



The Russian Ministry of Justice introduces a new option for forensic examinations in intellectual property cases



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INTELLECTUAL PROPERTY, RUSSIA

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The Russian Ministry of Justice introduced a draft amendment to its Order no. 237 dated 27 December 2012 concerning forensic examinations performed by special State institutions. The examination of intellectual property objects shall be a new category of expert study/assessment, and the review of intellectual property objects shall constitute new expert qualification.

The reason for this reform is to solve the existing difficulties that are met by the courts in appointing experts to answer technical IP issues arising in a case.

Under the current legislation, the parties may recommend experts for performing the assessment of intellectual property objects to the court, or produce an examination report by an independent

expert as an evidence. The Ministry states that it may be difficult for the court to understand the level of competence and scope of experience of the experts offered by the parties, whilst the assessments provided by experts qualified by the Ministry of Justice ought to be a simple and durable solution with both a guaranteed level of quality of the service and of independence.

In accordance with Federal Law no. 73-FZ dated 31 May 2001 State forensic expertise provides support to courts, judges, bodies of inquiry and preliminary investigation to answer the non-legal questions necessary to adjudge a case. More particularly, the forensic examination is the procedural action consisting of the examination, assessment and supplying opinions on scientific, technical, art or craft areas that



require special knowledge. The examination is performed by experts of designated authorized institutions of State authorities. All forensic examinations made in the same area shall be based on homogeneous scientific criteria and methodologies.

The Law also allows the carrying out of forensic examinations by experts without the official status of State expert subject to possessing the necessary competence and experience. In such a case, all main principles of forensic examination and requisites applicable to experts, the assessment activity and the report provided by the Law are also applicable to the examinations made by such experts.

There is no doubt that materials and issues connected with technical solutions protected by patents may need an expert assessment and the answering of specific questions, and it is essential that the expert should be possessed of adequate qualifications. The newly introduced possibility to obtain an opinion from a State expert may be of use to the court when the parties provide conflicting expert assessments or disagree on the name of the court-appointed expert.

However, the resort to forensic examination is not mandatory for all IP matters. For example, it is not needed for trademark similarity assessments. A recent resolution of the Supreme Court (Resolution of the Supreme Court "On enforcement of part 4 of the Russian Civil Code" no. 10 dated 23.04.2019) made it clear that the issue of the level of similarity between trademarks cannot be referred to an expert and must be resolved by the court, which should place itself in the position of an ordinary consumer that does not have any specific knowledge.

Conversely, the assessment of usage of a copyrighted work, infringement of related rights, independence of created work, as well as other technical questions in connection to intellectual property may need assistance of the expert.

The amendment does not annul or replace the option to seek or provide as evidence the examination of a non-State expert, but is rather supposed to provide a choice between State and non-State experts.



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