

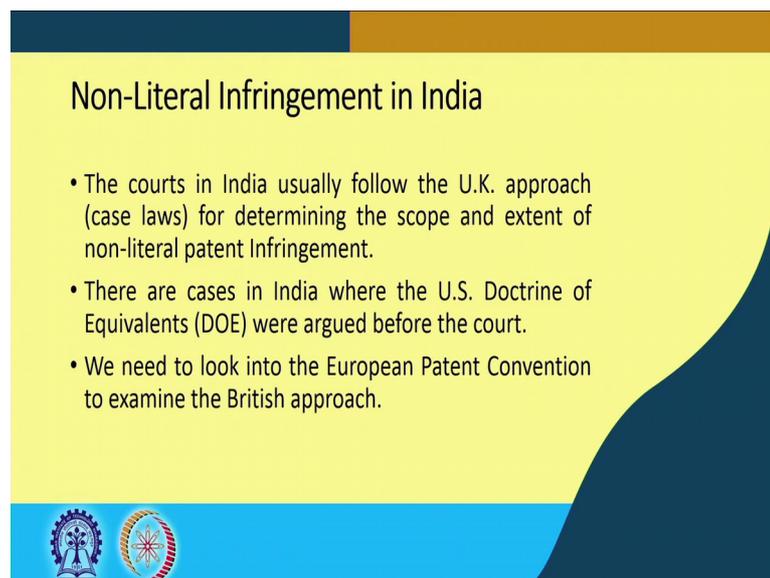
Patent Search For Engineers And Lawyers
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Lecture - 40
Patent Infringement

Welcome and in the last class I have discussed and we have seen that the scope of the claim not only limited to the literal meaning of the claim, but it goes beyond the literal meaning and it can capture the equivalent. And in the last class we have also seen that actually how this has been applied in your (Refer Time: 0:45), there are parallel to this (Refer Time: 0:50) which is there in UK and as well as in UAE in India.

In India actually we follow normally the British approach to the patent law and therefore before we get into the Indian understanding with regard to what extent the game scope can be extended to capture production processes which are coming within the parameter of equivalence, we need to understand it in the from the case laws coming from the UK. But before that let us straight go to the UK paradigm what is non literal infringement in India?

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Non-Literal Infringement in India

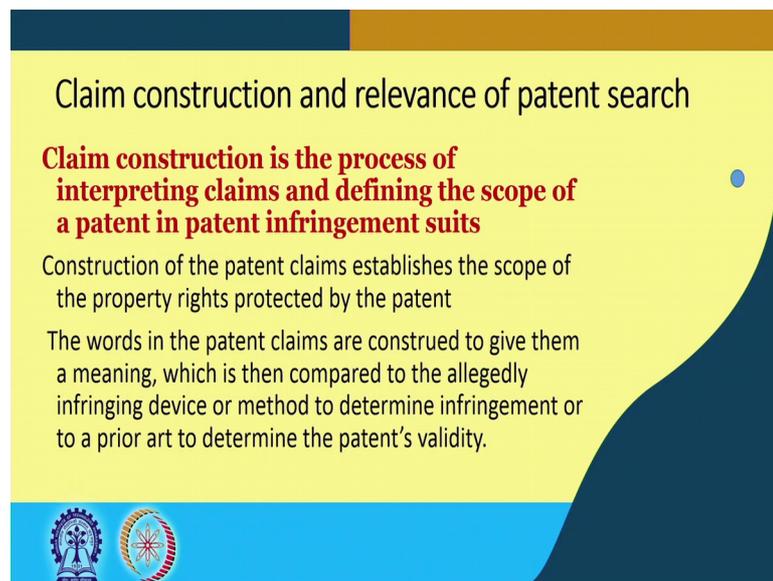
- The courts in India usually follow the U.K. approach (case laws) for determining the scope and extent of non-literal patent Infringement.
- There are cases in India where the U.S. Doctrine of Equivalents (DOE) were argued before the court.
- We need to look into the European Patent Convention to examine the British approach.

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As I have mentioned that the courts in India usually follow the UK approach, because this is actually we are inherited the a British common law system and almost all laws

including the patent law which was enforcing in UK was applied in India. When India was before independence it was applied in India. And there are cases in India's actually where even the US doctrine of equivalents were argued. But before we get into the Indian understanding we need to have in a kind of understanding about the UK approach.

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And here actually what is claim construction and what is its relevance that needs to be understood and I will request my colleague Professor Padmavati to explain it.

Thanks thank you Professor Shreya Matilal. So, when we look at the relevance of claim construction under the purview of patent search this becomes relevant in different types of proceedings. So, fundamentally as all of you are aware the property in a patent is in the claims. So, given that for either parties the need for claim construction comes into picture.

So, what is claim construction? Claim construction is the process of interpreting claims in relation to the scope of an invention and this typically happens in the cases of patent infringement suits. And through the interpretation of the law we get a final understanding of actually where there is a case of infringement and where there is a case of no infringement.

So, construction of patent claims actually establishes the right in relation to the property in a patent that is, what are the claims which are actually valid even through the

proceedings. So, if you look at the claims, claims are words in relation to our invention put in a context. So, when you look at an alleged infringing device or a method the question of the interpretation of claim terms comes into picture whenever you look at the determination of patent validity in relation to a particular diagram.

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How the understanding of Claim construction principles will help in a focused patent search in a patent dispute?

- There are several doctrines of claim construction in patent law
- There is a shift from applying literal reading of claims to purposive construction of claims

The name of the game is in the claim

So, there are different ways in which claim construction principles are understood, again from the point of view of a lot of case law across several jurisdiction. So, today we have different canons for claim construction and several doctrines, there are several doctrines like the doctrine of pith and marrow doctrine of purposive construction, doctrine of claim differentiation and the doctrine in which you have the issue preclusion all of these.

So, there is a shift definitely from the literal reading to the purposive construction of claims. So, when the patentee comes forward with names in relation to certain elements and the scope of that particular element claimed in the patent is looked at from the court's point of view. Today we see a definite shift from the literal meaning of the claim term to understanding the context of the claim term. So, here there is a divergence if you look at it from the case law.

So, why is this very important because as in the patent parlance we say the name of game is in the claim. So, to both the parties whether it is a plaintiff or the defendant

the claims become the heart of the entire interpretations, so far as the scope of patent law is concerned.

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See when it comes to real property and we can easily identify a real property by laying down defense of the real property and if you have looked into a sale document. You must have seen that it says that if the plot x belongs to mister a and he has purchased it the sale document tells us that on the right hand on the instant side as land is situated on the Northern side b land on the Western side c land and on the Southern side d land.

So, this is how the scope of a property real property is determined. But when it comes to patent actually it becomes very very difficult, because here they there are inherent limitation of the language, because here we are trying to capture an invention which is technical in nature. In terms of words and phrases and therefore what the patentee exactly meant by that claim, we have to understand it from the context and as my colleague Professor Padmavati.

She has mentioned that there are different methodologies which have emerged and those methodologies we are implying in different cases, but as we have we are trying to understand in what context we are looking in to the British case law. As I have mentioned that we have in India inherited the British tradition of common law and the British intellectual property laws are also adopted in India. And therefore what goes on in UK also influences the Indian court decisions.

So, here actually let us start with the European patent convention and Article 16 paragraph Article 69 paragraph 1 of the European patent convention which you can see in your screen. It says actually that the extent of protection conferred by a European patent or an European patent application shall be determined by the claims. Then the next sentence comes nevertheless the description and drawings shall be used to interpret the claim.

So, there are two distinct paragraph there are two distinct sentences which are used, the first sentence talks about the extent of protection the scope of protection it should be determined by the claim statement and it also says that while trying to understand the deforce squares of patent.

The description which is attached to the patent application and as well as the drawings which form part of the patent application that should be consider for trying for in the process of understanding where lies defense of the patentee patentees property right. Now here actually here I just want to mention that this is actually trying to harmonized two distincting paradigms, the paradigm of British patent law.

The paradigm of British patent law which was basically looking in to the language and whereas the German patent law which looks into the nature of the invention. So, this is an attempt to harmonize this common law understanding with the civil law understanding which was prevailing in Germany now. So, far as the interpretation of Section 69 paragraph 1 is concerned there is an agreed protocol and that protocol let us try to understand.

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Protocol on the Interpretation of Article 69 EPC

Article 1 General Principles: Article 69 should not be interpreted as meaning that the extent of the protection conferred by a European patent is to be understood as that defined by the strict, literal meaning of the wording used in the claims, the description and drawings being employed only for the purpose of resolving an ambiguity found in the claims. Nor should it be taken to mean that the claims serve only as a guideline and that the actual protection conferred may extend to what, from a consideration of the description and drawings by a person skilled in the art, the patent proprietor has contemplated. On the contrary, it is to be interpreted as defining a position between these extremes which combines a fair protection for the patent proprietor with a reasonable degree of legal certainty for third parties.

Article 2 Equivalents: For the purpose of determining the extent of protection conferred by a European patent, due account shall be taken of any element which is equivalent to an element specified in the claims.

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And this is known as protocol on the interpretation of Article 69 of the European patent convention. Now what it says here actually first I will read out the text and then will try to understand that what this text actually it contemplates. Say Article 69 should not be; should not be interpreted, as meaning that the extent of protection conferred by the European patent is to be understood as that defined by the strict literal meaning of the wording used in the claim.

The description and the drawing being employed only for the purpose of resolving an ambiguity in the claims, nor should it be taken to mean that the claims serve only as a guideline and that the actual protection conferred may extend to what form a consideration of the description and drawing by a person skilled in the art the patent the proprietor has cut contemplated. On the contrary it is to be interpreted as defining a position between these extremes which combine a for fair protection for patent proprietor with a reasonable degree of legal certainty for third parties.

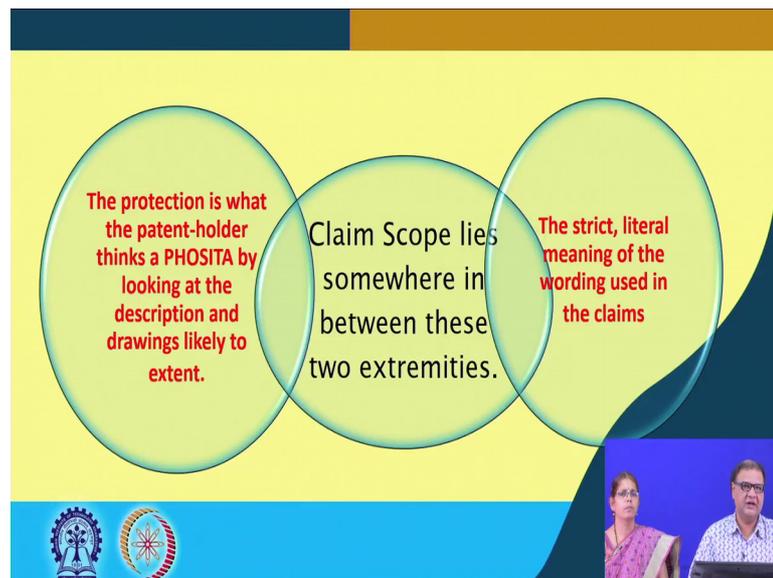
So, this is actually a striking the policy balance between the two aspect. If there is a two if it there is a mere literal interpretation it would create disincentive for the patentee to invest a might in research and development to, it would create disincentive for the patentee to create things. On the other hand if the claim scope is too broad and if it is interpreted in the light of what you call what a posita should is what a posita thinks in

that case and the posita here who is construing the posita? The posita is construed by the patentee himself.

He is putting himself at the shoes into the shoes of the posita, when he is trying to understand that what is the scope of patent both should be avoided and there should be emit path should be taken that is what this article is talking about. Then in addition to that Article 2 is clearly an in specific term explicitly talking about equivalents and it says that for the purpose of determining the extent of protection conferred.

By an European patent due amount account shall be taken of any element which is equivalent to an element specified in the claims. So now, let us try to understand this two paragraphs with the help of a kind of diagram.

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Now, as you see that there are two extremities here, on the right hand side what you can see is the strict literal meaning of the wording used in the patent and which will unnecessarily create with restrict the scope of property right of the patent holder. On the other hand on the right hand on the left hand side what you see is the protection; the protection is what the patent holder thinks a posita by looking at the description and drawing likely to extent.

So, he actually the patentee is as I have mentioned the patentee is putting himself into the shoes of the posita, at a time when he is writing the patent claim and as we know that

there are inherent limitations of the language. He would be trying to; he would be trying to say that the posita would in this situation would have interpreted the patent in this manner and this broad manner. So, when the issue comes up before a kind of agency that is required to determine the claim scope, the agency must take into consideration both and strike a balance in between these two extremes and that is what Article 69 of the European patent convention talks about.

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Doctrine of Pith and Marrow & Purposive Construction

Catnic Components and Another v Hills and Smith Limited

- Invention: Steel Lintels
- Plaintiff – Patent on steel lintels
- Defendant – Copied and manufactured lintels with interest to enter the market for galvanised steel lintels
- The lintel differed from the plaintiffs' commercially produced lintel only in that the rear support member, instead of being perpendicular to the base, was inclined 6° or 8° from the vertical.

Now, this article had this article was subject matter of interpretation by the British court and to be very precise the house of lords in two leading cases and the first one is Catnic component and Another versus Hills and Smith Limited. So, here actually first we need to understand the nature of the invention and the nature of the dispute involved in this case ok.

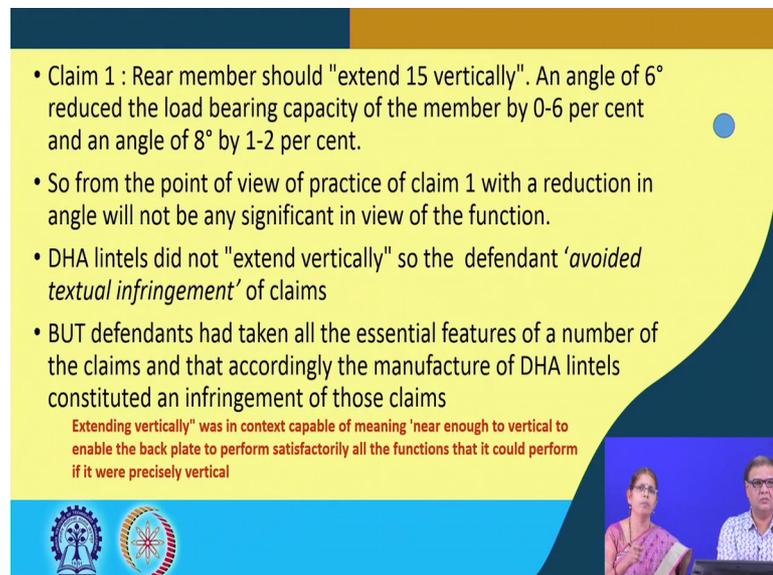
So, let us understand it from the point of view of the invention and what part of the invention is the infringement and then the context of the case. So, the invention is basically about lintels and in this case it is about steel lintels, most of you may be aware that wherever there is a requirement in a construction of where you have spaces lintels help to build the strength.

So, you can have wood based and of course for better support Steel Lintels are used, so the plaintiff had a patent on the steel lintels. Now what is the issue at hand is that the information on these steel lintels was copied, that is documents manuals from the

plaintiffs end have been shared by some of the employees that is one the. So, this also came under the purview of the copyright act at that point of time and the dependent Hills and Smith actually manufactured the lintels.

With the specific interest of moving into the market where galvanized steel lintels have a big area where they can capture in terms of commercial benefit from the profit point of view. So now, if you look at the plaintiff's product vis a vis the defendants product the essential difference is with respect to one member of that particular lintel which is a rear support member.

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- Claim 1 : Rear member should "extend 15 vertically". An angle of 6° reduced the load bearing capacity of the member by 0-6 per cent and an angle of 8° by 1-2 per cent.
- So from the point of view of practice of claim 1 with a reduction in angle will not be any significant in view of the function.
- DHA lintels did not "extend vertically" so the defendant '*avoided textual infringement*' of claims
- BUT defendants had taken all the essential features of a number of the claims and that accordingly the manufacture of DHA lintels constituted an infringement of those claims

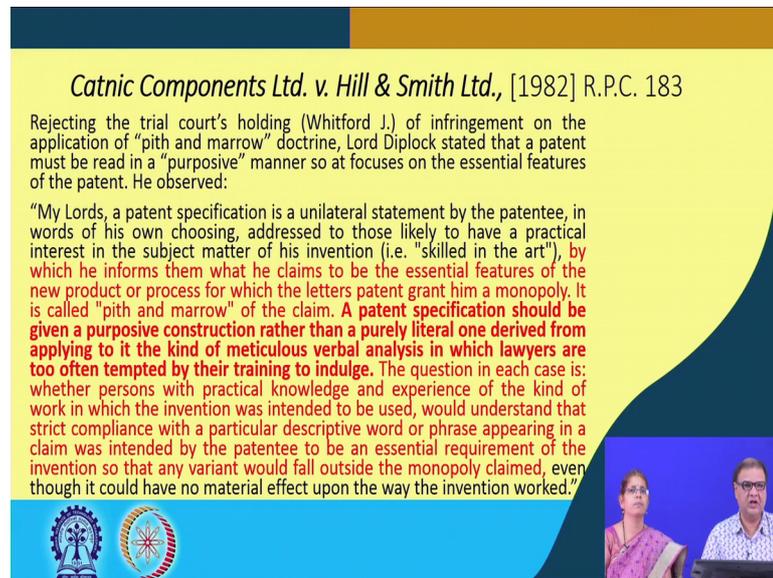
Extending vertically" was in context capable of meaning 'near enough to vertical to enable the back plate to perform satisfactorily all the functions that it could perform if it were precisely vertical

Now, if you look at the patentees the claims, the rear support member is at a particular angle and it extends to about 15 thing vertically and at a specific angle. Now an aspect of this is what has been modified in the defendant product. So, the question that comes in is that this is a variant of the patentee's invention. Now the question is essentially the defendant is making the lintels so is he infringing or not infringing. So, if you look at it from the point of view of claim terms as we have discussed the earlier instance, there is one way in which you can literally interpret the meaning of the claim term.

Now, here the angle is different so if you really import the literal meaning it is not a case of literal infringement. So, the defendant could avoid the textual infringement to that extent, but the question that came to the court is essentially he is making lintel. So, is it not a case of infringement? So, this is where you really read the context of what we say

reading beyond the literal infringement into looking at what is the purpose of the claim term. So, there is where you see the context of the doctrine of purposive construction coming up beyond the literal interpretation of the claims.

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Catnic Components Ltd. v. Hill & Smith Ltd., [1982] R.P.C. 183

Rejecting the trial court's holding (Whitford J.) of infringement on the application of "pith and marrow" doctrine, Lord Diplock stated that a patent must be read in a "purposive" manner so as to focus on the essential features of the patent. He observed:

"My Lords, a patent specification is a unilateral statement by the patentee, in words of his own choosing, addressed to those likely to have a practical interest in the subject matter of his invention (i.e. "skilled in the art"), by which he informs them what he claims to be the essential features of the new product or process for which the letters patent grant him a monopoly. It is called "pith and marrow" of the claim. **A patent specification should be given a purposive construction rather than a purely literal one derived from applying to it the kind of meticulous verbal analysis in which lawyers are too often tempted by their training to indulge.** The question in each case is: whether persons with practical knowledge and experience of the kind of work in which the invention was intended to be used, would understand that strict compliance with a particular descriptive word or phrase appearing in a claim was intended by the patentee to be an essential requirement of the invention so that any variant would fall outside the monopoly claimed, even though it could have no material effect upon the way the invention worked."

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So, in this case what happens actually the house of lord rejected the trial court's decision, the trial court justice Whitford J. He actually he held that the it constituted patent infringement under the doctrine by applying the doctrine of pith and marrow. However, as I have mentioned that house of lord rejected this and found no infringement and what house Lord Diplock has to say what Lord Diplock said in this case and his observation had as now become the famous observation that controls the rule concerning the purposive interpretation not only in England, but also in India.

So, what he says actually let us look into this statement, it is actually a long statement and it has a meaning and it has a far reaching consequence. He says actually my lord a patent specification is an unilateral statement, by the patentee in words of his own choosing, addressed to those likely to have practical interest in the subject matter of his invention.

Who is likely to have a practical interest in the subject matter of invention? Obviously, a person skilled in the art and as I have mentioned that person is called posita and that person is the hero of patent law, by which he informs them what he claims to be the essential feature of the new product or process for which letters patent grant him a

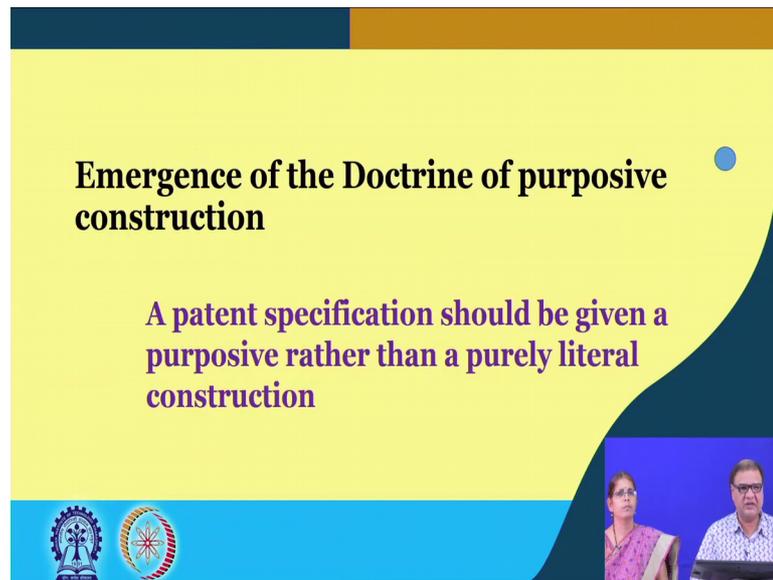
monopoly, it is called pith and marrow of the claim. So, the pith and marrow of the claim is what he thinks is the essential feature of the claim and which he wants to make it known to the person having ordinary skill in the art.

Then Lord Diplock says that a patent specification should be given a purposive construction rather than a purely literal one derived from applying to it the kind of meticulous verbal analysis, in which lawyers are too tempted by their training to indulge. See this is actually a very very important statement, a claim did not be understood in the way a lawyer actually employs the technique of interpretation to understand a piece of statute or a piece of document.

A patent claim is altogether a different text which needs to be interpreted from a different perspective and that perspective obviously is not a lawyers perspective, but that is a perspective which is a technical perspective. And then he says the question in each case is whether the person with practical knowledge and experience of the kind of work in which the invention was intended to be used, would understand that strict compliance with a particular descriptive word or phrase appearing in the claim was intended by patentee to be essential requirement of the invention.

So, that any variant would fall outside the monopoly claimed, even though it could have no material effect upon the way the invention worked. So, as I have said that this is the paragraph which controls the law of purposive construction throughout the common law jurisdiction including in India. Now what is the meaning what is the extent of this paragraph, we will try to understand it with the help of a technical example at a later stage.

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Now, now comes actually how what this is the starting point of the emergence of the doctrine of purposive construction. So, if you have seen the earlier instance now wherever there is a variant the question that arises is that would materially the posita who is looking at a that particular term would it be covered under the claim. So, the essentiality of the variant to the making of the patent claim is the question at hand.

So, how far is the variant from the original claim term? So, the pith and marrow doctrine talked about essentiality as an important component. Whereas, if you look at the purposive construction it went beyond the literal meaning, that is does the state of the art tell you that the variant can be easily made then in that case it can still come under the scope of infringement.

So, this is where we see the emergence of the doctrine of purposive construction. So, that the plaintiff gets a little bit of a you know extension of the relevant you know variants in relation to the claim term. So, here you see again the approach of the later part of the cases where you see the doctrine of purposive construction.

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Improver Corp. v Remington Consumer Product Ltd., 1990] F.S.R. 181

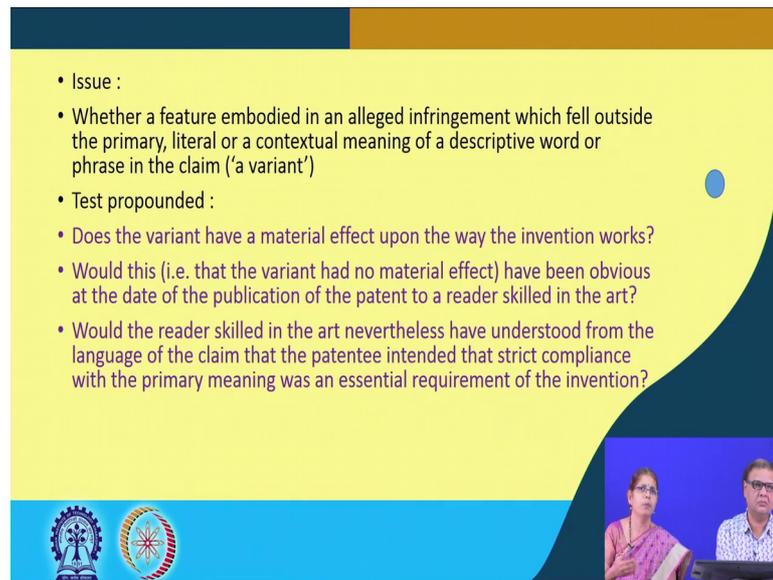
- Hair removal using an arcuate rod with slits
- When rotated at high speed, hair removal takes place with the opening and closing of the slits
- Alleged infringer – use of arcuate rod of vulcanized rubber with slits

Is replacement of a 'helical spring' with 'rubber rod' infringement?

So, one of the very important cases which the judge Hoffmann came gave the important decision is in relation to the improver case. This is the case of 1990 Improver Corporation versus Remington Consumer Products. What is the invention about? So, improver came up with the depilator which actually is helpful in hair removal and the invention is implemented based using an accurate rod which has slits.

So, whenever you rotate this at a high speed there is a opening and closing of slits by way of which the process of depilation happens. So, in this case Remington made the instead of the helical spring which is a central part of the invention that was replaced with a rubber rod using vulcanized rubber. Now the question is replacement of a helical spring with a rubber rod is it infringement, because ultimately the purpose of the invention is the same that is also working for depilation.

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- Issue :
- Whether a feature embodied in an alleged infringement which fell outside the primary, literal or a contextual meaning of a descriptive word or phrase in the claim ('a variant')
- Test propounded :
- Does the variant have a material effect upon the way the invention works?
- Would this (i.e. that the variant had no material effect) have been obvious at the date of the publication of the patent to a reader skilled in the art?
- Would the reader skilled in the art nevertheless have understood from the language of the claim that the patentee intended that strict compliance with the primary meaning was an essential requirement of the invention?

So, as we move on we will understand what actually happened in this particular case. So, here the question of actually the we are going beyond the literal meaning, because it is a variant. Now, we applied a contextual meaning and that is where we come into the context of the doctrine of purposive construction. So, this case is important from the point of view of Judge Hoffmann giving the test in relation to looking at that variant.

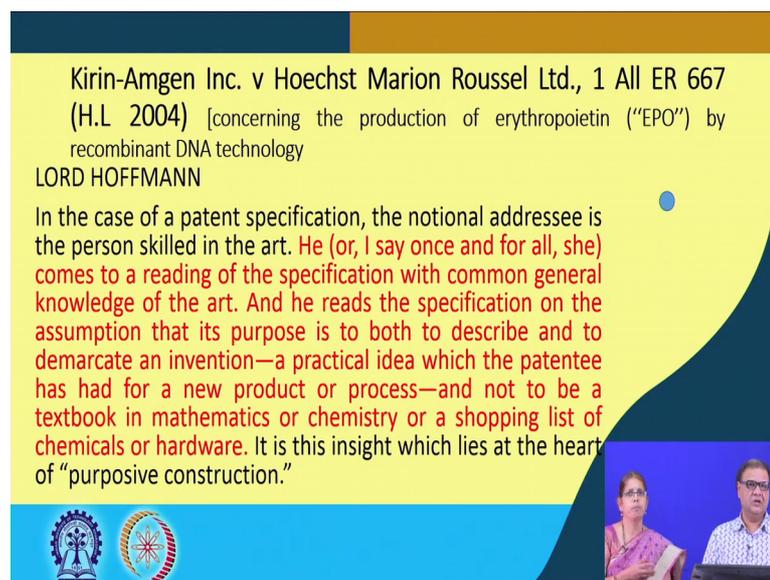
So, there are three important factors that are important are necessary in the determination of whether a variant will be infringing on the claims of the patentee particular element. So, the first question to addresses does the variant have any significant involvement in relation to invention that is one important thing. So, thus the variant have a material effect upon the way in which the invention works, the second question to ask is would this be obvious to the person skilled in the art.

So, when you read the patent does it occur to you that well this is obvious, the variant is in immediate necessity you know which you would extent to, so that is the second question that would be asked. Now the third important thing is so the one who is looking at it that is through the lens of the posita having understood the interpretation of the variant to what extent the essentiality can be imported. So, would that variant also come in to the purview of being an essential element?

So, the essentiality is then decided, so on this once you get to the understanding of the decision in relation to this, then one could decide on whether there is infringement or not.

So, wherever there is a scope of where it comes under the purview of the patentees invention then it would mean infringement. But if the variant is reading away from the purpose, so that means the invention is not made and so therefore there is no question of infringement. So, this is where you see the relevance of the protocol to the Article 69 which came about in 2000, where you have the interpretation coming again from the point of view of the understanding of the case law.

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Kirin-Amgen Inc. v Hoechst Marion Roussel Ltd., 1 All ER 667 (H.L. 2004) [concerning the production of erythropoietin ("EPO") by recombinant DNA technology]

LORD HOFFMANN

In the case of a patent specification, the notional addressee is the person skilled in the art. He (or, I say once and for all, she) comes to a reading of the specification with common general knowledge of the art. And he reads the specification on the assumption that its purpose is to both to describe and to demarcate an invention—a practical idea which the patentee has had for a new product or process—and not to be a textbook in mathematics or chemistry or a shopping list of chemicals or hardware. It is this insight which lies at the heart of "purposive construction."

Now, you know actually this the paragraph which we have seen and which has in light of those paragraph the scope of claim was determined and which we have seen that this talks about the essential feature of the claim. Now there is actually an there is an example and in that is an example concerning EPO and with they got to using the recombinant DNA technology. First we will understand the technology and then we will understand the legal rules which were been let down in this case.

As you can see in your screen it is the case of Kirin Amgen Incorporated versus Hoechst Marion Roussel Limited and this is again a decision coming from Lord Hoffmann of the House of Lords.

So here the case is about erythropoietin, erythropoietin is a molecule with Amgen had a great number of years it had a monopoly on. So, the entire sequence different variance of the sequences of DNA which are the different the EPO, EPO like the genes are under the claims in relation to the Amgen's patent. The question that comes into the issue here in

this particular case is by way of import is there is a case of infringement or not. So, Hoechst is also involved in some of the products in relation to e making EPO. Now so the question comes in terms of actually whether there is an infringement, by the way of making the relevant you know the product made out of EPO.

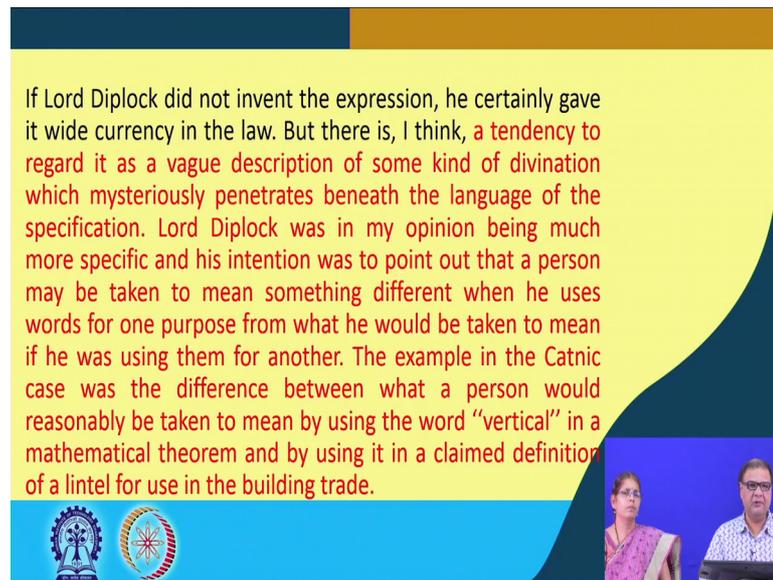
So, what typically happens in the area of pharmaceuticals is that the active pharmaceutical ingredient is the same between the you know whoever is actually working in the area. Now there are variations in relation to the formulation. So, suppose let us say you are making a variant of an EPO and implementing that as a part of the product and EPO is essentially you know the patent is by another party.

So, the question that comes is by way of making EPO is another party infringing on. So, his Hoechst infringing on Kirin Amgen's patent is the question here. So, that is where we see the entire application of the case of infringement in this particular case.

So, here what happens actually here what Lord Hoffmann has to say and this is very very important and this captures and explains the doctrine which was propounded in Catnic by Lord Diplock. In this case what the what lord Hoffmann says is actually in the case of a patent specification, the notional addressee is the person skilled in the art. He within bracket or I say once for all she comes to a reading of the specification with common general knowledge of the art.

And he reads the specification on the assumption that its purpose is to both to describe and to demarcate an invention. A practical idea which the patentee has had for a new product or process and not to be; not to be a textbook in mathematics or chemistry or a shopping list or of chemicals and hardware. So, the line the portion which I have red mark you will understand how it is relevant for catnic in the next line. So, it is this insight which lies at the heart of purposive construction.

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If Lord Diplock did not invent the expression, he certainly gave it wide currency in the law. But there is, I think, a tendency to regard it as a vague description of some kind of divination which mysteriously penetrates beneath the language of the specification. Lord Diplock was in my opinion being much more specific and his intention was to point out that a person may be taken to mean something different when he uses words for one purpose from what he would be taken to mean if he was using them for another. The example in the Catnic case was the difference between what a person would reasonably be taken to mean by using the word "vertical" in a mathematical theorem and by using it in a claimed definition of a lintel for use in the building trade.

Now, if Lord Diplock did not invent the expression this is the continuation of the earlier paragraph, he certainly gave it wide currency in the law. But there is and I think a tendency to regard it as a vague description of some kind of divination which mysteriously penetrates beneath the language of the specification. I think some of you may also have this that this is something which is ununderstandable which is very ambiguous and vague it is not.

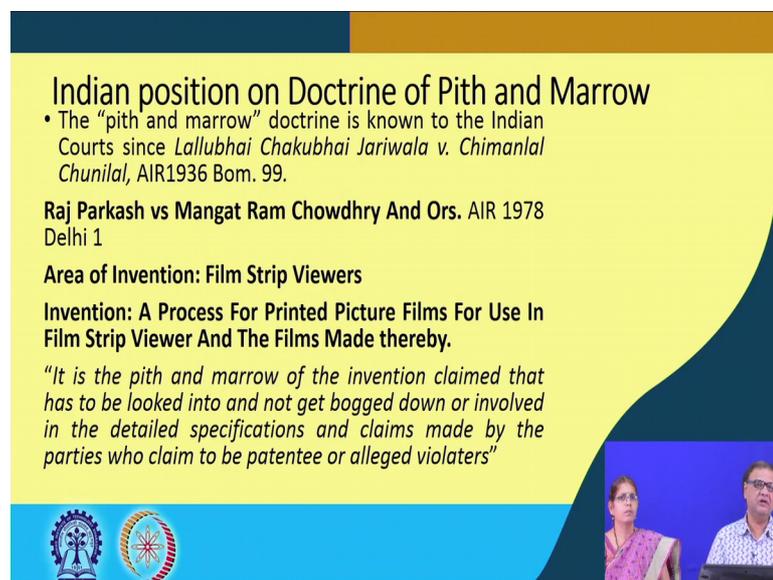
Now I continue what lord Hoffmann says Lord Diplock was in my opinion being much more specific and his intension was to point out that a person may be taken to mean something different when he uses words for one purpose. For what he would be; he would be taken to mean if he was using them for another. The example this is the most important the example in the catnic case was the difference between what a person would reasonably be taken to mean by using the word vertical in a mathematical theorem and by using it in a claimed definition of a lintel for use in the building.

See the word vertical it has two different meaning one meaning actually as we understand it from the mathematical point of view from the mathematical premise. The other meaning what vertical means to a person who is from the building perspective and what it means from the perspective of a lintel. So, here the word vertical has been used for the purpose of the lintel not in the sense of mathematics and therefore, the lord house

of lord in catnic held that it need not the invention the infringing product the alleged infringing product did not contravene the patent right.

So, here this is actually a clear understanding, what is the purpose and for from the purpose you have to give meaning to the words. This very word vertical again I repeat this it has two meaning vertical it can be used in mathematical signs, it can also be use from the point of view of what you call lintel which is actually moving across the window.

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Indian position on Doctrine of Pith and Marrow

- The “pith and marrow” doctrine is known to the Indian Courts since *Lallubhai Chakubhai Jariwala v. Chimanlal Chunilal*, AIR1936 Bom. 99.

Raj Parkash vs Mangat Ram Chowdhry And Ors. AIR 1978 Delhi 1

Area of Invention: Film Strip Viewers

Invention: A Process For Printed Picture Films For Use In Film Strip Viewer And The Films Made thereby.

“It is the pith and marrow of the invention claimed that has to be looked into and not get bogged down or involved in the detailed specifications and claims made by the parties who claim to be patentee or alleged violaters”

The slide features a yellow background with a blue and orange header. At the bottom, there are logos of the Indian Patent Office and a small video inset showing two people in a presentation setting.

Now this doctrine of pith and marrow, we in fact our Indian courts as I have mentioned that being a common law of country. We follow normally what the developments which are taking place in England. Now from the early days of the patent law and patent infringement cases as early as in 1936 the Lallubhai Chakubhai Jariwala versus Chimanlal Chunilal case we have seen that the word pith and marrow was used in the Indian case laws.

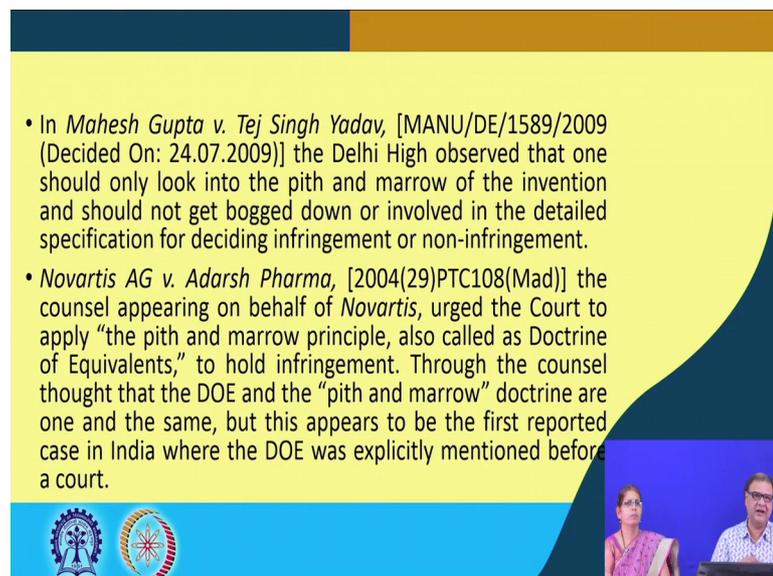
But the question whether purposive interpretation should be allowed or not there is no clear indication as such. But we can draw it from the different perspective we can draw it from the interpretation of different words which have been chosen by the Indian court. See here actually I think we should code the paragraph which is coming from the case law which is called Raj Prakash versus Mangat Ram Chowdhry that is AIR 1978 Delhi 1 and first let us try to understand the area of this invention.

So, in this case the invention is about film strip viewers. So, typically you are aware of the 35 mm you know the strip. The invention is about improvement where the looking at it simultaneously you can actually have the frames in 135 mm instead of having. So, you can have two or more you know in one particular frame and so this actually is a big improvement which can have a lot of relevance in terms of the market in this particular area.

So, the question of infringement came in from the point of view of actually using essentially the same type of process of making the film strip viewers. So, here is the case where the court looked into the essentiality principle from the point of view of the doctrine of pith and marrow which Professor Mathilal will explain further.

See here actually again I repeat that the pith and marrow means understanding the essential feature and in understanding the essential feature we also need to understand that what is the purpose for which the a particular word is used. So, here what the court says it is the pith and marrow of the invention claimed that has to be looked into and not get bogged down or involved in the detailed specification and claims made by the parties who claim to be patentee or alleged violators.

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- In *Mahesh Gupta v. Tej Singh Yadav*, [MANU/DE/1589/2009 (Decided On: 24.07.2009)] the Delhi High observed that one should only look into the pith and marrow of the invention and should not get bogged down or involved in the detailed specification for deciding infringement or non-infringement.
- *Novartis AG v. Adarsh Pharma*, [2004(29)PTC108(Mad)] the counsel appearing on behalf of *Novartis*, urged the Court to apply “the pith and marrow principle, also called as Doctrine of Equivalents,” to hold infringement. Through the counsel thought that the DOE and the “pith and marrow” doctrine are one and the same, but this appears to be the first reported case in India where the DOE was explicitly mentioned before a court.

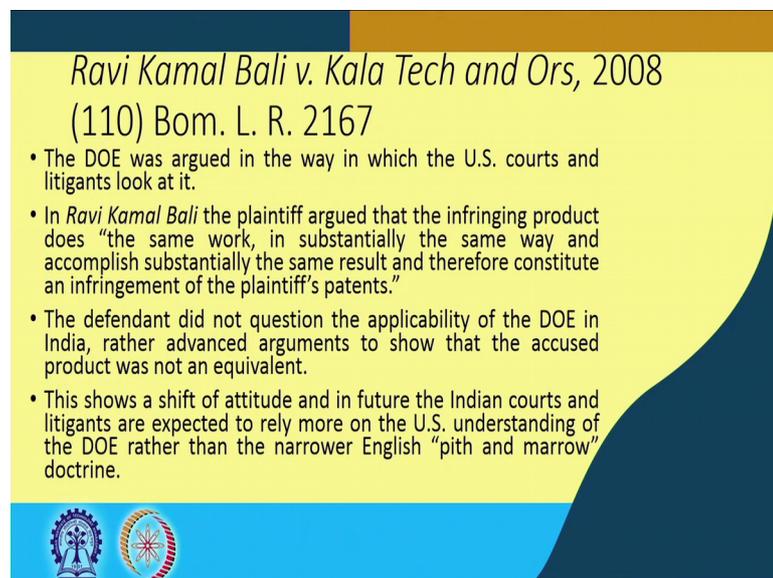
Now this ratio of Mangat Ram it has been courted in later cases also, we have in a case like say in Mahesh Gupta versus Tej Singh the Delhi high court referring to Mangat Ram and he the Delhi high court again courts the what you call pith and marrow doctrine. But

there is an interesting development when the case of Novartis a g versus Adarsh pharma was been argued, the council appearing on behalf of the Novartis actually he urged the court to apply pith and marrow principle.

And then while actually presenting his views before the court the law and council also said that pith and marrow also called doctrine of equivalents to hold infringement. Now here actually we need to understand that there are finer distinctions between these two doctrine. Pith and marrow is all about language, whereas the doctrine of equivalents we need it is not all about language, but we had to find out whether this equivalents is there or not.

And to be very precise the distinction is very clear when you will look into the protocol which interprets Article 69 of the European patent convention. Article 1 which talks about how it should be applied, how language should be interpreted that is what is called pith and marrow and Article 2 that the equivalents has to be determined this is what you call we in anyway say they call it doctrine of equivalents.

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Ravi Kamal Bali v. Kala Tech and Ors, 2008
(110) Bom. L. R. 2167

- The DOE was argued in the way in which the U.S. courts and litigants look at it.
- In *Ravi Kamal Bali* the plaintiff argued that the infringing product does “the same work, in substantially the same way and accomplish substantially the same result and therefore constitute an infringement of the plaintiff’s patents.”
- The defendant did not question the applicability of the DOE in India, rather advanced arguments to show that the accused product was not an equivalent.
- This shows a shift of attitude and in future the Indian courts and litigants are expected to rely more on the U.S. understanding of the DOE rather than the narrower English “pith and marrow” doctrine.

But here they now there were here now what is happening we find a tendency in Indian court to apply the US understanding of doctrine of equivalents instead of pith and marrow and this kind of attempt we have seen in the 2008 case of Ravi Kamal Bali versus Kala Tech.

So, here the technical details of the case are that it is basically about locks and seals and it is about the case where Kala tech and others are infringing from the point of view of making the locking mechanism in the similar way. So, you have the shape of the product which is substantially similar to the defendants. Now the question of the application of DOE comes in, because that is where we borrow that from the US understanding where the court for presumptive reasons has for persuasive reasons has taken up the aspect of DOE in this particular case.

The participants are referred to the case in which you can see a very nice stable beam put up, from the point of view of the plaintiffs invention and the defendants product. So, one to one match of each of those elements and where you can see the their replaced elements are the substantially similar. So, as Professor Matilal mentioned the doctrine of pith and marrow is different from the doctrine of equivalents, because equivalent where in doctrine of equivalents we are looking at an equivalent material which you replace in the patentees invention from the type of elements.

So, in the earlier part of the course you have actually gone through the aspects of DOE. So, this is for the first time that in this particular case the interpretation of the doctrine of equivalents came into picture in an Indian scenario.

So, now what happens here, actually here the counsel they arguing for the plaintiff it argues doctrine of equivalents in the sense in which it is been argued in USA. It says that it actually performs the same function in the same manner to obtain the same result and in the last class we have seen these are the three cardinal principles of doctrine of equivalents in USA.

So however, actually the defendant did not questioned that whether the doctrine of equivalents is applicably in Indian patent law scenario. But ultimately what is happened rather than advance argument to show the defendant showed basically advance argument to show that the accused product was not an equivalent.

So, is it actually now are we witnessing a paradigm shift in the Indian approach of the Indian judiciary and as well as in the in amongst the counsels who argue patent infringement case. But I do not think that this is happening so when it comes to the pith and marrow doctrine or the further advance doctrine of purposive construction, these are all rules of claim construction.

Where the doctrine of equivalents is something where we are looking at the equivalent materials. In the last class we have seen that whether manganese and magnesium can they be equivalent and that was the contention in the case of (Refer Time: 39:19), where the court for the first time in explicit terms let down the three tier test which just now I have mentioned. But what appears to us throughout this course is this that patent search is something which starts with the filing of patent at it is something which is which comes back again and again throughout the life time of the patent for 20 years.

So, I hope as participants you understood the relevance of patent search at different stages. It is also an important step during the litigation, because if this is where you are looking at what are the patents in the as a part of the dispute that is the heart of the dispute, then what are all the relevant patents that you can tie in litigation. So, many at time today it is about not say not a single patent you know it is not just about one patent into litigation, often it is a bunch of patents which are actually part of a litigation. For instance you have lot of cases of Roche versus Genentech then many other cases where you have patent portfolio as part of the litigation.

So that means, whole series of patents are heart of the dispute. So, the relevance of patent search can be realized from the point of view of the patent family members. So, so if you are looking at it in validating a particular patent, obviously you would like to strike of on the other related family members. So, here is a case where we are providing you in the reading material a particular patent which whose priority starts back into 2004.

So, the first provisional application was filed in the US in 2004 the currently there is a grant in 2017. So, you will be surprised to notice that there are almost up to hundred applications which are actually the earlier applications in the route. So, those all obviously become the patent family members, so that is one in relation to a specific jurisdiction.

Now incidentally the same patent is there in the EP it is also there in Mexico and many other countries. So, when you look at litigation as a strategy it is also important for you to look at search because, the question is you would not want to sue them in the US you may want to sue someone in Mexico and then indirectly bring in a case of invalidation into the US. So, this is where you see patent strategy inherently linked with patent search.

So, a good searcher would actually keep in mind the entire patent family into picture. So, today increasingly in litigation you see a lot of portfolio itself is actually the part of the entire infringement or the you know patent case itself.

So, this is where we are looking at the relevance of this course at different stages one is that the R and D, the other is at the stage where you are creating value for institutions of companies in terms of looking at you know where the patents are of worth. Then preparing strategy in terms of building the portfolio in this particular area and then also defending against competitors and also defending the portfolio and obviously also into litigation.

We look forward to meeting you in our live session and you have any question on any of the classes are or any of the presentations which you have made would be very happy to reply to your queries and you can ask us question even after the live session and send us email and we will be very happy to respond back.

So, happy patent searching to all of you.

Thank you.