

TIPRs in India



PGS 503
Quick Reference Book

IPR Toolkit- India

Intellectual property refers to the creations of the mind. Article 2(viii) of the Convention Establishing the World Intellectual Property Organization (WIPO) provides that "intellectual property shall include rights relating to:

- literary, artistic and scientific works,
- performances of performing artists, phonograms and broadcasts,
- inventions in all fields of human endeavor,
- scientific discoveries,
- industrial designs,
- trademarks, service marks and commercial names and designations,
- protection against unfair competition,

and all other rights resulting from intellectual activity in the industrial, scientific, literary or artistic fields"

Broadly, intellectual property is divided into two categories: industrial property and [copyright](#). Industrial property includes [patents](#), [trademarks](#), industrial [designs](#) and [geographic indications](#) while copyright include creative works like novels, poems, plays, films, musical works, computer software and artistic works.

The majority of countries in the world have a system of intellectual property protection and enforcement because it encourages innovation and creativity, which in turn leads to economic prosperity of the nation. The first intellectual property law was passed in Venice in the year 1474. This law protected the investor's interest against copying of their creation. England soon followed suit and in the year 1624 passed the Statute of Monopolies, which granted intellectual property rights to the inventor for a limited period. However, the intellectual property system as we know today, commenced with the birth of the Paris Convention for the Protection of Industrial Property in 1883. The Paris Convention made it easier for individuals in one nation to obtain protection globally. This convention was followed by the Berne Convention for the Protection of Literary and Artistic Works.

This toolkit is intended to provide practical information on the intellectual property system of India to businesses, academics and others.

Copyrights

Introduction to Copyright

Copyright is a form of protection provided to the creators of "original works of authorship," including literary, dramatic, musical and artistic works. The importance of copyright was recognized only after the invention of the printing press, which enabled the reproduction of books in large quantities. England's "Statute of Anne" is regarded as the first copyright law. This law for the first time accorded exclusive rights to authors and limited the duration of such exclusive rights to a certain number of years, after which all works would pass into the public domain.

The Indian Copyright Act, the first Indian legislation of its kind, was passed in 1914, and was mainly based on the U.K. Copyright Act of 1911. With the development of recording, broadcasting, television and other new technologies it became essential to update the copyright laws. As a result, the Copyright Act of 1957 ("the Act") was introduced in the Parliament. This law presently governs the copyright system in India. The Act has been

amended in 1983, 1984, 1992, 1994 and 1999. The Copyright Office in India falls under the Ministry of Human Resource Development.

Copyright subsists in original literary, dramatic, musical and artistic works, cinematograph films and sound recordings. In accord with international norms and the Berne Convention, it is not necessary to register a copyright; protection is vested with the original creator as soon as the work has been created and has been recorded in a material form. However, it is advisable to do so as its registration serves as a *prima facie* evidence of the information contained in the registration in case of a dispute. It is important to note that no copyright vests in an idea. Rather, copyright vests only in the expression of the idea.

Piracy is a problem worldwide and affects all the major content industries like software, television, recording and movies. This problem has assumed enormous proportions, with the major U.S. motion picture studios reporting a loss of \$6.1 billion in the year 2005 due to piracy worldwide. 80% of these losses have resulted from piracy overseas and 20% because of piracy in the United States. In India, 29% of the potential market for movies produced by major U.S. movie studios is lost to piracy. The IT industry is similarly affected with a recent study revealing that 35% of the software installed in 2006 on personal computers (PCs) worldwide was obtained illegally, amounting to nearly \$40 billion in global losses due to software piracy. Although there are various laws in place for battling piracy, the enforcement of these laws in India is weak. However, Indian courts have passed various judgments enforcing the provisions of the copyright law. As an example, Section 52A(2) of the Copyright Act, 1957 establishes certain requirements for publishing a video. As interpreted by Indian courts, a lack of these requirements may create a presumption of piracy. Section 52A(2) states that no person shall publish a video film in respect of any work unless the following particulars are displayed in the video film, when exhibited, and on the video cassette or other container:

- (a) if such work is a cinematograph film required to be certified for exhibition under the provisions of the Cinematograph Act, 1952, a copy of the certificate granted by the Board of Film Certification under section 5A of that Act in respect of such work;
- (b) the name and address of the person who has made the video film and a declaration by him that he has obtained the necessary license or consent from the owner of the copyright in such work for making such video film; and
- (c) the name and address of the owner of the copyright in such work

In one of its judgments protecting the copyright of the owner, the Supreme Court of India in *State of Andhra Pradesh v. Nagoti Venkataramanna* {1996 (16) PTC 634 (SC)} has held that compliance of the provision under Section 52A of the Act is mandatory and any video film that does not mention the particulars as required in Section 52A(2) of the Act is deemed to be a counterfeit video film. While passing the judgment, the Supreme Court had held it unnecessary for the prosecution to track and trace the owner of the copyright in order to adduce evidence of infringement of copyright. The Supreme Court held that in cases where the particulars as mandated under Section 52A are not contained on the video, film, etc., infringement of copyright will be presumed. The High Court in its judgment in the same matter, held "that unless the owner is identified and he comes and gives evidence that he had copyright of the video film which was sought to be in violation of Section 52A or Section 51 of the Act, there is no offence made out by the prosecution and that, therefore, the conviction and sentence of the respondent is not valid in law."

Market Entry Planning

Many foreign companies have been able to register their copyrights in India successfully; however, India has widespread piracy, which is a matter of grave concern for any organization wanting to enter the Indian market. Furthermore, copyright infringement is so rife in India that the Indian movie, music and IT industries are still losing millions of rupees every year despite initiating various initiatives to combat piracy. Internet piracy using the latest technologies - like P2P sharing - has further aggravated this problem. As a result, high piracy rates persist, and companies entering the Indian market should beware of piracy. There are, however, certain strategies that companies can utilize in order to reduce this risk.

The rights holder should evolve a comprehensive IPR strategy before entering the Indian market. Among others, the rights holder should considering including the following steps as part of an overall strategy:

- The rights holder may hire an IPR attorney in order to understand the laws of India and to ensure that its strategy is in conformity with these laws.
- The rights holder should also consider entering into contractual agreements before sharing creative works with third parties. These may include non-disclosure agreements and other provisions specifying the relation between the owner of a creative work and the recipient party and the rights and obligations of both the parties. It is imperative that the agreement clearly specifies the ownership of the copyright, the specific works and rights being assigned, the duration and the territorial extent of such assignment/ license.
- In case of any infringement, the rights holder should take immediate steps to enforce its rights and stop the breach. The rights holder may initially send a cease and desist notice to the infringer. Subsequently, it might initiate legal action against the infringer. It may also be helpful for the rights holder to publish cautionary notices claiming copyright to the work in order to establish their exclusive proprietary rights to the work in which copyright subsists.

Works protected under the copyright laws

- Original Literary works
- Original Dramatic works
- Original Musical works
- Original Artistic works
- Cinematographic films
- Sound recordings.

Rights of the copyright owners in India (in general, please consult law for specific rights for each type of copyrighted work)

- To reproduce the work in any material form
- To issue copies of the work to the public not being copies already in circulation
- To perform the work in public
- To communicate the work to the public
- To make any cinematographic film of a literary, dramatic or musical work
- To make any sound recording of a literary, dramatic or musical work or a sound recording

- To make any translation of the work
- To make any adaptation of the work
- To offer the work for sale or rental a computer program, cinematograph film or sound recording

Registration procedure

The copyright in a work automatically vests with the creator as soon as the work is created. A certificate of registration of copyright does, however, serve as prima facie evidence in a court of law. Rights holder can apply for the registration of both published as well unpublished works. The steps are as follows:

- Preparing the documents and filing the application
- Any person who is the owner of the copyright may make an application to the Registrar of Copyrights. The copyright owner or his/her representative can file the application. A separate application has to be filed for each separate work. The application has to be filed in a prescribed format and has to be accompanied by a Statement of Particulars and Statement of Further Particulars. The forms to be filed and other general information are available at: <http://www.copyright.gov.in/handbook.htm>. However, in respect to an artistic work which is used or is capable of being used in relation to any goods, the application will also include a certificate from the Registrar of Trade Marks to the effect that no trademark identical with or deceptively similar to such registered work has been registered or is pending registration under the Trade Marks Act, 1999.
- As a pre-requisite, before filing of a copyright application, the rights holder must give notice of his application to every person who claims or has interest in the subject matter of the copyright or disputes the rights of the rights holder to the copyright. [Really? There is no limiting clause for only those of whom the holder is aware? The law does not state the limiting clause but practically the copyright owner can only inform those about whom he is aware of]
- Registration and Publication
- After the application is filed, the Registrar examines the application. If required, the Registrar may seek clarifications from the Applicant. The Applicant must respond to these objections [This seems to say the Registrar can raise objections.-That is true, he can] or provide clarifications. Moreover, if no third party objection of such registration is received by the Registrar of Copyrights within thirty days of the receipt of the application, he shall be satisfied about the correctness of the particulars given in the application and will enter such particulars in the Register of Copyrights. In case of any dispute, the Registrar will hold an inquiry. After being satisfied, the Registrar will enter the details in the Register of Copyrights and publish them in the Official Gazette. Typically the time taken for the registration of a copyright is between 8 to 12 months.

The general copyright term of protection in India is for the life of the author plus 60 years. In the case of cinematograph films, sound recordings, photographs, posthumous publications, anonymous and pseudonymous publications, works of government and works of international organizations, the copyright term last 60 years from the calendar year following the year of publication.

Performer's Rights

Performer's Rights are the special rights of a performer i.e. an actor, singer, musician, dancer, acrobat, juggler, conjurer, snake charmer, a person delivering a lecture or any other person who makes a performance i.e. a visual or acoustic presentation made live by the performer. With regard to his/her performance, the performer has the exclusive right to:

- make a sound recording or visual recording of the performance;
- reproduce the sound recording or visual recording of the performance;
- broadcast the performance;
- communicate the performance to the public otherwise than by broadcast.
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- If any person does any of the aforementioned act, without the consent of the performer and during the continuance of the performer's right in relation to any performance, that act is an infringement of the performer's rights. However, if a performer has consented for incorporation of his/her performance in a cinematograph film, he shall have not have any performer's rights to that particular performance. The performer's rights subsist until fifty years from the beginning of the calendar year next following the year in which the performance is made.

Broadcaster's Rights

The Act defines 'Broadcast' as communication to the public by any means of wireless diffusion, whether in any one or more of the forms of signs, sounds or visual images; or by wire. Every broadcasting organization has special rights with respect to its broadcasts and these rights are known as broadcast reproduction rights. The broadcasting organization has the exclusive right to:

- re-broadcast the broadcast;
- cause the broadcast to be heard or seen by the public on payment of any charges;
- make any sound recording or visual recording of the broadcast;
- make any reproduction of such sound recording or visual recording where such initial recording was done without license or, where it was licensed, for any purpose not envisaged by such license and
- sell or hire to the public, or offer for such sale or hire, any sound recording or visual recording of the broadcast.
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- If any person does any of the aforementioned act with regard to a broadcast, without a license from the broadcasting organization and during the continuance of the broadcast's reproduction right, that act is an infringement of the broadcaster's rights. The broadcast reproduction right subsists until twenty-five years from the beginning of the calendar year next following the year in which the broadcast is made.

Moral Rights

Besides economic rights that vest in the author of the copyright, the author also has certain independent rights in the work, which, subsists, irrespective of any assignment, either in whole or in part. The author has the right to claim authorship of the work and to restrain or claim damages in respect of any distortion, mutilation, modification or other act in relation to the work which is done before the expiration of the term of copyright where, such distortion, mutilation, modification or other act would be prejudicial to the author's honor or reputation.

Infringement and Enforcement Remedies

A copyright in a work is said to be infringed when any person, without authorization:

- Does anything that, the exclusive right to do which is conferred upon the owner of the copyright, or
- Permits any place to be used for the communication of the work to the public for profit where such communication constitutes an infringement of the copyright in the work, or
- Offers for sale or hire, or sells or lets for hire, or by way of trade displays or offers for sale or hire, any infringing copy of the work, or
- Distributes any infringing copy either for the purpose of trade or to such an extent as to affect prejudicially the owner of the copyright,
- By way of trade exhibits in public any infringing copy, or
- Imports into India, any infringing copy of the work

What is not infringement of copyright in a work

The following acts shall not constitute an infringement of copyright in a work:

- Fair dealing with a literary, dramatic, musical or artistic work, not being a computer program for the purposes of-
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 - - private use, including research;
 - - criticism or review, whether of that work or of any other work;
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- Making of copies or adaptation of a computer program by the lawful possessor of a copy of such computer program, from such copy
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 - - in order to utilize the computer program for the purposes for which it was
- Supplied; or
 - - to make back-up copies purely as a temporary protection against loss, destruction or damage in order only to utilize the computer program for the purpose for which it was supplied;
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- Doing of any act necessary to obtain information essential for operating inter-operability of an independently created computer program with other program by a lawful possessor of a computer program provided that such information is not otherwise readily available;
- Observation, study or test of functioning of the computer program in order to determine the ideas and principles which underline any elements of the program while performing such acts necessary for the functions for which the computer program was supplied;
- Making of copies or adaptations of the computer program from a legally obtained copy for non-commercial personal use;
- Fair dealing with a literary, dramatic, musical or artistic work for the purpose of reporting current events-
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 - - in a newspaper, magazine or similar periodical, or
 - - by broadcast or in a cinematograph film or by means of photographs;
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Exclusively for teaching purpose; for internal consumption only during PGS503 course

- Reproduction of a literary, dramatic, musical or artistic work for the purpose of a judicial proceeding or for the purpose of a report of a judicial proceeding;
- Reproduction or publication of a literary, dramatic, musical or artistic work in any work prepared by the Secretariat of a Legislature exclusively for the use of the members of that Legislature;
- Reproduction of any literary, dramatic or musical work in a certified copy made or supplied in accordance with any law for the time being in force;
- Reading or recitation in public of any reasonable extract from a published literary or dramatic work;
- Provided that not more than 2 passages from works by the same author are published by the same publisher during any period of five years, the publication in a collection, mainly composed of non-copyright matter, bona fide intended for the use of educational institutions, and so described in the title and in any advertisement issued by or on behalf of the publisher, of short passages from published literary or dramatic works, not themselves published for the use of educational institutions, in which copyright subsists;
- Reproduction of a literary, dramatic, musical or artistic work-
 - - by a teacher or a pupil in the course of instruction;
 - - as part of the questions to be answered in an examination; or
 - - in answers to such questions;
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- Performance, in the course of the activities of an educational institution, of a literary, dramatic or musical work by the staff and students of the institution, or of a cinematograph film or a sound recordings if the audience is limited to such staff and students, the parents and guardians of the students and persons directly connected with the activities of the institution or the communication to such an audience of a cinematograph film or sound recording;
- Making of sound recordings in respect of any literary, dramatic or musical work, if
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 - - sound recordings of that work have been made by or with the license or consent of the owner of the right in the work;
 - - the person making the sound recordings has given a notice of his intention to make the sound recordings, has provided copies of all covers or labels with which the sound recordings are to be sold, and has paid in the prescribed manner to the owner of rights in the work royalties in respect of all such sound recordings to be made by him, at the rate fixed by the Copyright Board in this behalf;
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- Causing a recording to be heard in public by utilizing it,
 - - in an enclosed room or hall meant for the common use of residents in any residential premises (not being a hotel or similar commercial establishment) as part of the amenities provided exclusively or mainly for residents therein; or
 - - as part of the activities of a club, society or similar organization which is not established or conducted for profit;
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- Performance of a literary, dramatic or musical work by an amateur club or society, if the performance is given to a non-paying audience, or for the benefit of a religious institution;
- Reproduction in a newspaper, magazine or other periodical of an article on current economic, political, social or religious topics, unless the author of such article has expressly reserved to himself the right of such reproduction;
- Publication in a newspaper, magazine or other periodical of a report of a lecture delivered in public;
- Making of not more than three copies of a book (including a pamphlet, sheet of music, map, chart or plan) by or under the direction of the person in charge of a public library for the use of the library if such book is not available for sale in India;
- Reproduction, for the purpose of research or private study or with a view to publication, of an unpublished literary, dramatic or musical work whose author is unknown, kept in a library, museum or other institution to which the public has access; if the author is known, such reproduction can only be made more than 60 years after the author's death;
- Reproduction or publication of-
 - - any matter which has been published in any Official Gazette except an Act of a Legislature;
 - - any Act of a Legislature subject to the condition that such Act is reproduced or published together with any commentary thereon or any other original matter;
 - - report of any committee, commission, council, board or other like body appointed by the Government if such report has been laid on the Table of the Legislature, unless the reproduction or publication of such report is prohibited by the Government;
 - - any judgment or order of a court, tribunal or other judicial authority, unless the reproduction or publication of such judgment or order is prohibited by the court, the tribunal or other judicial authority, as the case may be;
- Production or publication of a translation in any Indian language of an Act of a Legislature and of any rules or orders made there under, together with a notice that the translation has not been authorized or accepted as authentic by the Government
- if no translation of such Act or rules or orders in that language has previously been produced or published by the Government; or
 - - where a translation of such Act or rules or orders in that language has been produced or published by the Government, if the translation is not available for sale to the public;
- Making or publishing of a painting, drawing, engraving or photograph of a work of architecture or the display of a work of architecture;
- Making or publishing of a painting, drawing, engraving or photograph of a sculpture, or other artistic work, if such work is permanently situate in a public place or any premises to which the public has access;
- Inclusion in a cinematograph film of-
 - - any artistic work permanently situated in a public place or any premises to which the public has access; or
 - - any other artistic work, if such inclusion is only by way of background or is otherwise incidental to the principal matters represented in the film;
- Use by the author of an artistic work, where the author of such work is not the owner of the copyright therein, of any mould, cast, sketch, plan, model or study made by him for

the purpose of the work, provided that the author does not repeat or imitate the main design of the work;

- Reconstruction of a building or structure in accordance with the architectural drawings or plans by reference to which the building or structure was originally constructed;
- In relation to a literary, dramatic or musical work recorded or reproduced in any cinematograph film the exhibition of such film after the expiration of the term of copyright therein;
- Making of an ephemeral recording, by a broadcasting organization using its own facilities for its own broadcast by a broadcasting organization of a work which it has the right to broadcast; and the retention of such recording for archival purposes on the ground of its exceptional documentary character; and
- Performance of a literary, dramatic or musical work or the communication to the public of such work or of a sound recording in the course of any bona fide religious ceremony or an official ceremony held by the Central Government or the State Government or any local authority.

Enforcement Remedies

As the copyright owner has the exclusive proprietary rights in its work, the copyright law in India provides for both civil and criminal remedies by which the rights holder can enforce its rights.

Civil Litigation: A suit for infringement of copyright can be initiated under the Act, irrespective of the fact whether the copyright has been registered or not.

- Jurisdiction and Venue: The suit for infringement can be initiated either in the District Court or in the High Court depending on the valuation of the suit. The suit can be at the place where the rights holder or one of the rights holders actually and voluntarily reside or work for gain or carries on business.
- Elements of the Complaint: In the Complaint, the rights holder is required to demonstrate that (a) the alleged infringing act involves a work that is identical or similar to the copyright of the rights holder; (b) the unlawful act interfered with the copyright holder's rights of exclusive use or caused the rights holder economic loss.
- Statue of Limitation: As a general policy in India and as has been prescribed in the Limitation Act, the rights holder has a period of three years from the cause of action for filing the suit. However, as copyright infringement is a continuing offence and the infringer violates the exclusive proprietary right of the rights holder every time he commits a discreet infringing act, the limiting period will anew with each new act. Nevertheless, it is advisable that the legal action be initiated against the infringer as promptly as possible in order to establish the seriousness of the rights holder's intent before the Court.
- Ex-parte Interim Injunction: Most Indian courts will grant ex-parte interim injunctions should the rights holder establish its rights before the Court, establish the gravity of the offence and that the violation of its proprietary rights merit immediate consideration. Ex-parte interim injunction is a temporary injunction granted for the course of the trial restraining the infringer from use of the infringing work and without any notice to the infringer. These injunctions, depending on the gravity of the offence, could be granted on the first day of the hearing itself.

- Appointment of the Local Commissioner: Depending on the facts of the case, it is also advisable to ask the court to appoint a local commissioner on the first date of the hearing who will raid the premises of the infringer where the infringing goods are stored in order to seize the goods.
- Damages: There has recently been a change in the mindset of the Indian judiciary and some of the courts grant damages to the rights holders. In the case of *Microsoft Corporation v. Yogesh Papat & Anr* {2005 (30) PTC 245 (Del)}, the Delhi High Court awarded damages against the Defendants for Rs. 19.75 lacs for loading the software owned by Microsoft Corporation on the computer of their customers without seeking any permission from Microsoft Corporation for use of the software.

Criminal Litigation: The Act provides for remedies for infringement under the criminal laws too. Under the copyright laws, the police have the power to *suo moto* conduct raids and seizure operations. However, the use of such powers by the police is minimal.

Under the criminal laws, should the rights holder not be aware of the details (name, address, dates of infringement, etc.) of the infringers, it is advisable to procure a general search and seizure warrant from the local magistrate and thereafter organize search and seizure operations in that area. In the alternative, should the rights holder be aware of the details of the infringer a complaint can be lodged with the police authorities and raids organized accordingly. In a criminal proceeding however, the litigation is between the State and the infringer and the rights holder has a limited role to play. Knowingly infringing shall be punished by imprisonment of not less than 6 months or more than three years with a fine, which may extend to Rs. two lakhs.

Administrative Remedies: The Copyright Board is constituted under the Act, and its jurisdiction extends to the whole of India. The Board is entrusted with the task of adjudication of disputes pertaining to copyright registration, assignment of copyright, grant of licenses in respect of Indian works withheld from public, unpublished Indian works, production and publication of translations of works for certain specified purposes. It also hears cases in other miscellaneous matters instituted before it under the Act. Furthermore, the rights holder can make an application to the Registrar of Copyrights and the Registrar of Copyrights, who will conduct an inquiry, and can order that copies made outside of India, which if made inside India would infringe the work not be imported. Such copies will be deemed to be goods for which the import has been prohibited and/or restricted under the Customs Act, 1962, and the Registrar of Copyright or any person authorized by him can enter any ship, dock or premises where such infringing copies may be found and may examine such copies.

Provisions under the Customs Laws: Besides the civil and the criminal remedies mentioned herein above, there are also certain provisions under the customs laws that prohibit the importation of infringing goods in India. The Customs Authorities have recently promulgated guidelines known as the Intellectual Property Rights (Imported Goods) Enforcement Rules, 2007. These guidelines authorize the Customs officials to seize goods infringing the copyrights of the rights holder at the border without obtaining any orders from the court. Under these rules, the Customs authorities have initiated a recordation system using which the rights holder may give a notice in writing, to the Commissioner of Customs or any other Customs officer authorized by the Commissioner and request the suspension of clearance of such goods suspected to be infringing the copyrights of the rights holder. Subsequent to the filing of such notice, the Commissioner is bound to notify the rights holder within 30 working days regarding the acceptance or rejection of this notice. In case of acceptance of the notice, such registration

shall be valid for one year during which Customs authorities will assist the rights holder to prohibit the importation of infringing goods at the border. The Customs officers have the authority to suspend the clearance of such prohibited goods either by the information received by the rights holder or by initiating suo moto action, provided they have prima facie evidence or reasonable grounds to believe that the imported goods are infringing the copyrights of the rights holder. When clearance of the goods is suspended, the Customs authorities must inform the rights holder, who must execute the requisite bond and join the proceedings against the importer. If the rights holder does not act within the prescribed period, the Customs authorities will release the goods. These rules also empower the Customs officers to destroy the goods under official supervision or dispose of them outside the normal channels of commerce if it has been determined that the goods detained have infringed the copyright of the rights holder and if no legal proceeding is pending in relation to such determination. These rules also prohibit the re-exportation of the goods infringing the copyright.

Expected Developments

India has not yet acceded to the 'WIPO Copyrights Treaty (WCT)' and the 'WIPO Performances and Phonograms Treaty (WPPT)', but it is planning to amend its copyright law in order to keep pace with the rapid advance of technology. It is expected that this legislation will be finalized and presented in the Parliament in the future.

Moreover, the Customs authorities are in the process of upgrading their information technology infrastructure so that they can accept notices from the rights holder electronically.

Copyright Legislation and Regulation in India

The Copyright Act, 1957

The Copyright Rules, 1958

International Copyright Order, 1999

International Treaties to which India is a signatory

-Berne Convention for the Protection of Literary and Artistic Works

-Geneva Convention for the Protection of Producers of Phonograms Against Unauthorized Duplication of Their Phonograms

-Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS)

-Universal Copyright Convention

Copyright Related Websites:

<http://copyright.gov.in/>

<http://www.cbec.gov.in/>

<http://www.wipo.int/copyrights/en/>

FAQs

1. When can I use the symbol ©?

As soon as you have created the work in which copyright subsists you should use the symbol © along with the year in which the work has been created and the name of the copyright owner. This is irrespective of whether the copyright in a work has been registered or not.[Is this mandatory?-No its not mandatory]

2. What is the term of copyright in a work in India?

Typically, the copyright in any literary, dramatic, musical or artistic work (other than a photograph) published within the lifetime of the author subsists until 60 years from the author's death.

3. Can I license/assign the copyright in a work to another person?

Yes. You can license/assign the copyright in a work to another person provided the arrangement has been reduced in writing. No license/assignment is valid unless a written instrument supports it.

4. It is mandatory to register the copyright in a work in India?

No. It is not mandatory to register a copyright in a work in India. However, registration of copyright constitutes prima facie evidence the information contained in the registration in case of a dispute. However there is no difference in the protection granted to a copyright in a work of a registered or an unregistered copyright.

5. Who is the first owner of copyright in a work?

Ordinarily the author is the first owner of copyright in a work.

6. Who is an author?

There are different authors for different kinds of work. In the case of a literary or dramatic work the person who creates the work is the author. In the case of a musical composition it's the composer. For cinematograph films and sound recordings the producer is the author while in the case of a photograph, the photographer is the author, while in relation to other artistic works, the artist is the author. In the case of a computer-generated work, the person who causes the work to be created is considered to be the author.

7. What will be the period of assignment of the copyrights in the work if it has specifically not been stated in the assignments?

If the period of assignment has specifically not been stated in the assignment, it shall be deemed to be five years from the date of assignment.

8. What will be the territorial extent of the assignment if it is not specified in the assignment?

If the territorial extent of assignment of the rights is not specified, it shall be presumed to extend to the whole of India.

9. In what conditions would an assignment lapse automatically?

Unless otherwise specified in the assignment, if an assignee does not exercise the rights assigned to him within a period of one year from the date of assignment, the assignment is deemed to have lapsed automatically after the expiry of this period.

10. Does copyright subsist in a foreign work?

Yes. Copyright in a work of nationals of countries who are members of the Berne Convention for the Protection of Literary and Artistic Works, Universal Copyright Convention and the TRIPS Agreement are protected in India. These rights are protected in India through the International Copyright Order.

Patents

Introduction to Patents

A patent is a grant by the government of exclusive rights in a new, useful and non-obvious invention in exchange for the disclosure of that invention. The rights holder may use the patent to exclude others from making, using, selling or exploiting the invention for a limited period of time. Patents are one of the oldest forms of intellectual property rights. The term "patent" has been in existence since the year 1700, though the world's first exclusive right over an invention is said to have been granted in the year 1421 to Filippo Brunelleschi for an improved method of transporting goods up and down the river Arno in Florence. Brunelleschi obtained the exclusive right to his invention for a term of three years.

In India, the first patent law was passed in the year 1856 and was known as the Act VI of 1856 on Protection of Inventions. This was modified in the year 1859 as Act XV. The Act was replaced in the year 1872 with the Patents and Designs Protection Act, which was later replaced by the Protection of Inventions Act, 1883. Then in the year 1888, this Act was replaced by the Inventions & Designs Act. In the year 1911, this Act was replaced with the Indian Patents & Designs Act and thereafter with the Patents Act, 1970. The Patents Act, 1970 has been amended in the years 1999, 2002 and 2005.

Presently, the patent system in India is governed by the Patents Act, 1970 as amended by the Patents (Amendment) Act, 2005 and the Patents Rules, 2003 as amended by the Patents (Amendment) Rules, 2006. The latest amendment in the year 2005 was made in order to bring the patent law in India into compliance with the TRIPS Agreement and to introduce patents for drugs, medicines and food products; to remove transitional provision to exclusive marketing rights and to rationalize and reduce the timeline for processing patent applications. The provisions of patentability under Section 3(d) and the new disclosure requirements were introduced under this legislation.

Patent rights are territorial in nature. Thus, a patent obtained in India is not enforceable in another country. Under the Patent Cooperation Treaty (PCT), a person can file a single application to seek protection in all of the contracting parties to the PCT. The process of a PCT application can be divided in two phases: international and national. The international phase starts with the rights holder filing a PCT application in an eligible receiving office or the International Bureau in Geneva. Thereafter, there are steps for international search, publication and preliminary examination. Subsequent to this is the national phase, in which the rights holder has to pay fees and prosecute an application in all the national or regional offices where protection is sought. The procedure for prosecution of a patent application then becomes dependant upon the laws of each contracting party.

Moreover, the Indian patent system also allows Applicants to claim the priority of an earlier filed application in another Paris Convention country. Where a person has made an application for a patent in respect of an invention in a convention country and that person makes an application under the Patent Act, 1970 for a patent within twelve months after the date on which the application in the convention country was made, the priority date of a claim of the complete specification, being a claim based on matter disclosed in the application in the convention country, is the date of making of the basic application.

Market Entry Planning

It is imperative that applicants file in India as early as possible, as India follows a "first to file" system that gives priority to the first inventor to file an application. This is irrespective of when

the applicant plans to commence use of the invention in India. Furthermore, in order to protect its proprietary rights to the invention, the rights holder should have watertight Non-Disclosure Agreements with the recipient party before disclosing any particulars regarding the invention, prior to filing. This will help to bind the recipient party by its contractual obligation to maintain the confidentiality about the invention that is disclosed to it. Moreover, other contractual agreements that define rights between the parties should also be considered.

Who can apply

- Any person claiming to be the true and first inventor;
- Any person being the assignee of a person claiming to be the first and true inventor;
- The legal representative of any deceased person who immediately before his death was entitled to make such an application.

What can be patented

Subject to certain exceptions, any invention that has the following three essential ingredients may be patented:

- (i) The invention must be new: The inventor must have invented a product/process that must be original and such an invention must not have ever been used before.
- (ii) Must involve an inventive step: This would mean that advancement has been made in the technology of the invention from existing technology and the advancement must not be obvious to a person of ordinary skill in that particular field.
- (iii) The invention must be capable of industrial application: the invention must be useful.

What is non-patentable under the Indian patent system

Many types of inventions may be patented. In general, a new product that has been created or any new process for developing a product may be patented. Though the range of things that can be patented is very wide, there are certain exceptions under the Indian patent system. The following is a list of subject matter that cannot be patented in India:

- (i) Any purported invention that is against the laws of nature; or
 - (ii) Any invention that is contrary to public order or morality; or
 - (iii) Any invention that causes serious prejudice to human, animal or plant life or health or to the environment; or
 - (iv) Things, which are discovered i.e., which have existed in nature.
- Only things that have been invented are patentable. For example, human genes cannot be patented in the form that they exist in nature. Another example of a non-patentable discovery might relate to a new star; or
- (v) Mere discovery of any new property or new use for a known substance or of the mere use of a known process, machine or apparatus (unless such known process results in a new invention or employs at least one new reactant); or
 - (vi) A substance obtained by a mere admixture resulting only in the aggregation of the properties of the components thereof or a process for producing such substance; or
 - (vii) The mere arrangement or re-arrangement or duplication of known devices each functioning independently of one another; or
 - (viii) A method of horticulture or agriculture; or
 - (ix) The method of doing a medical treatment for human beings or animals, or the way in which the disease is diagnosed; or

- (x) Plants and animals in whole or any part thereof including seeds, varieties, and species and essentially biological processes for production or propagation of plants and animals; or
- (xi) Mathematical methods and scientific theories. For example, Newton's Law of Motion or the Archimedes principle cannot be patented; or
- (xii) A literary, dramatic, musical or artistic work or any other aesthetic creation; or
- (xiii) Schemes, rules, and methods that are used for different things; like doing a classical dance, running a business, etc.; or
- (xiv) Presentation of information; or
- (xv) Topography of integrated circuits; or
- (xvi) An invention which in effect is traditional knowledge or which is an aggregation of duplication of known properties of traditionally known components; or
- (xvii) Invention relating to atomic energy falling within sub-section (1) of Section 20 of the Atomic Energy Act, 1962; or
- (xviii) Under the Indian patent law, a computer program is not patentable but a computer program embedded in hardware is patentable;[i.e. a description of a program is not patentable while a claimed computer readable medium integrated with hardware maybe patentable.

As another example of what is not considered to be patentable under the Indian legal system, the High Court of Gujarat in *Cadila Pharmaceuticals Ltd. v. Instacare Laboratories Pvt. Ltd.* {2001(21) PTC 472 (Guj.)} held that "development of a combination medicine by a pharmaceutical company does not amount to patentable invention...."

Procedure for grant of Patent

The patent system in India is on a 'first-to-file' basis. The grant of patent in India normally takes four to five years. The Office of the Controller General of Patents, Designs and Trade Marks is the appropriate office for filing of a patent application in India. The different steps that are involved in the registration process in India are as follows:

- Select a patent agent in India:As the area of patents is highly specialized, it is important that you consult a local IP law firm or a patent agent before proceeding with the filing of the patent application in India. See for example, www.legal500.com and http://www.patentoffice.nic.in/ipr/patent/patent_agent_2006.pdf.
- Preparation of the paperwork and filing of application
A patent application should be accompanied by the provisional or complete specification and drawings (if any). If the application is accompanied by the complete specification, the complete specification should include the following:
 - Description of the invention and its operation or use and the method by which it is to be performed; and
 - Disclosure of the best method of performing the invention, which is known to the Applicant and for which he is entitled to claim protection; and
 - Claims defining the scope of invention for which protection is claimed; and
 - Abstract to provide technical information on the information; and
 - Statement and undertaking regarding foreign filing details in respect of the same invention; and
 - Declaration as to Inventorship; and

- Priority document (if it is a convention application); and
- Power of attorney (if the application is made through a patent agent); and
- Proof of right to file (if the application is made by the assignee).

There are four patent offices in India, which are located in Mumbai, Kolkatta, Delhi and Chennai. A rights holder can file their patent application in any one of these patent offices, depending on the territorial jurisdiction. The patent law in India allows the Applicant to file a patent application if they have a place of residence or business or a domicile in India. The Applicant must be an Indian national or a national of a Convention country. The persons who are authorized to file the application are the true and first inventor or his/her assignee or the legal representative of deceased inventor or assignee. Foreign Applicants who do not having a place of business in India are required to file their patent applications through an Indian patent agent.

The Patent office has also started accepting patent applications online. Electronic applications can be filed through the following website:

<https://www.ipindiaonline.gov.in/on%5Fline/>.

- Publication and Examination of Patent Applications
If the application at the time of filing is accompanied by a provisional specification and not a complete specification then the complete specification has to be filed within twelve months from the date of filing of the application. If the complete specification is not filed within this period, the application is deemed to have been abandoned.

With some exceptions, all of the applications for patent are published in the Patent Office Journal 18 months after the date of filing of the application or the date of priority, whichever is earlier. The exceptions to this are applications that are prejudicial to the defense of India, applications that are abandoned due to non-filing of a complete specification within 12 months after filing a provisional application or applications, which are withdrawn within 15 months of filing the application. The publication of the application in the Patent Office Journal includes the date of application, number of application, name and address of Applicant identifying the application, and an abstract.

Thereafter, within a period of forty-eight months from the date of the filing of the application, the Applicant or any other interested person may request the Registrar to examine the application. If no such request is made then the application will be deemed to have been withdrawn and thereafter cannot be revived. Normally the First Examination Report stating the objections/requirements is communicated to the Applicant or his agent on record within six months from the date of request for examination or date of publication whichever is later. The Applicant has to respond to the First Examination Report by amending the application or the complete specification within 12 months from the date of the First Examination Report. In order to seek any clarification, the Controller General may even appoint a hearing. If the objections as cited in the First Examination Report are not complied with or overcome in the aforesaid period, the application is deemed to be abandoned. If the application along with the complete specification is accepted, the same is published in the journal.

- **Registration**
Where the complete specification of the application has been accepted and no opposition has been filed against it or an opposition has been filed and is decided in favor of the Applicant or the application has been accepted by the Controller General, the Applicant shall make a request in the prescribed form that the patent should be granted to him and thereafter the Controller General shall seal the patent with the seal of the Patent Office and the patent shall be entered in the Register of the Patents. The patent is generally granted after 6 months of the date of the publication.

- **Pre-grant and Post-grant opposition**
If an application for a patent has been published, but a patent has not been granted, any person may, in writing, oppose the same by making a representation to the Controller General. The Controller General shall, if requested by the person who is opposing the patent application, appoint a hearing in the matter and dispose of such representation. If the opposition is decided in favor of the Applicant, the patent will be granted and the patent advertised in the Patent Office Journal. Though this provision exists in the Indian patent system but it may result in unwarranted delay in the grant of patent because of some frivolous opposition that is initiated under this provision. The pre-grant opposition is typically decided within 4 months from the date of notice of opposition. There is no appeal from the order of the Controller General in these matters.

Any interested person can also file a post-grant opposition anytime after the grant of the patent, but before the expiry of a period of one year from the date of publication of grant of a patent in the Patent Office Journal. After the receipt of notice of any such opposition, the Controller General will constitute an Opposition Board. After receiving the recommendations of the Opposition Board and hearing the patentee and the opponent the Controller General will decide whether to maintain, revoke, or amend the patent. The time normally taken to decide the opposition proceedings is about 8 months. The order of the Controller General can be appealed before the Intellectual Property Appellant Board.

- **Term of a Patent**
The term of a patent is twenty years from the date of the application, irrespective of whether it is filed with provisional or complete specification. To keep the patent valid for the term of 20 years a renewal fee has to be paid every year. If the renewal fee is not paid within the prescribed time, the patent will cease to have effect.
- **Revocation of Patent**
At any time during the life of a patent, the patent might be revoked by the High Court on the petition of the following persons:
 - Any person interested; or
 - The Central Government by the Appellate Board; or
 - On a counter claim by the defendant in a suit of infringement.

The grounds for revocation as prescribed under The Patents Act, 1970 are as follows:

- Claimed invention is the subject of prior grant; or
- Patentee not entitled to the Patent; or
- A person other than the person who is rightfully entitled to it wrongfully obtained the patent; or
- Subject of a claim is not an invention; or
- Invention is lacking in novelty with regard to prior knowledge or prior use; or
- Invention is obvious or does not involve inventive step having regard to prior knowledge or prior use; or
- Invention is not useful; or
- Invention is not sufficiently described; or
- Claim not clearly defined and not fairly based; or
- Patent was obtained by false suggestion or representation; or
- Subject of claims not a patentable invention; or
- Claimed invention was secretly used before the priority date; or
- Failure to disclose information regarding Foreign Application; or
- Non-compliance of secrecy direction; or
- Leave to amendment of specification obtained by fraud; or
- Specification wrongly mentioning or not disclosing geographical origin; or
- Invention is anticipated by traditional knowledge.

Furthermore, a patent can also be revoked in public interest when the Central Government of India is of the opinion that a patent or the mode in which it is exercised is mischievous to the State or prejudicial to the public. In such case, the rights holder is given an opportunity to be heard and thereafter, should the decision to revoke remain in effect, a declaration is published in the official gazette and the patent shall be deemed to be revoked.

The Controller General also has the authority to revoke the patent for "failure to work" the patent. This action for revocation can be initiated by the Central Government or any other interested person after the expiration of two years from the date of the order granting the first compulsory license, on the grounds that the patented invention has not been worked in the territory of India, that reasonable requirements of the public with respect to the patented invention has not been satisfied, or that the patented invention is not available to the public at a reasonably affordable price.

- **Compulsory Licenses**

Under the prevailing Indian patent law, any person, including a current licensee of the patent holder, who is interested in the invention, can file an application with the Controller General for the grant of a compulsory license for a patent. Such an application can be filed after three years from the date of issuance of the patent. The basis on which the application for the compulsory license can be filed are:

- The reasonable requirements of the public with respect to the patented invention have not been satisfied;
- The patented invention is not available to the public at a reasonably affordable price; or
- The patented invention is not worked in the territory of India.

By the amendment of 2005, a provision regarding the compulsory licensing of patents relating to the manufacture of pharmaceutical products for export to countries with

public health problems has been included. This provision is intended to ensure that patented pharmaceutical products may be manufactured and exported to countries having insufficient or no manufacturing capacity in the pharmaceutical sector.

- Mailbox Applications

After India became a signatory to the TRIPS Agreement, it incurred an obligation to re-introduce product patents. India therefore amended its Patent Act, 1970 by The Patents (Amendment) Act, 1999 with effect from January 1, 1995. However, India had a transition period of 10 years to adopt products patent protection. Through this system, Applicants could file applications for product patents. However, examination did not start until January 1, 2005. Applications for pharmaceutical products filed between January 1, 1995 and January 1, 2005 are called Mailbox applications. Subject to certain conditions, exclusive marketing rights were provided to the Applicants for a period of 5 years, until the grant of patent, or the rejection of the application, whichever was earlier. Exclusive Marketing Rights were granted for mailbox applications if the following conditions were fulfilled:

- Where an invention had been made and before filing such a claim in India, application for the same invention claiming identical substance in a Paris Convention Country has been filed on or after 1st January, 1995 and a patent had been granted on or after the date of making a claim for the substance in India and approval to sell or distribute has been obtained in the other Convention Country on the basis of test done on or after 1st January, 1995.

- Where an invention had been made in India and before filing such a claim, the Applicant had made an application for patent on or after January 1, 1995 for method or process of manufacturing the identical substance and a patent had been granted in India on or after the date of making of the product claim.

- Marketing approval of the article or substance had been obtained from the appropriate authority in India provided that the Controller, on the basis of the report of the Examiner, had not rejected the application for patent, on the grounds that the invention is not an invention or the invention is an invention on which no patent can be granted.

The provision relating to mailbox applications has been omitted after January 1, 2005. Applications for Exclusive Marketing Rights are now treated as a request for examination and these applications have been examined accordingly. Subsequent to these applications being examined, they will be treated as normal patent applications. However, the Patent (Amendment) Act 2005 allows generic manufacturers to continue to produce and sell generic copies of products that receive a patent under the mailbox procedure on payment of a "reasonable" royalty to the patent holder.

Infringement and Enforcement Remedies available under the Act

The following acts, when not authorized by the patent owner, constitute infringement under the Indian patent law:

- Manufacturing patented products; or
- Using patented processes; or
- Offering to sell or selling patented products; or
- Using products directly acquired by the patented process for production or business purposes; or

- Importing or exporting patented products or products that are acquired through patented processes.

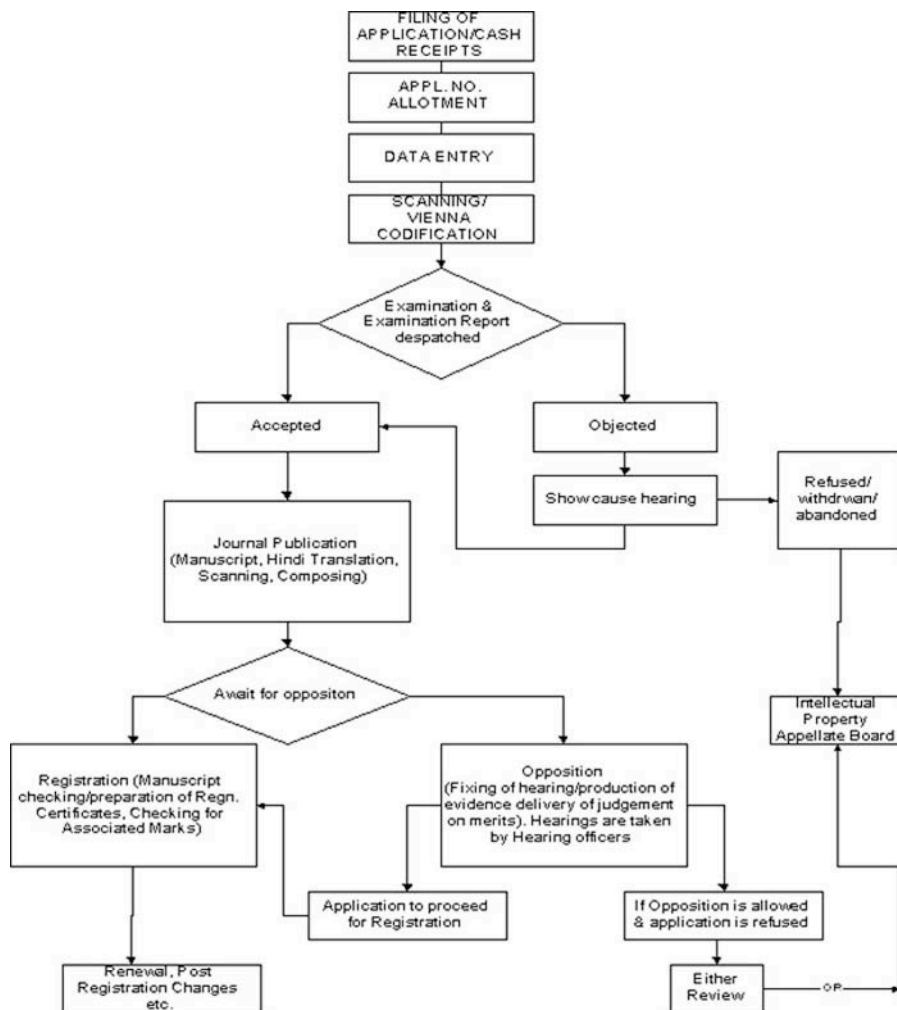
The rights holder may prevent unauthorized third parties from the acts of making, using, offering for sale, selling, or importing for those purposes, the patented product into India. When the rights holder has the exclusive right over a process, it shall have the right to prevent third parties, who do not have his consent, from the act of using that process, and from the acts of using, offering for sale, selling, or importing for those purposes the product obtained directly by that process in India.

The following acts are not considered to be an infringement under the Indian patent system:

- Any act of making, constructing, using, selling, or importing a patented invention solely for uses reasonably related to the development and submission of information, as is required under any law that regulates the manufacture, construction, use, sale, or import of any product;
- Importation of patented products by any person from a person who is duly authorized under the law to produce and sell or distribute the product.
- In the case of any infringement, the rights holder has the option of initiating a civil action against the infringer.
- Jurisdiction and Venue: The suit for infringement can be initiated either in the District Court or in the High Court depending on the valuation of the suit. The suit can be at the place where the rights holder or one of the rights holders actually and voluntarily reside or work for gain or carries on business.
- Elements of the Complaint: In the Complaint, the rights holder is required to demonstrate that (a) the alleged infringing act infringes the patent of the rights holder; and (b) the unlawful act interfered with the patent holder's rights of exclusive use or caused the rights holder economic loss
- Ex-parte Interim Injunction: Most Indian courts will grant ex-parte interim injunctions. Ex-parte interim injunction is a temporary injunction granted for the course of the trial restraining the infringer from use of the infringing patent, without any notice to the infringer and on the date of the first hearing itself, provided that the rights holder is able to establish its rights before the Court, establish the gravity of the offence and the fact that the violation of its proprietary rights merits immediate consideration.
- Relief sought in the complaint: The reliefs that can be sought in a complaint include an injunction and damages or an account of profits. The court may also order that the goods that are found to be infringing and materials, whose prominent use is in the creation of the infringing goods, can be seized, forfeited or destroyed.
- Damages: There has been a change in the Indian judicial system in recent times with some of the courts granting damages to the rights holders. However, such cases are still few and far between and the amount of damages has not been substantial.

Provisions under the Customs Laws: Besides the remedies mentioned herein above, there are also certain provisions under the customs law, which prohibit the importation of infringing goods in India. The Customs Authorities have recently promulgated guidelines known as the Intellectual Property Rights (Imported Goods) Enforcement Rules, 2007, under which the rights holder can record the patents that have been granted to it with the Customs authorities. These guidelines authorize the Customs officials to seize goods infringing the patents of the rights holder at the border without obtaining any orders from the court. Under these rules, the Customs authorities have initiated a recordation system using which the rights holder may give

a notice in writing to the Commissioner of Customs or any other Customs officer authorized by the Commissioner at the port of import of infringing goods requesting the suspension of clearance of goods suspected to be infringing patents of the rights holder. Subsequent to the filing of such notice, the Commissioner is bound to notify the rights holder within the prescribed time regarding the acceptance or rejection of this notice. In case of acceptance of the notice, the normal period of validity of such registration is one year during which assistance will be rendered by the Customs authorities to the rights holder to prohibit the importation of infringing goods at the border. After the grant of this registration the importation of goods that infringe the rights holder patents are deemed to be prohibited, as has been defined under the Customs Act, 1962. The Customs officers have the authority to suspend the clearance of such prohibited goods either at the information received by the rights holder or by initiating *suo moto* action, provided they have *prima facie* evidence or reasonable grounds to believe that the imported goods are goods infringing the patents of the rights holder. After the clearance of the suspected goods is suspended the Customs authorities have to inform the rights holder of the same and should the rights holder not execute the requisite bond and join the proceedings against the importer within the prescribed period the Customs



authorities will release the suspended goods. These rules also empower the Custom officers to destroy the suspended goods under official supervision or dispose them outside the normal channels of commerce after it has been determined that the goods detained have infringed the patents of the rights holder and that no legal proceeding is pending in relation to such

determination. These rules also prohibit the re-exportation of the goods infringing patents in an unaltered state.

Expected Developments

It is expected that the system of electronic prosecution of patent applications will commence shortly in India. The Patents Office is in the process of gearing up for the launch of this system. Moreover, the Patents Office has recently been designated as an International Searching and Examining Authority under the PCT system of filing and is likely to commence accepting applications under this system by June 2008. Furthermore, the Customs authorities are also in the process of upgrading their information technology infrastructure so that they can accept notices from the rights holders electronically.

Patent Legislation and Regulation in India

The Patents Act, 1970 as amended by The Patents (Amendment) Act, 2005

The Patents Rules, 2003 as amended by The Patents (Amendment) Rules, 2006

International Treaties to which India is a signatory

Paris Convention for the protection of Industrial Property

Patent Co-operation Treaty (PCT)

Budapest Treaty

Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS)

Patents Related Websites

<http://www.dipp.nic.in>

<http://ipindia.nic.in/>

<http://www.cbec.gov.in/>

<http://www.wipo.int/trademarks/en/>

<http://www.uspto.gov>

FAQs

1. Do I have to file the complete specification of the invention at the time of filing of the patent application?

No. You can file a patent application with a provisional specification. However the complete specification has to be filed within 12 months of the filing of the patent application, failing which the patent application is deemed to be abandoned.

2. How do I file for a patent application in India?

The procedure for the registration of the patent is described under the section 'Registration Procedure'

3. What is the filing fee?

The official filing fee for filing one patent application accompanied by provisional/complete specification by a natural person is Rs. 1,000/- while for the other than natural person is Rs. 4,000/-. The details of the official filing fees for various kinds of applications can be found at http://www.patentoffice.nic.in/ipr/patent/patents_filing.pdf. The attorney charges for filing the application will depend on the patent agent that you will hire.

4. What are the different types of patent applications under the Indian patent system?

The following are the different types of patent application under the prevailing patent system:

- (i) Ordinary Application
- (ii) Application for Patent of Addition (granted for Improvement or Modification of the already patented invention, for an unexpired term of the main patent).
- (iii) Divisional Application (in case there are multiple inventions disclosed in the main application).
- (iv) Convention application, claiming priority date on the basis of filing in Convention Countries.
- (v) National Phase Application under PCT.

5. What is the duration of a patent in India?

A patent is valid for 20 years from the date of filing of the patent application in India.

6. What is the Patent Cooperation Treaty (PCT)?

The Patent Cooperation Treaty (PCT) is a multilateral treaty that was concluded in Washington in 1970 and entered into force in 1978. The International Bureau of the World Intellectual Property Organization (WIPO), Geneva, administers it. The PCT facilitates the protection of inventions in any or all of the PCT Contracting States. It provides for the filing of one patent application ("the international application"), with effect in other PCT contracting parties, instead of filing many separate national and/or regional patent applications.

7. Can rectification proceedings be initiated for a patent?

Rectification proceedings can be initiated against a patent by an aggrieved person before the Intellectual Property Appellate Board on any of the following grounds:

- by the absence or omission from the register of any entry;
- by any entry made in the register of patents without sufficient cause;
- by any entry wrongly remaining on the register; or
- by any error or defect in any entry in the register.

The Appellate Board can pass orders for variation or deletion of any entry as it may deem fit.

Trademarks

Introduction to Trademarks

A trademark is a sign or combination of signs that distinguish goods or services of one person or enterprise from those of another^[1]. Its origin dates back to ancient times, when craftsmen reproduced their signatures, or "marks" on their artistic or utilitarian products.

The first trademark law in India was passed in the year 1940 and was known as the Trade Marks Act, 1940. This law was subsequently replaced by the Trade and Merchandise Act, 1958. Thereafter the Government of India amended this Act in order to bring the Indian trademark law in compliance with its TRIPS obligations. The new Act that was passed was the Trade Marks Act, 1999. This Act came into force in the year 2003. The Trade Marks Act, 1999 and the Trade Marks Rules, 2002, presently govern the trademark law in India.

The trademark law in India is a 'first-to-file' system that requires no evidence of prior use of the mark in commerce. A trademark application can be filed on a 'proposed to be used or intent-to-use' basis or based on use of the mark in commerce. The term 'use' under The Trade Marks Act, 1999 has acquired a broad meaning and does not necessarily mean the physical presence of the goods in India. Presence of the trademark on the Internet and publication in international magazines and journals having circulation in India are also considered as use in India. One of the first landmark judgments in this regard is the "Whirlpool case" [N. R. Dongre v. Whirlpool Corporation 1996 (16) PTC 583] in which the Court held that a rights holder can maintain a passing off action against an infringer on the basis of the trans-border reputation of its trademarks and that the actual presence of the goods or the actual use of the mark in India is not mandatory. It would suffice if the rights holder has attained reputation and goodwill in respect of the mark in India through advertisements or other means. Another judgment in this regard by the Supreme Court of India is of Milmet Oftho Industries & Ors. v. Allergan, Inc. (2006 (32) PTC 495), in which the court confirmed an order of interlocutory injunction restraining an Indian company from using the trademark Ocuflux and stating that "the mere fact that the Respondents have not been using the mark in India is irrelevant if they were first in the world market". The interim injunction was therefore not vacated by the Court despite the fact that Allergan, Inc. neither made any use of the mark Ocuflux in India nor was their trademark registered in India. Subsequently, the Calcutta High Court decreed the suit in favor of Allergan, Inc. and against Milmet Oftho Industries who was restrained from using the trademark Ocuflux.

A trademark registration in India gives exclusive proprietary rights to the rights holder for protection of their trademark in India. However as the Indian legal system is based on the common law system, even an unregistered trademark is entitled to protection and the rights holder of the unregistered trademark can initiate action against a third party under the law of passing off.

Market Entry Planning

With India having liberalized many sectors of its economy, there is a lot of interest amongst various businesses to set up a base in India or to sell their products or services in India. However a major concern for them is protection of their Intellectual Property (IP). Although the Indian legal framework has improved, but India still has weak IP enforcement. It is therefore imperative that businesses develop a comprehensive strategy for protecting their IP and take steps to safeguard their rights before they enter the Indian market.

Registration of trademarks is one of the important protections that businesses should avail in India. Many foreign and domestic Applicants have been able to successfully register their marks in India. Indian courts have upheld many of those registrations and granted favorable decisions to rights holders.

In addition to the registering of their trademarks in India, businesses need to adopt other strategies for protecting their trademarks. Some of them are mentioned below:

- Hire a local law firm specializing in IPR. See for example, <http://www.legal500.com>, which lists the various law firms, specializing in different areas of law in India
- Get clearance searches conducted in the Indian Trade Marks Registry in the classes that are of interest to you including the ancillary classes.
- Get common law searches (this includes the internet, market surveys, yellow pages and directories) conducted to ascertain whether third parties are using your trademarks and if so, the extent of such use.
- Based on this information and after seeking the local counsel's opinion decide if the trademark is available for use or not. Should the trademark be available for use, immediately apply for the registration. The rights holder should also consider hiring a watching service to monitor the trademark journals in order to alert them to any published, deceptively similar trademarks or descriptive trademarks that might be of concern.
- Should the rights holder own a trademark that has been used and has acquired goodwill and reputation, it is advisable that along with filing of the trademark application in India, they should also make press releases, publish cautionary notices and advertise the mark to ensure that the relevant section of the public is aware that they are entering the Indian market and are protecting their trademark from any kind of third party violation.
- It is also important that the rights holder not only register trademark in India but also in the Indian sub-continent i.e. in the territory of Pakistan, Sri Lanka, Bangladesh, Nepal, Bhutan, Maldives, Afghanistan and Burma. These countries are in close proximity to each other and as India is the biggest market amongst all of them, any trademark, which acquires goodwill and reputation in India, is likely to be copied in these markets. This could lead to not only counterfeit products being manufactured in these countries but also result in counterfeit goods being imported to India and various other countries across the world.
- The rights holder should also take immediate steps to register their domain names [top level domain names (tLDs) including country coded top level domain names (ccLDs)] in the Indian sub-continent, as there have been many instances of third parties registering domains for certain well known marks with the intention of extracting money by selling these domain names to the rights holders.
- Should the rights holder discover that their trademark is being infringed, they should take immediate steps to protect their trademark, either by the means of filing oppositions, cancellations, conducting investigations, sending cease and desist notices or initiating appropriate civil and criminal actions.

Who can apply and what can be registered

Under The Trade Marks Act, 1999 a person who is the proprietor of the trademark can apply for the registration of its mark for goods as well services. Any word, signature, name, logos,

label, numerals or combination of colors used by one enterprise on goods or services can be registered as a trademark in India. Under the Indian trademark law the following are the types of trademarks that can be registered:

- Product trademarks: are those that are affixed to identify goods.
- Service trademarks: are used to identify the services of an entity, such as the trademark for a broadcasting service, retail outlet, etc. They are used in advertising for services.
- Certification trademarks: are those that are capable of distinguishing the goods or services in connection with which it is used in the course of trade and which are certified by the proprietor with regard to their origin, material, the method of manufacture, the quality or other specific features
- Collective trademarks: are registered in the name of groups, associations or other organizations for the use of members of the group in their commercial activities to indicate their membership of the group.

Any person claiming to be the proprietor of a trademark may apply in writing for registration.

The trademarks that cannot be registered

The following are the types of marks that cannot be registered in India:

- Not capable of distinguishing the goods or services of one person from those of another person;
- Consisting exclusively of marks or indications which may serve in trade to designate the kind, quality, quantity, intended purpose, values, geographical origin or the time of production of the goods or rendering of the service or other characteristics of the goods or service
- Has become customary in the current language
- Of such nature as to deceive the public or cause confusion
- Contains or comprises of any matter likely to hurt the religious susceptibilities of any class or section of the citizens of India
- Comprises or contains scandalous or obscene matter;
- Its use is prohibited under the Emblems and Names (Prevention of Improper Use) Act, 1950. The list of the marks that can not be used as a trademark under this Act is [http://www.legalhelpindia.com/bareacts/THE%20EMBLEMS%20AND%20NAMES%20\(PREVENTION%20OF%20IMPROPER%20USE\)%20ACT,%201950.doc](http://www.legalhelpindia.com/bareacts/THE%20EMBLEMS%20AND%20NAMES%20(PREVENTION%20OF%20IMPROPER%20USE)%20ACT,%201950.doc)
- Consists exclusively of the shape of goods, which results from the nature of the goods themselves, or the shape of goods that is necessary to obtain a technical result or the shape, which gives substantial value to the goods.
- A word that is a commonly used and accepted name of any single chemical element or any single chemical compound in respect of a chemical substance or preparation or which is declared by the World Health Organization and notified in the prescribed manner by the Registrar from time to time, as an international non-proprietary name or which is deceptively similar to such name
- A generic term

Registration Procedure

The registration procedure in India is based on the 'first to file' system. It is therefore important that the rights holder apply for the registration of its mark as soon as possible. The

registration of a trademark in India typically takes about 2 to 3 years, subject to the trademark not being opposed by a third party[2]. The Office of the Controller General of Patents, Trade Marks, Industrial Designs and Geographical Indications is the appropriate office for filing of a trademark application in India. This office has branches in Mumbai, Delhi, Chennai, Ahmedabad and Kolkata. A trademark application may be filed in any of these offices based on the territorial jurisdiction. The different steps that are involved in the registration process in India are as follows:

- Select a trademark agent in India:

The trademark law in India allows the proprietor to file a trademark application only if they have a place of business in India. Should that not be the case, the rights holder will be required to file an application through a trademark agent/attorney. The trademark agent/attorney can do a trademark search, prepare, file and prosecute applications.

- To determine if the mark is eligible and available for registration:

The trademark agent will determine if the trademark is eligible for registration and also conduct clearance searches to determine if there is any deceptively similar mark that already exists on the Register of Trade Marks as maintained in the office of the Controller General. It is advisable that a common law search should also be conducted in order to ascertain if there are any third parties that might already be using the trademark.

- Completing the application form and filing

The trademark agent can complete and sign the application form, provided that the rights holder has issued a signed Power of Attorney appointing them as the trademark agent. The trademark agent would require information such as the name and description of the proprietor, address of principal place of business, a description of the goods and services associated with the mark, whether the mark has been used in commerce and a copy of the trademark in order to enable them to fill the form. Copies of all the forms are available at http://ipindia.nic.in/tmr_new/first_schedule_forms/the_first_schedule.htm. The application should be filled in either English or Hindi and should be filed at the appropriate office of the Trade Marks Registry. India being a signatory to the Paris convention recognizes foreign priority. An Applicant can accordingly claim priority from an application that might have been filed in another signatory country provided that the application in India is filed within six months of the filing of that application. Typical Indian law firms will charge around Rs. 10000 to Rs. 15000 for filing a trademark application in one class. These charges vary from firm to firm depending on the structure and the internal policy of the firm. Most of the law firms are open to giving discounts for bulk filings. Filing fees are approximately Rs. 3000 per class.

Furthermore, India has recently started accepting trademark applications electronically. The trademark application can be filed electronically through the website www.ipindiaonline.gov.in/etmr/.

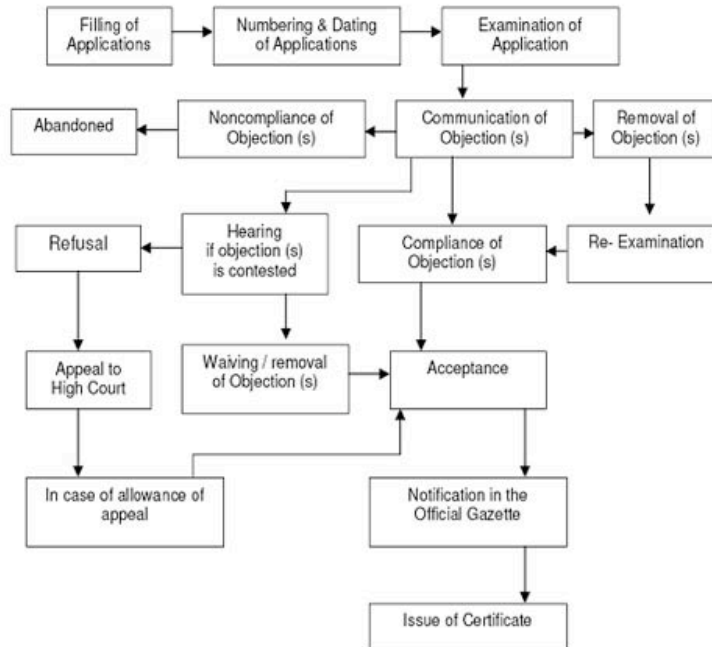
- Review by the Trade Marks Office

After the application has been filed, the Trade Marks Office reviews it to ensure that it is complete in all respects and thereafter allots an application number to the applications. If the trademark is registered, the application number becomes the registration number.

- Preliminary Approval and Publication, Show Cause hearing or Rejection of the Application

During the process of examination the Trade Marks Office determines if the trademark is barred for registration either under absolute grounds for refusal and/or relative grounds for refusal as prescribed in The Trade Marks Act, 1999. Accordingly, they issue an examination

report and the Applicant must respond to the objections that have been raised in the examination report within a period of one month from the issuance of the examination report. Thereafter and based on the response to the examination report that has been filed by the



Applicant, the Registrar of Trade Marks determines if the application should be refused, accepted for advertisement, accepted subject to certain limitations or put up for a “show cause” hearing, during which the application might be accepted, rejected or accepted subject to certain limitations. Should the application be rejected the Applicant can approach the Intellectual Property Appellate Board to appeal the order of the Registrar of Trade Marks.

- Registration

Within three months of the publication of the trademark in the Trade Marks Journal, should the trademark not be opposed by a third party, it will proceed for registration and the Trade Marks Registry will accordingly issue a registration certificate.

- Term of Trademark Registration

Trademark protection in India is perpetual subject to renewal of the registration after every 10 years. The application for renewal can be filed six months before the expiry of the validity period of the trademark.

The flow chart of the process for registration that is followed by the Trade Marks Registry is as follows: [3]

Should the rights holder of a trademark come across a trademark that is deceptively similar to their mark and which has been published in the Trade Marks Journal they can oppose the impugned mark within three months of the publication of the journal. The opposition proceedings in India maybe initiated by a party in order to maintain the purity of the Register of Trade Marks, regardless of whether they have any *locus standi*. Therefore, any third party who is of the opinion that the advertised mark should not be allowed to register can initiate an opposition proceeding by filing a Notice of Opposition in the appropriate office of the Trade

Marks Office. The Notice of Opposition should be sent to the Trade Marks Office in triplicate. It is imperative to note that during the opposition proceedings the Trade Marks Office adheres to strict deadlines and any delay in filing the Notice of Opposition or evidence will adversely affect the opposition proceedings.

In case a registered trademark owned by a third party infringes the rights of the rights holder, the rights holder can initiate cancellation/rectification proceedings against the registered owner. Furthermore, any trademark that has not been used for five years and three months from the date of registration in India is open to cancellation on the ground of non-use of the mark.

Infringement & Enforcement Remedies

A registered trademark is said to be infringed in the following circumstances:

- If a mark which is identical with, or deceptively similar to, the registered trademark is used in relation to the same or similar goods or services;
- If the use of the identical/similar mark for identical/similar goods or services is likely to cause confusion on the part of the public, or which is likely to have an association with the registered trademark;
- If the use of the identical/similar mark for different goods or services is likely to take unfair advantage of or be detrimental to the reputation of the registered trademark in India, cause confusion on the part of the public or which is likely to have an association with the registered trademark;
- If a third party uses the registered trademark, as his trade name or part of his trade name, or name of his business concern or part of the name, of his business concern for goods or services in respect of which the trademark is registered;
- If the registered trademark is applied to a material intended to be used for labeling or packaging goods, as a business paper, or for advertising goods or services, provided such person was not duly authorized by the proprietor of the trademark to do so;
- If a trademark is advertised and if (a) it takes unfair advantage of and is contrary to honest practices in industrial or commercial matters; or (b) is detrimental to its distinctive character; or (c) is against the reputation of the trademark.
- If the distinctive element of a registered trademark consist of or includes words, and another mark creates consumer confusion when spoken or visually represented

Being a signatory to the Paris Convention and TRIPS, the India recognizes the concept of a well-known mark. A mark, which has been designated as a well-known mark, is accorded stronger protection because of this status. Under the provisions of The Trade Marks Act, 1999, the factors that go into determining whether a trademark is a well-known mark are as follows:

- The knowledge or recognition of that trademark in the relevant section of the public including knowledge in India obtained as a result of promotion of the trademark;
- The duration, extent and geographical area of any use of that trademark;
- The duration, extent and geographical area of any promotion of the trademark, including advertising or publicity and presentation, at fairs or exhibition of the goods or services to which the trademark applies;
- The duration and geographical area of any registration of or any publication for registration of that trademark under this Act to the extent they reflect the use or recognition of the trademark;

- The record of successful enforcement of the rights in that trademark, in particular, the extent to which the trademark has been recognized as a well-known trademark by any court or Registrar under that record.

Though under the provisions of the Trade Marks Act, 1999 the Registrar of Trade Marks is required to maintain a register of the marks that have been designated, as well-known trademark, the Registrar of Trade Marks has not yet commenced this. It is expected that this register will be extremely helpful to rights holder.

The Trade Marks Act, 1999 provides for both civil and criminal remedies. With the coming in force of the Act, a new appellate body known as the Intellectual Property Appellate Board has been created. Appeals from the Office of the Controller General of Patents, Trade Marks, Industrial Designs and Geographical Indications now go to the Appellate Board instead of the High Courts. This has been done with the purpose to reducing the backlog of cases and for increasing IP expertise at the Appellate level.

Civil Litigation: A suit can be initiated either under the laws of passing off or for infringement under The Trade Marks Act, 1999 depending on whether the trademark is unregistered, pending registration or registered respectively.

- Jurisdiction and Venue: The suit for passing off and/or infringement can be initiated either in the District Court or in the High Court depending on the valuation of the suit. The suit can be at the place where the rights holder or one of the rights holders actually and voluntarily reside or work for gain or carries on business.
- Elements of the Complaint: In the Complaint the rights holder is required to demonstrate that (a) the alleged infringing act involves a mark that is identical or similar to a trademark of the rights holder; (b) the infringing representation of a the trademark is being used in connection with goods or services and might lead to confusion in public regarding the origin of the infringing goods/services; (c) the unlawful act interfered with the trademark holder's rights of exclusive use or caused the rights holder economic loss
- Statue of Limitation: As a general policy in India, as is prescribed in the Limitation Act, the rights holder has a period of three years from the cause of action for filing the suit. However, as trademark infringement is a continuing offence and the infringer violates the exclusive proprietary right of the rights holder every time he commits a discreet infringing act, the infringing period will run anew with each new act. Nevertheless, it is advisable that the legal action be initiated against the infringer as promptly as possible in order to establish the seriousness of the rights holder's intent before the Court.
- Ex-parte Interim Injunction: Most Indian courts will grant ex-parte interim injunctions. Ex-parte interim injunction is a temporary injunction granted without any notice to the infringer restraining him from using the infringing mark during the pendency of the trial. . This injunction is normally granted at the early stages of the trial and many a times on the first date of hearing itself, provided that the rights holder is able to establish its rights before the Court and prove the gravity of the offence merits immediate consideration.
- Appointment of the Local Commissioner: Depending on the facts of the case it is also advisable to ask the Court to appoint a local commissioner on the first date of the hearing who will raid the premises of the infringer where the infringing good are stored in order to seize the goods.

- Damages: There has been a change in the Indian judicial system in recent times with some of the courts granting damages to the rights holders. However, such cases are still few and far between and the amount of damages not substantial. One of the landmark judgments awarding damages for infringement of trademark was the case of Time Incorporated v. Lokesh Srivastava and Anr. {2005 (30) PTC 3 (Del)}. In this matter the Delhi High Court awarded Rs. 5 lakhs in favor of the Plaintiffs and against the Defendants on account of damages to the goodwill and reputation of Time Incorporated. The Court also passed a decree of Rs. 5 lakhs in favor of the Plaintiffs and against the Defendants as punitive and exemplary damages for flagrant infringement of the Plaintiffs' trademarks and copyrights by the Defendants.

Criminal Litigation: The Trade Marks Act, 1999 provides for remedies for infringement under the criminal laws too.

Under the trademark laws, the police have the power to *suo moto* conduct raids and seizure operations. However, the use of such powers by the police is minimal.

Under the criminal laws, should the rights holder not be aware of the details (name, address, dates of infringement, etc.) of the infringers, it is advisable to procure a general search and seizure warrant from the local magistrate and thereafter organize search and seizure operations in that area. In the alternative, should the rights holder be aware of the details of the infringer a complaint can be lodged with the police authorities and raids organized accordingly. In a criminal proceeding the litigation is between the State and the infringer and therefore the rights holder has a limited role to play. The maximum imprisonment that an infringer can get under The Trade Marks Act, 1999 is up to three years with a fine of up to Rs. three lakhs. However criminal sentences are rare.

Provisions under the Customs Laws: Besides the civil and the criminal remedies mentioned herein above, there are also certain provisions under the trademark law and the customs law which prohibit the importation of infringing goods in India. The Customs Authorities have recently promulgated guidelines known as the Intellectual Property Rights (Imported Goods) Enforcement Rules, 2007, under which the rights holder can record their registered trademarks with the Customs authorities. These guidelines authorize the Custom officials to seize goods infringing the trademarks of the rights holder at the border without obtaining any orders from the court^[4]. Under these rules, the Custom authorities have initiated a recordation system using which the rights holder may give a notice in writing to the Commissioner of Customs or any other Customs officer authorized by the Commissioner at the port of import of infringing goods requesting the suspension of clearance of goods suspected to be infringing the trademarks of the rights holder. Subsequent to the filing of such notice, the Commissioner is bound to notify the rights holder within the prescribed time regarding the acceptance or rejection of this notice. In case of acceptance of the notice, the normal period of validity of such registration is one year during which assistance will be rendered by the Customs authorities to the rights holder to prohibit the importation of infringing goods at the border. After the grant of this registration the importation of goods that infringe the rights holder trademarks are deemed to be prohibited, as has been defined under The Customs Act, 1962. The Customs officers have the authority to suspend the clearance of such prohibited goods either at the information received by the rights holder or by initiating *suo moto* action, provided they have *prima facie* evidence or reasonable grounds to believe that the imported goods are goods infringing the trademarks of the rights holder. After the clearance of the suspected goods is suspended the Customs authorities have to inform the rights holder of the

same and should the rights holder not execute the requisite bond and join the proceedings against the importer within the prescribed period the Customs authorities will release the suspended goods. These rules also empower the Custom officers to destroy the suspended goods under official supervision or dispose them outside the normal channels of commerce after it has been determined that the goods detained have infringed the trademarks of the rights holder and that no legal proceeding is pending in relation to such determination. These rules also prohibit the re-exportation of the goods infringing trademarks in an unaltered state.

Expected Developments

It is expected that the system of electronic prosecution of trademark applications will commence shortly in India. The Trade Marks Office is in the process of gearing up for the launch of this system. Moreover, it is also expected that the Office of Trade Marks will commence maintaining a register of well-known marks shortly thus making the protection of the marks that have been designated as well-known marks much easier. Furthermore, a bill has been introduced in the lower house of the Parliament to amend the Trade Marks Act, 1999 to include provisions regarding the filing of trademark applications under the Madrid Protocol. The bill is likely to be passed in a few months. Moreover, the Customs authorities are also in the process of upgrading their information technology infrastructure so that they can accept notices from rights holder electronically.

Trademark Legislations in India

The Trade Marks Act, 1999 along with The Trade Marks Rules, 2002

International Treaties to which India is a signatory

Paris Convention for the Protection of Industrial Property

Nairobi Treaty on the Protection of the Olympic Symbol

Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS)

Trademarks Related Websites

<http://www.dipp.nic.in>

<http://ipindia.nic.in/>

<http://www.cbec.gov.in/>

<http://www.wipo.int/trademarks/en/>

<http://www.uspto.gov>

FAQs

1. Must I sell my products or offer my services in India before I seek protection?

No, Indian trademark law allows filing of a trademark application in India on an 'intent-to-use' basis. However the registered proprietor of the trademark in India has to commence use of the mark within 5 years and 3 months of the date of registration. Otherwise the registered trademark is open to invalidation proceedings.

2. How do I file for a trademark in India?

The procedure for the registration of the trademark is described under the section 'Registration Procedure'

3. What is the filing fee?

The official filing fee for filing one trademark application in one class and without claiming priority is Rs. 2500/-. The details of the official filing fees for various kinds of applications can be found at http://ipindia.nic.in/tmr_new/first_schedule_forms/the_first_schedule.htm.

4. What are the typical costs for representation in India?

The attorney charges for filing the application will depend on the trademark agent/attorney that you will hire. However typically the filing of a trademark application in one class without claiming priority, will range between Rs. 10000 to Rs.15000.

5. Can I file a single application for use of my mark on more than one good or in association with more than one service in India?

Yes. India recognizes the system of multi-class applications and follows the International Classification. There are 42 classes in which the goods and services have been divided in India and you can file for multi-class applications both for goods and services.

6. I have a design logo and want to apply for the registration of the same for identical goods and services in black and white as well color. Can I do so in one application?

Yes. You can do so in one application as India recognizes the system of series application.

7. What is the duration of a trademark in India?

A trademark in India is valid for 10 years and can be renewed thereafter indefinitely for periods of 10 years.

8. What should I do if a competitor has already registered my mark in India?

The Indian trademark law provides for invalidation proceedings and you have the right to initiate a cancellation action should a competitor have registered your trademark in India. You also have the right to initiate either a civil or a criminal action against any party that is violating your mark in India.

9. Who can use the symbol ® in India?

Only the proprietor of a trademark whose trademark has been registered in India can use the symbol ® in India. Using the symbol ® unless your mark has been registered in India is unlawful.

10. When can the symbol ™ be used in India?

Using this symbol with your trademark simply implies that you claim to be the proprietor of the trademark. There is no prohibition on the use of the symbol ™ in India.

11. What is the penalty that is prescribed under the criminal laws for infringement of a trademark in India?

The penalty for selling or providing services using a false trademark is a minimum of six months and maximum of three years and with fine not less than Rs. fifty thousand but which may extend to Rs. two lakh .

[1] See TRIPS article 15

[2] Before the coming into force of the new Act, some applications have been known to be pending for periods as long as 15 years.

[3] Source: www.patentoffice.nic.in

[4] <http://www.cbec.gov.in/customs/cs-act/notifications/notfns-2k7/csnt47-2k7.htm>

Designs

Introduction to Designs

An industrial design registration protects the ornamental or aesthetic aspect of an article. Designs may consist of three-dimensional features, such as the shape or surface of an article, or of two-dimensional features, such as patterns, lines or color. Designs are applied to a wide variety of products of different industries like handicrafts, medical instruments, watches, jewelry, house wares, electrical appliances, vehicles and architectural structures. An industrial design is primarily for aesthetic features. They do not protect any technical features of an article. Industrial design protection precludes any trademark or artistic work.

The first design related legislation in India was passed by the British Government and was known as the Designs Act, 1911. The Designs Act, 2000, has since replaced this Act. The Designs Act, 2000 and the Designs Rules, 2001 presently govern the design law in India.

The registration of an industrial design in India gives the proprietor an exclusive right to sell, import and apply it to any article. Design rights are granted on a country-by-country basis, with an Indian registration providing protection only in India. If the rights holder wishes to protect a design in other countries, then it will have to seek protection in each country separately under the relevant law. India has not yet acceded to the Hague System for the International Registration of Industrial Designs, which gives the owner of an industrial design the possibility to have its design protected in several countries by simply filing one application in one language with the International Bureau of WIPO.

Market Entry Planning

India follows the system of "first-to-file." Therefore, it is imperative that a rights holder applies for the registration of its design at the earliest opportunity to ensure that no other person can claim prior rights to the design. Furthermore, an application for design in India has to be filed before publication of the design, in order to be eligible for registration. The Delhi High Court in *Wimco Ltd., Bombay v. Meena Match Industries, Sivakasi & Other* {1983 (3) PTC 373 (Del.)}, stated that, "[p]ublication within the meaning of the Act means the opposite of being kept secret. It is published if the design is no longer a secret. There is publication if the design has been disclosed to the public or the public has been put in possession of the design. Russell-Clarke in *Copyright in Industrial Design, Fourth Ed.* (pages 41-42) says:

"...It is sufficient, and there will be 'publication' if the knowledge was either:

- (1) Available to members of the public; or
- (2) Actually in fact shown and disclosed to some individual member of the public who was under no obligation to keep it secret.

It is not necessary that the design should have been actually used. There will just as much be publication if it is shown that it was known to the public, without ever having been actually put in use. Thus, publication may be of two types:

- (a) Publication in prior documents
- (b) Publication by prior user"

It is advisable that Applicants include the following strategies as a part of their comprehensive overall strategy for protection:

- Hire a local law firm specializing in IPR. See for example, <http://www.legal500.com>, which lists the various law firms, specializing in different areas of law in India.

- Apply for a clearance search at the Patents Office in order to ensure that rights holder's design is available for registration.
- Should the design be available for registration, applicants should immediately apply for registration.
- After the design has been registered, rights holders should ensure that the article on which the design is being used clearly mentions the word "Registered" (or any of its abbreviations) along with the Design Registration number. This is to inform the public that the design is registered and that the rights holder has the exclusive proprietary right to use the same. Should the rights holder not do this, in case of any infringement, the rights holder will have to prove that the infringer was aware that he was violating the rights holder's exclusive proprietary rights when he used the infringing design.
- Should a rights holder discover that its design is being infringed, the rights holder should take immediate steps to protect its design, either by the means of filing cancellations, conducting investigations, sending cease and desist notices or initiating other appropriate legal actions.

What can be registered as a design and who can apply

Any person (including a partnership firm or a body corporate) claiming to be the proprietor of the design can apply for its registration so long as the design is:

- New or original;
- Not previously published in any country;
- Reproducible by industrial means;
- Not contrary to public order or morality;
- Significantly distinguishable from known designs or combination of known designs;
- Not comprised of or containing scandalous or obscene matter;
- Appealing to the eye; and
- Not including anything that is in substance a mere mechanical device.

Registration Procedure

The registration of a design in India is as follows:

- Select a IPR law firm in India
The designs law in India allows the proprietor to file a designs application only if they have a place of business in India. Should that not be the case, the rights holder will be required to file an application through an attorney/agent. The attorney/agent can do a designs search, prepare, file and prosecute an application.
- Conduct a design search in order to ascertain the availability of the design
Should the design be available for registration, the rights holder - or its attorney/agent - can proceed with the filing of the application in India
- Preparing the documents and filing the application
The application can be filed directly by the Applicant or its assignee or its attorney/agent in the prescribed form. The details that are required in the application form include the name, address and nationality of the rights holder; the class in which the design is to be filed; representation of the design; name of articles to which the design is to be applied; address for service in India and priority details in case the rights holder is claiming priority from a Paris Convention application. The application has to be signed by the Applicant or their attorney/agent. The format of the application to be filed is

available at <http://www.patentoffice.nic.in/ipr/design/designform.htm>. The designs under the Indian law have been categorized in separate classes in order to provide for systematic registration. An International classification of Industrial Designs according to the Locarno Agreement is followed in India and this classification of goods is based upon the function of the goods. Presently there are 32 classes (Classes 1 to 31 and 99), which are further divided into sub-classes. The classification of goods as followed in India is available at http://www.patentoffice.nic.in/ipr/design/des_rule.PDF. The application can be filed at the Patents Offices in Kolkatta, Mumbai, Delhi, and Chennai.

- **Review by Designs Office**
After the application has been filed, the Patent Office reviews it to ensure that it is complete in all respects and thereafter allots an application number to the application.
- **Examination of the Application**
During the process of examination, the Patent Office determines if the design is barred for registration. Accordingly, it may issue a statement of objections and the Applicant must respond to the objections that have been raised within a period of three months from the official communication of objection. Should the Applicant not respond to the objections within this time frame, the Applicant is deemed to have withdrawn its application. Thereafter, based on the response to the objections that have been filed by the Applicant, the Controller of Designs determines if the application should be refused, accepted or put up for a hearing. Should the application be rejected, the Applicant may appeal the order of the Controller of Designs at the High Court.
- **Registration**
Following acceptance of an application, the Controller of Designs may direct the registration of the design. The particulars of the application and the representation of the articles to which the design has been applied will be published in the Official Gazette. After the registration of the design, the particulars are entered in the Register of Designs. Typically it takes about 6 to 12 months for the design to be registered.
- **Term of Designs Registration**
A design registration is valid for a period of 10 years from the date of registration. This is renewable for a period of 5 years.

The flow chart of the process for registration that is followed by the Designs Office is as follows¹:

After the design has been registered, any party aggrieved by the registration of the design may file an application for its cancellation. The application for cancellation has to be filed in the prescribed format and has to be accompanied by a statement setting out the nature of the Applicant's interest and the facts on the basis of which his application is based. The registered proprietor of the design can contest the cancellation application and after the Controller of Design has examined the evidence and heard both the parties, the matter will be decided and the decision conveyed to the parties.

Any aggrieved person can also initiate a rectification proceeding before the Controller of Designs on the grounds of non-insertion in, or omission from, the register of designs of any entry, by any entry made in such register without sufficient cause, by an entry wrongly remaining on such register or by an error or defect in any entry in such register. After following

the prescribed procedure, the Controller of Designs can make an order for making, expunging or varying such entry as he thinks fit.

Piracy & Enforcement Remedies

The following acts, if made without the consent of the registered proprietor and during the term when the copyright in the design subsists, are considered to be piracy:

- For the purpose of sale, to apply or cause to be applied to any article in any class of articles in which the design is registered, the design or any fraudulent or obvious imitation thereof, or to do anything with a view to enable the design to be so applied;
- To import for the purposes of sale, without the consent of the registered proprietor, any article belonging to the class in which the design has been registered and having applied to it the design or any fraudulent or obvious imitation thereof; or
- To publish or expose or cause to be published or cause to be exposed for sale the article, knowing that the design or any fraudulent or obvious imitation thereof has been applied to any article in any class of articles in which the design is registered.
-
- If a person commits any act of piracy as mentioned above, he shall be liable for every contravention to pay to the registered proprietor of the design a sum not exceeding Rs. 25,000/- subject to a maximum of Rs. 50,000/- recoverable as contract debt in respect of any one design or the registered proprietor can initiate a suit against the infringer.
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- Civil Litigation: A suit for infringement can be initiated under the Designs Act, 2000.
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- Jurisdiction and Venue: A suit for infringement and/or passing off can be initiated either in the District Court or in the High Court depending on the valuation of the suit. The suit can be at the place where the rights holder or one of the rights holders actually and voluntarily reside or work for gain or carries on business.
- Elements of the Complaint: In the Complaint, the rights holder is required to demonstrate that the alleged infringing act involves a design that is identical or similar to the design of the rights holder and that the unlawful act interfered with the rights holder's rights of exclusive use or caused the rights holder economic loss
- Statute of Limitation: As a general policy in India and as prescribed under the Limitation Act, the rights holder has a period of three years from the cause of action for filing the suit. However, as design infringement is a continuing offence and the infringer violates the exclusive proprietary right of the rights holder every time he commits a discreet infringing act, the limiting period will run anew with each new act. Nevertheless, it is advisable that the legal action be initiated against the infringer as promptly as possible in order to establish the seriousness of the rights holder's intent before the Court.
- Ex-parte Interlocutory Injunction: Most Indian courts will grant ex-parte interlocutory injunctions provided that the rights holder is able to establish its rights before the Court and establish the gravity of the offence and that the violation of its proprietary rights merits immediate consideration. Ex-parte interlocutory injunction is a temporary injunction granted for the course of the trial restraining the infringer from using the infringing design, without any notice to the infringer.

- Appointment of the Local Commissioner: Depending on the facts of the case, it is also advisable to ask the Court to appoint a local commissioner on the first date of the hearing to raid the premises of the infringer where the infringing goods are stored, in order to seize the goods.
- Damages: There has been a change in the Indian judicial system in recent times with some of the courts granting damages to rights holders for violation of their intellectual property rights, though such cases are still few and far between.

Provisions under the Customs Laws: Besides the civil and the criminal remedies mentioned herein above, there are also certain provisions under the customs law which prohibit the importation of infringing goods in India. The Customs Authorities have recently promulgated guidelines known as the Intellectual Property Rights (Imported Goods) Enforcement Rules, 2007, under which the rights holder can record its registered designs with the Customs authorities. These guidelines authorize the Custom officials to seize goods infringing the designs of the rights holder at the border without obtaining any orders from the court. Under these rules, the Customs authorities have initiated a recordation system under which the rights holder may give a notice in writing to the Commissioner of Customs or any other Customs officer authorized by the Commissioner at the port of import of infringing goods requesting the suspension of clearance of goods suspected to be infringing the design of the rights holder. Subsequent to the filing of such notice, the Commissioner is bound to notify the rights holder within the prescribed time regarding the acceptance or rejection of this notice. In case of acceptance of the notice, the normal period of validity of such registration is one year during which assistance will be rendered by the Customs authorities to the rights holder to prohibit the importation of infringing goods at the border. After the grant of this registration the importation of goods that infringe are deemed to be prohibited, as has been defined under The Customs Act, 1962. The Customs officers have the authority to suspend the clearance of such prohibited goods either based upon the information received by the rights holder or by initiating *suo moto* action, provided they have *prima facie* evidence or reasonable grounds to believe that the imported goods are goods infringing the design registration. After the clearance of the suspected goods is suspended, the Customs authorities must inform the rights holder. Should the rights holder not execute the requisite bond and join the proceedings against the importer within the prescribed period, the Customs authorities will release the suspended goods. The rules also empower the Customs officers to destroy the suspended goods under official supervision or dispose them outside the normal channels of commerce after it has been determined that the goods detained have infringed the design of the rights holder and that no legal proceeding is pending in relation to such determination. The rules also prohibit the re-exportation of the goods infringing the industrial design in an unaltered state.

Expected Developments

It is expected that a 'National Design Policy' will soon be in place in India. The Department of Industrial Policy and Promotion has initiated a consultative process with industry, designers and other stakeholders for formulating this policy. Under this policy, the Government proposes to strengthen design education at different levels, encourage use of designs by small scale and cottage industries and crafts, facilitate active involvement of industry and designers in the development of the design profession, position and brand Indian designs within India and overseas, enhance design and design service exports and create an enabling environment that recognizes and rewards original designs.

Moreover, it is expected that the Customs authorities will soon begin to accept notices from rights holders electronically. The Customs authorities are in the process of upgrading their information technology infrastructure to enable them to do so.

Designs Legislation and Regulation in India

The Designs Act, 2000

The Designs Rules, 2001

International Treaties to which India is a signatory

Paris Convention for the Protection of Industrial Property

Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS)

Designs Related Websites

<http://www.dipp.nic.in>

<http://ipindia.nic.in/>

<http://www.wipo.int/designs/en/>

<http://www.uspto.gov>

FAQs

1. What is the duration of the registration of a design? Can it be extended?

The duration of the registration of a design is initially ten years from the date of registration, but in cases where a claim to priority has been allowed, the duration is ten years from the priority date. This initial period of registration may be extended by a further period of 5 years on an application made to the Controller of Designs before the expiry of the initial period of Copyright. The rights holder may make an application for such extension as soon as the design is registered.

2. Is marking of an article with the word REGISTERED or with the abbreviations REGD or RD along with the design registration number compulsory in the cases of article to which a registered design has been applied?

Yes it is compulsory for the registered proprietor to mark the article as otherwise the registered proprietor would not be entitled to claim damages from any infringer. This would be essential to establish that the rights holder took all requisite steps to ensure the marking of the article. In the alternative the rights holder would have to establish that the infringer knew of or had received notice of the existence of the copyright in the design before the act of infringement took place. This provision is exempted for textile goods in which the design is woven or printed and for articles made of charcoal dust.

3. Is it necessary that an article by industrial process or means have been made before the application for registration of design is applied?

No, it is not necessary that an article should have been made by industrial process before the filing of the application for the registration of the design.

4. Are the registered designs open for public inspection?

Yes, registered designs are open for public inspection after they have been published in the official gazette on payment of prescribed fee in the prescribed format.

5. What is the fee for filing of an application for the registration of the design?

The filing fee for filing of an application for one design is Rs. 1000

6. Is it possible to transfer the rights in the design to another party?

Yes, it is possible to transfer the rights in the design to another party either through an assignment, transmission or license.

7. Can the rights holder file the application for registration of the design directly or does it have to be filed through an attorney?

The rights holder can file the application either directly or through an attorney. However for foreign nationals or entities that do not have a principal place of business in India, the application has to be filed through their agent (i.e. the address for service has to be based in India).

8. What are the artistic works that cannot be registered as a design in India?

The artistic works that fall within the purview of Section 2(c) of the Copyright Act, 1957 cannot be registered as a design. These artistic works mean:

- a painting, a sculpture, a drawing (including a diagram, map, chart or plan), an engraving or a photograph, whether or not any such work possesses artistic quality;
- a work of architecture; and
- any other work of artistic craftsmanship.

1 Source: http://www.patentoffice.nic.in/ipr/design/designs_filing.pdf

2 <http://www.cbec.gov.in/customs/cs-act/notifications/notfns-2k7/csnt47-2k7.htm>

3 See http://dipp.nic.in/design_policy/national_design_policy.pfd

Geographical Indications of Goods

Introduction to Geographical Indications

"Geographical indications are...indications, which identify a good as originating in the territory... or a region or locality in a territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin." It can also be defined as a sign used on goods that have a specific geographical origin and possess qualities or a reputation that is due to that place of origin. Most commonly, a geographical indication consists of the name of the place of origin of the goods. For example, "Champagne," "Cognac," and "Tuscany" are geographical indications designating the specific geographical origin from which they originate. Agricultural products typically have qualities that derive from their place of production and are influenced by specific local factors, such as climate and soil.

Under the TRIPS Agreement, countries are under no obligation to extend protection to a particular geographical indication unless that geographical indication is protected in the country of its origin. Prior to 2003, India did not protect geographical indications of Indian origin. In order to comply with India's obligations in the TRIPS Agreement, it enacted the Geographical Indications of Goods (Registration & Protection) Act, 1999, which came into force with effect from 15th September 2003. The present geographical indications regime in India is governed by the Geographical Indications of Goods (Registration & Protection) Act, 1999 and the Geographical Indication of Goods (Regulation and Protection) Rules, 2002.

By registering a geographical indication in India, the rights holder can prevent unauthorized use of the registered geographical indication by others and promote economic prosperity of producers of goods produced in a particular region. Registration of the geographical indication in India is not mandatory as an unregistered geographical indication can also be enforced by initiating an action of passing off against the infringer. It is, however, advisable to register the geographical indication as the certificate of registration is *prima facie* evidence of its validity and no further proof of the same is required.

Market Entry Planning

It is advisable to register your geographical indications in India at the earliest time possible. This will help ensure that your exclusivity to the geographical indications is maintained and you have the right to initiate infringement action against any person who is violating your rights. The following steps should also be a part of your overall strategy for protecting your geographical indications in India:

- Hire a local law firm specializing in IPR. See for example, <http://www.legal500.com>, which lists various law firms specializing in different areas of law in India
- Besides the official search of the Register of Geographical Indications that will be conducted when you will file for registration, it is important to also get common law searches (this includes the internet, market surveys, yellow pages, directories, etc.) conducted to ascertain whether third parties are using your geographical indications and if so, to what extent.
- Based on this information and after seeking your local counsel's opinion, decide if your geographical indication is available for use or not. Should the geographical indication be available for use, immediately apply for the registration. Also you should consider hiring a watching service to monitor the trademark journals in order to alert you to any published, deceptively similar trade marks or descriptive trade marks that might be of concern to you.

- It is advisable that you also issue press releases, publish cautionary notices and advertise the geographical indication to ensure that the relevant section of the fact that you are protecting your geographical indication from any kind of third party violation.
- It is also important that you not only protect your geographical indications in India, but also in the Indian sub-continent (i.e. in the territory of Pakistan, Sri Lanka, Bangladesh, Nepal, Bhutan, Maldives, Afghanistan and Burma). These countries are in close proximity to each other and as India is the biggest market amongst all of them, the geographical indications that acquire reputation in India are likely to be copied in these markets. This could lead to not only counterfeit products being manufactured in these countries, but also these goods being imported to India and various other countries across the world.
- You should also take immediate steps to register your geographical indications as domain names [top level domain names (tLDs) including country coded top level domain names (ccLDs)] in the Indian sub-continent, as there have been many instances of third parties registering domains for certain well-known marks with the intention of extracting money by selling these domain names to the rights holders.
- Should you discover that your geographical indications are being infringed, you should take immediate steps to protect them, either by the means of filing oppositions, cancellations, conducting investigations, sending cease and desist notices or initiating appropriate civil and criminal actions.

Who can apply

Any association of persons or producers or any organization or authority established by or under any law for the time being in force representing the interest of the producers of the concerned goods can apply for the registration of the geographical indication in the prescribed format.

What cannot be registered as a geographical indication

The following are the geographical indications that cannot be registered in India:

- The use of which would be likely to deceive or cause confusion;
- The use of which would be contrary to any law for the time being in force;
- Which comprise or contain scandalous or obscene matter;
- Which comprise or contain any matter likely to hurt the religious susceptibilities of any class or section of the citizens of India;
- Which would otherwise be disentitled to protection in a court;
- Which are determined to be generic names or indications of goods and are, therefore, not or ceased to be protected in their country of origin, or which have fallen into disuse in that country; or
- Which although literally true as to the territory, region or locality in which the goods originate, but falsely represent to the persons that the goods originate in another territory, region or locality, as the case may be.

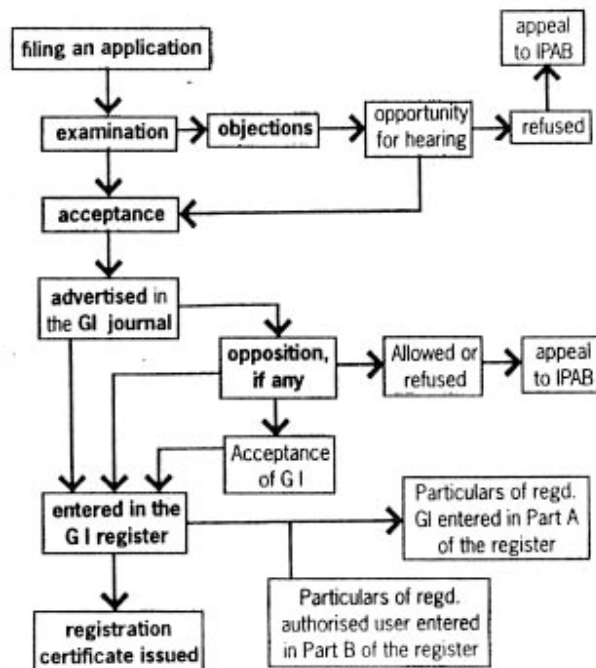
Registration Procedure

The Register of Geographical Indications is divided into two parts, part A and Part B. Part 'A' consists of particulars relating to registered geographical indications and Part 'B' consists of particulars of the registered authorized users. The various steps that the rights holder should follow for the registration of their geographical indications in India are as follows:

- Hire an IPR law firm
- It is advisable to hire a local IPR law firm, so as to get proper guidance regarding the laws and the procedures that are followed in India. For example, see www.legal500.com.
- Conduct a clearance search
- It is advisable to conduct a clearance search to ascertain if the geographical indication is available for registration in India. Should the geographical indication be available it would be advisable to register the same at the earliest.
- Preparing of documents and filing of application
- The rights holder can file a single application for registration of a geographical indication in different classes of goods as per the prescribed format. The application can be filed in the Office of Geographical Indications, Chennai. The application to be filed should contain a statement as to how the geographical indication serves to designate the goods as originating from the concerned territory of the country or region or locality in the country, in respect of specific quality, reputation or other characteristics of which are due exclusively or essentially to the geographical environment, with its inherent natural and human factors, and the production, processing or preparation of which takes place in such territory, region or locality. It should also include the class of goods to which the geographical indication shall apply, the geographical map of the territory of the country or region or locality in the country in which the goods originate or are being manufactured, the particulars regarding the appearance of the geographical indication (as to whether it is comprised of words or figurative elements or both) and any statement containing particulars of the producers of the concerned goods. The format for filing the application for geographical indications in India is available at <http://www.patentoffice.nic.in/ipr/gi/Girule~1.PDF>.
- Examination and Publication of the Application
- After the application has been filed, the examiner reviews the application and the accompanying statement of case. For purposes of examination, the Registrar of Geographical Indications ordinarily constitutes a Consultative Group of not more than seven representatives to ascertain the correction of the particulars as mentioned in the Statement of Case. Thereafter, the Registrar issues an examination report. Depending on the merits of the application and of any evidence of use, the Registrar may accept or reject the application either absolutely or subject to certain modifications. The Applicant is required to respond to the rejection or objections within two months of the receipt of the examination report failing which the application will be dismissed. After the acceptance of the application by the Registrar, either absolutely or subject to certain conditions and with or without a hearing being conducted, the application will be published.
- Opposition and Registration
- Any person may, within three months of the publication of the application to register a geographical indication, file an opposition. After serving the opposition documents on the Applicant and after examining the evidence and hearing the parties, the Registrar of Geographical Indications may decide whether and subject to what limitations or conditions the registration is to be permitted.

- The Registrar of Geographical Indications may register the geographical indication after the application has been accepted and not opposed or if opposed the opposition has been decided in favor of the Applicant. Thereafter the Registrar will issue the Registration Certificate in the prescribed format and sealed with the seal of the Geographical Indications Registry to each of the Applicant and the authorized users.
- Term of Registration
- The registration of a geographical indication is for a 10-year period, and is renewable, indefinitely.

The flow chart showing the registration process for the geographical indication is as mentioned herein below:[\[1\]](#)



Any aggrieved person can make an application to the Registrar of Geographical Indications or the Appellate Board in the prescribed manner on the ground that there has been a contravention or failure to observe the condition entered on the register, by the absence or omission from the register of any entry, or by any entry made in the register without sufficient cause, or by any entry wrongly remaining on the register, or by any error or defect in any entry in the register and after hearing both the parties the tribunal may make such order as it thinks fit.

Any person who is aggrieved by the order of the Registrar of Geographical Indications may appeal the order before the Appellate Board.

Authorized Users

Part B of the Register of Geographical Indications contains the particulars relating to the registration of authorized users. An authorized user is any person who claims to be the producer of the goods in respect of such geographical indications as have been registered

under the Act. Such person, along with the registered proprietor of the geographical indication, may apply in writing to the Registrar of Geographical Indications to register as an authorized user. A copy of the application form is available at <http://www.patentoffice.nic.in/ipr/gi/Girule~1.PDF>. This application has to be accompanied by a Statement of Case and an affidavit of how the authorized user claims to be the producer of the registered geographical indications. These documents may be accompanied by a letter of consent from the registered proprietor of the geographical indications; where such letter of consent is not furnished, a copy of the application is endorsed to the registered proprietor for information and the Registrar is intimated of due service by the proposed authorized user. The procedure followed by the Registry of Geographical Indications for examination, publication, opposition and registration of the application filed by the authorized user is the same as is followed in the case of an application for registration of the geographical indication.

Infringement & Enforcement Remedies available under the Act

A person, not being an authorized user, infringes a registered geographical indication when he uses:

- Such geographical indication by any means in the designation or presentation of
- goods that indicates or suggests that such goods originate in a geographical area other than the true place of origin of such goods in a manner which misleads the persons as to the geographical origin of such goods;
- Any geographical indication in such manner that constitutes an act of unfair competition including passing off in respect of registered geographical indication. The acts that constitute 'unfair competition' as mentioned above are:
 -
 - - all acts that are of such nature as to create confusion by any means whatsoever with the establishment, the goods or the industrial and the commercial process;
 - - false allegations in the course of the trade of such a nature as to discredit the establishment, the goods or the industrial or commercial activities, of the competitor;
 - - geographical indications, the use of which in the course of the trade is liable to mislead the persons as to the nature, the manufacturing process, the characteristics, the suitability for their purpose or the quantity of the goods; or
 - Another geographical indication for goods which, although true to the territory from which the goods originate, falsely represents that the goods originate in the territory in respect of which such registered indication relates.

In order to protect its geographical indication against unauthorized use, the rights holder may send a cease and desist notice after becoming aware of any violation. Thereafter, depending on the response of the infringer, the rights holder has the option of either initiating a civil or criminal litigation against the infringer.

Civil Action: The rights holder may initiate either infringement and/or passing off proceedings against an infringer. The infringement proceedings may be initiated if the geographical indication has been registered. However in case the geographical indication is not registered, the rights holder still has the option of initiating a passing off action against the infringer. The relief that the court may grant in the case of infringement and/or of passing off includes injunction, and at the option of the rights holder either damages or accounts of profits, delivery-up of the infringing labels and indication for destruction or erasure. One of the landmark judgments in India regarding the protection of geographical indications is Scotch

Whisky Association & Ors. v. Golden Bottling Limited {2006(32) PTC 656 (Del)}. In this case, the Delhi High Court passed an order of permanent injunction restraining the infringer from using the word 'Scot' as a part of its brand name, as it gives an impression to the unwary consumer of whisky that the product originates in Scotland or that it is Scotch Whisky.

- Jurisdiction and Venue: The suit for passing off and/or infringement can
- be initiated in any court not inferior to the District Court depending on the valuation of the suit. The suit can be at the place where the rights holder or one of the rights holders actually and voluntarily reside or work for gain or carries on business.
- Elements of the Complaint: In the Complaint, the rights holder is required to demonstrate that (a) the alleged infringing act involves a mark that is identical or similar to the GI of the rights holder; (b) the infringing representation of a geographical indication is being used in connection with goods and might lead to confusion in public regarding the origin of the infringing goods; (c) the unlawful act interfered with the rights holder's rights of exclusive use and/or caused the rights holder economic loss and/or resulted in loss of reputation and goodwill.
- Statue of Limitations: As a general policy in India, as is prescribed in the Limitation Act, the rights holder has a period of three years from the cause of action for filing the suit. However, as geographical indication infringement is a continuing offence and the infringer violates the exclusive proprietary right of the rights holder every time he commits a discreet infringing act, the infringing period will run anew with each new act. Nevertheless, it is advisable that the legal action be initiated against the infringer as promptly as possible in order to establish the seriousness of the rights holder's intent before the Court.
- Ex-parte Interlocutory Injunction: Indian courts may grant ex-parte interlocutory injunctions, provided that the rights holder is able to establish its rights before the Court, including the gravity of the offence and that the violation of its proprietary rights merit immediate consideration. Ex-parte interlocutory injunction is a temporary injunction granted for the course of the trial restraining the infringer from use of the infringing trademark, without any notice to the infringer and on the date of the first hearing itself.
- Appointment of the Local Commissioner: Depending on the facts of the case, it is also advisable to ask the court to appoint a local commissioner on the first date of the hearing who will raid the premises of the infringer where the infringing goods are stored in order to seize the goods.
- Damages: There has been a change in the Indian judicial system in recent times with the judiciary awarding some damages and costs to the rights holder because of violation of their intellectual property rights. In the case of Scotch Whisky Association & Ors. v. Golden Bottling Limited {2006(32) PTC 656 (Del)}, the Delhi High Court awarded damages to the amount of Rs. 5, 00, 000 for the violation of its Intellectual Property Rights and also awarded the sum of Rs. 3, 10, 000 as costs for the litigation.

Criminal Litigation: The Geographical Indications of Goods (Registration and Protection) Act, 1999 provides for remedies for violation of geographical indications under the criminal laws too. Under the criminal laws, if a person is convicted of an offence for applying false geographical indications or selling goods to which a false geographical indication is applied, the Court may direct the defendant to forfeit the goods to the government.

Any person who falsely applies a geographical indication, or sells goods to which false geographical indications are applied, may be punished by imprisonment for a term not less than six months but not exceeding three years with a fine, which shall not be less than fifty thousand rupees, but which may extend to two lakh rupees. No prosecution of any offence under this Act shall be commenced after the expiry of three years next after the commission of the offence charged or two years after the discovery thereof by the prosecutor, whichever expiration happens first.

Police have the power to *suo moto* conduct raids and seizure operations. However, before making any search and seizure, the police officer shall obtain the opinion of the Registrar of Geographical Indications on the facts involved in the offence and shall abide by the opinion that has been obtained.

Provisions under the Customs Laws: Besides the civil and the criminal remedies mentioned herein above, there are also certain provisions under the Customs law which prohibit the importation of infringing goods in India. The Customs Authorities have recently promulgated guidelines known as the Intellectual Property Rights (Imported Goods) Enforcement Rules, 2007, under which the rights holder can record its registered geographical indications with the Customs authorities. These guidelines authorize the Customs officials to seize goods infringing the geographical indications of the rights holder at the border without obtaining any orders from the court. Under these rules, the Customs authorities have initiated a recordation system using which the rights holder may give a notice in writing to the Commissioner of Customs or any other Customs officer authorized by the Commissioner at the port of import of infringing goods requesting the suspension of clearance of goods suspected to be infringing the geographical indications of the rights holder. Subsequent to the filing of such notice, the Commissioner is bound to notify the rights holder within the prescribed time regarding the acceptance or rejection of this notice. In case of acceptance of the notice, the normal period of validity of such registration is one year during which assistance will be rendered by the Customs authorities to the rights holder to prohibit the importation of infringing goods at the border. After the grant of this registration, the importation of goods that infringe the rights holder's geographical indications are deemed to be prohibited, as has been defined under the Customs Act, 1962. The Customs officers have the authority to suspend the clearance of such prohibited goods either at the information received by the rights holder or by initiating *suo moto* action, provided they have *prima facie* evidence or reasonable grounds to believe that the imported goods are infringing the geographical indications of the rights holder. After the clearance of the suspected goods is suspended, the Customs authorities have to inform the rights holder. Should the rights holder not execute the requisite bond and join the proceedings against the importer within the prescribed period, the Customs authorities will release the suspended goods. These rules also empower the Customs officers to destroy the suspended goods under official supervision or dispose them outside the normal channels of commerce after it has been determined that the goods detained have infringed the geographical indications of the rights holder and that no legal proceeding is pending in relation to such determination. These rules also prohibit the re-exportation of the goods infringing geographical indications in an unaltered state.

Expected Developments

The Customs authorities are in the process of upgrading their information technology infrastructure so that they can accept notices from rights holder electronically.

Geographical Indications Legislation and Regulation in India

The Geographical Indications of Goods (Registration and Protection) Act, 1999 The Geographical Indications of Goods (Registration and Protection) Rules, 2002

International Treaties to which India is a signatory

Paris Convention for the Protection of Industrial Property

Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS)

Geographical Indications Related Websites

<http://www.dipp.nic.in>

<http://ipindia.nic.in/>

<http://www.cbec.gov.in/>

http://www.wipo.int/about-ip/en/geographical_ind.html

FAQs

1. Can I register my geographical indication as a trademark too?

No. The trademark law in India bars the registration of any geographical indication as a trademark.

2. Is there a penalty for falsely representing a geographical indication as registered?

Yes. Falsely representing a geographical indication as registered is an offence under the Geographical Indication of Goods (Registration and Protection) Act, 1999. Any person who commits this offence may be punished by imprisonment for a term, which may extend to three years, by a fine or by both.

3. Where are the offices of the Registrar of Geographical Indications located in India?

The Registry of Geographical Indications in India is based at Chennai.

4. What are the categories of goods that may be protected by geographical indications?

There are 34 different classes on the basis of which the goods are classified. The classifications can be found at: <http://www.patentoffice.nic.in/ipr/gi/Girule~1.PDF>

5. What is the fee for filing an application for the registration of geographical indications?

The filing fee for filing one application in one class is Rs. 5,000

6. Can I conduct a clearance search to ascertain if the geographical indication that I propose to register is available?

Yes

7. Can I claim priority in India from an application filed in other Convention countries?

Yes

8. Can I file one application for the registration of one geographical indication in different classes of goods?

Yes. The Geographical Indications of Goods (Registration and Protection) Act, 1999 allows the filing of a multi-class application.

9. What is an Appellation of Origin and how is it different from a Geographical Indications?

An appellation of origin means the geographical name of a country, region, or locality, which serves to designate a product originating therein, the quality and characteristics of which are due exclusively or essentially to the geographical environment, including natural and human factors. All appellations of origin are geographical indications but not all geographical indications are appellations of origin. Appellation of origins are used on those goods which, along with being an indication of source, also signify the quality and the characteristics of the product which is due exclusively to the geographical environment. For example, Roquefort cheese, which is said to taste the way it does because it is matured in a certain way in the caves of Roquefort is an appellation of origin and a geographical indication.

[1] See Article 22 of the TRIPS Agreement

2 http://www.keralaindustry.org/e_magazine/geographical_indications_registr.htm

3 <http://www.cbec.gov.in/customs/cs-act/notifications/notfns-2k7/csnt47-2k7.htm>

The Protection of Plant Varieties and Farmers' Rights

Introduction to Plant Varieties and Farmers Rights

The TRIPS Agreement states that "Members shall provide for the protection of plant varieties either by patents or by an effective *sui generis* system or by any combination thereof." In order to fulfill its obligations under the TRIPS Agreement, India has implemented the Protection of Plant Varieties and Farmers' Rights Act, 2001 (hereinafter known as the "Act"). This Act has been passed in order to provide for the establishment of an effective system for protection of plant varieties, the rights of farmers and plant breeders, and to encourage the development of new varieties of plants. The Act helps to stimulate investment for research and development to produce new plant varieties. Such protection is also likely to facilitate the growth of the seed industry that will ensure the availability of high quality seeds and planting material to the farmers.

Registration of a plant variety gives protection only in India and confers upon the rights holder, its successor, agent, or licensee the exclusive right to produce, sell, market, distribute, import, or export the variety.

Who can Apply and What can be Registered

The application for protection under the Act can be made by any of the following persons:

- Any person claiming to be the breeder of the variety;
- Any successor of the breeder of the variety;
- Any person being the assignee or the breeder of the variety in respect of the right to make such application;
- Any farmer or group of farmers or community of farmers claiming to be breeder of the variety;
- Any person authorized to apply on behalf of farmers; or
- Any university or publicly funded agricultural institution claiming to be breeder of the variety.

A new variety shall be registered under this Act if it conforms to the following criteria:

- **Novelty:** A new variety is deemed to be novel if, at the date of filing of the application for registration for protection, the propagating and harvested material of such variety has not been sold or otherwise disposed of by or with the consent of its breeder or his successor for the purposes of exploitation of such variety for a certain period of time before the date of filing of the application. For sale or disposal of a new variety in India, this time period is earlier than one year. Outside of India, in the case of trees and vines, the time period is earlier than six years. In any other case in India, it is earlier than four years.
- **Distinctiveness:** A new variety is deemed distinct if it is clearly distinguishable by at least one essential characteristic from any other variety whose existence is a matter of common knowledge in any country at the time of filing of the application.
- **Uniformity:** A new variety is deemed uniform if subject to the variation that may be expected from the particular features of its propagation it is sufficiently uniform in its essential characteristics.
- **Stability:** A new variety is deemed stable if its essential characteristics remain unchanged after repeated propagation or, in case of a particular cycle of propagation, at the end of each such cycle.

Unacceptable Denominations

A new variety cannot be registered under a given name if the denomination given to such variety:

- Is not capable of identifying such variety;
- Consists solely of figures;
- Is liable to mislead or cause confusion concerning the characteristics, value identity of such variety or the identity of breeder of such variety;
- Is not different from every denomination which designates a variety of the same botanical species or of a closely related species registered under the Act;
- Is likely to deceive the public or cause confusion in the public regarding the identity of such variety;
- Is likely to hurt the religious sentiments respectively of any class or section of the citizens of India;
- Is prohibited for use as a name or emblem for any purposes mentioned in section 3 of the Emblems and Names (Protection of Improper Use) Act, 1950; or
- Is comprised of solely or partly of geographical name.

Registration Procedure

Rights holders can apply for the registration of a new variety either directly or through their agents. The Office of the Registrar, Protection of Plant Varieties and Farmers' Rights Authority is the appropriate office for filing of the application in India. The different steps that are involved in the registration process in India are as follows:

- Completing the application form and filing
- The Applicant has to file the prescribed form with the requisite fee in the Office of the Registrar. The Applicant can make an application to the Registrar for registration of any variety of such genera and species as specified under sub-section (2) of Section 29 or which is an extant variety or which is a farmer's variety. An agent can complete and sign the application form, provided that the Applicant has issued a signed Power of Attorney appointing them as the agent. The application has to be in respect to a variety and state the denomination assigned to such variety by the Applicant. It has to be accompanied by an affidavit sworn by the Applicant that such variety does not contain any gene or gene sequence involving terminator technology and also a statement containing brief description of the variety bringing out its characteristics of novelty, distinctiveness, uniformity and stability. The application should also contain a complete passport data of the parental lines from which the variety has been derived along with the geographical location in India from where the genetic material has been taken and all such information relating to the contribution, if any, of any farmer, village community, institution, or organization in breeding, evolving, or developing the variety. It should also contain a declaration that the genetic material or parental material acquired for breeding, evolving, or developing the variety has been lawfully acquired. Copies of all the forms are available at <http://www.plantauthority.in/download.htm>.
- The Applicant must, along with the application for registration under this Act, also make available to the Registrar such quality of seeds of a variety for registration of which such application is made so that the Registrar can conduct tests to evaluate whether seeds of such variety along with parental material conform to the standards as may be

specified by regulations. The Applicant should also deposit the requisite fees for conducting such tests.

- Review by the Registrar
- After the application has been filed, the Registrar will accept the application absolutely or subject to certain conditions or limitations, after reviewing the application and making such inquiry as he deems fit. Should the Registrar not be satisfied with the particulars as mentioned in the application, he can either direct the Applicant to amend the application or in the alternative reject the application.
- Publication and Opposition
After the Registrar accepts the application either absolutely or subject to any conditions, it will be advertised in the prescribed manner along with its photographs or drawings. Within three months of the publication of this application, any person may give notice of his opposing the application to the Registrar in the prescribed format. Any person can oppose the application on the following grounds:
 - The person opposing the application is entitled to the breeder's right as against the Applicant;
 - The variety is not registerable under the Protection of Plant Varieties & Farmers' Rights Act, 2001 Act;
 - The registration of this variety will not be in public interest; or
 - The variety may have adverse effect on the environment.

After following the prescribed procedure of serving the Notice of Opposition to the Applicant, perusing the evidence as filed by both the parties and hearing both the parties, the Registrar will either allow or reject the opposition.

- Registration
When an application for registration of a variety (other than an essentially derived variety) has been accepted and not opposed or opposed but the opposition has been rejected, the Registrar will issue a certificate of registration to the Applicant. A person aggrieved by the decision of the Protection of Plant Varieties and Farmers' Rights Authority or the Registrar can file an appeal before the Plant Varieties Protection Appellate Tribunal.

The Distinctiveness Uniformity and Stability test guidelines have been finalized for 12 notified crop species: Black gram, Bread wheat, Chickpea, Field pea, Green gram, Kidney bean, Lentil, Maize, Pearl millet, Pigeon pea, Rice and Sorghum and the registration for these crops has started

- Term of Registration
The certificate of registration issued by the Registrar is valid for eighteen years from the date of registration of the variety in the case of vine and trees, fifteen years from the date of notification of that variety (under Section 5 of the Seeds Act, 1966) by the Central Government in the case of extant varieties and for a period of fifteen years from the date of registration of the variety in other cases. However, the certificate of registration is valid for a period of nine years in the case of trees and vines and six years in the case of other crops. The Registrar may review and renew this registration for the remaining term on payment of the prescribed fee.

- **Researcher's Right**
Though the rights holder has the exclusive right to the use of a registered variety, no provision of the Act precludes the researcher's right to the use of any variety for conducting experiments or research or the use of a variety as an initial source for creating other varieties. However, the researcher will have to seek the rights holder's authorization where the repeated use of such variety as a parental line is necessary for commercial production of a newly developed variety.
- **Revocation**
There are certain circumstances in which the protection that has been granted to a rights holder can be revoked. These circumstances in which the same can be done are enumerated below:
 - The grant of the certificate of registration has been based on incorrect information furnished by the rights holder;
 - The registered proprietor is not eligible for protection;
 - The rights holder has not provided the Registrar with such information and documents as are required under the Act;
 - The rights holder has not provided the Registrar with an alternative denomination, which could be used in case the denomination provided by the rights holder is not available;
 - The rights holder has not provided the necessary seeds or propagation material to the person to whom a compulsory license has been issued;
 - The rights holder has not complied with the provisions of the Act or the accompanying Rules;
 - The rights holder has not complied with the directions of the Protection of Plant Varieties and Farmers' Rights Authority; or
 - The grant of the certificate is not in public interest.

The Registrar also has the authority to either cancel or rectify the registration on an application made by an aggrieved person.

- **Compulsory License**
Any person, after expiry of three years from the date of registration, can apply to the Protection of Plant Varieties and Farmers' Rights Authority for a compulsory license for undertaking production, distribution, and sale of the seed or other propagating material on the grounds that the reasonable requirements of the public for seeds or other propagating material of the variety have not been satisfied or that the seed or other propagating material of the variety is not available to the public at a reasonable price. This application should contain a statement of the nature of the compulsory license Applicant's interest and the facts upon which the application is based. The Protection of Plant Varieties and Farmers' Rights Authority in consultation with the Central Government and after hearing both the parties may pass an order for the registered proprietor to grant the license on such terms and conditions as the Protection of Plant Varieties and Farmers' Rights Authority deems fit. Furthermore, the Protection of Plant Varieties and Farmers' Rights Authority will determine the duration of the compulsory license on a case-to-case basis but in no event will the duration of the license exceed the total remaining period of the protection.

Infringement & Enforcement Remedies available under The Protection of Plant Varieties and Farmers' Rights Act, 2001

A right established under the Act is infringed by a person:

- Who not being the registered proprietor of the variety under the Act sells, exports, imports or produces such variety without the permission of the registered proprietor;
- Who uses, sells, exports, imports or produces any other variety, giving this variety, the denomination identical with or deceptively similar to the denomination of a variety registered under the Act in such a manner so as to cause confusion in the mind of the general public in identifying the variety that has been registered.

The rights holder in case of an infringement of its rights can file a civil suit in court. This court will not be inferior to a District Court. In the suit, the rights holder may seek an injunction and either damages or a share of the profits. The order for injunction could include interlocutory order for discovery of documents, preserving of infringing variety or documents or other evidence which are related to the subject matter of the suit, and attachment of such property of the infringer that the court deems necessary to recover damages, costs, or other pecuniary remedies which may be finally awarded to the rights holder.

Expected Developments

The office of the Registrar of Plant Varieties and Farmer's Rights has drafted guidelines for the conduct of test for Distinctiveness, Uniformity and Stability for Tetraploid Cotton, Diploid Cotton, and Jute and is likely to commence accepting applications for these crops soon. Moreover the Plant Varieties Protection Appellate Tribunal is also likely to be formed soon.

Legislation and Regulation in India

The Protection of Plant Varieties and Farmers' Rights Act, 2001

The Protection of Plant Varieties and Farmers' Rights Rules, 2003

International Treaties to which India is a signatory

Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS)

International Treaty On Plant Genetic Resources For Food And Agriculture

Plant Varieties Related Websites

www.plantauthority.in

www.upov.int

FAQs

1. What are Farmers' rights?

A farmer who has bred or developed a new variety shall be eligible to register his variety under the Protection of Plant Varieties & Farmers' Rights Act, 2001 in the same manner as a breeder of a variety. A farmer who is engaged in the conservation of genetic resources of land races and wild relatives of economic plants and their improvement through selection and preservation shall be eligible to register his variety for recognition and reward from the Gene Fund provided that material so selected and preserved has been used to donate genes of varieties registered under the Act. Moreover, a farmer shall also be entitled to save, use, sow,

re-sow, exchange and share or sell his farm produce including seed of a variety protected under the act in the same manner as he was entitled before the coming into force of the Act provided that the farmer shall not be entitled to sell branded seed of a variety protected under the Act.

2. What are the characteristics that may be used for distinguishing a Variety?

The new variety should be distinct from the other varieties for at least one characteristic.

3. Is it necessary to submit the seed / propagating material before registration?

Yes, the breeder shall be required to deposit the seed or propagating material including parental line seeds of a registered variety to the Authority. An Applicant has to submit a fixed amount of seed sample (breeder seed) with prescribed germination percentage, physical purity and phyto-sanitary standards. The Applicant shall also submit along with the seed / propagating the seed quality test report.

4. Can a person apply for registration of a variety, which is already in the market?

Any variety, which is already in the market, but not for more than one year, may be eligible for registration as a new variety. Other older varieties may be eligible for registration as extant varieties.

5. What is the cost of registering a plant variety?

The fee structure as defined by the Authority is available at <http://www.plantauthority.in/PDFFile/Questionnaire.pdf>.

6. Is there any punishment if any person falsely represents a variety as a registered variety?

If a person falsely represents a variety as a registered variety, then he may be punished by imprisonment for a term not less than six months, which can be extended up to three years or by a fine not less than Rs. one lakh which may be enhanced to Rs. five lakhs, or both.

7. What species can be protected?

The Central Government has notified the following crops with their genera eligible for registration of varieties.

S.No.	Botanical Name	Hindi Name	Common Name
1	<i>Oryza sativa</i> L.	Chawal	Rice
2	<i>Triticum aestivum</i> L.	Gehun	Bread wheat
3	<i>Zea mays</i> L.	Makka	Maize
4	<i>Sorghum bicolor</i> (L.) Moench	Jowar	Sorghum
5	<i>Pennisetum glaucum</i> (L.) R. Br.	Bajra	Pearl millet
6	<i>Cicer arietinum</i> L.	Chana	Chickpea
7	<i>Cajanus cajan</i> (L.) Millsp.	Arhar	Pigeon pea
8	<i>Vigna radiata</i> (L.) Wilczek	Mung	Green gram
9	<i>Vigna mungo</i> (L.) Hepper	Urd	Black gram
10	<i>Lens culinaris</i> Medik	Masur	Lentil
11	<i>Pisum sativum</i> L.	Matar	Field pea
12	<i>Phaseolus vulgaris</i> L.	Rajmah	Kidney bean

The Semiconductor Integrated Circuits Layout Designs

A semiconductor integrated circuit is a product having transistors and other circuitry elements, which are inseparably formed on a semiconductor material or an insulating material or inside the semiconductor material and designed to perform an electronic circuitry function. In India, the Semiconductor Integrated Circuits Layout-Design Act, 2000 (hereinafter known as the "Act"), along with the Semiconductor Integrated Circuits-Layout Design Rules, 2001, is the prevailing law. Registering the layout-design under the Act gives the rights holder the exclusive right to the layout-design and to obtain relief in respect of infringement.

Layout-designs are prohibited from registration under the Act if they are as follows:

- Not original;
- Have been commercially exploited anywhere in India or in a Convention country i.e. any country that the Government of India notifies in the Official Gazette for the fulfillment of a treaty, convention or an arrangement with any country outside India and which affords to citizens of India similar privileges as are granted to its own citizens;
- Not inherently distinctive;
- Not inherently capable of being distinguishable from any other registered layout-design.

Any person who is claiming to be the creator of a layout-design and who is interested in registering it has to apply in writing to the Registrar. The Registrar may refuse the application or may accept it fully or subject to amendments. Within fourteen days from the date of acceptance, the Registrar will advertise the application. Within three months from the date of the advertisement of the application, any person may oppose the application by providing written notice and a fee to the Registrar. After hearing the parties and examining the evidence, the Registrar will decide the opposition.

If the application has been accepted and not opposed, or if opposed and the opposition has been decided in the favor of the Applicant, then the Registrar will register the layout-design. This registration is valid for a term of ten years from the date of filing an application for registration or from the date of first commercial exploitation anywhere in the world, whichever is earlier.

A registered layout-design is infringed by a person who, not being the registered proprietor of the layout-design or a registered user thereof,

- Does any act of reproducing, whether by incorporating in a semiconductor integrated circuit or otherwise, a registered layout-design in its entirety or any part thereof; or
- Does any act of importing or selling or otherwise distributing for commercial purposes a registered layout-design or a semiconductor integrated circuit incorporating such registered layout-design or an article incorporating such a semiconductor integrated circuit containing such registered layout-design for the use of which such person is not entitled.

The Act also provides for the rectification and correction of the Register. Any person who is aggrieved by the absence or omission from the Register of any entry or by an entry made in the Register without sufficient cause, or by an entry remaining on the Register wrongly, or by an error or defect in any entry in the Register, may apply to the Appellate Board or to the Registrar to expunge the entry. The Registrar or the Appellate Board may expunge or vary the entry as it may think fit.

Infringement of a layout-design is considered to be a criminal offence in India. Any person who has infringed is liable to be punished by imprisonment for a term, which may extend to three years or by fine of more than Rs. fifty thousand but less than Rs. ten lakhs or both.

Legislation and Regulation in India

The Semiconductor Integrated Circuits Layout-Design Act, 2000

The Semiconductor Integrated Circuits-Layout Design Rules, 2001

International Treaties to which India is a signatory

Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS)

Treaty on Intellectual Property in Respect of Integrated Circuits

Layout-designs Related Websites

http://www.wipo.int/clea/docs_new/pdf/en/in/in003en.pdf

<http://www.mit.gov.in/default.aspx?id=322>

Biological Diversity

The United Nations Convention on Biological Diversity held at Rio de Janeiro in the year 1992 reaffirmed the rights of the Sovereign states over their biological resources. India, being a signatory to this Convention passed the Biological Diversity Act, 2002 which is intended to provide for conservation of biological diversity, sustainable use of its components and fair and equitable sharing of the benefits arising out of the use of biological resources and knowledge. The Biological Diversity Act, 2002 along with The Biological Diversity Rules, 2004 are the prevailing laws for biological diversity in India. This Act primarily addresses access to genetic resources and associated knowledge by foreign individuals, institutions or companies, which is intended to ensure equitable sharing of benefits arising out of the use of these resources and knowledge to the country and the people.

Under this Act, a person who is not a citizen of India or who is a citizen of India but is a non-resident (as defined in clause 30 of Section 2 of the Income Tax Act, 1961), or a body corporate, association or organization that is not incorporated or registered in India or if incorporated or registered in India has any non-Indian participation in its share capital or management, is prohibited from obtaining any biological resource occurring in India or knowledge associated thereto for research or commercial utilization or for bio-survey or bio-utilization without the prior approval of the National Biodiversity Authority. Such a person must seek the permission of the National Biodiversity Authority by making an application in the prescribed format and on the payment of the prescribed fee. The forms and the prescribed fee for the same are available at <http://www.nbaindia.org/applications/application.htm>. Moreover, no person may apply, for any intellectual property right, without the prior approval of the National Biodiversity Authority, whether within or outside India, for any invention based on any research or information on a biological resource obtained from India. The National Biodiversity Authority shall dispose of the application for permission made to it within a period of ninety days from the date of receipt of the application. On receipt of the application, the National Biodiversity Authority may make the enquiries that it deems fit including consulting the expert committee constituted for this reason. Thereafter it could either grant approval to the application subject to any terms and conditions or after hearing the affected person, reject the application. The reasons for the rejection of the application have however to be recorded in writing. The National Biodiversity Authority issues a public notice of every approval granted by it. Furthermore, a person who has been granted approval cannot transfer any biological resource or knowledge associated thereto which is the subject matter of the approval without the prior approval of the National Biodiversity Authority. The prior approval of the National Biodiversity Authority is also required before any person can transfer the results of any research relating to any biological resources occurring in, or obtained from India for monetary consideration or otherwise to any person who is not a citizen of India or who though a citizen of India but is a non-resident (as defined in clause 30 of Section 2 of the Income Tax Act, 1961) or a body corporate, association or organization that is not incorporated or registered in India or if incorporated or registered in India has any non-Indian participation in its share capital or management.

Even a citizen of India or a body corporate, association or organization, which is registered in India has to give prior notice to the State Biodiversity Board before obtaining any biological resource for commercial utilization, or bio-survey and bio utilization for commercial utilization. This however does not apply to local people and communities of the area, including growers

and cultivators of biodiversity and *vaids* and *hakims* (indigenous doctors) who have been practicing indigenous medicine.

The National Biodiversity Authority, while granting approvals, is also charged with ensuring that the terms and conditions subject to which approval is granted secures equitable sharing of benefits arising out of the use of accessed biological resources, their by-products, innovations and practices associated with their use and applications and knowledge relating thereto in accordance with mutually agreed terms between the persons applying for the approval, local bodies concerned and the benefit claimers.

Under the Act, each State in India must constitute its own Board known as the State Biodiversity Board which would advise the State Government on matters relating to the conservation of biodiversity, sustainable use of its components and equitable sharing of the benefits arising out of the utilization of biological resources and also regulate by granting of approvals or otherwise requests for commercial utilization or bio-survey and bio-utilization of any biological resource by Indians.

Any person who is aggrieved by the order of the National Biodiversity Authority or a State Biodiversity Board or by any determination of benefit sharing may file an appeal to the High Court. Any person who contravenes the provisions regarding seeking prior approval of the National Biodiversity Authority or abets in its contravention is liable to be punished with imprisonment for a term which may extend to five years or with fine which may extend to ten lakh rupees and where the damage caused exceeds ten lakh rupees then such fine maybe commensurate with the damage caused or with both imprisonment and fine. This provision is a matter of grave concern to the industry as they might inadvertently contravene this provision and be liable to fine and imprisonment.

Legislation in India

The Biological Diversity Act, 2002 along with The Biological Diversity Rules, 2004

International Treaties to which India is a signatory

Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS)

The United Nations Convention on Biological Diversity

Biological Diversity Related Websites

<http://www.wto.org>

<http://www.cbd.int>

<http://www.nbaindia.org>

Patent offices on the Internet

<http://members.tip.net.au/~arhen/>

1. Australian Patent Office
2. Austrian Patent Office
3. Belgian Patent Office
4. Benelux Trademark Office
5. Brazilian Patent Office
6. Canadian Intellectual Property Office
7. Czech Patent Office
8. Chinese Patent Office
9. Croatian Patent Office
10. Cuban Patent Office
11. Danish Patent Office
12. European Patent Office
13. Finnish Patent Office
14. French Patent Office
15. Georgian Patent Office
16. German Patent Office
17. Greek Industrial Property Organisation
18. Hong Kong Patent Office
19. Hungarian Patent Office
20. Iceland Patent Office
21. Indian Patent Office
22. Indonesian Patent Office
23. Irish Patent Office
24. Israel Patent Office
25. Italian Patent Office
26. Japanese Patent Office
27. Korean Patent Office
28. Lithuanian Patent Office
29. Luxembourg Patent Office
30. Macedonian Patent Office
31. Malaysian Intellectual Property Division
32. Mexican Patent Office
33. Monaco Patent Office
34. Netherlands Patent Office
35. New Zealand Patent Office
36. Norwegian Patent Office
37. Peruvian Intellectual Property Office
38. Philippines Patent Office
39. Polish Patent Office
40. Portuguese Patent Office
41. Romanian Patent Office
42. Russian Patent Office
43. Singaporean Patent Office
44. Slovak Republic Patent Office
45. Slovenian Patent Office
46. Spanish Patent Office
47. Swedish Patent Office
48. Swiss Institute of Intellectual Property
49. Taiwan Patent Office
50. Thai Patent Office
51. United Kingdom Patent Office
52. United States Patent Office
53. World Intellectual Property Organisation (WIPO)
54. World Trade Organisation (WTO)

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