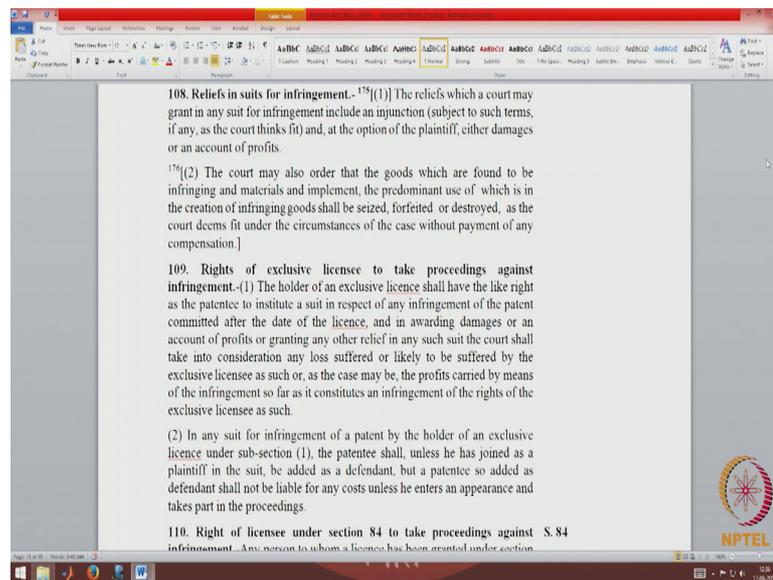


**Patent Law for Engineers and Scientists**  
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**Lecture – 71**  
**Patent Enforcement, International Arrangements & Other Miscellaneous Provisions**  
**Reliefs in Suit for Infringement**

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Now, what could be the reliefs a patentee claims in a suit for infringement, now let us look at the reliefs. Broadly the patentee can asked for two broad reliefs; one in any suit for infringement, the patentee seek and injunction and injection is subject to terms and conditions. In junction is the reliefs of stopping the other person from doing the activity, and injunction when you say you have an injunction against the person then the injunction would require that person to specific if it pertains to patents for him to stop from doing things. If he is manufacturing the patented article he has to stop from manufacturing at. I f he selling it he has to stop from selling it, if he is using it he has to stop from using it.

So, based on the language of section 48 and injunction would mean depending on the wording of the injection, would mean it would stop the person from doing that activity. So, the first one of the reliefs that a person can claim in an infringement suit is injunction stopping the different from doing the activity and in addition at the option of the plaintiff

by plaintiff we mean, the patentee the patent holder or the person who drives a title from the patent holder or at the option of the plaintiff. The plaintiff is the person who files the case the person who initiates the case the person who makes the complaint is called the plaintiff and he seeks a relief.

So, what are the reliefs you can seek he can ask the court to stop the person from doing the infringing activity, which is what we call injunction or at the option of the plaintiff he can either ask for damages or an account of profits. Now damages means compensation you can ask for compensation because his invention was used without his permission. So, you can ask for monetary compensation or account of profits. He can ask for the account of profits asks the person to keep give accounts of the profits he made and then determine by a further procedure as to what he is entitled to from that profit because many a times the profit fully may not be something which the patentee can claim.

So, broadly the reliefs are stopping the person from doing a particular act and claiming monetary compensation 2 states 182 talks about certain for the other reliefs. The court may also order that a good which are found to be infringing and material, and materials and implement the predominant use of which is in the creation of the instrument goods shall be seized forfeited or destroyed as the code deems fit under the circumstances of the case without payment of any compensation. Now this is the relief of see show forfeiture and destruction. So, not only there is the court can stop a person from doing things, if he has already manufacture a good amount of infringing material, the court can also orders see show, forfeiture and destruction.

So, this power is also given. So, in cases where an infringement infringer is involves in piracy or involves in creating duplicate copies of the patented pro product, then this option is open that not only can a patentee stop him from doing things, the patentee can also seize all the existing particles infringing articles and destroy them. Now 109 tells us about the right of an exclusive licensee, now the exclusive licensee in many ways acts like the patentee. Now if we need to understand what an exclusive licensee we can do we need to go back to section 2 the definition of exclusive licensee, in section 2 1 f exclusive licensee means a licence from a patentee, which confers on the licence or on the licence and the persons authorized by him. To the exclusion of all other persons including the patentee this is important when an exclusive licence is granted, the exclusive licensee can even exclude the patentee the act says that.

Including the patentee any right in respect of the patented invention and exclusive licensee shall be construed accordingly. So, the holder of an exclusive licensee can even exclude the patentee. Now the question arises if the holder of an exclusive licensee can exclude the patentee, who will take action if there is an infringement? This is the legitimate question that can arise because the exclusive licensee can even keep the patentee away from enforcing its right his right. So, the exclusion is complete in the sense that even the patentee who was granted the licence cannot do anything pertained into a patent. So, what happens if the patent is given on an exclusive licensee and there is infringement? Going by the definition the patentees cannot take action unless the parties of agreed to the contrary, going by the definition the patentee cannot take action.

So, the law should empower an exclusive licensee to take action of in on infringement that you find in 109. See normally we understand the rights of a patentee under section 48 as including the rights of a person whose holder of the patent. Now 109 allows the exclusive licensee to act like a patentee, 109 1 the holder of an exclusive licensee shall have the like right as a patentee to institute a suit in respect of any infringement of a patent after the date of the licence, and in avoiding damages or an account of profit or granting any other relief in any such suit the co course I will take into consideration the lost suffered or likely to be suffered by the exclusive licensee as such or as the case may be the profits carried by means of infringements. So, for it will constitution and infringement of rights of the exclusive licensee as such.

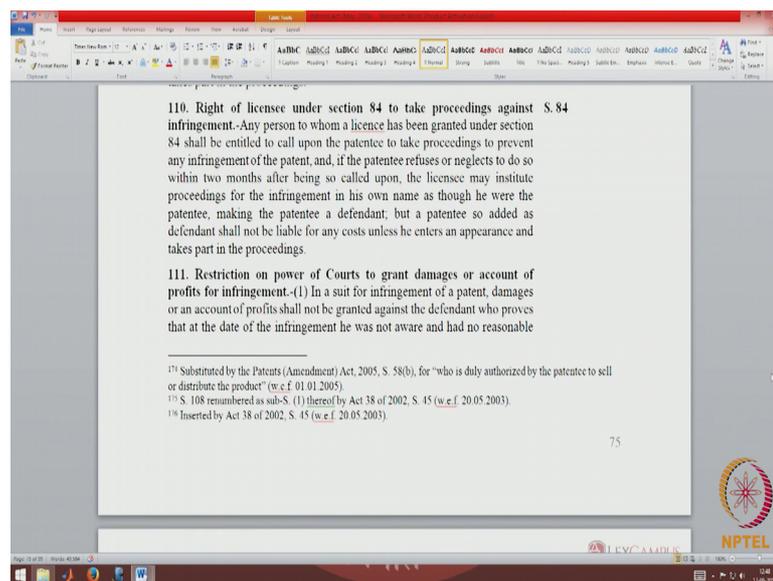
So, the exclusive licensee here is empowered to take an action of infringement and also seek damages or account of profit and in granting damages the court shall consider the loss suffered by the exclusive licensee. So, if the licence exclusive licensee it took a particular licence, and pursuant to that there was infringement and he suffered a loss then they can claim infringement. Apart from stopping the person from infringing they can also claim the reliefs to come back to them. Now 109 2 states that in any suit for infringement of a patent by a holder of an exclusive licensee under subsection 1, the patentee shall unless he as joined as a plaintiff in the suit be added as a defendant in, but a patentee so, added as a defendant shall not be liable for any cause unless he enters and appearance and takes part in the proceedings.

Now, we saw that an exclusive licensee can operate without the patentee that is the definition. We also I have seen that an exclusive licensee can file a suit on its own. Now

this provision says that the patentee shall be added as a defendant. So, if there is some information with regard to the patent which only the patentee can give for that purpose he can be added as a defendant, but they cannot be any claim now the patentee can be added as independent if he is not already shown as a plaintiff. Sometimes the exclusive licensee and the patentee we will file a joint suit they will be shown as joint plaintiffs. Plaintiff number one will be the exclusive licensee or the patentee and the other person we will be shown as plaintiff number 2. So, they can jointly I will a case if they have not jointly if I will the case, the exclusive licensee we can add the patentee has a defendant and the patentee we will not be liable for any costs in case the patent is invalidated or the patentee and the licensee lose the case.

They will the patentee cannot be charged to pay any cost unless he enters appearance and takes part in the procedure. So, we call this a pro forma party; pro forma is if party is being made and entity is shown as a party in a proceeding just for the sake of formality for the sake of completion of procedure. But if the party enters and takes part in the proceeding then the party seems to be a pro forma party, the party becomes an actual party then they can be release ordered like costs if the party is not successful than the other party can is entitled to cost from this party; Section 110 right of licensee under section 84 to take proceedings against infringement.

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Now, we have seen that the licensee could be a compulsory licensee. A person who has taken a licence under section 84. a compulsory licensee is also empowered with some rights to institute a suit for infringement.

Now, in 109 we saw that an exclusive licensee and exclusive licensee fill in all cases be a person who has voluntarily taken a licence, but 110 talks about a compulsory licensee a person who holds a compulsory licence under 84, also has the right to initiate infringement proceedings. Any person to whom a licence has been granted under section 84 shall be entitled to call upon the patentee to take proceedings to prevent any infringement of a patent, and if the patentee refuses or neglects to do so, within 2 months, after being so called upon, the licensee may initiate institute proceedings for infringement in his own name as though he were the patentee, making the patentee a defendant, but the patentee. So, added by the defendant shall not be liable for any cost unless he enters appearance and takes part in the proceeding.

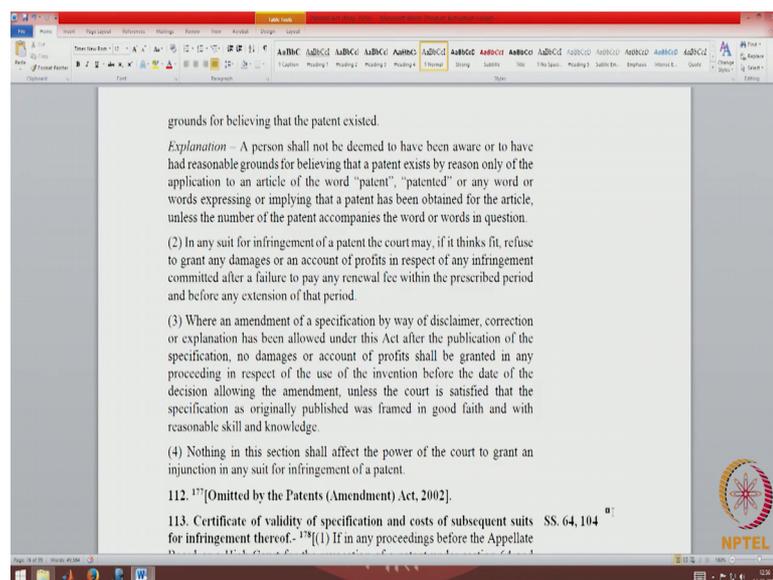
Now, in this case the procedures slightly different, in the case of an exclusive licensee he could show the patentee as a joint plaintiff he could show as a co plaintiff. Now that option is not here and the exclusive licensee since he can operate to the exclusion of the patentee, he could file the patent infringement suit without seeking anybody's permission or without informing anyone. Here that is not the case because the compulsory licensee has a limited licence, and that is given by the patent office. So, if he detects infringement the compulsory licensee should inform the patentee and ask him to take action against the infringement, and if the patentee does not do anything for 2 months then he can file a case by in his own name and even then he can show the patentee only as a defendant. If somebody asks the question though in the following cases the patentee shall help can be shown as a plaintiff. A and exclusives and licensee files a case for infringement and shows the patentee as the plaintiff, B and compulsory licensing files a case for infringement and shows the patentee as the plaintiff and two other choices, and if you were to pick up the true statement the statements will be what comes under section 109, because in 110 the compulsory licensee cannot show the patentee as a plaintiff.

So, that is difference between these two provisions, the other part of the provision remains the same the patentee who is added as the party if he does not appear he is not liable for costs. Now 111 talks about damages; now we are already seen the two kinds of broadly two reliefs that a person can have in an infringement suit pertains to stopping

the person from doing things that is relief on the conduct of the defendant, the other reliefs is a monetary relief asking the defendant to pay compensation. Now there are restrictions on the powers of the court to grant damages or account of profit in infringement.

Now 111 talks about the restrictions for claiming monetary relief 1, in any suit for infringement of a patent damages or account of provision shall not be granted against the defendant who proves that at the date of infringement, he was not aware or had no reasonable ground for believing that the patent existed. Now this is called the defense of innocent infringement. The defendant did not know that the patent existed and one of the conditions required here is the movement he came to know he stopped the infringing activity, to demonstrate is good will.

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Explanation a person shall not be deemed to have been aware or to have at reasonable grounds for believing that a pattern, that a patent exist by reason only of the application to the article of the word patent patented or any word or words expressing or implying that a person has been obtained for the article, unless the number of the patent accompanies the word or words and crystal.

So, this is something which patentees have to take care in practice, it is not just sufficient that they say patented or patented article, they also have to give the number of their patent. It is normally I and followed by another long string of numbers. So, it is

necessary to show that the patent is identified by number, rather than just saying patent or patented. So, if the patent is identified by number that serves as notice mere use of the word patent or patented in itself will not amount to notice. Subsection 2, in any suit for infringement of a patent the court may in things fit refuse to grant any damages or account of profit in respect of any infringement committed, after a failure to pay any renewal fee within the prescribed period or before the extension of that period.

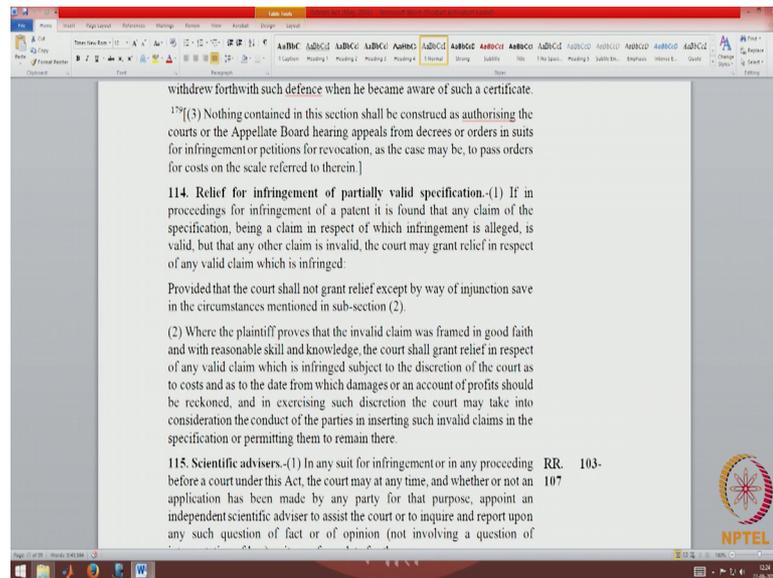
Now, we are already seen that the patent can only be enforced, during the time when the renewal fee is being paid. So, if the renewal fee is not paid and the patent is in the lapsed condition that it is deemed to have ceased to have effect. Now during that time when the renewal fee is not paid a patentee cannot claim damages or account of profit. 3 where any amendment to the specification by way of disclaimer correction or explanation has been allowed under this act after the publication of the specification, no damages or account of profits shall be granted in any proceeding in respect of use of the invention before the date of the decision allowing the amendment, unless the court is satisfied that the specification as originally published was framed in good faith, and with reasonable skill and knowledge.

Now, if there is a patent and the patent gets amended, then there cannot be damages just acts that happened for use of the invention before the date of the amendment. So, because patent rights have to be specific and they have to be clear. So, if you file a case for infringement, and later on if you amend the claim then the amended claim we will not change the scope of the protection. So, if the scope of the protection changes, then you cannot go back and stop a person who had committed an infringing act, if the use of the invention before the date of the amendment, did not fall within the scope of the amendment. Now there are cases where the court if it is satisfied that the specification as originally published was framed in good faith, then the court may accommodate, but normally a patent cannot be enforced after an amendment, for an act that was done pertaining to an invention as it was covered before the amendment.

So, if you change the claim you can only stop people after the claim is established all the acts that happen before the claim was amended, you cannot claim damages over it. 4 nothing in the section shall effect the power of the court to grant an injunction in any suit for infringement of a patent, which simply means that the relief of injunction is not tied to the relief of damages. So, this is it just provision makes it very clear that the

ability of a person to stop a person from doing things, is not tied to the person's success in getting damages. So, even if he had not mentioned the patent number on his invention that will not jeopardize his ability to seek damages, but that will not affect a person's ability to get an injunction.

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Now 114 deals with the relief for infringement for partially valid specification; now, what happens when patent is challenged, and some claims of the patent are revoked and the remaining are held to be a valid and infringement. So, how does the court mould the reliefs because if they way 10 claims and 5 claims are let us assume all of them are independent claims, 5 claims are held to be invalid or a combination of 5 claims are held to be invalid, and the remaining 5 have been held to be valid and infringing. Now how does the court mould its relief? 141 states that if the proceedings for infringement of a patent it is found that any claim of a specification, being a claim in respect of which infringement is alleged is valid, but any other claim is invalid the court may grant relief and respect of any valid claim which is infringe.

Now, this brings out of fundamental principle in patent law, that only a valid claim can be infringed. An invalid claim cannot be infringed, they cannot they can be no infringement of an claimed that is invalid. So, this also tells us what is the first thing that in a patent infringement so, that the courts will look into. The courts will look into the issue of validity first because if the claim is found to be invalid and there is no need to

determine the issue of infringement we get that principle from 114. The court may grant relief in respect of any valid claim. In other words the court is not bound to grant any relief in respect of a claim that is invalid. Further if you take the logic further the court is not required to look at infringement when it finds that the claim is invalid.

So, validity of the claim should be the first thing that the court should look into and 114 1 gives the principle though in the context of partially a valid claims, it gives the principle that the court's obligation to grant a relief is only confined to claims that are valid. Provided that the court shall not grant relief except by way of injunction saves in the circumstances mentioned in subsection 2. So, in such cases the court shall not grant relief except by way of injunctions.

So, in such cases where some claims are valid and the other claims are not valid, the court can grant a relief of infringement and the details are given in 114 2. Which states where with the plaintiff prove that the invalid claim was framed in good faith, and with reasonable skill and knowledge, the court shall grant relief in respect of any valid claim which is infringed subject to the discretion of the court as to costs and as to the date from which damages or any account of profit should be reckoned, and in exercising such discretion the court may take into consideration the conduct of the parties in inserting such invalid claims, in the specification or permitting them to remain there.

Now, if the claims comprise of a mixture of valid and invalid claims, if the plaintiff is able to prove infringement by the plaintiff we refer to the patentee. That the invalid claims were framed in good faith and with reasonable skill and knowledge; which means due diligence and caution was exercised in framing those claims, the court shall grant relief in respect of the valid claim which is infringed, and we will have the discretion on costs and damages and an account of or account of profits, the court shall exercise is a discretion on cause and damages or account on profit, as to the date on which the damages or account of profit will accrue.

So, that is left to the discretion of the court. Should the court award cause that is left to the discretion and of the court, and the date on which the damages accrue because if you find that there is a claim that is valid and there is also a claim that is invalid, then the court will look into the date from which the party is entitled to damages. And in exercising such discretion the court may take into consideration the conduct of the

parties and inserting such invalid claims and permitting them to remain that. So, the court we will also look at the conduct of the patentee, how the invalid claims came into being in the first place and whether the patentee knew the claims to be invalid and let it remain there or that the patentee exercise any due caution in amending them or in even removing them.

So, the conduct of the patentee will be considered before any relief pertaining to costs or damages of profits, which is largely what I had earlier mention as the monetary relief. So, injunction is the reliefs that stops a person from doing things and damages caused an account of profits are compensation, which can be granted by way of monetary compensation, that can be granted or computed or the quantum can be determined with money.