

INFRINGEMENT OF IPRs: LAW PROVISIONS

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ABSTRACT

The word infringement is derived from the word infringe. As per the Oxford Law Dictionary, 'infringement' means 'to break a law or an agreement'. It also means 'to intrude on a right or privilege'. Thus, if a person does any act or commits any wrong with respect to the intellectual property of the owner of such property without his consent, it constitutes infringement.

Since the author/owner of the intellectual property has put his skill, labor and intellect in creating or inventing the work, he is entitled to certain benefits thereto, which are exclusive commercial benefits available to him.

However, the right granted under IP laws to the author/ inventor/owner is for a specified period, after which the work will fall under public domain.

Thus in light of the above, the researcher through the research paper analyses the following:

- 1. The acts which constitute Infringement under various IP laws;*
- 2. The Principles for determining infringement for various IPs;*
- 3. The persons who can sue and be sued for infringement;*
- 4. Statutory defenses against infringement or Acts which do not constitute infringement; and*
- 5. The remedies available against infringement of IPs.*

Introduction

Infringement is derived from the word "infringe". As per the Oxford Law Dictionary, infringe means 'to break a law or an agreement' or 'to intrude on a right or privilege'. Thus, if a person does any act or commits any wrong with respect to the intellectual property of the owner of such property without his consent, it constitutes infringement.

Copyright

Sec. 51 of the Copyright Act, 1957 defines infringement and states the acts by which a copyright shall be deemed to be infringed.

Since the author/owner of the copyright has put in skill and labor in creating the work, he is entitled to certain benefits thereto, such as to make copies, reproduce, to make publication, adaptation, translation of work, etc. These are exclusive commercial benefits available to the owner/author of the copyright and any person, other than the owner, who carries out any of the

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above acts without the lawful consent of the owner would amount to having committed infringement of copyright.

However, the right granted under the copyright to author is for a specified period. Once that period has expired, the work will fall under public domain. Thus, to ascertain whether an act constitutes infringement or not it would depend on whether the copyright in the work is subsisting or not.

Copyright in a work shall be deemed to be infringed:

- (a) When any person, without a license granted by the owner of the copyright or the Registrar of Copyrights under this Act or in contravention of the conditions of a license so granted or of any condition imposed by a competent authority under this Act-
 - (i) Does anything, the exclusive right to do which is by this Act conferred upon the owner of the copyright, or
 - (ii) Permits for profit any place to be used for the communication of the work to the public where such communication constitutes an infringement of the copyright in the work, unless he was not aware and had no reasonable ground for believing that such communication to the public would be an infringement of copyright; or
- (b) When any person-
 - (i) Makes for sale or hire, or sells or lets for hire, or by way of trade displays or offers for sale or hire, or
 - (ii) Distributes either for the purpose of trade or to such an extent as to affect prejudicially the owner of the copyright, or
 - (iii) By way of trade exhibits in public, or
 - (iv) Imports into India, any infringing copies of the work.

However, infringement shall not apply to the import of one copy of any work for the private and domestic use of the importer.

Also for the purposes of Sec. 51, if a literary, dramatic, musical or artistic work of another is copied and reproduced in the form of a cinematograph film, such film shall be deemed to be an infringing copy of such work.

To determine whether an act constitutes an infringement or not is the Lay Observer Test, laid down in *Associated Electronic v/s Sharp Tools*.² In this case, the Court specified that one of the surest test to determine whether or not there has been a violation of copyright is to see if the reader, spectator or the viewer, after having read or seen both the works would be of the clear opinion that there is a unmistakable impression of the second work being copied from the first. In other words, the Court must examine the visual appearance of the object, drawing or artistic work which is called 'the Lay Observer Test'.

² AIR 1991 Karn. 406

The following are the basic principles for determining infringement of copyright:

- (1) Whether the defendant has put sufficient skill and labor in making his work? And
- (2) To what extent have the original author's work been reproduced?

In *Ladbroke (Football) Ltd. v/s William Hill*, Lord Reid was of the opinion that "a more correct approach is to first determine whether the Plaintiff's work as a whole is 'original' and protected by copyright, and then to inquire whether the part taken by the defendant is substantial."

Infringement can be determined by the following:

- (i) Direct Copying: It means reproducing a part or portion of the author's work in the infringers work.
- (ii) Indirect Copying: It is the most common form of infringement. For instance, when a novel is converted into a play without the author's consent, it would amount to indirect infringement.
- (iii) Substantial Copying: It means copying a major part of the work of another. However, what constitutes substantial copying would depend on the facts of each case.

Thus, if a person does any act or commits any wrong with respect to the intellectual property of author/owner of such property without his consent, it constitutes infringement. However, in order to protect people with creative mind and for interest of public at large, the Copyright Act provides for certain exceptions/defences which can be used for action against infringement.

Section 52(1) is an exhaustive section which lists the acts which do not constitute infringement. It applies to the doing of any act in relation to the translation of a literary, dramatic or musical work or the adaptation of a literary, dramatic, musical or artistic work as they apply in relation to the work itself.

Section 52(1) (a) and (b) set out the acts which are considered as a fair dealing of a copyrighted work. Fair dealing or fair use means the use of a copyright of another by any person for specific purpose such as research, private use, etc. The doctrine of fair dealing is the exception to a basic rule which states that thre copyrighted work cannot be used without the permission of the owner. The following factors determine fair use:

- (i) The nature, extent and quantum of use of the copyrighted work,
- (ii) The purpose of such use, including whether such use is for commercial or non-commercial nature,
- (iii) The likelihood of competition between the two works,

- (iv) The effect of use upon the potential market value of the copyrighted work.

Remedies against Infringement of Copyright:

The Copyright Act, 1957 gives protection not only to the Copyright but also provides certain remedies against infringement of such copyright. There are 3 kinds of remedies available to the owner of copyright:

- (i) Civil Remedies

Section 55 under Chapter XII of the Copyright Act provides the Civil Remedies available to the owner:

- (a) Injunction
 - (b) Damages
 - (c) Accounts of Profit
 - (d) Damages for Conversion
- (ii) Criminal Remedies

Chapter XIII (Secs. 63-70) consists of the offences and the penalties relating thereto.

If any person who knowingly infringes or abets the infringement of-

- (a) The copyright in a work, or
- (b) Any other right conferred by this Act, except the right to resale original copies under Sec. 53A

Shall be punishable with imprisonment for a term which shall not be less than 6 months but which may extend to 3 years and with fine which shall not be less than 50,000 rupees but which may extend to 2 lakh rupees.

- (iii) Administrative Remedies

They are available under the Copyright Act with authorities i.e. the Registrar of Copyright, the Copyright Board and Copyright Societies. These authorities have certain powers relating to copyright and the owner can approach them in case of infringement.

Trademark

Sec. 29 explicitly deals with infringement of Registered Trademarks. A registered trademark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which is identical with, or deceptively similar to, the trade mark in relation to goods or services in respect of which the trade mark is registered

and in such manner as to render the use of the mark likely to be taken as being used as a trade mark.

The following are the essentials of infringement:

1. Infringement shall be in respect of registered goods or services
2. The mark must be used in the course of a trade
3. Adopting of a part of a mark and making alteration to the original mark so as to cause confusion would also amount to infringement
4. Infringement can be even by spoken words
5. Infringement may occur due to visual representation

Who can sue for infringement?

The following persons can institute a suit for infringement:

1. The Registered proprietor or his legal successor
2. Legal heirs of the registered proprietor of the trade mark
3. The Registered User
4. The applicant for registration of trade mark
5. Any one of the joint proprietors of trade mark

Who can be sued for infringement?

The following persons can be sued for infringement:

1. The person who infringes the trade mark
2. The person who threatens to use the trademark
3. The agents of the infringer
4. In case of a company, directors or promoters cannot be sued unless they are personally liable
5. In a master-servant relationship, the master who orders the servant to make infringing copies is liable to be sued.

Patents

Infringement means a violation of any rights conferred on the patentee subject to other conditions and limitations in the Act.

The patentee has certain rights over the patented invention. When these rights are violated or if any third party uses such rights over a patent without the permission of the patentee, it constitutes infringement.

Infringement can occur in the following ways:

1. Copying the entire patented invention with minor modification/Colorable Variation
2. Using the essential ingredient of the process of the patented invention
3. Merely using a substitute in the invention/Mechanical Equivalent
4. Adopting essential features of an invention

As per the doctrine of Pith and Marrow, if the 'pith and marrow' i.e. the 'true nature and character' or 'essence' of the product or process has been adopted by the infringer, the same would constitute infringement. The courts observe the doctrine of pith and marrow while determining the question of infringement. By applying this doctrine, the courts need not go into the details of absolute similarity between the two patents but has to see if the pith and marrow of the invention has been adopted by the infringer and if so, infringement exists.

Designs

Piracy of a design means infringement in copyright in case of design.

In *Micolube India v/s Rakesh Kumar*, it was held that passing off action is not available in respect of registered design. Parties are therefore relegated to the remedy under the Designs Act to seek cancellation of registration and other remedies under the Act.

In a design infringement case, the Court has to consider whether the alleged design is copied so as to produce an article exactly or substantially similar to the design or it is any fraudulent or obvious imitation thereof.

In *Peter Castell v/s Pipken*, it was held that in an infringement suit it must be found at the outset that, judged solely the eye, there is an inescapable similarity in the two designs.

Defences set by Defendant:

1. Cancellation
2. Expiry
3. Unreasonable Delay
4. No right to sue
5. Not new or original
6. Previously registered
7. Prior publication
8. Conduct of plaintiff

