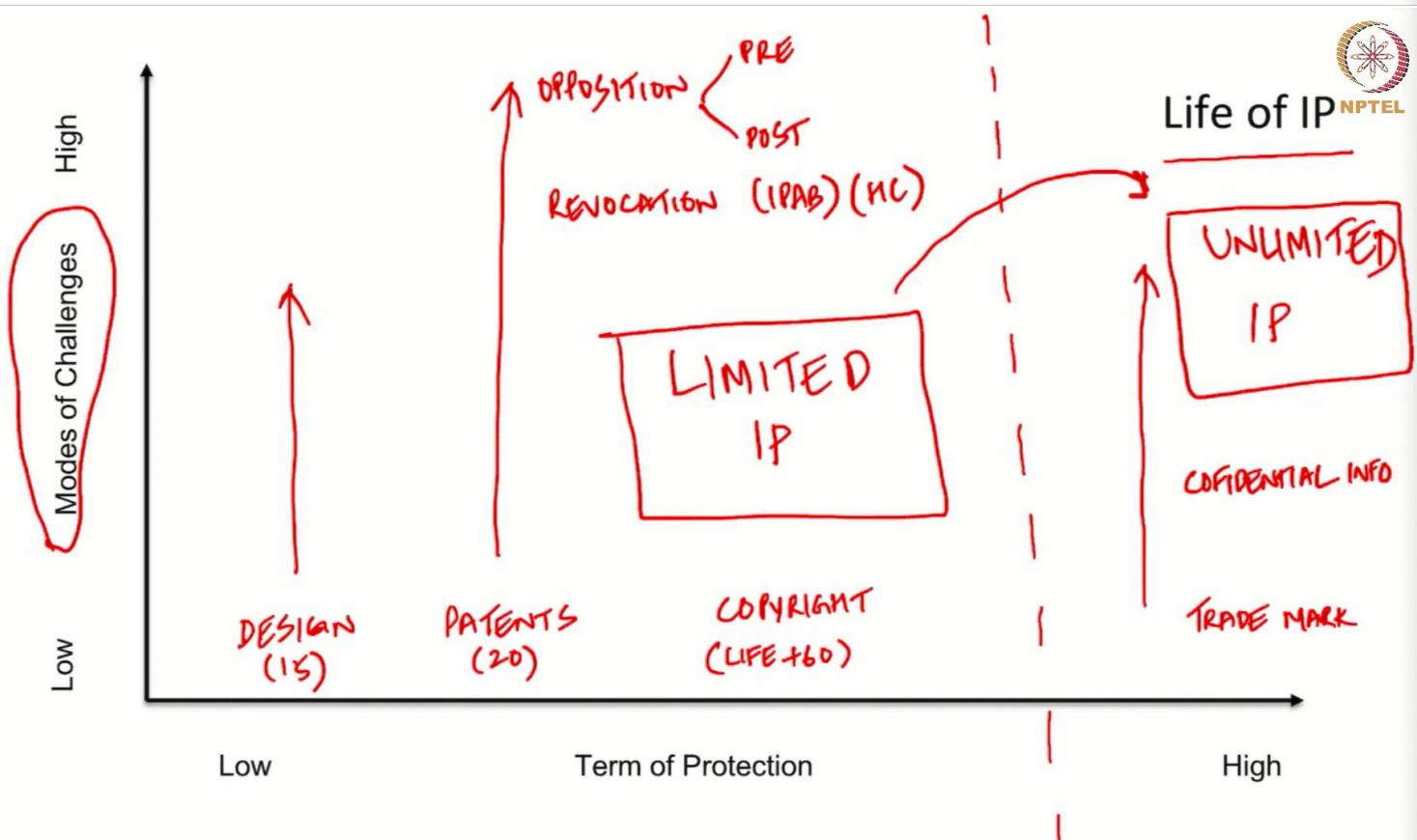
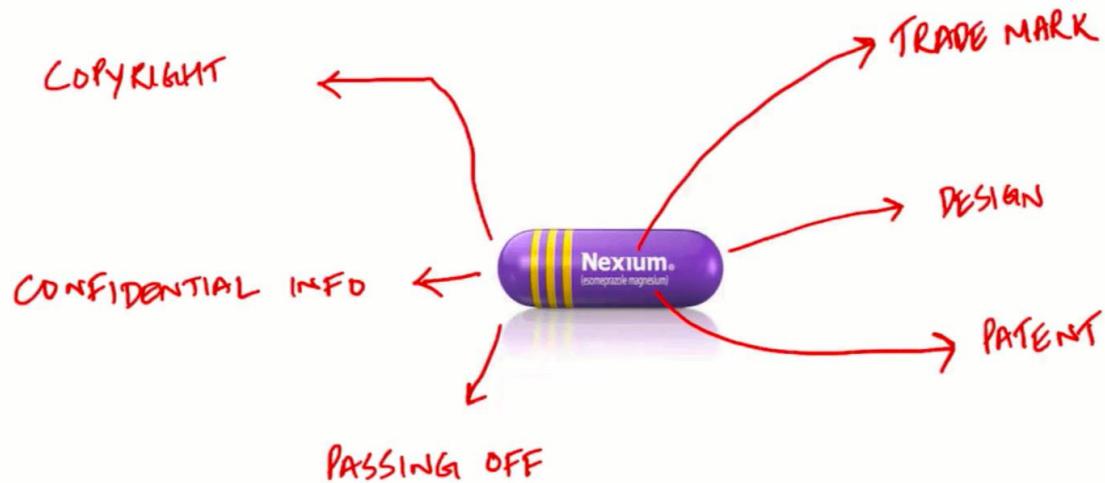




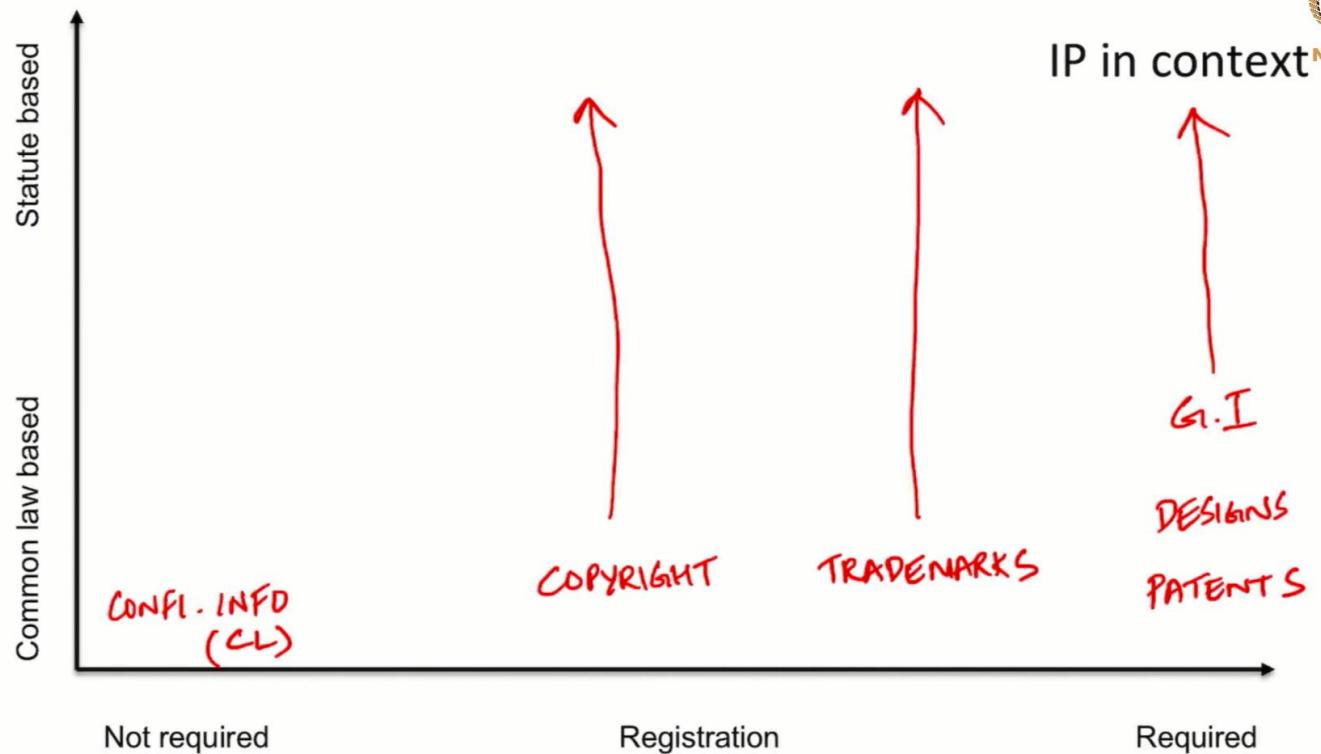
# Enforcement of IP

# Purple Pill

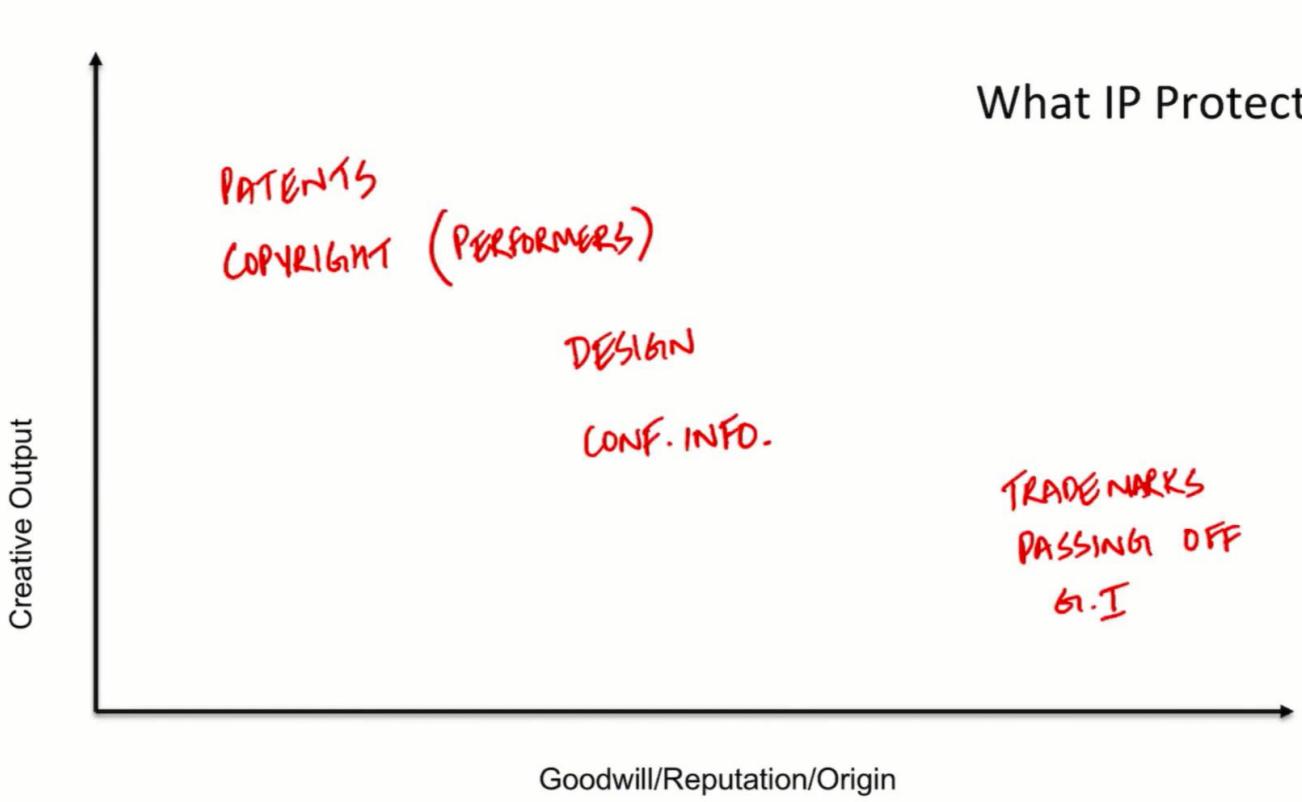
# Purple Pill

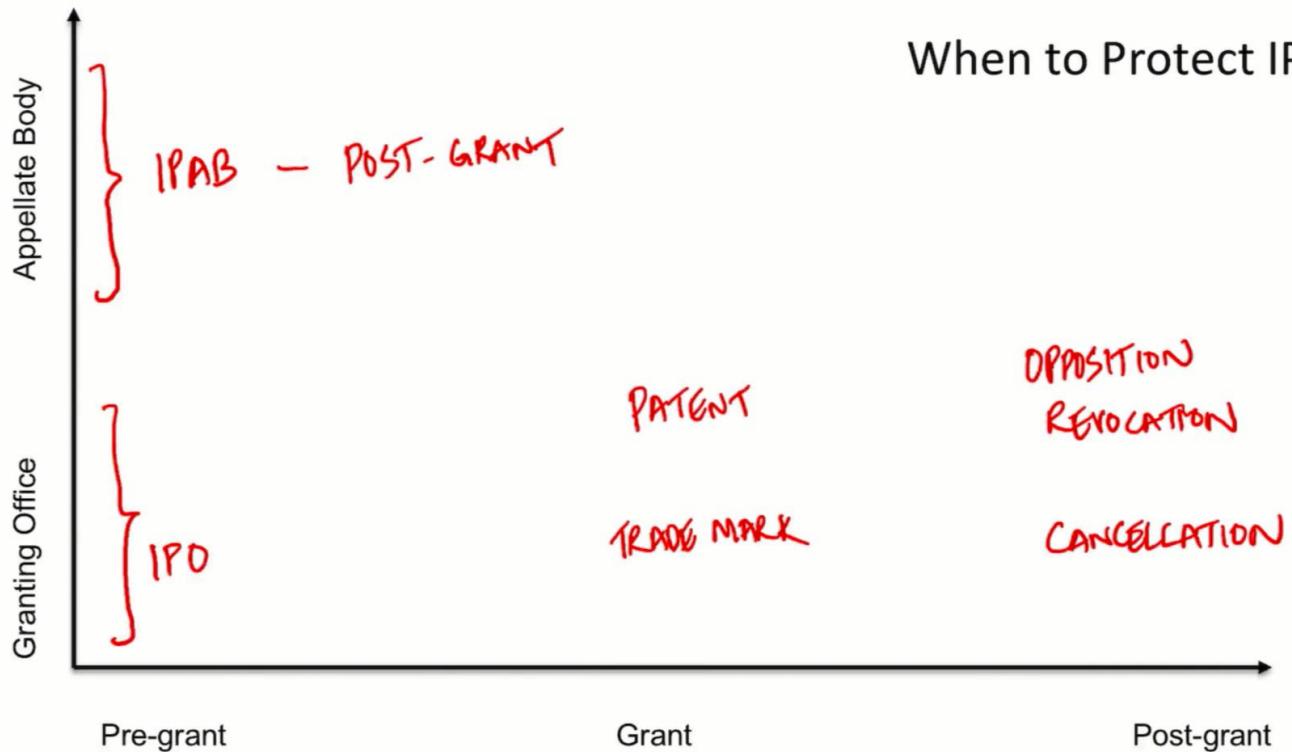


## IP in context



## What IP Protects





## 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

# 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

# Enforcement

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

# Cease and Desist Notice

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

# 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

## 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

## 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

# Patent Infringement

- 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

- 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? *S<sup>P</sup>*
    - Whether the act comes under any exception?

S.47  
S.107A  
B  
S.140

# Patent Infringement

- 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

# 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

# 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

# Trade Mark Infringement

- For well known marks:
  - Use of an identical or similar sign for both similar and/or dissimilar signs.



# 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**)

# Copyright Infringement

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

# 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

## Remedies

# Legal Consequences

- IP Infringement
  - Civil liability
    - Private action remedies
    - Injunction, damages, account of profit
  - Criminal liability; except for patent infringement
    - Public action sanctions
    - Arrest, detention, destruction, fines, imprisonment

# Civil Remedies

- Injunction
  - Ad-interim injunction
    - Ex-parte injunction
  - Interim injunction
    - Ordering the defendant not to continue or not to embark upon a course of action until the trial
  - Permanent injunction

# Civil Remedies

- Interim Injunction
  - Prima facie case
  - Irreparable injury
  - Balance of convenience
- Permanent Injunction
  - Granted by a court by passing a decree made at the hearing and upon the merits of the case

# Civil Remedies

- Mareva Injunction
  - Restrain the defendant from disposing of the assets which may be used to satisfy plaintiff's claim
- Anton Piller Order
  - Permit the plaintiff to inspect the defendant's premises

# Civil Remedies

- Damages
  - Compensatory/Actual Damages
    - Damages actually suffered by the plaintiff because of infringement of the plaintiff's IP by the defendant
  - Damages to goodwill and reputation
    - On account of undermining the plaintiff's reputation and goodwill

# Civil Remedies

- Damages
  - Exemplary/punitive damages
    - To deter the wrong-doer and the like-minded from indulging in unlawful activities
- Account of Profits
  - Plaintiff is entitled to require the defendant to account for the profits made by him
  - Can't be claimed together with damages

# Criminal Remedies

- Copyright
  - Offence of infringement of © or other right
    - Offence under S. 63
    - Imprisonment; 6 months to 3 years
    - Fine; Rs. 50000 to Rs. 2 Lakhs
  - Police has power to seize infringing copies
    - Seize without warrant all copies of infringing works

# Criminal Remedies

- Copyright
  - Possession of plates for making infringing copies
    - Imprisonment extendable upto 2 years and fine
  - Deliver all infringing copied to the copyright owner
  - Offences by companies
    - Every person who was responsible for the company's affairs at the time the offence was committed shall be responsible

# Criminal Remedies

- Trade Marks
  - False Trade Mark/ Falsifying Trade Mark
  - Penalty for applying/selling goods with false trade marks
    - Imprisonment; 6 months to 3 years
    - Fine; Rs. 50000 to Rs. 2 Lakhs
  - Enhanced penalty for subsequent conviction
    - Imprisonment of minimum 1 year
    - Fine of minimum Rs. 1 lakh

# Criminal Remedies

- Trade Marks
  - Criminal offences can be for registered as well as unregistered trade marks
  - Forfeiture of Goods
    - Direct government to forfeit all goods relating to which an offence is committed
  - Power of police for search and seizure

# Criminal Remedies

- Patents
  - No criminal remedies available
  - Infringement requires analysis of claims
  - Seizure cannot be done by police officer on the face of alleged infringement

# Border Measures

- Intended to prevent infringing copies from being brought into the country concerned
- Carried out by administrative authorities
  - Custom officials
- Recently power of customs to seize import on mere complaints of patent infringement revoked

# Alternate Dispute Resolution

## ADR

- Resolving IP disputes without having to start court proceedings
- Many forms of ADR
  - Arbitration
  - Mediation
  - Expert Determination

# WIPO

- WIPO Arbitration and Mediation Center
  - Established in 1993
  - Services of resolution of IP disputes b/w private parties
- Offers confidentiality of proceedings

# WIPO

- WIPO Internet Domain Name Dispute Resolution
  - Uniform domain name dispute resolution
  - Adopted by ICANN
  - UDRP applies to registrations in generic top level domains

# Compulsory Licenses

## Compulsory Licenses

- Two types of Licenses
  - Voluntary license ✓
  - Compulsory license
- CL are statutory licenses to do an act covered by an exclusive right without prior authority of the owner

# Patents

- Types of compulsory licenses in patents
  - Third party initiated CL
  - Special CL
  - CL of related patents
  - CL for export of pharmaceuticals

# Patents

- Application for CL [Third Party]
  - Establish a prima facie case
  - Any person interested after the expiration of 3 years from the grant of patent can apply
- Conditions
  - Reasonable requirements of public not satisfied

# Patents

- Conditions
  - Not available at reasonably affordable price
  - Not worked in India
- Other applications under ss. 91, 92, 92A
- One CL in India
  - Nexavar case

*RP SV EXP*

# Copyright

- Section 31 of Copyright Act provides for compulsory licensing of copyright
  - For works that are withheld from the public
- Conditions: © owner refused to
  - Republish or allow the republication of the work
  - Allow for the performance of the work in public, hence work withheld from public

# Copyright

- Conditions: © owner refused to
  - Allow communication of the work to the public by way of broadcast of such work
  - Provide sound recording in reasonable terms
- CL can be granted in case of unpublished Indian works
- Objective: Ensure availability of © material