

Course Outline

Intellectual Property Law

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Resource Materials:

1. P. Narayan: Intellectual Property Law
2. A.S.M Sayem Ali Pathan: Intellectual Property Law (Theories, law and case)
3. Copyright Act 2000
4. Trademark Act 2009
5. The Patents and Designs Act 1911

World Intellectual Property Organization

World Intellectual Property Organization (WIPO)

World Intellectual Property Organization (WIPO), international organization designed to promote the worldwide protection of both industrial property (inventions, trademarks, and designs) and copyrighted materials (literary, musical, photographic, and other artistic works).

The WIPO is one of the 15 specialized agencies of the United Nations (UN). WIPO was established in 1967. It was created to promote and protect intellectual property (IP) across the world by cooperating with countries as well as international organizations. Now, the headquarter of the Organization is in Geneva, Switzerland. WIPO currently has 193 member states including Bangladesh.

Main Objectives of WIPO

WIPO's two main objectives are-

- (i) to promote the protection of intellectual property worldwide
- (ii) to ensure administrative cooperation among the intellectual property

Main Activities of WIPO

- a) **Normative Activities:** involving the setting of norms and standards for the protection and enforcement of intellectual property rights through the conclusion of international agreement.
- b) **Program Activities:** involving legal and technical assistance to states in the field of intellectual property.
- c) **International classification and standardization activities:** involving cooperation among industrial property offices concerning patent, trademark and industrial design documentation.
- d) **Registration and filing activities:** involving services related to international applications for patents for inventions and for the registration of marks and industrial designs.

Functions of WIPO

1. Assisting campaigns development to improve IP protection all over the world and to harmonize national legislation in this field.
2. Signing the international agreements on IP protection.
3. Providing technical and legal assistance in the field of IP.

4. Collecting and circulating the information, conducting research and publishing their results.
5. Ensuring the work of the services facilitating the international IP protection.
6. Applying any other appropriate actions.

Intellectual Property Law

Intellectual Property Law (IPL)

The law which provides rules for securing and enforcing legal rights to inventions, designs, and artistic works is called as Intellectual property law.

In **Article 27, Universal Declaration of Human Rights** says that everyone has the right to the protection of the moral and material interests resulting from any scientific, literary or artistic production of which he is the author.

The Convention Establishing the **World Intellectual Property Organization (WIPO)**, concluded in **Stockholm on July 14, 1967 (Article 2(8))** provides that “intellectual property shall include rights relating to:

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

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

WIPO: Two main reasons of IPL

WIPO Handbook gives two reasons for Intellectual Property laws:

- to give statutory expression to the moral and economic rights of creators in their creations and the rights of the public access to those creations.
- to promote Government policy, creativity and to encourage fair trading which would contribute to economic and social development.

Purpose of IPL

- To encourage the creation of a wide variety of intellectual goods for consumers.
- To give the creator a limited protectable ownership interest.
- To give an incentive for people to develop creative works that benefit society.
- Intellectual property protection is critical to fostering innovation.

Intellectual Property Laws in Bangladesh

1. The Copyright Act, 2000 (amended in 2005)
2. The Trademarks Act, 2009(amended in 2015)
3. The Patents and Designs Act, 1911
4. Geographical Indication (Registration and Protection) Act, 2013

Copyright

Copyright

Copyright is a legal right which grants the creator of an original work the exclusive rights to its use and distribution, usually for a limited time.

It is a legal term used to describe the rights that creators have over their literary and artistic works. Works covered by copyright range from books, music, paintings, sculpture, films, computer programs, databases, advertisements, maps, and technical drawings.

- **According to Black's Law Dictionary:**

Copyright is the exclusive right of the owner of an intellectual production to multiply and dispose of copies; the sole right to the copy, or to copy it.

It is an incorporeal right, being the exclusive privilege of printing, reprinting, selling, and publishing his own original work, which the law allows an author.

- **According to WIPO:**

Copyright (or author's right) is a legal term used to describe the rights that creators have over their literary and artistic works. Works covered by copyright range from books, music, paintings, sculpture, and films, to computer programs, databases, advertisements, maps, and technical drawings.

Ownership of Copyright

Author is the person who does the creative work. In the narrow sense, an author is the originator of any written work. Author is broadly defined as the person who originates or gives existence to anything.

Under Section 2(24) "author" means-

- a) regarding a **literary or dramatic work**, the author of the work
- b) regarding a **musical work**, the composer
- c) regarding an **artistic work**, except photograph, the artist

Under Section 2(36) "artistic work" means

- (a) a painting, a sculpture, a drawing (including a diagram, map, chart or plan), an engraving or a photograph whether or not any such work possesses artistic quality
 - (b) a work of architecture; and
 - (c) any other work of artistic craftsmanship
- d) regarding a **photograph**, the person taking the photograph
 - e) regarding a **cinematograph film or a sound recording**, the producer, and
 - f) regarding any literary, dramatic, musical or artistic work which is **computer generated**, the person or institution who causes the work to be created

First owner of copyright (Section 17)

- ✓ The author of a work shall be the first owner of the copyright.
- ✓ In the case of a literary, dramatic or artistic work made by the author under course of employment/contract of service/Apprenticeship; the employer shall be the first owner of copyright.
- ✓ In case of a photograph taken or a painting or a portrait drawn, or an engraving or a cinematograph film made by a person under anyone's personal initiative or exchange of money, the person shall be the first owner of the copyright therein.
- ✓ In the case of an address or speech delivered in public, the person who has delivered such address or speech, shall be the first owner of it, if such person has delivered such address or speech on behalf of any other person, such other person shall be the first owner of the copyright.
- ✓ In the case of a Government work, the Government shall be the first owner of the copyright therein, if there is no other agreement.
- ✓ In the case of a computer programme, the person or persons or institution appointed for creating the programme, shall be the first owner of copyright, if there is no other agreement.

“Owner of the copyright” shall include- (Section 75)

- (a) an exclusive licensee
- (b) in case of an anonymous or pseudonymous literary, dramatic, musical or artistic work, the publisher of the work

Fair use

Fair use is the necessary exception to copyright protection. It allows someone other than the copyright holder to copy, display, perform, and distribute copyrighted material under certain conditions without first obtaining permission.

Fair use is a doctrine under copyright law. It outlines the legal boundaries of utilizing copyrighted material without the copyright holder's permission. Fair use is a contradiction of the basic concept of copyright. Fair use provides the privilege of using an author's work without permission or payment.

Copyright Infringement

When copyright infringed (Section 71)

When any person, without a license granted by the owner of the copyright or the Registrar under this Act----

- does anything
- makes for sale or hire, or sells or lets for hire, or by way of trade displays or offers for sale or hire
- distributes for the purpose of trade
- by way of trade exhibits in public
- imports into Bangladesh, any infringing copies of the work

The above-mentioned acts will be treated as infringement of copyright.

Essential ingredients of Infringement of Copyright

Depending upon the nature of copyright work, infringement involves one or more of the following acts without the authorization of copyright owner:

- a) Reproduction of the work in any material form
- b) Publication of the work
- c) Communication of the work to the public
- d) Performance of the work in public, and
- e) Making of adaptations and translations of the work and doing any of the above acts in relation to a substantial part of the work.

Remedies of Copyright

Offences of infringement of copyright or other rights conferred by this Act (Section 82)

Any person who willingly infringes or abets the infringement of the copyright in a work, or any other right conferred by this Act, except the right conferred by section 23, other than in the case of cinematograph film, shall be punished with imprisonment for a term which may extend to four years but not less than six months and with fine which may extend to taka two lakh but not less than taka 50,000 (fifty) thousand.

Any person who willingly infringes or abets the infringement of copyright in a cinematograph film, shall be punished with imprisonment which may extend to five years but not less than one year and with a fine of not exceeding five lakhs but not less than one lakh.

Duration of Copyright protection in Bangladesh

In Bangladesh the term of copyright varies according to the nature of the work and whether the author is a natural person or a legal person e.g., a corporation, Government Institution, etc., or whether the work is anonymous or pseudonymous.

Sections 24-38 of the 2000 Act deal with the term of protection as follows:

- 1) in cases of literary, artistic, musical, dramatic works, the terms are 60 years from the beginning of the calendar years next following the year in which the author dies (Life + 60 years) [Section 24]
- 2) in case of joint authorship of a work, the term will be 60 years from the death of last surviving author (60 years from death of the last surviving author) [Section 25]
- 3) in case of cinematographic film, the term is 60 years following the year in which the film is published (60 years from publication) [Section 26]
- 4) in case of sound recordings, it is 60 years from publication (60 years from publications) [Section 27]
- 5) in cases of photograph, the term is 60 years from the beginning of calendar year next following the year in which the photograph is published (60 years from publication) [Section 28]
- 6) in cases of Computer program, it is 60 years from first publication (60 years from first publication) [Section 28(a)]
- 7) in cases of Govt. works, it is 60 years from first publication (60 years from first publication) [Section 30]
- 8) in cases of local authority, the term is 60 years from first publication (60 years from first publication) [Section 31]
- 9) in case of works of international organizations, the term is 60 years from first publication (60 years from first publication) [Section 32]
- 10) in case of broadcasting, the term is 25 years from the beginning of the calendar year next following the year in which the broadcasting is made (25 years from broadcasting) [Section 33]
- 11) in case of performance, it is 50 years from the beginning of the year next following the year in which the performance is made (50 years from the first performance is made) [Section 34]
- 12) in case of published edition (typographical arrangement), the term is 25 years from the beginning of the calendar year next following the year in which the edition is first published (25 years from the first publication) [Section 35]

Copyright Act also provides for the protection of broadcast reproduction rights for a term of twenty years from the beginning of the calendar year next following the year in which the broadcast is made and protection of performer's rights, which extends to fifty years from the beginning of the calendar year next following the year in which the performance is made.

Patent

Patent

Patent is a monopoly right granted to an inventor for his invention. It means a right granted to anyone who invents or discovers a new and useful process, product, article or machine of manufacture, or composition of matter, or any new and useful improvement of any of those.

- **According to Halsbury's Laws of England,**

A patent denotes a **monopoly or exclusive right** in respect of an invention. It is the reward of the inventor.

- **The Patents and Designs Act, 1911** is the regulatory law in Bangladesh.

Section 2(11) provides that "patent" means a patent granted under the provisions of this Act.

Section 2 (12) provides "patentee" means the person for the time being entered on the register of patents kept under this Act as the grantee or proprietor of the patent.

- **According to WIPO,**

A patent is an exclusive right granted for an invention over a product or a process that provides a new way of doing something or offers a new technical solution to a problem.

- **Hoffmann opines that,** Patent is a property right, which the State grants to inventors.

During the ruling period of Queen Elizabeth I in the UK modern patent system started.

Types of patents

An inventor of process of manufacture may have the either of the following types of patents:

1. An ordinary patent (under Section 3 of the Patent Act)
2. patent claiming priority of date (under Section 78A)
3. A secret patent (under Section 21A)
4. A patent of addition (under Section 15A of the Act)

Object of patent law

The core objective of patent law is to promote the **progress of science** and useful arts. It can be listed as:

1. **To encourage inventor:** If a person puts efforts and resources in invention something that can be patented, he should have a provision that stops others from copying his work without his permission. If it happens, he will get motivated to research further.
2. **To protect Inventors' interest:** By protecting inventions the Law also protects the goodwill and financial gains of the inventor. For e.g., if Patents are not provided anyone can copy the formula of drugs and can sell it at cheaper rates. This will affect the goodwill

- of the inventor in case the drug does not work, and the inventor will also lose his market that will result in financial loss.
3. **Encourage Research and Development:** If an inventor gets recognition for his work and at the same time his work is protected also, he may get motivated for further research. This will also motivate others to go into the field of research. All this will finally result in the technical and financial growth of society.
 4. **To ensure Fair trade practices:** By providing protection and monopoly rights the law indirectly stimulates fair trade practices. If a businessman knows that he will be facing legal action for copying others' process or product, he may not try to do so. This will help in controlling unfair competition.

Can a patent be granted for discovery or an idea?

A **discovery** is not patentable as such. Patents are granted only for **inventions**. It is the practical application of discovery which leads to patentability. Discovery is the unearthing of causes, properties or phenomena already existing in nature, whereas invention is the application of such knowledge to the satisfaction of social needs.

In **Reynolds v. Smith, Buckley L.J.** observed "Discovery adds to the amount of human knowledge, but it does so only by lifting the veil and disclosing something which before had been unseen or dimly seen. Invention also adds to human knowledge, but not merely by disclosing something. Invention necessarily involves also the suggestion of an act to be done, and it must be an act which results in a new product, or a new result, or a new process, or a new combination for producing an old product or an old result."

Like discovery, an **idea** is also not patentable. Therefore, unless an idea or a discovery is converted into an invention which is new, involves an inventive step and capable of industrial application, it is not patentable.

In **Hickton's Patent Syndicate v. Patents & Machine Improvements, Fletcher Moulton L.J.** stated:

Invention may lie in the idea, and it may lie in the way in which it is carried out, and it may lie in the combination of the two; but if there is invention in the idea plus the way of carrying it out, then it is good subject matter for Letters Patent.

Who can apply for a patent?

An application for a patent for an invention may be made by any of the following persons either alone or jointly with any other person:

1. any person claiming to be the true and first inventor of the invention.
2. any person being the assignee of the person claiming to be the true and first inventor in respect of the right to make such an application.

3. the legal representative of any deceased person who immediately before his death was entitled to make such an application.

Is it mandatory to get a patent?

It is not mandatory for an inventor to apply for a patent in respect of his invention. It is optional. The inventor may prefer to keep his invention secret instead of applying for a patent by disclosing it. However, where an inventor does not apply for a patent and exploit his invention by keeping it secret, he runs with the risk of his invention being disclosed to his competitors either by way of reverse engineering or by communication of information by someone who possesses such information and is under no obligation to keep it secret or by an independent discovery. In such a case, other people may start manufacturing the article by using the same invention. No remedy shall be available to the inventor in such a case.

In Shinning Industries v. Shri Krishna Industries, the Allahabad High Court held that an invention is not a property right unless it has been patented. It is due to this reason that inventors normally apply for patents and get monopoly rights for a specific period of time to exploit their inventions to the exclusion of all others.

Invention not patentable

The following inventions are not patentable:

- 1) An invention which is frivolous, or which claims anything obvious or contrary to well-established natural laws.
- 2) An invention the primary or intended use of which would be contrary to law or morality or injurious to public health.
- 3) The mere discovery of a scientific principle or the formulation of an abstract theory (e.g., the theory of relativity is not patentable).
- 4) The mere discovery of any new property or new use for a known substance or of the mere use of known process, machine, or apparatus unless such known process results in a new product or employs at least one new reactant.
- 5) A substance obtained by a mere admixture resulting only in the aggregation of the properties of the components thereof or a process for producing such substance.
- 6) The mere arrangement or rearrangement or duplication of known devices each functioning independently of one another in a known way.
- 7) A method or process of testing applicable during the process of manufacture for rendering the machine, apparatus, or other equipment more efficient or for the improvement or restoration of the existing machine, apparatus or other equipment or for the improvement or control of manufacture.
- 8) A method of agriculture or horticulture

- 9) A process for the medical, surgical, curative, rain prophylactic or other treatment of human beings or any process for a similar treatment of animals or plants to render them free of disease or to increase their economic value or that of their products.
- 10) An invention relating to atomic energy.
- 11) In respect of food, medicine or drug, patents are granted only for the process of manufacture of the substance but not for the substance itself.
- 12) In respect of substances produced by chemical processes (including alloys, optical glass, semi-conductors and intermetallic compounds) patents are granted only for the process of manufacture but not for the substance itself.

Trademark

Trademark

A trademark is a visual symbol in the form of a word, a device, or a label applied to articles of commerce with a view to indicate to the purchasing public that they are the goods manufactured or otherwise dealt in by a particular person as distinguished from similar goods manufactured or dealt in by other persons.

- **According to Black's Law Dictionary:**

A trademark means a word, phrase, logo, or other graphic symbol used by a manufacturer or seller to distinguish its product or products from those of others.

- **According to WIPO:**

A trademark is a sign capable of distinguishing the goods or services of one enterprise from those of other enterprises. Trademarks are protected by intellectual property rights.

Characteristics of trademark

There are three essentials of trademarks:

- 1) It should be a mark.
- 2) It should be capable of being represented graphically.
- 3) It should be capable of distinguishing the goods or services of one person from those of others.

There are also other characteristics of trademarks:

- a) It may include shape of goods, their packaging and combination of colors.
- b) It must be used or proposed to be used in relation to goods or services.
- c) The use must be for the purpose of indicating a connection in the course of trade between the goods or services and some persons having the right as proprietor to use the mark.
- d) The right to proprietorship of a trademark may be acquired by registration under the Act or by use in relation to particular goods or services.

Functions of Trademark

A trademark normally performs following functions:

- it identifies the goods of one trader and distinguish them from goods sold by others
- it signifies that all goods bearing a particular trademark come from a single source
- it signifies that all goods bearing a particular trademark are of an equal level of quality;
- it acts as a prime instrument in advertising and selling the goods.

The main functions of a trademark are, therefore, **identification, source, quality and advertising.**

What is a good trademark?

Apart from distinctiveness or capable of distinguishing a good trademark should possess the following attributes:

1. it should be easy to pronounce and remember, if the mark is a word,
2. in the case of device mark the device should be capable of being described by a single word,
3. it must be easy to spell correctly and write legibly,
4. it should not be descriptive but may be suggestive of the quality of the goods,
5. it should be short and simple,
6. it should appeal to the eye as well as to the ear,
7. it should satisfy the requirements of registration,
8. it should not belong to the class of marks prohibited for registration.

Remedy for Trademark Infringement (Section 73, 76)

73. Penalty for applying false trademarks, trade descriptions, etc.

If any person-

- (a) falsifies any trademark,
 - (b) falsely applies any trademark to goods or services,
 - (c) makes, hands over, or keeps in his possession, or uses any die, block, machine, plate or other instrument for the purpose of falsifying a trademark,
 - (d) applies any false trade description to goods or services,
 - (e) applies false identity, name and address to any goods instead of the identity of the country or place in which they were made or produced or the name and address of the manufacturer or the person for whom the goods were manufactured as required under section 108,
 - (f) effaces, alters or erases a correct mark or indication regarding production of any goods as required under section 108, or
 - (g) causes or organizes any of the activities described in Clauses (a) to (f),
- then, subject to the provisions of this Act, he shall be punishable with imprisonment for a maximum term of 2 (two) years but not less than 6 (six) months, or a maximum fine of 2 (two) lakhs but not less than 50 (fifty) thousand taka, or both; and if he is convicted a second time or next time for the same offence, imprisonment for a maximum term of 3 (three) years but not

less than 1 (one) year or a maximum fine of 3 (three) lakhs but not less than taka 1 (one) lakh, or both.

76. Penalty for representing an unregistered trademark as registered

(1) If any person –

- (a) represents an unregistered trademark as a registered trademark;**
- (b) represents part of a registered trademark as separately registered as a trademark although it is not so registered;**
- (c) represents that a trademark is registered for any goods or services although it is not in fact so registered; or**
- (d) gives the false notion that registration of a trademark gives an exclusive right to use thereof in any circumstances although it is registered with limitations;**

then, he shall be punishable with imprisonment for a maximum term of 1 (one) year but not less than 6 (six) months, or a maximum fine of 1 (one) lakh taka but not less than 50 (fifty) thousand taka, or both.