

**Intellectual Property**  
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**Lecture – 59**  
**Enforcement of IP**

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Now, that we have seen the different types of intellectual property rights, let us look at how enforcement of intellectual property rights can happen. One thing to bear in mind is that these rights intellectual property rights, pertaining to inventions, pertaining to creative works, pertaining to confidential information, goodwill. They are all different rights, which can sometimes be used in conjunction with each other.

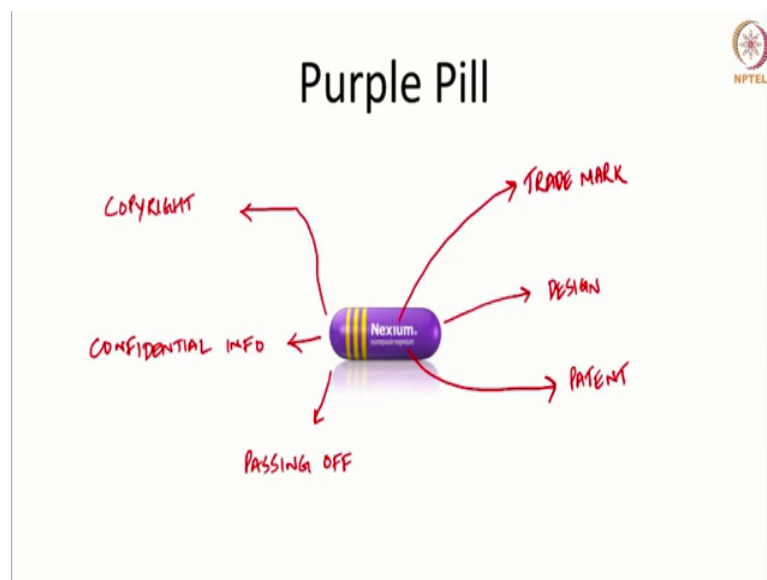
There is a small degree of overlap between these rights and we will have a look at the area in which they overlap, but predominantly they have evolved for serving different purposes. So, the patents evolved to protect technological inventions whereas, copyright evolved to protect creative works, trademarks evolved to protect origin of goods and the association of goods and designs evolved to protect aesthetic designs or aesthetic works, which were pleasing to the eye.

Now, when an intellectual property is enforced many a times in practice, we find that enforcement does not happen in isolation. In fact, enforcement happens, when the right owner applies in most cases, more than one right to get an effective protection. So, when

a person a patentee files a case for a patent infringement, most likely is the case allows for it, they will also be a trademark infringement because the product may be covered by a patent and a trademark.

When a patentee files a case for a patent infringement, say a device or a machine which can operate. It could be clubbed with the copyright infringement, saying that the user manual with the machine is also infringed by the person, who is copying the product. So, you will find that for the same product, they could be overlapping rights and the most effective way to protect a product is to have, all these rights cover different aspects of the product. To understand how different types of intellectual property rights can overlap on a product; let us look at the example of the purple pill.

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The purple pill is a drug, which is an acid reflux medication, it sold in the United States and it is marketed as a purple pill. In fact, if you look at their website it is called purple pill dot com and it is a drug, that is sold by Astrazeneca and you will find various details about the drug. The purple pill exhibits almost every type of intellectual property that we have to study here.

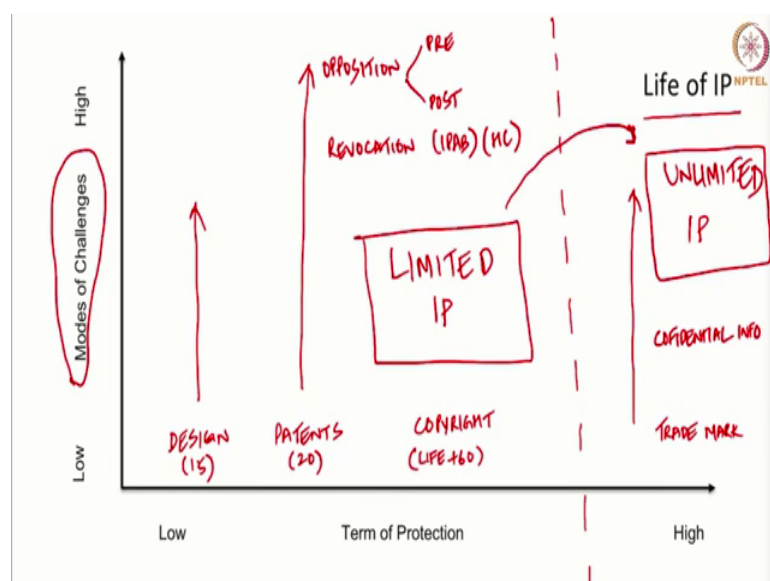
For instance Nexium is protected by a trademark. It is a word that can be protected. So, it is protected by a trademark the chemical ingredient Esomeprazole magnesium is protected by a patent, this was a subject matter of patent in the United States. And, you will find there is a small r next to the word Nexium, then the shape of the pill though, it

is a generic shape in some cases the shape of the pill can itself be unique. So, the shape can be protected by design, in this scale it is generic, but in cases where the shape is unique it could be protected by a design.

Now, they could be information with regard to how users should use it. What we call the user information can be protected by copyrights and any trade secret, which the company had while evolving this drug, which were not disclosed in the patent specification could be protected by confidential information. And, the entire getup of the product the colour, coding, the shape and the way in which it is presented the packing can be protected by the law of passing off, which is a right that is similar to trademark, but you can protect unregistered elements of your product through this right.

So, we see this in many cases, where a product is released in the market organisation or a company would like to protect it with overlapping, sometimes overlapping intellectual property rights. So, you can see how a trademark a design in some cases, there are pills that are specially shaped, heart shaped pills and diamond shaped pills. In that case by a design the chemical ingredient can be protected by a patent, the user information can be protected by a copyright, any trade secret can be protected by confidential information and the entire getup of the product, the look and feel of the product can be protected by the relief of passing off.

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Now, let us look at the life of intellectual property, because we have studied various different types of intellectual property. We need to see how these intellectual property rights have a life which is comparable to its term during, which it can be enforced. Now, the life of any intellectual property right refers to the term during, which it can be enforced.

Now, the life of say a design is 15 years, it can be 10 plus 5 years. So, it is a low life IP. So, we will just put it here whereas, the life of a trademark is very high, it can be renewed every 10 years and it can be renewed without any limit. So, this is something what we call an unlimited life intellectual property. Now between this extreme of a trademark, which can be protected forever and a design, which is a very short right you have here you also have patents. Now if design is 15, then patent is 20 years then you have copyright as well copyright is life plus 60 and you have along the higher side, you also have trade secrets or confidential information.

So, the life of an intellectual property right is dependent not only on the period, that is granted statutorily in the case of design, it is 15 patents 20, copyright 60 and trademark renewable every 10 years. It is also subject to modes of challenges, modes of challenges in the sense that, it can be challenged by the competitors in case, they find that the patent or the intellectual property right is wrongly granted.

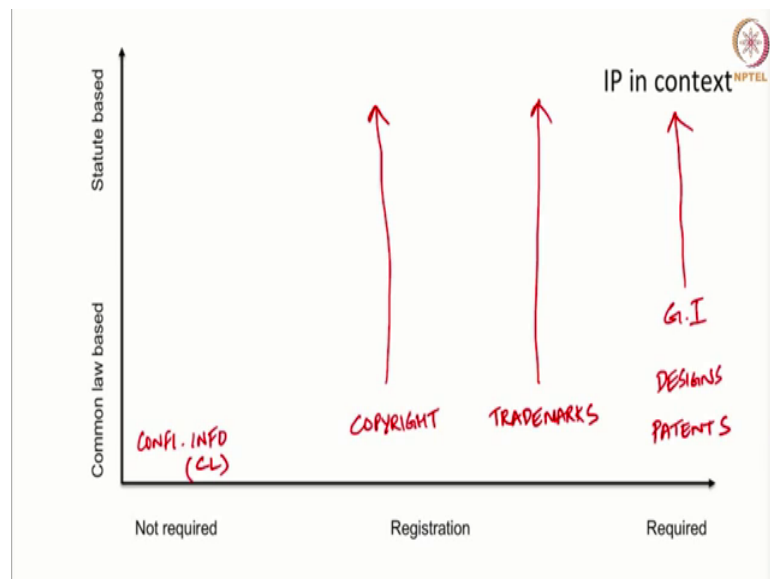
So, there is a high incidence of challenge for patents, it is pretty high because patents can be challenged by opposition. And, this can be both pre grant and we had seen all these things it can be both pre grant and post grant and patents can be challenged also by revocation. And, the revocation can be before the appellate board intellectual property appellate board or it could also be before the high court, where a infringement suit is pending.

So you will find that, there are multiple ways in which a patent can be challenged. A design can also be opposed and there is procedure for opposing trademarks as well. So, if you look at the modes of challenges, you will find that the life of an intellectual property right is also dependent on the modes of challenges. So, if there are multiple modes by which a patent. So, if there are multiple modes by which an intellectual property right can be challenged, then the chances of that intellectual property right surviving or lasting throughout its entire term could be less.

So from this, we understand that there is something called a limited life IP. Now if I need to draw a line between these 2 sets of rights, we can call this limited life because, their life is limited and these 2 rights are called unlimited life IP. Now this will be important, when we look at IP in business that the limited life IP is something that is going to come to an end and business manager constantly try to migrate limited life IP into unlimited life IP. So that they can have a longer business advantage, even within the IP, say for patents there is a tendency to file more patents as the patents expire over the same invention.

So, that they can manage the life of protection, which is also called portfolio management; patent portfolio management is a device by which multiple patents are filed over a period of time on improvements and modifications in such a way, that the life of the patent is extended beyond the life of the first file patent.

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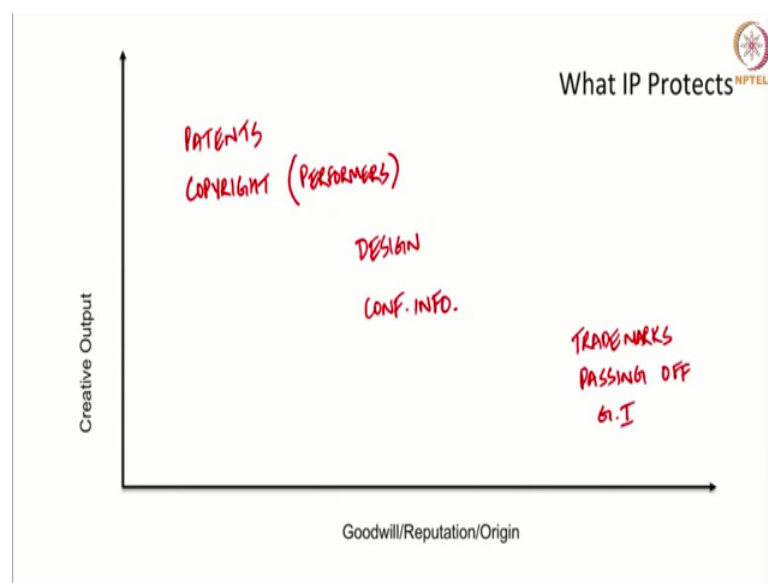


Now, let us also look at intellectual property in context, because some of these rights require registration and the others do not. Now let us look at the ones that do not require registration, you have confidential information and at the end, where registration is a must you have patents and you have certain kinds of rights, where registration can be optional even designs it is a must. If you need to have a registered design it has to be registered.

Now, in between you have say copyright, because copyright can be enforced even without registration, but there is a mechanism for registering copyrights as well and you also have trademarks, because trademarks unregistered trademarks can also be enforced. So, when you look at the line of enforcement, there are rights, that do not require registration, confidential information does not require registration and there are rights that require registration, you can add geographical indications to this list, which mandates registration.

Now, this also tells us that some of these rights are statute based and some are common law based. Now confidential information is a common law based right, copyright is a statute based right, we have a statute for it trademarks is again a statute based right. GI design and patents, they are again statute based right by statute, we refer to there is an enactment passed by the parliament, which has the formalities of how the right can be granted and how it can be protected.

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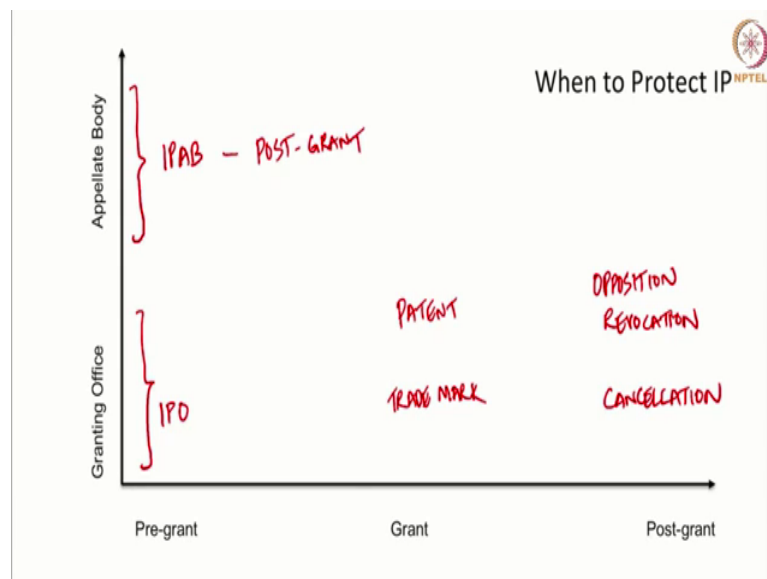
Now, what does IP protect? Because, we have seen the different types of right that have come, there are some types of intellectual property right, that protects the creative output we let us put patents here, patents protect the creative output in technological inventions and also copyright and when we refer to copyright, we also refer to all the related rights like the performers rights, broadcasting rights, etcetera. We can also add design here, because some designs are though, they are aesthetically pleasing they could be designs

that are already there or that are slightly change the creative element in design could be considered to be of a lesser amount.

And we can also add confidential info here, because not all matters that are protected by the confidential information regime needs to be creative. And, this end things pertaining to goodwill and reputation, you can add things pertaining to goodwill reputation and origin we can add passing off, which is a relief to protect unregistered trademarks and even geographical indications.

So, the creative aspects of intellectual property right are protected by patents and copyright and the goodwill and reputation rights, that protect goodwill. And, reputation like trademarks and passing off and geographical origin can be regarded as rights that protect whereas, trademark passing off and G I can be regarded as rights that protect goodwill, reputation and origin.

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Now, when to protect IP is another factor, that any person, who is interested in enforcing needs to consider some rights, can be protected after they are granted, but right during the course of it is grant could also be challenged. So, let us assume that there is a trademark, which is granted at this point or there is a patent that is granted, now for the trademark and the patent they could be challenges that can happen after the grant. Now we saw in the case of patents, they could be opposition, they could be revocation as well for trademarks, they could be cancellation of trademarks by way of opposition.

Now, some of these proceedings can happen in the granting office that is the IPO in most cases and some of them can happen at the appellate body IPAB and the appellate body proceedings are most likely post grant. So, this happens after the grant, now we look at this in greater detail, but this is just to let you know, that enforcement is not something that is completely try tied to the grant of a intellectual property right. Enforcement can also be considered even, while the intellectual property right is being registered at the granting office.

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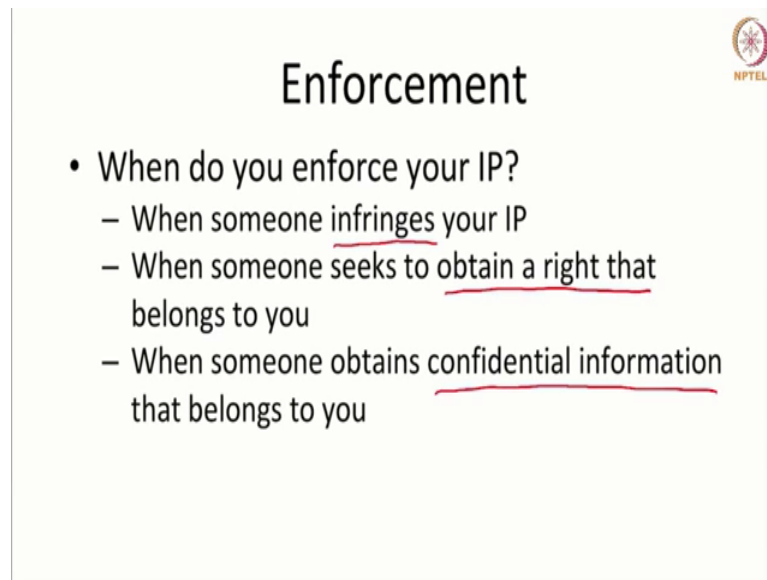
The slide is titled "Enforcement" and features an NPTEL logo in the top right corner. The content is organized into two main bullet points, each with three sub-points.

- **Enforcement**
- What is IP enforcement?
  - Protecting your Intellectual Property assets
- Why protect your IP?
  - Prevent free-riders causing harm
  - Avoid losing company's proprietary knowledge
  - Solving disputes over ownership

Now, let us look at enforcement, in further detail. Now what we what do we mean by IP enforcement? IP enforcement refers to the act of protecting, your intellectual property assets and it means that you are trying to stop free riders from causing harm to your intellectual property, you are trying to avoid losing the company's proprietary knowledge and it could also mean that you are trying to solve disputes with regard to ownership.



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## Enforcement

- When do you enforce your IP?
  - When someone infringes your IP
  - When someone seeks to obtain a right that belongs to you
  - When someone obtains confidential information that belongs to you

Now, the need to protect IP arises, when somebody infringes your intellectual property, now infringement is a special word that we use for violations with regard to intellectual property, we also try to enforce the IP, when somebody seeks to obtain a right that is actually yours. So, your right is being violated and also we seek to enforce IP, when somebody obtains confidential information that belongs to you, something that is proprietary and something that is private information, that is belong that belongs to you.

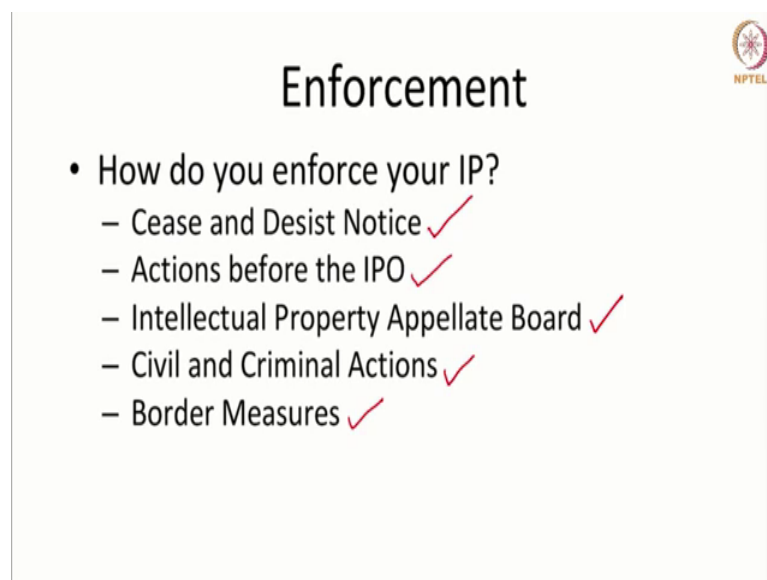
Now, you will find that intellectual property is at 1 level, it is tried to some amount of secrecy and that is true for all private property, they could because a private person owns the property. He has private control over it and private, the word private itself tells that there is an amount of exclusive control, that person can have. For instance, what you do within the premises of your house is completely private? The law allows you that privacy. So, that you know they cannot be any third parties or external forces, that come on to you and disturb your privacy.

Intellectual property because, it is private property there is an element of secrecy that is in it, in almost every intellectual property, trade secrets can be kept as a secret as long as you have an agreement with the person patents, before filing are kept a secret trademark especially in the nascent stage, where they are developed a mark is being developed or a logo is being developed, there is a tendency to keep it as secret. So, that people do not

claim prior use over it, if somebody else takes the mark and uses it then that person could have a prior user.

So, protect a argument against prior use, you are trying to keep the mark while it is been developed, while it is been conceived private copyright unless, it is published the world does not know and unless it is published you cannot let the world know that the subject matter of the creative work is protected by a copyright. So, during the proprietary phase the copyright, the work in which the copyright would eventually manifest would be kept as a secret by the author. So, this secret element is something that defines or you can also say, it is a confidential element it is something that defines intellectual property right.

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The slide is titled "Enforcement" and features a list of five enforcement methods, each with a red checkmark. In the top right corner, there is a small circular logo with the text "NPTEL" below it.

- How do you enforce your IP?
  - Cease and Desist Notice ✓
  - Actions before the IPO ✓
  - Intellectual Property Appellate Board ✓
  - Civil and Criminal Actions ✓
  - Border Measures ✓

Now, how do you enforce intellectual property? There are multiple ways to do it, almost for all intellectual property, it is true that we can say that, there is no mechanism of an automatic enforcement in the sense that, the fact that you have the right, you cannot stop others from using it, you have to enforce the right, your exclusive right through a mechanism known by law. If you own a pen, let us assume that it is an expensive pen, the easiest way you can keep it from others stealing it, is to keep the pen safely preferably in a secure place, where others cannot access it.

Unfortunately intellectual property by its nature and we saw the trades of intellectual property, it is something that is available for everyone, when it is marketed and it is something that can be easily duplicated, because of the nature of intellectual property

you should be careful about, how you enforce it? Because, there are multiple ways in which you can enforce it and you can make the person stop, but the most effective way is to approach a court of law by filing a case. So, that is the reason why intellectual property litigation is popular and it is the only way, you can enforce it there are other measures, where in you can enforce the right, but may not be as effective as approaching the court.

For instance, you could issue a cease and desist notice. Now this could be written by the right owner or by the right owners council, pointing out to your intellectual property right and telling the person to cease and desist from infringing and also giving a threat that, if the person continues that they will be and action of infringement, a cease and desist notice is at the end of the day, it is only a written communication the person, who receives it the alleged infringer has an option to abide by the notice and stop the action or the person can, if there are reasons to do it continue with the infringement. So, that notice itself does not mean anything, unless it is followed by a legal action.

So, in most notices you will find that towards the end, the person who issues the notice, will have an indication or a threat of a possible legal action with which the notice is normally concluded. So, notice is one way to enforce your IP, but it is not a guaranteed way and even if you file a cease and desist notice, they could be instances, where the person continues with the infringing action.

Now, there are certain actions that, you can take before the intellectual property office. Now all these you come to the enforcement part only when, your right is granted. So, let us assume that, you have a patent that has been granted your competitor also files a patent making small modifications around your invention and the application is still pending before the patent office, you can use certain procedures in the patent office like pre grant opposition. And, file an application before the patent office seeking revocation of that right, which is still pending because, your objective is that if that right gets granted then, it will be hard for you to enforce your right, which is already in existence.

So, there are actions before the intellectual property at office, which can be taken there are cancellation and opposition proceedings for trademarks as well, which can be taken by a person, who already has an IP. So, to ensure that there is no overlapping IP or to ensure that the competitors do not get, what is called defensive intellectual property

right. The rights that are registered, just to ensure that others do not take legal action against you, the pre grant mechanism especially for patents can be used effectively to ensure that your right is enforced.


If the competitor's right is granted as let us assume that, the competitor filed a patent on a similar modification to your invention and that is now been granted and some time has passed, say a couple of years have passed, you still have a remedy to challenge it before the Intellectual Property Appellate Board by filing a revocation petition. So, law affords you an opportunity to file action before, the Intellectual Property Appellate Board to correct wrong, which you feel could affect your chances of enforcing your IP.

There are civil and criminal actions, both trademark and copyright attract criminal sanctions and there are also civil by civil, we mean the actions that you can take before the court, every infringement suit is an action before the court and you can have a relief of injunction stopping, the person from doing the act. For instance, when you issued the cease and desist notice and following the cease and desist notice, where you just ask the infringer to stop his activities, if the infringer continued his activities then the remedy for you is to approach the court telling, the court that, I issued notice the person did not stop.

Now, so that brings us to the set of actions before the court, which can be civil and in some cases like, trademark and copyright it can also be criminal and you also have border measures. Border measures are with regard to import of an intellectual property say, you have a patent protection over a particular technology and you find that that particular technology is not protected in China and there are Chinese versions of your technology, which have been manufactured and which try to enter the country.

Now, at the point of entry you can use certain border measures to stop infringing article. It is more effective for trademarks and copyright not so much for patent, because of certain disputes that came up as to whether, you can whether the border authorities, which are largely the customs authorities have the power to determine patent infringement and the courts have said that no, they do not have the power. So, but with regard to trademark and copyright, which is where it is easy to detect a pirated material border measures are effective.

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## Cease and Desist Notice

- Legal warning to stop doing something
- Notice of rights
- Notice of possible commencement of litigation

Now, cease and desist notice means that, you issue a legal warning to stop a person from doing something. Now, they can be an advantage in this because, you put a person on notice and you have you can definitely say, one legal cause rather than going to the court directly, but they could also be some disadvantages. Especially, when you are dealing with pirated goods say, there are quite a lot of pirated copyrighted works. Now, if you issue a cease and desist notice, the person who receives the notice can quickly wipe out all the infringing material and when you go for a search, a court assisted search nothing incriminating could be found in the premises.

So, the infringement material can be especially, in the case of fly by night operators, they can just dismantle the entire set up and it will be very hard for you to find infringing copies to prove infringement. So, you can give notice normally, when you give notice you give notice of the rights. If it is a patent, you refer to the patent in your notice and tell them that, this is a patent that is being infringed and in your notice you can also give a threat or a possible commencement of litigation.

Now, there are provisions in the patent law, where the threat itself can lead to a declaratory action. If the threat is groundless, the law allows you under 106 of the Patents Act the law allows the person, who receives that threat the alleged infringer to approach the court to say that, this is a groundless threat so, stop the person from making the threat. So, there has to be some careful study before a notice is issued.

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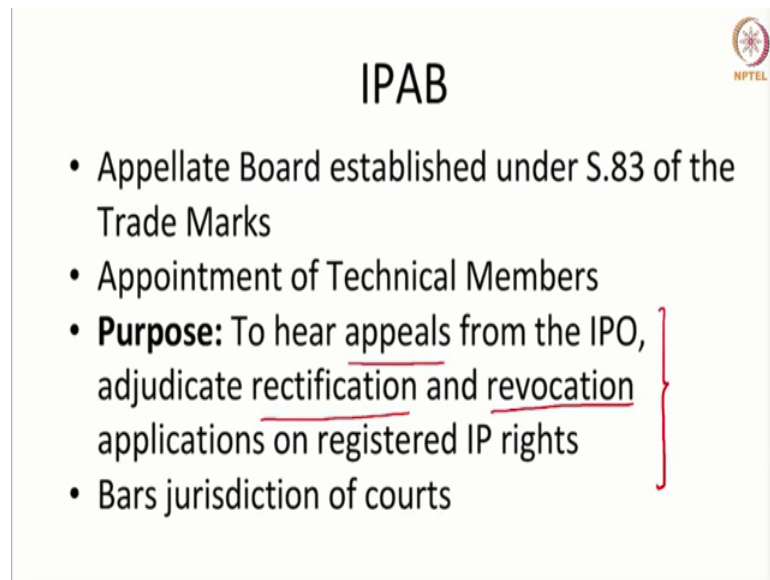
## Actions before the IPO

- Opposition Proceedings
  - Patents
    - Before the grant of patents by any person
    - Within one year after the grant of patent by any person interested
  - Trade Marks
    - File opposition within 4 months of publication of trade mark application

Now, with regard to the actions before the IPO, there are largely opposition proceedings and for patents as we have seen, they can be an opposition proceeding before the grant by any person. So, if you find that your competitor has is trying to patent something, very similar to your invention, which is been granted or your prior in time, then you can use this procedure to go to the patent office and stall his application from materializing into an intellectual property right.

And opposition proceedings can also be conducted 1 year after the grant, by a person who is interested, but that becomes a tougher task to prove because, then you already have your competitor already has an IP, that is granted in his name. So, it becomes slightly difficult to object or to oppose something that has been granted, but the pre grant procedure is quite easy and it is quite effective. Similarly, for trademarks you have a provision for filing opposition from within 4 months of publication of the trademark application.

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A slide titled "IPAB" with a list of four bullet points. The third bullet point is enclosed in a red bracket. In the top right corner, there is a small circular logo with the text "NPTEL" below it.

## IPAB

- Appellate Board established under S.83 of the Trade Marks
- Appointment of Technical Members
- **Purpose:** To hear appeals from the IPO, adjudicate rectification and revocation applications on registered IP rights
- Bars jurisdiction of courts

Before the Intellectual Property Appellate Board which was established under the Trademarks Act and which also has technical members. So, for trademark there is a person, who has a background in trademark, for patents there is a technical member who has a background in patent law. You could make an action for revocation of your competitor's right. So, it is a part of enforcement that you ensure that, your competitor does not get an IP. So, that your IP can be enforced and the IP be generally, also looks at appeals from the IPO and it also has power of rectification, rectifying the register of patents.

And the IPAB has received the power to decide these matters. So, there is a bar on the jurisdiction of the courts. The courts the matter, subject matters which are covered by the intellectual property IPAB, covered by the Intellectual Property Appellate Board cannot be taken to the civil courts.