

**Intellectual Property**  
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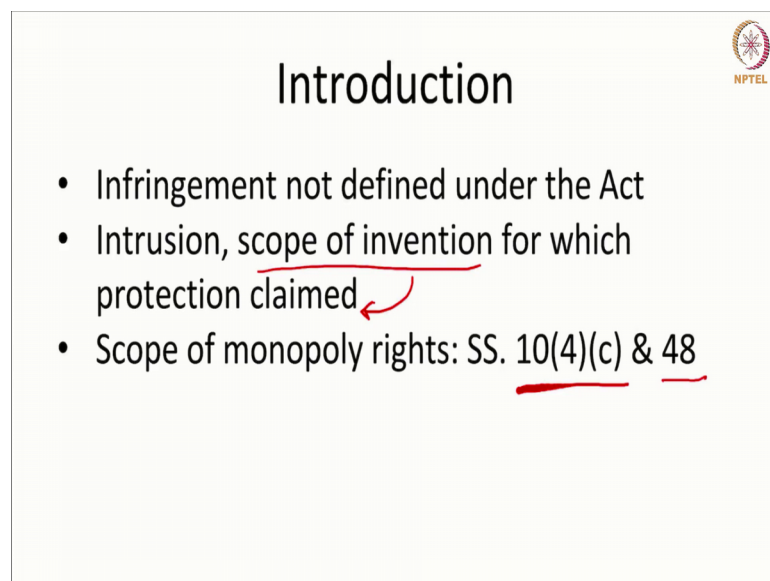
**Lecture – 33**  
**Infringement of Suits**

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Infringement suits.

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The term infringement is not defined under the act, the patents act and the patents rules do not define infringement. We understand infringement through case laws. Case laws developed by the courts where patent cases were litigated and the decisions bring out some principles on what could amount to infringement. Apart from the case laws developed in India, because the Indian patents act has a British origin, we also used some cases from the United Kingdom in understanding the principles of infringement.

Infringement can be understood as an intrusion into the scope of the invention for which protection is claimed. We understand that a patent specification, the document that encompasses the patent right is a techno legal document, which comprises technical information which also demarcates the limits of the right in a legal fashion. So, this part where the rights are demarcated is what we call the claims of a specification. The claims or the concluding part of the patent specification and the patent specification shall end with the claims as per the act.

The claims contain the limits of the patent. The claims contain what are claimed by the inventor in fact, the preamble of the claim will read I claim or we claim. So, the claim is the boundary of the right that the patent claims, any intrusion into this boundary is regarded as infringement. An infringement is something that has to be proved before a court of law; an infringement analysis can only be done before the court of law.

So, when a patentee, the owner of a patent suspects infringement he has to file a case before the court of law. In India, it could be a case that can be filed in a District Court or at the High Court having appropriate jurisdiction. You have to determine which court has the jurisdiction, and then you can file a case in the appropriate court. Now, this intrusion is understood as something that intrudes into the right of a person. Earlier in law they used to call this as trespass. Trespass in a normal case with regard to property would happen when somebody enters upon private property without prior consent.

When someone enters into a private property without permission, it is regarded as trespass. Intellectual property is also capable of being trespassed, but not in the sense in which a physical properties, but not in the way in which a physical property is trespassed. In determining infringement there are various steps that we need to undertake. Before we can make an analysis of whether an invention covered in a patent

has been infringed. So, first step will be to identify the act which is the infringing act and see whether the infringing act falls within the scope of the protection claimed in a patent.


So, this involves principles of claim interpretation, the claim has to be interpreted, the claim has to be understood and it has to be determined whether the act falls within the scope of the claim. Infringement can only be with regard to rights that are guaranteed to the patentee. A person can only infringe the rights that are protected. The patents act though it does not define entrainment. It does mention the rights of the patentee in section 48. In section 10 4 c, it mentions that the scope of what is claimed shall be mentioned in the claim itself. So, the patent specification shall end with the claims describing the scope of the invention.

So, the scope of the invention is something which you will find in the claim. So, the rights that are protected are enumerated in section 48. The right to manufacture and the right to sale, the right to manufacture the right to sell, the right to offer for sale, the right to use and the right to import. Any intrusion into these rights or when a patentee rights with regard to manufacturers sale, offer for sale, import and use is affected, then we can say there is infringement of the patent.

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## Determining Infringement

- Within scope of invention as per claims?
- Violation of any right of the patentee?
- Who is liable for the act?
- Whether the act comes under any exception?



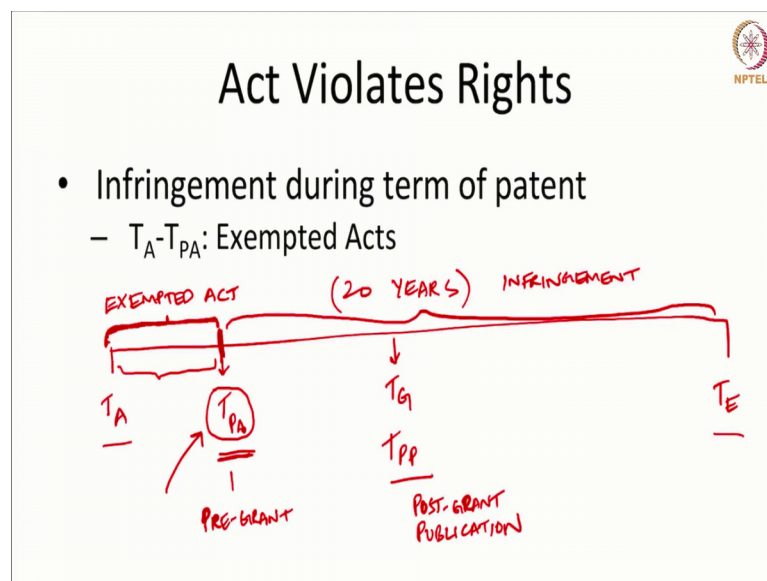
How do we determine infringement? The first thing is to see whether the act the for which is alleged to be an infringement, the act that is complained of falls within the scope of the invention as per the claims. So, we have to determine the scope of the

claims first. Two, we will have to see whether there is a violation of any right of the patentee. So, it is not just sufficient that the scope of the invention is determined, but a violation should also be established. There could be instances where an act may fall within the scope of the claim, but it may not violate any right of the patentee.

Then you we have to determine who is liable for the act. So, we have an act we determine the act say it is a sale of the infringing product in the market. The infringing product is analyzed. And it is found to be falling within the scope of the claims; it is determined whether right of a patentee with regard to the rights guaranteed under section 48 are violated. If the answer to that is again yes, then we determine who is liable for the act.

We identify the person who caused the infringing act. And then we see whether the act comes under any of the exceptions. We saw the exceptions to the grant of a patent what would be an exempt at act, if it is correct, if it is committed. So, the act should not be an exempted act, it should be something which falls within the scope of the invention as claimed, it should violate a right of the patentee and the person who committed the act has to be identified. So, these are the four steps that needs to be undertaken in determining infringement.

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Now, the acts that violate the rights of a patentee or the acts that are committed during the term of a patent. Now, we had seen that the term of a patent is a 20 year period that


extends from the time of the application T A till time of expiry T E. Now, this is the period for which patent protection is granted from the time of application till the time of expiry. It is a 20 year period in normal course.

Now, we are also mentioned there is a time of publication of the application. The application is published you have also mentioned, there is a time for grant, and the time of grant coincides with a second publication time for publication of the patent. This is the second publication. Now, the time for the publication of the application is what we called the pre grant publication. We had mentioned this as the pre grant publication; and this is the post grant publication, post grant publication.

The pre grant publication is important because it is at this point that the world gets to know about a patent, because still such time the, it comes under the it enjoys confidential status. Now, this timeline between T A and T PA that is the time of application and the time of publication of the application. Any act done is exempted any act of infringement cannot be an act for which any liability can be imposed. The reason being a person who commits an act between this time line can be regarded as an innocent infringer, because he did not have knowledge about the patent. The knowledge of about the patent reaches out to the world only at this point where the patent application has published.

So, any act within T A to T PA would it would be presumed that the person did not have knowledge unless there is proof to the contrary and such acts are exempted. So, any act committed within T A and T PA cannot give a cause of action for filing a case against a person. Whereas, any act from T PA up until the time of expiry will constitute infringement. So, we determine infringement as notice served by the patentee. And this is the point at which the patent application serves notice to the world.

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## Act Violates Rights

- Infringement during term of patent
  - $T_A - T_{PA}$ : Exempted Acts
- Rights of patentee protected
  - S.48 rights are protected
- Infringement of product and process

*Handwritten notes:* "PRODUCT" and "PROCESS" with arrows pointing to the respective underlined words in the last bullet point.

We had already mentioned that section 48 meant section 48 categorizes section 48 mentions the rights of the patentee. And an infringement can affect either a product or a process because in section 48 the two types of rights that are protected are rights with regard to a product and rights with regard to a process. All the rights of making, using, offering for sale, selling and importing has to pertain to a product or it has to pertain to a process. Now, this is also true for the definition of invention as well. Invention is defined and then the act as a product or a process. So, infringement can only happen with regard to a protected product or a protected process.

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## Jurisdiction [S.104]

- Courts having jurisdiction
  - District Court ✓ – COUNTER-CLAIM OF INVALIDITY
  - High Court ✓
    - Ordinary original civil jurisdiction –
    - Value of the relief claimed –
- Power to transfer
  - Counter claim of revocation is claimed – DISTRICT


Now, where do you file the case? Section 104 tells us that the courts that have jurisdiction for filing an infringement case will be the District Court or in the High Court within the territory where the defendant resides or defendant carries his business. So, in patent law, the case has to be instituted at the place where the infringement occurs either the infringing activity occurs say if sale or manufacturing, the infringing activity has to occur and the courts in that jurisdiction will have the power to look into it.

So, you can file a case before the District Court which is the lowest court or in the High Court. But if you file a case in the District Court and the defendant the person who is infringing raises a counterclaim now the counterclaim is an opposing claim. So, you say there is infringement the defendant says your patent is invalid. So, when a defendant raises a counterclaim of invalidity, so the defendant raises a counterclaim in an infringement suit stating that the patent is invalid. So, how can you infringe an invalid patent, so that is a claim of the defendant, then the case is transferred to the High Court. So, if a case is filed in the District Court, it has to be transferred to the High Court.

So, wherever the law requires the detail examination of the counterclaim, the case has to be transferred to the High Court. So, as a strategy it would be better to move to the High Court so that you can protect the case from being transferred if you move to the District Court because in most cases it is possible for the defendant to raise a counterclaim of invalidity.

So, when a case is filed, the first reaction for the defendant will be to say that, no, he is not infringing; and also to state that the patent which is being enforced against him is invalid. The courts having jurisdiction are again determined by the ordinary original civil jurisdiction which is how we determine the civil courts that have jurisdiction. And the courts again have the value of the relief can also determine the court which can have jurisdiction in taking up a matter. The courts have the power to transfer the case. So, a District Court can transfer the case in case a counterclaim of revocation or a counterclaim of invalidity. A invalidity is a ground for revocation is claimed. When a counterclaim is raised, the District Court has the power to transfer of the case.

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## Parties

- Who can institute a suit?
  - Patentee ✓
  - Exclusive Licensees ✓
  - Co-owners ✓
- Who may be sued?
  - Any person infringing, or his agents
  - Joint tortfeasors (distributor, retailer)

Now, who are the parties in an infringement suit? Now, the patentee is a party the patentee is the owner of the patent who files the suit. In cases where the patent has been given on an exclusive license then the exclusive licensee will be the party. The exclusive licensee will have the same rights as that of the patentee, in fact, once an exclusive licensee is licensed is given the exclusive licensee can even stop the patentee from doing the act. So, it is exclusive in every sense. Co-owners owning the patent can also have the right to institute a infringement suit.

Now, who may be sued? Now, we just saw the parties who can initiate the action. Now, any person who commits the infringement or his agents people working with him or working under him even they could be the distributors and detailers of retailers of the product could also be joined as tortfeasors. tortfeasors refers to us term people who have committed a civil wrong an infringement is regarded as a civil wrong.