The Patent Lawyer

GLOBAL REACH, LOCAL KNOWLEDGE

www.patentlawyermagazine.com

September / October 2021

South Africa and Australia tackle AI inventorship in patents

Steven M. Shape, Managing Partner at Dennemeyer & Associates, questions whether AI-generated solutions will force patent systems across the globe to re-evaluate traditional notions of inventorship.

Patenting renewable energy
Page 18

Expert witness Page 36

German patent reform
Page 71

AIPPI 2021 WORLD CONGRESS SPECIAL EDITION

CTC Legal Media

Expert witness in Russian Court

Nikolay Bogdanov & Sergey Dorofeev, Partners at Gorodissky & Partners, explain the use of expert witnesses in Russian court with advice on best procedure.

As in many other countries, in Russia at the preparation stage of a patent infringement lawsuit the patent owner seeks the opinion of a sufficiently skilled technical specialist regarding use of the patented invention by the assumed infringer. Such technical specialist, which is usually a patent attorney in the beginning of a long story of infringement litigation, is expected to establish, based on available evidence, whether each and every feature of an independent claim of the patent is present in a product or process marketed or otherwise commercially used by such assumed infringer. The opinion confirming the use of the invention normally accompanies the court claim as evidence of the fact of use of the plaintiff's invention by the defendant.

Then the litigation starts. Sometimes the defendant does not deny the fact of use, and, for example, seeks a licensing agreement with the patent owner; however, in many cases the defendant prefers to follow one of numerous ways of defense providing non-use technical arguments.

Since, as a rule, the judges do not have sufficient technical knowledge to establish and evaluate the fact of use of the invention by making their own study of whether the claimed features are present in allegedly infringing product or process, a court-appointed expertise on such issue becomes a usual stage in almost all patent infringement litigations. Such stage includes selection of an expert or a number of them, appointing selected expert(s), and posing questions requiring expert opinion. The appointed expert(s) shall provide opinion basing on full, non-biased and professional consideration of the posed questions, which in patent infringement cases inherently requires study of the allegedly infringing product or process in comparison with a patented invention(s). Although the opinion of a court appointed expert shall be considered by the judge together and equally with the other evidence, such opinion may play a crucial role for the final decision of the court as well as for the whole court procedure.

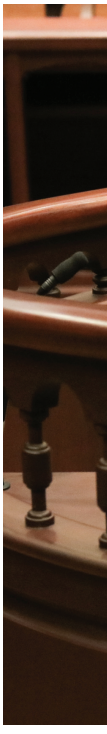
Nikolay Bogdanov

Sergey Dorofeev

Engaging court experts, having corresponding technical background to put light on the questions of the particular technologies, is more frequent in patent infringement litigation; however, a certain tendency to seek expert opinion in separate validity litigations regarding matters of novelty, inventiveness, industrial applicability, and associated with the latter sufficiency of disclosure may also be noted.

The court shall appoint court expertise at a request of one party or with consent of all the parties. Having made the conclusion to carry out the expertise, the court as a rule asks the parties to suggest candidate/candidates, to prepare the questions for response by the expert and to deposit expert remuneration. In line with those preparations the court shall be obliged to delimit materials and documents to be further analyzed by the appointed expert.

A court expert may be a state or non-state expert. A state court expert is a certified specialist who is an employee of a state owned court examination entity and whose service duty is conducting court examinations of particular types. State court experts are bound by requirement to pass re-certification every five years for confirming their skills. Appointing of state court experts in patent infringement cases is yet a very rare case, much more frequent in infringement cases are non-state experts. A non-state expert can have any kind of employment or even be a self-employed person, it is not essential for the court provided such expert possesses particular special knowledge for conducting needed expertise. Before appointing a non-state court expert, the court demands and considers information of such expert's educational background, profession, experience, position, etc., for estimating their sufficiency and relevance to the task posed before the expert.



Parties may raise objections against the expert basing on lack of necessary knowledge or skills in the field of examination, or on assumable expert's prejudice. Parties may request to be present at the expertise process. If this does not prevent normal activity of the expert, the court, in its notification of expertise, shall request the expert to inform the parties of the place and time of the expertise. The parties do not have the right to give oral or written explanations to the expert, e.g., containing factual or legal information. In addition, the parties shall in no way provide the expert with materials and documents relating to the expertise beyond the court.

While it is in the competence of the judges to choose the expert for a particular case at their own discretion, usually the judge selects candidates from those suggested by the parties, and that means each involved party should pay special attention to the matter of selection of the most appropriate expert. Since in a majority of cases it would be hardly possible to engage a foreign expert to a legal proceeding in Russia the foreign party will have to rely on the choice of the local representative. We recommend double-checking any candidate since the suggested option might not always be perfect.

To particularly point out the task we will require a person having knowledge and experience in the relevant field of art, who is able to educate the court in the required technical matter by explaining the technology in an adequate, logical and (what is the most important) simple manner. It should be a specialist who was working in the right field and preferably at the right time.

> **"A court-appointed expertise on such issue becomes a usual stage in almost all patent infringement litigations."**

Résumés

Nikolay Bogdanov, Partner & Russian Patent Attorney

After graduating from the Moscow Institute of Electronical Engineering and from Central Institute of Intellectual Property Mr. Bogdanov started his career in the Russian PTO as an examiner, researcher, Deputy Chief of Legal Department, Deputy Chief of Department for International Cooperation, and a Deputy General Director of the Russian PTO.

He contributed to the development of Russian legislative and regulatory acts in the IP area, drafting international agreements in the field of patent harmonization under WIPO. Mr. Bogdanov has also participated in intergovernmental negotiations, including those on Russia joining the WTO.

Mr. Bogdanov joined "Gorodissky & Partners" in 2004, and in 2006 was promoted to partner at the firm.

He advises clients on the Russian and foreign IP legislation including international IP treaties, conventions, agreements, and peculiarities of their implementation in Russia and provides expert judgment on the legal documents.

Sergey Dorofeev, Partner, Chief of Mechanics Department, Russian & Eurasian Patent Attorney

Mr. Dorofeev is a Partner at "Gorodissky & Partners" since 2002.

Mr. Dorofeev's primary focus is patent prosecution related to consumer goods and food industries, printing equipment, electronic plus mechanical devices.

In addition to supervising the activities a number of other patent attorneys as a Chief of Mechanics Department he personally attends to the most complicated patent matters.

Mr. Dorofeev has a vast experience of oppositions and appeals before the Russian and Eurasian Patent Offices and representing clients in a number of litigation cases. In addition, he is actively involved in technology transfer and licensing.

Apart from that the expert should have proper technical skills in the proper technical field, the expert should have good experience in the claims language construing and in comparison of the claims with the assumably infringing subject matter. In this respect, the expert shall properly evaluate technical issues of the use of language in the patent specification and in the prior art as well as the general state of knowledge and practice in the relevant field at the priority date.

Very often, the question of experiments may arise. Therefore, the expert should have an ability to use the appropriate equipment to carry out the required experiments, or we should be ready to suggest two or more candidates for complex expertise.

Of course, as in any other legal matter, the question of conflict of interests should be carefully checked before asking the candidate to serve as an expert. The most dangerous fact is that usually conflict of interests has a kind of submarine effect, appearing at the very final stage of the procedure and undermining the long ago obtained results.

You will appreciate that the best result is to get the very qualified technical person with very good skills of interaction in the court, since often a court expert is summoned to the court to give explanations on his opinion. However, as a rule, a perfect combination of these two abilities is very seldom.

Even for a very qualified expert in the particular field with good experience in the court, it would always be a challenge to answer provocative questions from the other side who would be trying to discredit the prepared opinion. One of our colleagues long ago took part in the court proceedings as the court expert in the case relating to infringement of the patented typewriter. The expert opinion was presented from which it was crystal clear that infringement took place. The expert was summoned to the court to answer the questions of the opposite party on the opinion. The only question was how to open the housing of typewriter. Actually, the housing had a hidden lock, opening the typewriter for the first time was hardly possible. Fortunately, since the expert, while preparing the opinion, used not only the typewriter manual but also the typewriter *per se* he easily managed to open the housing. If not, the whole opinion might have been discredited by the other side.

Still our practice in Russia clearly shows that if choosing between a prevailing good technical skills person and a person with dominating interactive abilities, we should rely on the technical skills persons.

Patent attorneys, according to the law of patent attorneys, have the right to serve as the court experts in IP rights enforcement cases, and, as a rule, namely patent attorney having both technical skills as well as legal knowledge may be the best candidate for the court expertise to establish use fact of the patent in the subject.

> **Who is able to educate the court in the required technical matter by explaining the technology in an adequate, logical and (what is the most important) simple manner.**

Appointed court experts are obligatory warned in writing of criminal liability for willingly giving a false conclusion. The court expert may need related materials and documents or access to the related objects. In this case, court may request the parties of the process or other parties to provide the required materials and documents or access to the subject in question. The parties may be fined by the court if the court request has been ignored.

It is interesting to mention the peculiarity of the cases being considered in the frame of the procedural civil code regulations, that is, within competitiveness of the common jurisdiction court. For these cases non-presenting of the materials requested by the court for the court expertise without good excuse reasons leading to court expertise failure is considered by the court as the established use/non-use fact in favor of the opposed party.

It was confirmed in the fourth common jurisdiction court cassation case *Individual v Astra pro* (No. 88-19725/2020, infringement of a patent for an apparatus for producing a PET packing), wherein the defendant, twice at the expertise at the first instance court as well as at the appeal stage, repeated expertise provided the subject misfit for court expert analysis. The cassation court decided in favor of the plaintiff using the above-mentioned procedural civil code stipulation.

The courts in Russia usually consider not only opinions by the court experts but will surely evaluate evidences presented by the parties, especially if they relate to the facts discussed in the opinion. These evidences and opinions of the specialists may sometimes have conclusive meaning.

If the party does not agree with the court expert opinion, it has the right to provide its own comments and counterarguments. The parties may request to summon the expert to the court to clarify grounds and conclusions. Advance preparation and active position of the party in the court expert inquiry may substantially influence on the level of trust of the judge to the court expert and eventually may be decisive.

In IP court cassation case *Astellas Pharma Inc. v. Nativa* (A41-62706/2019, infringement of RU patent No. 2165423) the court expert issued two similar opinions (the first one in the frame of the main expertise and the second one in the frame of the additional expertise, both being made at

the stage of the first instance court) stating that each and every feature of independent claim 1 for polypeptide compound and independent claim 6 for pharmaceutical composition of the patent are used in the pharmaceutical drug "Micafungin-native".

The question of argue in the proceedings was whether sodium micafungin, which is an active substance of "Micafungin-native", relates to the class of polypeptide compounds as it was stated in the two opinions of the court expert.

The evidence of the specialists by Nativa were more persuasive for the IP court than those of the court expert, so the IP court decided against the expert opinion that no infringement of the patent took place.

It is a normal practice in the court to have a single court expertise. However, in case some questions set by the court are still unclear after making a conclusion by the court expert, the court may appoint additional expertise with the same expert. If there are some doubts in reasonability of the opinion or contradictions in conclusions of the court expert, a repeated expertise setting the same questions may be carried out with appointing another expert. Practice of requesting repeated court expertise several times still exists but is rather seldom. In majority cases, it will hardly be accepted by the court.

In IP court cassation case *Individual v Steel Oboi* (A82-21013/2017) the plaintiff has lost the case in the court of appeal requesting to appoint repeated court expertise, which, if appointed, would be the third one in this case.

The plaintiff motivation was that the National Research University by Lobachevski used by the court exerts for carrying out experiments required for making the opinion neither confirmed its agreement to that nor provided the court with information of the corresponding technical possibilities for carrying out the experiments. The second argument was that the court of appeal rejected to appoint repeated court expertise in spite of the fact of having two contradictory court expertise opinions in this case.

The IP court supported the defendant and refused to appoint repeated court expertise confirming that the University was properly appointed by the court of appeal as the experimental base for the court expertise and that the plaintiff himself requested the repeated court expertise at the appeal stage.

From time-to-time judges put themselves into a kind of awkward position by appointing two different experts, suggested by plaintiff and defendant, to prepare their own separate opinions. Usually, it leads to appearing two opposite conclusions. Then judges as a rule are forced to sort out this legal dead-end by appointing repeated expertise using another expert.

> **"The question of conflict of interests should be carefully checked before asking the candidate to serve as an expert."**

Sometimes, but frankly very seldom, the courts may issue decisions on the patent cases not involving court experts and based only on the common logics or on the evidence by the specialists of the parties. It may however refer only to very simple subjects not requiring special technical knowledge or to rather self-contradictory cases.

One of such self-contradictory cases is cited here for information to give a notion of what difficulties one may face if the court expertise is not used. In IP court cassation case *Luxor v Saturn* (A65-29386/2019, infringement of RU utility model patent 123755 for illuminator) the key matter was whether the first instance court, as well as the appeal court, were correct not using the court expertise as a basis for the decision.

Both plaintiff and defendant at the first instance court stage provided their own opposite opinions, made by two patent attorneys each representing the corresponding party. The court managed to establish that the plaintiff

patent attorney improperly broadened the scope while construing the claims, and therefore at the end of the day both opinions just confirmed the fact of non-infringement. This conclusion was made without any assistance of an independent specialist having proper technical background.

The request for the court expertise applied by the plaintiff was objected by the court of the first instance as well as by the appeal court and the objection was confirmed by the IP court.

Further, we would like to draw your attention to some anecdotic approaches sometimes used by defendants to avoid negative court expertise opinions.

In IP court cassation case *Dipix v Iceberg and Deep 2000* (A40-211524/2016, infringement of utility model patent No. 159591 for a coin sorter) the defendant removed essential elements of the accused device presented to the court expertise and the court expert had nothing to do but to state non-use of several features of the patent in the device.

However, the court expert in the opinion stated that for a coin sorter it is illogical not to have a coin dosing unit as well as a coin valve taking into account the fact that there are provided a coin dosing unit mounting socket and a coin presence sensor of coins at the supply disk. Finally, the IP court supported the decision of the court of appeal that the patent is infringed.

In IP court cassation case *Isolator v Energo-transisolator* (A50-11383/2018, infringement of patent No. 251119 for a bird-protected isolator), the defendant deliberately advertised on its internet site the product which differed from the real isolator put into commercial turnover. In practice, the isolators produced by the defendant had additional features inherent to the patented invention. The court expert appointed at the first instance stage, trying to get down to bedrock, went beyond the questions set by the court and beyond her competency analyzing *inter alia* the materials, which were not officially provided by the court. Therefore, the opinion of the court expert was not taken by the court into account. The court of appeal appointed repeated expertise with another court expert, the opinion of which was opposite to the first one. The court of appeal did not properly evaluate two opposite expert opinions and did not find out why having the same materials the experts came to opposite conclusions. Accordingly, the IP court directed the case to the first instance court for reconsideration.

Apart from the rather anecdotic situation, the main take-away from this case is a necessity to request the court expert to strictly follow the procedural rules and not to go beyond the set questions and the provided materials for smooth proceeding and shortening time of considering cases.

> **Therefore, the opinion of the court expert was not taken by the court into account.**

Opinion of the court expert is only one of the evidences in the patent litigation. It is equal to other evidence and does not have any prejudgment. On the other hand, opinion of the distinguished expert may sufficiently influence the court conclusion of the use fact of the patented invention. The court however should not obligatorily follow the court expert conclusion. Therefore, it is quite possible that the judge decision is not in line with that conclusion.

In the appeal court case *Kombitekh v Serum Institute of India* (A40-60073/2009, infringement of patent No. 2238105 for genetically engineered vaccine[1] for prophylaxis[2] of virus hepatitis B[3]) the judge did not agree with the opinion of the court expert, which stated that the patented vaccine is used in the marketed product containing all the features of the patented invention known from the prior art and one feature equivalent to the single distinguishing feature of the patented invention.

The judge made emphasis on the fact that the differing feature of the patented invention cannot be interpreted as equivalent namely because it is the single distinguishing feature. Therefore, the court decided that the patented vaccine is not used in the marketed product of the defendant.

Since the court expertise very often plays the ultimate part in the patent litigation, the parties should pay careful attention to all the components thereof such as procedural particulars of the expertise, choice of the proper expert, drafting clear and adequate questions as well as detailed analysis of the opinion of the expert.

1 https://www.multitran.com/m.exe?s=genetically+engineered+vaccine&l1=1&l2=2

2 https://www.multitran.com/m.exe?s=prophylaxis&l1=1&l2=2

3 https://www.multitran.com/m.exe?s= hepatitis+B&l1=1&l2=2

Contact

Gorodissky & Partners
B. Spasskaya Str., 25, bldg 3, Moscow
129090, Russia
Tel: +7 (495) 937-6116
Fax: +7 (495) 937-6104
pat@gorodissky.com
www.gorodissky.com

Gorodissky & Partners

Practicing since 1959

PATENTS, TRADE MARKS, DESIGNS
UTILITY MODELS, COPYRIGHTS
LITIGATION, IP DUE DILIGENCE
ANTI-COUNTERFEITING, MEDIA-
TION, LICENSES, SEARCHES
TRANSLATIONS

Moscow, St. Petersburg
Kazan, Ekaterinburg
N.Novgorod, Krasnodar
Vladivostok, Samara
Novosibirsk, Perm
Sarov, Dubna, Ufa, Kiev

GORODISSKY

Head Office:
B. Spasskaya Str., 25, bldg. 3
Moscow 129090, Russia
Tel.: +7(495) 937 6116
Fax: +7(495) 937 6104/6123
E-mail: pat@gorodissky.ru
www.gorodissky.com