French IP courts. She is very reactive and understands the business needs of clients. Her pleadings are clear and assertive.

Ms Casalonga obtained her law degree from the University of Paris Assas in 1991 and an LLM from Cornell University in 1996. She was admitted to the Paris Bar in 1993. Ms Casalonga is a member of the International Association for the Protection of Intellectual Property, the European Patent Lawyer Association, the Licensing Executives Society and the International Trademark Association.