

# The Role of Experts in Patent-infringement Cases in the UAE

**El-Ameir Noor** - Partner - Litigation

a.noor@tamimi.com - Abu Dhabi

Zane Anani

z.anani@tamimi.com - Dubai, UAE

In this case, the Claimant requested an expert to determine whether his invention was protected by the patent in question and determine the extent of the Defendant's use of the invention and the profits made as a result of the alleged patent infringement. Compensation for moral damages as well as profits gained by the First Defendant was also claimed by the Claimant.

It is important to note in this case that the Claimant challenged the integrity of the committee of experts appointed by the court and raised allegations that the experts appointed by the court were not impartial (the Claimant argued that one of the experts worked for a patent and trademark law firm that had a close business relationship with the Second Respondent); however, the Claimant's appeal was rejected. It is well established by the Court of Cassation that the trial court has full discretion to find facts and weigh evidence, adopting and discarding evidence to the extent that it finds it persuasive. The court need only explain the truth of which it is convinced with supporting evidence. The trial court may adopt the report of a court-appointed expert over the report of a consultative expert (in this case the consultative expert was appointed by the Claimant) if it considers his analysis of the points at issue to be sufficient.

The Claimant's claim for infringement and request for the Defendants to cease using the patent was not successful and therefore the Claimant was not entitled to any remedies.

## **Background**

The action was brought before the Abu Dhabi courts by an inventor (the Claimant) against a telecommunications corporation (the First Defendant). During the proceedings, the First Defendant joined the Second Defendant. The Second Defendant was joined on the basis that they were the owner of the system which the First Respondent had purchased. The patent related to a service, the "Mobile TV service", which allows subscribers to view selected TV channels using live streaming of satellite TV programming.

The dispute revolved around purely technical issues and therefore experts were needed. It is common practice for UAE courts to adopt experts' report as part of its reasoning in its decision.

The Claimant challenged the integrity of the committee of experts appointed in this case by raising allegations that the experts appointed were not impartial.

## **Court of First Instance**

The Court of First Instance issued its judgment in favour of the Claimant, ordered the First Defendant to pay compensation in the amount of AED 30 million for the patent infringement and ordered the First Defendant to cease using the mobile TV system. The Court of First Instance based its decision on a consultative experts' report which the Claimant had commissioned.

Both parties appealed the Court of First Instance judgment. The Claimant appealed to amend the compensation to AED 100 million and the First Defendant argued that the Court of First Instance had misapplied the law by relying on a consultant's report prepared at the request of the Claimant, from a

consultant whose background was unknown, was not a sworn expert and without the Defendants involvement. The Second Defendant joined the First Defendant in its appeal and requested the same remedies.

### **Court of Appeal**

The Court of Appeal rejected the Claimant's appeal on the basis that his objections were without merit.

The Court of Appeal issued a preliminary decision to appoint a tripartite panel of experts consisting of a telecommunications expert, a patent expert, and an accounts expert. The Experts Division at the Judicial Department, Abu Dhabi, nominated a patent expert and accounts expert from among its own experts but nominated an international expert in telecommunications engineering from among the experts put forward by the Second Respondent from this area of specialty (given the lack of experts practicing within this area at the Judicial Department).

The Court of Appeal held that it was clear from the report of the tripartite panel of experts that the First Defendant did not infringe the Claimant's patent, and issued its judgment overruling the Court of First Instance judgment and rejecting the claim of the Claimant.

### **Court of Cassation**

The Court of Cassation (in Civil Appeal 81 of 2016) upheld the Court of Appeal's decision and held that it was clear from the report of the panel of experts that there was no infringement and the system used by the First Defendant and integrated by the Second Defendant was different to the Claimant's patent. In addition, the First Defendant had purchased the system they implemented from the Second Defendant pursuant to a letter of intent which predates the filing of the Claimant's patent.

### **Comment**

This case confirms the general rule that the court may rely on an expert report if it has not seen any grounds on the challenges against it. In this case, the committee of experts produced a report that was very clear and the committee had complied with its assignment.