little sympathy for parties who chose to "sit on their hands."[305] Depending on the issues' complexity, courts, generally, permit between three and twenty-four months for discovery.[306]

Accordingly, in terms of timing, the Saisie better accommodates patent litigants, as well as the industries and consumers making use of patented inventions. This is because quick resolutions of infringement issues restores certainty in the market and thereby increases transactions (such as licensing) involving the patent as well as further improvements of the invention it incorporates. This procedural aspect also makes litigation and the enforcement of patents less burdensome to the rightholder and thereby strengthens his right to the full extent permitted by the substantive law.

E. *Extraterritorial Application*

Besides Belgium, no other country knows the Saisie as it exists in France.[307] While the Saisie is unique to those two jurisdictions, the United States and Japan remain the only countries litigating significant numbers of patent cases that entirely lack a comparable measure for securing evidence.[308] This absence of such a pre-summons, *ex parte* measure means that infringers can systematically destroy proof of infringement as long as no lawsuit exists, and rightholders may not legally access premises hosting infringing operations to secure such evidence before filing suit.

The laws of Italy and Spain, which generally share significant commonalities with the French legal system, know measures similar to the Saisie.[309] Even the United Kingdom, as well as many of its former colonies following a substantially-similar common law system,[310] permit *ex parte* civil searches for purposes of securing infringement evidence before service of process.[311] The orders permitting such searches, known as *Anton Piller* orders, direct the respondent, who as in the Saisie is often the defendant later, to permit certain people to enter his premises for inspecting, copying, searching and potentially removing certain enumerated items.[312] However, the British practice differs from the Saisie in that it requires more proof by the rightholder before granting

305 *Id*.
306 *Id*. Such a timeframe would be noted in the scheduling order. *See* FED. R. CIV. P. 16 (b)(1).
307 BIZOLLON ET AL., *supra* note 157, at 3.
308 Interview with Judge Takami Shintaro, Associate Justice, Osaka District Court, Japan, in Munich, Germany (Aug. 26, 2008). All European Member States *had to* adopt such measures under Article 7 of Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights. Council Directive 2004/48/EC, 2004 O.J. (L 157) 32 (EC) (Enforcement Directive).
309 Bertoni et al., *Forum Shopping Prospers Despite Enforcement Directive*, 69 – 70, Managing IP (July/August 2008).
310 *See* Daniel S. Drapeau, *Anton Piller Orders: The Latest Word from the Supreme Court, the Federal Court of Appeal and the Federal Court*, 20 INTELL. PROP. J. 39 (2006) (explaining the history of Anton Piller Orders in the U.K. and their adoption by the Canadian judiciary).
311 British Civil Procedure Rules (CPR) 1997, §7. Before being codified, this practice was authorized by case law under Anton Piller KG v. Manufacturing Processes, [1976] Ch 55 and its progeny.
312 CPR 1997, §7; Bertoni, *supra* note 309, at 70.

an inspection.[313] As mandated by the Directive 2004/48/EC,[314] Germany, which previously lacked a procedure analogous to the Saisie, finally, adopted a preliminary measure permitting rightholders to secure evidence of infringement. Because this law was only recently implemented, it remains unclear how effective and powerful a tool it provides to rightholders.[315]

Despite the availability of similar measures in other jurisdictions, none reward such a relatively modest effort by the plaintiff with a right as potent as the Saisie.[316] This, coupled with many jurisdictions' welcoming reception of evidence gathered under the Saisie,[317] has made it a popular instrument for plaintiffs all across Europe.[318] The Saisie lends itself markedly well for export. It touts a track record of frequent involvements in cross-border disputes and often generates evidence that ends up in litigations outside France.[319] In fact, many European law firms use the opportunity of applying the Saisie extraterritorially as an advertising tool. Scores of websites boast how their attorneys can attain quality infringement evidence cheaply and effectively via a Saisie.[320] This is usually done by way of filing a *pro forma* lawsuit in France that avails plaintiffs of the Saisie procedure, while, concurrently, filing an infringement suit elsewhere[321] and actually *pursuing* the main infringement action there with the help of the Saisie-adduced proof.[322] This requires plaintiffs to own the same patent

313 That is, the rightholder must demonstrate that the infringer will likely destroy evidence. *See* Bertoni, *supra* note 309, at 70.

314 Enforcement Directive, *supra* note 308. The German Bundesrat, at last, transposed the Enforcement Directive on May 23, 2008.

315 In fact, the German lawmaker exceeded the deadline for implementing the Enforcement Directive, on April 29, 2006, by over two years.

316 BIZOLLON ET AL., *supra* note 157, at 3; *see generally* Larry Coury, Note, *C'est What? Saisie! A Comparison of Patent Infringement Remedies among G7 Economic Nations*, 13 FORDHAM INTELL. PROP. MEDIA & ENT. L.J., 1101, 1152 – 1154, 1158 (2003).

317 Cohen & Kohler, *supra* note 159 (characterizing Germany as a jurisdiction "reticent with respect to disclosure injunctions but at the same time open to the use of disclosure results obtained in foreign jurisdictions.")

318 *See* Bertoni, *supra* note 309, at 69.

319 *Id*.

320 *E.g.* Jochen Bühling, *Obtaining Evidence When Preparing Patent Litigation*, ¶ ¶ 14 & 32, IP VALUE 2008, *available at* http://www.buildingipvalue.com/06EU/172_175.htm. (Explaining the saisie-contrefacon and previously stating: [W]hen advising clients about the necessary evidence, the possibility of obtaining evidence in other countries should always be considered."); *e.g.* Allen & Overy, website, *available at* http://www.allenovery.com/AOWEB/Knowledge/Editorial.aspx?contentTypeID=1&contentSubTypeID=7945&itemID=27083&prefLangID=411. ("We set up offensive strategies[,] such as filing simultaneous actions for patent infringement and gathering evidence of infringement in various countries by conducting saisie-contrefaçon in France[,] as well as defensive strategies […].")

321 Generally, plaintiffs seek fora proffering sizable damage awards (meaning the extent of the harm – and, thus, the market – must be large) as well as speedy adjudications and IP-specialized judges. Germany's district courts in Duesseldorf and Munich have, particularly, good reputations and plaintiffs often chose these tribunals to litigate important infringement claims. *E.g.* Richard A. Egli, *The Main Patent Litigation Countries in Europe*, 366 PRAC. L. INST./PAT. 35, 56 – 57 (1993) (ranking the major European patent litigation jurisdictions based on cost, procedural complexity, control, manageability and predictability of outcome, and sophistication; Switzerland wins, beating Germany by one point.); WORLD INTELLECTUAL PROPERTY ORGANIZATION, Advisory Committee on Enforcement, Second Session, *Intellectual Property Litigation Under the Civil Law Legal System; Experience in Germany*, WIPO/ACE/2/3, 3 – 8 (June 4, 2004) (*prepared by* Joachim Bornkamm). Professor Bornkamm is a judge at the German Supreme Court.

322 *See* ALLEN & OVERY *supra* note 320.

right in both France and the adjudicating jurisdiction, which, nowadays, often holds true, especially as regards European patents.

While the Saisie constitutes an admired and respected procedural tool for export, extraterritorial discovery under the Federal Rules has not been similarly welcomed and, indeed, has spawned what some term a "judicial conflict."[323] This is especially true for European civil law countries, which perceive the practice of discovery on their soil as offensive to their judicial sovereignty.[324] There, *courts* are charged with conducting depositions and gathering evidence.[325] Thus, the practice of attorneys performing depositions, making inspections, and requesting documents and items outside the presence of a judicial officer insults the judiciary's very *raison d'être*.[326] The civil law countries' discontent with discovery within their borders ultimately led to the conclusion of The Hague Convention on the Taking of Evidence Abroad in Civil or Commercial Matters (Hague Convention),[327] which establishes rules for gathering evidence abroad.[328]

The Hague Convention allows letters of requests through foreign courts, notices to appear before consular officers, and designation of private commissioners.[329] These procedures restrict U.S. lawyers from running wild in attempting to depose foreign litigants abroad or directly request information from them. However, the United States Supreme Court limited the effect and significance of the Hague Convention in *Societe Nationale Industrielle Aerospatiale v. United States Dist. Ct.*, by holding that application of the convention is merely optional and, moreover, that the party seeking to pur-

323 *See e.g.* Samuel Baumgartner, *Is Transnational Litigation Different?* 25 U. Pa. J. Int'l Econ. L 1297, 1313, 1326 – 1353 (2004) Judicial conflict or "Justizkonflikt" as first termed by German legal commentators essentially means a clash in two jurisdictions' procedures, which ultimately hampers and blocks the litigants' access to efficient and effective cross-border adjudication. *See id* at 1313 – 1314; *see also* ROLF STÜRMER ET AL., DER JUSTIZKONFLIKT MIT DEN VEREINIGTEN STAATEN VON AMERIKA (Walther J. Habscheid ed., Gieseking 1986) (including essays on the judicial conflict between the United States and Europe).

324 RESTATEMENT (THIRD) OF FOREIGN RELATIONS LAW § 442, Reporter's Note 1 (1987) ("No aspect of the extension of the American legal system beyond the territorial frontier of the United States has given rise to so much friction as the request of documents in investigation and litigation in the United States.")

325 Baumgartner, *supra* note 323, at 1351. Additionally, discovery's enablement of fishing expeditions and abuses such as overproductions (paper avalanches) has invited criticism from civil law scholars. *See e.g.* JUNKER, *supra* note 12 at 172 – 173.

326 *See* Baumgartner, *supra* note 323, at 1313 – 1322 (explaining that German lawyers perceived U.S. litigation as "both crude and threatening" because of "expensive party-driven discovery with comparatively immense scope and scant protection of trade and business secrets; and a willingness of at least some U.S. courts to enforce their procedural rules transnationally in the face of sovereignty objections by the foreign governments involved.") *Id*. at 1320 – 1321.

327 Federal Rule 28(b) references to the Hague Convention for taking depositions abroad.

328 Hague Convention on the Taking of Evidence Abroad in Civil or Commercial Matters, opened for signature Mar. 18, 1970, 23 U.S.T. 2555; *see* 6 MOORE ET AL., *supra* note 13, at §28.11[1]. All of the major patent litigations jurisdictions, except Japan,are signatories to the Hague Convention *See* Art. 42 (listing countries such as France, Germany, Italy, Netherlands, Spain, U.K. and the United States.)

329 Discovery under the Hague Convention is independent and alternative from Federal Rules discovery. *See* 6 MOORE ET AL., *supra* note 13, at §28.12 – 14. In choosing between Federal Rules or the Hague Convention, discovery, post-Aerospatiale courts consider the specific facts of a case such as: (1) the sovereignty interests involved, (2) the nature and intrusiveness of the discovery requested, (3) the probability that Hague Convention will effectively produce evidence. *See e.g.* In re Pierre Bottled Water Litig., 138 F.R.D. 348, 354 (D.Conn. 1991).

sue discovery under the convention must show that it should apply.[330] Thus, United States litigants may disregard the Hague Convention entirely and resort directly to the Federal Rules of Civil Procedure in conducting discovery abroad.[331] That comes back, full circle, to the risk of offending foreign nations' judicial sovereignty – a concern that did not seem to bother the *Aerospatiale* Court.[332] However, the legal and political backlash created by discovery perceived as offensive may ultimately disserve United States litigants in foreign courts[333] and can motivate reactive legislation such as blocking statutes.[334]

Under the Federal Rules, discoverable materials need not be located within the court's territorial jurisdiction; personal jurisdiction of the controlling entity suffices to enforce a Rule 34 request.[335] The Saisie's extraterritorial reach differs in that a French tribunal cannot reach beyond its geographic jurisdiction. Thus, the commonly-introduced Saisie-evidence in non-French tribunals was actually gathered in France and simply transported abroad for purposes of litigating the merits of a patent infringement action. The Federal Rules and *Aerospatiale*, however, do not similarly restrict a United States court from ordering the production of documents and things beyond that court's geographic district or even confine it to the United States.[336] Thus, discovery is much more aggressive than the Saisie, in that it applies itself in a foreign country, and, what is more, without necessarily requesting that country's approval.[337]

330 *Societe Nationale Industrielle Aerospatiale v. United States Dist. Ct.,* 482 U.S. 522, 533, 539 – 541 (1987).

331 *Id*.; Brief of the Government of the Federal Republic of Germany as Amicus Curiae in Support of Respondent, Societe Nationale Industrielle Aerospatiale v. United States Dist. Ct., 482 U.S. 522 (1986) (No. 85-1695); *see generally.* Baumgartner, *supra* note 323, at 1331 – 1348 (adding that the drafters of the Federal Rules helped create the judicial conflict by failing to consider the different manner in which civil law jurisdictions collect evidence) *Id*. at 1348. German law, on the other hand, perceives a U.S. court's order of taking discovery under the Federal Rules in a foreign state absent that state's consent as a violation of public international law. JUNKER, *supra* note 12, at 368 – 369. The DOJ used to support the same view. *See* Brief for the United States as Amicus Curiae, at 10, 12, In re Anschuetz & Co., GmbH, 754 F.2d 602 (5th Cir. 1985), *vacated sub nom*. Anschuetz & Co., GmbH v. Mississippi River Bridge Authority, 107 S. Ct. 3223 (1987) (No. 85-98).

332 Brief of the Government of the Federal Republic of Germany as Amicus Curiae in Support of Respondent, Societe Nationale Industrielle Aerospatiale v. United States Dist. Ct., 482 U.S. 522 (1986) (No. 85-1695).

333 Baumgartner, *supra* note 323, at 1347 – 48. (suggesting that the United States' ignorance in conducting discovery abroad has contributed to laws and attitudes in Germany which have disadvantaged U.S. parties' access to evidence located in Germany)

334 McKay, 16 N.Y.U.J.. Int'l L. & Pol. 1217, 1223 – 1226 (listing all blocking statutes existing at that time). "A blocking statute is a law passed by a foreign government imposing a penalty on a national for complying with a foreign [United States] court's discovery request." 6 MOORE ET AL., *supra* note 13, at §28.16. Such blocking statutes do not prevent a U.S. court from ordering discovery from a party over which it has jurisdiction, even if discovery compliance would violate the statute. *Id*. A party claiming that a foreign blocking statute prevents its production of certain materials, must make a good faith effort to have the foreign government waive the statute. The extent of effort which the nonproducing party exerts in seeking waiver controls the sanctions it will receive for noncompliance. *Id*. Since World War II every important trading partner of the U.S. has passed a blocking statute, which in practice serves to protect domestic undertakings from U.S. discovery requests "Vorlageanordnungen." JUNKER, *supra* note 12, at 395 – 397. Almost all countries having enacted blocking statutes did so in response to unilateral U.S. extraterritorial discovery efforts which the blocking nations perceived as threatening to a particular industry. BORN & WESTIN, *supra* note 19, at 282 – 283.

335 7 MOORE ET AL., *supra* note 89, at §34.14[2][b].

336 BORN & WESTIN, *supra* note 19, at 266 (suggesting that documents or things discoverable by Rule 34 must not be within the territorial jurisdiction of the court).

337 *See id*. at 264 – 267; *see generally* Baumgartner, *supra* note 323, at 1320 – 21.

Accordingly, comparing the Saisie and discovery's respective popularities when exported may be unjust, because the extent to which they apply extraterritorially (that is, beyond France and the United States, respectively) differs starkly. The Saisie itself is not subject to export, but the information it generates is. With regard to discovery, on the other hand, the mechanism itself is subject to export but, unlike in the case of the Saisie, not for purposes of a foreign but for a domestic action.[338] Despite these significant differences regarding extent and objective, both evidence-gathering devices are renowned for their extraterritorial application – the nature, extent, and reception of which differ significantly and help shape the picture of cross-border patent litigation.

338 *See* BORN & WESTIN, *supra* note 19, at 266 – 267 (suggesting that U.S. courts prefer using the Federal Rules, rather, than the Hague Convention, for gathering proof for domestic actions).