

Mumbai University
3 Years LLB- Semester VI (April 2024),
Intellectual Property Rights (IPR)
Questions & Answers.

Q1) What is the meaning of Intellectual Property?

Ans) Intellectual Property, often abbreviated as IP, is a term that refers to unique creations of the mind. These can include things like inventions, literary and artistic works, designs, and symbols, names, and images that are used in business. These intangible assets are legally protected by a company or individual, preventing their use or implementation by others without explicit permission.

Various forms of law, such as patents, copyright, and trademarks, protect IP. These laws allow creators to gain recognition or financial benefit from their inventions or creations.

Some examples of Intellectual Property/ Types of IP:

Patents: These are exclusive rights granted for an invention.

Copyright: This is a legal term that describes the rights creators have over their literary and artistic works.

Trademarks: These are signs that can distinguish the goods or services of one enterprise from those of others.

Industrial designs: These relate to the ornamental or aesthetic aspect of an item.

Geographical indications: These are signs used on goods that originate from a specific geographical location and possess qualities, reputation, or characteristics attributable to that location.

Trade secrets: These are IP rights on confidential information which may be sold or licensed.

In essence, the concept of intellectual property is that certain products of human intellect should be given the same protective rights that apply to physical property. Even though it's an intangible asset, intellectual property can sometimes be more valuable than a company's physical assets.

Q2) What is Copyright

Ans) Copyright is a form of intellectual property protection granted under the Indian Copyright Act 1957 (Section 14 of the Act) to the creators of original works of authorship such as literary works (including computer programmes, tables and compilations), dramatic, musical and artistic works, cinematographic films and sound recordings. As per the Copyright Act, 1957 of India, copyright refers to a bundle of exclusive rights vested in the owner of copyright by virtue of Section 14 of the Act. These rights can be exercised only by the owner of copyright or by any other person who is duly licensed in this regard by the owner of copyright.

Q3) What is patent?

Ans) A patent is a form of intellectual property that provides its owner with the legal authority to prevent others from manufacturing, using, or selling an invention for a specified period of time, given that the invention is disclosed to the public. In simpler terms, a patent is a right granted by a government to an inventor. This grant gives the inventor the exclusive privilege to the patented process, design, or invention for a certain period, in return for a detailed public disclosure of the invention.

Q4) What is invention?

Ans) An invention, as per the Indian Patent Act of 1970, is defined as a new product or process that involves an inventive step and is capable of industrial application. This means the invention must be novel, non-obvious to someone skilled in the field, and must have a practical use in any form of industry.

Q5) What is Trade mark?

Ans) A trademark or service mark is a word, name, symbol, or device used to indicate the source, quality and ownership of a product or service. A trademark is used in the marketing is recognizable sign, design or expression which identifies products or service of a particular source from those of others. The trademark owner can be an individual, business organization, or any legal entity. A trademark may be located on a package, a label, a voucher or on the product itself.

Q6) What are three international conventions on Intellectual Property?

Ans) Three international conventions on Intellectual Property Rights (IPR) are:

- a) Paris Convention for the Protection of Industrial Property (1883): This convention deals with the protection of industrial property, covering patents and trademarks.
- b) Berne Convention for the Protection of Literary & Artistic Works (1886): It provides for a copyright system, protecting the rights of authors over their literary and artistic works.
- c) Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS): Administered by the World Trade Organization (WTO), this agreement sets down minimum standards for many forms of intellectual property regulation as applied to nationals of other WTO Members.

Q7) Name some international organizations that play a key role in the protection and enforcement of Intellectual Property Rights (IPR)

Ans) There are several international organizations that play a key role in the protection and enforcement of Intellectual Property Rights (IPR):

World Intellectual Property Organization (WIPO): WIPO is a specialized agency of the United Nations that is dedicated to developing a balanced and accessible international intellectual property system.

World Trade Organization (WTO): The WTO is an international organization that deals with the global rules of trade between nations. It administers the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), which sets down minimum standards for many forms of intellectual property regulation as applied to nationals of other WTO Members.

These organizations work together to ensure that intellectual property rights are respected and enforced, promoting innovation and creativity globally.

Q8) Short note on Copyright for artistic work?

Ans) Copyright for an artistic work is a form of protection provided by the legislature to authors/owners of original works of authorship from the time the works are created and expressed in a tangible form. Copyright generally belongs to the artist or creator of the work. It subsists in any original artistic work comprising of paintings, sculptures, graphics, cartoons, etchings, lithographs, photography, drawings, plans, maps, diagrams, charts, buildings, models of buildings, moulds and casts for sculptures.

Duration: A copyright in case of literary, dramatic, musical, and artistic works lasts for the life of the artist, plus 60 years after the artist's death.

Rights: If you own the copyright in an artwork, you have exclusive rights over certain uses of that work. These rights fall into two categories: economic rights and moral rights. Economic rights relate to copying, licensing, renting, lending, performing, showing the work to the public, making an adaptation of the work or translating a work.

Q9) Donoghue v/s. Allied Newspapers -

Ans) It is one of the significant case law in r/o copyright. In this case, it was held that, if a person has a brilliant idea for a story, play, or picture and he communicates that idea to another person, this another person who clothes the idea in the form of a book, or play, or picture, he becomes the author of the work, and can claim ownership of the copyright. The person who has given the idea, has no right to the product. For, Copyright exists not in ideas, but in tangible form in which it is expressed. Where a person provides the material to another for writing a book and the later (Ghost writer) writes the book on the basis, then writer is the owner of the copyright in the book.

Q10) Who is the owner of copyright of musical work?

Ans) The first owner of the Copyright in musical work is the composer of the music. However, where the work is composed in the course of employment under a contract of service, the employer will be the first owner of the Copyright.

Q11) Define performer under copyright act?

Ans) Under the Copyright Act, a "performer" is defined in Section 2 (qq) and includes an actor, singer, musician, dancer, acrobat, conjurer, snake charmer, a person delivering a lecture, or any other person who makes a performance.

Q12) Meaning of abridgement under copyright act?

Ans) Under Copyright Act, an abridgement refers to a condensed version of an original literary work. It is considered an original work and is entitled to copyright if it is new, original, and the author has invested sufficient skill and labor in its creation.

Strictly speaking, an abridgement of an author's work is a statement designed to be complete and accurate of the thoughts, opinions, and ideas expressed by the author in the original work, but set forth much more concisely in the compressed language of the abridger. This means that while the abridgement presents the same ideas as the original work, it does so in a more brief manner.

Q13) What is Adaptation under Copyright Act?

Ans) Adaptation under Copyright Law, particularly in the context of Indian law, refers to the transformation of a copyrighted work from one format to another. This could involve the conversion of a dramatic work into a non-dramatic work, the conversion of a literary or artistic work into a dramatic work, the re-arrangement of a literary or dramatic work, or the depiction in a comic form or through pictures of a literary or dramatic work.

Q14) What is the meaning of performance under copyright act 1957?

Ans) Under the Indian Copyright Act, 1957, the term "performance" is defined in Section 2(qq) and refers to the work performed by any performer. This includes actors, dancers, musicians, singers, acrobats, conjurers, snake charmers, jugglers, a person delivering a lecture or any other person who makes a performance. The term earlier included literary and artistic work only but later on its scope was broadened to include dramatic and musical work, cinematograph films and the sound recordings.

Q15) What are the classes of work in which copyright subsists as per section 13 of copy right act?

Ans) As per Section 13 of the Indian Copyright Act, 1957, copyright subsists throughout India in the following classes of works:

- a) Original literary, dramatic, musical and artistic works: This includes novels, plays, songs, paintings, etc.
- b) Cinematograph films: This includes movies and other audiovisual works.
- c) Sound recording: This includes recordings of music, spoken words, or other sounds.

Q16) Define an Indian Work under the copyright act 1957?

Ans) Under the Indian Copyright Act, 1957, an "Indian Work" is defined as a literary, dramatic, or musical work where:

- The author of the work is a citizen of India, or
- The work is first published in India, or
- In the case of an unpublished work, the author, at the time of the making of the work, is a citizen of India.

Q17) Brief note on copyright societies under copyright act

Ans) A Copyright Society is a legal entity that safeguards the interests of the owner in the product in which copyright subsists.

It is a registered collective administration society under Section 33 of the Copyright Act, 1957.

Such a society is formed by authors and other owners. The minimum membership required for registration of a society is seven.

Copyright societies assure the creative author of the commercial management of their works. They are authorized to watch out for copyright infringement and take appropriate legal action against the infringer.

They help in enforcing copyright with benefits to the parties mentioned above.

It also aids copyright owners by increasing their revenues and the general public by providing them with a convenient destination to obtain licenses from multiple right holders.

Q18) Explain the rights & Liabilities of Copyright Societies?

Ans) Rights of Copyright Societies:

- a) **Issue Licenses:** Copyright societies have the authority to issue licenses for the reproduction, performance, or communication to the public of copyrighted works. These licenses serve as legal permissions, allowing individuals or organizations to utilize copyrighted material.
- b) **Collect Fees:** Copyright societies can collect fees in relation to licenses. They can also distribute these fees among authors or other owners, provided that they had kept the money for their expenses.
- c) **Locate Infringement:** Copyright societies are authorized to watch out for copyright infringement and take appropriate legal action against the infringer.

Liabilities of Copyright Societies:

The liabilities of copyright societies are not explicitly defined in the Copyright Act. However, they are expected to operate within the confines of the law and uphold the rights of the copyright owners they represent. This includes:

- a) **Fair Distribution of Royalties:** Copyright societies are responsible for the fair distribution of royalties collected from the licensing of works to the copyright owners.
- b) **Transparency:** Copyright societies are expected to maintain transparency in their operations, particularly in relation to the collection and distribution of royalties.

c) Legal Compliance: Copyright societies must comply with all relevant laws and regulations, including those related to copyright and intellectual property.

Q19) Who is the first owner of copyright as per copyright act?

Ans) As per Section 17 of the Indian Copyright Act, 1957, the first owner of copyright is generally the author of the work. However, there are exceptions to this rule. For instance, in the case of a work made in the course of an author's employment under a "contract of service" or apprenticeship, the employer is considered as the first owner of copyright, in the absence of any agreement to the contrary.

Q20) What is dramatic work?

Ans) A "dramatic work" in the context of copyright law refers to a composition that depicts a story or narrative intended to be performed in front of an audience. This includes plays, musicals, operas, choreographed dance routines, and even mime performances.

In addition to the script or lines for a performer, a dramatic work also includes the choreographic notation. However, it does not include the film itself.

Q21) Who is author? Explain the concept of author and owner of copyright? What are the rights of copyright owner?

Ans) In the context of copyright law, an "author" is generally considered to be the creator of an original work. The specific definition can vary depending on the type of work and the jurisdiction, but it typically includes the following:

- a) In relation to a literary or dramatic work, the author is the person who created the work.
- b) In relation to a musical work, the author is the composer.
- c) In relation to an artistic work other than a photograph, the author is the artist.
- d) In relation to a photograph, the author is the person who took the photograph.
- e) In relation to a cinematograph film or sound recording, the author is the producer.
- f) In relation to any literary, dramatic, musical or artistic work which is computer-generated, the author is the person who causes the work to be created.

Author and Ownership of Copyright:

It's important to note that the author of a work is not necessarily the copyright owner.

If the author creates work for his own, he is the owner of copyright.

If the author creates the work at the instance of another person for valuable consideration, the person at whose instance the work is done is the owner of copyright. If the work is done at in the course of employment, the ownership of copyright depends on the nature of employment.

The copyright can be transferred or assigned to another person or entity, such as a publisher on which publisher shall become the owner of copyright.

Rights of the Copyright Owner

The rights of a copyright owner are quite extensive and serve to protect their intellectual property. The main rights typically granted to copyright owners:

- Right of Reproduction: This allows the copyright owner to make copies of their work in various forms.
- Right to Distribute: The owner can distribute their work in any manner they choose, including selling or licensing copies.
- Right to Create Derivative Works: This enables the owner to make adaptations or translations of their work.
- Moral Rights: These include the right to claim authorship of the work and to object to any derogatory treatment of it that might harm the author's reputation.

These rights are designed to ensure that creators can control how their work is used and distributed, and that they can receive financial compensation for their creations. The specifics can vary by jurisdiction, but these principles are widely recognized in international copyright law.

Q22) Who is registered proprietor of trade mark?

Ans) The registered proprietor of a trademark is the person or entity that is officially recorded as the owner of the trademark in the register of trademarks. This person or entity has the power to assign the trademark and receive consideration for such assignment.

In India, the registered proprietor of a trademark can create, establish, and protect the goodwill of their products or services. They can stop other traders from unlawfully using their trademark, sue for damages, and secure the destruction of infringing goods and/or labels.

Q23) Define term goods under trade mark act 1999?

Ans) Under the Trade Marks Act, 1999 of India, the term "goods" is defined in Section 2(j) as "anything which is the subject of trade or manufacture". This means any item that can be bought, sold, or produced falls under the definition of "goods" in the context of this Act.

Q24) Name 4 important qualities of good trade mark?

Ans) The four important qualities of a good trademark are as under:

- a) Distinctiveness: A good trademark should be unique and not similar to any trademark that is already popular or registered.
- b) Simplicity: The trademark should be easy to recognize, speak, and spell so that the masses can acknowledge it quickly.
- c) Short and Memorable: Shorter trademarks are easier to remember, while people find it hard to remember long ones.

d) Reflective of the Product's Quality: An ideal trademark should have the potential to reflect the quality of the product.

Q25) Explain doctrine of honest and concurrent user in trade marks act?

Ans) The doctrine of honest and concurrent use is provided under section 12 of Indian Trade Marks Act, 1999. This doctrine allows for the registration of a trademark that is identical or similar to an already registered trademark, under certain conditions.

The main contention to prove honest concurrent use is that the applicant has been using the mark in a bonafide manner and/or didn't know about the earlier registered trademark.

The main features of this doctrine are:

- a) Concurrent use: This is when users have identical or similar marks on similar or non-similar goods.
- b) Honest use: The applicant has been using the mark in good faith and/or didn't have the knowledge of the earlier registered trademark.
- c) Association with the product or service: The applicant also has the burden to prove that the relevant customers associate their mark with their product or service.
- d) Discretion of the Registrar: The section also provides that the registration of such a mark is at the subjective discretion of the Registrar.

Q26) Short note on rights and obligations of Patentee?

Ans) A patentee, or the holder of a patent, has certain rights and obligations under the Indian Patents Act, 1970.

Rights of a Patentee:

- Right to exploit the patent: The patentee has the sole authority over the manufacture and sale of the patented items.
- Right to assign and license: The patentee can license the invention to others for a fee.
- Right to surrender the patent: The patentee can choose to give up their patent.
- Right before sealing: The patentee has certain rights before the patent is officially granted.
- Right to apply for the patent of addition: If the patentee makes improvements or modifications to the patented invention, they can apply for an additional patent.
- Right in case of infringement: If someone else uses, produces, or sells the patented invention without the patentee's permission, the patentee has the right to take legal action.

Obligations of a Patentee:

- Duty to Disclose: The patentee must fully disclose their invention.

- Duty to Request for Examination: After applying for a patent, the patentee must request an examination.
- Duty to Respond to Objections: If any objections are raised during the examination of the patent application, the patentee must respond to them.
- Duty to clear all Objections: The patentee must address and resolve all objections to their patent application.
- Duty to Pay Statutory Fees: The patentee is responsible for paying all required fees.

Q27) Explain the term geographical indication?

Ans) A Geographical Indication (GI) is a sign used on products that have a specific geographical origin and possess qualities or a reputation that are due to that origin. In order to function as a GI, a sign must identify a product as originating in a given place.

The qualities, characteristics, or reputation of the product should be essentially due to the place of origin. Since the qualities depend on the geographical place of production, there is a clear link between the product and its original place of production.

For example, a watch can only bear the indication "Swiss made" if its origin is Swiss, and if its technical development, assembly, and final checks take place in Switzerland.

Short Notes

Q1) Berne Convention

Ans) The Berne Convention for the Protection of Literary and Artistic Works, usually known as the Berne Convention, is an international treaty designed to protect the rights of creators and their works. The main features of Berne Convention are as under:

- a) Establishment: The Berne Convention was adopted in 1886 in Bern, Switzerland.
- b) Principles: It is based on three basic principles and contains a series of provisions determining the minimum protection to be granted, as well as special provisions available to developing countries that want to make use of them.
- c) Protection: The convention provides creators such as authors, musicians, poets, painters etc. with the means to control how their works are used, by whom, and on what terms.
- d) Copyright: The Berne Convention introduced the concept that protection exists the moment a work is "fixed", that is, written or recorded on some physical medium. Its author is automatically entitled to all copyrights in the work and to any derivative works, unless and until the author explicitly disclaims them or until the copyright expires.
- e) Members: As of November 2022, the Berne Convention has been ratified by 181 states out of 195 countries in the world.
- f) Equal Treatment: The Berne Convention requires its parties to recognize the protection of works of authors from other parties to the convention at least as well as those of its own nationals.

Q2) Compulsory licensing of Patents

Ans) Compulsory licensing is a measure provided by the patent act to ensure that patentees do not misuse their patent rights.

It is a license given to a third party to manufacture, use, or sell a product or use a process that has already been granted a patent, without the permission of the patent owner. This is done for public health, or in national emergencies and health crises.

The conditions which need to be fulfilled for a compulsory license to be granted are given under sections 84 and 92 of the Indian Patent Act, 1970. For example, if a drug that is already patented is available at a very high price and the poor people of the society cannot afford it, then the government can give a compulsory license to other pharmaceutical companies to make the same drug at a lower rate.

Compulsory licensing is a government's authorization to someone else to produce the patented product or process without the consent of the patent owner. While there has been particular attention to the use of compulsory licensing for pharmaceuticals, it can also apply to patents in any field.

The term "compulsory license" refers to the grant of permission for an enterprise seeking to use another's intellectual property without the consent of its proprietor. The grant of a compulsory patent license typically requires the sanction of a governmental entity and provides for compensation to the patent owner.

Q3) Works in which copyright subsists?

Ans) As per Section 13 of Copyright Act 1957, copyrights subsists in a variety of works, including but not limited to:

- a) **Literary works:** This includes novels, poems, plays, film scripts, textbooks, articles, encyclopaedias, reports, speeches, etc.
- b) **Dramatic works:** This includes dance, mime performances, and plays.
- c) **Musical works:** This refers to the musical notes and the composition, not the lyrics or the recording.
- d) **Artistic works:** This includes photographs, paintings, sculptures, architecture, maps, logos, etc.
- e) **Cinematograph films:** This refers to the visual and audio recording of any moving object.
- f) **Sound recordings:** This refers to the recording of sounds from which sounds may be produced.
- g) **Broadcasts:** This refers to electronic transmission of information.

Q4) Infringing Copy

Ans) As per Section 2(m) of Indian Copyright Act, 1957, the term "infringing copy" is a reproduction, adaptation, or distribution of a copyrighted work without the express permission of the copyright holder.

Infringement can be classified into two categories: Primary and Secondary.

Primary infringement occurs when there is an actual act of copying. This involves a direct infringement by the defendant. For example, if someone reproduces a book without the author's permission, it would be a case of primary infringement.

Secondary infringement, on the other hand, occurs when unauthorized dealings take place, such as selling or importing pirated books. It happens if someone facilitates another person or group in infringing on a copyright. Secondary infringement can be further classified into contributory infringement and vicarious infringement.

- Contributory infringement takes place when a person induces or instigates another person to materially contribute to copyright infringement. For example, if a professor instructs students to get a copy of the textbook from a photocopy shop, the professor will be liable for contributory infringement.
- Vicarious infringement occurs when a person or entity gets benefitted because of the copyright infringement done by the primary infringer. For example, the photocopy shop in the previous example will be liable for both vicarious infringement and secondary infringement.

Q5) Copyright is "bundle of rights", Explain.

Ans) Copyright is often referred to as a "bundle of rights" because it encompasses several different types of rights that the owner has in relation to the work. These rights are typically classified into economic rights and moral rights.

A. Economic Rights:

- a) **The Right of Reproduction:** This right allows the copyright owner to control the reproduction of their work in any material form, including sound and film recording.
- b) **The Right of Publication or Communication to Public:** This right allows the copyright owner to control the public display or diffusion of their work.
- c) **The Right of Performance:** This right allows the copyright owner to control and generate revenues through performances of their work.
- d) **The Right of Audio-Visual Expression:** This right allows the copyright owner to control the representation of their work in audio-visual format.
- e) **The Right of Translation and Adaptation:** This right allows the copyright owner to control the translation and adaptation of their work.

B. Moral Rights:

- a) **The Right to Paternity:** This right allows the copyright owner to claim authorship of the work.
- b) **The Right to Integrity:** This right allows the copyright owner to prevent any distortion, mutilation or other modification of their work that would be prejudicial to their honor or reputation.

These rights give the copyright owner the ability to control how their work is used and distributed, and they provide the legal basis for the owner to seek compensation if their rights are infringed.

Q6) Broadcast Reproduction Rights:

Ans) As per Section 37 of Indian Copyright Act, 1957, Broadcast Reproduction Rights are special rights granted to broadcasting organizations. These rights are independent of the copyright that rests with the creator or owner of the work being broadcast. The term of the broadcast reproduction right is 25 years from the beginning of the calendar year next following the year in which the broadcast is made. The rights include:

- a) **The right to re-broadcast a broadcast:** This allows the broadcasting organization to control the re-broadcasting of their original broadcast.
- b) **The right to cause a broadcast to be heard or seen by the public on payment of any charges:** This allows the broadcasting organization to control the public viewing or listening of their broadcast, typically through a subscription or pay-per-view model.

Q7) Explain the concept of owner and author of copyright

Ans) Author: In the context of copyright law, an "author" is generally considered to be the person who creates an original work. This includes the person who writes a book (for literary works), composes a song (for musical works), or takes a photograph (for photographic works), among others. The author is the one who uses their creativity, imagination, and intellectual abilities to create the work.

Owner: The "owner" of a copyright is typically the person who has the legal rights to the work. This can be the author themselves, or it can be another person or entity to whom the author has transferred their rights. For example, an author might sell their copyright to a publisher, in which case the publisher becomes the owner. The owner has the right to reproduce the work, to distribute it, to display or perform it publicly, and to create derivative works.

It's important to note that while the author and owner might often be the same person, they don't have to be. The author is always the original creator of the work, but the owner is the one who holds the legal rights.

Q8) Deceptive Similarity.

Ans) "Deceptive similarity" is a concept in trademark law. It refers to a situation where a trademark is so similar to an existing trademark that it could deceive or confuse the public.

The concept of deceptive similarity is defined under Section 2 (h) of the Trade Marks Act, 1999 in India. It states: "A mark shall be deemed to be deceptively similar to another mark if it so nearly resembles that other mark as to be likely to deceive or cause confusion."

In simple terms, a mark doesn't need to be identical to be considered deceptively similar to another. If it closely resembles another mark, there's a high chance that it could deceive the general public or cause confusion in their minds.

According to Section 11 (1) of the Trademark Act, 1999, a trademark cannot be registered if it is deceptively similar, or identical, with an existing trademark and goods and services, that is likely to create confusion in the mind of the public at large.

Q9) Mareva Injunction

Ans) A "Mareva injunction", also known as a "freezing order", is a form of interim relief that is usually sought during the pendency of court or arbitration proceedings, or once the proceedings are completed and a verdict is rendered, but before the judgement/award is enforced and executed.

It is an exceptionally powerful legal instrument that orders a defendant not to move any assets they own or control, wherever and in whoever's name they may be, in order to safeguard a plaintiff's clear and apparent legal claims.

The Mareva injunction was first granted in the English law case of "The Mareva" in 1980. It has since been adopted in many jurisdictions, including India.

The primary purpose of a Mareva injunction is to prevent a risk of dissipation of assets by the defendant for ulterior purposes before judgment. It is designed to prevent the defendant from rendering a decree against him worthless by removing his assets from the court's jurisdiction.

To obtain a Mareva injunction, the plaintiff must usually establish that:

- a) There exists a strong *prima facie* case against the defendant.
- b) It will suffer irreparable harm if the injunction is not issued.
- c) The balance of convenience favors the issuing of the injunction.
- d) The cause of action lies within the jurisdiction of the Court which the Mareva injunction is sought.
- e) It has a "good arguable case" on the merits of the cause of action.

Q10) Anton Piller Order

Ans) An "Anton Piller Order", often referred to as an "Anton Piller injunction", is a court order that provides the right to search premises and seize evidence without prior warning.

This is intended to prevent the destruction of relevant evidence, particularly in cases of alleged trademark, copyright, or patent infringements.

The order is named after the 1975 English case of *Anton Piller KG v Manufacturing Processes Limited*, dealing with the theft of trade secrets.

The Anton Piller order does not authorize anyone to enter the defendant's premises against his will. It only authorizes entry and inspection by the permission of the defendants. However, it does bring pressure on the defendants to give permission. Because such an order does not give the accused party the ability to defend themselves, Anton Piller orders are only issued exceptionally under following circumstance:

- a) There is an extremely strong *prima facie* case against the respondent.
- b) The damage, potential or actual, must be very serious for the applicant.
- c) There must be clear evidence that the respondents have in their possession relevant documents or things and that there is a real possibility that they may destroy such material before an *inter partes* application can be made.

Q11) Passing off

Ans) Passing off is a common law tort that can be used to enforce unregistered trademark rights. It refers to the unauthorized use of another party's name, mark, or get-up (the appearance or "look and feel" of a product) for commercial gain. This action of misrepresentation often damages the goodwill of a person or business, causing financial or reputational damage.

Some key elements of passing off are as under:

- a) Misrepresentation: One party misrepresents their goods or services as those of another person. This can lead to confusion among customers and consumers, and

can be detrimental to the business of the original or legitimate owner of the trademark.

- b) Goodwill: The plaintiff has the burden of proving goodwill in its goods or services, get-up of goods, brand, mark, or the thing standing for itself. Goodwill normally develops alongside a brand name or brand association.
- c) Damage: The misrepresentation must cause damage to the goodwill of the business.

It's important to note that passing off does not confer monopoly rights to any names, marks, get-up, or other indicia. It does not recognize them as property in its own right. Instead, the law of passing off is designed to prevent misrepresentation in the course of trade to the public. For example, it prevents a situation where there is some sort of association between the businesses of two traders when this is not true.

Q12) Distinguish between infringement and passing off

Ans) Infringement is a statutory remedy provided under section 28 (1) of The Trademark Act, 1999 for which registration of a trademark is a pre-requisite. While Passing off is a common law remedy and in Passing Off claims, registration of a trademark is not required.

Infringement is defined as taking unfair advantage of or harming a trademark's unique character or goodwill. It involves the unauthorized use of a trademark in the course of trade in a way that causes confusion in the general public while Passing off refers to a person's deceptive portrayal of products as those of someone else and it is used to protect or safeguard the goodwill attached to an unregistered trademark.

When the trademark has not been registered by the owner and infringement happens, then it becomes a case of passing off. In essence, infringement is the violation of a registered trademark, while passing off is the misrepresentation of a product or service as that of another.

Injury: In infringement, the use of registered trade mark by the defendant need not cause injury or damage to plaintiff. In passing off, the use of trade mark by defendant should likely to cause injury or damage to plaintiff goodwill.

Q13) Procedure for registration of trade marks?

Ans) A trademark or service mark is a word, name, symbol, or device used to indicate the source, quality and ownership of a product or service. A trademark is used in the marketing is recognizable sign, design or expression which identifies products or service of a particular source from those of others. The trademark owner can be an individual, business organization, or any legal entity. A trademark may be located on a package, a label, a voucher or on the product itself.

Steps/Procedure of Registration of Trade Mark:

- Trademark Search: This step is very crucial before filing for trademark registration because conducting a detailed search will help a trademark owner to know whether their trademark is unique and distinct in nature and also check whether there is any similar or identical mark already existing or not.
- Filing an application: After conducting a search, comes the process of filing the application for registration. The application must be filed in Form TM-A either online on the IP India's official website or physically at the Trademark Registry Office according to one's jurisdiction.
- Examination Process: Once the application is filed, it will be thoroughly examined by the Registrar and they will prepare an examination in writing and will send a copy of it to the applicant within 30 days informing them whether the registrar wants to refuse or conditionally accept the application and shall also include the materials by which he came to such a decision. The applicant within 30 days from receiving the examination report, must file a reply, stating all the defences along with evidences against the objection raised by the trademark office and the owner shall put forward the reasons as to why their application should not be refused and must be proceeded for further registration procedures. If the applicant fails to reply within the above mentioned time frame, the application will be abandoned.
- Post Examination Procedures: Once the applicant files the reply to the examination report, the examiner if wants can arrange a hearing if due to any reason he/she is not satisfied with the reply sent by the applicant or if, the reply is not able to fulfill the purpose of the objection stated in the report. After the hearing process, if the examiner is fully satisfied, can accept the mark and forward it for publication in the Trademark Journal or can refuse the application if any objection is still there.
- Publication of the Trademark Application: After the examiner has accepted the application, it will be published in the Trademark Journal which will remain there for 4 months. Advertisement of such an application is done so that within the time period stated above, any third party can see it and if they want can file an opposition against the applicant every Monday the Journal is updated with new accepted trademark applications.
- Notice of opposition: within 4 months from the date of publication of the application, any aggrieved party can file a notice of opposition in Form TM-O, when any third party feels that their already existing and prior use trademark has been infringed by the applicant, or the application is made in bad faith and if such a trademark is registered, it will harm the reputation and good will associated with the prior trademark of the third party. Notice of opposition will halt the registration process and the opposed mark of the applicant according to the Trademark Act, 1999, and the applicant have to go through certain legal procedures if they wants to continue with the registration of the same mark, which includes filing a counter- statement, submitting evidence

in reference to that counter statement and in some cases it is seen that the applicant have to go through hearing as well.

- Registration: The last step in the registration procedure is to get the certificate of registration. After the mark goes through all the legal processes related to the opposition, and if the opposition is cleared, the applicant will receive the certificate.

Q14) Discuss grounds of refusal of registration of trademarks?

Ans)

I) Meaning of Trademark:

A trademark or service mark is a word, name, symbol, or device used to indicate the source, quality and ownership of a product or service. A trademark is used in the marketing is recognizable sign, design or expression which identifies products or service of a particular source from those of others. The trademark owner can be an individual, business organization, or any legal entity. A trademark may be located on a package, a label, a voucher or on the product itself.

II) Importance of registration of Trademark:

The registration of trademarks holds significant importance for businesses and individuals alike.

- a) **Exclusive Rights and Protection:** Trademark registration grants the owner exclusive rights to use the mark in connection with specific goods or services. It acts as a protective shield, preventing others from using a similar mark for similar products. Without registration, enforcing these rights becomes challenging.
- b) **Presumption of Ownership:** A registered trademark establishes a legal presumption of ownership. It simplifies legal proceedings if any disputes arise. The burden of proving ownership shifts to the alleged infringer.
- c) **Public Notice and Brand Recognition:** Registration publicly announces the existence of the trademark. It appears in official databases and publications, making it accessible to competitors and the public. A well-recognized trademark enhances brand reputation and consumer trust.
- d) **Deterrent Against Infringement:** Registered trademarks act as a deterrent to potential infringers. Competitors are less likely to use a similar mark, knowing legal consequences may follow. It safeguards your brand identity and market position.
- e) **International Protection:** Trademark registration provides global protection. It facilitates expansion into international markets. International treaties and agreements recognize registered trademarks.

Thus, trademark registration is crucial for brand identity, legal protection, and business growth. It ensures that your unique mark remains exclusively associated with your products or services.

III) Grounds for refusal of trademark registration:

a) Absolute Grounds for Refusal:

Section 9 deals with absolute grounds for refusal. It specifies the criteria for determining whether a mark is eligible for registration. Covers aspects such as distinctiveness, descriptiveness, functionality, and scandalous/offensive nature. Absolute grounds focus on the inherent qualities of the mark itself and apply universally. It includes:

- **Incapability to Distinguish:** A trademark cannot be registered if it is incapable of distinguishing the goods or services of the applicant from those of others. For instance, a geographical name like "Simla" was deemed unregistrable because it lacked distinctiveness.
- **Descriptive or Generic Marks:** Marks that describe the kind, quality, origin, or characteristics of goods/services are ineligible. For example, the term "Rasoi" (meaning kitchen) could not be registered for edible oils.
- **Common Usage:** If a mark has become common in everyday language or trade practices, it cannot be registered.
- **Deceptive Nature:** Marks that deceive the public or cause confusion are refused. This includes marks likely to hurt religious sentiments.
- **Functional Marks:** Marks serving a functional purpose (e.g., necessary product shapes) are not registrable.
- **Scandalous or Offensive Marks:** Obscene or offensive marks are prohibited.

b) Relative Grounds for Refusal: Section 11 addresses relative grounds for refusal. Focuses on existing marks and potential conflicts. Includes provisions related to similarity, likelihood of confusion, and well-known marks. These grounds consider existing marks and potential conflicts:

- **Similarity to Prior Marks:** If a proposed mark is identical or similar to an earlier registered mark, it may face refusal.
- **Likelihood of Confusion:** Marks causing confusion among consumers due to similarity are rejected.
- **Well-Known Marks:** If a mark resembles a well-known mark, it may be refused.
- **Honest Concurrent Use:** In exceptional cases, concurrent use of similar marks may be allowed.

Q15) Short note on Well Known Trade Mark

Ans) According to Section 2(1)(zg) of the Trademarks Act, 1999, a well-known trademark is one that:

- a) Has gained recognition among the public using related goods or services.
- b) Implies a connection between those goods/services and the person using the mark.
- c) Well-known trademarks are protectable, even if they are not formally registered.

Protection and Importance:

- a) Well-known trademarks receive special protection beyond regular registered trademarks.

- b) They safeguard brand reputation, prevent confusion, and maintain exclusivity.
- c) Notoriety plays a crucial role in their legal strength.

In short, well-known trademarks are powerful assets that transcend mere registration and hold immense value in the business world.

Q16) Patent of addition.

Ans) A patent of addition is an instrument used to protect improvements or modifications to an existing patented invention. It covers advancements or variations that were not initially included in the main patent. Unlike an independent patent, a patent of addition is closely linked to the original invention.

When an inventor makes minor enhancements to their patented invention during its practical use, they can seek a patent of addition. It ensures that these improvements are also legally protected. No separate renewal fee is required for a patent of addition.

Term and Validity: The term of a patent of addition is equal to that of the main patent. It remains in force as long as the main patent is valid. If the main patent expires or is revoked, the patent of addition ceases to exist.

In brief, a patent of addition allows inventors to safeguard incremental improvements to their original inventions without the need for a separate patent application.

Q17) Short note on "what cannot be patented under Indian Patent Act 1970?"

Ans) Section 3 and Section 4 of the Patent Act deals with the list of exclusions that are non-patentable. The non-patentable inventions under the Indian Patents Act, 1970 are as under:

- a) **Frivolous inventions or those contrary to natural laws (Section 3(a)):** An Invention which is frivolous or which is obvious or which claims anything obvious or contrary to well established natural law. For example, a machine giving 100% efficiency, or any machine giving output without an input cannot be considered as obvious and cannot be patented.
- b) **Inventions contrary to public order or morality (Section 3(b)):** An invention, the primary or intended use of which would be contrary to law or morality or injurious to public health This includes inventions that cause serious prejudice to human, animal or plant life or health, or to the environment. For instance, terminator gene technology cannot be patented as it severely threatens animal and plant life and the environment.
- c) **Mere discovery of a scientific principle or formulation of an abstract theory (Section 3(c)):** Discovering an existing phenomenon like natural gas or an element cannot be patented.
- d) **Invention Relating to Atomic Energy:** The provisions regarding the patent of inventions related to atomic energy in India are outlined in Section 4 of the Patents Act, 1970. This section states that no patent shall be granted for inventions that are considered by the Central Government to be useful for or

related to atomic energy. This includes the production, control, use, or disposal of atomic energy or any prescribed substance or radioactive substance as defined under Section 20 of the Atomic Energy Act, 1962.

- e) Method of Agriculture or Horticulture: The patent provisions for methods of agriculture or horticulture in India are specified under Section 3(h) of the Patents Act, 1970. This section states that a method of agriculture or horticulture is not an invention within the meaning of the Act and thus, is not patentable. This exclusion is intended to preserve traditional farming and breeding practices within the public domain, preventing their exclusive appropriation through the granting of patents. However, this clause does not encompass all agricultural or horticultural inventions, allowing for potential patentability in certain cases. For example, while conventional agricultural methods on open fields are not patentable, innovations that significantly enhance or modify these methods may be considered for patent protection if they meet the necessary criteria.
- f) Mere discovery of a new form of a known substance (Section 3(d)): This does not result in the enhancement of the known efficacy of that substance. For example, new uses of the plant neem cannot be patented as per this clause.
- g) Substances obtained by a mere admixture (Section 3(e)): This refers to substances resulting only in the aggregation of the properties of the components.

Q18) Write short note on Specifications under Patents Act?

Ans) The provisions related to the specification of a patent in India are provided under Section 10 of the Indian Patent Act, 1970. This section details the contents required in both provisional and complete specifications. Specifically, Section 10(4) outlines the requirements for a complete specification, including a full and particular description of the invention, disclosure of the best method of performing the invention known to the applicant, and the claims defining the scope of the invention for which protection is claimed. Under the Indian Patent Act, the specification of a patent is a critical document that outlines the technical details and the scope of protection for an invention.

There are two types of specifications:

- a) Provisional Specification: This is filed when the invention is not yet complete but the inventor wishes to secure a filing date. It must describe the invention and is often used to buy time for completing the invention to its full extent.
- b) Complete Specification: This is required when the invention is fully developed and ready for patenting. It must fully and particularly describe the invention, its operation or use, and the method by which it is to be performed. It should also disclose the best method of performing the invention known to the applicant and end with a claim or claims defining the scope of the invention for which protection is claimed.

The specifications are submitted in Form-2 as prescribed under the Patent Act, 1970, and the Patent Rules, 2003. The first page of Form-2 should contain the title of the invention, the name, address, and nationality of each of the applicants, and a preamble to the description.

For a complete specification, the preamble should state: "The following specification particularly describes the invention and the manner in which it is to be performed." Meeting these requirements is essential for the grant of a patent, as the specification forms the basis of the patent grant and defines the extent of patent protection.

Q19) Write short note on sui generis patent

Ans) The term "sui generis" refers to a unique, one-of-a-kind system that is different from traditional intellectual property (IP) rights like patents. A sui generis system is often established when traditional IP rights are insufficient to protect certain types of knowledge or creations, such as the topography of integrated circuits, plant varieties, or traditional knowledge.

The main differences between sui generis protection and patents:

- **Scope:** Patents can protect a wide range of inventions including processes, machines, manufactures, and compositions of matter. Sui generis systems, on the other hand, are tailored for specific subject matters that don't fit well within the patent framework.
- **Protection Criteria:** For patents, an invention must be new, non-obvious, and useful. Sui generis systems have criteria that are specifically designed for the subject matter they protect, which may differ from these patent criteria.
- **Duration:** Patent protection typically lasts for 20 years from the filing date, whereas sui generis protection periods can vary. For example, the protection for topographies of integrated circuits usually lasts for 10 years.
- **Rights Granted:** Patents grant the right to exclude others from making, using, selling, offering for sale, or importing the patented invention. Sui generis rights are more specific to the type of creation they protect and the rights can be more limited in scope.
- **Collective vs. Individual Rights:** Sui generis systems may protect collective rights of communities, especially in the case of traditional knowledge, whereas patents protect individual or corporate rights.

Q20) What are the rights conferred by registration of trademarks?

Ans) The rights conferred by the registration of a trademark in India are designed to protect the interests of the trademark owner and ensure the trademark can be used exclusively:

- a) **Exclusive Use:** The registered proprietor has the exclusive right to use the trademark in relation to the goods or services for which it is registered.

- b) Legal Protection: Registration provides better legal protection for action against infringement, as the registered owner can sue for infringement and seek remedies such as injunctions, damages, or accounts of profits.
- c) Assignment and Licensing: The owner has the right to assign (transfer) the trademark to another party or license it for use by others.
- d) Prevention of Unauthorized Use: The registration empowers the owner to prevent unauthorized use of the trademark, or a deceptively similar mark, on dissimilar goods or services if the original mark has a reputation in India.
- e) Deterrence of Others: It deters others from using a similar or identical mark for the same or similar goods or services.
- f) Statutory Remedies: Registered trademark holders can seek statutory remedies against infringement, which are often more convenient than common law protection.

These rights are crucial for maintaining the integrity of a brand and ensuring that the goodwill associated with a trademark is not diluted by unauthorized use. It's important to note that while registration is not compulsory, it offers significant advantages and legal protections for the trademark owner.

Q21) Who can oppose patents and what are the grounds for opposing patents? What is the procedure for opposing patents?

Ans) I) The Grounds for opposition to the grant of Patent (Section 25 (1) to (4)): Opposition to the grant of patent may be made, once the Controller has accepted the complete specifications, and it is advertised in the Official Gazette giving reasons for such acceptance. It is thrown open to the public to oppose the grant, if there are any reasonable grounds for the same. Within 4 months from the date of advertisement of the acceptance of the complete specifications, any person interested, may give notice to the Controller, stating his opposition to the grant of patent.

"Any Person Interested"

"Person interested" includes a person engaged in, or promoting, research in the same field as that of the invention.

Thus, he can establish "locus standi" on the following grounds:

- i) He has in his possession, patents relating to the same subject matter.
- ii) Bona fide manufacturer of an article or based on a similar process as that of the invention.
- iii) Trading interest.

II Grounds for Opposition:

The provisions relating to grounds of opposing patents are given in Section 25 of Patents Act. An application for a patent may be opposed by any person interested, on one or more of the following grounds:

- a) Invention wrongfully obtained.

- b) Prior publication in any Indian specification, or prior publication in any other document in India or elsewhere.
- c) Prior claim in a concurrent application.
- d) Prior public use or public knowledge in India.
- e) Obviousness and Lack of Inventive step.
- f) Invention not patentable under the Act.
- g) Insufficient description of the invention.
- h) Failure to disclose information relating to foreign application.
- i) In the case of convention application not made within the prescribed time.

III) The procedure for opposing patents in India involves several steps, and it can be divided into two types: pre-grant opposition and post-grant opposition.

Pre-Grant Opposition:

- a) **Filing of Opposition:** Any person can file a pre-grant opposition after the patent application is published but before the patent is granted.
- b) **Submission of Evidence:** The opponent must submit evidence and documents supporting their opposition.
- c) **Controller's Examination:** The Controller of Patents examines the opposition and the applicant's response.
- d) **Decision:** The Controller decides whether to grant the patent, require amendments, or refuse the patent application.

Post-Grant Opposition:

- a) **Filing of Notice:** An 'interested person' can file a notice of opposition within one year from the date of publication of the grant of the patent.
- b) **Constitution of Opposition Board:** The Controller constitutes an Opposition Board consisting of three members to examine the patent.
- c) **Examination Report:** The Opposition Board submits their examination report to the Controller.
- d) **Hearing:** Both parties are given an opportunity to be heard.
- e) **Controller's Decision:** Based on the hearing and the Board's report, the Controller decides on the opposition.
- f) **Appeal:** Parties dissatisfied with the decision can appeal to the Intellectual Property Appellate Board (IPAB).

This process ensures that any third party can challenge the validity of a patent application or a granted patent, maintaining the integrity of the patent system.

Situational Problems

Q1) Government of India starts manufacturing a drug which is patented by PACTO Pharma Ltd. The drug is distributed to government medical colleges and hospitals. PACTO Pharma Ltd. files a suit of infringement against the government.

- a) Will PACTO Pharma Ltd. succeed in the suit?
- b) Which provisions of the Patents Act will be applicable in this scenario

Ans) In the scenario where the Government of India begins manufacturing a drug patented by PACTO Pharma Ltd. and distributes it to government medical colleges and hospitals, the outcome of PACTO Pharma Ltd.'s infringement suit against the government would depend on several factors, including the specific provisions of the Indian Patents Act and any exceptions or compulsory licensing provisions that may apply.

- a) The success of PACTO Pharma Ltd. in the suit would largely hinge on whether the government's actions fall under any of the exceptions to patent infringement outlined in the Patents Act. For instance, the government may invoke Section 47, which allows for the government use of patented inventions for its own purposes without constituting an infringement.
- b) Additionally, under Section 100, the government can authorize the use of a patented invention for the purposes of its own services.
- c) Moreover, if the government's actions are deemed to be in the public interest, particularly in scenarios like a public health crisis, it could potentially invoke the compulsory licensing provisions under Sections 84-92, which allow for the manufacturing and distribution of a patented drug without the consent of the patent holder under certain conditions.
- d) Thus, in the above scenario, the provisions of section 47, 100, 84-92 may be applicable and under such circumstance the suit of PATCO pharma may not be succeed.

Q2) Mr 'T' invents a topography of integrated circuits and applies for a patent for the same. i. ii. Will Mr. 'T' succeed in getting a patent? What is the provision of law regarding the invention of topography of integrated circuits

Mr. 'T' may be able to protect his invention of the topography of integrated circuits, but not through a traditional patent. Instead, this type of intellectual property is typically protected under a sui generis system, which is a unique category of rights separate from patents.

In India, for example, the Semiconductor Integrated Circuits Layout-Design Act, 2000, governs the protection of layout designs of integrated circuits. Registration is a prerequisite for protection under this Act. For Mr. 'T' to succeed in protecting

his layout designs (topographies) of integrated circuits, the design must be original, resulting from his intellectual effort, and not merely a copy of another layout design. It should also not have been commercially exploited before. The protection for such a layout design is usually for a period of 10 years, starting from the date of filing the application or from the first commercial exploitation, whichever is earlier.

Q3) Being inspired by the Web series 'Maharani', Shashi Khanna - a fiction author wrote a biography of Smt. Rabri Devi named ' RANIDEVI' without her consent. Smt. Rabri Devi sought an injunction on the sale of the said book. But the controversy led to heavy public demand of the book. Mohan Trivedi made a pirated copy of this book and began to sell it all over India. i. What remedies would have been available to the author, if there was no injunction against his book? ii. What are the remedies available to Smt. Rabri Devi?

If there was no injunction against Shashi Khanna's book 'RANIDEVI', the author would have had several remedies available under Indian law for the infringement of copyright by Mohan Trivedi's pirated copies:

Remedies for the Author:

- Civil Remedies: The author could seek damages for the losses incurred due to piracy. This includes compensatory damages for the loss of sales and profits.
- Criminal Remedies: The author could file a criminal complaint against the infringer. Copyright infringement is a criminal offense under the Copyright Act, 1957, which can lead to imprisonment and fines.
- Administrative Remedies: The author could approach the Copyright Board for certain administrative actions against the infringer.

Remedies for Smt. Rabri Devi:

- Right to Privacy: If the biography discloses private facts without consent, Smt. Rabri Devi could claim a violation of her right to privacy and seek damages.
- Defamation: If the content of the book is defamatory, she could file a defamation suit.
- Injunction: Although an injunction was already sought, if it were not in place, she could still seek an injunction to prevent further distribution of the book if it violates her privacy or defames her.

It's important to note that the remedies would depend on the specifics of the case, including the nature of the content in the book and the extent of the infringement or violation of rights.

Q4) In 2003, Famous Camera Ltd. Invents and adopts the trade mark 'THADAX' in relation to cameras and obtains registration of the same THADAX. THADAX becomes a very popular brand in most Asian Countries in a short while. In 2005, Super Cakes Private Ltd. launches its cakes under the trade name THADAX. (i) (ii) Can Famous Cameras Ltd. take action against Super Cakes Ltd for restraining Super

Cakes Ltd from using the trade mark THADAX ? Can Famous Camera Ltd. Succeed in the action against Super Cakes Ltd., if the trade mark was popular only in Mumbai?

In the given scenario, Famous Cameras Ltd. has several legal avenues to address the trademark infringement by Super Cakes Private Ltd.:

- a) Action Against Super Cakes Ltd.: Famous Cameras Ltd. can indeed take legal action against Super Cakes Ltd. for using the trademark 'THADAX'. The action can be based on trademark infringement, which occurs when a trademark that is identical or confusingly similar to a registered trademark is used without permission, leading to confusion among consumers. Since 'THADAX' is registered for cameras, its use by another company for cakes could potentially dilute the distinctiveness of the trademark or cause confusion that the cakes are associated with or endorsed by Famous Cameras Ltd.
- b) Success in the Action in Mumbai: The success of Famous Camera Ltd. in the action against Super Cakes Ltd. would depend on several factors, including the extent of the reputation of the 'THADAX' trademark. If the trademark 'THADAX' is well-known in Mumbai and is associated with Famous Cameras Ltd., the company may argue that the use of the same trademark by Super Cakes Ltd. is likely to cause confusion or deception among the public, even if the trademark's popularity is limited to Mumbai. The concept of 'trans-border reputation' and 'passing off' could also be relevant in such cases, where a trademark is well-known in a particular region and enjoys a reputation.

It's important to note that the specifics of the case, including evidence of the trademark's popularity and consumer confusion, would be crucial in determining the outcome of any legal action.

Q5) Venugopal is a manufacturer of tennis racquets and wants to use the name "Rocket" as his trademark. He applies for a trademark registration to the Registrar of Trademarks.

i. Will Venugopal succeed to register the name "Rocket" as a trademark for his goods?

ii. State and explain the provisions of the law involved.

Ans) Whether Venugopal will succeed in registering "Rocket" as a trademark for his tennis racquets depends on several factors. The Trademarks Act, 1999, governs the registration of trademarks in India and stipulates that a trademark must be distinctive, not deceptive, and not similar to existing trademarks for related goods or services. If "Rocket" is deemed distinctive enough and does not conflict with existing trademarks in the same category, Venugopal may succeed in his application. The provisions of the law involved are primarily from The Trademarks Act, 1999. The key provisions that would be considered in Venugopal's case include:

➤ Section 9: Absolute grounds for refusal of registration, which includes trademarks that lack distinctiveness or are descriptive of the goods.

- **Section 11:** Relative grounds for refusal of registration, which involves refusal if the trademark conflicts with or is similar to an earlier trademark and may cause confusion.
- **Section 18:** Application for registration, which outlines the process of applying for a trademark and the examination by the Registrar.

The Registrar will examine the application to ensure that the trademark "Rocket" meets the necessary criteria, including distinctiveness and non-conflict with prior trademarks. If it passes the examination and there's no opposition, Venugopal may be granted the registration. It's advisable for Venugopal to conduct a thorough trademark search and possibly consult with a trademark attorney to navigate the registration process effectively.

Q6) Kamya Drugs make a herbal tea for cold and cough treatment using traditionally well-known actives.

i. Will they be able to get a patent for the herbal tea in India?

ii. What are the steps for filing a patent application in India?

Kamya Drugs may face challenges in obtaining a patent for the herbal tea in India if the tea is made using traditionally well-known actives. According to Indian patent law, an invention must be novel, involve an inventive step, and be capable of industrial application to be patentable. Since the actives are traditionally well-known, they may not meet the novelty requirement. Additionally, herbal formulations based on traditional knowledge are generally not considered patentable unless they involve a new process, formulation, or synergistic effect that is not obvious.

ii. The steps for filing a patent application in India are as follows:

- a) **Patent Search:** Conduct a worldwide patent search to determine the novelty of the invention.
- b) **Drafting Patent Specification:** Prepare a detailed description of the invention, including claims that define the scope of the patent sought.
- c) **Patent Application Filing:** File the patent application with the appropriate Indian Patent Office, either online or at a physical location.
- d) **Patent Publication:** The application is published 18 months after filing to allow for public opposition.
- e) **Requesting Patent Examination:** After publication, request a substantive examination of the patent application.
- f) **Responding to Objections:** Address any objections raised by the patent examiner.
- g) **Patent Grant:** If the application meets all requirements, the patent will be granted.

Q7) A film producer makes a cinematographic adaptation of a book without consent of the author.

- i. Is he permitted to do so under the Copyright Act, 1957?
- ii. What is copyright infringement?
 - i. Under the Copyright Act, 1957, a film producer is not permitted to make a cinematographic adaptation of a book without the consent of the author. The author's permission is required to adapt their work into a film, as this constitutes a 'derivative work' under copyright law.
 - ii. Copyright infringement is the use or production of copyright-protected material without the permission of the copyright holder. This includes any reproduction, distribution, performance, public display, or creation of derivative works without authorization. In the context of a film adaptation, if the producer does not have the rights to the book, any production based on it would be an infringement of the author's copyright.

Q8) Scientist 'A' working in B.A.R.C. and involved in atomic energy research, discovers a scientific principle. His colleague, Scientist 'B' uses the principle and invents' a novel, inventive, and useful working device based on the principles.

a) Will Scientist 'A' be granted a Patent for his discovery? Why?

Ans) No, Scientist 'A' will not be granted a Patent for his discovery. Under Section 4 of the Patents Act, 1970, inventions relating to atomic energy are not patentable. Inventions related to atomic energy fall under the non-patentable category in India. According to Section 4 of the Indian Patents Act, no patent shall be granted for inventions related to the control, production, disposal, or use of atomic energy. This includes inventions that the Government of India considers pertinent to atomic energy operations. The exclusion is in place because the government maintains strict control over atomic energy due to its strategic importance and potential risks.

b) Will Scientist 'B' be granted a Patent for his invention? Why?

Answer: No, Scientist 'B' will not be granted Patent for his invention, as his invention is related to the principles of atomic energy which is not patentable.

c) What will be your answer to b) above, if the invention is not related to atomic energy ? Why?

Answer: In such a case, the Scientist will be granted Patent if his invention is not related to atomic energy and if his invention is novel and innovative.

Q9) Dr. Singh has written a book on Intellectual Property Law. The book has been published by Western Law House.

a) Who is the author of the work?

Answer: Dr. Singh is an author of the book on Intellectual Property Law.

b) A journalist uses extracts of the book in the review of the book published in a magazine. Will this amount to infringement? Why?

Answer: No, this will not amount to infringement as extracts can be used for review purpose, under Section 52 of the Copyright Act, 1957, certain acts does not amount to infringement of copyright.

c) A student extensively quotes from Dr. Singh's book in his law examination. Will this amount to infringement? Why?

Answer: No. this will also not amount to infringement, under Section 52 of the Copyright Act. 1957, certain acts not to be infringement of copyright.

d) Shyam makes 10 photocopies of the book and distributes them amongst his friends. Will this amount to infringement? Why?

Answer: Yes, this will certainly amount to infringement, because, under Section 51 of Copyright Act, 1957, making photocopy of the book and distributing the same amounts to infringement of copyright.

Q10) Anil a research scientist, discovers a new phenomenon in physics. Using principles underlying this new discovery, Anil and Amit invent a product having substantial commercial potential. Anil and Amit have come to you for advice.

a) Would you advise Anil to obtain a patent in respect of his discovery ? Give reasons either way.

Answer: No, Anil would be advised against making any effort to obtain a patent in respect of the said discovery. Under the Patents Act, 1970, only inventions are capable of securing patents and Section 3 of the said Act also discusses "what are not inventions"

Section 3 (c): - mere discovery of a scientific principle or the formulation of or the discovery of any living thing or non-living substance occurring in the nature cannot be considered as inventions. Since Anil's work clearly falls under Section 3 (c), the same would not be granted a patent.

b) Would Anil and Amit together, be eligible for a patent? If no, who amongst them would have a better right?

Answer: Yes, Anil and Amit would be eligible for applying for a patent grant in respect of the product developed by them.

c) The inventor(s) would like to file a Complete Specification, but their claims are not yet ready. What advice would you give them under the circumstances?

Answer: The inventors should draft and file the 'provisional specifications' in respect of the patentable invention. They are not required to file their claims at this stage; however, the applicants must file the complete specifications within one year from the filing of the provisional specifications.

d) Further, the inventor(s) would like to discuss the discovery and the product at a scientific conference. What advice would you give them?

Answer: Since the discovery is not the subject matter of the patent, the scientist can discuss the same at the scientific conference. However, they are advised not to make any mention of the product, unless they have filed at least a provisional specification in respect of the invention embodied in the product.

Q11) Dhoni has been granted a patent, by the Indian Patents Office on 31st December, 2007

a) For how long will Dhoni have the patent over his invention?..

Answer: Under Section 53 (1) of the Act, the term of every patent granted, after the commencement of the Patents (Amendment) Act, 2002, and the term of the patent which has not expired and has not deceased to have effect on the date of such commencement, under this Act, shall be 20 years from the date of filing of the application for the patent.

b) If Ganguly wants to challenge the patent, in which Court has he to file a suit?

Answer: A suit has to be instituted in a District Court or in appropriate cases, the High Court.

c) Can Dhoni file an action for infringement against manufacturer who is making the invention in Nepal? Why?

Answer: No, because, the patent is not registered in Nepal. If Nepal is a convention country, then only the infringement action can be initiated.

d) Can Dhoni get a patent in England in respect of the same invention, if he applies in 2008? Why?

Answer: Yes, provided, that no other similar invention has already been granted a patent.

e) If Dhoni had initially applied under the PCT then, would he have gained any advantage?

Answer: The advantage would be the crystallizing of the priority date for the same invention in multiple countries simultaneously.

Q12) A detective agency wants to register the trademark "I Section I Section I" for its firm. The Controller General of Patents, Designs and Trademarks has refused to grant trademark on the plea that it sounds similar to the trademark ICICI.

a) Is the stand of the Controller correct?

Answer: Yes, the Controller refusing to grant/register trademark is correct. Under Section 9 (d) of the Act, there is the 'absolute' ground for refusal, that is, if the trademark is of such nature as to deceive the public or cause confusion, then the trademark shall not be registered.

b) Can there be any other ground of refusal ?

Answer: Yes, under Section 11 of the Act, if the trademark is relative in nature (i.e. 'relative' grounds for refusal. It means (a) if there is likelihood of confusion caused to the public including the likelihood of association with an earlier trademark by virtue of its identity with the earlier trademark and similarity of goods or services

caused by the earlier trademark, (b) if the earlier trademark is well-known trademark in India and the later mark would take unfair advantage of the earlier mark or would be detrimental to the distinctive character or repute of the earlier trademark.

c) What are the remedies available against the refusal?

Answer: The remedies that the consent of the proprietor is obtained and it is for honest concurrent use (Section 12 of the act).

Q13) Sanchit and Sagar filed patent application with provisional specification on the same date for the same invention. After that, Sanchit filed a complete specification much earlier to Sagar, both filed within the allowed period. Examine the status of the patent applications filed by both, Sanchit, and Sagar. i) If Sanchit adopted the idea from Sagar dishonestly.

Answer: If Sanchit adopted the idea from Sagar dishonestly, then it will amount infringement of Sagar's rights to patent. And hence, Sagar will have right to institute suit for Declaration, Injunction and also for damages and accounts of profits.

ii) Both Sanchit and Sagar are honest independent inventors conducting their own separate experiments.

Answer: As Sanchit has filed a complete Specification much earlier to Sagar; Sanchit will have exclusive right to make or use the patented article or use of the patented process. But if Sagar has discovered new process other than Sanchit's experimental process, Sagar can get patent on his new process; which will be improvement in Sanchit's patented process, but Sagar have to get consent and permission from Sanchit, because, Sanchit has filed complete Specification much earlier to Sagar. So, Sanchit is the exclusive owner (i.e. First Inventor) of patented process.

Q14) 'A' launches a new hand bag in the market under the brand name "Orange". The unique feature of this bag is it is made of orange peels with a very innovative technology and is in shades of orange. 'A' also wants to get the colour Orange as a trade mark. i. Identify the IPR involved in the given case. ii. Will 'A' be entitled to use Orange as a trade mark ?

- i) The IPR involved in the given situation is Trademark. Trademarks are used to protect symbols, names, and slogans used to identify goods or services. The brand name "Orange" and potentially the unique shade of orange used for the handbags could be registered as trademarks
- ii) Regarding the color orange as a trademark, it is possible to trademark a color if it has acquired distinctiveness and is not functional to the product. In India, a color can be trademarked under Section 2 (1) of the Trademarks Act of 1999 if it is distinctive and can be graphically represented. However, 'A' would need to prove that the color orange has become distinctive of their handbags in the eyes of consumers and does not serve a merely decorative or utilitarian purpose.

So, 'A' may be entitled to use the color orange as a trademark if these conditions are met and if the color has become associated with their brand in the minds of consumers.