

# Intellectual Property Rights (IPR)

## 1. What are Intellectual Property Rights (IPR)?

IPR is a general term covering patents, copyright, trademark, industrial designs, geographical indications, layout design of integrated circuits, undisclosed information (trade secrets) and new plant varieties.

## 2. What are the legislations covering IPRs in India?

**Patents:** The Patents Act, 1970 as amended in 1999, 2002 and 2005

**Design:** The Designs Act, 2000

**Trade Mark:** The Trade Marks Act, 1999

**Copyright:** The Copyright Act, 1957 as amended in 1983, 1984 and 1992, 1994, 1999

**Layout Design of Integrated Circuits:** The Semiconductor Integrated Circuits Layout Design Act, 2000

**Protection of Undisclosed Information:** No exclusive legislation exists but the matter would be generally covered under the Contract Act, 1872

**Geographical Indications:** The Geographical Indications of Goods (Registration and Protection) Act, 1999

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

## 3. Who are responsible for administration of IPRs in the country?

Patents, designs, trademarks and geographical indications are administered by the Controller General of Patents, Designs and Trademarks which is under the control of the Department of Industrial Policy and Promotion, Ministry of Commerce and Industry. Copyright is under the charge of the Ministry of Human Resource Development. The Act on Layout-Design of Integrated Circuits is administered by the Ministry of Telecommunication and Information Technology. Protection of Plant Varieties and Farmers' Rights Authority, Ministry of Agriculture administers the Act on Plant Variety.

# Patents

## 4. What is a patent?

A patent is an exclusive ownership right granted by a country to the owner of an invention, provided the invention satisfies certain conditions stipulated in the law. A Letters Patent (a kind of certificate) is issued to the owner of the invention by the patent office of the country conferring this right. Exclusivity of right implies that no one else can make, use, manufacture or market the invention without the consent of the patent holder. This right is available to the owner of the invention only for a limited period of time. However, the use or exploitation of a patent may be affected by other laws of the country which has awarded the patent. These laws may relate to health, safety, food, security etc.

A patent in the law is a property right and hence, it can be gifted, inherited, assigned, sold or licensed. As the right is conferred by the State, it can be revoked by the State under very special circumstances for the benefit of public even if the patent has been sold or licensed or manufactured or marketed in the meantime. The patent right is territorial in nature meaning thereby, that a patent granted in India can only be enforced in India. In case the owner of the invention wishes to obtain patents in other countries, the owner will have to file separate patent applications in countries of his interest, along with necessary fees.

## 5. What is expected from patentee as an obligation to the State?

A patentee must disclose the invention in a patent document for people to practice it after the expiry of the term of the patent or after the patent has lapsed due to nonpayment of maintenance fee or practice it with the consent of the patent holder during the life of the patent. Disclosure of an invention is a legal requirement for obtaining a patent.

## 6. How is invention defined in the Indian Patents Act, which can qualify for grant of a patent?

**Invention** means a **new** product or process involving an **inventive step** and **capable of industrial application**.

**Capable of industrial application** means that the invention is capable of being made or used in an industry.

## 7. How do you explain the term ‘a new product or a process’?

An invention is considered new or novel if it is not known to the public through publication or prior use anywhere in the world. The invention should not be a part of the existing global state of the art. Information appearing in magazines, technical journals,

books, newspapers, published patents etc. constitute the state of the art. Oral description of the invention in a seminar/conference can also spoil novelty. Novelty is always assessed in the global context. An invention will cease to be novel if it has been disclosed in public through any type of publications anywhere in the world before filing a patent application in respect of the invention. Prior use of the invention before the filing date can also destroy the novelty. Novelty is determined through extensive literature and patent searches. It should be realized that patent search is essential and critical for ascertaining novelty as most of the information reported in patent documents does not usually get published anywhere else or it is published in technical literature after a fairly long gap.

### **8. How is inventiveness defined in the Indian Patents Act? Explain the meaning of the term.**

**Inventive step** is defined as a feature of an invention that involves technical advance as compared to the existing knowledge or having economic significance or both and that makes the invention not obvious to a person skilled in the art.

A person skilled in the art means a person having knowledge and skill in the subject matter of the patent application. This term has not been defined in terms of educational qualifications and experience. Inventiveness is different from novelty in the sense that an invention must lead to a technical advance. Replacement of a wooden knob in an almirah by a metallic knob is not considered inventive. A substantial degree of interpretation is called for in determining the inventiveness. Inventiveness cannot be decided on the basis of the material contained in unpublished patents. This would mean that while deciding inventiveness of an invention one has to examine it in the light of published information on the date of filing of the patent application. The complexity or the simplicity of an inventive step does not have any bearing on the grant of a patent. In other words a very simple invention can qualify for a patent. A mere 'scintilla' of invention is sufficient to found a valid patent.

### **9. What are the types of inventions which are not patentable in India?**

An invention may satisfy the condition of novelty, inventiveness and usefulness but it may not qualify for a patent under the following situations:

- (i) an invention which is frivolous or which claims anything obviously contrary to well established natural laws;
- (ii) an invention the primary or intended use or commercial exploitation of which could be contrary to public order or morality or which causes serious prejudice to human, animal or plant life or health or to the environment;
- (iii) the mere discovery of scientific principle or the formulation of an abstract theory or discovery of any living thing or non-living substance occurring in nature;
- (iv) the mere discovery of a new form of a known substance which does not result in enhancement of the known efficacy of that substance or the 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 product or employs at least one new reactant;

**Explanation:** For the purposes of this clause, salts, esters, ethers, polymorphs, metabolites, pure form, particle size, isomers, mixtures of isomers, complexes, combinations and other derivatives of known substance shall be considered to be the same substance, unless they differ significantly in properties with regards to efficacy.

- (v) a substance obtained by mere admixture resulting only in the aggregation of the properties of the components thereof or a process for producing such substance;
- (vii) the mere arrangement or re-arrangement or duplication of known devices each functioning independently of one another in a known way;
- (ix) a method of agriculture or horticulture;
- (x) any process for medicinal, surgical, curative, prophylactic (diagnostic, therapeutic) or other treatment of human beings or any process for a similar treatment of animals to render them free of disease or to increase their economic value or that of their products;
- (xi) plants and animals in whole or any part thereof other than microorganisms but including seeds, varieties and species and essentially biological processes for production or propagation of plants and animals;
- (xii) a mathematical or business method or a computer program *per se* or algorithms;
- (xiii) a literary, dramatic, musical or artistic work or any other aesthetic creation whatsoever including cinematographic works and television productions;
- (xiv) a mere scheme or rule or method of performing mental act or method of playing game;
- (xv) a presentation of information;
- (xvi) topography of integrated circuits;
- (xvii) an invention which, in effect, is traditional knowledge or which is an aggregation or duplication of known properties of traditionally known component or components;
- (xviii) inventions relating to atomic energy;

#### **10. When should an application for a patent be filed?**

Filing of an application for a patent should be completed at the earliest possible date and should not be delayed. An application filed with provisional specification, disclosing the essence of the nature of the invention helps to register the priority by the applicant. Delay in filing an application may entail some risks such as (i) some other inventor might file a patent application on the said invention and (ii) there may be either an inadvertent publication of the invention by the inventor himself/herself or by others independently of him/her.

#### **11. Can a published or disclosed invention be patented?**

No. Publication of an invention in any form by the inventor before filing of a patent application would disqualify the invention to be patentable. However, a grace period of 12 months is available in India for filing a patent application after disclosure of the invention through publication or display. This grace period is available only when such publications or displays are done in government notified exhibitions or paper read before learned society. A patent application must be filed before the grace period ends. A practical advice to inventors is that they should try to utilize the grace period only under special circumstances. As a matter of sound practice they should not disclose their invention before filing the patent application. The invention can be considered for publication after a patent application has been filed. Thus, it can be seen that there is no contradiction between publishing an inventive work and filing a patent application in respect of the invention.

## **12. What is considered as the date of patent?**

The date of patent is the date of filing the application for patent (whether provisional or complete). The term of the patent is counted from this date.

## **13. What is the term of a patent in the Indian system?**

Term of the patent is 20 years from the date of filing for all types of inventions.

## **14. How does one keep a patent in force for the full patent term?**

A patent has to be maintained by paying the maintenance fees every year. If the maintenance fees are not paid, the patent will cease to remain in force and the invention becomes open to public. Anyone can then utilize the patent without the danger of infringing the patent.

## **15. What are the essential documents to be generated and submitted by a potential patentee?**

There are two types of patent documents usually known as patent specification, namely

(i) Provisional Specification and (ii) Complete Specification

### **Provisional Specification**

A provisional specification is usually filed to establish priority of the invention in case the disclosed invention is only at an early stage and a delay is expected in giving final shape to the invention. Although, a patent application accompanied with provisional specification does not confer any legal patent rights to the applicant, it is, however, a very important document to establish the earliest ownership of an invention. The provisional specification is a permanent and independent scientific cum legal document and no amendment is allowed in this. No patent is granted on the basis of a provisional specification. It has to be followed by a complete specification for obtaining a patent for

the said invention. Complete specification must be submitted within 12 months of filing the provisional specification. This period is non-extendible. It is not necessary to first file an application with provisional specification and then the complete specification. An application with complete specification can be filed right at the first instance.

### **Complete Specification**

Submission of complete specification is necessary to obtain a patent. The contents of a complete specification would include the following :-

1. Title of the invention.
2. Field to which the invention belongs.
3. Background of the invention including prior art giving drawbacks of the known inventions & practices.
4. Complete description of the invention along with experimental results.
5. Drawings etc. essential for understanding the invention.
6. Claims, which are statements related to the invention on which legal proprietorship is being sought. Therefore, the claims have to be drafted very carefully.
7. Abstract of the invention.
8. If a biological material is mentioned in a specification; then the source and geographical origin of the same is to be disclosed in the specification. For new biological material, registration number of the same given by an International Depositary Authority (IDA) is to be included in the specification along with its address. [Institute of Microbial Technology (IMTech), Chandigarh is a recognized IDA in India]

### **16. What is request for examination and when it is to be filed?**

An applicant has to make a request to the Patent Office for examining the patent application by paying the requisite fees. The request can be made at the time of submitting complete specification or within 48 months of filing the application. The request can also be made by any other interested person.

### **17. Which all forms are required to be filled for filing of a patent application in India?**

Some of the important forms required for filing and prosecution of a patent application in India are listed below:

<b>S. No</b>	<b>Action</b>	<b>Form No</b>	<b>Conditions</b>
1.	Application for grant of a patent	Form 1*	This form will be accompanied by provisional or complete specification filled in Form 2
2.	Provisional or Complete	Form 2*	

	specification		
3.	Statement and undertaking foreign applications	Form 3*	In this form the applicant gives the undertaking that he has not made any application outside India and will inform the Patent Office as and when he files the same abroad.
4	Declaration as to inventorship	Form 5	The applicant discloses the names of all the inventors. This is generally used when complete specification is filed after provisional specification.
5.	Request or claim regarding mention of inventor as such in a patent	Form 8	If this form is filled then the letters patent document will have the name of the inventors, otherwise not.
6.	Request for examination of a patent application	Form 18*	This form can be filed anytime with in 48 months of filing an application. It can be filed even at the time of filing the patent application. Without filing this form the patent specification will not be examined.
7.	Form of authorization of a Patent Agent	Form 26	This form is required when the applicant is authorizing a patent agent to act before the patent office on his/her behalf
8.	Request for early publication	Form 9	This form is required to be filled if the applicant wants that his application is published before 18 months of filing

Forms marked with asterisk are necessary to be deposited with the Patent Office in order to process the application for grant of a patent by the Patent Office. Rest of the forms can be filled as and when the need arises.

### **18. What time lines are to be adhered to while prosecuting a patent application in India?**

Following are the important time lines to observed by an applicant during the prosecution of a patent application.

No.	Description	Time line
1.	Filing of Complete Specification	With in 12 months of filing the

	following provisional specification <b>(Form 2)</b>	provisional specification
2.	Statement and undertaking regarding foreign applications <b>(Form 26)</b>	With in 6 months from the date of filing of application
3.	Declaration of Inventorship <b>(Form 5)</b>	With the complete specification or within one month from the date of filing of the complete specification
4.	Reference to deposit of biological material	With in 3 months form the date of filing of application
5.	Withdrawal of application to prevent publication	Fifteen months from date of filing or priority, whichever is earlier
6.	Request for examination <b>(Form 18)</b>	Forty eight months from the date of filing or priority, whichever is earlier
7.	Time for replying to the First Examination report (FER)	Twelve months from the date of issuance of the FER. The applicant must reply to the objections raised in this report and should put the application in order for the grant as early as possible. This 12 month period is non-extendible.
8.	Pre-grant opposition	After publication of the application and any time before the grant of patent
9.	Notice of Opposition (post-grant opposition) <b>(Form 7)</b>	One year from the date of publication of grant of patent
10.	Time after which no permission required for filing abroad	Six weeks after filing the application in India, where no direction for secrecy in present
11.	Furnishing information relating to working of patent, upon notice of Controller <b>(Form 27)</b>	Two months from the date of notice

### 19. When will a patent application be published? How will it be accessible to public?

A patent application will be published in the Official Journal of the Patent Office on expiry of eighteen months from the date of filing or date of priority of the application, whichever is earlier. It can also be published earlier, if such a request is made by the applicant.

An application will not be published in cases where directions have been given for secrecy, until the term of those directions expires. If an applicant wishes to withdraw the application on his own without any secrecy consideration, he can do so by withdrawing his application at-least three months before the date of the publication. In that case the application will not be published.



The publication of every application includes the particulars of the date of application, application number, name and address of the applicant, an abstract, and is open for public

inspection. However, the whole patent document can be obtained from the Patent Office upon payment of the requisite fees. These documents are now also available online at the Patent Office website [www.ipindia.nic.in](http://www.ipindia.nic.in). The Official Journal of the Patent Office and the patent database in the searchable form can be accessed through this website.

## **20. What is opposition under the Indian Patents Act 1970?**

The Act now provides for pre-grant and post-grant opposition. **Pre-grant opposition** can be filed after the publication of patent application and before the grant of patent. **Post-grant opposition** can be filed within one year of the grant of the patent. An opposition board will be constituted for each of the opposition notifications accepted by the Controller for the post grant opposition proceedings. Opposition in both cases will be allowed on all grounds specified in the Act.

## **21. What are the grounds for opposition?**

Pre-grant and post-grant opposition can be filed only on the following grounds:-

- i. Claimed invention or its part wrongfully obtained;
- ii. Claimed invention is published in a patent or any other document before the priority date;
- iii. Claimed invention is published in a patent after the priority date having earlier priority date;
- iv. Claimed invention was publicly known or publicly used before the priority date;
- v. Claimed invention is obvious and does not involve clearly any inventive step, as regards to the matter published or used (in India) before the priority date;
- vi. Claimed invention is not an invention within the meaning of the Patents Act or is not patentable under the Patents Act;
- vii. The complete specification does not sufficiently and clearly describe the invention or the method by which it is to be performed;
- viii. The applicant has failed to disclose to the Controller the information regarding foreign applications filed by him for the same invention or has furnished the information which in any material particular was false to his knowledge;
- ix. In case of convention application if the application is not filed before the expiry of 12 months from the date of first application in convention country;
- x. The complete specification does not disclose or wrongly mentions the source and geographical origin of biological material used in the invention;
- xi. Claimed invention was anticipated having regard to the knowledge, oral or otherwise available within any local or indigenous community in India or elsewhere.

## 22. What is the cost of filing a patent application in India?

Some important fees are given below :-

N o.	Action	Limits, conditions and timelines	Official Fees	
			Individual	Legal entity
1.	Filing of patent application along with complete/provisional specification	For maximum number of pages 30 and maximum number of claims 10	Rs.1000/-	Rs.4000/-
		For each additional sheet	Rs.100/-	Rs.400/-
		For each additional claim	Rs.200/-	Rs.800/-
2.	Request for examination of patent		Rs.2,500/-	Rs.10,000/-
3	Request for early publication		Rs.2,500/-	Rs.10,000/-
4.	Renewal fee (every year)	2 <sup>nd</sup> year to 6 <sup>th</sup> year	Rs.500/-	Rs.2,000/-
		7 <sup>th</sup> year to 10 <sup>th</sup> year	Rs.1500/-	Rs.6000/-
		11 <sup>th</sup> year to 15 <sup>th</sup> year	Rs.3000/-	Rs.12,000/-
		16 <sup>th</sup> year to 20 <sup>th</sup> year	Rs.5000/-	Rs.20000/-

## 23. Is a patent granted in one country automatically enforceable in other countries?

No. There is nothing like a global patent or a world patent. Patent rights are essentially territorial in nature and are protected only in a country (or countries), which has (have) granted these rights. Therefore, the patent could only be enforced in such countries. In other words, for obtaining patent rights in different countries one has to submit patent applications in all the countries of interest for grant of patents. This would entail payment of official fees and associated expenses, like the attorney fees, essential for obtaining patent rights in each country. However, there are some regional systems where by filing one application, one could simultaneously obtain patents in the member countries of a regional system; European Patent Office is an example of a similar system.

## 24. Does grant of a patent in one country affect its grant or refusal in another country?

Each country is free to grant or refuse a patent on the basis of scrutiny by its patent office. This means that grant of a patent in one country does not guarantee that some

other country will also grant patent for the same invention. Similarly, the refusal of the patent in one country does not mean that it will be refused in other countries.

## **25. What is industrial property?**

Industrial property includes:

(a) Patents (b) Utility models (c) Industrial designs (d) Trademarks, service marks and trade names (e) Indication of source or appellations of origin (this is same as the geographical indications adopted in TRIPS). *[Readers may note the use of the phrase 'Industrial Property' and how it is different from intellectual property].*

## **26. What is the Paris Convention?**

The Paris Convention is an international convention for promoting trade among the member countries, devised to facilitate protection of industrial property simultaneously in the member countries without any loss in the priority date. All the member countries provide national treatment to all the applications from the other member countries for protection of industrial property rights. The Convention was first signed in 1883. Since then, the Convention has been revised several times, in 1900 at Brussels, in 1911 at Washington, in 1925 at The Hague, in 1934 at London, in 1958 at Lisbon and in 1967 at Stockholm. The last amendment took place in 1979. India became a member of the Paris Convention on December 7, 1998.

## **27. What are the principal features of the Paris Convention?**

The principal features of the Paris Convention have been listed below:-

- National treatment
- Right of priority
- Independence of patents
- Parallel importation
- Protection against false indications and unfair competition

## **28. What is the meaning of national treatment under the Paris Convention?**

This is a very important concept and is essential for successfully achieving the fundamental aim of the Paris Convention. The idea is to provide equal treatment to a patent applicant from other member countries, and not to differentiate between the nationals of your country and nationals of the other countries for the purpose of grant and protection of industrial property in your country. Imagine that a national of country X applies for grant of a patent in India. According to the Paris Convention, the Indian Patent Office shall apply the same norms and rules, to the applicant from X, as applicable

to an Indian applicant, for granting a patent. Similarly the applicant from X shall have the same protection after grant and enjoy identical legal remedies against any infringement provided the conditions and formalities imposed upon Indians are complied with.

**29. Is there a provision for filing patent application online in India?**

Yes. From 20<sup>th</sup> July, 2007 the Indian Patent Office has put in place an online filing system for patent application. More information for filing online application is available on the website of Patent Office i.e. [www.ipindia.nic.in](http://www.ipindia.nic.in).

**30. What do you understand by the right of priority and what is its significance?**

The date from which patent right is deemed to start is the date of filing of a patent application. To obtain rights in other member countries, the application must be filed on the same day in other member countries if it is desired to have the rights started from the same day. However, there are practical difficulties in synchronizing the activities. For facilitating simultaneous protection in member countries, the Convention provides that within 12 months of national filing, if patent applications are filed in those member countries, the patents, if granted in member countries, will be effective from the date of national filing. This right is known as the right of priority. In other words you maintain the priority or the same date of filing in all the member countries and no one else in those countries can obtain the patent rights on a similar/identical invention from the same or a later date.

In case the applicant after a second look at the patent application finds that the patent contains more than one invention or on his own accord wishes to divide the application, he can claim the initial date of priority for subsequent patent applications. The applicant may also, on his own initiative, divide a patent application and preserve as the date of each divisional application the date of the initial application and the benefit of the right of priority, if any. Each country of the Convention shall have the right to determine the conditions under which such division shall be authorized.

Priority may not be refused on the ground that certain elements of the invention for which priority is claimed do not appear among the claims formulated in the application in the country of origin, provided that the application documents as a whole specifically disclose such elements.

**31. What is implied by 'importation' in relation to working of a patent under the Convention?**

Importation is considered as working of patent, provided that the patented product is manufactured in a member country and is imported into another member country which has also granted a patent on the same invention to the same applicant. Imagine that a product X has been patented in two member countries A and B. The product X is then manufactured in country A and imported into the country B. This product X shall enjoy

the same patent protection in the country B even though it has been manufactured in the country A. This would also be considered as if the patent has been worked in country B.

**32. Is there a provision for compulsory license in the Paris Convention?**

Yes, each member country shall have the right to provide for the grant of compulsory licenses to prevent the abuses resulting from the exclusive rights conferred by the patent. Compulsory licenses for failure to work or insufficient working of the invention may not be requested before the period of time of non-working or insufficient working has elapsed. This time limit is four years from the date of filing of the patent application or three years from the date of the grant. Such licenses will be a non-exclusive and non-transferable one.

**33. Is there any relationship between the Paris Convention and the TRIPS Agreement?**

It has been made mandatory for the member countries of the TRIPS Agreement to comply with the Article 1 to 12 and Article 19 of the Paris Convention.

**34. What are the other advantages of joining the Paris Convention?**

There are a number of international conventions and treaties, which are open only to the members of the Paris Convention. Some of these are:

- Patent Cooperation Treaty (PCT)
- Budapest Treaty (for deposition of microorganisms)
- UPOV (for protection of new varieties of plants)
- Madrid Agreement (for repression of false or deceptive indications of source on goods)
- Madrid Protocol (concerning registration of marks)
- Hague Agreement (concerning deposits of industrial designs)
- Strasbourg Agreement (concerning the International Patent Classification)

**35. What is the Budapest Treaty?**

This is an international treaty governing the registration of deposits of microorganisms, cell lines etc in officially approved culture collections for the purpose of patent applications in any country that is a party to it. Because of the difficulties and, on occasion, of virtual impossibility of reproducing a microorganism from a description of it in a patent specification, it is essential to deposit a strain in a culture collection centre for testing and examination by others. The Treaty was signed in Budapest in 1973 and later

on amended in 1980. India became a member of this Treaty, with effect from December 17, 2001.

**36. Are there any differences in the filing of patent applications in respect of microbiological inventions and other inventions?**

The basic difference is that an inventor is required to deposit the strain of a microorganism in a recognized depository which assigns a registration number to the deposited microorganism. This number needs to be quoted in the patent application. Obviously a strain of microorganism is required to be deposited before filing a patent application. It may be observed that this mechanism obviates the need of describing a microorganism in the patent application. Further, samples of strains can be obtained from the depository for further working on the patent. There are many international depositories in many countries, which are recognized under the Budapest Treaty. Such a requirement of deposition of a physical element of an invention, in respect of inventions in other area, does not exist.

**37. What is the system for protecting microbiological inventions and microorganisms in India?**

The Indian Patent Act has included microorganisms discovered from nature in the list of items not patentable. However, genetically modified microorganisms will be patentable. The process for producing microorganisms or culture of microorganisms etc. will also be patentable. Many countries allow patenting of genetically modified microorganisms but a few also allow patenting of naturally occurring microorganisms if isolated from nature for the first time and if other conditions of patentability are satisfied.

**38. What is the Patent Cooperation Treaty (PCT)?**

The Patent Cooperation Treaty (PCT) is a multilateral treaty entered into force in 1978. Through PCT, an inventor of a member country (Contracting State) of PCT can simultaneously obtain priority for his/her invention in all the member countries, without having to file a separate application in those countries, by filing of PCT application, which is popularly known as International Application. India joined the PCT on December 7, 1998.

**39. Is designation of countries in PCT applications required now?**

No, it is no longer required to designate countries in a PCT application as was the practice until recently. All the PCT member countries are considered as designated countries.

**40. Who coordinates the activities of PCT?**

All activities related to PCT are coordinated by the World Intellectual Property Organization (WIPO) situated in Geneva.

#### **41. What is the need for PCT?**

In order to protect your invention in other countries, you are required to file an independent patent application in each country of interest; in some cases, within a stipulated time to obtain priority in these countries. This would entail a large investment, within a short time, to meet costs towards filing fees, translation, attorney charges etc. In addition you are making an assumption which, due to the short time available for making the decision on whether to file a patent application in a country or not, may not be well founded.

Inventors of Contracting States of PCT on the other hand can simultaneously obtain priority for their inventions without having to file separate application in the countries of interest; thus saving the initial investments towards filing fees, translation etc. In addition the system provides much longer time for filing patent application in member countries. The time available under Paris Convention for securing priority in other countries is 12 months from the date of initial filing. Under the PCT, the time available could be a minimum of 20 months and maximum of 31 months. Further, an inventor is also benefited by the search report prepared under the PCT system to be sure that the claimed invention is novel. The inventor could also opt for preliminary examination before filing in other countries to be doubly sure about the patentability of the invention.

#### **42. How are patent applications handled under PCT?**

The patent office or any other office designated by each contracting state becomes a receiving office for receiving PCT patent applications. These applications are referred to International Searching Authorities (ISA), which usually are patent offices, appointed to carry out patent search on a global basis. In case the receiving office is also an ISA, a separate referral is not required. There is also a provision to get a patent application examined by International Preliminary Examining Authorities, which in most cases are ISAs.

#### **43. What is the meaning of delayed processing of an application filed under the PCT system?**

A search report on the patent application filed with a receiving office is received by the applicant/inventor 16 months after the priority date, the latter is nothing but the date of submitting the application in the receiving office (It has been observed that in some cases, the 16 months period is strictly not adhered to). The International Bureau of the WIPO publishes the application and the search report 18 months after the priority date. Within two months of the publication of the application i.e. by the 20<sup>th</sup> month, the applicant will have to formally apply to the patent offices of these countries for grant of

patents by paying official fees and completing other formalities stipulated by these offices. However, it is now possible to enter national phase by 30<sup>th</sup> or 31<sup>st</sup> month in many countries even if no request is made for preliminary examination. In other words, the 20 month period has been virtually extended to 30 or 31 months. In case translated copies of the application are required, the same has to be furnished by the applicant. In spite of submitting the request for grant of patents in designated countries in the 20<sup>th</sup> or 31<sup>st</sup> month after the priority date, the priority in these countries is the same as the date of filing the original PCT application.

If applicant/inventor has requested for an examination report, the report is usually received by the applicant/inventor about 28 months after the priority date. Within two months of this and in some countries within three months, the applicant/inventor will have to formally apply for grant of patents in designated countries. The priority of the application is maintained in the designated countries.

#### **44. What is the benefit of the delayed processing?**

(a) By the end of the 20<sup>th</sup> to 31<sup>st</sup> month the applicant is in a better position to assess the quality of the invention being protected as a detailed search report or an examination report or both would be available to help making an assessment.

(b) Applicants can re-evaluate their decision about filing applications in all the member countries after a long gap of 20 to 31 months.

(c) If not satisfied, applicants may decide to select or drop a few countries from the list. This decision would also be influenced by the changing market conditions.

(d) Applicants can delay their investment in respect of the national phase or the regional phase applications by 20 to 31 months without sacrificing priority. As mentioned earlier, it is possible to file national phase applications in 30<sup>th</sup> or 31<sup>st</sup> months in many countries without opting for preliminary examination. The actual time limits for each country can be seen at <http://www.wipo.int/pct/guide/en/> for each country by clicking for the time limit for that country.

#### **45. Which is the appropriate office in India in relation to PCT applications?**

A PCT application can be filed in any of the Branch Offices of the Patent Office located at New Delhi, Chennai, Mumbai and Kolkata (Head Office). Any of these Offices shall function as a receiving office, designated office and elected office for the purpose of international applications filed under the Treaty.

An international application shall be filed in the Patent Office which would process the application in accordance with these rules and the provisions under the PCT.

#### **46. What is the cost of filing a PCT application?**



The cost of filing a PCT application by an Indian Applicant is as follows:

1.	Transmittal Fees	Rs.8,000/- for legal entity and Rs.2000/- for individuals
2.	International Filing Fee	US\$ 1,367 (will be increased to US\$1,520 w.e.f. 01.09.2011)
3.	Fee per sheet over 30 sheets	US\$15 (will be increased to US\$17 w.e.f. 01.09.2011)
4.	Search Fee	US\$ 314 to US\$ 2,443 depending on the International Searching Authority (ISA) selected by the applicant

All fees payable are reduced by 90% for the applications filed by any individual as an applicant who resides in a PCT contracting state where the per capita national income is below US\$3000.

**47. Where do you pay the fees and in which currency?**

All types of fees are payable at the receiving office and it is the responsibility of the receiving office to remit the search fees to the concerned office if the receiving office is not the search authority. Similarly, all other charges due to other agencies would be remitted by the receiving office. The fees are payable in the currency acceptable to the receiving office. As an Indian you can pay all the fees in Indian rupees.

**48. What are the criteria to be used for naming inventors in an application for patent?**

The naming of inventors is normally decided on the basis of the following criteria:

- i. All persons who contribute towards development of patentable features of an invention should be named inventor(s).
- ii. All persons, who have made intellectual contribution in achieving the final results of the research work leading to a patent, should be named inventor(s).
- iii. A person who has not contributed intellectually in the development of an invention is not entitled to be included as an inventor.
- iv. A person who provides ideas needed to produce the 'germs of the invention' need not himself / herself carry out the experiments, constructs the apparatus with his/her own hands or make the drawings himself/herself. The person may take the help of others. Such persons who have helped in conducting the experiments, constructing apparatus or making the drawings or models without providing any intellectual inputs are not entitled to be named inventors.

Quite often difficulties are experienced in deciding the names of inventors. To avoid such a situation, it is essential that all the scientists engaged in research should keep factual, clear and accurate record of daily work done by them in the form of

diary. The pages in the diary should be consecutively numbered and the entries made be signed both by the scientists and the concerned leader.

#### **49. What is the nature of information needed while consulting a patent attorney?**

As an inventor one should share the complete invention with a patent attorney in the same manner as a patient confides in a doctor. As the doctor may not be able to write a correct prescription without knowing the details of the disease/problem, a patent attorney may not be able to draft a good specification in the absence of details about the invention. Following points should be kept in mind while discussing with the attorney:

- i. Provide complete details of the invention including failures, if any, on the way to the invention.
- ii. Do not feel bad if attorney asks you questions like where did you get the idea from or did you copy the idea from somewhere or are you keeping all inventors working with you on the inventorship or have you published the invention or disclosed it in a seminar/conference or have you displayed the invention in an exhibition? A patent document is a techno-legal document; hence precautions have to be taken right from the first step. You must provide/furnish correct information to the attorney and you may even show your laboratory note book/log book to the attorney. This will help the attorney / agent to explain the inventive step in a precise manner and draft a good specification and associated claims.
- iii. Explain the central theme of the invention along with novelty, inventiveness and utility of the invention.
- iv. Share all the prior art documents in your possession with the attorney.
- v. If you have developed an improved version of a known product/process, admit it and be totally honest. This would help the attorney in drafting precise claims and avoid excessive claims, which might be struck down immediately or at a later date.
- vi. A detailed description of the best way of putting the invention into practical use, results of your tests and trials, etc., including all failures and defects should be shared with the attorney.
- vii. Alternative ways of using the invention, and the substitutes or parts of it may be discussed.
- viii. It may be worth drafting the patent wide enough to cover less satisfactory alternatives as well so as to prevent rivals from marketing a less satisfactory competing product which because of its defects might bring the whole genre of product into disrepute or which may be cheaper.
- ix. Both after an initial search and during the course of the filing and grant of a patent application, it is important to respond quickly and accurately to queries which the

patent attorney may have. In addition the client should also keep the patent attorney informed of any new developments in the field of invention carried by the patentee or some one else.

**50. What is the distinction between a patented invention and know how?**

Patent laws do not require that the information disclosed in the patent specification be sufficient for commercial exploitation of the invention. Thus, a patent will usually not disclose sufficient information for commercialization. Know how on the other hand, covers all information necessary to implement and commercialize the invention such as setting up a production plant, operating conditions, plant layout designs, details of the production methods, various designs and drawings etc. It is this know how which is traded while transferring technology. Know how is usually kept as a trade secret and not shared with public. Know how is not protected through patents as most of it may be non-patentable matter and one does not take patent on the remaining parts to avoid public disclosure. A know how developed around an existing patent and commercialized subsequently may be an infringement of the patent unless the patentee has agreed to commercialization on mutually agreed terms.

# Copyrights

## 70. What does copyright cover?

- (i) Literary, dramatic and musical work. Computer programs/software are covered within the definition of literary work;
- (ii) Artistic work;
- (iii) Cinematographic films which include sound track and video films;
- (iv) Record-any disc, tape, perforated roll or other device.

## 71. What are the rights of a copyright holder (which when violated lead to infringement)?

(a) In the case of **literary, dramatic or musical work**, not being a computer program:-

- (i) to reproduce the work in any material form including the storing of it in any medium by electronic means;
- (ii) to issue copies of the work to the public not being copies already in circulation;
- (iii) to perform the work in public, or communicate it to the public;
- (iv) to make any cinematography film or sound recording in respect of the work;
- (iv) to make any translation of the work; to make any adaptation of the work;
- (v) to do, in relation to a translation or an adaptation of the Work, any of the acts specified in relation to the work in Sub-clauses (i) to (vi);

(b) In the case of **computer program** -

- (i) to do any acts specified in clause (a);
- (ii) to sell or give on hire, or offer for sale or hire any copy of the computer program, regardless of whether such copy has been sold or given on hire on earlier occasions;

(c) In the case of an **artistic work** –

- i. to reproduce the work in any material form including depiction in three dimensions of a two dimensional work or in two dimensions of a three dimensional work;
- ii. to communicate the work to the public;
- iii. to issue copies of the work to the public not being copies already in circulation;
- iv. to include the work in any cinematography film;
- v. to make any adaptation of the work;

- vi. to do, in relation to a translation or an adaptation of the work, any of the acts specified in relation to the work in sub-clauses (i) to (vi);

(d) In the case of a **cinematography film** -

- i. to make a copy of the film including a photograph of any image forming part thereof;
- ii. to sell or give on hire or offer for sale or hire, any copy of the film, regardless of whether such copy has been sold or given on hire on earlier occasions;
- iii. to communicate the film to the public;

(e) In the case of **sound recording** -

- i. to make any other sound recording embodying it;
- ii. to sell or give on hire or offer for sale or hire, any copy of the sound recording, regardless of whether such copy has been sold or given on hire on earlier occasions;
- iii. to communicate the sound recording to the public;

**Explanation:** - For the purpose of this section, a copy which has been sold once shall be deemed to be a copy already in circulation.

**72. How is computer defined for the purpose of copyright?**

Computer includes any electronic or similar device having information processing capabilities.

**73. What is the definition of a computer program?**

Computer program means a set of instructions expressed in words, codes, schemes or any other form, including a machine readable medium, capable of causing a computer to perform a particular task or achieve a particular result.

**74. What is the term of a copyright?**

- a. If published within the life time of the author of a literary work, the term is for the life time of the author plus 60 years.
- b. For cinematography films, records, photographs, posthumous publications, anonymous publication, works of government and international agencies, the term is 60 years from the beginning of the calendar year following the year in which the work was published.
- b. For broadcasting, the term is 25 years from the beginning of the calendar year following the year, in which the broadcast was made.

**75. Is it necessary to deposit accompanying documents of the computer program for which copyright is being sought?**

Documentation which normally accompanies the program is regarded as separate work and for this reason if the same has to be registered, it must be separately registered and not combined with the computer program in a single application.

**76. If an employee in a company develops a program, would this employee own the copyright?**

No. In the case of a program made in the course of author's employment under a contract of service or apprenticeship, the employer shall, in the absence of any agreement to the contrary, be the first owner of the copyright.

**77. If an independent third party develops a program for a company, who owns the copyright?**

The copyright in works created by third parties on commission do not automatically belong to commissioning party. If the third party is an independent contractor, it is essential for the commissioning party to obtain the copyright through a written deed of assignment. It is a common misconception that the copyright automatically belongs to the commissioning party. Thus, it is only where the developer is an employee creating the work under a contract of service that the rights belong to the employer.

**78. What is the rule for the transfer of copyright?**

The owner of the copyright in an existing work or prospective owner of the copyright in a future work may assign to any person the copyright, either wholly or partially in the following manner.

- i. for the entire world or for a specific country or territory; or
- ii. for the full term of copyright or part thereof ; or
- iii. relating to all the rights comprising the copyright or only part of such rights.

**79. Is there a possibility of divulging secrets through deposit of source code?**

Once the copyright is registered, the work is open to public inspection. For this reason, it is advisable, only to file a small extract of the computer program rather than the full program itself. It is important, however, to know that the part of the computer program which is not being filed would remain the trade secret of the owner and can be subject matter of a protection against any person who wrongfully obtains and utilizes the said program.

**80. In order to further ensure that secrets are protected, is deposition of computer program in object code permissible?**

Although the recent amendment (1994) in the Copyright Act enlarges the meaning of a computer program, it is still not very clear as to whether it includes both object code and

source code. However, keeping in mind the proclaimed object of the amendment, presumably the benefit of the Copyright Act will be available to both. As per experts' opinion, it is easier to determine from source code whether the deposit represents copyrightable material. Deposit of object code may be possible, but registration presumably would be accepted pending on assurance that the code does represent copyrightable material. Procedures for these do not exist at present with the Copyright Office.

**81. In some of the programs, the screens could be the most commercially significant aspect. Is it necessary to register the program screen separately from the underlying code?**

Generally, all copyrightable expressions embodied in a computer program, including screen displays, are protectable. However, unlike a computer program, which is a literary work, screen displays are artistic work and cannot therefore be registered in the same application as that covering the computer program. A separate application giving graphic representation of all copyrightable elements of the screen display is necessary.

**82. What notice needs to be put on computer program copies to seek copyright protection?**

When a work is published by authority of the copyright owner, a notice of copyright may be placed on publicly distributed copies. As per the Berne Convention for protection of literary and artistic works, to which India is a signatory, use of copyright notice is optional. It is, however, a good idea to incorporate a copyright notice.

**83. What are the major provisions in the amended Copyright Act, 1999 with regards to computer programs**

The major provisions of **Copyright Act** are:-

- (i) the doing of any act necessary to obtain information essential for operating interoperability of an independently created computer program with other programs by a lawful possessor of a computer program provided that such information is not otherwise readily available;
- (ii) the 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;
- (iii) the making of copies or adaptation of the computer program from a personally legally obtained copy for non-commercial personal use.

**84. What is the cost of filing copyright application in India?**

Some important fees are given below :-

<b>S. No</b>	<b>Action</b>	<b>Official fee</b>
1	For an application for registration of copyright in a- (a) literary, dramatic, musical or artistic work (b) literary or artistic work which is used or is capable of being used in relation to any goods	Rs.50 per work Rs.400 per work
2	For an application for registration of copyright in a Cinematograph Film	Rs.600 per work
3	For an application for registration of copyright in a sound recording	Rs.400 per work



# Designs

## **51. What does the term 'Design' mean according to the Designs Act, 2000?**

We see so many varieties and brands of the same product (e.g., car, television, a piece of furniture, mineral water bottle etc.) in the market, which look quite different from each other. If the products have similar functional features or have comparable price tags, the eye appeal or visual design of a product determines the choice. Even if similarities are not close, a person may decide to go for a more expensive item because that item has a better look or color scheme suiting the person's taste and choice. What is being said is that the external design or color scheme or ornamentation of a product plays a key role in determining the market acceptability of the product over other similar products. Therefore, if you have a good external design that gives you an advantage then you must have a system to protect the features. This protection is provided by the Designs Act, 2000 in India. "Design" means only the features of shape, configuration, pattern, ornament or composition of lines or colours applied to any article whether in two dimensional or three dimensional or in both forms, by any industrial process or means, whether manual, mechanical or chemical, separate or combined, which in the finished article appeal to and are judged solely by the eye; but does not include any mode or principle of construction or anything which is in substance a mere mechanical device. Functional aspects of design are not covered in this Act.

## **52. What are the types of designs not registrable under the Act?**

A design which: -

- (a) is not new or original; or
- (b) has been disclosed to the public anywhere in India or in any other country by publication in tangible form or by use in any other way prior to the filing date, or where applicable, the priority date of the application for registration; or
- (c) is not significantly distinguishable from known designs or combination of known designs; or
- (d) comprises or contains scandalous or obscene matter, shall not be registered.

## **53. What is meant by an 'article' under the Designs Act, 2000?**

Article means any article of manufacture and any substance, artificial, or partly artificial and partly natural; and includes any part of an article capable of being made and sold separately.

## **54. What is the object of registration of designs?**

The Designs Act protects new or original designs so created to be applied or applicable to particular article to be manufactured by industrial process or means. Sometimes purchase of articles for use is influenced not only by their practical efficiency but also by their appearance. The object of design registration, therefore, is to see that the artisan, creator

or originator of a design is not deprived of his bonafide reward by others applying it to their goods.

**55. What are the essential requirements for the registration of design under the Designs Act, 2000?**

1. The design should be new or original, not previously published or used in any country before the date of application for registration. The novelty may reside in the application of a known shape or pattern to new subject matter. However, if the design for which application is made does not involve any real mental activity for conception, then registration may not be considered.
2. The design should relate to features of shape, configuration, pattern or ornamentation applied to an article. Thus, designs of industrial plans, layouts and installations are not registrable under the Act.
3. The design should be applied to any article by any industrial process. Normally, designs of artistic nature like painting, sculptures and the like which are not produced in bulk by any industrial process are excluded from registration under the Act. Paintings and sculptures are subject matter of copyright.
4. The features of the designs in the finished article should appeal to and are judged solely by the eye. This implies that the design must appear and should be visible on the finished article, for which it is meant. Thus, any design in the inside arrangement of a box, money purse or almirah may not be considered for registration, as these are generally put in the market in the closed state.
5. Any mode or principle of construction or operation or any thing, which, in substance is a mere mechanical device, would not qualify for registrable design. For instance, a key having its novelty only in the shape of its corrugation or bend at the portion intended to engage with levers inside the lock associated with, cannot be registered as a design under the Act. However, when any design suggests any mode or principle of construction or mechanical or other action of a mechanism, a suitable disclaimer in respect thereof is required to be inserted on its representation, provided there are other registrable features in the design.
6. The design should not include any trade mark or property mark or artistic work.

**56. Can stamps, labels, tokens, cards, be considered an article for the purpose of registration of a design?**

No. Because once the alleged design i.e., ornamentation is removed only a piece of paper, metal or like material remains and the article referred ceases to exist. Article must have its existence independent of the design applied to it. So, the design as applied to an article should be integral with the article itself.

**57. When does the applicant for registration of design get the registration certificate?**

When an application for registration of a design is in order, it is accepted and registered, then a certificate of registration is issued to the applicant. However, a separate request should be made to the Controller for obtaining a certified copy of the certificate for legal proceedings with requisite fee.

**58. What is a Register of Designs?**

The Register of Designs is a document maintained by the Patent Office, Kolkata as a statutory requirement. It contains the design number, date of filing and reciprocity date (if any), name and address of proprietor and such other matters as would affect the validity of proprietorship of the design and it is open for public inspection on payment of prescribed fee and extract from register may also be obtained on request with the prescribed fee.

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

The term of a registered design is 15 years. Initially the right is granted for a period of 10 years, which can be extended, by another 5 years by making an application and paying a fee of Rs. 2000/- to the Controller before the expiry of initial 10 years period. The proprietor of design may make application for such extension as soon as the design is registered.

**60. Is it mandatory to make the article by industrial process or means before making an application for registration of design?**

No, design means a conception or suggestion or idea of a shape or pattern, which can be applied to an article or intended to be applied by industrial process or means.

**61. Why is it important for filing the application for registration of design at the earliest possible?**

First to file rule is applicable for registrability of design. If two or more applications relating to an identical or a similar design are filed on different dates, the first application will be considered for registration of design.

**62. Can the same applicant make an application for the same design again, if the prior application has been abandoned?**

Yes, the same applicant can apply again since no publication of the abandoned application is made by the Patent Office, provided the applicant does not publish the said design in the meanwhile.

**63. Are the registered designs open for public inspection?**

Yes, registered designs are open for public inspection only after publication in the official gazette on payment of prescribed fee of Rs.500/- on a request in Form -5.

**64. Can an applicant file the application for registration of design himself?**

The application for registration of design can be filed by the applicant himself or through a professional person (i.e. patent agent, legal practitioner). However, applicants not residents of India have to file applications through an agent residing in India.

**65. Can appeal for cancellation of the registration of a design be made? What are the grounds for cancellation?**

The registration of a design may be cancelled at any time after the registration of design on a petition for cancellation in Form 8 with a fee of Rs.1500/- to the Controller of Designs on the following grounds:

1. That the design has been previously registered in India;
2. That it has been published in India or elsewhere prior to the date of registration;
3. That the design is not new or original;
4. That the design is not registrable;
5. That it is not a design under Clause (d) of Section 2.

**66. What is the penalty for the piracy of registered design?**

If anyone contravenes the copyright in a design he is liable for every offence to pay a sum not exceeding Rs.25,000/- to the registered proprietor subject to a maximum of Rs.50,000/- recoverable as contract debt in respect of any one design.

**67. What is the cost of filing design application in India?**

The fee for filing application for registration of design in India is Rs.1,000/-.

**68. What does Hague Agreement on Industrial Designs signify?**

The Hague Agreement Concerning the International Deposit of Industrial Designs first came into existence in 1925. The Agreement aims at providing a mechanism for securing protection of an industrial design in all the member countries by means of an international deposit. The international deposit could be in the form of the industrial product or drawing or photograph or any other graphic representation of the said design. The duration of protection was 15 years from the date of deposit; this term is divided in two periods namely, one period of five years and the other of ten years. This Agreement is now being implemented by the WIPO.

## **69. What are the changes made to the Hague Agreement?**

A Diplomatic Conference was held in June and July 1999 to bring out some amendments in the Hague Agreement. The revised agreement will come into effect after it has been ratified by six of the initial signatory nations to the Agreement. The idea is to provide a way through which a single design application can give rights to protection for that design in member countries. The international design application must designate countries where protection will be sought. The designated countries can refuse to award design rights, if the application does not meet the requirements of national laws. The Agreement does not lay down any particular standards for registrability of the design, leaving this to national laws. Once registered, the international registration will have the same effect as a national design registration in those designated countries that have not refused grant for national registration. Other main features of the revised agreement/treaty are:-

1. International design protection will be available to nationals of a contracting country, domiciled in a contracting country or have industrial or commercial establishment in a contracting state.
2. An international design application may be filed either at the applicant's national office or directly with the International Bureau of WIPO.
3. Two-dimensional designs (textile designs) would be eligible for protection.
4. A formalities examination will be carried out by the International Bureau and then the application will be published if it is found to satisfy the formalities. The publication will be made six months after the registration. This can be deferred to 30 months in some special cases.
5. The International Bureau will, after the registration, send a copy of the application to each of the designated countries. These countries have to inform the Bureau within six months if national requirements are not met. However, countries that examine design applications for novelty or where opposition system exists, this time is increased to 12 months.
6. Multiple designs may be included in the same application. It is however, required that all products to which such designs relate must be in the same class under the Locarno Classification.

It can be seen that there are some similarities with the PCT system for patent applications. India is not yet a member of the Hague Agreement and hence, the above provisions or description may not be of immediate relevance to us. However, there is a strong need to monitor the developments in this area.

# Trademarks

## **85. How is the Trademarks Act 1999 different from the Trade and Merchandising Marks Act 1958?**

Enactment of the Trademarks Act 1999 is a big step forward from the Trade and Merchandise Marks Act 1958 and the Trademark Act 1940. The newly enacted Act has some features not present in the 1958 Act and these are:-

1. Registration of service marks, collective marks and certification trademarks.
2. Increasing the period of registration and renewal from 7 years to 10 years.
3. Allowing filing of single application for registration in more than one class.
4. Enhanced punishment for offences related to trademarks.
5. Exhaustive definitions for terms frequently used.
6. Simplified procedure for registration of registered users and enlarged scope of permitted use.
7. Constitution of an Appellate Board for speedy disposal of appeals and rectification applications which at present lie before High Court.

## **86. How is "Trademark" defined?**

A trademark is a distinctive sign, which identifies certain goods or services as those produced or provided by a specific person or enterprise. A trademark may be one or a combination of words, letters and numerals. It may also consist of drawings, symbols, three-dimensional colours and combination of colours. It is used by traders/companies/firms etc to distinguish their goods and services from those of their competitors. A consumer associates some level of quality/price/prestige with the goods of a particular trademark. In other words the consumer uses the trademark for making a choice while buying a particular product. There are so many examples in our day to day life such as TATA, BATA, Liberty, Brooke Bond, Dabur, Baidyanath, Park Avenue, SAIL and so on. Trademarks do not protect the design or the ideas behind the goods or services from imitation or duplication, but prevent other traders/company/firm from deceiving customers into believing that goods or services actually produced by them were produced by the trademark holder.

## **87. What are "Well-known Trademarks"?**

Well-known trademarks in relation to any goods or services, means a mark which has become known to a substantial segment of the public which uses such goods or receives such services that the use of such mark in relation to other goods or services is likely to be taken as indicating a connection in the course of trade or rendering of services between those goods or services and a person using the mark in relation to the first-mentioned goods or services.

**88. What is the meaning of "Service" in the Trademark Act 1999?**

Service means service of any description which is made available to potential users and includes the provision of services in connection with business of any industrial or commercial matters such as banking, communication, education, financing, insurance, chit funds, real estate, transport, storage, material treatment, processing, supply of electrical or other energy, boarding, lodging, entertainment, amusement, construction, repair, conveying of news or information and advertising.

**89. How are the terms "Certification Trademarks" and "Collective Marks" defined in the Act?**

Certification trade mark means a mark capable of distinguishing the goods or services in connection with which it is used in the course of trade which are certified by the proprietor of the mark in respect of origin, material, mode of manufacture of goods or performance of services, quality and accuracy.

Collective Mark means a trademark distinguishing the goods or services of an association of persons (not being a partnership within the meaning of the Indian Partnership Act, 1932).

**90. What is the term of a registered trademark?**

The initial registration of a trademark shall be for a period of ten years but may be renewed from time to time for an unlimited period by payment of the renewal fees.

**91. What is the cost of filing trademarks application in India?**

Some important fees are given below:

No	Action	Official fee
1	Application to register a trade mark for a specification of goods or services included in one class	Rs.2500/-
2	Application to register a textile trade mark consisting exclusively of numerals or letters or any combination thereof for specification goods included in one item	Rs.2500/-
3	Application to register a collective mark for a specification of goods or services included in one class	Rs.10,000/-
4	Application to register a certification trade mark for specification of goods or services included in one class	Rs.10,000/-
5	Renewal of registration	Rs.5,000/-
6	Application for approval of Registrar	(i) For first mark Rs.2500/- (ii) For every additional mark Rs.500/-

7	Application under Geographical Indications of Goods (Registration and Protection) Act, 1999 to refuse or invalidate registration of a trade mark consisting of Geographical Indication etc.	Rs.3000/-
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## 92. What is the Madrid Agreement?

The Madrid Agreement was adopted on April 14, 1891 to facilitate protection of a trademark or service mark in several countries by means of a single international registration. As on July 15, 1999, 54 countries are party to this Agreement mainly belonging to Europe, countries of Africa and four countries in the Far East namely, China, the Democratic People's Republic of Korea, Mongolia and Vietnam. The United Kingdom, the United States of America, most Latin American countries, Japan and India are not signatories to this agreement. The Agreement covers both trademarks and service marks.

## 93. What are the main features of the Madrid Agreement?

Main features of the Madrid Agreement are as follows:-

1. An applicant must be a national of a member country. A person having his domicile or a real and effective industrial or commercial interest in such a country is also eligible. It may be noted that this would be governed by the national laws of the country in question.
2. A mark to be registered in member states should be first registered at the national level in the country of origin of the applicant. The first registration is called 'basic registration'.
3. The country having given the basic registration can only transmit there quest for international filing to the International Bureau of the World Intellectual Property Organization (WIPO) along with the list of the countries in which protection is being sought. There is no provision for directly filing a request under the Agreement.
4. It may be iterated that the country of origin has to be a member state. The role of the office of the country of origin is not only to send the application for international registration but also to certify that the mark which is the subject of the international registration, is the same mark which is the subject of the basic registration.
5. For each application fees has to be paid for each designated country and WIPO. The fees paid for the designated countries, is called the 'complementary fee'.
6. The International Bureau notifies the international registration to the offices of the designated countries and publishes it in a monthly periodical called 'The WIPO Gazette of International Marks'.
7. If the basic registration is cancelled for some reasons, in the country of origin, during the first five years, the international registration automatically stands cancelled in all the designated countries. This also gives an advantage to a person to oppose the registration of a mark only in the country of origin and that person need not oppose it in all the designated countries. This possibility of challenging



an international registration through a national registration is referred to as 'Central Attack' feature of the Agreement.

#### **94. What is the Madrid Protocol?**

The Protocol relating to the Madrid Agreement concerning the International Registration of Marks was adopted at Madrid on June 27, 1989. The Protocol, which entered into force on December 1, 1995, retains the basic features of the Madrid Agreement. As on July 15, 1999, 39 countries have acceded to the Protocol. The Protocol was formed to remove some of the features of the Madrid Agreement, which posed some obstacles to accession by several countries. These features are:

2. For an international registration, it is essential to first register a mark at the national level. The time required for obtaining a mark at the national level varies from country to country. Hence some parties do suffer.
3. Within one year, a designated member country has to examine and issue a notice of refusal by giving all the grounds for refusal. The period was considered short.
4. A uniform fee is paid for the designation of a member country. This was found to be inappropriate for countries with high level of national fees.
5. An international registration is linked to the basic registration during the initial five years and the former gets cancelled if latter is cancelled. The fact, that grounds under which a mark is cancelled in the country of origin need not necessarily exist in every other designated country, is overlooked.
6. The only working language of the Madrid Agreement is French.

#### **Innovations introduced by the Madrid Protocol are:**

1. An international application need not necessarily be based on a registration made by the Office of Origin but can also be based on an application filed with the Office of Origin. This makes it convenient for countries with full examination system where the national registration takes time. It also makes it possible to claim the right of priority of six months under the Paris Convention.
2. A Contracting Party can receive the fee under the existing Madrid Treaty system through its share in the international fees collected for each designation made as in the Madrid Treaty. Alternatively, the member country can choose "Individual fee" system for each designation made, which should be an amount not more than the national fee for a ten-year registration. The "Individual fee" system makes an attractive proposition for countries with high level of national fees.
3. It is possible to transform an international registration into national or regional application in the designated Contracting Parties, if the basic registration is cancelled for some reasons, as in the case of "Central Attack".
4. An applicant may choose to base an international registration in any of the Contracting States with which he has connection through nationality, domicile or establishment.

# IC Layout Designs

## 95. What does Semiconductor Integrated Circuits Layout-Design Act, 2000 cover?

It provides protection for semiconductor IC layout designs. Layout design includes a layout of transistors and other circuitry elements and includes lead wires connecting such elements and expressed in any manner in a semiconductor IC. Semiconductor IC 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.

## 96. What is not registrable as IC layout design?

An IC layout design is not registrable if it is: -

1. Not original;
2. Commercially exploited anywhere in India or in a convention country;
3. Inherently not distinctive;
4. Inherently not capable of being distinguishable from any other registered layout design

**Note:** Design not exploited commercially for more than 2 years from date of registration of application shall not be treated as commercially exploited for the purpose of this Act.

## 97. What is the term of an IC layout design protection?

The term is 10 years from the date of filing or from the date of first commercial exploitation anywhere in any country whichever is earlier.

## 98. What constitutes an infringement under the Act?

Reproducing, importing, selling and distributing the IC layout design for commercial purposes only constitutes infringement. A layout design created on the basis of scientific evaluation of a registered layout design shall not constitute any infringement.

## 99. What is the cost of registering IC layout design application in India?

Some important fees are given below:

No	Action	Official fee
1	On application to register a layout - design	Rs.5000/-
2	On request for certificate of the Registrar	Rs.1000/-

# Geographical Indications

## **100. What does the term 'Geographical Indications (GI)' stand for?**

Geographical Indications are names associated with goods which identify such goods as agricultural goods, natural goods or manufactured goods as originating, or manufactured in the territory of a country, or a region or a locality in that territory, where a given quality, reputation or other characteristics of such goods is essentially attributable to its geographical origin. Some examples of GI are Darjeeling Tea, Pochampalli Saree, Chanderi Saree, Kanjeevaram Silk, Champagne Wine, Scotch Whisky.

## **101. Who can apply for GI's registration?**

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, who are desirous of registering geographical indication in relation to such goods can apply for GI's registration.

## **102. Who is a registered proprietor of a geographical indication?**

Any association of persons or of producers or any organisation or authority established by or under the law can be a registered proprietor. Their name should be entered in the Register of Geographical Indication as registered proprietor for the Geographical Indication applied for.

## **103. Who can use the registered geographical indication?**

An authorised user has the exclusive rights to the use of geographical indication in relation to goods in respect of which it is registered.

## **104. Who is an 'authorised user'?**

'Authorised user' is any person claiming to be the producer of the goods in respect of which a geographical indication has been registered. For becoming an authorized user the person has to apply in writing to the Registrar in prescribed manner and by paying requisite fee.

## **105. Who can be considered a 'producer' for the purposes of this act?**

'Producer' in relation to goods, means any person who :-

- (a) Produces, processes or packages agricultural goods
- (b) Exploits natural goods
- (c) Makes or manufactures handicraft or industrial goods.

**106. Can all geographical indications be registered?**

No, a GI cannot be registered if :-

- its use is likely to deceive or cause confusion or be contrary to any law;
- it comprises or contains scandalous or obscene matter or any matter likely to hurt religious susceptibilities of any class or section of the citizens of India;
- it is a generic name;
- it has ceased to be protected in their country of origin or which have fallen into disuse in that country;
- it is falsely represented by persons claiming that goods originate in another territory, region or locality as the case may be.

**107. What is the punishment in the Act for falsifying GI?**

A sentence of imprisonment for a term between six months to three years and a fine between fifty thousand rupees and two lakh rupees is provided in the Act. The court may reduce the punishment under special circumstances.

**108. What is the term of GI protection?**

The registration of a GI shall be for a period of ten years but may be renewed from time to time for an unlimited period by payment of the renewal fees.

**109. What is the cost of registering a GI in India?**

Some important fees are given below:-

No	Action	Official fee
1	On application for the registration of a geographical indication for goods included in one class	Rs.5000/-
2	On a single application for the registration of a geographical indication for goods in different classes	Rs.5000/- for each class
3	On application for the registration of an authorized user of a registered geographical indication	Rs.500/-
4	For renewal of an authorized user	Rs.1,000/-

# Protection of New Plant Varieties

## 110. Is there any Act for protecting a new plant variety in India?

The Protection of Plant Varieties and Farmers' Rights Act 2001 was enacted in India to protect the new plant varieties. Rules for the same were notified in 2003. The Act has now come into force. The Protection of Plant Varieties and Farmers' Rights Authority has been set up and is responsible to administer the Act. The office of the Registrar has started receiving applications for registration of twelve notified crops viz. rice, lentil, maize, green gram, kidney bean, black gram, chickpea, pearl millet, pigeon pea, sorghum, field pea, bread wheat.

Under the TRIPS agreement it is obligatory on part of a Member to provide protection to new plant variety either through patent or an effective sui generis system or a combination of these two systems. India was therefore under an obligation to introduce a system for protecting new plant variety. India opted for sui generis system and enacted The Protection of Plant Varieties and Farmers' Rights Act 2001. However, in many countries such plants can be protected through Breeders' Rights, patents and UPOV Convention.

## 111. What are the objectives of Protection of Plant Varieties and Farmers' Rights Act in India?

The objectives of the Protection of Plant Varieties and Farmers' Rights Act are:

- (i) to stimulate investments for research and development both in the public and the private sectors for the developments of new plant varieties by ensuring appropriate returns on such investments;
- (ii) to facilitate the growth of the seed industry in the country through domestic and foreign investment which will ensure the availability of high quality seeds and planting material to Indian farmers; and
- (iii) to recognize the role of farmers as cultivators and conservers and the contribution of traditional, rural and tribal communities to the country's agro biodiversity by rewarding them for their contribution through benefit sharing and protecting the traditional right of the farmers.

More importantly this act provides safeguards to farmers by giving farmers' rights while providing for an effective system of protection of plant breeders' rights. The Act seeks to safeguard researchers' rights as well. It also contains provisions for safeguarding the larger public interest. The farmer's rights include his traditional rights to save, use, share or sell his farm produce of a variety protected under this Act provided the sale is not for the purpose of reproduction under a commercial marketing arrangement.

## 112. What kind of varieties are registerable under the plant variety Act?

1. A new variety if it conforms to the criteria of novelty, distinctiveness, uniformity and stability.

2. An extant variety if it conforms to criteria of distinctiveness, uniformity and stability.

**113. How is an “Extant Variety” defined in PPVFR Act, 2001?**

An “**Extant Variety**” means a variety, which is–

- (i) notified under section 5 of the Seeds Act, 1966 (54 of 1966); or
- (ii) a farmers’ variety; or
- (iii) a variety about which there is common knowledge; or
- (iv) any other variety which is in the public domain.

**114. What is the meaning of Farmers’ Variety as per PPVFR Act, 2001?**

“Farmers’ Variety” means a variety which–

- (i) has been traditionally cultivated and evolved by the farmers in their fields; or
- (ii) is a wild relative or land race of a variety about which the farmers possess the common knowledge;

where farmer means any person who (i) cultivates crops by cultivating the land himself; or (ii) cultivates crop by directly supervising the cultivation of land through any other person; or (iii) conserves and preserves, severally or jointly, with any person any wild species or traditional varieties or adds value to such wild species or traditional varieties through selection and identification of their useful properties.

**115. What is the meaning of “Essentially Derived Variety” as per PPVFR Act, 2001?**

“Essentially Derived Variety” is a variety which is predominantly derived from another variety (protected or otherwise) and conforms to the initial variety in all aspects except for the differences which result from the act of derivation, and yet is clearly distinguishable from such initial variety

**116. How novelty, distinctiveness, uniformity & stability have been defined in the Protection of Plant Varieties and Farmers’ Rights Act?**

**A) Novelty** – Plant variety is novel if at the date of filing of the application for registration for protection, the propagating or harvested material of such variety has not been sold or otherwise disposed of by or with the consent of breeder or his successor for the purpose of exploitation of such variety–

- (i) in India earlier than one year or
  - (ii) outside India , in the case of trees or vines earlier than six years or in any other case, earlier than four years,
- before the date of filing such application:

Provided that a trial of a new variety which has not been sold otherwise disposed of shall not affect the right to protection.

Provided further that the fact that on the date of filing the application for registration, propagating or harvested material of such variety has become a matter of common knowledge other than through the aforesaid manner shall not affect the criteria of novelty for such variety.

- B) **Distinctiveness** – New plant variety will be considered 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.
- C) **Uniformity** – New plant variety will pass uniformity test, if subject to the variation that may be expected from the particular features of its propagation, it is sufficiently uniform in its essential characteristics.
- D) **Stability** – New plant variety will be considered stable if its essential characteristics remain unchanged after repeated propagation or, in the case of a particular cycle of propagation, at the end of each such cycle.

**Compulsory Plant Variety denomination:** After satisfying the above four essential criteria every applicant shall assign a single and distinct denomination to a variety with respect to which he is seeking registration.

### 117. What are farmers' rights?

The farmers' rights as defined in the Act are:

- (i) a farmer who has bred or developed a new variety shall be entitled for registration and other protection in like manner as a breeder of a variety under this Act;
- (ii) the farmers' variety shall be entitled for registration if the application contains declaration as specified in clause (h) or sub-section (1) of section 18;
- (iii) 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 entitled in the prescribed manner for recognition and reward from the Gene Fund.

Provided that material so selected and preserved has been used as donors of genes in varieties registrable under this Act;

- (iv) a farmer shall be deemed to be entitled to save, use, sow, resow, exchange, share or sell his farm produce including seed of a variety protected under this Act in the same manner as he was entitled before the coming into force of this Act.

**Note:** Branded seed means any seed put in a package or any other container and labelled in a manner which gives indication that such seed is of a variety protected under this Act.

In addition to the above, where any propagating material of a variety registered under this Act has been sold to a farmer or a group of farmers or any organization of farmers, the breeder of such variety shall disclose to the farmer or the group of farmers or the organization of farmers, as the case may be, the expected performance under given conditions, and if such propagating material fails to provide such performance under such given conditions, the farmer or the group of farmers or the organization of farmers, as the case may be, may claim compensation in the prescribed manner before the Authority and the Authority shall, after giving notice to the breeder of the variety and after providing him an opportunity to file opposition in the prescribed manner and after hearing the parties, direct the breeder of the variety to pay such compensation as it deems fit, to the farmer or the group of farmers or the organization of farmers, as the case may be.

### 118. Which plant varieties can not be protected under this Act?

A plant variety which is :-

- (i) not capable of identifying such variety; or
- (ii) consists solely of figures; or

- (iii) is liable to mislead or to cause confusion concerning the characteristics, value, identify of such variety, or the identity of breeder of such variety;
- (iv) is likely to deceive the public or cause confusion in the public regarding the identity of such variety;
- (v) is comprised of nay matter likely to hurt the religious sentiments respectively of any class or section of the citizens of India;
- (vi) is prohibited for use as a name or emblem for any of the purposes;
- (vii) is comprised of solely or partly of geographical name.

#### **119. What is the term of plant variety protection?**

- (i) in the case of trees and vines, eighteen years from the date of registration of the variety;
- (ii) in the case of extant varieties, fifteen years from the date of the notification of that variety by the Central Government under section 5 of the Seeds Act, 1966
- (iii) in the other cases, fifteen years from the date of registration of the variety.

Initially the certificate of registration shall be valid for nine years in the case of trees and vines and six years in the case of other crops and may be revived and renewed for the remaining period on payment of fees as may be fixed by the rules.

#### **120. What is the cost of registering a plant variety?**

Some important fees are given below:

No.	Action	Official fee
1	Conducting tests	Dependent on the nature and type of test subject to a maximum of Rs. 50,000 per entry
2	Fees for registration of essentially derived varieties	Individual – Rs. 5,000/- Educational – Rs. 7,000/- Commercial –Rs. 10,000/-
3	Renewal fee per year	Individual – Rs. 5,000/- Educational – Rs. 7,000/- Commercial – Rs. 10,000/-
4	Application for benefit sharing	Rs. 5,000/-

#### **121. What is UPOV?**

UPOV is an abbreviation of Union pour la Protection des Obtentions Vegetales (Union for protection of new varieties of plant). It is an international convention which provides a common basis for the examination of plant varieties in different member States of UPOV for determining whether a plant variety merits protection under UPOV or not.