Ignorance is bliss - but not for patent infringement

By Yogani Reddy

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In 1742, poet Thomas Gray wrote, "Where ignorance is bliss, 'tis folly to be wise". But Gray did not mean what we have since assumed: that ignorance is literally bliss. Instead, he referred to being ignorant as a child and therefore being able to enjoy the wonders of life, without having to bear the considerable burden of adult responsibilities.

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Fast-forwarding in time, technology evolved and in 1980 we saw the movement from mechanical and analogue technology to digital technology. The digital revolution, led digital technologies to accelerate, to the extent that we now live in a largely digital society.

We enjoy easier access to and distribution of information. But there is a down-side: being ignorant today can land us in deep water, especially in the context of patent infringement.

If you create a new product

Let's say that you created a new product. From the outset, it had economic potential, life-saving benefits, or the capacity to resolve global issues. Before exploiting the product, you studied the market, conducted research and concluded that your product would be new.

You decided that it would be “safe” to use the product. But, after the product had been launched onto the market, you received a communication…

“Your product is infringing on an existing patent.”

Can ‘innocent infringement’; i.e. not knowing that your product infringes on an existing patent, be used as a form of defence?

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Innocent infringement

In *Proctor v Bennis & Others* 1887 4 RPC 333 at 356, the Court held that if the defendant’s act constitutes an infringement, even though the defendant acted in a way that was bona fide or honest, he/she would not be protected from an injunction.

Therefore, even an innocent act of infringement cannot be regarded as a defence. But are you liable to pay damages, if you were not aware of the existence of the patent?

In each country, the patent laws in respect of damages for innocent infringement are different. In the USA and China, any party directly infringing on a patent, irrespective of innocent infringement, is liable to pay damages.

In the UK and Australia, there is a provision for not awarding damages for innocent infringement. The onus is on the infringer to prove that, at the date of infringement, he/she was unaware that the patent existed. The test is an objective test; taking into account the circumstances of the case, with very few cases having favoured the innocent party. This complicates the use of this provision.

South Africa has a similar provision to the UK and Australia. The South African Patents Act 57 of 1978 provides that a defendant may not be liable for damages if, at the date of the infringement, he/she was not aware, and had no reasonable means of making himself aware, of the existence of the patent.

Further, if the article was marked “patent”, “patented” or similar, but was not accompanied by the patent number, this does not constitute notice of the existence of the patent.

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You’ll need a sound case

Infrastructure and the ease of access to information have changed vastly through the years. The internet is ‘at our fingertips’, quite literally, and most of the Patent Offices around the world, including South Africa’s, have accessible online patent databases.

The courts are unlikely to take a claim of ‘innocent infringement’ lightly and, to avoid damages for patent infringement, you’ll need to make a sound case of your unawareness as to the existence of the patent. No easy task, and not one in which innocence is bliss.

Before bringing a new product to market, it is advisable to conduct ‘patent freedom to operate’ searches, also known as ‘non-infringement searches’. This will assist in surveying the patent landscape and help you to avoid patent infringement.

ABOUT THE AUTHOR

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