

# CHOOSE YOUR BATTLES WISELY

Pankaj Soni, a partner at Remfry & Sagar, provides some smart tips for patent enforcement in 2017.



Pankaj Soni

“How can I enforce my intellectual property (IP) rights in India?” A simple question, the answer to which is complicated because India’s IP regime is sometimes inconsistent in its approach towards what can be protected. It is also plagued with delays. In the face of such challenges, an IP owner may be left contemplating whether or not India as a jurisdiction is worth the investment. If one can enforce IP rights in India, then it will be worth the investment, but having a sound strategy is a must to make sure that the enforcer does not become the victim.

## PICK YOUR BATTLES

In the words of Kenny Rogers, “You’ve got to know when to hold ‘em, know when to fold ‘em, know when to walk away, and know when to run”. Litigation is not always the best option and a good attorney will tell you so. The opponent(s) must be carefully considered and a strategy should be developed based on the parties, the product/technology involved and importantly, the desired outcome. I believe an “outcome” differs from, and should not be confused with a “result”. A result is limited in that it is merely the conclusion of the impending battle, but the outcome is the bigger picture where one envisions the conclusion of a conflict in the long term, which may not require litigation at all.

Having said that, Indian entities are not good at coming to the discussion table, so litigation is never off the table. One must strategically decide when to walk away from a discussion and start a courtroom battle. IP owners must also plan carefully how to start a conflict and whether to (i) initiate a licensing discussion, (ii) send a cease-and-desist letter, or (iii) immediately seek temporary injunctive relief. A cookie-cutter approach does not work in any jurisdiction including India.

## INJUNCTION: A LEGITIMATE WEAPON

If a company seeks profits from enforcing its rights in India, then its *ab initio* strategy needs to be aligned with the peculiarities of Indian practice. Unlike the US, punitive damages and treble damages are notions that have not found universal acceptance. The better option is to seek injunctive relief, which is inexpensive, efficient and effective. After all, a patentee can, to the chagrin of some commentators, even obtain an *ex parte* interim

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injunction at a cost less than that of two business class air tickets from the US to India! If not *ex parte*, then a successful preliminary injunction bid can be achieved in nine to 12 months – not a bad option for a judicial system that is steeped in unfortunate delays. Yes, the injunction can, and will, be appealed, but it sends a message and can bring the defendant into a more temperate mood.

## EVERYONE IS A PUBLIC POLICY EXPERT

In India, you ignore public policy at your own peril. Recent decisions indicate that pharmaceutical rights in particular will likely be adjudicated within a public policy framework. Judges, opposing counsel, the media and the IP community often do not shy away from expressing their interpretation of public policy and stressing its applicability. This can lead to

great uncertainty in outcomes. However, IP owners may be reassured by the fact that this trend is not so prevalent in matters outside of pharmaceutical litigation.

## SEP AND FRAND ARE KNOWN (DEVILS)

A few years ago one would be hard pressed to have conversations on standard essential patents (SEPs) and fair, reasonable and non-discriminatory (FRAND) licensing obligations. However, since the Ericsson battles commenced in 2012, coupled with the fact that India is one of the primary telecom markets in the world, everyone is talking about SEPs and FRAND, their interplay with Indian competition law and the trend of *ex parte* injunctions being freely granted (or lifted subject to deposit orders).

The Indian government has also created a body, the Cell for IPR Promotion and Management, to examine the availability of SEPs on FRAND terms. Interested parties should thus carefully study the playing field in India before they set about enforcing telecom patents.

## KNOW YOUR LAW FIRM

A lesser known aspect of IP enforcement in India is that law firms are, and should be, hired for their technical and procedural expertise and the depth of their practice. There is a common pool of senior counsel – eminent lawyers who are expert orators and known for their court craft – that work independently and are accessible to every law firm. So work with a firm that matches your style, is willing to strategize with you and gives you the quality of service you desire.

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**PANKAJ SONI** is a partner at Remfry & Sagar. Email: [Pankaj.Soni@remfry.com](mailto:Pankaj.Soni@remfry.com).

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