

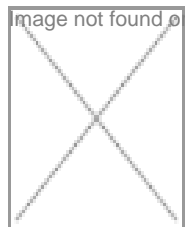
Playing Tom and Jerry in Patents

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With the product patent regime on the anvil, things would change and Jerry must watch out for Tom before venturing out.

In the present changing scenario, two issues gain importance-acquiring patents and enforcing them. In this article, we shall examine some of the issues relating to infringement from Tom's (innovator's) perspective.

The copied or accused products are usually of two types. A direct copy where the accused or the allegedly infringing product has all the features that have been claimed in the patent. In patent parlance, it is called "literal infringement"; or a variant wherein the accused product differs from the claims in one or more aspects, but is essentially derived from or inspired by the patented product.

Each claim must be adequately supported in the specification by way of examples and description. If not, the claim would be invalid for "insufficiency of disclosure".

After having determined that the accused product does actually infringe the claims of the patent, the next step is to prepare for the legal battle with ammunition such as particulars of the infringing product like its manufacturer and the scope of their activities in India. Under the Indian law, any act of importation, use, offering for sale, selling, marketing in any manner would constitute infringement. The criterion is whether the innovator is being deprived of the fruits of his labor and whether the invention is being used to further commercial interests. All these activities must occur within the Indian territory for an action to be taken in India.

If for instance, a patent holder had an Indian process patent for a product, which is already in the public domain and the infringer prepared the product using the patented process outside India and imported the finished product into India, it would not constitute infringement of the process patent in India.

In certain developed countries, preparing a product even outside their territory via a process patented in their territory would constitute infringement if it can be proved that the product was prepared by that patented process. A classic example is where the product and the process for its preparation are patented in US. An Indian company obtains the relevant literature, prepares the product via the patented process in India and exports it to US. Such an activity is likely to invite an infringement action.

In case of a process, it is often far difficult to prove the nuts and bolts of the infringing process since access to the premises of the defendant where the process is being carried out is nearly impossible, especially in India. Hence, the Patent Act, 1970 (as amended in 2003) now provides that if the product of the plaintiff is new and identical to that of the defendant and if the plaintiff is not able to obtain details of the defendant's process, then, the onus is on the defendant to prove that the process adopted by him is different from that of the plaintiff.

Having gathered enough ammunition, one may approach the court (district or High Court) with a suit for infringement claiming injunction to restrain the defendant from continuing his infringing acts and damages for the loss caused by such infringement. If a prima facie case is made out, the court may grant ex-parte injunction and order seizure of goods.

In conclusion, a plaintiff must take adequate care to first obtain a good patent, maintain it and then to enforce it against infringers. Mere ownership is like a half-told story.

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K&S Partners is a full-fledged intellectual property law firm with offices in New Delhi and Bangalore. It specializes in the entire gamut of intellectual property laws, protection and enforcement.