



MAX-PLANCK-GESELLSCHAFT



TECHNISCHE
UNIVERSITÄT
MÜNCHEN

THE GEORGE
WASHINGTON
UNIVERSITY
LAW SCHOOL
WASHINGTON D.C.

MIPLC Studies
Edited by

Prof. Dr. Christoph Ann, LL.M. (Duke Univ.)
Technische Universität München

Prof. Robert Brauneis
The George Washington University Law School

Prof. Dr. Josef Drexl, LL.M. (Berkeley)
**Max Planck Institute for Intellectual Property,
Competition and Tax Law**

Prof. Dr. Thomas M.J. Möllers
University of Augsburg

Prof. Dr. Dres. h.c. Joseph Straus,
**Max Planck Institute for Intellectual Property,
Competition and Tax Law**

Volume 4

Esther Seitz

Fact-Gathering in Patent Infringement Cases: Rule 34 Discovery and the Saisie-Contrefaçon



Nomos

MIPLC

Munich
Intellectual
Property
Law Center

Augsburg
München
Washington DC

Die Deutsche Nationalbibliothek verzeichnet diese Publikation in der Deutschen Nationalbibliografie; detaillierte bibliografische Daten sind im Internet über <http://dnb.d-nb.de> abrufbar.

The Deutsche Nationalbibliothek lists this publication in the Deutsche Nationalbibliografie; detailed bibliographic data is available in the Internet at <http://dnb.d-nb.de>.

a.t.: Munich, Munich Intellectual Property Law Center, LL.M., Thesis, 2008

ISBN 978-3-8329-4855-9

1. Auflage 2009

© Nomos Verlagsgesellschaft, Baden-Baden 2009. Printed in Germany. Alle Rechte, auch die des Nachdrucks von Auszügen, der fotomechanischen Wiedergabe und der Übersetzung, vorbehalten. Gedruckt auf alterungsbeständigem Papier.

This work is subject to copyright. All rights are reserved, whether the whole or part of the material is concerned, specifically those of translation, reprinting, re-use of illustrations, broadcasting, reproduction by photocopying machine or similar means, and storage in data banks. Under § 54 of the German Copyright Law where copies are made for other than private use a fee is payable to »Verwertungsgesellschaft Wort«, Munich.

The author would like to thank her parents,

Iris and Günter Seitz,

for making all of her academic endeavors a possibility.

Further, the author thanks Professor Paul Goldstein

for his guidance with this project.

Table of Contents

I.	Introduction	9
II.	Federal Rules Discovery	11
	A. Rule 34	15
	1. Inspection of Things – Types of Items Covered	16
	2. Premise Inspections	17
	3. Custody, Possession, Control	18
	4. Obligation to Preserve and Spoliations	19
	B. Context of Rule 34 amid Other Discovery Rules	19
	1. Privileges	20
	2. Protective Orders	21
	3. Motions to Compel and Sanctions	22
III.	Saisie-Contrefacon	23
	A. Before the Saisie: Ex Parte Application for Inspection	24
	B. During the Saisie: Carrying out the Order	26
	C. After the Saisie: Suit and Possibility for Appeal	29
IV.	Comparing and Contrasting Basic Aspects of the Saisie and Rule 34	31
V.	Specific Patent-Related Aspects of Evidence Gathering	35
	A. Third Party Production	35
	B. Trade Secrets and Secret Commercial Information	36
	C. Costs	38
	D. Duration	39
	E. Extraterritorial Application	40
VI.	Evaluative Comparison of the Procedures' Strengths	45
VII.	Conclusion	49
	List of Works Cited	51

