



COURT OF JUSTICE OF THE STATE OF SÃO PAULO
DISTRICT OF SÃO PAULO
CENTRAL CIVIL COURT
2ND BUSINESS COURT AND ARBITRATION CONFLICTS
PRACA DOUTOR JOAO MENDES, S/N, São Paulo - SP - CEP 01501-000

DECISION

Case No.: **1132420-11.2021.8.26.0100**
 Class - Subject **Common Civil Procedure - Patent**
 Applicant: **Cilag Gmbh International and others**
 Required: **Scitech Medical Products Ltd**

Judge: Dr(a). **GUILHERME DE PAULA NASCENTE NUNES**

Seen.

CILAG GMBH INTERNATIONAL, ETHICON ENDO-SURGERY INC and **JOHNSON & JOHNSON DO BRASIL INDUSTRY AND TRADE OF PRODUCTS Para Saúde Ltda** filed a lawsuit against **SCITECH PRODUTOS MÉDICOS S.A.** They claim, in summary, that they are the holders of patent PI 0807365-1 (electrically self-powered surgical instrument with cryptographic identification of an interchangeable part), and of industrial design DI 7101834-4 (motorized surgical stapler). They assert that the defendant allegedly "launched on the market a motorized surgical stapler under the brand name Endofire Power that would be a copy of the JOHNSON & JOHNSON stapler." They request, in the context of urgent relief, that the respondent "cease within 48 (forty-eight) hours of its summons the importation, manufacture, assembly, export, offering for sale, exhibition, use, maintenance in stock and sale of the Endofire Power stapler (sanitary registration No. 10413960227) in the Brazilian territory until the final judgment on the merits, under penalty of a fine of R\$ 10,000.00 (ten thousand reais) per unit in case of non-compliance, or in another amount to be arbitrated by Your Excellency, at a level capable of impelling the RESPONDENT to comply with the injunction; collect the units of the Endofire Power stapler (sanitary registration No. 10413960227) in the possession of third parties for sale, within 15 (fifteen) days of its subpoena; display in these records, within twenty (20) days of its summons, the documentation capable of proving that it has fully complied with the injunction, such as, but not limited to, accounting documents and return invoices referring to the return of Endofire Power staplers distributed and/or consigned for direct or indirect sale by third parties; Abstain from the practice



COURT OF JUSTICE OF THE STATE OF SÃO PAULO
DISTRICT OF SÃO PAULO
CENTRAL CIVIL COURT
2ND BUSINESS COURT AND ARBITRATION CONFLICTS
PRACA DOUTOR JOAO MENDES, S/N, São Paulo - SP - CEP 01501-000

of any act that may contribute to the activities listed or that aim to circumvent the injunction, such as, but not limited to, the transfer of the Endofire Power stapler to third parties". In the end, it postulates the confirmation of the urgent relief, as well as the condemnation of the defendant to pay compensation for moral damages, in the amount of R\$ 200,000.00, in addition to compensation for material damages, to be determined in settlement of the judgment.

Having been given the opportunity to file a statement on the urgent relief (fl. 508), the respondent made a statement to fls. 553/572, for the rejection of the urgent relief. It argues, briefly, that the validity of the industrial design presented by the plaintiff expired on 31.03.2021 and that the infringement of the patent or industrial design would not be proven, as no expert opinion was carried out by this court. It asserts that there is no infringement of the industrial design and patent, since its products are different from those produced by the plaintiff, in addition to the danger of reverse damage.

The plaintiff manifested himself to fls. 621/624, alleging that the validity of the protection of industrial design DI7101834-4 would have been extended until 31.03.2026, reiterating the credibility of the technical opinions attached to the initial one.

Granted in part the urgent relief to order the defendant to: "refrain, within 48 hours from the knowledge of this decision, from the manufacture, commercialization, exposure for sale or maintenance in stock of products marketed by it that infringe the patent of n. PI0807365-1 owned by the plaintiff, in particular the one called Endofire Power Stapler"; and "(b) collect, within 30 days from the knowledge of this decision, the units of the Endofire Power stapler (sanitary registration No. 10413960227) in the possession of third parties for commercialization, proving in the records compliance with the measure" (fls. 625/632).

An interlocutory appeal was filed against the decision, in which suspensive effect was granted (fl. 932).

The defendant stated that the injunction had been complied with (fls. 646/648).

The defendant lodged a defence (fls. 779/822). It states that there was no counterfeiting of the plaintiffs' industrial design, insofar as DI 7101834-4 is intended to serve as a stapler intended to perform sutures in gastrointestinal surgeries, and the configuration of said piece presupposes a handle with a handle to attach fingers, a trigger to be fired and a rod for suture, common and necessary aspects for such equipment, that would be in the state of the art and present in other competing products, so that minor differentiations must be considered in order to rule out the allegation of infringement. It argues that there is no infringement of the



COURT OF JUSTICE OF THE STATE OF SÃO PAULO
 DISTRICT OF SÃO PAULO
 CENTRAL CIVIL COURT
 2ND BUSINESS COURT AND ARBITRATION CONFLICTS
 PRACA DOUTOR JOAO MENDES, S/N, São Paulo - SP - CEP 01501-000

patent PI 0807365-1 owned by the plaintiffs, insofar as there are differences between the defendant's product and that registration, and the defendant's Endofire Power does not have an internal power source, as it uses an attachable battery, unlike the device object of the patent. It argues the nullity of patent PI 0807365-1 registered with the BPTO, insofar as the device would be in the state of the art, and the BPTO only sought to protect the exact electromechanical arrangement defined in independent claim 1, so that the structures of the defendant's product would not be covered by the patent. It argues that there is no illegality in its conduct, the absence of compensable material damages, and the need to produce expert evidence, in addition to the need to revoke the urgent relief. It contends that the applications should be dismissed.

Reply (fls. 936/956).

The parties have specified the evidence they intend to produce (pp. 1123/1144 and 1161). The parties expressed themselves (fls. 1165/1169 and 1170/1171).

A decision was issued on the reorganization and organization of the deed in which the production of documentary and expert evidence was granted (fls. 1177/1183).

Request for clarification and adjustments on the reorganization decision (fls. 1190/1191). The parties submitted questions (fls. 1192/1198 and 1199/1222).

The plaintiffs contested the defendant's claims (fls. 1229/1233).

The forensic expert estimated her fees (fls. 1234/1240), to which the parties agreed (fls. 1248 and 1253).

The request for clarification and adjustments to the reorganization decision was accepted and the challenge to the questions was dismissed (fls. 1249/1250).

Expert fees arbitrated (fl. 1263).

After an expert report was presented (fls. 1276/1368), the parties expressed their views (fls. 1382/1385 and 1386/1418).

The plaintiff requested the granting of relief of evidence (fls. 1449/1461), which was rejected (fl. 1463).

Clarifications of the judicial expert (fls. 1469/1481).

The plaintiff requested the immediate approval of the expert report (fls. 1483/1488), which was



COURT OF JUSTICE OF THE STATE OF SÃO PAULO
 DISTRICT OF SÃO PAULO
 CENTRAL CIVIL COURT
 2ND BUSINESS COURT AND ARBITRATION CONFLICTS
 PRACA DOUTOR JOAO MENDES, S/N, São Paulo - SP - CEP 01501-000

rejected due to the need for the defendant to exercise the adversarial process (fl. 1503).

The defendant argued for the granting of an additional period (fls. 1506/1507), which was granted (fl. 1512).

Subsequently, the defendant raised the incidental nullity of patent PI 0807365-1 by the defendant (fls. 1517/1555), argued for the expansion of the scope of the expert opinion (fls. 2732/2751), formulated additional questions requesting clarification (fls. 2752/2774), and, in the end, challenged once again the expert report (fls. 2775/2825).

The author expressed herself (fls. 3035/3038).

The expert report was approved (fls. 3039/3040).

Motions for clarification were filed against the decision (fls. 3043/3046), which were rejected (fls. 3063/3065).

Closing arguments (fls. 3068/3145 and 3148/3160).

The respondent reported the filing of an interlocutory appeal against the decisions of fls. 3039/3040 and 3063/3065 (fls. 3164/3166), to which suspensive effect was granted (fl. 3194).

Letter received from the 13th Federal Court of the Regional Court of the 2nd Region reporting on the rejection of the urgent relief requested by Scitech Produtos Médicos S.A. in the records of the proceeding under No. 5066098-04.2023.4.05.5101 before that court (fls. 3195/3201).

The plaintiff argued that the defendant was using "procedural maneuvers" to delay the sentencing of the deed, which is why she requested the granting of "provisional relief of evidence" so that the defendant is ordered to: (i) cease "the importation, manufacture, assembly, export, offer for sale, exhibition, participation in bids, the use, maintenance in stock, and sale of the Endofire Power stapler (sanitary registration No. 10413960227) in the Brazilian territory"; (ii) collect "the units of the Endofire Power stapler (sanitary registration No. 10413960227) in the possession of third parties for commercialization"; and (iii) exhibit "documentation capable of proving that it has fully complied with the provisions of the decision, such as, but not limited to, accounting documents and return invoices referring to the return of Endofire Power staplers distributed and/or consigned for direct or indirect sale by third parties" (fls. 3205/3207).

The defendant manifested itself for the rejection of the protection of evidence, defending the



COURT OF JUSTICE OF THE STATE OF SÃO PAULO
 DISTRICT OF SÃO PAULO
 CENTRAL CIVIL COURT
 2ND BUSINESS COURT AND ARBITRATION CONFLICTS
 PRACA DOUTOR JOAO MENDES, S/N, São Paulo - SP - CEP 01501-000

absence of procrastination on her part and the implausibility of the applicant's right, since the expert opinion would have been terminated prematurely (fls. 3235/3250).

The defendant communicated the filing of a lawsuit seeking a declaration of nullity of the industrial design DI 7101834-4, which is being processed under No. 5091208-05.2023.4.02.5101, also distributed to the 13th Federal Court of Rio de Janeiro (fls. 3251/3252).

The author expressed herself (fls. 3299/3301).

The protection of evidence was rejected (fls. 3302/3306).

The news of the judgment of the interlocutory appeal filed by the defendant was announced, which was dismissed (fls. 3332/3341).

The plaintiff argued for the judgment of the case (fls. 3327/3331).

It's the report. I give reasons and I decide.

The documents attached to the case file show that the applicant is the holder of invention patent No. PI 0807365-1, according to the documents of fls. 79/234, which indicates the registration of the patent by Ethicon Endo-Surgery Inc., and fls. 430/444, which demonstrates the assignment of the rights over the registration to CILAG. Thus, the applicant would have the exclusive right to exploit the electrically self-powered surgical instrument with cryptographic identification of an interchangeable part, since 21.02.2008, valid until 21.02.2028.

In addition, it appears from the records that the applicant is the owner of industrial design No. DI 7101834-4, according to documents of fls. 235/248, which indicates the ownership of the registration by Ethicon Endo-Surgery Inc., and of fls. 445/463, which demonstrates the transfer of ownership of the registration to CILAG. The referred industrial design refers to the configuration applied to a surgical instrument, whose validity period began on 03.31.2011, with validity until 03.31.2021, which would later have been extended until 03.31.2026, as indicated on the INPI website, presented in *a print* of fl. LIFE 621.

The documents of fls. 354/355 and 411/429, as well as the notarial act of fls. 380/410 indicate that the defendant would be marketing its product called Endofire Power Stapler, and its participation was demonstrated even in the auction, allegedly with the intention of also supplying the said product, according to what is stated in the fls. 357/372. These facts are undisputed between the parties.

Still, I check at fls. 249/251, 345/346 and 613 that the products marketed by



COURT OF JUSTICE OF THE STATE OF SÃO PAULO

DISTRICT OF SÃO PAULO

CENTRAL CIVIL COURT

2ND BUSINESS COURT AND ARBITRATION CONFLICTS

PRACA DOUTOR JOAO MENDES, S/N, São Paulo - SP - CEP 01501-000

1132420-11.2021.8.26.0100 - Lauda 5

both parties would have valid authorization granted by ANVISA.

The plaintiffs presented the technical opinions of fls. 268/315 and fls. 317/332, whose conclusions attest that there is a violation of the right guaranteed by the invention patent and the industrial design in question, insofar as the defendant would be importing and distributing the electric surgical stapler model Endofire Power, *"which would infringe all the elements of claim 1 of patent PI 0807365-1"* (fls. 290/291 and fl. 332), in addition to reproducing "totally, in the smallest detail, the external configuration of the surgical instrument" (fl. 291), and would be "a copy of the visual configuration of the object in its entirety, in its characteristics of the ornamental plastic form" (fl. 331), protected by the registration of the industrial design DI 7101834-4.

The defendant, for its part, argues to the contrary, based on the technical opinion of fls. 599/611, the conclusion of which would show that there is no infringement on the part of the defendant or even infringement of the right arising from the patent granted to the plaintiff, since the plaintiff's patent deals with a circular stapler with an internal power supply, while the product marketed by the defendant is a linear stapler, with an attachable power supply.

In addition, the defendant asserts that the product it sells does not violate the right arising from the industrial design granted to the plaintiff, since there would be *no "ornamental similarity between the equipment of the company Scitech and the equipment of the Industrial Design patent DI 7101834-4, since the exclusively ornamental elements do not have a full correspondence"* (fl. 611), and the similarities would be restricted to the common and functional and technical aspects, typical of this type of equipment and also present in other similar products.

Well then.

In view of the intense discussion between the parties, the production of expert evidence was granted, which concluded *that "the Defendant's "Endofire Power" equipment infringes patent PI 8087365-1, insofar as it presents all the technical and functional characteristics claimed"*, as well as found that *"the Defendant's surgical stapler presents the technical and functional characteristics of the dependent claims"* relating to the patent owned by the applicant (fl. 1367).

According to the expert report, *"the finding that the characteristics covered in the independent claim are included in the "Endofire Power" equipment, by itself, would be sufficient to characterize the infringement of the patent. The Expertise, for example,*

1132420-11.2021.8.26.0100 - Lauda 6



COURT OF JUSTICE OF THE STATE OF SÃO PAULO
DISTRICT OF SÃO PAULO
CENTRAL CIVIL COURT
2ND BUSINESS COURT AND ARBITRATION CONFLICTS
PRACA DOUTOR JOAO MENDES, S/N, São Paulo - SP - CEP 01501-000

caution, however, made a detailed analysis of all the claims, unequivocally verifying the reproduction of the protection conferred by the Plaintiff's invention patent No. 0807365-1 in the product "Endofire Power Stapler" marketed by the Defendant" (fl. 1306).

Still, in response to questions formulated by the plaintiff, he clarified that the patent would not be limited to colorectal surgical procedures, since *"the patent reveals that other procedures, such as gastric bypass, can be performed with the use of an electric stapler"* (fl. 1324). Accordingly, the defendant is wrong in its claim that the products marketed by the parties have different purposes.

In addition, the expert evidence carried out in the case file found *that "the Defendant's "Endofire Power" equipment infringes the industrial design registration DI 7101834-4, since the ornamental characteristics of the product are closer to the object protected by the industrial design registration DI7101834-4 than the state of the art US5465895", and that "the similarities between the product "Endofire Power Stapler" and DI 7101834-4, go beyond the common and non-original configuration, according to the comparative analysis presented in this report, since, even if there are similarities directly related to ergonomic need, the Defendant could incorporate other ornamental characteristics to the surgical equipment in order to distance itself and/or differentiate itself from the Plaintiff's surgical equipment"* (fls. 1367/1368).

In response to the questions, the judicial expert clarified that the products marketed by the parties *"have the same general configuration", and that "the handle of the Endofire Power Stapler has the same ornamental configuration of buttons and triggers defined in DI7101834-4, in addition to presenting the same geometric ornamental configurations"* (fl. 1348). He also pointed out that *"the Endofire Power stapler has the same shape and the same number of fins (06 fins) defined in the drawings of the DI7101834-4"* (fl. 1351).

Also, in clarifications provided in response to the defendant's supplementary questions, the judicial expert clarified, in relation to the protection of the ornamental shape of the product embodied in the plaintiff's industrial design, *that "it is not possible to state that the (only) reason for the prismatic body being rounded is the need to maintain the hygiene of the equipment", or that "the position of the button was defined exclusively to facilitate access to the user"* (fl. 1474).

According to articles 42 and 109, sole paragraph, both of Law No. 9,279/1996, the registration of the patent and industrial design gives its holder the right to prevent third parties,



COURT OF JUSTICE OF THE STATE OF SÃO PAULO
DISTRICT OF SÃO PAULO
CENTRAL CIVIL COURT
2ND BUSINESS COURT AND ARBITRATION CONFLICTS
PRACA DOUTOR JOAO MENDES, S/N, São Paulo - SP - CEP 01501-000

without your consent, to produce, use, offer for sale, sell or import for these purposes a product subject to registration or process or a product obtained directly by a patented process or registered as an industrial design.

In this context, in view of the content of the expert evidence produced in the case file, it is necessary to recognize the violation of invention patent No. PI 0807365-1 and industrial design No. DI 7101834-4, both owned by the plaintiff, due to the commercialization, by the defendant, of the product called Endofire Power Stapler.

I emphasize that, in spite of the defendant's repeated challenges, any discussion about the validity of the patent or industrial design owned by the plaintiff goes beyond the objective limits of the present action, and it is also unfeasible to suspend the deed due to the existence of lawsuits that discuss the nullity of the registrations before the Federal Court, All as clarified in the decisions of FLS. 3039/3040 and 3063/3065, fully upheld by the Superior Court (fls. 3332/3341).

Consequently, in view of the validity of the invention patent and the applicant's industrial design, in the absence of any judicial decision that casts doubt on the integrity of the administrative act, also considering the content of the expert report, I also consider the practice of unfair competition to be proven.

Finally, I would like to point out that the intention or not of the defendant to compete or not to compete unfairly with the plaintiff is irrelevant, insofar as the improper use, by the defendant, of the patent and industrial design developed by the plaintiff is presumed to be parasitic use, confusion to consumers and diversion of customers, all to the detriment of the plaintiff.

In addition, as Fábio Ulhoa Coelho points out (Curso de Direito Comercial, v. 1, 19th ed. São Paulo: Saraiva, 2015, p. 262):

"The characterization of unfair competition, as seen above, cannot be done by resorting to the objectives or effects of a particular business practice. For the purposes of attributing civil liability to the entrepreneur for unfair competition, the discussion of the objectives pursued or the effects achieved is completely irrelevant. In both legitimate and unfair competition, the entrepreneur wants the same thing: to subtract market shares from competitors; In both cases, the effects are the same: gain for one and loss for another competitor."



COURT OF JUSTICE OF THE STATE OF SÃO PAULO
 DISTRICT OF SÃO PAULO
 CENTRAL CIVIL COURT
 2ND BUSINESS COURT AND ARBITRATION CONFLICTS
 PRACA DOUTOR JOAO MENDES, S/N, São Paulo - SP - CEP 01501-000

Thus, by manufacturing and marketing products that reproduce the industrial property of the plaintiff, unfair competition perpetrated by the defendant was configured, under the terms of article 195, items III and VIII, of the Industrial Property Law.

Once the violation of the legal protection of the applicants' patent and industrial design has been demonstrated, as well as the practice of unfair competition, therefore, the defendant must be ordered to be ordered to: (i) cease the import, manufacture, assembly, export, offer for sale, exhibition, use, maintenance in stock and sale of the Endofire Power stapler (sanitary registration No. 10413960227); and (ii) collect the units of the Endofire Power stapler (sanitary registration No. 10413960227) in the possession of third parties for sale, displaying accounting documents and return invoices referring to the return of the Endofire Power staplers distributed and/or consigned for direct or indirect sale by third parties.

I emphasize that it is unnecessary to condemn the defendant to the obligation to refrain from the practice of "any act that may contribute to the activities listed or that aim to circumvent the preliminary injunction", inasmuch as, obviously, the defendant must refrain from circumventing a judicial determination, subject to the provisions of article 77, item IV, §§ 1 and 2 of the Code of Civil Procedure.

In addition, the defendant must be ordered to pay compensation for material and moral damages in favor of the plaintiff, to the extent that, once the practice of unfair competition due to the violation of industrial property is verified, the damages suffered by the victim are presumed. In this sense, the jurisprudence of Superior Court of Justice is as follows:

Commercial law and civil procedure. Special feature. Unfair competition and diversion of customers. Declaratory Motions. Omission. Absence. Re-examination of evidence. Inadmissibility. Ineptitude of the initial. Non-occurrence. Property damage. Proof. Presumption - In the absence of the defects of article 535 of the CPC, the motion for clarification is rejected. - It is inadmissible to re-examine facts and evidence in a special appeal. - Once the existence of a cause of action has been established, there is no recognition of the ineptitude of the initial action in the present case. - **Article 209 of Law 9,279/96 authorizes compensation for material damages arising from acts of unfair competition that result in diversion of customers due to the confusion caused to consumers. - Compensation is not conditional on actual proof of damage, since acts of unfair competition and the consequent diversion of customers cause, by themselves, a loss of property to the victim.**



COURT OF JUSTICE OF THE STATE OF SÃO PAULO
 DISTRICT OF SÃO PAULO
 CENTRAL CIVIL COURT
 2ND BUSINESS COURT AND ARBITRATION CONFLICTS
 PRACA DOUTOR JOAO MENDES, S/N, São Paulo - SP - CEP 01501-000

Special appeal dismissed. (REsp n. 978.200/PR, rapporteur Justice Nancy Andrichi, Third Panel, judged on 11/19/2009, DJe of 12/2/2009 - emphasis added).

In the same sense is the jurisprudence of the Reserved Chambers of Business Law of the Distinguished Court of Justice of São Paulo:

Counterfeiting of trademarks. Punitive action (abstention from use), cumulated with claims for damages. Judgment partially upheld, rejected the claim for compensation for moral damages, with the plaintiff succumbing. Plaintiffs' and defendant's appeal. Ownership of trademark right and demonstrated violations. **Material and moral damages that are found "in re ipsa" when it comes to the exploitation of the industrial property of others. "The mere violation of the right requires the satisfaction of the damage, in the form of article 159 of the CC, and it is therefore not necessary, in our view, that the plaintiff prove the damages in the course of the action. Once the infringement has been verified, the action must be upheld" (GAMA CERQUEIRA). Jurisprudence of this TJSP and the STJ.** The criteria for determining non-material damages "must aim at (...) to the maximum effectiveness of the legal remedy, (...) ensuring the guarantees of due process of law" (DENIS BORGES BARBOSA). Arbitration considering, on the one hand, the need to curb the lucrative illicit act, and, on the other hand, the defendant's small economic size. Property damage. Determination in liquidation of judgment, pursuant to article 210, III, of Law 9,279/96. Failure to hear the plaintiffs' appeal against this chapter of the judgment, due to the lack of appeal interest. They are not "losing party" in the words of article 996 of the CPC. It is true that "what justifies the appeal is the loss, or encumbrance, that the party suffered as a result of the judgment. Thus, the loss results from the loss. By succumbing, or defeated, and, therefore, prejudiced, the party to whom the sentence did not attribute the practical effect to which it aimed is considered" (MOACYR AMARAL SANTOS). Fine of 2% of the value of the case arbitrated by the appealed award, due to the non-appearance of the plaintiffs at the conciliation hearing and the absence of justification for doing so. Its maintenance. Intelligence of § 8 of article 334 of the CPC. Sentence partially reformed. Plaintiffs' appeal partially heard and, in part known, partially granted. Defendant's appeal dismissed. (TJSP; Civil Appeal 1005978-85.2018.8.26.0526; Rapporteur: Cesar Ciampolini; Judging Body: 1st Reserved Chamber of Business Law; Jump Forum - 3rd Court; Date of Judgment: 04/23/2020; Registration Date: 04/23/2020 – emphasis added).

ACTION OBLIGATION NOT TO DO C.C. DAMAGE REPAIR.



COURT OF JUSTICE OF THE STATE OF SÃO PAULO
 DISTRICT OF SÃO PAULO
 CENTRAL CIVIL COURT
 2ND BUSINESS COURT AND ARBITRATION CONFLICTS
 PRACA DOUTOR JOAO MENDES, S/N, São Paulo - SP - CEP 01501-000

UNFAIR COMPETITION. Appellant-defendants who, while they were still employees of the Appellant-plaintiff, incorporated a company operating in the same field of activity, with a similar corporate purpose. Attempts to entice customers and hire employees of the Appellant-plaintiff, in addition to violating know-how and disseminating false information. Documentary evidence constituting the right of the Appellant-plaintiff (art. 333, item I, CPC). **Civil tort. Parasitic competition.** The acquittal of the Appellants-defendants in the criminal sphere for lack of evidence does not preclude the filing of the civil action. Intelligence of Articles 66, 67 and 386 of the Code of Criminal Procedure. Judgment upheld on this point. **DAMAGE REPAIR. Admissibility of compensation for damage caused by acts of unfair competition. Exegesis of article 209 of Law No. 9279/96. Presumed damage to property (in re ipsa). There is no need for concrete proof of the damage and/or its extent. Assessment in liquidation of judgment.** Moral damages. Absence of proof of actual damage. Precedents of the Superior Court of Justice and of this 2nd Reserved Chamber of Business Law. Sentence amends in part on this point. Appellant-plaintiff's appeal partially granted. Appellant-defendants' appeal dismissed. (TJSP; Civil Appeal 0022440-20.2011.8.26.0320; Rapporteur: Tasso Duarte de Melo; Judging Body: 2nd Reserved Chamber of Business Law; Limeira Court - 1st Civil Court; Date of Judgment: 14/04/2014; Registration Date: 16/04/2014 - emphasis added).=

As for material damages, the way of calculating the quantum due, article 210 of Law No. 9,279/96 authorizes the determination of the most favorable criterion to the injured party, which will be analyzed in the settlement of the judgment, in the case of loss of profits.

As for moral damages, in the case of violation of industrial property, especially in cases of imitation and/or counterfeiting, they are configured in *re ipsa*, and it is sufficient to prove the unlawful conduct, without the need to demonstrate damage or damage to the reputation of the holder of the right, because its simple violation implies reparation of damages.

Therefore, once the unlawful conduct of counterfeiting practiced by the defendant is recognized, it can be presumed that the plaintiff is harmed by the violation of the trademark, and the indemnity seeks to mitigate the losses sustained by the company and also to repress the conduct of the person who caused the damage, so that he does not practice it again, taking care to avoid unjust enrichment.

In view of the above, considering the size of the defendant, the time of counterfeiting, the value of the products, the economic capacity of the parties and the intensity of the intent, including the possible celebration of an agreement



COURT OF JUSTICE OF THE STATE OF SÃO PAULO
DISTRICT OF SÃO PAULO
CENTRAL CIVIL COURT
2ND BUSINESS COURT AND ARBITRATION CONFLICTS
PRACA DOUTOR JOAO MENDES, S/N, São Paulo - SP - CEP 01501-000

between the parties regarding the withdrawal of the products from circulation, by the defendant, I believe that the amount of R\$ 50,000.00 (fifty thousand reais) is appropriate for the present case.

The amount is increased by monetary correction from the publication of this judgment of 1% per month starting on the date of the harmful event, which is considered the date of filing of the lawsuit, in the absence of another date to assess the beginning of the practice of the unlawful act, under the terms of Precedents 362 and 54 of the Superior Court of Justice.

That said, **I CONSIDER THAT THE requests, based on article 487, item I, of the Code of Civil Procedure, to order the defendant to be PARTIALLY FOUNDED:**

(a) the obligation to, within fifteen (15) days and under penalty of a daily fine of R\$ 10,000.00 (ten thousand reais), limited to the amount of R\$ 500,000.00 (five hundred thousand reais), without prejudice to any increase in case of repeated non-compliance: (a.1) cease importing, manufacturing, assembling, exporting, offering for sale, the display, use, stock keeping and sale of the Endofire Power stapler (sanitary registration No. 10413960227); and (a.2) collect the units of the Endofire Power stapler (sanitary registration No. 10413960227) in the possession of third parties for commercialization, displaying accounting documents and return invoices referring to the return of the Endofire Power staplers distributed and/or consigned for direct or indirect sale by third parties;

(b) the payment of compensation for material damages in favor of the claimant, pursuant to articles 208 and 210 I of Law No. 9,227/96, which shall be determined in settlement of the award by arbitration, pursuant to articles 509 and 510, both of the Code of Civil Procedure; and

(c) indemnify the plaintiff for moral damages in the amount of R\$ 50,000.00 (fifty thousand reais), monetarily adjusted as of today's date, with the incidence of default interest of 1% per month since the date of the harmful event, which here is considered the date of filing of the lawsuit, in the absence of another date to assess the beginning of the practice of the unlawful act.

In view of the preponderant loss, I order the defendant to pay the costs and expenses of the proceedings, as well as to pay the attorney's fees of the plaintiff's attorneys, which, pursuant to Article 85, § 2, of the Code of Civil Procedure is set at 10% of the value of the judgment.

In relation to procedural costs and expenses, there will be the incidence of monetary correction according to the indices of the practical table of the Honorable Court of Justice, from each advance, as well as default interest of 1% per month, from the date of the transit in court of the



COURT OF JUSTICE OF THE STATE OF SÃO PAULO
DISTRICT OF SÃO PAULO
CENTRAL CIVIL COURT
2ND BUSINESS COURT AND ARBITRATION CONFLICTS
PRACA DOUTOR JOAO MENDES, S/N, São Paulo - SP - CEP 01501-000

conviction.

Urgent relief. Considering the content of the report produced in the records, which states that there is a probability of the plaintiff's right, and also considering the urgency inherent in the case discussed here, in order to avoid the perpetuation of the unlawful act by the defendant, I understand that it is the case to grant the request for urgent relief formulated by the plaintiff, in order to immediately comply with item "a" of the operative part of this judgment.

Thus, I determine that the respondent, within fifteen (15) days from the personal summons of the respondent, and under penalty of a daily fine of R\$ 10,000.00 (ten thousand reais), limited to the amount of R\$ 500,000.00 (five hundred thousand reais), without prejudice to any increase in case of repeated non-compliance: (a.1) cease the importation, manufacture, the assembly, export, offering for sale, display, use, maintenance in stock and sale of the Endofire Power stapler (sanitary registration no. 10413960227); and (a.2) collect the units of the Endofire Power stapler (sanitary registration No. 10413960227) in the possession of third parties for commercialization, displaying accounting documents and return invoices referring to the return of the Endofire Power staplers distributed and/or consigned for direct or indirect sale by third parties.

This document is valid as a letter to be sent directly by the interested party to the defendant, proving receipt in the records.

Once the final and unappealable decision is certified, the case file is archived and written off from the system.

Any request for the initiation of the liquidation phase, in relation to the liquidated part of the judgment, must be formulated by means of a petition filed specified as liquidation by arbitration (class 151), upon registration by the counsel, in order to observe the regular processing by the SAJPG5-JM system.

In the case of a request for compliance with a judgment in relation to the net part of the conviction, pursuant to Resolution 551/2011 and CG Communiqué No. 1789/2017, it must be filed by means of a petition protocol specified as "compliance with judgment" (item 156), when registered by the lawyer, so that the regular processing by the SAJPG5-JM system is observed.

After the beginning of the execution phase or the liquidation of the judgment, at the time of the registration of future petitions, the lawyers should pay attention to the use of the number of the procedural incident created for the execution phase of the judgment or for the liquidation of the judgment, avoiding



COURT OF JUSTICE OF THE STATE OF SÃO PAULO
DISTRICT OF SÃO PAULO
CENTRAL CIVIL COURT
2ND BUSINESS COURT AND ARBITRATION CONFLICTS
PRACA DOUTOR JOAO MENDES, S/N, São Paulo - SP - CEP 01501-000

registered as new incidents, jeopardizing the speedy progress of the proceedings.

P.R.I.C.

São Paulo, January 16, 2024.

**DOCUMENT DIGITALLY SIGNED UNDER THE TERMS OF LAW 11.419/2006,
AS PRINTED IN THE RIGHT MARGIN**