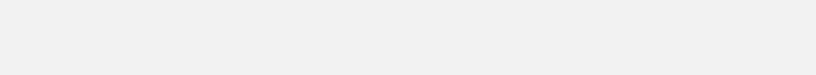
 **Intellectual Property Rights** 



**INTELLECTUAL PROPERTY RIGHTS**

**1.1 Introduction**

For nearly last two hundred years, neo-classical economics had recognized only

two  factors  of  production:  labour  and  capital.  But  now  this  is  changing.

Information  and  knowledge  are  replacing  capital  and  energy  as  the  primary

wealth-creating assets, just as the latter two replaced land and labour 200 years

ago.   In   addition,   technological   developments   in   the   20th   century   have

transformed  the  majority  of  wealth-creating  work  from  physically-based  to

"knowledge-based.”  Technology  and  knowledge  are  now  the  key  factors  of

production.  With  increased  mobility  of  information  and  the  global  work  force,

knowledge  and  expertise  can  be  transported  instantantly  around  the  world,  and

any  advantage  gained  by  one  company  can  be  eliminated  by  competitive

improvements overnight. The only comparative advantage a company will enjoy

will  be  its  process  of  innovation--combining  market  and  technology  know-how

with  the  creative  talents  of  knowledge  workers  to  solve  a  constant  stream  of

competitive problems--and its ability to derive value from information. The major

challenge before organizations in the coming years would be to create a culture

for IPRs regime, so that creative work and innovations get duly protected. More

and  more  organizations  may  have  to  provide  at  their  cost  the  services  of  IP

Management Consulting Firm for drafting/prosecution of the intellectual Property

(IP)  application(s)  and  also  provide  adequate  funds  for  making  payments  for

accessing the relevant IP databases for this purpose. Thus, to make  Economics

of Knowledge as the greatest strength of Indian economy, there would be  need

for  creating  an  ecosystem  for  promotion  of  particularly  knowledge  driven

entrepreneurship with major emphasis on creating an environment and a system

to  provide  due  protection  to  the  intellectual  properties.  This  can  be  achieved  by

creating a stringent IPR regime.

1

Intellectual Property Rights (IPR), very broadly, are rights granted to creators and

st

owners of works that are results of human intellectual creativity. These works can

be  in  the  industrial,  scientific,  literary  and  artistic  domains,  which  can  be  in  the

form of an invention, a manuscript, a suite of software, or a business name.

The  importance  of  intellectual  property  in  India  is  well  established  at  all  levels-

statutory, administrative and judicial. India ratified the agreement establishing the

World  Trade  Organisation  (WTO).  This  Agreement,  inter-alia,  contains  an

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

which came into force from 1  January 1995. It lays down minimum standards for

protection  and  enforcement  of  intellectual  property  rights  in  member  countries

which  are  required  to  promote  effective  and  adequate  protection  of  intellectual

property  rights  with  a  view  to  reducing  distortions  of  and  impediments  to

international  trade.  The  obligations  under  the  TRIPS  Agreement  relate  to

provision  of  minimum  standard  of  protection  within  the  member  countries  legal

systems and practices.

The Agreement provides for norms and standards in respect of following areas of

intellectual property:

•        Patents

•        Copyrights and related rights

•        Trade Marks

•        Geographical Indications

•        Industrial Designs

•        Layout Designs of Integrated Circuits

•        Protection of Undisclosed Information (Trade Secrets)

•        Plant varieties

IPR is a general term covering patents, copyright, trademark, industrial designs,

geographical  indications,  protection  of  layout  design  of  integrated  circuits  and

protection of undisclosed information (trade secrets).

2

**1.2**

**Legislations Covering IPRS in INDIA**

**1.2.1 Patents:** The Patents Act, 1970.

The act was last amended in March 1999.

**1.2.2**  **Design:**  The  Designs  Act,  1911.  A  new  Designs  Act  2000  has  been

enacted superseding the earlier Designs Act 1911.

**1.2.3  Trade  Mark:**  The  Trade  and  Merchandise  Marks  Act,  1958.  A  new

Trademarks  Act,  1999  has  been  enacted  superseding  the  earlier  Trade  and

Merchandise Marks Act, 1958. (Enforcement pending)

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

1994, 1999 and the Copyright Rules, 1958.

**1.2.5  Layout  Design  of  Integrated  Circuits:**  The  Semiconductor  Integrated

Circuit   Layout   Design   Act   2000.   (Enforcement   pending)   Protection   of

Undisclosed Information: No exclusive legislation exists but the matter would be

generally covered under the Contract Act, 1872

**1.2.6   Geographical   Indications:**   The   Geographical   Indication   of   Goods

(Registration and Protection) Act 1999. (Enforcement pending).

**PATENTS**

The Patents Act, 1970 is a landmark in the industrial development of India. The

basic  philosophy  of  the  Act  is  that  patents  are  granted  to  encourage  inventions

and  to  ensure  that  these  inventions  are  worked  on  a  commercial  scale  without

undue delay.

3

The word “Invention “has been defined under the Patents Act 1970 as amended

from time to time; as

*“An****invention****means a new product or process involving an inventive step and*

*capable of industrial application” (S. 2(1) (j))*

“**New  invention”  is  defined  as  any  invention  or  technology  which  has  not**

**been anticipated by publication in any document or used in the country or**

**elsewhere  in  the  world  before  the  date  of  filing  of  patent  application  with**

**complete  specification,  i.e.  the  subject  matter  has  not  fallen  in  public**

**domain or that it does not form part of the state of the art .**

A patent is an exclusive right granted by a country to the owner of an invention to

make,  use,  manufacture  and  market  the  invention,  provided  the  invention

satisfies  certain  conditions  stipulated  in  the  law.  Exclusivity  of  right  implies  that

no  one  else  can  make,  use,  manufacture  or  market  the  invention  without  the

consent  of  the  patent  holder.  This  right  is  available  only  for  a  limited  period  of

time. However, the use or exploitation of a patent may be affected by other laws

of the country which has awarded the patent.

These  laws  may  relate  to  health,  safety,  food,  security  etc.  Further,  existing

patents  in  a  similar  area  may  also  come  in  the  way.  A  patent  in  the  law  is  a

property right and hence, can be gifted, inherited, assigned, sold or licensed. As

the  right  is  conferred  by  the  State,  it  can  be  revoked  by  the  State  under  very

special   circumstances   even   if   the   patent   has   been   sold   or   licensed   or

manufactured  or  marketed  in  the  meantime.  The  patent  right  is  territorial  in

nature and inventors/their assignees will have to file separate patent applications

in  countries  of  their  interest,  along  with  necessary  fees,  for  obtaining  patents  in

those countries.

4

By virtue of the grant of a patent, patentee gets the exclusive rights in his favour

that prevent the third parties (not having his consent) from making, using, offering

for sale, selling or importing the patented product or process within the territory of

grant.

The  basic  obligation  in  the  area  of  patents  is  that,  invention  in  all  branches  of

technology  whether  products  or  processes  shall  be  patentable  if  they  meet  the

three  tests  of:  being  new,  involving  an  inventive  step,  and  being  capable  of

industrial application. In addition to the general security exemption which applies

to  the  entire  TRIPS  Agreement,  specific  exclusions  are  permissible  from  the

scope  of  patentability  of  inventions,  the  prevention  of  whose  commercial

exploitation is necessary to protect public order or morality, human, animal, plant

life or health; or to avoid serious prejudice to the environment. Further, members

may also exclude from patentability diagnostic, therapeutic and surgical methods

of  treatment  of  humans,  animals  and  plants  other  than  micro-organisms  and

essentially biological processes for the production of plants and animals.

The  TRIPS  Agreement  provides  for  a  minimum  term  of  protection  of  20  years

counted  from  the  date  of  filing.  India  has  already  implemented  its  obligations

under Articles 70.8 and 70.9 of TRIPS Agreement.

A  comprehensive  review  of  the  Patents  Act,  1970  was  also  made  and  a  bill  to

amend  the  Patents  Act,  1970  was  introduced  in  Parliament  on  20th  December,

1999  and  notified  on  25-6-2002  to  make  the  Patents  Law  TRIPS  compatible.

India  amended  its  Patents  Act  again  in  2002  to  meet  the  second  set  of

obligations  (Term  of  Patent  etc.),  which  had  to  take  effect  from  1-1-2000.  This

amendment, which provides for 20 years term for the patent, reversal of burden

of  proof  etc.,  came  into  force  on  20th  May,  2003.  The  Third  Amendment  of  the

Patents  Act  1970,  by  way  of  the  Patents  (Amendment)  Ordinance  2004  came

into force on 1st January, 2005 incorporating the provisions for granting product

patent   in   all   fields   of   Technology   including   chemicals,   food,   drugs   and

5

agrochemicals   and   this   Ordinance   has   been   replaced   by   the   Patents

(Amendment) Act 2005 which has been in force now with effect from 1-1-2005.

**2.1 Conditions to be satisfied by An Invention to be Patentable**

An invention must satisfy the following three conditions of:

**(i)**

Novelty

**(ii)**

Inventiveness (Non-obviousness)

**(iii)**

Usefulness

**(i)**

**Novelty:**

A  novel  invention  is  one,  which  has  not  been  disclosed,  in  the  prior  art  where

prior  art  means  everything  that  has  been  published,  presented  or  otherwise

disclosed to the public on the date of patent (The prior art includes documents in

foreign  languages  disclosed  in  any  format  in  any  country  of  the  world).  For  an

invention to be judged as novel, the disclosed information should not be available

in the 'prior art'. This means that there should not be any prior disclosure of any

information  contained  in  the  application  for  patent  (anywhere  in  the  public

domain,  either  written  or  in  any  other  form,  or  in  any  language)  before  the  date

on which the application is first filed i.e. the 'priority date'.

**(ii)**

**Inventiveness (Non-obviousness):**

A  patent  application  involves  an  inventive  step  if  the  proposed  invention  is  not

obvious  to  a  person  skilled  in  the  art  i.e.,  skilled  in  the  subject  matter  of  the

patent  application.  The  prior  art  should  not  point  towards  the  invention  implying

that  the  practitioner  of  the  subject  matter  could  not  have  thought  about  the

invention prior to filing of the patent application. Inventiveness cannot be decided

on the material contained in unpublished patents. The complexity or the simplicity

of an inventive step does not have any bearing on the grant of a patent. In other

6

words a very simple invention can qualify for a patent. If there is an inventive step

b)

between  the  proposed  patent  and  the  prior  art  at  that  point  of  time,  then  an

invention has taken place.

**(iii)**

**Usefulness:**

An invention must possess utility for the grant of patent. No valid patent can be

granted for an invention devoid of utility.

**2.2 Patentable Inventions under the Patents Act, 1970**

a)  Art, process, method or manner of manufacture.

Machine,    apparatus    or    other    article,    Substances    produced    by

manufacture,  which  include  any  new  and  useful  improvements  of  any  of

them and an alleged invention.

c)  However,  inventions  claiming  substance  intended  for  use,  or  capable  of

being  used,  as  food  or  as  medicine  or  drug  or  relating  to  substances

prepared  or  produced  by  chemical  processes  (including  alloys,  optical

glass, semiconductors and inter-metallic compounds) are not patentable.

**2.3 Types of Inventions which are not Patentable in India**

An invention may satisfy the conditions of novelty, inventiveness and usefulness

but it may not qualify for a patent under the following situations:

a)  An invention which is frivolous or which claims anything obviously contrary

to  well  established  natural  laws  e.g.  different  types  of  perpetual  motion

machines.

7

b)  An invention the primary or intended use of which would be contrary to law

or morality or injurious to public health e.g. a process for the preparation of

a beverage which involves use of a carcinogenic substance, although the

beverage may have higher nourishment value.

c)  The  mere  discovery  of  a  scientific  principle  or  formulation  of  an  abstract

theory e.g., Raman Effect.

d) The mere discovery of any new property or new use of known substance

or the mere use of a known process, machine or apparatus unless such a

known  process  results  in  a  new  product  or  employs  at  least  one  new

reactant.

e)   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.

f)   The  mere  arrangement  or  rearrangement  or  duplication  of  features  of

known devices each functioning independently of one another in a known

way.

g)   A   method   or   process   of   testing   applicable   during   the   process   of

manufacture  for  rendering  the  machine,  apparatus  or  other  equipment

more efficient.

h)  A method of agriculture or horticulture.

i)

Any process for medical, surgical, curative, prophylactic or other treatment

of  human  beings,  or  any  process  for  a  similar  treatment  of  animals  or

plants.

8

j)

Inventions relating to atomic energy.

**2.4 Term of a Patent in the Indian System**

(a)

Five years from the date of sealing of the patent or seven years from the

date  of  the  patent  (i.  e.  the  date  of  filing  the  complete  specification),

whichever  period  is  shorter,  for  an  invention  claiming  the  method  or

process of manufacture of a substance, where the substance is intended

or capable of being used as a drug, medicine or food.

(b)

Twenty  years  from  the  date  of  patent  in  respect  of  any  other  patentable

invention.

**2.5**

**Essential Patent Documents to be submitted**

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

namely

**(i)**

Provisional Specification and

**(ii)**

Complete Specification

A  provisional  specification  is  usually  filed  to  establish  priority  of  the  invention  in

case the disclosed invention is at a conceptual stage and a delay is expected in

submitting  full  and  specific  description  of  the  invention.  Although,  a  patent

application accompanied with provisional specification does not confer any legal

patent  rights  to  the  applicants,  it  is,  however,  a  very  important  document  to

establish the earliest ownership of an invention. The provisional specification is a

permanent and independent scientific cum legal document and no amendment is

allowed in this. No patent is granted on the basis of a provisional specification. It

9

has to be followed by a complete specification for obtaining a patent for the said

invention. Complete specification must be submitted within 12 months of filing the

provisional  specification.  This  period  can  be  extended  by  3  months.  It  is  not

necessary to file an application with provisional specification before the complete

specification.  An  application  with  complete  specification  can  be  filed  right  at  the

first instance.

**(ii)**

**Complete Specification:**

Submission  of  complete  specification  is  necessary  to  obtain  a  patent.  The

contents of a complete specification would include the following

**Title of the invention**



Field to which invention belongs.



Background of the invention including prior art giving drawbacks of the

known inventions practices.



Complete description of the invention along with experimental results.



Drawings etc. essential for understanding the invention.



Claims,  which  are  statements,  related  to  the  invention  on  which  legal

proprietorship is being sought. Therefore the claims have to be drafted

very carefully.

Note: Some sample forms for filling of Patent application are given in Annexure-1.

**2.6 Criteria for Naming Inventors in an Application for Patent**

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

a)

All persons who contribute towards development of patentable features of

an invention should be named as inventor(s).

10

b)

All persons, who have made intellectual contribution in achieving the final

results  of  the  research  work  leading  to  a  patent,  should  be  named  as

inventor(s).

c)

A  person  who  has  not  contributed  intellectually  in  the  development  of  an

invention is not entitled to be included as an inventor.

d)

A  person  who  provides  ideas  needed  to  produce  the  ‘germs  of  the

invention’  need  not  himself  /  herself  carry  out  the  experiments,  construct

the   apparatus   with   his/her   own   hands   or   make   the   drawings

himself/herself.  The  person  may  take  the  help  of  others.  Such  persons

who have helped in conducting the experiments, constructing apparatus or

making  the  drawings  or  models  without  providing  any  intellectual  inputs

are not entitled to be named as inventors.

Quite  often  difficulties  are  experienced  in  deciding  the  names  of  inventors.  To

avoid  such  a  situation,  it  is  essential  that  all  scientists  engaged  in  research

should keep factual, clear and accurate record of daily work done by them in the

form  of  a  diary.  The  pages  in  the  diary  should  be  consecutively  numbered  and

the  entries  made  should  be  signed  both  by  the  scientists  and  the  concerned

leader.

**2.7 Where to apply?**

Application  for  the  patent  has  to  be  filed  in  the  respective  patent  office  as

mentioned below. The territorial jurisdiction is decided based on whether any of

the following occurrences falls within the territory:

a)

Place  of  residence,  domicile  or  business  of  the  applicant  (first  mentioned

applicant in the case of joint applicants)

b)

Place from where the invention actually originated.

c)

Address for service in India given by the applicant when he has no place

of business or domicile in India.

11

A foreign applicant should give an address for service in India and the jurisdiction

will  be  decided  upon  that.  An  applicant  (Indian  or  foreigner)  also  can  give  his

Patent Agent’s address as address for serving documents, if he/she so wishes.

**Table: 2.1 Various Patent Offices in India**

Patent Office

Territorial Jurisdiction

Mumbai

States    of    Gujarat,    Maharashtra,   
Madhya  Pradesh,  Goa,  Chattishgarh;   
Union  territories  of  Daman  and  Diu,

and Dadra and Nagar Haveli

Delhi

State  of  Haryana,  Himachal  Pradesh,   
Jammu  &  Kashmir,  Punjab,  Rajasthan,   
Utter   Pradesh,   Uttarnchal,   National   
Capital  Territory  of  Delhi  and  Union   
Territory of Chandigarh

Chennai

States   of   Andhra   Pradesh,   Kerala,   
Karnataka,   Tamil   Nadu;   and   Union   
Territories      of      Pondicerry      and   
Lakshdweep

Kolkata (Head Office)

Rest of India

**2.8 How to apply ?**

**Steps Involved in Obtaining a Patent**

o   To  file  an  application  for  patent  accompanied  with  either  a  provisional   
 specification or a complete specification

o   To  file  complete  specifications  ,  if  provisional  application  was  submitted   
 earlier

o   Examination of the application by patent office

o   Acceptance  of  applications  and  publication  in  the  gazette  of  accepted   
 applications

o   Responding  and  satisfactorily  overcoming  the  opposition/objections  ,  if   
 any, to the grant of patent

o   Sealing of patent

12

Application  for  patent  (Form  1)  in  duplicate  should  be  accompanied  by  the

documents as indicated below. The fee (Rs.1000/- for natural citizen of India or

Rs.4000 /- for other than a citizen) can be paid within one month. Other details of

the  fee  payable  for  different  purposes  are  given  in  the  Appendix  -3.  The  details

about various applicable forms for filing patents are given in the Appendix – 4.

 a)

Application for Grant of Patent (Form 1)

  b)        Provisional  or  Complete  Specification  (Form  2)  and  drawings  (if  any)  in

duplicate

c)

Statement and undertaking regarding foreign filing details in respect of the

same invention (Form 3)

d)

Declaration  as  to  Inventorship  (Form  5)  (In  the  case  of  a  Convention

Application and PCT National Phase Application and filing Complete after

Provisional)

e)

Priority document (if it is a Convention Application) 

f)

Power  of  Attorney  (Form  26)  (if  the  application  is  made  through  a  patent

agent)

g)

Proof of Right if the application is made by the assignee (Proof of right to

apply can be produced either in the body of the application (Endorsement

in Form1) or by way of a separate assignment deed.

**2.9 Why ‘Provisional’ Specification ?**

When the applicant finds that his invention has reached a presentable form, then

he may prepare a disclosure of the invention in the form of a written description

and  submit  it  to  the  patent  office.  This  disclosure  is  called  a  Provisional

Specification.  Application  for  P*rovisional  Specification  has  to  include  the  nature*

*of the invention. This gives a priority to the applicant over any other person who*

13

*is  likely  to  file  an  application  for  patent  in  respect  of  the  same  invention  being*

*developed concurrently in some other part of the world.*

Immediately on receiving the provisional specification the patent office accords a

filing date for the application and gives a period up to twelve months for filing the

Complete Specification during which the applicant can fully develop his invention.

**2.10 Complete Specification**

Complete  Specification  is  a  techno-legal  document  that  fully  and  particularly

describes the invention and the best method of performing it. It should start with

a  preamble  “The  following  specification  particularly  describes  the  nature  of  this

invention and the manner in which it is to perform.” It should contain the following

in not more than 30 pages beyond which each page is chargeable as given in the

first schedule.

•

**A Title**

The title should give a fair indication of the art or industry to which the invention

relates. It should be brief and as precise and definite as possible. The following

are  not  allowable  in  the  title:  —  a)  The  inventor’s  name  b)  The  word  ‘Patent’  c)

Words in other languages d) The abbreviation “etc.” e) Fancy words, e.g., “Wash

Well Soap”, “Universal Rest Easy Patent Chair”.

•

**Field of the invention**.

The  description  should  preferably  begin  with  a  short  general  statement  of  the

invention  so  as  to  show  its  *scope*,  and  to  indicate  briefly  the  subject  matter  to

which the invention relates, *e.g.*“This invention relates to . . . . . . . . . . . . . . . . ..”

14

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**State of the Art in the Field**

This part should indicate the status of the technology in the field of invention with

reference  to  experiments  going  on  in  the  field,  patents  and  pending  patent

applications  in  the  specific  art  with  emphasis  on  the  **‘prior  art’**relevant  to  the

invention.  When  the  invention  relates  to  an  improvement  on  an  existing

apparatus or process a short statement of ***closest prior art***may also be given.

•

**Object of the invention (Problem & Solution)**

The purpose is to clearly bring out the necessity of the invention. It shall clearly

specify  the  technical  problems  associated  with  the  existing  technology  and  the

proposed  solution,  highlighting  the  obvious  difference  between  the  claimed

invention and the prior art. The solution sought by the invention should be clearly

brought out with statements like “It has already been proposed . . . . . . . . . . . . . . .

. . . . . . . . . . ..” followed by the objects which the invention has in view e.g. “The

principal object of this invention is . . . . . . . . . . . . . . . . . . . . . . . . . .”, “Another

object of this invention is . . . . . . . . . . . . . . . . . . . . . . . .”, “A further object of this

invention is . . . . . . . . . . . . . . .. . . . . . . . . . . . . . .” etc.

•

**Statement of invention**

The description should include a statement of invention before giving the details

of the invention and the method of performing it. The statement should clearly set

forth  the  distinguishing  *novel  features*of  the  invention  for  which  protection  is

desired.  This  part  is  intended  to  declare  the  different  aspects  of  the  invention

*verbatim*with the claims and complements to the omnibus claim in situations of

infringement  proceedings.-  It  usually  starts  like  “Accordingly  the  invention

provides  an  apparatus  consisting  of  ---------------------------  which  is  characterized

in that ----------------------“. Other aspects and processes if any also can be stated

e.g. “There is also provided a method for performing ------------------“ etc.

15

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**Detailed description of the invention with reference to the drawings**.

The details of the invention described should be sufficient for an average person

skilled in the art to perform the invention by developing the necessary technical

**know  how**by  himself.  It  can  include  examples/drawings  or  both  for  clearly

describing  and  ascertaining  the  nature  of  the  invention.  Sufficient  number  of

examples can be appended to the description especially in the case of chemical

inventions.  The  following  terms  are  somewhat  vague,  and  their  use  should  be

avoided from the description as far as possible: — “Special”, “design”, “suitable”,

“etc”.  “Whereby”,  “if  desired”,  “and/or”,  “customary  methods”,  “known  methods”.

Terms in other languages, if any, used in the description should be accompanied

by their English equivalents. The use of vague slang words and colloquialisms is

Objectionable and should be avoided**.**

•

**Scope and/or Ambit of the Invention**

This  part  of  the  specification  should  bring  out  the  areas  of  application  of  the

invention and the preferable use of the invention. The applicant can substantiate

the  industrial  applicability  of  the  invention  in  this  part  and  call  for  the  protection

against  duplication  of  the  invention  in  the  related  fields  by  specifying  the  scope

and ambit. *The advantages of the invention also can be described in this part of*

*the specification.*

•

**Claims**

The description in the Complete Specification need to clearly and succinctly state

the  “Claims”  proceeded  by  the  prescribed  preamble,  “I  claim”  or  “We  claim”,  as

the  case  may  be.  It  shall  preferably  start  from  the  next  page  after  the  full

description of the invention with the claims serially numbered. The purpose of the

16

8 statement  of  Claims  is  to  highlight  with  conciseness,  precision  and  accuracy  as

to  how  much  of  what  is  described  in  the  specification  has  been  sought  to  be

protected,  implying  thereby  that  what  is  not  claimed  is  open  to  public  use.  *The*

*claim or claims of a complete specification shall relate to a single invention, or to*

*a group of inventions linked so as to form a single inventive concept.*

Statement of the form given immediately below is *not*to be regarded as claims,

in as much as they do not define the invention: —

a)

I claim to be the inventor of this appliance.

b)

I claim a patent and that no one else shall use my invention without leave.

c)

I claim that the machine described above is quite new and has never been

seen or used before.

**2.11 Hierarchy of Officers in Patents Office**

Controller General of Patents, Designs, Trademarks & GI

Assistant Controller of Patents & Designs

Deputy Controller of Patents & Designs

Examiners   
of Patents   
and   
Designs

Joint Controller of Patents & Designs

Senior Joint Controller of Patents & Designs

**2.12 Register of Patents**

Register of patents and particulars to be entered therein (S. 67)

17

a)

e)

Upon  the  grant  of  a  patent,  the  Controller  will  arrange  to  enter  in  the

Register  of  Patents,  the  name,  address  and  nationality  of  the  grantee  as

the  patentee  thereof,  the  title  of  the  invention  (including  the  categories

specified in section 5 to which the invention relates), the date of the patent

and  the  date  of  granting  thereof  together  with  address  of  service  of  the

Patent.

b)

Such other particulars as the Controller may think fit may be entered in the

register  in  respect  of  notification  of  assignment  and  of  transmission  of

patents,  licenses  under  patents  and  of  amendments,  extensions  and

revocation of patents, cessation of patents, restoration of lapsed patents,

payment   of   renewal   fees,   term   of   patents,   surrender   of   patents,

compulsory licenses etc.

c)

The  Controller  shall  also  enter  in  the  Register  of  Patents,  particulars

regarding  proceeding  under  the  Act  before  the Controller or the courts in

respect of every patent.

d)

Upon  the  issue  of  a  certificate  of  the  payment  of  the  prescribed  renewal

fee in respect of a patent, the Controller will arrange for the entry thereof

in  the  Register  of  Patents  that  the  fee  has  been  paid  and  the  date  of

payment of such fee as stated in the certificate.

      A  patentee  may  make  a  request  in  writing  to  the  Controller  for  the

alternation  of  his  name,  nationality,  address  or  address  for  service  as

entered in the Register of Patents in respect of any patent granted to him.

The Controller may require such proof of the alteration as he may think fit

before acting on a request to alter the name or nationality. If the Controller

allows  a  request  made  under  sub-rule  (1)  of  Rule  94,  he  shall  cause  the

entries in the register to be altered accordingly.

If  a  patentee  makes  a  request  in  writing  for  entering  an  additional  address  for

service in India and the Controller is satisfied that the request should be allowed,

18

subject  to  the  condition  that  no  more  than  two  addresses  for  service  shall  be

entered in the register at any one time.

Register of patent can be used as evidence in the court of law. There is no need

of  producing  the  original  register  in  the  court  .The  duly  certified  copies  of  the

entries in respect of patent in the register can serve the purpose.

Some examples of patents granted are given in Appendix -5.

**2.13 Working of Patents and compulsory Licensing**

  **Working of Invention**

Patents are granted for the purpose of exploitation, which will enhance industrial

development  and  therefore  should  be  worked  in  its  fullest  extent  within  the

territory  of  India.  S.83  of  Patents  Act  provides  that  *“Patents  are  granted  to*

*encourage inventions and to secure that the inventions are worked in India on a*

*commercial scale and to the fullest extent reasonably practicable without undue*

*delay and they are not granted merely to enable patentees to enjoy a monopoly*

*for the importation of the patented article.”*

The  patentee  and  every  licensee  should  furnish  the  details  of  working  of  the

invention at every six months and whenever required by the Controller (S. 146)

  **Revocation of patent for non-working (S. 85):**

An  application  to  the  Controller  for  an  order  revoking  the  patent  under  section

85(1) may be made after the expiry of 2 years from the date of order granting the

first compulsory license. The application shall be in Form 19 with the prescribed

fee.  Except  in  the  case  of  an  application  made  by  the  Central  Govt.,  the

application shall set out the nature of the applicant's interest and the terms and

conditions of the license the applicant is willing to accept.

19

  **Compulsory Licenses (S. 84):**

The provisions for compulsory licenses are made to prevent the abuse of patent

as a monopoly and to make way for commercial exploitation of the invention by

an interested person. Any interested person can make an application for grant of

compulsory  license  for  a  patent  after  three  years  from  the  date  of  grant  of  that

patent on any of the following grounds –

a)

The  reasonable  requirements  of  the  public  with  respect  to  the  patented

invention have not been satisfied.

b)

The  patented  invention  is  not  available  to  the  public  at  a  reasonably

affordable price.

c)

The patented invention is not worked in the territory of India. The request

for  grant  of  a  compulsory  license  can  also  be  made  by  a  licensee  of  the

patent. Application for compulsory license should be made in Form 17 with

the  prescribed  fee  of  Rs.1500  for  natural  person  and  Rs.6000/-  for  other

than  natural  person  with  a  statement  setting  out  the  nature  of  the

applicant’s interest and the facts upon which the application is based.

  **Government Use of the Inventions**

•

Anytime  after  filing  or  grant  of  a  patent,  Government  or  any  person

authorized  by  it  can  use  the  patented  invention  for  the  purpose  of

Government.

•

If  an  invention  is  used  before  the  priority  date  of  the  relevant  claim  of

complete specification by the Government or any person authorized by it

for the purpose of Government, then no royalty or remuneration need to

be paid to the patentee.

•

If  an  invention  is  to  be  used  at  any  time  after  the  grant  of  Complete

Specification  by  Government  or  any  person  authorized  by  it  for  the

purpose  of  Government,  then  that  use  should  be  made  only  on  terms

agreed  upon  between  the  Government  or  any  person  duly  authorized

20

and  the  patentee  or  in  default  of  agreement  be  decided  by  High  Court

under section 103.

•

Government  can  authorize  any  person  in  respect  of  an  invention  either

before  or  after  the  grant  whether  or  not  the  patentee  authorizes  that

person.

•

Where  Government  authorizes  any  person  for  using  an  invention  for

Govt.  purposes  then  unless  it  is  contrary  to  the  Public  interest  the

Central  Government  shall  inform  the  patentee,  from  time  to  time,  the

extent of use of the invention for the purpose of Government. In case of

use by the undertaking, Government may call for such information from

the undertaking.

•

The  right  to  use  the  invention  for  the  purpose  of  Government  includes

the right to sell the goods and the purchaser has the power to deal with

the  goods  as  if  the  Government  or  the  person  authorized  were  the

patentee of the invention.

•

In  case  of  an  exclusive  licensee  as  per  section  101  (3)  or  an  assignor,

Central  Government  should  also  inform  the  exclusive  licensee  or

assignor,  as  the  case  may  be,  regarding  the  extent  of  use  of  invention

for the purpose of Government.

•

In  respect  of  an  invention  used  by  the  Government  for  the  purpose  of

Government,  any  agreement,  license  of  assignment  etc.  between  the

patentee  or  applicant  and  any  person  other  than  the  Government  shall

have  no  effect  if  the  agreement  restricts  the  use  for  the  purpose  of

Government  or  instructs  any  payment  in  respect  of  any  use  for  the

purpose of Government.

•     In  relation  to  any  use  of  the  invention  made  for  the  purpose  of

Government  by  the  patentee  to  the  order  of  Central  Government  any

sum  payable  by  virtue  of  section  100  (3)  shall  be  divided  between  the

21

patentee and the assignor in such proportion as may be agreed upon or

in default be decided by high Court under section 103.

•

In case there is an exclusive licensee authorized under his license to use

the  Invention  for  the  purpose  of  Government  the  patentee  shall  share

any payment and such licensee in such proportion as agreed upon or, in

default, is decided by High Court under section 103.

•

If  necessary  Central  Government  can  acquire  an  invention  from  the

applicant or patentee for a public purpose, by publishing a notification to

that effect in the Official Gazette

•

Notice  of  acquisition  shall  be  given  to  the  applicant  or  patentee,  as  the

case  may  be,  and  other  persons  appearing  in  the  register  as  having

interest in that patent.

•      Compensation  should  be  given  by  the  Central  Government  to  the

concerned  person  as  agreed  upon  between  them  or  in  default  be

determined by High Court under Section 103. Any dispute arising out of

use  of  an  invention  by  the  Central  Government  for  the  purpose  of

Government  may  be  referred  to  the  High  Court  by  either  party  to  the

dispute  in  such  manner  as  may  be  prescribed  by  rules  of  High  Court

under  Section  103.  Government  may  ask  for  revocation  of  patent  or

raise   an   issue   regarding   the   validity   of   the   patent.   In   case   the

Government  thinks  disclosure  of  any  document  regarding  the  invention

will  be  prejudicial  to  the  public  interest,  then  the  Government  can

disclose  confidentially  to  the  advocate  of  other  party  in  any  proceeding

at any time at the High Court.

**2.14 Revocation of Patents**

**I.**A Patent may be revoked by High Court on any of the grounds stated hereafter,

at any time during the life of the patent.

22

i)

On the petition by any person interested or

ii)

On the petition by the Central Government by the Appellate Board

iii)

On a counter claim by the defendant in a suit of infringement.

In  a  suit  for  infringement  under  Sec.  104  the  defendant’s  counter-claim  for

revocation of a patent, the High Court may revoke a patent without any separate

petition for revocation.

**II.**Grounds for Revocation

The following are the grounds of opposition

a)

Invention claimed is the subject of prior grant

b)

Patentee not entitled to the patent

c)

Patent was wrongfully obtained by a person other than the person entitled:

d)

Subject of a claim is not an invention

e)

Invention is "lacking in novelty with regard to prior knowledge or prior use

(f)

Invention  is  obvious  or  does  not  involve  inventive  step  having  regard  to

prior knowledge or prior use

g)

Invention is not useful.

h)

Invention is not sufficiently described.

i)

Claim not clearly defined and not fairly based.

j)

Patent was obtained by false suggestion or representation.

k)

Subject of claims not a patentable invention.

l)

Claimed invention was secretly used before the priority date.

m)

Failure to disclose information regarding Foreign Application.

n)

Non-compliance of secrecy direction.

o)

Leave to Amendment of specification obtained by fraud.

p)

Specification Wrongly Mentioning or Not Disclosing Geographical Origin.

q)

Inventions is Anticipated by traditional knowledge

23

**2.15 Term of Patent**

The term of patent is 20 years from the date of the application in respect of all the

patents  including  those  which  have  not  expired  on  20/05/03,  when  Patents

(Amendment)  Act  2002  came  into  force  provided  that  the  renewal  fee  is  paid

every year on due date or extended period (maximum six months). To keep the

patent  in  force  renewal  fee  should  be  paid  at  the  expiration  of  the  second  year

from  the  date  of  patent  or  of  any  succeeding  year  before  the  expiration  of  the

second  or  succeeding  year  (Rule  80  (1)).  The  annual  fee  payable  in  respect  of

two  or  more  years  may  be  paid  in  advance.  The  fee  to  be  paid  is  listed  under

entry no. 18 of the First Schedule whereas renewal fee, which has become due

after  the  grant  of  patent,  shall  be  governed  by  the  provisions  of  Sec.  53.  The

renewal  fee,  which  has  become  due  at  the  time  of  grant  of  patent,  will  be

governed  by  Section  142(4).  It  says  that  when  the  patent  is  granted  later  than

two  years  from  the  date  of  filing  of  complete  specification,  the  fee  that  has

become due in the meantime might be paid within three months from the date of

recording of the patent in the Register or within the extended period not later than

nine  months  from  the  date  of  recording.  (S.  142(4)).  In  the  cases  where  the

renewal  fee,  which  have  became  due  at  the  time  of  grant  and  which  have

become due after the grant are very close, these may be paid together along with

required extension under Section 53. 

**2.16 Patent of Addition**

When an applicant feels that he has come across an invention which is a slight

modification on the invention for which he has already applied for / has patent the

applicant  can  go  for  Patent  of  Addition  since  the  invention  does  not  involve  a

substantial inventive step. It is also possible to convert an independent patent to

a patent of addition at a later date if the subject matter was an improvement in or

modification to the main invention for which he holds a patent.

24

However patent will not be granted as Patent of Addition unless the date of filing

complete  specification  was  the  same  or  later  than  the  date  of  filing  of  the

complete specification in respect of the main invention (S. 54(1), S. 54 (2) & S.

54(3)).

It should be noted that a Patent of Addition will not be granted before the granting

of the patent for the main invention. In an application for a Patent of Addition, the

determination as to whether the invention proposed is or is not an improvement

or modification of the applicant’s previous invention, has to be done by the proper

comparison between the novel contributions which each specification has made

to  the  art  and  not  between  the  sum  of  the  characteristics  claimed  in  the

respective main invention and proposed Patent of Addition. In other words mere

presence of a number of elements common to both inventions is not sufficient to

make one invention an improvement of or addition to the other.

Note:  Patenting  process  and  stages  of  prosecution  of  IPR  application  in  India  are  given  in

Appendix-1 & 2. Some examples of patent(case Studies) are given in Appendix-5.

**COPYRIGHT**

Copyright is one of the key branches of IP law which protects the expression of

ideas. For a work to gain copyright, it has to be original and should be expressed

in  a  material  form.  Copyright  is  thus  effective  upon  the  creation  of  the  work.  It

arises automatically and in the UK one does not have to register the copyright in

the work before it is protected.

**3.1 Entitlement to Copyright**

A work will qualify for copyright protection if:

•

It is of a type protected by copyright under the Act.

•    It  is  recorded  in  some  form  –  e.g.  in  writing,  by  a  sound  recording,  on  a

computer disk, or in a printed form.

25

•    The  work  meets  the  requisite  degree  of  originality.  A  work  is  original  if

adequate skill, labour and judgment are spent on creating it.

**3.2 Works Protected by Copyright**

The types of copyright works are broadly categorised into:

•

Original literary, dramatic, artistic or musical works,

•

Sound recordings, films or broadcasts and

•

The typographical arrangement of published editions.

Literary work also includes:

•

A table or compilation other than a database,

•

A computer program,

•

Preparatory design material for a computer program and

•

A database.

Dramatic work includes a work of dance or mime. Musical work means any work

consisting of music but excludes the words and music of songs.

**3.3 Rights granted by Copyright**

Copyright  grants  certain  rights  that  are  exclusive  to  its  owner.  Based  on  these

rights, the copyright owner

•

Can copy the work

•

Issue copies of the work to the public

•

Rent or lend the work to the public

•

Perform, show or play the work in public

•

Communicate the work to the public – this includes broadcasting of a work

and  also  electronic  transmission  and    make  an  adaptation  of  the  work  or

do any of the above in relation to an adaptation

26

Copyright  can  subsist  separately  and  collectively  in  the  building  blocks  of  any

particular work. For example, the elements that constitute a website may include

the  web  page,  title,  sound  effects,  images  or  pictures  on  the  page  and  the

address or domain name. Apart from a copyright on the web site, each of these

building blocks grants separate rights to their owners.

**3.4 Copyright Ownership - Who owns what in a Copyright Work?**

Copyright   ownership   can   arise   automatically   or   by   means   of   transfer   of

ownership through an assignment, assignation or license.

**3.5 Copyright Owner**

The first owner of copyright in a work is the person who created the work. Joint

ownership may arise where more than one author is involved in creating a work.

**3.6 Copyright Ownership in Computer Generated Works**

 In the case of computer generated works, the creator is the person by whom the

arrangement necessary for the creation of the work is undertaken.

**3.7 Copyright Ownership in an Employer-Employee Relationship**

Copyright  of  works  created  during  the  course  of  employment  will  be  owned  by

the  employer  unless  an  agreement  to  the  contrary  is  in  place.  Additionally,

copyright  ownership  is  also  dependent  on  the  question  of  whether  the  work  in

question was produced during the course of employment.

27

**\3.8 Ownership of Copyright by Staff**

Copyright  ownership  of  works  created  by  Further  Education  (FE)  and  Higher

Education  (HE)  staff  is  principally  dependent  on  the  question  whether  the

creation  of  the  work  was  within  the  scope  of  his/her  job  specification.  The  rule

applies  irrespective  of  the  question  whether  the  staff  had  used  the  employer’s

resources to produce the work and whether  the  work  in  question  was  produced

during  the  office  hours  of  the  staff.  This  issue  has  great  significance  within  FE

and HE. Many academics in the institutes produce content in the form of articles

and  other  publications  during  office  hours  whilst  using  the  equipment  of  the

institution. In some cases, their primary job specification may only relate to their

teaching or lecturing function. Here, the reality is that FE and HE institutes have

by  convention,  expressly  or  impliedly,  waived  their  copyright  in  materials

produced  out-with  the  remit  of  the  academics  job  specification.  The  rationale  of

this may be is that allowing the academic to retain copyright in the work he or she

is encouraged to produce more material thus raising the profile of the institution.

It can also be observed that one of the common deliverables currently included in

the job specification of most academic staff is to raise the research profile of FE

or HE institutes through publications in journals. It is also worth pointing out that

academics  often  give  their  copyright  to  academic  journals  and  their  institutions

pay for subscriptions to the journals that may contain articles, which in law is the

first owner.

**3.9 Copyright Ownership in Collaborative Research**

In  the  case  of  collaborative  research  partnership  between  FE  and  HE  institutes

and  an  outside  partner  copyright  ownership  can  be  held  jointly.  It  is  often  the

case  that  an  agreement  regulates  this  partnership  and  so  ownership  rights  are

distinguishable.

28

**3.10 Copyright Ownership by Students**

Relationship between students and FE and HE institutes are based on a special

type  of  contract.  These  agreements  are  the  various  terms  and  conditions  in  the

documentation  (e.g.  prospectus)  that  passes  between  them.  In  the  absence  of

special terms and conditions in  these  documentations,  copyright  ownership  in  a

work created by the student normally rests with the student. FE or HE institutes

would therefore be better protected if it were to state in the prospectus or student

handbooks  that  it  may  own  copyright  in  certain  works  created  (e.g.  databases,

software, and thesis publications) by the students. A feasible option so that both

FE or HE institutes and its students reap mutual benefits from this collaboration

would  be  to  allow  the  student  to  retain   ownership   in   his   work   and   be

compensated by means of a reward or income and the FE or HE institute to have

the  rights  to  use  the  work  (e.g.  to  publish  the  work  or  to  use  it  as  a  teaching

material).

**3.11 Duration of Copyright Protection**

The  duration  of  copyright  is  dependent  on  the  type  of  work  in  question.  Given

below are examples of some works.

           **Literary,  Dramatic,  Musical  and  Artistic  Works:**  The  life  time  of  the

author  plus  a  period  of  70  years  from  the  end  of  the  year  in  which  the

author dies.

           **Computer  generated  works:**  50  years  from  the  date  of  creation  of  the

work.  A  work  is  deemed  to  be  computer  generated  where  there  is  “no

human author”.

           **Sound recordings:** 50 years from the end of year in which it was made or

published.

           **Broadcasts**– 50 years from the end of the year of broadcast.

           **Typographical  arrangement  of  published  editions:**25  years  from  the

year of first publication.

29

**3.12 Infringement of Copyright**

Work

Ownership

Copyright is said to be infringed when one of the exclusive rights of an author is

performed  by  a  party  without  the  consent  or  authorisation  of  the  author.  This

infringement  is  called  primary  infringement.  Providing  accessories  for  infringing

the exclusive rights or assisting in the making or distribution of infringing copies is

also treated as an infringement and is referred to as secondary infringement.

**3.13 Library Uses**

The making of copies from books in libraries by its users (staff or students) is fair

dealing  only  if  it  is  made  for  research  or  private  study  for  non-commercial

purposes. This would require the user to sign a copyright declaration form.

**3.14 How to file a Copyright Application?**

•        Classify

•        Determine

•

Identify Appropriate Form

•

Complete Registration Form

•

Comply with Deposit Requirements

•

Payment of Fee

Note: List of forms for filling Industrial Designs are given in Annexure-2.

The details of Copy Right Office are:

B-2/W-3, Curzon Road Barracks

Kasturba Gandhi Marg

New Delhi-110001

Phone:91-113382549

           91 -11 338 4687

30

**TRADE MARKS**

Trade marks have been defined as any sign, or any combination of signs capable

of  distinguishing  the  goods  or  services  of  one  undertaking  from  those  of  other

undertakings.  Such  distinguishing  marks  constitute  protectable  subject  matter

under  the  provisions  of  the  TRIPS  Agreement.  The  Agreement  provides  that

initial registration and each renewal of registration shall be for a term of not less

than  7  years  and  the  registration  shall  be  renewable  indefinitely.  Compulsory

licensing of trademarks is not permitted.

Keeping in view the changes in trade and commercial practices, globalisation of

trade,  need  for  simplification  and  harmonisation  of  trade  marks  registration

systems etc., a comprehensive review of the Trade and Merchandise Marks Act,

1958 was made and a Bill to repeal and replace the 1958 Act has  been passed

by Parliament and notified in the Gazette on 30.12.1999. This Act not only makes

Trade Marks Law compatible with TRIPS Agreement but also harmonises it with

international systems and practices. Work is underway to bring the law into force.

**GEOGRAPHICAL INDICATIONS**

The TRIPS Agreement contains a general obligation that parties shall provide the

legal  means  for  interested  parties  to  prevent  the  use  of  any  means  in  the

designation or presentation of a good that indicates or suggests that the good in

question originates in a geographical area other than the true place of origin in a

manner  which  misleads  the  public  as  to  the  geographical  origin  of  the  good.

There  is  no  obligation  under  the  Agreement  to  protect  geographical  indications

which are not protected in their country of origin or which have fallen into disuse

in that country.

A  new  law  for  the  protection  of  geographical  indications,  viz.  the  Geographical

Indications  of  Goods  (Registration  and  the  Protection)  Act,  1999  has  also  been

31

passed by the Parliament and notified on 30.12.1999 and the rules made there-

•   Textual description

•   The

under notified on 8-3-2002.

**5.1 Documents required for filing Geographical Indications**

An application for registration of a geographical indication is to be made in writing

using  a  replica  of  the  official  application  Form  GI-1  for  the  registration  of  a

Geographical Indication in Part A of the Register by an Indian applicant; Form GI-

2 for a convention application; an application for goods falling in different classes

by an Indian applicant in Form GI-3 and an  application  for  registration  of  goods

falling  in  different  classes  from  a  convention  country  in  Form  GI-4  along  with

prescribed  fee,  and  should  be  addressed  to  the  "Registrar  of  Geographical

Indications”.

**5.2 Additional Requirements**

Application  in  prescribed  forms  (submitted  to  The  Registrar  of  Geographical

Indications)

•   How  the  indication  serves  to  designate  the  goods  as  a  Geographical

Indication?

•

The class of goods;

territory;

•

The particulars of appearance;

•

Particulars of producers;

•

An affidavit of how the applicant claims to represent the interest;

•   The  standard  bench  mark  or  other  characteristics  of  the  geographical

indication;

•

The particulars of special characteristics;

of the proposed boundary;

•

The growth attributes in relation to the G.I. pertinent to the application;

•

Certified copies of the map of the territory;

•

Special human skill involved, if any;

32

•

•     Preparing

a

Number of producers; and

•    Particulars   of   inspection   structures,   if   any,   to   regulate   the   use   of

geographical indication.

**INDUSTRIAL DESIGNS**

Obligations envisaged to patent industrial designs that are independently created

designs  and  are  new  or  original.  Individual  governments  have  been  given  the

option  to  exclude  from  protection,  designs  dictated  by  technical  or  functional

considerations,   as   against   aesthetic   consideration   which   constitutes   the

coverage of industrial designs. The right accruing to the right holder is the right to

prevent  third  parties  not  having  his  consent  from  making,  selling  or  importing

articles being or embodying a design, which is a copy or substantially a copy of

the  protected  design  when  such  acts  are  undertaken  for  commercial  purposes.

The duration of protection is to be not less than 10 years.

A  new  Designs  Law  repealing  and  replacing  the  Designs  Act,  1911  has  been

passed by Parliament in the Budget Session, 2000. This Act has been come into

force from 11.5.2001.

**6.1. Documents Required**

•

A signed Power of Attorney in front of 2 witnesses;

•

Sets of figures or photographs in color or black and white, preferably of

various views of the complete article;

•      A  certified  copy  of  the  priority  document  showing  the  filing  date,

number and country, if priority is to be claimed.

**6.2. Steps involved in Registration of Designs**

•

Finding out whether any registration already exists

representation of the design

•

Identifying the class of design

33

•

Providing a statement of novelty

•

Including a disclaimer

•

Claiming a priority date

•

Determining the fee to be paid

•

 Ensuring all enclosures are attaché

**LAYOUT DESIGN OF INTEGRATED CIRCUIT**

Three  dimensional  disposition  of  the  elements  –  at  least  one  of  which  is  active

and of some or all of the interconnections of an integrated circuit, or such a three

dimensional   disposition   prepared   for   an   integrated   circuit   intended   for

manufacture.

A product in its final or intermediate form in which the elements, at least one of

which is active, and some or all of the interconnections are integrally formed in or

on  a  piece  of  material,  and  the  purpose  of  this  is  to  perform  an  electronic

function.

**PLANT VARIETY**

A plant grouping within a single botanical tax on of the lowest known rank which,

irrespective of whether the conditions for the grant of a Breeders Right are fully

met,  can  be  defined  by  the  expression  of  the  characteristics  resulting  from  a

given genotype or a combination of genotypes distinguished from any other plant

grouping,  by  the  expression  of  at  least  one  of  the  said  characteristics,  and

considered  as  units  with  regard  to  its  suitability  for  being  propagated  without

change.

34

**8.1 Plant Breeder**

The person, who breeds, discovers or develops a new plant variety.

**8.2 New Plant Varieties and TRIPS Agreement**

Like  Patent,  Copyright,  Trademark  and  Industrial  Design  protection  a  special

protection for new Plant varieties is available. This provision is lesser known by

many  people.  The  International  Union  for  the  Protection  of  New  Plant  Varieties

(UPOV)  and  the  TRIPS  Agreement  provide  this  protection.  The  Act  of  UPOV

Convention  in  1991  gave  this  important  protection  to  the  plant  breeders.  The

UPOV office is situated in Geneva and it coordinates the Protection of New Plant

species.  There  is  a  debate  in  many  countries  that  the  plants  developed  do  not

satisfy  the  non-obvious  requirement  in  a  patent  application  system  as  existing

techniques  are  used  and  the  new  breed  is  obvious.  Therefore,  a  unique  “sui

generis” system is utilized for the Protection of New Plant Varieties. The TRIPS

provides a protection for 25 years in case of trees and vines while the protection

for other plants is 20 years. The main aim of this article is to create awareness in

the less known area of Protection of New Plant Varieties.

The  Indian  Parliament  has  finally  passed  the  Plant  Variety  Protection  and

Farmers  Rights  Act,  2001.  India  has  put  in  place  a  law  to  grant  Plant  Breeders

Rights  on  new  varieties  of  seeds,  for  the  very  first  time.  It  has  simultaneously

provided a Farmers Right. This legislation was necessitated by the commitments

that  India  made  in  the  agreement  on  Trade  Related  Intellectual  Property  Rights

(TRIPS)  when  it  ratified  the  Uruguay  GATT  Round  in  1994.  Article  27.  3(b)  of

TRIPS which deals with the protection of new plant varieties offers three options.

Protection will have to be granted by a patent, an effective sui generis system or

by a combination of the two. The sui generis system refers to the grant of Plant

Breeders  Rights,  of  what  kind  is  not  defined,  except  to  say  that  it  should  be

"effective".  India  ultimately  opted  for  the  sui  generis  option  but  not  without  a

determined struggle by civil society to stop seed patents.

**INTERNATIONAL PATENTING**

**9.1 Need for International Patenting**

An Indian patent provides the owners with exclusionary rights for the exploitation

and  for  taking  benefits  of  the  patent  for  its  term.  Thus,  an  India’s  patent  owner

can preclude others from making, using or selling the claimed invention in India

and  its  territories.  But  the  Indian  patent  does  not  grant  rights  outside  India,  nor

does  it  curtail  **“infringing”**  activities  abroad.  Protection  of  the  invention  outside

India requires the applicant to file a written description of the invention, relevant

drawings,  support  documents,  and  required  fees  with  the  patent  office  in  the

foreign jurisdiction where protection is sought. Filing can be done directly with a

national  patent  office  or  under  the  **Patent  Cooperation  Treaty**  (PCT).  If

protection  is  sought  only  in  Europe,  one  application  can  be  filed  before  the

European Patent Office (EPO).

**9.2 Patent Cooperation Treaty ("PCT") (1970)**

The Treaty makes it possible to seek patent protection for an invention related to

industrial property simultaneously in each of a large number of countries by filing

an  **"international"**  patent  application.  Such  an  application  may  be  filed  by

anyone who is a national or resident of a Contracting State. It may generally be

filed with the national patent office of the Contracting State of which the applicant

is a national or resident or, at the applicant's option, with the International Bureau

of  WIPO  in  Geneva.  If  the  applicant  is  a  national  or  resident  of  a  Contracting

State which is party to the European Patent Convention, the Harare Protocol on

Patents and Industrial Designs (Harare Protocol), the revised Bangui Agreement

Relating  to  the  Creation  of  an  African  Intellectual  Property  Organization  or  the

Eurasian  Patent  Convention,  the  international  application  may  also  be  filed  with

the  European  Patent  Office  (EPO),  the  African  Regional  Industrial  Property

36

Organization  (ARIPO),  the  African  Intellectual  Property  Organization  (OAPI)  or

the Eurasian Patent Office (EAPO), respectively.

The international application is then subjected to what is called an **"international**

**search."** That search is carried out by one of the major patent offices appointed

by  the  PCT  Assembly  as  an  International  Searching  Authority  (ISA).  The  said

search  results  in  an  **"international  search  report,"**  that  is,  a  listing  of  the

citations  of  such  published  documents  that  might  affect  the  patentability  of  the

invention  claimed  in  the  international  application.    At  the  same  time,  the  ISA

prepares  a  written  opinion  on  patentability.  The  international  search  report  and

the  written  opinion  are  communicated  by  the  ISA  to  the  applicant  who  may

decide to withdraw his application, in particular where the said report or opinion

makes  the  granting  of  patents  unlikely.  If  the  international  application  is  not

withdrawn,  it  is,  together  with  the  international  search  report,  published  bythe

International Bureau.

**9.3 General Information Concerning US Patents**

A  U.S.  patent  for  an  invention  is  the  grant  of  a  property  right  to  the  inventor(s),

issued  by  the  U.S.  Patent  and  Trademark  Office.  The  right  conferred  by  the

patent grant is, in the language of the statute and of the grant itself, **"the right to**

**exclude  others  from  making,  using,  offering  for  sale,  or  selling"**the

invention  in  the  United  States  or  **"importing"**  the  invention  into  the  United

States. To get a U.S. patent, an application must be filed in the U.S. Patent and

Trademark Office.

Generally,  the  term  of  a  new  patent  is  20  years  from  the  date  on  which  the

application for the patent was filed in the United States or, in special cases, from

the  date  an  earlier  related  application  was  filed,  subject  to  the  payment  of

maintenance fees. U.S. patent grants are effective only within the United States,

U.S. territories, and U.S. possessions. Under certain circumstances, patent term

extensions or adjustments may be available.

37

The  Constitution  of  the  United  States  gives  Congress  the  power  to  enact  laws

relating  to  patents,  in  Article  I,  section  8,  which  reads  “Congress  shall  have

power  .  .  .  to  promote  the  progress  of  science  and  useful  arts,  by  securing  for

limited  times  to  authors  and  inventors  the  exclusive  right  to  their  respective

writings  and  discoveries.”  Under  this  power  Congress  has  from  time  to  time

enacted  various  laws  relating  to  patents.  The  first  patent  law  was  enacted  in

1790. The patent laws underwent a general revision which was enacted July 19,

1952, and which came into effect January 1, 1953. It is codified in Title 35, United

States  Code.  Additionally,  on  November  29,  1999,  Congress  enacted  the

American  Inventors  Protection  Act  of  1999  (AIPA),  which  further  revised  the

patent laws. See Public Law 106-113, 113 Stat. 1501 (1999).

Most  inventors  employ  the  services  of  registered  **patent  attorneys  or  patent**

**agents**.  The  law  gives  the  USPTO  the  power  to  make  rules  and  regulations

governing conduct and the recognition of patent attorneys and agents to practice

before  the  USPTO.  Persons  who  are  not  recognized  by  the  USPTO  for  this

practice are not permitted by law to represent inventors before the USPTO.

**Utility Patent**

**Utility** patents may be granted to anyone who invents or discovers any new and

useful  process,  machine,  article  of  manufacture,  or  compositions  of  matters,  or

any new useful improvement thereof.

**Design Patent**

**Design**  patents  may  be  granted  to  anyone  who  invents  a  new,  original,  and

ornamental design for an article of manufacture.

**Plant Patent**

Plant patents may be granted to anyone who invents or discovers and asexually

reproduces any distinct.

Provisional Application for a Patent

38

Since  June  8,  1995,  the  USPTO  has  offered  inventors  the  option  of  filing  a

provisional application for patent which was designed to provide a lower cost first

patent  filing  in  the  United  States  and  to  give  U.S.  applicants  parity  with  foreign

applicants.  Claims  and  oath  or  declaration  are  NOT  required  for  a  provisional

application.  Provisional  application  provides  the  means  to  establish  an  early

effective filing date in a patent application and permits the term “Patent Pending”

to  be  applied  in  connection  with  the  invention.  Provisional  applications  may  not

be filed for design inventions.

The  filing  date  of  a  provisional  application  is  the  date  on  which  a  written

description  of  the  invention,  and  drawings  if  necessary,  are  received  in  the

USPTO.  To  be  complete,  a  provisional  application  must  also  include  the  filing

fee, and a cover sheet specifying that the application is a provisional application

for  patent.

 The  applicant  would  then  have  up  to  12  months  to  file  a  non-

provisional application for patent as described above. The claimed subject matter

in  the  later  filed  non-provisional  application  is  entitled  to  the  benefit  of  the  filing

date of the provisional application if it has support in the provisional application. If

a provisional application is not filed in English, and a non-provisional application

is  filed  claiming  benefit  to  the  provisional  application,  a  translation  of  the

provisional application will be required. See title 37, Code of Federal Regulations,

Section 1.78(a)(5).

Provisional  applications  are  NOT  examined  on  their  merits.  A  provisional

application  will  become  abandoned  by  the  operation  of  law  12  months  from  its

filing  date.  The  12-month  pendency  for  a  provisional  application  is  not  counted

toward  the  20-year  term  of  a  patent  granted  on  a  subsequently  filed  non-

provisional  application  which  claims  benefit  of  the  filing  date  of  the  provisional

application.

39

A surcharge is required for filing the basic filing fee or the cover sheet on a date

<http://www.uspto.gov>

later than the filing of the provisional application.

Filing, Search, and Examination Fees

Patent applications are subject to the payment of a basic fee and additional fees

that include search fees, examination fees, and issue fees. These fees are due at

the   time   of   filing   the   application.   Consult   the   USPTO   Web   site   at

 for the current fees. Additional filing fees are due if there are

more than 3 independent claims, more than 20 total claims, or if the total number

of  sheets  of  paper  in  the  specification  and  claims  is  over  100.  If  the  application

contains multiple dependent claims, additional fees are required.

If the owner of the invention is a small entity, (an independent inventor, a small

business  concern  or  a  non-profit  organization),  most  fees  are  reduced  by  half  if

small  entity  status  is  claimed.  If  small  entity  status  is  desired  and  appropriate,

applicants  should  file  a  written  assertion  of  small  entity  status  in  addition  to

paying the small entity filing fee. The written assertion may be a simple statement

on  a  transmittal  letter  such  as  “Applicant  claims  small  entity  status.”  Applicants

claiming  small  entity  status  should  make  an  investigation  as  to  whether  small

entity status is appropriate before claiming such status.

Specification (Description and Claims)

The   following   order   of   arrangement   should   be   observed   in   framing   the

application:

(a) Application transmittal form.

(b) Fee transmittal form.

(c) Application Data Sheet.

(d) Specification.

(e) Drawings.

(f) Executed Oath or declaration.

The specification should have the following sections, in order:

(1) Title of the Invention.

40

(2) Cross Reference to related applications (if any). (Related applications may be

listed on an application data sheet, either instead of or together with being listed

in the specification.)

(3) Statement of federally sponsored research/development (if any).

(4)  Reference  to  a  ”Sequence  Listing,”  a  table,  or  a  computer  program  listing

appendix submitted on a compact disc and an incorporation by reference of the

material  on  the  compact  disc.  The  total  number  of  compact  disc  including

duplicates and the files on each compact disc shall be specified.

(5) Background of the Invention.

(6) Brief Summary of the Invention.

(7) Brief description of the several views of the drawing (if any).

(8) Detailed Description of the Invention.

(9) A claim or claims.

(10) Abstract of the disclosure.

(11) Sequence listing (if any).

The  specification  must  include  a  written  description  of  the  invention  and  of  the

manner  and  process  of  making  and  using  it,  and  is  required  to  be  full,  clear,

concise,  and  exact  terms  as  to  enable  any  person  skilled  in  the  technological

area to which the invention pertains, or with which it is most nearly connected, to

make and use the same.

The  specification  must  set  forth  the  precise  invention  for  which  a  patent  is

solicited, in such manner as to distinguish it from other inventions and from what

is  old.  It  must  describe  completely  a  specific  embodiment  of  the  process,

machine,  manufacture,  composition  of  matter,  or  improvement  invented,  and

must  explain  the  mode  of  operation  or  principle  whenever  applicable.  The  best

mode  contemplated  by  the  inventor  for  carrying  out  the  invention  must  be  set

forth.

41

To sum up, this manual gives the need and importance of protecting intellectual

property  in  present  context  of  globalization.  It  attempts  to  create  a  greater

awareness  to  know  about  various  aspects  of  Intellectual  Property  Rights

pertaining to Patents, Design, Trade mark, copyright, layout design of integrated

circuits,  trade  secrets  and  geographical  indications.  The  purpose  is  to  direct

research  and  scientific  efforts  that  can  result  in    benefits  to  the  society  and  in

particular  to  the  innovator(s)  by  taking  required  steps  at  appropriate  time  to

protect  against  any  infringements.  It  also  gives  insight  into  procedures  for  filing

IPR’s  in  India.      It  provides  a  guideline  to  follow  the  steps  meticulously  to  avoid

any infringement.

To  protect  the  innovative  and  creative  work  of  an  individual,  it  is  mandatory  to

create  a  culture  of  IPR  regime  so  as  to  derive  full  benefit  from  the  investments

made in research and developments.

**Note:**

**1.   Details   of   Intellectual   Property   Rights:   Instruments,   Subject   Matter,   Fields   of**

**Application  and  Related  WIPO  and  Other  International  Agreements  are  given  in**

**Annexure-3.**

**2.**

**List of web sites for more details on IPR are given in Annexure-4.**

**3.**

**List of web sites to find out details of Patents are given in Annexure-5.**

**4.**

**Some important definitions related to IPR are given in Annexure-6.**

42

**Appendix-1**

**THE PATENTING PROCESS**

Identifying an Invention

Prior Art Searches

  Patents

  Periodicals   
  Books

  Products

•   
•

•   
•

Title   
Drawings

Invention   
Claims

Preparing Patent Specifications

Ascertaining Ownership

Who Owns   
 an

Invention?

Self or Through an   
 Advocate.

In case through   
 Advocate, Fee to

be Negotiated in   
 Advance.

Filing a Patent application   
 along with Fee

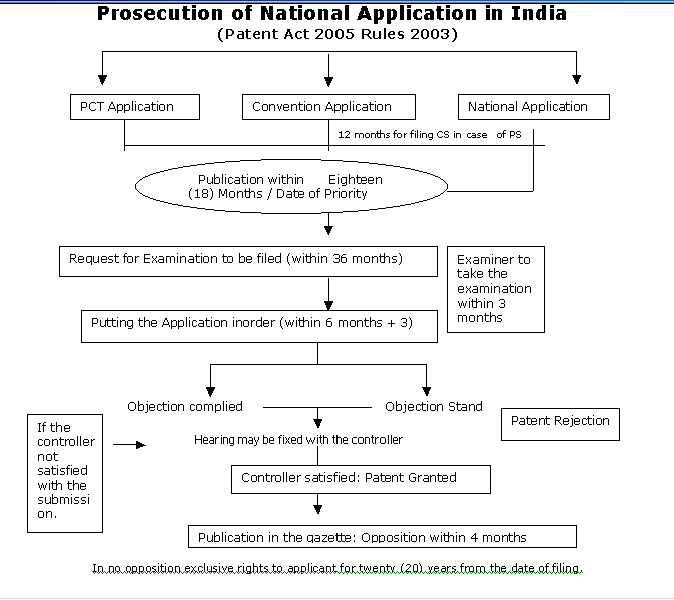
Prosecuting Through Patent   
 Office

Patent Registration and Issue   
 If Granted

Renewals

43

**Appendix -2**



**STAGES OF PROSECUTION OF IPR APPLICATION   IN INDIA**

44

**TRADEMARKS**

1. **Introduction**

In India, trademarks are protected both under statutory law and common law. The Trade and Merchandise Marks Act, 1940 (“TM Act, 1940”) was the first law in this regard in India, which was replaced later by the TM Act, 1958. The Trade Marks Act, 1999 (“TM Act”) - which has replaced the TM Act, 1958 - came into effect on September 15, 2003 and is in compliance with the TRIPS obligations. The TM Act allows for the registration of service marks and three-dimensional marks as well. India follows the NICE Classification of goods and services, which is incorporated in the Schedule to the Rules under the TM Act.1 A Trade Marks Registry had been established for the purposes of the TM Act, 1940, which has continued to function under the TM Act, 1958 and TM Act. The Trade Marks Registry is under the charge of the Registrar of Trademarks. The head office of the Trade Marks Registry is in Bombay (Mumbai) and its branches are at Calcutta (Kolkata), Delhi, Madras (Chennai), and Ahmedabad. The territorial jurisdiction of each office has also been allocated. In addition to trademarks, the following categories of marks can also be registered under the TM Act:

￭ Certification marks are given for compliance with defined standards, but are not confined to any membership. Such marks are granted to anyone who can certify that the products involved meet certain established standards. The internationally accepted “ISO 9000” quality standard is an example of a widely recognized certification mark.

￭ Collective marks can be owned by any association. The members of such associations will be allowed to use the collective mark to identify themselves with a level of quality and other requirements and standards set by the association. Examples of such associations would be those representing accountants, engineers or architects.

1. **Unconventional Marks**

India’s Trade Mark Registry has begun to recognize “unconventional trademarks” and has extended trademark protection to a sound mark. On August 18, 2008, India’s first “sound mark” was granted to Sunnyvale, California-based Internet firm Yahoo Inc.’s three-note Yahoo yodel by the Delhi branch of the Trademark Registry. It was registered in classes 35, 38 and 42 for a series of goods including email, advertising and business services and managing websites.

Under the TM Act, the term ‘mark’ is defined to include ‘a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or, combination of colors, or any combination thereof.’ Thus, the list of instances of marks is inclusive and not exhaustive. Any mark capable of being ‘graphically represented’ and indicative of a trade connection with the proprietor is entitled to get registered as a trademark under the TM Act. This interpretation opens the scope of trademark protection to unconventional trademarks like sound marks provided they satisfy the ‘graphical representation’ test and are not prohibited under Section 9 and 11 of the Act. The only way the mark may be described in the application for trademark is by way of “graphical representation”. However, the TM Act or the rules framed there under do not contemplate the form of submission of records of the unconventional trademarks

1. **Scope of ‘Graphical Representation’**

Trademark Rules define “graphical representation” as representation of a trademark for goods or services in paper form.2 Therefore, sound marks can be represented on paper either in descriptive form e.g. kukelekuuuuu (registered as Dutch sound mark - onomatopoeia which sounds like the call of a cock) or as traditional musical notations e.g. D#, E etc. Other alternative methods for their visual representation have also emerged like depictions by oscillogram; spectrum, spectrogram and sonogram are now being accepted in other jurisdictions. However, such representations must be handled carefully in order to meet the requirements of trademark offices in India. In the case of Yahoo’s Yodel mark, they represented the mark using musical notations.

1. **Syncing the Indian Law to Tide over the Hurdles of Registration**

Reducing a sensory mark to a written description on paper may not be always possible. A “graphical description” of a sound mark should clearly identify the exact sound, else the enforcement of the same, would lead to practical issues. E.g. the search result of the trademark at Trade Mark Registry would not be accurate if the mark is not appropriately described. Merely musical notes without a listing of the note pattern would not provide enough sensory information to contemplate the scope of protection on the mark. Musical notations alone are neither a clear nor precise description of the sound mark and gives no information about the pitch and duration of the sounds forming the melody. The graphical representations should be clear, precise, self contained, easily accessible, intelligible, durable and objective. A stave divided into bars and showing, in particular, a clef, musical notes and rests whose form indicates the relative value and, where appropriate, accidentals (sharp, flat, natural) - all of these determine the pitch and duration of the sounds. This may constitute a faithful representation of the sequence of sounds forming the melody in respect of which registration is sought.

With regard to onomatopoeias, there is lack of consistency between the onomatopoeia itself, as pronounced, and the actual sound or noise which it purports to imitate phonetically. Practical difficulties are bound to arise when trademark searches will be required. For e.g. if the sound mark is a crow’s call and is described as kukelekuuuuu, the same may be spelt differently or represented with musical notations. The procedure may be highly complicated as musical notations need to be matched against alphabets. To simplify matters, a sample of the sound may be submitted with the application. A separate database of these sound marks can be created and rules for determination of deceptive similarity between sound marks should be developed.

Indian Trade Mark Registry may have enhanced the scope of protection under the trademark umbrella, but there need to be clear guidelines for description, recording and protection that will help define the boundaries of protection of unconventional marks.

1. **Who can Apply?**

Any person claiming to be the proprietor of a trademark used or proposed to be used by that person can file an application for registration. The application may be made in the name of the individual, partner of a firm, a company, any government department, a trust, or even in name of joint applicants. Domestic and international applicants are treated at par. An application can also be filed on behalf of a company that is about to be incorporated or registered under the Companies Act, 1956.4

1. **Is Prior use Required?**

Prior use of the trademark is not a prerequisite for filing application or its registration and an application may be made for registration even if the intention of the applicants is bona fide use of the trademark in the future. In such a case, the application can be filed on a “proposed to be used basis”. However, in the case of descriptive marks, the Trade Marks Registry usually insists upon proof of use of the mark and the distinctiveness acquired through such use before granting a registration.

1. **Is a Prior Search Necessary?**

Though a prior search for a conflicting trademark is not a prerequisite for filing an application, it is advisable to carry out a search and maintain the search results. In opposition proceedings or in infringement / passing off actions, such search reports act as proof of honesty and good faith in the adoption of the marks. In a move to curb the spread and sale of counterfeit drugs, the Drugs Control Department of the National Territory of Delhi has made search reports from the Registrar of Trade Marks mandatory before approving any drug-manufacturing license under a particular brand name. This initiative by the Delhi Drugs Authority is in pursuance of the Indian Supreme Court’s (SC) observations in the case of Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd. (decided on March 26, 2001).5 If adopted in the other states in India, this provision will eliminate the chances of approval of a deceptively similar and look-alike brand of the existing products

1. **What is the Process of Registration?**

The application for trademark registration must contain a clear reproduction of the sign, including any colors, forms, or three-dimensional features. These forms need to be filed with the appropriate office of the Trade Marks Registry. The sign must fulfill certain conditions in order to be protected as a trademark – or as another type of mark – and must indicate the class of goods / services to which it would apply. The TM Act has laid down absolute6 and relative grounds of refusal7 of trademark registration. These grounds are akin to the provisions of the UK Trademark Act of 1994. The process of registration of trademarks under the TM Act can be explained utilizing the diagram on the following page:

|  |  |
| --- | --- |
| **SELECTION OF THE MARK** | Mark should be distinctive and should not be in the prohibited category |
| **SEARCH BEFORE APPLICATION** | Carry out a search at the Trade Marks Registry, to find out if same or similar marks are either registered or pending registration. This is advisable although not compulsory |
| **FILING OF THE APPLICATION** | Under the Trade Marks Act, a single application with respect to multiple classes can be filed. |
| **NUMBERING OF THE APPLICATION** | The application is dated and numbered, and a copy is returned to the applicant / attorney. Once the mark is registered, this number is deemed to be the Registration Number. |
| **MEETING THE OFFICIAL OBJECTIONS** | The Trade Marks Registry sends the “Official Examination Report” asking for clarifications, if any, and also cites identical or deceptively similar marks already registered or pending registration. The applicant has to overcome the objections. |
| **ADVERTISING OF THE APPLICATION** | The application is thereafter published in the “Trade Marks Journal,” which is a Government of India publication, published by the Trade Marks Registry. |
| **ACCEPTANCE OF THEAPPLICATION** | After publication, if the application is not opposed within the specified opposition period (four months), then the registration is granted. On the other hand, if it is opposed by a third party, the registration is granted only if the matter is decided in favor of the applicant. |
| **OPPOSITION PROCEEDINGS** | After the objections are successfully met and answers are provided to the queries, the Trade Marks Registry issues an official letter intimating their acceptance of the application. |
| **ISSUE OF CERTIFICATE OF REGISTRATION** | Registration of a trademark normally takes four to five years. However, when the registration certificate is issued, it is always effective from the date on which the application is filed. |

1. **Can the Registration Process be Expedited?**

After receipt of the official number of an application, the applicant may request an expedited examination of a registration application, together with a declaration stating the reason for the request and a payment of five times the application fee. If the Registrar of Trademarks is satisfied with the reason, the examination of the application is expedited and the examination report is issued within three months of the date of such request. If such a request is rejected after the hearing, the fee paid is refunded.

1. **What is the Term of Registration?**

The registration is valid for ten years and is renewable for a subsequent period of ten years. Nonrenewal leads to a lapse of registration. However, there is a procedure whereby a lapsed registration can be restored. X.How can the Registration of a Trademark be Cancelled? An application for cancellation or rectification of registration of a trademark can only be filed by the aggrieved person (e.g. prior users of the mark). Such an application must be filed with the Registrar of Trade Marks or the Appellate Board.

1. **Grounds for Cancellation / Revocation**

The following are some of the grounds on which the registration of a trademark can be removed or cancelled:

￭ The trademark was registered without any bona fide intention on the part of the applicant to use the trademark and there has been no bona fide use of the trademark for the time being up to a date three months before the date of the application for removal; or

￭ That up to a date three months before the date of application for removal, a continuous period of five years from the date on which the trademark is actually entered on the register or longer has elapsed during which the trademark was registered and during which there was no bona fide use thereof; or

￭ The trademark was registered without sufficient cause, or the trademark is wrongly remaining on the Register.

1. **Assignment of Trademarks**

A registered trademark can be assigned or transmitted with or without the goodwill of the business concerned, and in respect of either or all of the goods or services in respect of which the trademark is registered. An unregistered trademark can be assigned or transmitted with or without the goodwill of the business concerned. However, in respect of assignment of trademarks (registered or unregistered) without goodwill of the business concerned, the prescribed procedure has to be followed, which inter alia, includes advertisement of the proposed assignment to be published in the newspapers. The Registrar of Trade Marks could impose certain restrictions and conditions for the assignment or transmission of the trademark. To be effective, the assignment or transmission must be recorded with the Registrar of Trade Marks.

1. **License of Trademarks**

The TM Act provides for a registration procedure of registered / licensed users of the registered trademark. The benefit of use by the registered / license user accrues to the benefit of the mark’s proprietor. The TM Act recognizes non-registered licensed use if only such use is with the consent of the proprietor as embodied in a written agreement and if such user satisfies the prescribed conditions. Owners of Indian registered trademarks, who are located abroad, having no presence in India, can use their trademarks in India by granting licenses to the Indian parties

1. **Rights Conferred by Registration**

The registration of a trademark gives the registered proprietor the exclusive right to use the trademark in relation to the goods or services for which it is registered and to obtain relief with respect to infringement of the same. Registration acts as a public notice to others, informing them that they should not use the trademarks which are registered or pending for registration.

1. **Paris Convention**

Reciprocity for the purpose of claiming priority is allowed from the applications originating from the Paris Convention countries if filed within 6 months from the date of priority.

1. **Infringement of Trademark**

Registration of a trademark is a prerequisite for initiating an infringement action. The following essential conditions must exist for initiation of an infringement action:

￭ The allegedly infringing mark must be either identical or deceptively similar to the registered trademark;

￭ The goods / services in relation to which the allegedly infringing mark is used must be specifically covered by the registration of the registered trademark;

￭ The use of the allegedly infringing mark must be in the course of trade; and

￭ The use must be in such a manner as to render the use likely to be taken as being used as a trademark. A registered trademark is also infringed by use of a mark when because of:

￭ Its identity with registered trademark and similarity with goods / services covered by registration; or

￭ Its similarity with registered trademark and identity with goods / services covered by registration; or

￭ Its identity with registered trademark and identity with goods / services covered by registration Is likely to cause confusion on the part of the public (in case 3 above, confusion is presumed), or which is likely to have an association with the registered trademark.

If an identical or similar mark is used with respect to goods or services which are not similar to those for which a registered trademark is registered, such use amounts to infringement if a registered trademark has reputation in India and the use of the mark without due cause takes unfair advantage of or is detrimental to the distinctive character or repute of the registered trademark.

Under the TM Act, the following acts would also amount to an infringement of the RTM:

￭ Use of the registered trademark as a trade name or part of the trade name dealing in same goods or services for which the registered trademark is registered;19 or

￭ Use of the trademark in advertising if such advertising takes unfair advantage of and is contrary to the honest practice in industrial or commercial matters, or is detrimental to its distinctive character; or against the reputation of the trademark.

￭ Under the TM Act, even oral use of the mark can constitute infringement.

1. **Who can sue for Infringement?**

The registered proprietor, his heirs and the registered user(s) can sue for infringement. An assignee of a registered trademark can also sue for infringement. A passing off suit can be converted into a combined action of infringement and passing off, if the registration of the trademark is obtained before the final hearing of the passing off suit.

1. **Passing Off**

The user of an unregistered trademark is barred from instituting an infringement action. However, if the mark in question has become well known in India, the user of such a trademark is not without recourse and may seek a remedy by means of a passing off action. The purpose of this tort is to protect commercial goodwill and to ensure that one’s business reputation is not exploited. Since business goodwill is an asset and therefore a species of property, the law protects it against encroachment as such. In a passing off action, the plaintiff must establish that the mark, name or get-up - the use of which by the defendant is subject of the action - is distinctive of his goods in the eyes of the public or class of public and that his goods are identified in the market by a particular mark or symbol.

1. **Recognition of Foreign Well Known Marks & Trans-border Reputation**

The courts in India have recognized the trans-border reputation of foreign trademarks and trade names and the importance of their protection.

*The ruling of the Supreme Court of India in N. R. Dongre and Others v. Whirlpool Corporation and Another* was perhaps the first Indian case to recognize the concept of trans-border reputation of trademarks. The subject matter of this case was the manufacture, sale of washing machines by an Indian company using the trademark “Whirlpool” as part of the name by which it had recently commenced marketing its washing machines. The appellant had also advertised the washing machines as such. The claim of the respondent, the Whirlpool Corporation and its Indian joint venture TVS Whirlpool Limited was based on prior user of the mark “Whirlpool” and the fact that the trademark had a trans-border reputation. They contended that any goods marketed with the mark “Whirlpool” gave the impression of being goods manufactured by the respondents. The washing machines manufactured, sold, and advertised by the appellant gave that impression and this resulted in confusion arising in the market. The Whirlpool Corporation sought a temporary injunction against the appellant’s use of the mark, which was granted by the Delhi High Court and upheld by the Supreme Court of India. This judgment has been relied upon successfully in a number of decisions passed by Indian courts down the years. International trademarks, having no actual presence in India could, as a result, be enforced in India if a trans-border reputation with respect to such trademarks can be shown to exist. Subsequently, marks such as Volvo, Caterpillar, and Ocuflox, have received protection of their trademarks via judicial decisions.

1. **Orders in Infringement and Passing off Suits**

In an action for infringement of a registered trademark, or in an action for passing off for either a registered or unregistered mark, the court may order an injunction. The court may also award damages or an order for account of profits along with the delivery of the infringing marks, for destruction or erasure. In addition to the civil remedies, the TM Act contains stringent criminal provisions relating to offenses and penalties.