

Intellectual Property
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Lecture – 60
Infringement

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Infringement

- Using someone else's IP without permission
- Enforce your rights through courts
- Infringing Acts
 - Primary Infringement
 - Secondary Infringement }
 - Indirect ✓
 - Contributory ✓
- Remedies: Civil, Criminal, Administrative

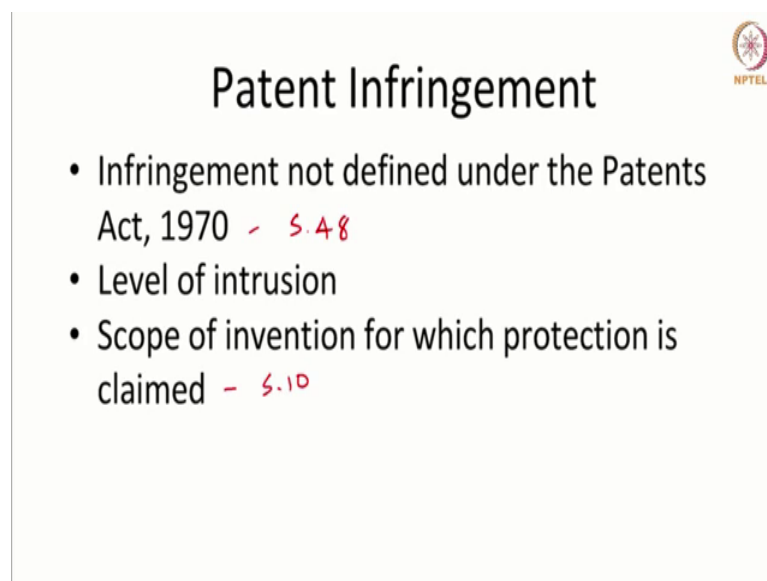
Infringement, Infringement refers to the use of intellectual property without permission or without consent. Now this use is obviously by a third party, when infringement happens and we saw the different types of infringement with regard to patents, trademark, copyright and designs and how they kind of these rights in at some place overlap with each other, the request for a person whose right has been infringe is to go to the courts. Now the infringing acts can themselves be classified broadly as primary infringement, where the infringer directly infringes the act, the act of infringement is directly attributed to the infringer or they could also be secondary.

Secondary, in the sense that there are other parties, who help the person in the infringement there are groups of party so help in the infringement. For instance, if you have a patent for a drug and your competitor also manufactures the same drug, but without a patent protection so, in the eyes of law the competitor is an infringer. Now he not only manufacturers it, he supplies it and distributes it to different parts of the country. So, he has a distributor who collects the drugs from the manufacturing unit and he has

got retailers, who sell them in pharmacies. So, the distributors and the retailers can be considered as people, who indirectly or who contribute to the infringement.

So, indirect and contributory infringement, are aspects of secondary infringement. So, say we refer to something is secondary, where the persons involvement is indirect, but it helps or aides the infringement. Primary infringement, where is where the act is directly attributable to the person who infringes, for instance as we just mentioned the competitor, who manufactures the drug making a patented article is one of the rights protector under the Patents Act and making the article or manufacturing it, is an act of direct infringement. Now the remedy is a person has can be civil it can be criminal and it can also be administrative, by administrative we refer to the remedies that a person can have before the patent office.

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The slide is titled "Patent Infringement" and features the NPTEL logo in the top right corner. It contains a bulleted list of three points:

- Infringement not defined under the Patents Act, 1970 - S.48
- Level of intrusion
- Scope of invention for which protection is claimed - S.10

Patent infringement is not defined under the Patents Act, but we understand that any right, that is granted under the Patents Act, if there is a violation with regard to that right then it can be construed as infringement.

So, section 48 of the Patents Act, details the rights that a patentee has their rights can fall broadly within 2 categories it, could be with regard to product, what you called product patents or it could be with regard to processes, what is called as process patents. Now these rights pertain to manufacturing or making sale or selling offering for sale, which can be regarded as marketing using and import. So, these are the 5 types of rights that are

covered under the patents act. So, any other person, who makes uses sells, offer for sale, offers for sale or imports, the process or a product that is protected without the consent of the patentee, then we call that infringement though it is not defined by case law and by convention, we understand infringement has an intrusion into the right guaranteed under the act.

The level of intrusion is also important, because in patent law the level of intrusion can be ascertained by looking at the scope of the patent claimed. The patent specification has a claim and the claim is where a person either says I claim or we claim or what is claimed. And they mention the aspect of the inventions for which they claim protection. Now the act of the infringer may not fully map on to the claim, they could be certain aspects of the act that are mapping and there are could be certain aspects of the infringers act, which may not be falling within the scope of the claim. So, that is an exercise that the court will have to determine the level of intrusion, before it comes up with a finding of infringement.

A patent specification is granted with the claim and the claim describes the scope of the invention, we find this in the Patents Act section 10 says that, the scope of the invention is defined in the claims for which protection is granted. So, in patent infringement unlike trademark and copyright, there is an assessment of the scope of what is protected; by reading the claim and by interpreting the claim and there is a mapping of the act to the scope of the claims. So, there are two things you look at the infringing act, could be a product or it could be a manufacturing process and you see whether the act the infringing act falls within the scope of the patent.

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Patent Infringement

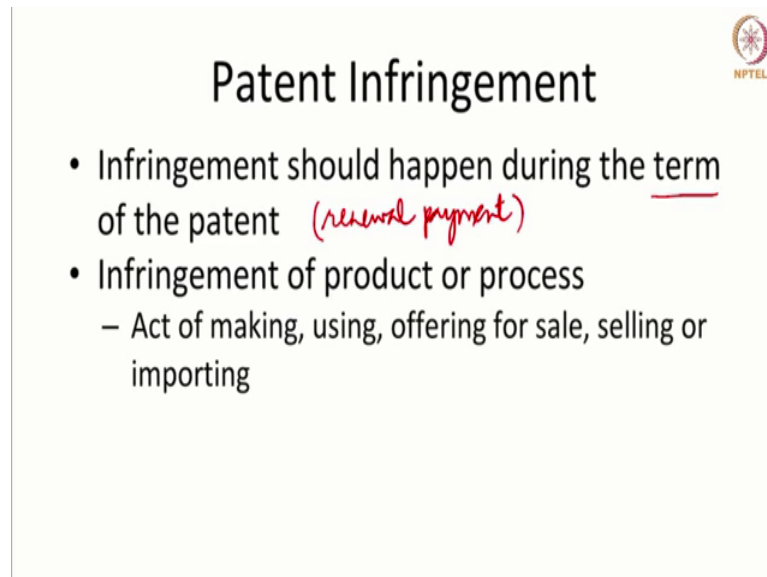
- Determine Infringement
 - ✓ What is the scope of invention as per claims? - S.10
 - ✓ Violation of any right of the patentee? - S.48
 - ✓ Who is liable for the act? ^PS
 - ✓ Whether the act comes under any exception?
 - S.47
 - S.107A
 - B
 - S.14D

Now to determine the infringement, the first thing that the courts would do is to look at the scope of the invention as per the claims. Now, it may not be apparent on a plain reading of the claim, the court may have to construct the claim where the language is not clear. The court may also seek assistance if the language is too technical, if the subject matter is technical the court can always get the assistance of experts. Once the court ascertains the scope of the invention as by the claims then, the court will ask the question whether there is a violation of any of the rights of the patentee. So, this we mentioned section 10 talks about the fact that the claim should define the scope of the invention and the claim is what is protected.

So, the scope is ascertained then, the courts see whether any right is violated, for instance we mention that the 5 rights of patentee which are protected are mentioned in section 48 manufacturing, selling, offering for sale import and using. Once this is done these 2 steps are then the court will determine who is liable for the act. Now this comes, because the reason for the infringing act against which a case has been filed, now the liability as we saw could be primary or secondary. So, the court will do the determination as to who is primarily liable and finally, the court will look at whether the act comes under any of the exceptions, now we have some exceptions in patent law section 47 has its set of exceptions, which cannot be taken action against then, we have in section 100 and 7 A and B, we have some exceptions which would not amount to infringement.

In section 140, we have certain protections, which could be claimed in case of a infringement. So the exceptions, the court to look into the exception so, once the court goes through this 4 step process and it finds that it has cleared all these steps, then the court will say there is been an infringement of a patent.

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The slide is titled "Patent Infringement" and features the NPTEL logo in the top right corner. It contains a bulleted list of conditions for infringement. The first bullet point is "Infringement should happen during the term of the patent", with the word "term" underlined and the handwritten note "(renewal payment)" written in red next to it. The second bullet point is "Infringement of product or process", followed by a sub-bullet: "– Act of making, using, offering for sale, selling or importing".


- Infringement should happen during the term of the patent (renewal payment)
- Infringement of product or process
 - Act of making, using, offering for sale, selling or importing

It is important that the patent can only be enforced, during the term of the patent meaning, which during the time the patent is alive, now the term can be kept alive by regular payment of renewal fees. Now renewal fees, if it is not paid then the patent would laps. So, it has to be paid on an annual basis assume that a case, where a patentee does not pay the renewal fees and for a year and the patentee tries to enforce the patent with regard to infringing acts, which have been happening during the time, when the patentee is patent had last lapsed.

The patentee will not be able to enforce the patent, because the time during which the infringement happened, the patentee had not paid the fees to the patent office to keep it is patent alive. So, renewal is an important aspect of infringement the first thing a person would do, when there is a infringement case against the person is to see whether the intellectual property right has been kept alive, if there is a default in the payment of renewal fee, which consequently gives a defence for the infringer in the sense that the patentee cannot enforce the patent, during the time when the renewal see fee was not properly paid and we are already mentioned, this the infringement with should be with

regard to only a product or a process. Because the patent protection is only for either a product or a process and it should be with regard to the 5 acts making, using, offering for sales, selling or importing.

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Patent Infringement

- Jurisdiction
 - District Court
 - High Court
 - Ordinary original civil jurisdiction ✓
 - Value of the relief claim ✓
 - Patentee can file a civil suit
 - Place of residence, business (DEFENDANT)
 - Court which has jurisdiction where infringing act takes place

Now, jurisdiction refers to the courts, which will have power to take the take up the matter, now the act says it can be filed before a district court or it could also be filed before the high court. Now district court is the lowest level, where you can file a patent infringement case, but the patent acts provides, that if in the case which is filed before the district court. The infringer makes a challenge to the patent, now challenge to the patent can be a defence in an infringement suit.

If the patentee enforces the patent the infringer can in return say that, how can you enforce the patent, I am questioning the validity of the patent? So, when the question is with regard to the validity of a patent, then the law states that the matter cannot be decided by the district court, it has to be transferred to the high court. So, that is the provision in the law and there is some wisdom behind it. So, the district court could be the first place, where you can file an infringement suit, but if the infringer raises a challenge to the validity of the patent and we find that in most patent infringement cases, a challenge to the validity is something which a defendant would raise then, it has to be transferred to the high court. So, it is safer in some cases to directly file the case, before

the high court expecting that the defence of invalidity could be raised by the defender defendant.

Now, the high court has an appellate side and it also has the original side. So, the patent cases are filed in the original side of the high court and the ability for the court to decide a case will depend on the release that is claimed, because there is something called pecuniary jurisdiction, which tells us the value of the court, which tells us that the value of the case will determine, which court will look at it. Now where can the patentee file the suit? The patentee can file the suit at the place of residence or the place of business of the defendant.

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Trade Mark Infringement

- Registered mark used by a person not a registered proprietor or licensee
- Uses the infringing mark in the course of trade
- The infringing mark is identical with, deceptively similar
- In respect of goods and service, TM registered

So, the case has to be filed where the defendant is where the defendant is or rather way the infringement happens and the court, where the infringement happen or where the defendant resides will have the jurisdiction with regard to taking up the matter.

Trade mark infringement is different from patent infringement. Because in patent infringement, we saw construction of the claim which has been granted protection and mapping the infringing, act to the scope of the claim looking whether it fell with an any of the rights of the patentee and also looking at whether, they were any they pertain to any of the exceptions. Now in trademark, the infringement is determined by a simple comparison, now the registered mark used by a person, not an registered proprietor or licensee can be enforced in an infringement proceeding, the use of the infringing mark

should have been in the course of trade and the infringing mark should be identical with the registered mark or it should be deceptively similar in such a way that it causes confusion.

So, these are the requirements that is, why I said the test for infringement in trademark is a very simple test of comparison. If the 2 marks, I have kept next to each other and if they look identical or if they are deceptively similar such that, it can cause confusion to the lay person then infringement is determined and the mark should be with regard to goods and services.

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The slide is titled "Trade Mark Infringement" and includes an NPTEL logo in the top right corner. A bullet point states: "For well known marks: - Use of an identical or similar sign for both similar and/or dissimilar signs." Below this, three examples are shown in red boxes. The first box contains the text "Munchy Burger" and is labeled "Yes" with a bracket on the left. The second box contains the McDonald's golden arches logo with "McDonald's" written below it, labeled "McDonald's Brand Design". The third box contains the golden arches logo with "Munchy Burger" written below it, labeled "No", and is crossed out with a large red 'X'.

Now for well known marks, the use of an identical or similar mark for both similar and dissimilar signs can be a subject matter of infringement. For instance Munchy Burger is something, which a person can have as a mark trademark, but if the Munchy Burger is shown with the McDonald's M at the background, then that would amount to an infringement.

So, this is not allowed by law whereas, the Munchy Burger by itself is a mark that can be allowed. So, this is a protection that is given to marks that are well known.

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Trade Mark Infringement

- Jurisdiction
 - District Court
 - High Court
 - Registered Proprietor can file a civil suit
 - Any person can file criminal suit for false descriptions
 - Person instituting the suit resides (PLAINTIFF)

Jurisdiction in a trademark case again, you can file it before the district court or the high court and the registered proprietor can file a civil suit, any person can file a criminal suit for false descriptions, we have mentioned that there are criminal sanctions in trademark law and more importantly a person can reside, a person can institute the suite where he resides. So, the place of jurisdiction is that of the plaintiff not of the defendant. So, the person who chooses the file the case can file it, where the person resides or carries bit business.

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Copyright Infringement

- Infringement, rights of reproduction
- Piracy
- Reproduction in any material form
- Substantial copying
- Types
 - Direct copying
 - Indirect copying

Unlike patent law there is no need to go after the descendant, who could be in a different city or a different place. Copyright infringement protects the right of reproduction, the right to make copies and piracy is one of the ways in which infringement happen mass copying of a copyrighted work is what we refer to as piracy. Now the reproduction in any material form as covered, for instance if a book a scanned and a video is uploaded it is still copyright infringement and the copying should be substantial. Substantial as in a good amount of the book should have been copied, a few pages to say, photocopying a few pages may not amount to copyright infringement.

And again you have in 2 different types of copying, it could be copying, can be direct copying or it could be indirect. Indirect in the sense that, it is not a replica, but the substance has been copied from the copyrighted material.

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Copyright Infringement

- Jurisdiction
 - District Court
 - High Court
 - Registered Proprietor can file a suit
 - • Person instituting the suit resides, carries on business
 - Criminal and civil remedies

Jurisdiction again, it is with the district court and the high court, the registered proprietor can file the suit and it can be filed again, where the person instituting the suit resides. Like trademark it could be filed, where the person who institutes a suit resides and like trademark you again have criminal and civil remedies.