

AL 58 – Research Methodology and IPR

UNIT 5

*Text Book: Dr. B L Wadehra,
Law Relating to Intellectual Property*

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What is a Design?

Design Act was enacted in the year 2000

- “Design” means only the features of shape, configuration, pattern, ornament or
- composition of lines or colours applied to any article
- whether in two dimensional or three dimensional or in both forms,
- by any industrial process or means,
- whether manual, mechanical or chemical, separate or combined,
- which in the finished article appeal to and are judged solely by the eye; but does not include any mode or principle of construction or anything which is in substance a mere mechanical device, and does not include any trade mark

A design is defined under **Section 2(d)** of the **Designs Act 2001**, as only the features of a shape, pattern, configuration, composition, or ornament of lines or colors that are applied to any article that is two dimensional, three dimensional, or both by an industrial process or any means whether mechanical, manual or chemical, separated or combined, which in the finished article are judged solely by the eye; but is not taken into account upon the principle of construction or anything which is in substance a merely mechanical device.

Essential requirements for a registrable design

- A design should be **Original and new design**. This means that it should not have been used or published previously in any country before the date of application of registration.
- NO Prior publication (Publication in prior document & Publication by prior user)
- The design must be applied to a particular article.
- The design must have a visual appeal.
- Effect of an earlier or later design

- A design should be significantly distinguishable from known designs or a combination of known designs
- A design should not comprise or contain scandalous or obscene matter
- A design should not be a mere mechanical contrivance
- A design should not be contrary to public order or morality

Procedure for registration of a design

The procedure consists of the following steps:

1. Submission of application
2. Documents to be filed with the application
3. Acceptance / Objections / Refusal
4. Removal of Objections / appeal to Central Government
5. Decision of Central Government
6. Registration of a Design

Filing of Application:

- The application for design registration must be made on Form-1 along with the prescribed fee.
- The application must include the name, address, and nationality of the applicant,
- name of the article, class number, and address for service in India.
- The application must be signed by the applicant or an authorized agent, who must be a registered patent agent or legal practitioner in India.

Examination:

- After filing the application, the design is examined to ensure that it meets the formal requirements.
- The examination includes a substantive examination to determine if the design is novel, original, and has not been published or used before.

Publication: If the design is found to be eligible for registration, it is published in the **Patent Office Journal**.

Opposition: After publication, any person can file an opposition to the registration of the design **within four months** from the date of publication.

Registration: If no opposition is filed, or if the opposition is unsuccessful, the design is registered and a certificate of registration is issued.

Consumer Products



Pharmaceutical Product



Trademark

The trademark act was enacted in the year 1999.

- A **trademark** is a type of intellectual property consisting of a recognizable sign, design, or expression that identifies a product or service from a particular source and distinguishes it from others.
- A 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.
- Trademarks used to identify services are sometimes called service marks.

Trademark

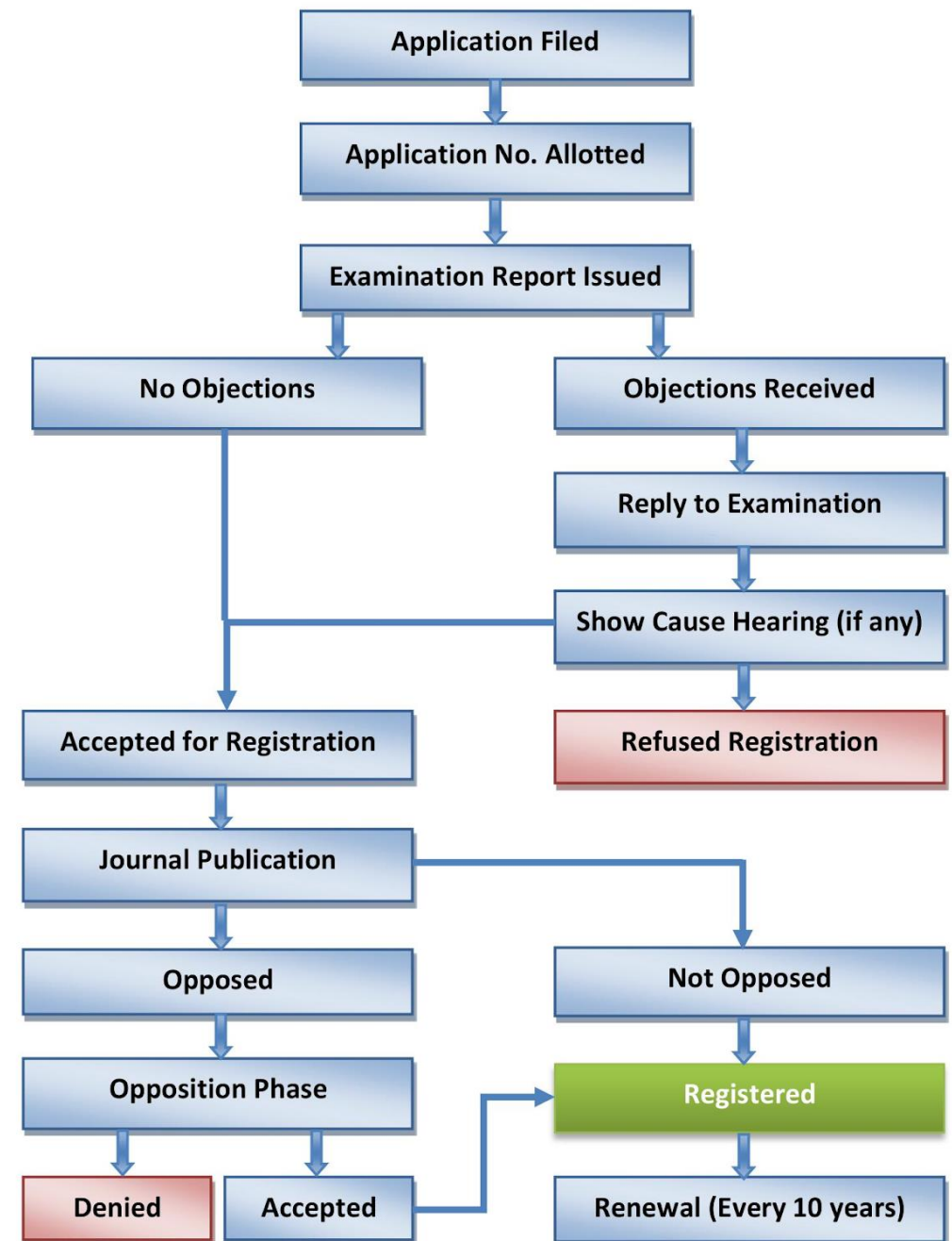


Essentials of a Trademark

- A trademark must be a mark which includes a device, heading, brand, label, ticket, signature, word, letter, name, numeral, packaging or combination of colors or any combination of the above attributes.
- It should be easy to speak and spell. A good trademark is such that the public can easily spell and speak.
- It should be easy to remember. A good trademark that is easy to speak and spell can be easily remembered as well. So that it becomes easy for public to
- It should not be too lengthy and complicated to be forgotten easily. If it is lengthy or complicated, people will not bother to take the effort to memorize it and ultimately it will be forgotten.

- It must be distinctive. It can be natural distinctiveness or acquired distinctiveness.
- The best trademarks are invented words or coined words or unique geometrical designs
- It can only be suggestive of the quality of the products, but not descriptive

Registration of a Trademark



Protection of Trademarks in India

To protect the trademark in India, the following remedies can be resorted.

- Civil Remedies
- Criminal Proceedings
- Administrative Remedies

~~Criminal~~ Remedies:

When instances of infringement and passing off occur,
the court of competent jurisdiction (not lower than district court) can
be moved for grant of interlocutory injunction,
Anton pillar orders,
damages and account of profits.

Criminal Remedies:

An **interlocutory injunction** is a temporary order issued by the court to prevent the defendant from continuing their infringing or passing off activities until the final determination of the case.

Anton Piller Orders

- **Purpose:** An Anton Piller order is a form of interim injunction that allows the plaintiff to enter the defendant's premises to search for and seize evidence of infringement or unlawful activity.

Criminal Remedies:

Damages

- **Purpose:** Damages refer to a monetary award intended to compensate the plaintiff for the harm suffered due to the infringement or passing off.

Account of Profits

- **Purpose:** An account of profits is a remedy where the defendant is ordered to pay the profits they made as a result of the infringement or passing off.

Criminal Proceedings:

Complaint may be made against person causing infringement.

Both the actions under civil law and criminal law can be initiated simultaneously. Under the civil law proceedings, the plaintiff seeks reliefs for himself while under the criminal law proceedings the complainant seeks award of punishment to the infringer.

Administrative Remedies:

Opposition the registration of deceptively similar trade mark when the Trade Mark registry is in the process of considering the grant of a trade mark, can protect the trademark.

The registry can also be moved for removal of a deceptively similar trade mark.

Rights conferred by registration of Trademarks

Section 28 of the Trademark Act 1999 confers on the proprietor of the trademark, exclusive right to use of trade mark in relation to the goods or services in respect of which the trade mark is obtained.

In addition to conferring the right of exclusive dealing, the proprietor of the trademark also has the right to file a suit for infringement of his right and obtain:

1. Temporary injunction.
2. Permanent injunction.
3. Damages.
4. Account of profits (damages in the amount of the profits gained from the infringement)
5. Destruction of goods using the infringing mark.
6. Cost of legal proceedings

Infringements

A trademark is said to be infringed, when a registered trademark or a trademark deceptively similar to the registered trademark is used by a person, who is neither the registered proprietor nor the licensee and/or assignee of the said trademark in relation to the goods and services for which it is registered.

A registered trademark is said to be infringed in case of the following situation:

- If the mark in dispute is identical with or deceptively similar to the registered trademark and is in relation to the same or similar goods or services;
- If the identical or similar mark can cause confusion in the minds of general public to have an association with the registered trademark
- If the registered trademark is used as a part of trade name or business concern for goods and services in respect of which the trademark is registered
- If the trademark is advertised and as a result it takes unfair advantage or is contrary to the honest practices or is detrimental to the distinctive character and reputation of the registered trademark.
- If the registered trademark is used in the material meant for packaging or labelling of other goods or as a business paper without due authorization of the registered user.

Types of reliefs to which a plaintiff is entitled are:

- An injunction restraining further use of the infringement mark.
 - **Anton Piller Injunction** : An Anton Piller order is a form of interim injunction that allows the plaintiff to enter the defendant's premises to search for and seize evidence of infringement or unlawful activity.
 - **Mareva Injunction** : granted by a court to prevent a defendant from dissipating or removing assets from the jurisdiction to avoid the enforcement of a potential judgment.
 - **Interlocutory injunction** : An **interlocutory injunction** is a court order that is issued during the course of legal proceedings, typically before a final judgment is reached. The purpose of an interlocutory injunction is to maintain the status quo or to prevent harm or injustice while the legal process continues. It is a temporary measure aimed at preserving the rights of the parties until the case is fully resolved.
 - **Perpetual Injunction** : A **perpetual injunction** is a type of court order that is granted after a final determination of a case, requiring the defendant to do or refrain from doing a specific act permanently or indefinitely
- Damages or an account of profits
- An order to delivery up infringing labels and marks for destrucion or erasure.

Copyrights

- ❑ 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.
- ❑ Copyright is a type of intellectual property that protects original works of authorship as soon as an author fixes the work in a tangible form of expression.

Characteristics of copyrights

1. Creation of a Statute : statutes are the legal frameworks that protect the rights of creators and inventors
2. Some form of Intellectual Property : Intellectual Property (IP) refers to creations of the mind that are protected by law. These creations can take various forms, such as: design, patents etc
3. Monopoly Right : means that the holder of a right has exclusive control over the use and exploitation of a particular creation or invention.
4. Negative Right : right to **exclude others** from using the work in ways that the copyright holder does not approve
5. Multiple Right : often refers to the concept that one work can be protected by several forms of IP rights or can grant the creator multiple types of rights.
6. Copyright only in the form of an Idea : **Copyright** does **not** protect ideas, concepts, or facts themselves.
7. Neighboring Rights : are rights granted to people who contribute to the creation of a work but are not the actual authors or creators. These rights are often associated with performers, producers, broadcasters, and others who help make a work publicly accessible.

Characteristics of copyrights

1. Creation of a Statute : statutes are the legal frameworks that protect the rights of creators and inventors
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Rights conferred by registration of Copyrights.

1. Statutory Rights
2. Negative Rights
3. Multiple Rights
4. Economic Rights
5. Moral Rights

Registration of Copyrights.



Filling of
Application
in IPO Office

Examination
of
Application

Publication in
Newspaper
(Artistic Work Only)

Opposition
if
any

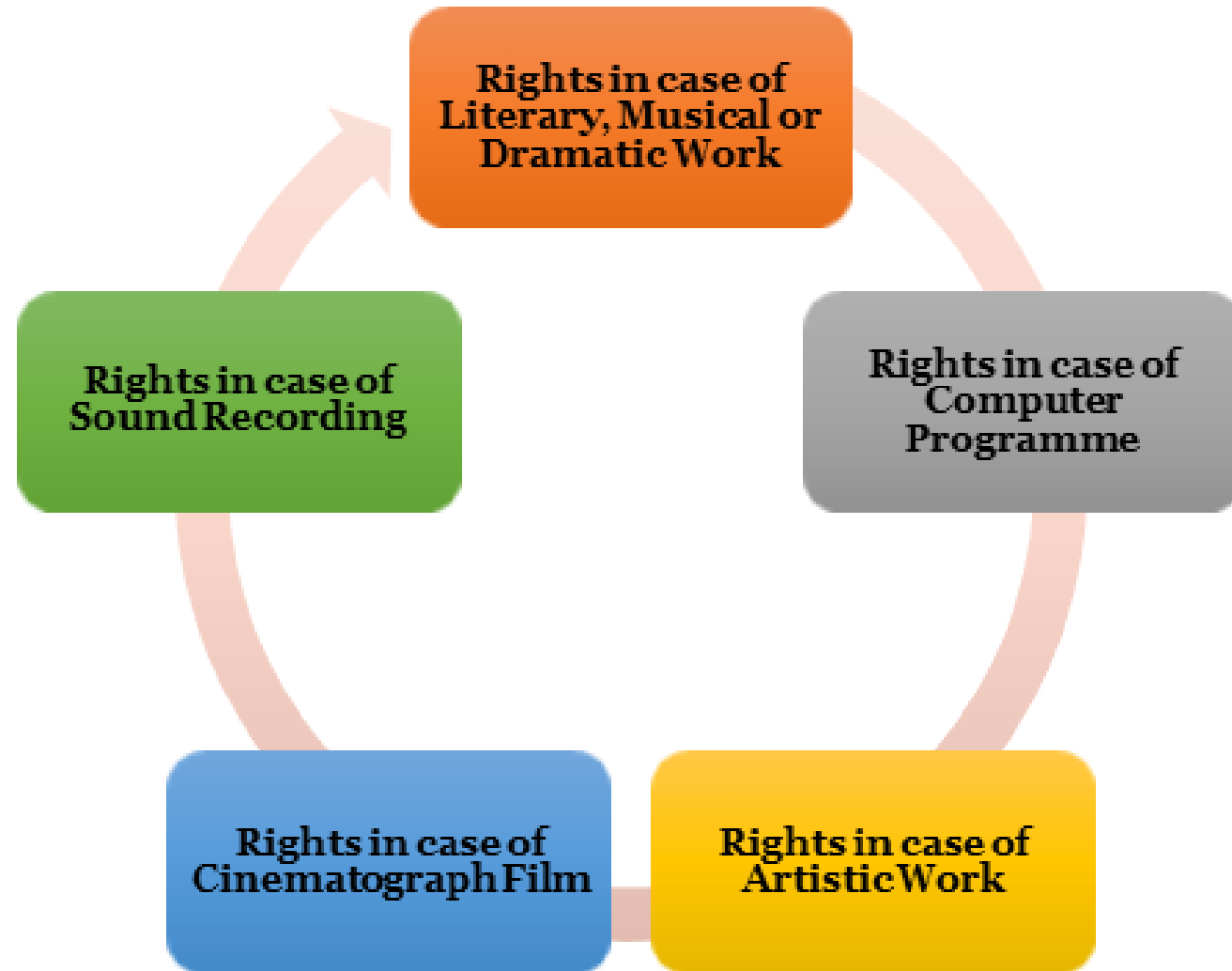
Copyright
Registration

Infringements

- ❑ Copyright infringement is the use or production of copyright-protected material without the permission of the copyright holder.
- ❑ Copyright infringement means that the rights afforded to the copyright holder, such as the exclusive use of a work for a set period of time, are being breached by a third party.
- ❑ Music and movies are two of the most well-known forms of entertainment that suffer from significant amounts of copyright infringement.
- ❑ Infringement cases may lead to contingent liabilities, which are amounts set aside in case of a possible lawsuit.

- Copyright infringement is the use or production of copyright-protected material without the permission of the copyright holder.
- Individuals and companies who develop new works register for copyright protection to ensure that they can profit from their efforts.
- Other parties may be granted permission to use those works through licensing arrangements or buy the works from the copyright holder.

Infringements Types



Remedies against Infringement of copyrights

- Civil Remedies

 - Anton Piller

 - Interlocutory Injunction

 - Damages or Account of Profits

- Criminal Remedies

- Administrative Remedies

