

Expert evidence in patent actions: should this be a necessity?

Expert evidence is a type of proof provided in Articles 464 to 480 of the Brazilian Civil Procedure Code (13105/2015). An expert assists the judge in order to help them form their understanding of the facts in the case, as this sometimes requires specialised technical and/or scientific knowledge.

Expert evidence creates a dialogue between the proceedings and the scientific field, in which tests, research and conclusions from this field contribute to a legal solution. This ensures an appropriate judicial protection for the specific case.

The Civil Procedure Code establishes the types of expert evidence, determines the procedure to be followed and specifies the cases in which such measures are necessary. In addition, it provides that the judge must appoint an expert on the subject matter. An expert is selected from a database (maintained by the court to which the judge is linked) of legally qualified professionals and technical or scientific bodies.

Further, the code allows parties to appoint a technical assistant to monitor the production of expert evidence and submit questions for the court expert and technical assistants. The report analysis is attached to the court records with the inquiry answers and also provides clarification on the technical subject.

There is a particular need for this process in patent-related actions (eg, infringement and patent nullity). This is because the analyses of the merits of these cases, if carried out exclusively by the judge and without a proper technical background, could lead to unfair and prejudicial decisions, because these matters require such technical knowledge.

The expert should have an academic background and practical-professional experience in the relevant field of the patent in order to assist the judge in deciding, for example, whether the patent in question should be annulled.

In this way, not only would the court consider the arguments and evidence submitted by the parties, but also the technical analysis made by the expert, which would allow a higher quality of judicial accuracy.

Therefore, the production of expert evidence in actions involving patents is essential, given the specificity of the object under discussion, for it demands scientific and technical knowledge that goes beyond the capability of the judges.