

S. Naumenko,

PhD in Law, Head of Sumy Branch of NSC “Hon. Prof. M. S. Bokarius FSI”,
Sumy, Ukraine,

ORCID: <https://orcid.org/0000-0002-2167-4149>, e-mail: svhndise@meta.ua

L. Zolota,

PhD in Law, Assistant of the Department of Criminal Law and Procedure
at Sumy State University of Academic and Research Institute of Law,
Forensic Expert of Sumy Branch of NSC “Hon. Prof. M. S. Bokarius FSI”,
Sumy, Ukraine,

ORCID: <https://orcid.org/0000-0002-1100-4520>,
e-mail: zolotalesia@gmail.com

Features of intellectual property analysis in Ukraine and abroad

Issues on the implementation of intellectual property analysis in Ukraine, as well as a forensic expert participation in court hearing abroad were considered. Intellectual property objects belong to a variety of types of art, science, technology and crafts, effective consideration of cases related to protection of intellectual property rights, for a complete and comprehensive study of the subject of examination and providing an expert's conclusion becomes possible only in case of attracting specialists, who have special knowledge in a particular field.

The article purpose is to define features of intellectual property analysis in Ukraine and formal requirements for a forensic expert in Ukraine and foreign states.

One of the priority directions of state policy is the protection of intellectual property rights, as the development of this area stimulates innovation in all fields by increasing the country's economy to a new level, and providing it a rightful place at the international level. Also, an increase of scientific potential not only promotes Ukraine's modernization in various fields of science and technology but also increases its defense capability and national security.

Today there is a negative state of compliance with the legislation regulating intellectual property issues, the number of violations of relevant rights is increasing. The reason for such a state is the imperfection of the mechanism of legal protection and protection of intellectual property rights in the field of scientific activity, failure to resolve the issue regarding legal protection of scientific advances, etc. In January 2020, the European Commission made a publication of a report on protection and ensuring intellectual property rights in third countries, according to which (despite all preventive measures) our country was already on the list of countries, where there are serious systematic

problems in the field of defense and protection of intellectual rights, causing significant damage to the economic interests of the EU.

Forensic science plays a priority role in introducing advanced achievements of science and technology and promotes the reliability of the proof system in the case. In some cases, the appointment and conduct of a forensic examination are not only necessary but also the only possible means of establishing the truth and solving a litigation.

Keywords: *forensic science, intellectual property, literary works, trademark, forensic expert, court.*

Formulation of Research Problem. One of the priorities of state policy is the protection of intellectual property rights, as the development of this area intensifies innovation in all areas, raises the country's economy to a new level, providing it with a worthy place at the international level. The growth of scientific potential not only contributes to the modernization of Ukraine in various fields of science and technology, but also strengthens its defense capabilities and national security.

Today, there is a negative state of compliance with legislation governing issues of intellectual property, increasing the number of violations of these rights. The reason for this situation is the imperfection of the mechanism of legal protection and protection of intellectual property rights in the sphere of scientific activity, unresolved issue of legal protection of scientific discoveries, etc. In January 2020, the European Commission published a report on the protection and enforcement of intellectual property rights in third countries, according to which despite all preventive measures, our country is once again among the countries with serious systematic problems in the sphere of protection and enforcement of intellectual property rights and cause significant damage to economic interests of the EU.

Forensic examination plays a priority role in the implementation of advanced achievements in science and technology and contributes to the reliability of the evidence system in the case. In some cases, the appointment and conduct of a forensic examination is not only necessary, but the only possible means of finding out the truth and resolving the dispute.

Analysis of Recent Researches and Publications. Problematic issues of forensic examination were studied by such scientists as P. P. Krainev, O. M. Kliuiev, E. B. Simakova-Yefremian, V. L. Fedorenko, N. V. Kisil, O. F. Doroshenko, O. P. Orliuk and others ¹.

¹ E.g., Крайнев П. П., Ковальова Н. М., Мельников М. В. Судові експертизи у сфері інтелектуальної власності. За ред. П. П. Крайнева. Вінниця. 2008. 376 р. ; Столітній шлях судової експертизи в Україні, 1918—2018 рр.: монограф. ; авт.-уклад. : О. М. Клюєв, О. П. Угровецький, Е. Б. Сімакова-Єфремян ; за ред. О. М. Клюєва. Харків, 2018. 335 р. ; Основи судової експертизи: навчальний посібник для фахівців, які мають намір отримати або підтвердити кваліфікацію судового експерта ; авт.-уклад. : Л. М. Головченко, А. І. Лозовий, Е. Б. Сімакова-Єфремян

The **Article Purpose** is to clarify the features of conduct of forensic examination of intellectual property objects in Ukraine and the formal requirements for a forensic expert in Ukraine and foreign countries.

Main Content Presentation. Peculiarities of the content of rights to intellectual property objects determine a certain specificity of the dispute resolution procedure that arises in the process of creation and use of these objects. An important component of such disputes is that they concern specialized knowledge that requires special competence in various fields of science and technology, arts and crafts. That is, such disputes are generally not resolved without an application of specialized knowledge in the particular area and, accordingly, require the involvement of forensic experts and conduct of forensic examination and expert researches.

Legal, organizational, and financial bases of forensic activity are determined by the Law of Ukraine: *On Forensic Examination*¹.

Forensic examination of intellectual property is rather new type of a forensic examination, which was established in Ukraine in 2001—2002 and is developing to this day².

Prior to that, there was a certain practice of conducting examinations in this area. According to P. P. Krainev, a well-known scientist in the field of forensic examination of intellectual property, during the 1980's and 1990's district people's courts and investigative bodies appointed (as indicated in the relevant procedural documents) economic, patent-economic, and technical examination. The task of the examination was often to establish the fact of use of the plaintiffs' inventions, to determine the amount of royalties for the use of inventions on the copyright certificate, to calculate the economic effect of the use of inventions or the introduction of innovation proposals³.

та ін. Харків, 2016. 928 р. ; Федоренко В. Л., Тимошик Л. П. Судова експертиза з питань інтелектуальної власності: генезис, поняття, класифікація та система [Електронний ресурс]. *Експерт: парадигми юридичних наук і державного управління*. 2019. № 1(3). Р. 11—52. DOI: <https://doi.org/10.32689/2617-9660-2019-3-1-11-52> (date accessed: 12.03.2021) ; Кісіль Н. В. Сутність і зміст судово-експертної діяльності у сфері інтелектуальної власності. *Теорія та практика судової експертизи і криміналістики* : зб. наук. пр. Харків, 2015. № 15. Р. 346—354 ; Дорошенко О. Ф. Процесуальні права та обов'язки судового експерта. *Питання інтелектуальної власності* : зб. наук. пр. НДІВ АПрН України за 2007 рік. Київ, 2007. № 5. Р. 4—25 ; Орлюк О. П., Дорошенко О. Ф. Проблемні питання проведення судової експертизи об'єктів інтелектуальної власності. *Юридичний радник*. 2006. № 3. Р. 88—89.

¹ Про судову експертизу : Закон України від 25.02.1994 р. № 4038-ХІІ. URL: <https://zakon.rada.gov.ua/laws/show/4038-12> (date accessed: 19.03.2021).

² Федоренко В. Л., Тимошик Л. П. Судова експертиза з питань інтелектуальної власності: генезис, поняття, класифікація та система. 2019. (date accessed: 12.03.2021).

³ Крайнев П. П., Ковальова Н. М., Мельников М. В. Судові експертизи у сфері інтелектуальної власності. 2008.

In Ukraine, for the implementation of such forensic examination within the structure of the Ministry of Justice there is a specialized Scientific-Research Institute of Intellectual Property, as well as forensic experts of state specialized institutions and forensic experts who are not employees of these institutions, who carry out an expert activity on works of literature, arts, sciences, technology, crafts.

The Ministry of Justice organizes expert ensuring of justice and researches in the field of forensic science, in particular, in the field of intellectual property, maintains the Register of methods of conduct of forensic examinations and the State Register of certified forensic experts, promotes the Central Expert Qualification Commission under the Ministry of Justice, the main functions of which are the certification of specialists in order to assign (confirm) the qualification of a forensic expert, in particular, in the field of intellectual property, and consideration of disciplinary liability of forensic experts.

The purpose of specialized forensic institutions is to meet the needs of pre-trial investigation bodies, court, other government agencies and provide public services to legal entities and individuals to provide them with independent, qualified and objective analysis, in particular on intellectual property issues.

The subject of forensic examination in the field of intellectual property N. V. Kisil points the facts and circumstances of the case on the properties, characteristics, patterns of creation and use of intellectual property, their value, damages and economic transactions in respect of these objects, which are important for pre-trial investigation or court proceedings and which are determined by applying special knowledge in the manner prescribed by law ¹.

L. Gula confirms that persons, that persons engaged in pre-trial investigation or endowed with exclusive powers to administer justice, do not have special knowledge in the field of intellectual property, and therefore can not and should not objectively assess the evidence in terms of special knowledge. In this case, there is a need to involve people with special knowledge and relevant qualifications in this field ².

Appointment and conduct examinations in the field of intellectual property is carried out according to the rules, provided for any type of examinations. However, depending on the content of the expert task, there may be some differences in the content and structure of the expert conclusion. Today, the examination in the field of intellectual property is included in the class of forensic examinations, within which the following expert specializations are distinguished:

13.1.1 Researches related to literary, artistic, and other works;

13.1.2 Researches related to computer programs and data compilations (databases);

¹ Кісіль Н. В. Сутність і зміст судово-експертної діяльності у сфері інтелектуальної власності. 2015. Р. 346.

² Гула Л. Судова експертиза об'єктів інтелектуальної власності як одне із джерел доказів у кримінальному провадженні. 2017. Р. 255—260.

13.2 Researches related to performances, phonograms, videograms, programs (broadcasts) of broadcasting organizations;

13.3 Researches related to inventions and utility models;

13.4 Researches related to industrial designs;

13.5.1 Researches related to plant varieties;

13.6 Researches related to commercial (brand) names, trademarks (signs for goods and services), geographical indications;

13.8 Researches related to trade secret (know-how) and innovation proposals;

13.9 Economic researches in the field of intellectual property ¹.

During forensic examination in the field of intellectual property, the circumstances to be proved are clarified, namely, the type and amount of damages caused to the right holder of the intellectual property object, the volume of reproduction of intellectual property objects, the method of their use, etc. An important remark is that in the criminal process, determining the amount of material damage and non-pecuniary damage caused by a criminal offense is the basis for the mandatory involvement of an expert ².

Thus, forensic examinations, related to copyright and related rights, are appointed in the following cases: court decision on the violation of the rights of the copyright owner; recognition of the use of work, etc. Forensic examination solves the following tasks: determines the signs of originality and creative nature, originality of the title of work, the fact of use of the work and the method of its use.

Forensic examinations of means of individualization are appointed when the court decides on the violation of the rights of the owner of a trademark, commercial designation, brand name or person, an association of persons who manufacture goods under a registered geographical indication. The main tasks of forensic examination are to determine: the identity of different means of individualization or similarity so that they can be confused; the possibility of misleading the consumer about the product, service or person.

The protection of objects of intellectual property rights is carried out by conducting forensic examinations and expert researches by certified forensic experts. A forensic expert is the only subject of forensic examination. There are formal requirements for the forensic expert in Ukraine, and they are extremely strict. Given that intellectual property objects belong to various fields of art, science, technology and crafts, effective consideration of cases related to the protection of intellectual property rights for a full and comprehensive study of

¹ Про затвердження Положення про Центральну експертно-кваліфікаційну комісію при Міністерстві юстиції України та атестацію судових експертів : наказ Мін'юсту України від 03.03.2015 р. № 301/5. URL: <https://zakon.rada.gov.ua/laws/show/z0249-15> (date accessed: 20.03.2021).

² Гула Л. Судова експертиза об'єктів інтелектуальної власності як одне із джерел доказів у кримінальному провадженні. 2017. Р. 255.

the subject of examination and providing an expert conclusion is possible only in the case of involving specialists who have special knowledge in a particular field.

According to O. F. Doroshenko, after the appointment of the examination and its acceptance for conduct, a person with special knowledge acquires the procedural status of a forensic expert, with all the rights, duties and responsibilities arising from it. It should be understood that the main function of the forensic expert is to provide a written conclusion on the basis of a study conducted with the use of special knowledge of the objects submitted for examination ¹.

The expert conclusion in the field of intellectual property is an independent source of evidence in various types of litigation. Forensic examinations in the field of intellectual property are mainly appointed, resolving issues in such categories of disputes as recognition of the right to intellectual property and infringement of intellectual property rights.

The forensic expert is an independent subject of the process that has its own scope of procedural rights and duties that distinguish him from other participants in the process. The basic rights, duties, and requirements for a forensic expert are enshrined in Section II of the *Law On Forensic Examination*. In addition, Section VI Regulations on the Central Expert Qualification Commission under the Ministry of Justice of Ukraine and certification of forensic experts provide grounds for bringing a forensic expert to disciplinary responsibility.

Article 10 of the *Law On Forensic Examination* stipulates that *forensic experts of state specialized institutions may be specialists who have the appropriate higher education, educational and qualification level not lower than a specialist, have been trained and qualified as a forensic expert in a particular specialization* ².

Employees of specialized state expert institutions are required to carry out only a few types of examinations, which belong to forensic and forensic psychiatric. Such requirements do not apply to examination in the field of intellectual property. As mentioned above, in order to engage in expert activities, the expert must pass the appropriate certification procedure and pass a qualifying exam. In addition, according to the legislation of Ukraine, the main principles on which forensic activity is based are the independence of the forensic expert from the court and pre-trial investigation bodies, the competence of the forensic expert, the validity, objectivity and completeness of the expert study, the ability to verify the results of research and appoint a re-examination, compliance with the safety and rights of the expert during the study.

If we analyze the foreign experience of forensic activity, then in not all countries the law clearly defines the criteria for the competence of the forensic expert, which sometimes complicates the process of such activities. For example,

¹ Дорошенко О. Ф. Процесуальні права та обов'язки судового експерта. 2007. Р. 8.

² Про судову експертизу. URL: <https://zakon.rada.gov.ua/laws/show/4038-12> (date accessed: 19.03.2021).

in the United States, the lack of formal requirements for an expert leads to the representatives of the parties during the interrogation specifically asking questions that confirm the competence of the expert or, conversely, raise doubts about both the expert's experience and the reliability of his research methods. According to I. V. Reshetnikov, when a party is going to bring an expert to a court hearing, he must provide the opposite party with an expert conclusion and add to it all calculations, plans, etc.¹.

In England, there is a specialized Intellectual Property Enterprise Court. The Patent Act 1977 and the European Patent Convention define an intellectual property expert as an art professional, in other words, as a qualified person. Most of the evidence in patent disputes contains the conclusions of experts. In some cases, the expert lacks his own experience, so he must refer to authoritative sources, summarize the experience of others².

French civil procedure law provides that an expert examination may be appointed in any situation where the judge does not have sufficient components to rule on the case. That is why the examination is understood as the provision of evidence and as assistance in making a decision, as an investigative action carried out by a technical specialist, the need for which arose before or during the trial, using techniques to assist the judge, but not eliminating it from solving the problem³. Interestingly, the French experts are effective people involved in the reconciliation of the parties, i.e., the expert is the mediator of the parties with whom he meets, interrogates, listens and acquaints with the recordings; he has a winning position to simplify the procedure for concluding an amicable agreement.

Conclusions. In the light of judicial reform in Ukraine and the prospects of establishing a High Court of Intellectual Property, forensic examination in this area remains a necessary and often the only source of evidence in cases of infringement of property and personal non-property rights of authors, industrial property rights, since a forensic expert provides an objective and well-founded conclusion an effective and well-founded conclusion that is or will be the subject of legal proceedings. It is a certified forensic expert who is responsible for the quality and objectivity of forensic examination in the field of intellectual property in Ukraine. Certified forensic experts on intellectual property are rare abroad. Relevant researches for courts are conducted by experts, nominated by the court.

¹ Решетникова И. В. Доказательственное право Англии и США. Екатеринбург. 1997. P. 34—41.

² England Paul. The role of experts in life sciences patent litigation [Electronic resource]. URL: https://www.taylorwessing.com/synapse/ip_patentlitigation.html (date accessed: 21.03.2021).

³ Євдокіменко С. В., Петрова І. А. Особливості використання судової експертизи за законодавствами України та Франції. 2016. № 2 (73). P. 54—62.

References

- Doroshenko, O. F. (2007). *Protseusualni prava ta obov'iazky sudovoho eksperta. Pytannia intelektualnoi vlasnosti* : zb. nauk. pr. NDIV APRN Ukrainy za 2007 rik. Kyiv. Vyp. 5 [in Ukrainian].
- England, P. *The role of experts in life sciences patent litigation* [Electronic resource]. URL: https://www.taylorwessing.com/synapse/ip_patentlitigation.html (data zvernennia: 21.03.2021).
- Fedorenko, V. L., Tymoshchuk, L. P. (2019). Sudova ekspertyza z pytan intelektualnoi vlasnosti: henezys, poniattia, klasyfikatsiia ta systema [Elektronnyi resurs]. *Ekspert: paradyhmy yurydychnykh nauk i derzhavnoho upravlinnia*. № 1 (3). DOI: <https://doi.org/10.32689/2617-9660-2019-3-1-11-52> (data zvernennia: 12.03.2021) [in Ukrainian].
- Hula, L. (2017). Sudova ekspertyza ob'iektiv intelektualnoi vlasnosti yak odne iz dzherel dokaziv u kryminalnomu provadzheni. *Visnyk Natsionalnoho universytetu «Lvivska politekhnika»*. Seria: Yurydychni nauky. Lviv. Vyp. 4. Nom. 876 (15). DOI: <https://doi.org/https://doi.org/10.23939/law2017.876.255> (data zvernennia: 20.03.2021) [in Ukrainian].
- Kisil, N. V. (2015). Sutnist i zmist sudovo-ekspertnoi diialnosti u sferi intelektualnoi vlasnosti. *Teoriia ta praktyka sudovoi ekspertyzy i kryminalistyky* : zb. nauk. pr. Kharkiv. Vyp. 15 [in Ukrainian].
- Krainiev, P. P., Kovalova, N. M., Melnykov, M. V. (2008). *Sudovi ekspertyzy u sferi intelektualnoi vlasnosti* ; za red. P. P. Krainieva. Vinnytsia [in Ukrainian].
- Orliuk, O. P., Doroshenko, O. F. (2006). Problemni pytannia provedennia sudovoi ekspertyzy ob'iektiv intelektualnoi vlasnosti. *Yurydychnyi radnyk*. № 3 [in Ukrainian].
- Osnovy sudovoi ekspertyzy: navchalnyi posibnyk dlia fakhivtsiv, yaki maiut namir otrymaty abo pidtverdyty kvalifikatsiiu sudovoho eksperta* (2016); avt.-uklad. : L. M. Holovchenko, A. I. Lozovyi, E. B. Simakova-Iefremian ta in. Kharkiv [in Ukrainian].
- Pro sudovu ekspertyzu* : Zakon Ukrainy vid 25.02.1994 r. № 4038-XII (zi zmin. ta dopov.). URL: <https://zakon.rada.gov.ua/laws/show/4038-12> (data zvernennia: 19.03.2021) [in Ukrainian].
- Pro zatverdzhennia Polozhennia pro Tsentralnu ekspertno-kvalifikatsiinuu komisiuu pry Ministerstvi yustytysii Ukrainy ta atestatsiiu sudovykh ekspertiv* : nakaz Min'istru Ukrainy vid 03.03.2015 r. № 301/5 (zi zmin. ta dopov.). URL: <https://zakon.rada.gov.ua/laws/show/z0249-15> (data zvernennia: 20.03.2021) [in Ukrainian].
- Reshetnikova, I. V. (1997). *Dokazatelstvennoe pravo Anglii i SSHA*. Ekaterinburg [in Russian].
- Stolitnii shliakh sudovoi ekspertyzy v Ukraini, 1918—2018 rr.* : monohraf.(2018); avt.-uklad. : O. M. Kliuiev, O. P. Uhrovetskyi, E. B. Simakova-Iefremian ; za red. O. M. Kliuieva. Kharkiv [in Ukrainian].

Yevdokimenko, S. V., Petrova, I. A. (2016). Osoblyvosti vykorystannia sudovoi ekspertyzy za zakonodavstvamy Ukrainy ta Frantsii. *Visnyk KhNUVS*. № 2 (73) [in Ukrainian].

С. М. Науменко, Л. В. Золота
Особливості судової експертизи
об'єктів інтелектуальної власності
в Україні та за кордоном

Розглянуто здійснення експертизи об'єктів інтелектуальної власності в Україні, а також участь експерта в судовому засіданні за кордоном. Об'єкти інтелектуальної власності належать до різноманітних галузей мистецтва, науки, техніки й ремесла, тому ефективність розгляду справ, пов'язаних із захистом прав інтелектуальної власності, залежить від залучення фахівців, які мають спеціальні знання в певній галузі,— для повного та всебічного дослідження предмета експертизи й надання висновку експерта. З'ясовано особливості проведення судової експертизи об'єктів інтелектуальної власності в Україні та визначено формальні вимоги до судового експерта в Україні й іноземних державах.

Ключові слова: *судова експертиза, інтелектуальна власність, літературні твори, торговельна марка, судовий експерт, суд.*

С. М. Науменко, Л. В. Золотая
Особенности судебной экспертизы объектов
интеллектуальной собственности в Украине и за рубежом

Рассмотрены вопросы осуществления экспертизы объектов интеллектуальной собственности в Украине, а также участие эксперта в судебном заседании за рубежом. Объекты интеллектуальной собственности относятся к различным областям искусства, науки, техники и ремесла, эффективное рассмотрение дел, связанных с защитой прав интеллектуальной собственности, для полного и всестороннего исследования предмета экспертизы и дачи заключения эксперта возможно только в случае привлечения специалистов, обладающих специальными знаниями в определённой области.

Цель статьи — выяснить особенности осуществления судебной экспертизы объектов интеллектуальной собственности в Украине и формальные требования к судебному эксперту в Украине и иностранных государствах.

Одно из приоритетных направлений государственной политики — охрана прав интеллектуальной собственности, поскольку развитие этой сферы активизирует инновации во всех отраслях, поднимая на новый уровень экономику страны и обеспечивая ей достойное место на международном уровне. В свою очередь повышение научного потенциала не только способствует модернизации Украины в различных сферах науки и техники, но и укрепляет её обороноспособность и национальную безопасность.

Сегодня наблюдается негативное состояние соблюдения законодательства, регулирующего вопросы интеллектуальной собственности, увеличивается количество нарушений соответствующих прав. Причиной такого состояния является несовершенство механизма правовой охраны и защиты прав интеллектуальной собственности в сфере научной деятельности, неурегулированность вопроса о правовой охране научных открытий и т. п. В январе 2020 г. Европейская комиссия опубликовала отчёт о защите и обеспечении прав интеллектуальной собственности в третьих странах, согласно которому (несмотря на все превентивные меры) Украина в очередной раз оказалась среди стран с серьёзными системными проблемами в области охраны и защиты прав интеллектуальной собственности, наносящими существенный ущерб экономическим интересам ЕС.

Судебная экспертиза играет приоритетную роль во внедрении передовых достижений науки и техники и способствует надёжности системы доказывания по делу. В некоторых случаях назначение и проведение судебной экспертизы не только необходимо, но и единственно возможно для установления истины и решения судебного спора.

Ключевые слова: судебная экспертиза, интеллектуальная собственность, литературные произведения, торговая марка, судебный эксперт, суд.

Submitted on 31.03.2021 / Revised 21.04.2021 / Approved 29.04.2021

Naumenko S., Zolota L. Features of intellectual property analysis in Ukraine and abroad. *Theory and Practice of Forensic Science and Criminalistics: Collection of Scientific Papers/Editorial Board: O. M. Kliuiev, V. Yu. Shepitko and others. Kharkiv: Pravo Publishing House, 2021. 23rd Issue, p. 326—335. DOI: <https://doi.org/10.32353/khrife.1.2021.25>.*

Contributors

The authors contributed solely to the intellectual discussion underlying this paper, case-law exploration, writing and editing, and accept responsibility for the content and interpretation.