

BOOK REVIEW

INTELLECTUAL PROPERTY RIGHTS: INFRINGEMENT AND REMEDIES, ANANTH PADMANABHAN, LEXIS NEXIS- BUTTERWORTHS. 1092 PAGES. PRICE RS. 1195.

At the heart of intellectual property ('IP') law are the 'hard' questions on infringement and remedies. Complex legal matters concerning IP validity (exclusion of subject-matter, qualification requirements), determination of scope of rights, availability of defences etc. are more likely to be determined when IP infringement suits seeking statutory and equitable remedies are initiated by market players.¹ Today, Indian courts have to grapple with these issues on an ever-increasing scale. A focused legal commentary on the nuances of IP law has been much awaited.

Ananth Padmanabhan's book on *Intellectual Property Rights: Infringement and Remedies* couldn't have come at a better time.² It is a definitive legal commentary on Indian IP law with an overall focus on IP remedies, nevertheless, uncovering a variety of distinct IP topics. With the domestic implementation of WTO-TRIPS³ agreement's common minimum standards governing IP enforcement in the post-TRIPs scenario,⁴ the book's focus on IP infringement and remedies make it all the more relevant in the Indian context. While there is rich literature on global IP procurement, being a thoroughly focused work on the IP enforcement scenario in India singles out this book as a must-read for every IP enthusiast. Not surprisingly, the book has received an endorsement from Justice J. Chelameswar of the Supreme Court by way of a brief foreword to the book.

To combine five different chapters on patents, copyrights, trademarks, industrial designs and on the law of common law relief, with an exclusive focus on infringement and remedies, is a marvel of comprehension. Additionally, an introductory chapter on the nature and scope of injunctive

¹ A pragmatic assessment of the functioning of IP as a 'property' system relies on market-based litigation to determine IP validity challenges. IP granted through administrative processes are more likely to be challenged at every stage by competitors for conclusive validity. In other words, IP validity is sustained by what competitors view as important by making a cost-benefit analysis in terms of litigating IP validity. In fact, for the same reason, some commentators are of the view that mutual settlements between competitors or litigation (as a last resort) are more efficient than to create a second tier review to avoid grant of questionable patents. See S.Scott Kieff, *The Case for Preferring Patent-Validity Litigation over Second-Window Review and Gold-Plated Patents: When One Size doesn't Fit All, How Could Two do the Trick?*, available at <https://www.law.upenn.edu/live/files/80-kieff157upalrev19372009pdf> (Last visited on August 8, 2013).

² ANANTH PADMANABHAN, *INTELLECTUAL PROPERTY RIGHTS: INFRINGEMENT AND REMEDIES* (2012).

³ Agreement on Trade-Related Aspects of Intellectual Property Rights, 33 ILM 1197 (1994).

⁴ For an elaborate discussion on international standards of IP enforcement, see, e.g., XUAN LI AND CARLOS CORREA, *INTELLECTUAL PROPERTY ENFORCEMENT: INTERNATIONAL PERSPECTIVES* (2009).

relief is a must read for those seeking to understand the foundational principles of injunctive procedures to obtain legal relief.⁵ Notwithstanding that the key objective of the book was to clearly examine and identify legal standards pertaining to IP infringement and remedies, the author has done a good job of elucidating issues concerning IP validity from the perspective of subject-matter and threshold qualification requirements, and on issues bearing IP acquisition, statutory and equitable defences and other relevant issues on which Indian courts have pronounced in a variety of different cases. Interestingly, Padmanabhan candidly admits in his preface that although he initially tried to limit the book to IP injunctions, he was forced to accept that this work was “fundamentally a book on intellectual property rights” with its focus on IP infringement and remedies.⁶ It is obvious that Padmanabhan should have encountered great difficulty in building linkages around different unconnected topics.

The book is well-structured with clear synopsis and readable fonts. However, the book is not too generous in providing broad page margins and hence leaves no scope for making personal notes - a drawback for those owning a personal copy. The organization of the book is novel. Starting with the nature of injunctive relief, which is at the core of its analysis, the book proceeds to unravel how foundational principles of IP interact with general property principles in providing necessary relief. Unlike most legal commentaries authored by practitioners which rely on ‘section by section’ analysis of the statute, Padmanabhan works instead on a structure and organisation that relies on a topical analysis of intellectual property issues. Academics would appreciate this structure and organization for its flow, since issues can be taught on a topical basis. In fact, I would argue that an IP curriculum designed keeping infringement and remedies at the core would help students appreciate the subject better, than if the subject were approached in the order of the statute. The usefulness of the structure and organization to teachers can be illustrated way of an example. Most IP teachers would agree that the starting point in teaching intellectual property law should be the discussion on the subject matter of IP and the threshold requirements. However, by keeping remedies at the core (since most case-laws on subject matter or qualification requirements arise out of issues concerning infringement and counterclaims), a teacher can creatively analyze such issues through the case-law method.

Readers should not be deterred by the bulkiness of the book. That is a consequence of the inclusion of huge appendices which cover all relevant IP legislations. This essentially means that Padmanabhan’s contribution takes up only the first 640 of the 1092 pages. Nevertheless, such legislations come in handy as readers will be able to cross-reference while reading the analysis that primarily avoids any substantive reproduction of such bare texts. Many recent commentaries on Indian IP draw heavily from comparative literature and case

⁵ PADMANABHAN, *supra* note 2, 1-50.

⁶ PADMANABHAN, *supra* note 2, ix-xi.

law of the UK and USA. Although foreign judgments are heavily relied on by Indian courts in this area due to their high persuasive value, such an approach has its own pitfalls in as much as it leaves less scope for creative interpretation by the Indian judiciary to read IP contextually. However, this book relies on foreign case law jurisprudence only to address ambiguities arising due to a dearth of Indian case laws. Moreover, the book attempts to elaborately deal with the differences in Indian law at a much nuanced level. Here, the readers will note the originality in the author's analysis.

The major highlights of the book include an overview of the types of injunctive relief, the four-factor test for determining injunctions and an elaborate discussion on decisions in comparative jurisdictions (*viz.*, the UK and US).⁷ For example, classic precedents like *American Cyanamid*⁸ and *Cayne* principles,⁹ including their application in the Indian context, have been adequately discussed.¹⁰ The discussion on relevant orders of the Indian Civil Procedure Code will attract practitioner and non-practitioner alike.¹¹ To my knowledge, no other prominent work in the Indian context has discussed the rule of injunctions in such elaborate detail.¹² It is needless to mention that this chapter adds ingenuity to the book. It is true that in a case for temporary relief, the proceedings cannot be converted into a mini-trial. However, in a situation where there is no presumption of patent granted by the IP office, if the judge gets it wrong, there are definitive implications for competitors and consumers. This is very true in a situation when IP laws do not allow for restitution in cases of unjust enrichment. Furthermore, some commentators are of the view that temporary injunctions in intellectual property cases should be limited where other important constitutional values like free-speech are in question.¹³ It could have added greater value to the analysis if the author would have critically examined such issues arising out of the four-factor test in their application to IP matters.

To Padmanabhan's credit, his focused and logically sound analysis of copyrightability, infringement and fair dealing defences will surely help readers towards an understanding of bright-line rules on provisions and

⁷ *Id.*, 22-42.

⁸ *American Cyanamid Co. Ltd. v. Ethicon Ltd.*, (1975) 1 All ER 504.

⁹ *Cayne v. Global Natural Resource Plc.*, (1984) 1 All ER 225.

¹⁰ PADMANABHAN, *supra* note 2, 42-50. IP injunctions have also been elaborately dealt with in each individual chapter.

¹¹ *Id.*, 13-22.

¹² Most IP texts focus largely on cases that deal with IP injunctions and remedies, rather than on any elaborate discussion of the very nature of injunctive relief from a procedural law perspective. It may be important to note that a casebook by Prof. N S Gopalakrishnan and T G Agitha has an exclusive heading on enforcement of intellectual property rights, while the discussion on general rule injunctions and remedies is only in passing. See NS GOPALAKRISHNAN & TG AGITHA, *PRINCIPLES OF INTELLECTUAL PROPERTY* 565-97 (2009).

¹³ See, e.g., Mark Lemley & Eugene Volokh, *Freedom of Speech and Injunctions in Intellectual Property Cases*, 48 (4) DUKE L. J. 147 (1998).

doctrines that are usually fraught with conceptual difficulties of consistency and scope.¹⁴ Furthermore, relevant provisions of the Copyright (Amendment) Act, 2012 have been discussed in some detail.¹⁵ While some amendments have been elaborately discussed, other amendments have been mentioned only in the passing.¹⁶ However, for example, readers will not find any discussion on the proposal to amend §2(m) to clarify the issue of parallel importation of copyrighted works, which was ultimately dropped by the Government at the eleventh hour.¹⁷ Such a discussion would have served a greater academic purpose. Surprisingly, the book does not discuss criminal remedies for copyright infringement under §63. This reveals a major flaw in the book's focus of 'remedies'. Furthermore, the discussion on copyright has also missed out on administrative remedies,¹⁸ while the same have been elaborately discussed under the section on patents.¹⁹

The emerging case law on patent validity and infringement analysis, and on how injunctive relief in patent cases may differ, is very insightful. More specifically, the discussion on the presumption of patent validity and the death of the 'recentness' of patents rule is useful in understanding patent injunctions.²⁰ Padmanabhan supports the use of public interest factor in denying pharmaceutical patent injunctions, especially in cases where the *prima facie* validity of patent is in doubt.²¹ However, there is no elaborate discussion on issues that concern patent abuse and remedies that follow in the form of a compulsory license. It is true that issues of compulsory license do not form part of infringement analysis. However, they form part of remedies available to third parties in cases where the patent holder fails to comply with his *quid pro quo* obligations.²²

While the discussion in the chapter on trademarks draws from a general structure of the book in explaining topics through case law analysis,

¹⁴ PADMANABHAN, *supra* note 2, 289-360.

¹⁵ *Id.*, 317-322, 348-350, 384-389, etc.

¹⁶ For example, while the issue of right to receive royalties has been analyzed in greater detail, the fair-dealing amendments have been discussed only in the passing. See PADMANABHAN, *supra* note 2, 319-322 and 348-350.

¹⁷ The amendment proposed a proviso to the definition of infringing copy under §2(m): It stated: "provided that a copy of a work published in any country outside India with the permission of the author of the work and imported from that country into India shall not be deemed to be an infringing copy". See *Report of the Standing Committee on HRD on the Copyright Amendment Bill, 2010*, available at <http://164.100.47.5/newcommittee/reports/EnglishCommittees/Committee%20on%20HRD/227.pdf> (Last visited on August 8, 2013).

¹⁸ For example, the seminal decision of the Supreme Court in *Gramophone Co. of India Ltd. v. Birendra Bahadur Pandey*, (1984) 2 SCC 534: (1950-2000) 22 PTC Supp (1) 547 does not find any mention.

¹⁹ PADMANABHAN, *supra* note 2, 592-596.

²⁰ *Id.*, 564-570.

²¹ *Id.*, 573-576.

²² It is surprising to note that even while discussing the topic on "effect of patent not being commercially exploited in India" (at 579), the author has missed out discussing the Natco compulsory licensing Order of the Indian Patent office decided in March 2012.

the discussion on linkages built by the author between the Trademarks Act and the tort of commercial disparagement is unique to the book. Legal analysis of Indian Supreme Court and appellate court decisions on deceptive similarity, trademark infringement and remedies for passing-off, including the legal position in other jurisdictions is coherent and well-articulated.²³ Again, criminal remedies for trademark infringement have not been discussed. Elaborate listing of descriptive and invented words, deceptively similar marks, marks having no deceptive similarity, including a focus on pharma trademarks, is useful by way of illustrations. Often neglected even in the best of IP commentaries, Padmanbhan's book elaborately covers design law validity, infringement and remedies, and the different dimensions of common law remedies and unfair competition as applied to intellectual property.

It is understandable that while the book's exclusive focus is on Indian law, we have witnessed few domestic legal challenges based on the mandate governed by the WTO-TRIPS Agreement.²⁴ Although the discussion on TRIPS challenges in domestic courts is largely academic due to India's dualist legal system, it still reveals a notable pattern. It suggests that Indian law will have to increasingly withstand the test of TRIPS consistency at the WTO dispute-settlement fora. Legislations, administrative actions and judicial pronouncements of Indian courts can always be challenged within the WTO dispute settlement forum for want of consistency.

A basic discussion on the operation of Indian law in the light of TRIPS legal framework governing IP enforcement could have enriched the discussion and widened the scope of the book to reach out to an international audience. Such a discussion would help global practitioners in understanding the nature of cross-border injunctive relief at different stages in the light of TRIPS Agreement's mandate, especially on controversial matters such as special requirement in relation to border measures (Articles 51-60).²⁵ Furthermore, such an analysis would also reveal the pattern in which India has implemented the TRIPS Agreement by way of TRIPS-plus provisions. For example, India's failure to utilize TRIPS flexibilities in case of copyright's criminal measures to contain piracy by covering every act of infringement, irrespective of its 'commercial scale', has much to reveal about the 'TRIPS-plus' nature of copyright enforcement in India.²⁶

²³ PADMANABHAN, *supra* note 2, 56-180.

²⁴ Novartis v. Union of India, (2007) 4 MLJ 1153 and Natco v. Bayer, CLA No. 1 of 2011 (March 2012).

²⁵ Agreement on Trade-Related Aspects of Intellectual Property Rights, 33 ILM 1197 (1994).

²⁶ *China — Measures Affecting the Protection and Enforcement of Intellectual Property Rights*, DISPUTE DS362 decided by the WTO dispute settlement leaves enough leeway for countries to determine commercial scale for determining criminal penalties associated with copyright piracy and trademark infringement.

Readers should appreciate that the strong justifications for injunctive relief as in real property,²⁷ may at times, not adequately serve the public policy objectives of the IP system in a developing country like India.²⁸ We are increasingly witnessing cases of procedural bias in access to and implementation of the remedial system. Abuse of IP remedies by taking advantage of legal loopholes and frivolous litigation could be a subject for further discussion within the framework of the book. In a serious legal commentary such as this one, it is indeed heartening to note that the author has made an attempt to highlight public interest in articulating legal principles.²⁹ However, having said that, the book employs a rather myopic focus in examining the teleological implications of IP. Consequently, the book may not prove too helpful to IP policy makers or academics interested in IP law and policy.

An in-depth examination of the content will reveal that, the book, although authored by an academically-minded practitioner, may not qualify as a text that engages with the purely academic, but nevertheless important, questions. In that sense, the book is less academic and more oriented towards practice. Padmanabhan generally avoids any examination of the ‘why’ questions and the theoretical considerations that arise in IP. By way of an example, Padmanabhan has not examined the linkages between contractual waiver of fair use, waiver of moral rights or how technological protection measures will interact with existing fair-dealing provision post the introduction of §65A of the Copyright (Amendment) Act, 2012. While the book is useful in ascertaining bright-line rules on many issues of IP infringement and remedies, this is drawn only from existing case law, and is therefore largely historic. No hypothetical examples are proffered to test how impending controversies could potentially be resolved.

Students interested in understanding general principles of IP and practitioners needing a quick but nuanced grasp on infringement and remedies will immensely benefit from the book. The conceptual design of the book and content analysis presented by the author makes the material more easily digestible, and the text easier to navigate. An increased focus on policy embedded in the statutory design of IP infringement and remedies could have better fuelled

²⁷ The US Supreme Court has stated that patent injunctions cannot be granted as a matter of rule without following the four-factor test in *ebay Inc. v. MercExchange*, 547 US 388 (2006). See, e.g., Rachel Janutis, *The Supreme Court's Unremarkable Decision in Ebay v. Mercexchange*, *L.L.C.*, 14 LEWIS & CLARK L. REV. 597 (2010).

²⁸ Shamnad Basheer & Prakruti Gowda, *Pharmaceutical Patent Enforcement*, available at <http://www.law.kyushu-u.ac.jp/programs/english/conference2010/draft10.pdf> (Last visited on August 8, 2013). See also, Shamnad Basheer, *Eliminating Interim IP injunctions*, October 5, 2010, available at <http://spicyipindia.blogspot.in/2010/10/eliminating-interim-ip-injunctions.html> (Last visited on August 8, 2013).

²⁹ See, e.g., on parallel imports and parallel exports, the author is critical of the decision in *Penguin Books Ltd. v. India Book Distributors*, AIR 1985 Del 29 and *John Wiley & Sons Inc. v. Prabhat Chander Kumar Jain*, (2010) 170 DLT 701 for manipulating the Copyright Act to carve out remedies for the plaintiffs.

an academic discourse around these issues. Moreover, a reading list of articles (for further reading) at the end of each chapter could have helped students gain a deeper understanding of the material and may have been useful for advanced research. This can definitely be added in the subsequent editions of the book.

This book is bound to be a favourite among students, academics seeking wider case-law analyses, and practitioners for its legal documentation, focused analysis and concrete opinions on this subject of growing importance.

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