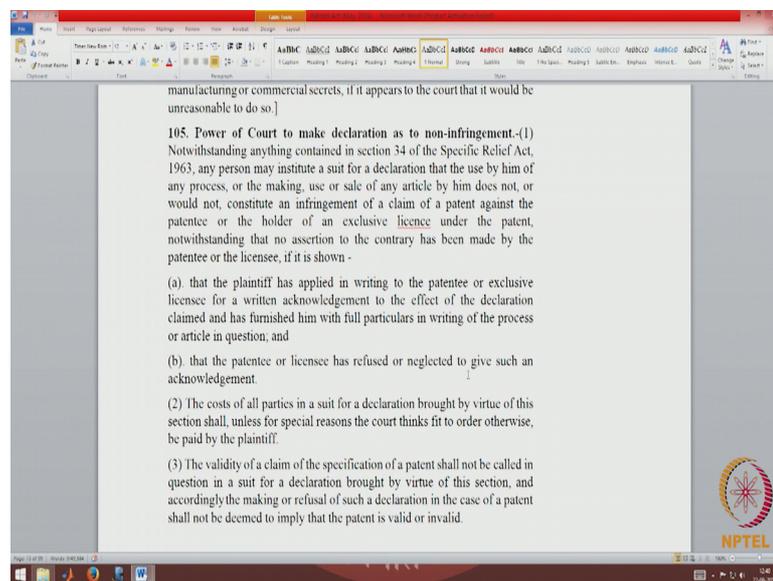


Patent Law for Engineers and Scientists
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Lecture – 72
Patent Enforcement, International Arrangements & Other Miscellaneous Provisions
Declaration as to Non-Infringement

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We had mentioned that there are 2 types of declaratory suits that can be filed under the patents act and this was in the context of 104 where 104 refers to 3 types of proceedings; one suit for declaration under 105 or a suit for declaration under 106 or an infringement suit cannot be filed in a code that is inferior to a district code we saw that in 104 and we have already seen infringement cases what can be done in infringement cases what are the different reliefs defenses damages; how damages can be; damages can be computed certificate of validity scientific advisors and a whole lot of things that usually come up in a infringement suit.

Now, in a declaratory suit the relief a person claims is different from that of an infringement suit, we are already seen in a infringement suit the patentee would ask for broadly 2 reliefs; one is a relief to stop the infringing activity; what we call infringement or compensation by way of money what could be referred to as damages our account of

profit these are the 2 broad reliefs. Now the infringement suit is filed by the patentee to enforce patent law provides for certain declaratory reliefs or declaratory suits where a person who apprehension and infringement action which means the person who could be the potential defendant or the potential infringer in an infringement suit to proactively approach the court and get some reliefs from the court.

So, we call them preventive provisions of the patents act; the patents act promotes competition at the same time the patents act also grants a monopoly to the patentee in such a way that the patentee can exercise his rights, but there could be instances where in the process of enforcing his rights the patentee could lead to certain abuses those abuses could pertain to abuse of use of a patent or it could also be abuses pertaining to competition laws. So, 105 talks about a preventive action potential infringer can take even before the infringement suit is filed against him. Now what is that relief in 105 the potential infringer can approach the court and make a declaration or seek a declaration that the process that he is using does not constitute infringement.

So, it is a declaration of non infringement. So, we are already mentioned the defendant in an infringement suit can claim the defense of non infringement. So, the defense of non infringement is just defense person alleges infringement and you state that I am not infringing; what I am doing is different or the patents scope of the patent does not cover the activity. I am doing maybe a product that I am manufacturing or a process I am using the scope of the patent or the boundaries of the patent does not cover my activity this is the defense of non infringement a declaration of non infringement is where you ask the court to give grant your relief in a defense you are not actually asking for relief you are only asking the court not to grant the relief of infringement there is an instrument that is alleged you just state that as a defense you say that what you are doing is not infringement you do not ask the court to give or to declare that your process is non infringing you do not do that you just defend yourselves by saying that your process is different.

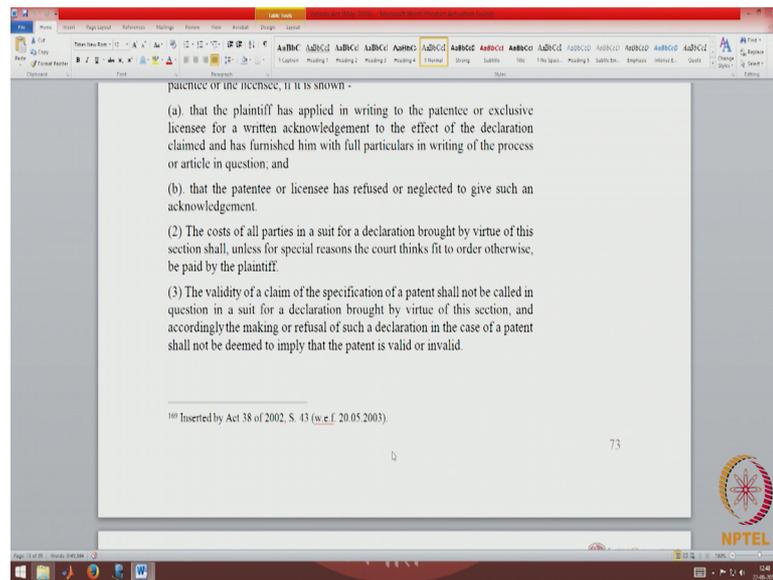
But in 105, you are entitled to get a declaration by saying requiring that the process used by the person or the making use or sale of any article by him does not constitute infringement of a claim of a patent against the patentee. Now to do this the patentee should be first approached by the defendant by way of a writing and you can see in section 105 1, there are 2 requirements a and b the plaintiff which is the potential infringer the

plaintiff has applied in writing to the patentee or exclusive licensee for a return acknowledgement to the effect that the declaration claimed and as furnished as to him with full particulars in writing of the process or article in question.

So, before approaching the court it is a pre requirement that the potential infringer had returned to the patentee saying that I am adopting a process or I am manufacturing an article and this process or this article does not infringe your patented process or article. So, and he should approach the patentee asking for an acknowledgement in writing. So, the potential infringer rights to the patentee and for a written declaration. So, if the patentee gives the written declaration then they will not be any infringement suit based on the action of the potential infringer. So, it is one way to avoid litigation. So, he writes to the patentee and b the patentee or licensee has refused to or neglected to give such an acknowledgement. So, that is the reason why the potential infringer approaches the court he had ask for an acknowledgement stating disclosing what he is doing and asking the patentee to give a declaration that what is doing is different it is not covered by the patent and hence it is non infringing.

The patentee or the exclusive licensee refuses to give such a declaration once there is a refusal then the potential infringer you can approach the court within declaratory suit under 105. Now there is also a provision under section 34 of the specific relief act where you could generally get reliefs on declaration, if there is dispute with regard to a pertains marital status you could there are instances way section 34 has been employed or any dispute with regard to a person's right or a title it is a very broadly worded provision. So, this provision is not withstanding anything contained in section 34. So, this operates on a separate level. So, whatever is contained in section 34 without independent of that; this provision will cover instances where you need to get a declaration pertaining to a patent 105 2 states that the costs will be borne by the plaintiff.

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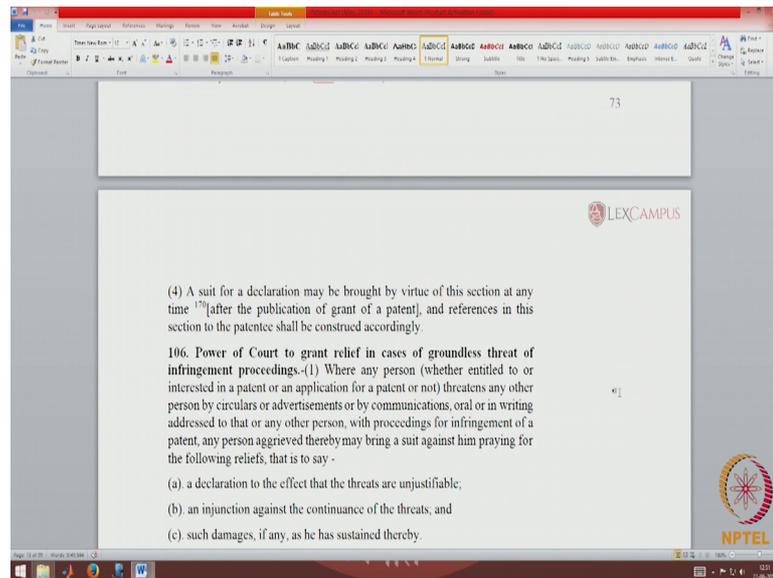
Unless there is a reason to decide or to adjudicate otherwise and in this proceeding importantly the validity of a claim of a specification shall not be called into question for a declared brought by virtue of the section and accordingly making or refusal of such a declaration, we will not have any bearing on the patents validity it shall not be deemed to imply that the patent is valid or invalid.

What this means when you are seeking a declaration on non infringement you are not touching upon the validity of the patent, rather you are going to interpret the claim of the patent and see whether the disclosed process or article falls within the scope of the claim that is the entire preceding a simple because the task of the court is to interpret the claim as claimed in the patent and to see whether the article that is been disclosed or the process that is being disclosed by the potential infringer falls within the scope of what is been claimed if it does not all within the scope the court will grant a declaration that this process is known infringing and in plaintiff in this case which is a potential infringer or a defendant in an or a potential defendant and in infringement suit cannot raises issues of validity because the object of this preceding is not to look into the validity of a patent it is rather to look into the claim made by the potential infringer as to his processor product being different from what is patented.

So, the analysis here is to look at the patented process or product which is the claim and see whether what the potential infringer has disclosed in the suit will fall within the

scope of that it is largely an affair of interpreting the claims of the patent and understanding the scope of what is been disclosed by the potential infringer and doing a mapping it does not you cannot raise issues of validity questions or grounds under section 64 cannot be raised in these proceedings.

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Now this suit can be brought after the publication of the grant. So, this is a suppose grant proceeding in the sense that you cannot claim by declaration of non infringement of a patent that has not been granted. So, this is the first type of declaratory suit where a person who apprehends an infringement action against him because that is a only reason why you need to get an a declaration of non infringement. So, that is why has been using the world a potential infringer a potential infringer can go to the court and get the entire way cleared by saying or by getting a declaration from the court that what he is doing is different from what is patented. So, that he can preempt injunctions that can come along with an infringement suit if there is a chance that the patentee could enforce the part patent against the potential infringer.