

IP Enforcement and Implications for A2M

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What is IP Enforcement?

- The process of ensuring compliance with the IP rights in case actual or potential infringement

Nature of Enforcement

- IP rights is considered as personal rights
- In other words infringement is considered as a civil offence and not a criminal offence
- The method of enforcement is generally through civil procedure
- Exception: Piracy and counterfeiting

Types of Ip Enforcement /Remedies against IP Infringement

- Judicial Enforcement
 - Injunctions
 - Damages
- Administrative Enforcement
 - Border measures

Border Measures

- The customs authorities are to prevent the importation of the IP infringed goods to a country.
- Majority of countries apply boarder measures only to pirated/counterfeited goods in commercial scale

Judicial Enforcement : Injunction

- A remedy to prevent a person to stop an ongoing infringement of IP or a potential infringement
- Conditions for granting injunction: Prima Facie case, irreparable damage and balance of convenience
- Types of injunctions
 - Ex parte
 - Preliminary
 - Final injunction

Judicial Enforcement: Damages

- It is a compensation paid by the infringer to the IP owner for the infringement of IP
- Punitive damage : To deter future infringement

Remedy for Patent Infringement

- An injunction can compromise the availability of affordable medicines and the enjoyment of right to health
 - BMS v Natco
- An injunction can affect the use of TRIPS flexibility
- Court may not grant injunctive remedies
 - E-Bay Case
 - Cipla V Roche

TRIPS Enforcement Provisions

- Preamble
- Desiring to reduce distortions and impediments to international trade, and taking into account the need to promote effective and adequate protection of intellectual property rights, and to ensure that measures and procedures to enforce intellectual property rights do not themselves become barriers to legitimate trade;

TRIPS Flexibilities on IP Enforcement

- No obligation to set up special courts (Art.41.5)
- No obligation to provide criminal remedies for patent enforcement (Art.61)
- No border measures for patents (Art. 51)
- De Minimis Imports are exempted from border measures (Medicines infringing trade marks) (Art.60)
- No Obligation on ex officio action (Art.58)
- No enforcement for exports (Art.51)
- No mandatory injunction for government use (Art. 44)
- No obligation for punitive damages (Art.45)
- No obligation for mandatory provisional remedies (Interim injunctions) (Art.50)

Definition of Counterfeit

- "counterfeit trademark goods" shall mean any goods, including packaging, bearing without authorization a trademark which is identical to the trademark validly registered in respect of such goods, or which cannot be distinguished in its essential aspects from such a trademark, and which thereby infringes the rights of the owner of the trademark in question under the law of the country of importation"

Implications for A2M

- Generic production can continue even after the finding on infringement
- No need to grant interim injunction
- Injunctions can be denied for government use
- Personal use are exempted
- De minimis imports can be carried out (Buyers club)
- Generic can be imported