



Patents 2009

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Brazil

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Patent enforcement proceedings

1 Lawsuits and courts

What legal or administrative proceedings are available for enforcing patent rights against an infringer? Are there specialised courts in which a patent infringement lawsuit can or must be brought?

Criminal and civil legal proceedings are available for enforcing patent rights against an infringer. A patent infringement lawsuit can be brought in any competent state court according to the procedural law. Federal courts have jurisdiction over erga omnes invalidity and title adjudication claims. Although very controversial, it is arguable that there is a possibility of joinder infringement and invalidity claims. So far, in a 2006 decision, a federal court denied a joinder infringement and title adjudication claim.

The Brazilian Industrial Property Law (Law No. 9279/1996) specifically authorised the judicial power to create special courts to settle issues involving intellectual property; however, just a few federal and state courts throughout the territory have created special benches or sections.

2 Trial format and timing

What is the format of a patent infringement trial? To what extent are documents, affidavits and live testimony relied on? Is cross-examination of witnesses permitted? Are experts used? Are disputed issues decided by a judge or a jury? How long does a trial typically last?

Usually a patent infringement trial follows the course of an ordinary civil action, in which the evidence requested by the parties is relied on according to the discretionary power of the judge. Evidence may include documents, affidavits, live testimony, cross-examination of witnesses, and experts (court-appointed and private). Judges usually place great reliance on the court expert's report.

For a criminal action, a preliminary search and seizure court order for obtaining evidence accompanied by two court-appointed experts and a court officer is usually a condition for further criminal prosecution. Hence, the titleholder often starts enforcement through a preliminary criminal search and seizure complaint, followed by a criminal complaint against the natural entities (usually the partners or directors of the infringing legal entity) and a civil complaint against the legal entity claiming a permanent injunction and damages.

Depending on the venue, the trial may take a year; however, it is more likely that inferior court proceedings take more than two years.

Disputed issues in both civil and criminal patent trials are decided by a judge.

3 Proof requirements

What are the respective burdens of proof for establishing infringement, invalidity and unenforceability of a patent?

The burden of proof lies on the party alleging the disputed fact, except when a product is alleged to have been made infringing a patented process, in which case the burden of proof shifts to the alleged infringer.

4 Standing to sue

Who may sue for patent infringement? Under what conditions can an accused infringer bring a lawsuit to obtain a judicial ruling or declaration on the accusation?

The titleholder or his licensees are entitled to sue for patent infringement. In the case of the licensee, it is necessary to record the licence agreement before the Patent Office, preferentially with a clause empowering the licensee to bring the action, because it is controversial if a licence agreement without said clause allows the licensee to bring the action. A non-exclusive licensee also has standing to bring an action for infringement.

A party must convincingly show standing to sue for bringing a declaratory judgment of non-infringement or invalidity (nullity). A party who receives a cease-and-desist letter or which otherwise shows an actual controversy with the accuser, even though without an effective and actual injury, will invariably have good standing to sue.

An infringement action in a state court is usually replied with a non-infringement and inter partes invalidity counterclaim, or a separate erga omnes invalidity legal action in a federal court.

5 Inducement and contributory infringement

To what extent can someone be liable for inducing or contributing to patent infringement?

The Brazilian Industrial Property Law defines as a crime the act of supplying a component of a patented product, or material or equipment to practise a patented process, provided that the final application of the component, material or equipment leads necessarily to the exploitation of the object of the patent. Inducement is also sanctioned by the criminal law.

Civil liability does not require that the final application of the component, material or equipment leads necessarily to the exploitation of the object of the patent. Nonetheless, it is more likely that contributory liability will require that:

- the means supplied or offered by the contributory infringer relate to a substantial element of the subject matter of the patent;
- the means supplied or offered by the contributory infringer are for an infringing use; and