

Bird & Bird

France

Patent Litigation Q&A

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France – Patent Litigation

Where can patent infringement actions be started? Is there a choice of venue?

Civil actions and claims relating to patents shall be brought exclusively before the Court of Paris (“*Tribunal judiciaire de Paris*” at first instance and “*Cour d’appel de Paris*” on appeal).

This is an exclusive jurisdiction of the Paris court, meaning there is no choice of venue. In the case of patents and supplementary protection certificates, the President of the Paris Judicial Court also has exclusive jurisdiction to carry out an infringement seizure anywhere on French territory.

Are the judges’ specialists? Do they have technical backgrounds?

At the Court of Paris, several judges (1st instance and appeal court) are dedicated to IP litigations but they have no specific technical background.

How long does it take from starting proceedings to trial?

The Judicial Court of Paris usually brings cases to trial within 18 to 24 months of commencement of proceedings.

Can a party be compelled to disclose documents before or during the proceedings?

France has implemented the so called “IPR Enforcement Directive” n°2004/48/EC including the right of information. The court may order, upon request from the claimant, that information on the origin and distribution networks of the goods or services which are alleged to infringe be provided by the defendant, and/or any other person found in possession of the alleged infringing goods, using the alleged infringing services or providing services used in alleged infringing activities.

The right of information is independent of the infringement seizure – it is usually ordered as an additional measure to a seizure proving an infringement if not all the relevant information has been gathered during the seizure and may be ordered during the proceedings (on the merits or in interim proceedings). However, this right of information does not serve to prove the materiality of the infringement. The judges will consider the seriousness of the request and whether it is proportionate and respects confidentiality to order the communication of information.

The forced production of evidence may be ordered on a more general basis under the Code of civil proceedings. It follows directly from the general principle of the collaboration of the parties in the determination of the truth. However, the burden of proof is quite high to order force production of evidence.

How are arguments and evidence presented at the trial?

Arguments and evidence are presented by way of written submissions up to the oral hearing. At the oral hearing, the parties will present their claims and means of defence, including law, facts and arguments before the court. The claimant speaks first, then the defendant. The judges may ask the parties questions on specific aspects of the claim.

How long does the trial generally last and how long is it before a judgment is made available? Are judgments publicly available?

The oral hearings generally last 1 to 3 hours. The judges will deliberate separately after the oral hearing but would not render their decision at the end of the oral hearing.

The judgments are generally communicated to the parties 1 to 3 months from the oral hearing.

The judgments are made publicly available, but the court does not publish them. Judgments are typically available on private dedicated web platforms.

Can a defence of patent invalidity be raised? Are infringement and validity issues heard together?

Invalidity of a patent may be requested as a defence against an infringement action. It may be requested as a means of defence, a counterclaim or a main claim for revocation of the patent.

There is no bifurcated system, and so the infringement and invalidity claims are heard together unless there are exceptional circumstances requiring separate actions. Typically, this would be if too much time has passed between the start of a main action for revocation and a separate main action for infringement and so hearing both actions together would prejudice the 1st action. If the nullity is requested as a counterclaim or defence means, both infringement and validity are heard together.

Are infringement proceedings stayed pending resolution of validity in the national patent office (or, if relevant, the EPO) or another court?

Two situations should be differentiated:

- A court seized of an action for infringement of a French patent covering the same invention as a European patent that is applied for by the same inventor, or granted to him or his successor in title, with the same priority date shall stay proceedings until the date on which the French patent ceases to have effect, or until the date on which the European patent application is refused, withdrawn or deemed to be withdrawn, or the European patent revoked. This stay is mandatory by law.
- In other cases (typically a claim for infringement involving a European patent under opposition) the proceedings are stayed at the court's discretion, depending on whether a stay is in the interests of a good administration justice.

Are preliminary injunctions available? If they are, can they be obtained *ex parte*? Is a bond necessary? Can a potential defendant file protective letters?

Preliminary injunctions (PIs) are available for patents.

In theory, PIs can be obtained *ex parte* but such *ex parte* proceedings are exceptional. In practice PIs are almost always inter partes proceedings, where the defendant can file written submissions/exhibits and to be represented by their lawyers at a quite comprehensive oral hearing.

Overall, PIs are granted in cases where there is a likelihood of success of the infringement action whilst considering the validity of the patent (if raised as a defence by the alleged infringer). The PI gives rise to a personal assessment by the court of the actual need for a PI. The court would consider whether a PI would be proportionate (weighing up pros/cons of an injunction regarding both the claimant's and the defendant's interests). In contrast with some other countries, the delay in requesting the PI after knowledge of the infringement acts and urgency are not specific requirements for granting a PI.

A bond is not necessary.,but it may be ordered by the court.

There is no concept of protective letters available for a defendant.

Are final injunctions available as of right? Is a bond necessary?

The court will grant final injunctions if the claimant is successful, but this is a matter up to the court's discretion. The Court may order only a part of the requested injunctions if it sees fit.

A bond is not necessary but may be ordered by the court.

What other remedies are usually ordered if a patentee is successful?

The remedies available include financial damages, the delivery up or destruction of infringing goods, recall from commercial channels, appropriate measures for the publication of the judgment, and/or an award of costs.

Would the tribunal consider granting cross-border relief?

Concerning infringement actions, the French supreme court (“*Cour de Cassation*”) recently ruled (on June 29, 2022 - *Hutchinson (FR) vs Global Wheel*) that the French courts may have jurisdiction over acts of infringement committed outside the French territory where the infringement action involves a number of defendants, one of them being domiciled in France and the same product infringes at least the same national part of a European patent (Art. 8(1) EU regulation n°1215/2012 and following the CJEU decision C-616/10 - *Solvay vs Honeywell*) or, independently, in case the claimant is of French nationality where no other rule on territorial jurisdiction applies (Art. 14 French Civil code).

However, it would be contrary to EU Regulation n°1215/2012 and current case law to issue a cross-border relief on the validity of a patent. The French judges would decide on the validity of the FR national part of a European patent only, even raised as a defence to an infringement claim (CJEU decision C-4/03 - *Gat v LuK*).

Is there a right of appeal from a first instance judgment? How long between judgment at first instance and hearing the appeal?

It is possible to appeal against a negative decision of the first instance. The case is examined and retried by the court of appeal.

The time between the 1st instance judgment up to the end of the appeal proceedings is typically between 12 to 24 months depending on the complexity of the case.

Is an appeal by way of a review or a rehearing? Can new evidence be adduced on appeal?

An appeal is by way of a rehearing of the facts and law of the case. The case is re-examined de novo by the appeal court.

The parties may invoke new arguments and file new pieces of evidence. However, the appeal rehearing is limited to the claims submitted in the first instance unless specific circumstances exist where a new claim may be allowed in appeal proceedings.

What is the cost of a typical infringement action to first instance judgment? If the issues of invalidity and infringement are bifurcated, what is the cost of the invalidity action? Can the winner's costs be recovered from the losing party? How much is the cost of an appeal?

French courts of first instance do not require any court fees. However, patent litigations involve attorneys' fees, patent attorneys' fees, bailiff's disbursements.

The costs may vary depending on the level of technical difficulty, the interests at stake and the patent(s) involved. There is no bifurcated system. The costs are generally between €50,000 and €200,000 in total. The costs could be up to €500,000 for the most complex matters and are only higher in exceptional cases. The costs largely depend on the complexity of the case and possible judicial and/or private expert's reports, bailiff's reports, etc. The costs include the defence to a revocation action of the infringed patent.

The costs for appeal proceedings are usually half to two-thirds of the first instance proceedings. The winning party may recover its defence costs from the losing party. These costs typically include attorneys' fees, patent attorneys' fees, bailiff's disbursements, etc. The awarding of such costs are at the court's discretion.

In practical terms, the parties usually disclose the total amount of their costs going into the trial. There are no separate proceedings regarding the recovery of costs, the judgment will include an order on the costs (if requested). Separate proceedings are however possible for deciding on the amount of financial damages.

Note: The information in this document relates to litigation through the national jurisdiction and not the UPC.

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