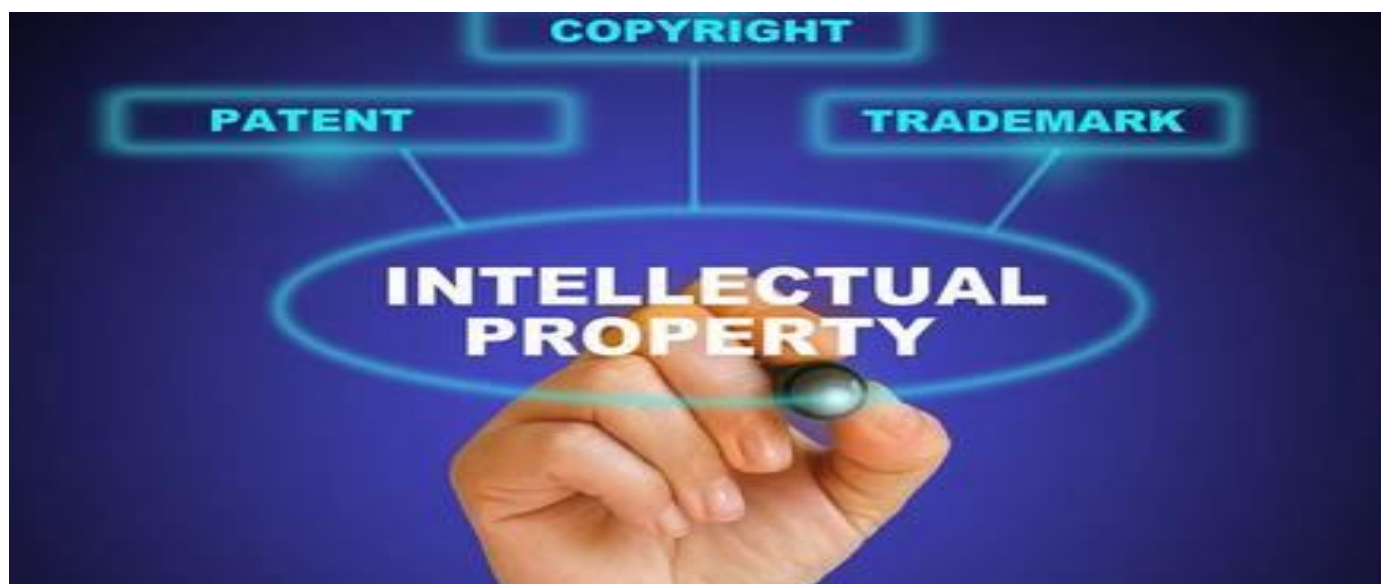


## MANAGEMENT SKILLS ORIENTATION PROGRAMME (e-MSOP)



### PROJECT TOPIC

**Procedural aspects and case studies related to Intellectual Property Rights i.e. Trademarks, Patents and Copyrights**



**THE INSTITUTE OF COMPANY SECRETARIES OF INDIA**

### PREPARED BY:

**Name:**

**Registration No:**

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## **PREFACE**

This project report has been prepared after a thorough study of various books, case studies, and data from web pages, for submission to the ***‘Institute of Company Secretary of India’*** as a part of the course curriculum e-Management Skills Orientation Programme( e-Msop).

During my tenure of working till date, I have observed that intellectual property rights is so much in use in common parlance but is highly misunderstood. Even among the professional managers the controversy and confusion persist. All over the world, R&D and business activities are becoming increasingly global and borderless, and the securing of worldwide Intellectual Property (IP) protection is becoming an extremely important issue. IP protection is a key factor for promoting foreign investment and technology transfer, as well as for boosting a nation’s industrial development

Through this project report, I have endeavoured to clarify the concept of IPR, including user friendly explanation of different types of IPRs, case studies on patents granted in India and other countries, special studies on technology evaluation, analyses of patent applications filed in India in various technology areas, international treaties and conventions and patent laws in other countries. Besides regular features like domestic and international news and information about patents for being opposed are included.

I take this opportunity to express our deep gratitude to the ***‘Institute of Company Secretary of India’*** for giving us this task.

*Disclaimer: Although it is our endeavor to provide accurate and timely information, there can be no guarantee that such information is accurate as of date it is received or that it is continued to be accurate in the future. No one should act upon such information without appropriate professional advice after a thorough examination of a particular situation.*

## ACKNOWLEDGEMENT

I acknowledge, with all our sincerity, **The Institute of Company Secretaries of India** for giving us an opportunity to participate in the e-MSOP.

I would like to extend our special thanks to team **The Institute of Company Secretaries of India** , for giving us an opportunity to prepare and present a project on such a fascinating topic, which would not have been successful without their constant guidance and assistance.

I would like to express my gratitude towards my parents & member of Institute of Company Secretaries of India (ICSI) for their kind co-operation and encouragement which help me in completion of this project.





## **INTRODUCTION**

Intellectual property (IP) refers to the creations of the human mind like inventions, literary and artistic works, and symbols, names, images and designs used in commerce. Intellectual property is divided into two categories: Industrial property, which includes inventions (patents), trademarks, industrial designs, and geographic indications of source; and Copyright, which includes literary and artistic works such as novels, poems and plays, films, musical works, artistic works such as drawings, paintings, photographs and sculptures, and architectural designs. Rights related to copyright include those of performing artists in their performances, producers of phonograms in their recordings, and those of broadcasters in their radio and television programs. Intellectual property rights protect the interests of creators by giving them property rights over their creations.

The most noticeable difference between intellectual property and other forms of property, however, is that intellectual property is intangible, that is, it cannot be defined or identified by its own physical parameters. It must be expressed in some discernible way to be protectable. Generally, it encompasses four separate and distinct types of intangible property namely — patents, trademarks, copyrights, and trade secrets, which collectively are referred to as “intellectual property.” However, the scope and definition of intellectual property is constantly evolving with the inclusion of newer forms under the gambit of intellectual property. In recent times, geographical indications, protection of plant varieties, protection for semi-conductors and integrated circuits, and undisclosed information have been brought under the umbrella of intellectual property.

## **THE CONCEPT OF INTELLECTUAL PROPERTY**

The concept of intellectual property is not new as Renaissance northern Italy is thought to be the cradle of the Intellectual Property system. A Venetian Law of 1474 made the first systematic attempt to protect inventions by a form of patent, which granted an exclusive right to an individual for the first time. In the same century, the invention of movable type and the printing press by Johannes Gutenberg around 1450, contributed to the origin of the first copyright system in the world.

Towards the end of 19th century, new inventive ways of manufacture helped trigger large-scale industrialization accompanied by rapid growth of cities, expansion of railway networks, the investment of capital and a growing transoceanic trade. New ideals of industrialism, the emergence of stronger

centralized governments, and nationalism led many countries to establish their modern Intellectual Property laws. At this point of time, the International Intellectual Property system also started to take shape with the setting up of the Paris Convention for the Protection of Industrial Property in 1883 and the Berne Convention for the Protection of Literary and Artistic Works in 1886. The premise underlying Intellectual Property throughout its history has been that the recognition and rewards associated with ownership of inventions and creative works stimulate further inventive and creative activity that, in turn, stimulates economic growth.

Over a period of time and particularly in contemporary corporate paradigm, ideas and knowledge have become increasingly important parts of trade. Most of the value of high technology products and new medicines lies in the amount of invention, innovation, research, design and testing involved. Films, music recordings, books, computer software and on-line services are bought and sold because of the information and creativity they contain, not usually because of the plastic, metal or paper used to make them. Many products that used to be traded as low-technology goods or commodities now contain a higher proportion of invention and design in their value, for example, brand-named clothing or new varieties of plants. Therefore, creators are given the right to prevent others from using their inventions, designs or other creations. These rights are known as intellectual property rights.

The Convention establishing the World Intellectual Property Organization (1967) gives the following list of the subject matter protected by intellectual property rights:

- literary, artistic and scientific works;
- performances of performing artists, phonograms, and broadcasts;
- inventions in all fields of human endeavor;
- scientific discoveries;
- industrial designs;
- trademarks, service marks, and commercial names and designations;
- protection against unfair competition; and
- “all other rights resulting from intellectual activity in the industrial, scientific, literary or artistic fields.”

With the establishment of the world trade Organization (WTO), the importance and role of the intellectual property protection has been crystallized in the Trade-Related Intellectual Property Systems (TRIPS) Agreement. It was negotiated at the end of the Uruguay Round of the General Agreement on Tariffs and Trade (GATT) treaty in 1994.

The TRIPS Agreement encompasses, in principle, all forms of intellectual property and aims at harmonizing and strengthening standards of protection and providing for effective enforcement at both national and international levels. It addresses applicability of general GATT principles as well as the provisions in international agreements on IP (Part I). It establishes standards for availability, scope, use (Part II), enforcement (Part III), acquisition and maintenance (Part IV) of Intellectual Property Rights. Furthermore, it addresses related dispute prevention and settlement mechanisms (Part V). Formal provisions are addressed in Part VI and VII of the Agreement, which cover transitional, and institutional arrangements, respectively.

The TRIPS Agreement, which came into effect on 1 January 1995, is to date the most comprehensive multilateral agreement on intellectual property. The areas of intellectual property that it covers are:

- (i) Copyright and related rights (i.e. the rights of performers, producers of sound recordings and broadcasting organisations);
- (ii) Trade marks including service marks;
- (iii) Geographical indications including appellations of origin;
- (iv) Industrial designs;
- (v) Patents including protection of new varieties of plants;
- (vi) The lay-out designs (topographies) of integrated circuits;
- (vii) The undisclosed information including trade secrets and test data.

### **OBJECTS OF INTELLECTUAL PROPERTY**

Intellectual Property comprises the following types of protection:

1. Industrial Property Rights (Patents, Trademarks, Industrial designs, Utility Models, Topography of integrated circuits and Geographical Indications)
2. Copyright (Literary and artistic works)

### **IMPORTANCE**

Intellectual property has long been recognized and used by industrialized countries, and some developing countries, as an important tool of technological and economic development. Many developing countries are becoming increasingly aware that it is in their best interests to establish national industrial property systems, where they do not exist, and to strengthen and upgrade existing systems which, inherited from their historical past, are no longer adequately responding to new needs and priorities.

Countries have laws to protect intellectual property for two main reasons. One is to give statutory expression to the moral and economic rights of creator for their creations and the other is to promote, as a deliberate act of government policy, creativity and to encourage fair-trading. This contributes to economic and social development.

### **TRADE MARK**





## **BACKGROUND**

The Indian law on trademarks is enshrined in The Trade Marks Act, 1999 which came into force with effect from September 15, 2003. The salient features of the amended Act are as follows:

- Registration of Service Marks
- A single application for registration of Trade Mark in multiple classes
- The validity of registered trademark extended to 10 years from 7 years
- Single register for the maintenance of records
- Protection to Well - Known Trade Marks
- Offences relating to Trademarks made cognizable.

## **WHAT IS A TRADEMARK?**

Trade Mark means a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include shape of goods, their packaging and combination of colours.

## **WHY TRADE MARK?**

Identifies the actual physical origin of goods and services  
 Guarantees the identity of the origin of goods and services.  
 Stimulates further purchase  
 Creates brand image for the product  
 Promotes life style and fashion

## **WHO CAN APPLY FOR REGISTRATION OF TRADE MARK?**





- A person claims to be proprietor of the trade mark
- Any other person with the authority of the owner of trade mark.
- In case of Company about to be framed, any anyone may apply in his name for subsequent assignment of the registration in the company's favour.

### **QUALIFICATION FOR REGISTRATION AS TRADEMARK AGENT**

Subject to the provisions of rule 151, of the Trade Mark Rules, 2002, a person shall be qualified to be registered as a trade marks agent if he-

- is a citizen of India;
- is not less than 21 years of age;
- has passed the examination prescribed in rule 154 or is an Advocate within the meaning of the Advocates Act, 1961 (25 of 1961), or **is a Member of the Institute of Company Secretaries of India;**
- is a graduate of any university in India or possess an equivalent qualification; and
- is considered by the Registrar as a fit and proper person to be registered as a trade mark agent.
- Being a India Trademark Attorney is both a demanding and rewarding profession.

**Note:** An application is to be made in Form TM -A

### **WHAT ARE THE TYPES OF TRADEMARKS THAT CAN BE REGISTERED?**

- **Product trademarks:** are those that are affixed to identify goods.
- **Service trademarks:** are used to identify the services of an entity, such as the trademark for a broadcasting service, retails outlet, etc. They are used in advertising for services.
- **Collective trademarks:** are registered in the name of groups, associations or other organizations for the use of members of the group in their commercial activities to indicate their membership of the group.
- **Certification trademarks:** are those that are capable of distinguishing the goods or services in connection with which it is used in the course of trade and which are certified by the proprietor with regard to their origin, material, the method of manufacture, the quality or other specific features

### **POINTS TO BE REMEMBER FOR SELECTING TRADE MARK**

- Inherently distinctive
- Coined or fanciful words: “Kodak”, Arbitrary marks: “apple” for computers, Suggestive marks: SWIFT for Cars.
- Easy to memorize and pronounce,
- Fits product or image of the business.,

- Has no legal restrictions,
- Has a positive connotation
- Suitable for export markets

### **MODE OF OBTAINING TRADE MARK RIGHTS**

A trade mark right can be obtained by a trader or manufacturer by any one of the following modes:

- Registration
- Assignment and Transmission
- Prolonged usage.
- License under Common Law

### **ASSIGNMENT AND TRANSMISSION**

A registered trade mark is assignable and transferable according to section 37 of the Trade Mark Act, 1999.

**However**, an unregistered trade mark can also be assigned and transmitted as per section 39 of the trade mark Act, 1999 an unregistered proprietor

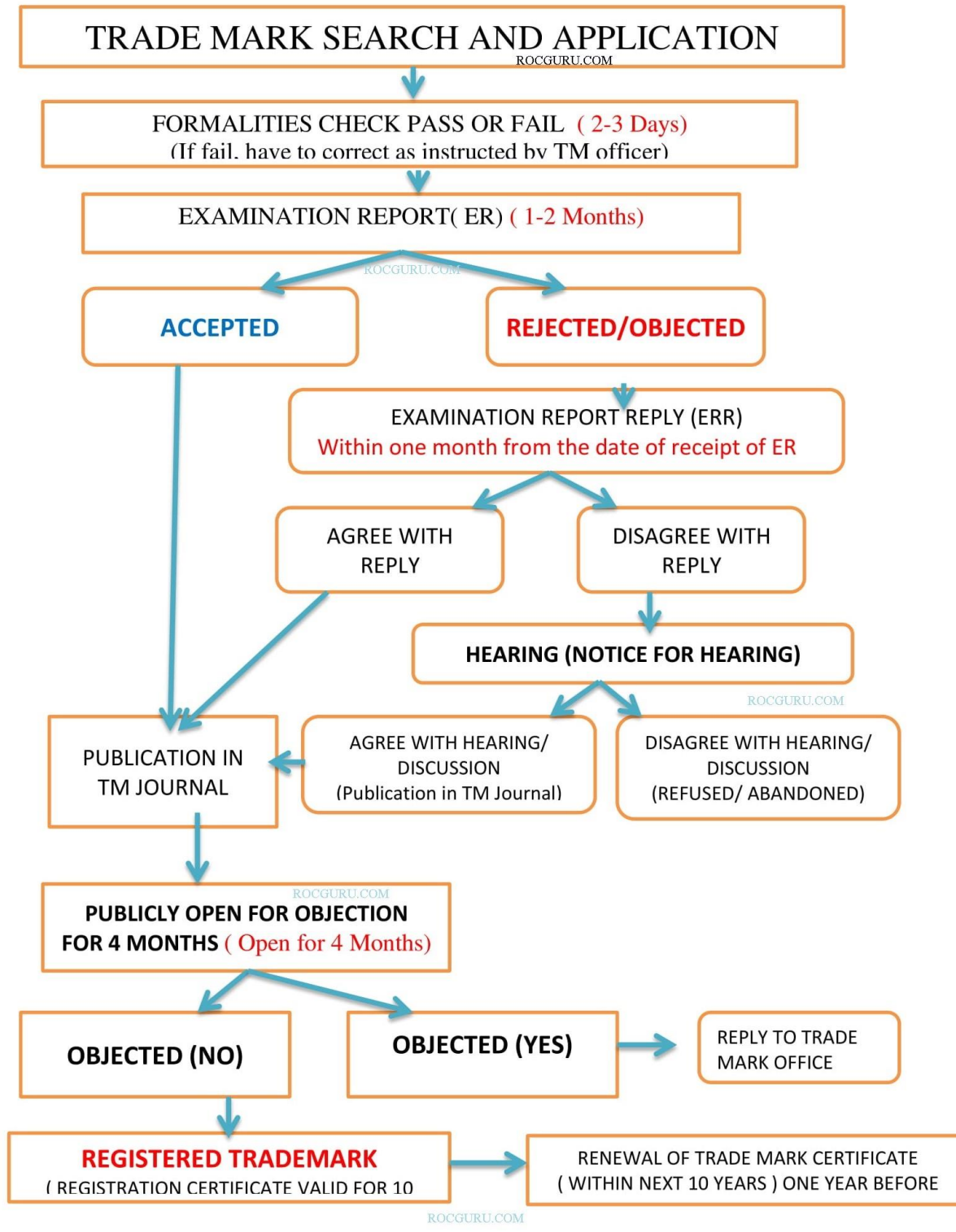
### **PROLONGED USAGE / WELL-KNOWN TRADEMARK**

- The duration, extent and geographical area of any use for that trademark.
- The duration, extent and geographical area for any promotion of the trademark including advertising or publicity and presentation at fairs or exhibition of the goods or services in which the trademark appears.
- Whereas a trademark has been determined to be well known in at least one relevant section of the public in India by any court or Registrar, the Registrar shall consider that trademark as a well known trademark for registration under this Act.

The Registrar is not required to consider the following facts while determining a well known trademark.

- The Trademark has been used in India
- The Trademark has been registered
- The application for registration of the Trademark has been filed in India.
- The trademark is well known in or has been registered in, or in respect of which an application for registration has been filed in any jurisdiction other than India or
- The trademark is well known to the public at large in India.

## TRADE MARK REGISTRATION PROCESS IN INDIA



## **LICENSING IN TRADE MARK**

A person other than the registered proprietor of a trade mark may be registered as a registered user thereof in any or all of the goods or services covered under the registered trade mark.

The use of the trade mark permitted as above shall be deemed to be used by the proprietor of the trade mark for the purposes of the Act or any other law.

The registered proprietor and the proposed registered user have to jointly apply in the prescribed manner to the registrar enclosing with the application the written agreement between them and an affidavit of the registered proprietor or a person authorized by him, giving particulars of the relationship between them including the degree of control by the proprietor and whether the proposed registered user would be the role registered user.

## **VALIDITY PERIOD FOR TRADE MARK**

- Term of registration of a trade mark is ten year, which may be renewed for a further period of ten year on the payment of prescribed renewal fees.
- Non-user of registered trade mark for the continuous period of five years is ground for cancellation of registered trade mark at the behest of the aggrieved party.

## **RIGHTS & REMEDIES OF A TRADE MARK OWNER**

The owner of a registered trademark may commence legal proceedings for trademark infringement to prevent unauthorized use of that trademark.

However, owner of an unregistered mark may be protected through the common law process for the passing off its Trade Marks by some other person.

Two types of remedies are available to the owner of a trademark for unauthorized use of his or her mark or its imitation by a third party. These remedies are:

- an action for infringement' in case of a registered trademark; and
- an action for passing off' in the case of an unregistered trademark

## **INFRINGEMENT**

Infringement of a trade mark occurs if a person other than the registered proprietor in the course of trade, in relation to same goods or services for which the mark is registered, uses the same mark or a deceptively similar mark

## **WHO CAN SUE FOR INFRINGEMENT?**

The plaintiff in an infringement suit may be either:

- a) The proprietor of the registered trade mark or his legal successor,
- b) The registered user of the trade mark subject to prior notice to the registered proprietor.
- c) An applicant for registration of a trade mark can file an infringement suit to protect his right to continue with the suit which will sustain only if his trade mark is registered before the hearing of the suit.
- d) Legal heirs of the deceased proprietor trade mark.
- e) Any one of the joint proprietor trade mark.
- f) A foreigner proprietor of a trade mark registered in India when infringement occurs in India.

In an action involving infringement or passing off, a court may grant relief of injunction and/or monetary compensation for damages for loss of business and/or confiscation/destruction of infringing labels and tags etc.

## **DIFFERENCES BETWEEN PASSING OFF AND INFRINGEMENT**

| S.No. | INFRINGEMENT                                                                                                                      | PASSING OFF                                                                                                |
|-------|-----------------------------------------------------------------------------------------------------------------------------------|------------------------------------------------------------------------------------------------------------|
| 1.    | Remedy in the form of action for Infringement is available in case of registered trade mark                                       | Remedy in the form of action for Passing Off is available in case of unregistered trade mark.              |
| 2.    | Statutory remedy is available for infringement                                                                                    | Common law remedy is available for passing off.                                                            |
| 3.    | In case infringement, Protection is available only with respect to a particular category of goods/ services which are registered. | In case of passing off, the defendant's goods need not be the same; they may be related or even different. |

## **WHAT ARE THE REGISTRABLE TRADE MARK?**

A trade mark must qualify the following tests for being eligible for registration:

- Mark should be capable of distinguishing goods or services of one person from those of another.
- Mark should not consist exclusively of marks used in general for referring to the characteristics of goods or services.

- Mark should not be of the nature so as to deceive the public or cause confusion.
- Mark should not contain any scandalous or obscene matter.
- Mark should not be prohibited under the Emblems and Names (Prohibition of Improper use) Act, 1950
- Mark should not consist exclusively of shape of the goods which is necessary to obtain technical results.<sup>4</sup>
- Mark should not consist exclusively of the goods resulting from the nature of the goods themselves.

### **INTELLECTUAL PROPERTY APPELLATE BOARD**

Central Government by notification in official gazette established an appellate board to be known as Intellectual Property Appellate Board.

Appellate Board Consist of

- A chairman
- A vice chairman
- Such number of other members as the Central Government may deem fit.

The jurisdiction power and authority of the Appellate Board may be exercised by Bench. A Bench shall consist of one judicial member and one technical member and shall sit at such place as the Central Government may by notification in the official Gazette specify.

A chairman, vice chairman and other member shall be appointed by president of India. However, appointment of chairman after consultation with the chief justice of India.

### **HOW A TRADE MARK CAN BE PROTECTED IN INDIA**

To protect the registered Trade Mark, the following remedies can be resorted to:-

1. Civil remedies,
2. Administrative remedies
3. Criminal proceedings

### **TYPES OF RELIEFS**

The plaintiff is entitled to the following reliefs both in an infringement and passing off action:

- An injunction restraining further use of the infringing mark.
- Damages or an account of profits.
- An order of search and seizure.

## **SOME IMPORTANT CASE LAWS**



### **CROCS INC USA V. BATA INDIA LTD AND ORS.**

Issue – Whether a Design can function as trademark?

Judgment – Crocs USA filed cases against shoe manufacturers alleging infringement of their design No. 197685 which is valid up to 28.05.2019. The plaintiff was unsuccessful in a suit filed for design infringement as the designs on which the suit was filed were found to be not new or original and therefore the Plaintiff pressed for the injunction on the ground of passing off which is an action in common law. It was settled by an earlier judgment of five judge bench that as long as the elements of design are not used as a trade mark, but a larger trade dress get up, presentation of the product through its packaging and so on, given that a passing off claim can sustain. A passing off action has been held to be maintainable with respect to elements of trade dress and overall get up, other than registered design and not with respect to registered design. It was argued by the Defendant that if the passing off is claimed of elements of the design as a trade mark, no passing off action lies. Since the plaintiff itself relied on use of its registered designs as a shape trade mark and no additional features qualifying as trade dress, which are not part of the registered design have been pleaded or pointed out, the passing off suit is not maintainable. The court agreed with the Defendant that the plaintiff has not been able to show any extra features, besides the design, which is used as a trade mark.

The Court interpreted the legislative intent of the Design Act which is to grant limited monopoly by design registration and after the term of registration, it should be open for anyone to use the said design. The legislative intent will be defeated if the design after its term was allowed to be used as trademark. The court used the analogy of patents rights which is granted for a limited period and observed that the intention to give design protection for a limited time cannot be extended to protection in perpetuity by claiming trademark rights. Therefore, the court gave an opinion that not only the registered design cannot be a trade mark during the period of design registration but even thereafter. Accordingly, the court held that a registered design cannot constitute a trade mark;



however if there are features other than those registered as a design and are shown to be used as a trade mark and with respect to which goodwill has been acquired, it is only those extra features which can be protected as a trade mark. If there has been a copy of registered design, only an action for infringement under the Designs Act would lie.

### **YAHOO!, INC. V. AKASH ARORA & ANR**

The first landmark judgment on cybersquatting. The Delhi High Court, for the first time ever in India, held that a domain name serves the same function as trademark and is entitled to equal protection. The defendant had a domain name ‘Yahoo India!’ which was identical and phonetically similar to the plaintiff’s trademark ‘Yahoo!’. The court held that internet users would be confused and deceived into believing that both the domain names have the same source. The defendant took a defence that it had put a disclaimer on its website. However, it was observed that a mere disclaimer was not sufficient because the nature of the internet is such that use of a similar domain name cannot be rectified by a disclaimer and it does not matter that ‘yahoo’ is a dictionary word. The name possesses acquired distinctiveness and uniqueness and was largely associated with the plaintiff.

### **DM ENTERTAINMENT V. BABY GIFT HOUSE AND ORS.**

Daler Mehendi, the famous pop star from Punjab has a large fan base and is extremely popular amongst Punjabi pop music lovers. DM Entertainment was incorporated in 1996 to manage the artist’s escalating career. The defendant company was making a large business by selling miniature dolls of the artist and cashing on his popularity. The plaintiff company was extremely aggrieved and filed for permanent injunction from infringing the artist’s right of publicity and false endorsement leading to passing off.

The plaintiff company was assigned all rights, titles and interests in the personality of the artist along with the trademark, Daler Mehendi. The plaintiff argued that the unauthorized or unlicensed use of the artist’s reputation with respect to goods or services will deceive the public into believing that the goods and services are associated with the singer and hence, would lead to passing off. The plaintiff further submitted that such use was done for commercial exploitation without adequate permission from the person or any other authorized by him and shall constitute infringement of the person’s right to publicity.

Character merchandising is an area of law that is still unexplored in India. This was the first case that dealt with the issue of celebrity merchandising where the publicity rights of the artist was given due recognition.

### **RANBAXY LABORATORIES LIMITED VS. ANAND PRASAD & 4 OTHERS 2004 (28) PTC 438 (IPAB)**

The appellant was the registered proprietor of the mark 'FORTWIN' and had been using the mark since 1975. The respondent applied for registration of the mark 'OSTWIN'. Both the marks related to pharmaceutical compositions in respect of treatment of bones.

The appellant brought an action against the respondent stating that the mark is deceptively similar. The IPAB held that the prefixes are 'FORT' and 'OST' while both the marks end with the suffix 'WIN'. It was further held that since the rival goods are also pharmaceutical goods it might lead to serious consequences due to deception or confusion in the minds of the public. Hence on the possibility of harm being caused to common person the appeal was allowed.

### **AMUL WINS TRADE MARK CASE IN GUJARAT HIGH COURT, (SEP 24, 2007)**

Amul has won the trade mark case in Gujarat High Court and no one else can use it.

The Registered owner of Amul had filed trade mark infringement cases, against two local shop owners? Amul Chasmaghar and its partners and Amul Cut Piece Stores in the District Court, Anand.

The District Court, Anand passed an order dated 25 April 2007, ruling that it was a clear case of infringement and restrained the two from using the Amul trademark.

Amul Chasmaghar had challenged this interim injunction in the Gujarat High Court. The Gujarat High Court ruled the decision in favour of Amul, terming the order passed by the trial court as true, correct, legal and in consonance with the facts of the case, as well as in accordance with the provisions of the Trade Marks Act 1999.

### **WARNER BROS. ENTERTAINMENT INC. & ANR V. HARINDER KOHLI & ORS.**

In this case plaintiff had filed an application for grant of injunction for restraining the defendants from releasing their film under trademark/title “**HARI PUTTER**” for infringing plaintiff trade mark “**HARRY POTTAR**”.

This application was dismissed on the following facts

1. The name of the main protagonist in the film is Hariprasad Dhoonda.
2. Hari is a derivation from the short form of the main character name.
3. Putter” in Punjabi means son and the focus in the film is on the son of the family, who is the real hero of the movie.
4. The language of movie is a mix of Hindi and Punjabi.
5. The title of the movie i.e. “Hari Puttar –A Comedy of Terror”, itself reveals the theme of the film whereas, the focus in “Harry Potter” relates to a school, where magic is taught.

## **THE COCA COLA COMPANY V. BISLERI INTERNATIONAL PVT. LTD.**

The defendant, Bisleri by a master agreement, had sold and assigned the trademark MAAZA including formulation rights, know-how, intellectual property rights and goodwill for India with respect to a mango fruit drink known as MAAZA to Coca Cola.

In 2008, the defendant company filed for registration of the mark MAAZA in Turkey and started exporting fruit drink under the name MAAZA. The plaintiff, Coca Cola claimed permanent injunction and damages for infringement of trademark and passing off.

The court granted an interim injunction against the defendant (Bisleri) from using the trademark MAAZA in India as well as for export, which was infringement of trademark.



## **WHAT IT IS PATENTS**

A Patent is an intellectual property right relating to inventions and is the grant of exclusive right for limited period, provided by the Government to the patentee, in exchange of full disclosure of his invention, for excluding others, from making, using, selling, importing the patented product or process producing that product for those purposes. The purpose of this system is to encourage inventions by promoting their protection and utilization so as to contribute to the development of industries, which in turn, contributes to the promotion of technological innovation and to the transfer and dissemination of technology. Under the system, Patents ensure property rights (legal title) for the invention for which patent has been granted, which may be extremely valuable to an individual or a Company. One should make the fullest possible use of the Patent System and the benefits it provides. Patent right is territorial in nature and a patent obtained in one country is not enforceable in other country. The inventors/their assignees are required to file separate patent applications in different countries for obtaining the patent in those countries.

## **LEGISLATION**

The Patent System in India is governed by the Patents Act, 1970 (No. 39 of 1970) as amended by the Patents (Amendment) Act, 2005 and the Patents Rules, 2003, as amended by the Patents (Amendment) Rules 2006 effective from 05-05-2006.

## **ADMINISTRATION**

The Patent Office, under the Department of Industrial Policy & Promotion, Ministry of Commerce & Industry, performs the statutory duties in connection with the grant of patents for new inventions and registration of industrial designs. Patent Offices are located at Kolkata, Mumbai, Chennai and Delhi

to deal with the applications for patents originating within their respective territorial jurisdictions. Patent Information System (PIS) located at Nagpur maintains a comprehensive collection of patent specifications and patent related literature, on a worldwide basis and provides technological information contained in patent or patent related literature through search services and patent document supply services.

## **INTERNATIONAL TREATIES**

India is a member-state of World Intellectual Property Organization (WIPO), an International Organization, responsible for the promotion of the protection of intellectual property throughout the world. India is a member of the following International Organizations and Treaties in respect of

Patents:

- a) World Trade Organization (WTO) with effect from 01-01 -1995.
- b) Convention establishing World Intellectual Property Organization, (WIPO).
- c) Paris Convention for the protection of Industrial Property with effect from Dec.7, 1998.
- d) Patent Co-operation Treaty (PCT) with effect from Dec.7, 1998.
- e) Budapest Treaty with effect from 17th December, 2001.

## **WHO MAY APPLY**

The inventor may make an application, either alone or jointly with another, or his/their assignee or legal representative of any deceased inventor or his assignee.

## **GENERAL PRECAUTIONS FOR APPLICANT**

The first to file system is employed, in which, among persons having filed the same invention, first one is granted a patent, therefore, a patent application should be filed promptly after conceiving the invention. It is common experience that through ignorance of patent law, inventors act unknowingly and jeopardize the chance of obtaining patents for their inventions. The most common of these indiscretions is to publish their inventions in newspapers or scientific and technical journals, before applying for patents. Publication of an invention, even by the inventor himself, would (except under certain rare circumstances) constitute a bar for the subsequent patenting of it. Similarly, the use of the invention in Public, or the commercial use of the invention, prior to the date of filing patent application would be a fatal objection to the grant of a patent for such invention, thereafter. There is, however, no objection to the secret working of the invention by way of reasonable trial or experiment, or to the disclosure of the invention to others, confidentially.

Another mistake, which is frequently made by the inventors, is to wait until their inventions are fully developed for commercial working, before applying for patents. It is, therefore, advisable to apply for a patent as soon as the inventor's idea of the nature of the invention has taken a definite shape.

It is permissible to file an application for a patent accompanied by a "Provisional Specification" describing the invention. The application may, therefore, be made even before the full details of working of the invention are developed. The filing of an application for a patent disclosing the

invention would secure priority date of the invention, and thereby, enable the inventor to work out the practical details of the invention and to file complete specification within 12 months from the date of filing of provisional specification.

## **WHAT IS PATENTABLE INVENTION**

A new product or process, involving an inventive step and capable of being made or used in an industry. It means the invention to be patentable should be technical in nature and should meet the following criteria - 3

**Novelty:** The matter disclosed in the specification is not published in India or elsewhere before the date of filing of the patent application in India.

**Inventive Step:** The invention is not obvious to a person skilled in the art in the light of the prior publication/knowledge/ document.

**Industrially applicable:** Invention should possess utility, so that it can be made or used in an industry.

## **WHAT IS NOT PATENTABLE**

The following are Non-Patentable inventions within the meaning of the Act: -

- (a) An invention which is frivolous or which claims anything obviously contrary to well established natural laws;
- (b) An invention the primary or intended use or commercial exploitation of which could be contrary to public order or morality or which causes serious prejudice to human, animal or plant life or health or to the environment;
- (c) The mere discovery of a scientific principle or the formulation of an abstract theory (or Discovery of any living thing or non-living substances occurring in nature);
- (d) The mere discovery of a new form of a known substance which does not result in the enhancement of the known efficacy of that substance or the mere discovery of any new property or mere new use for a known substance or of the mere use of a known process, machine or apparatus unless such known process results in a new product or employs at least one new reactant;

**Explanation-** For the purposes of this clause, salts, esters, ethers, polymorphs, metabolites, pure form, particle size, isomers, mixtures of isomers, complexes, the same substance, unless they differ significantly in properties with regard to efficacy.

- (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 re-arrangement or duplication of known devices each functioning independently of one another in a known way;
- (g) A method of agriculture or horticulture;

- (h) Any process for the medicinal, surgical, curative, prophylactic, diagnostic, therapeutic or other treatment of human beings or any process for a similar treatment of animals to render them free of disease or to increase their economic value or that of their products.
- (i) Plants and animals in whole or any part thereof other than micro-organisms but including seeds, varieties and species and essentially biological processes for production or propagation of plants and animals;
- (j) A mathematical or business method or a computer programme per se or algorithms;
- (k) A literary, dramatic, musical or artistic work or any other aesthetic creation what so ever including cinematographic works and television productions;
- (l) A mere scheme or rule or method of performing mental act or method of playing game.

### **APPROPRIATE OFFICE FOR FILING AN APPLICATION & FOR OTHER PROCEEDINGS**

Application is required to be filed according to the territorial limits where the applicant or the first mentioned applicant in case of joint applicants, for a patent normally resides or has domicile or has a place of business or the place from where the invention actually originated. If the applicant for the patent or party in a proceeding having no business place or domicile in India, the appropriate office will be according to the address for service in India given by the applicant or party in a proceeding . The appropriate office once decided in respect of any proceedings under the Act shall not ordinarily be changed. The four patent offices are located at Kolkata, Mumbai, Delhi & Chennai.

### **PUBLICATION & EXAMINATION OF PATENT APPLICATIONS**

#### **i) Publication:**

All the applications for patent, except the applications prejudicial to the defence of India or abandoned due to non-filing of complete specification within 12 months after filing the provisional or withdrawn within 15 months of filing the application, are published in the Patent Office Journal just after 18 months from the date of filing of the application or the date of priority whichever is earlier. The publication includes the particulars of the date of the application, application number, name and address of the applicant along with the abstract. The applications for patent are not open for public inspection before publication. After the date of publication of the application, as stated above, the complete specification along with provisional and drawing, if any, abstract, application on any form or on plain paper and any correspondence between the office and applicant may be inspected at the appropriate office by making a written request to the Controller in the prescribed manner and on the payment of prescribed fee..

Early Request for Publication:



The applicant may also file a request for early publication in Form-9 with a prescribed fee of Rs 2500/- or Rs 10,000/- for natural person and other than natural person respectively. The above application is published ordinarily within one month from the date of the request on Form-9. The applicant shall have provisional Rights from the date of publication.

## ii) Request for examination

No application for patent will be examined if no request is made by the applicant or by any other interested person in Form-18 with prescribed fee of Rs.2,500/- or Rs.10,000/- for natural person and other than natural person respectively, within a period of 48 months from the date of priority of the application or from the date of filing of the application ,whichever is earlier. Where no request for examination of the application for patent has been filed within the prescribed period, the aforesaid application will be treated as withdrawn and, thereafter, application cannot be revived.

## iii) Examination

Application for patent, where request has been made by the applicant or by any other interested person, will be taken up for examination, according to the serial number of the requests received on Form 18. A First Examination Report (FER) stating the objections/requirements is communicated to the applicant or his agent according to the address for service ordinarily within six (06) months from the date of request for examination or date of publication whichever is later. Application or complete specification should be amended in order to meet the objections/requirements within a period of 12 months from the date of First Examination Report (FER). No further extension of time is available in this regard. If all the objections are not complied with within the period of 12 months, the application shall be deemed to have been abandoned. When all the requirements are met the patent is granted, after 6 months from the date of publication, the letter patent is issued, entry is made in the register of patents and it is notified in the Patent Office, Journal.

## **WITHDRAWAL OF PATENT APPLICATION**

The application for patent can be withdrawn at least 3(Three) months before the first publication which will be 18(Eighteen) months from the date of filing or date of priority whichever is earlier.

The application can also be withdrawn at any time before the grant of the patent.

The application withdrawn after the date of publication cannot be refilled as it is already laid open for public inspection. However, application withdrawn before the publication can be refilled provided it is not opened to public otherwise.

## **GRANT OF PATENT**

When all the requirements of the FER are met or in case of opposition under section 25(1), if the opposition is decided in favour of the applicant, the patent is granted, after 6 months from the date

of publication under section 11 A, the letter patent is issued, entry is made in the register of patents and it is notified in the Patent Office, Journal, thereafter opening the application, specification and other related documents for public inspection on payment of prescribed fee.

### **TERM AND DATE OF PATENT**

Term of every patent will be 20 years from the date of filing of patent application, irrespective of whether it is filed with provisional or complete specification. Date of patent is the date on which the application for patent is filed.

### **RIGHTS OF THE PATENTEE**

Where a patent covers a product, the grant of patent gives the patentee the exclusive right to prevent others from performing, without authorization, the act of making, using, offering for sale, selling or importing that product for the above purpose.

Where a patent covers a process, the patentee has the exclusive right to exclude others from performing, without his authorization, the act of using that process, using and offering for sale, selling or importing for those purposes, the product obtained directly by that process in India. These rights created by statute are circumscribed by various conditions and limitations as provided in the

Patents Act, 1970 as amended by The Patents (amendment) Act, 2002.

### **REGISTER OF PATENT**

The Register of Patents are kept in the Patent offices and can be inspected or extract from it can be obtained on payment of prescribed fee. Register of Patent contains the name and address of the patentee, notification of assignment etc., particulars in respect of validity or proprietorship of patent and payment of renewal fee.

### **RENEWAL FEE**

To keep the patent in force, Renewal fee is to be paid every year. The first renewal fee is payable for the third year and must be paid before the expiration of the second year from the date of patent. If the patent has not been granted within two years the renewal fees may be accumulated and paid immediately after the patent is granted, or within three months of its recordable in Register of Patents or within extended period of 9 months, by paying extension fees of six month on Form 4, from the date of recordable. If the renewal fee is not paid within the prescribed time, the patent will cease to have effect. However, provision to restore the patent is possible provided application is made within eighteen months from the date of cessation.

Renewal fee is counted from the date of filing of the Patent application. Six month's grace time is available with extension fee for payment of renewal fee. No renewal fees is payable on Patents of Addition, unless the original patent is revoked and if the Patent of Addition is converted into an independent patent; renewal fee, then, becomes payable for the remainder of the term of the main patent.

## **RESTORATION**

Application for restoration of a patent that lapses due to non-payment of renewal fees must be made within 18 months of lapse. The application is to be filed in the appropriate office according to the jurisdiction.

## **DOCUMENTS REQUIRED FOR FILING AN APPLICATION**

- 1) Application form in duplicate (Form 1).
  - 2) Provisional or complete specification in duplicate. If the provisional specification is filed, it must be followed by the complete specification within 12 months.(Form 2).
  - 3) Drawing in duplicate (if necessary).
  - 4) Abstract of the invention in duplicate.
  - 5) Information & undertaking listing the number, filing date & current status of each foreign patent application in duplicate (Form 3).
  - 6) Priority document (if priority date is claimed) in convention application, when directed by the Controller.
  - 7) Declaration of inventor-ship where provisional specification is followed by complete specification or in case of convention/PCT national phase application (Form 5).
  - 8) Power of attorney (if filed through Patent Agent).
  - 9) Fee (to be paid in cash/by cheque/by demand draft) (See Schedule I).
- (Note: The cheque or demand draft should be payable to the "Controller of Patents" drawn on any schedule bank at a place where the appropriate office is situated)

## **SOME IMPORTANT CASE LAWS**



## **MONSANTO TECHNOLOGY LLC AND ORS. VS. NUZIVEEDU SEEDS LTD. AND ORS., MANU/SC/0027/2019.**

Court: Supreme Court of India

The patented invention in the case related to a DNA sequence called NAS, which when inserted into a plant cell provides insect tolerance to the plant. On appeal from the interim injunction of the Single Judge in an infringement suit, the Division Bench of the Delhi High Court decided the counterclaim of the defendant for revocation summarily. Taking up the case on special leave, the Supreme Court held that a decision on revocation of a patent requires a trial, and cannot be decided in a summary manner. It stated that the Division Bench should have confined its decision to the injunctive relief in question, and remanded the case back to the Single Judge for a full trial in accordance with the law.

## **FERID ALLANI VS. UNION OF INDIA AND ORS., MANU/DE/4323/2019.**

Court: Delhi High Court

This case involves a patent application relating to a method and device for accessing information sources and services on the web. The patent application was rejected based on Section 3(k) of the Patents Act by the Controller. The Court directed the Controller to re-examine the patent application based on the fact that only computer programs per se are not patentable in India, and that a computer program that has technical effect or technical contribution is not a computer program per se. The Court stated in the case that computer programs embedded in digital or electronic devices must be tested for technical effect, and that inventions relating to computer programs must be examined in the

context of modern technology. It stated that computer programs cannot be denied patent protection if they satisfy the requisite standards under the law.

### **NOVARTIS AG & ANR. VS NATCO PHARMA LIMITED**

Court: Delhi High Court

In this case, the Delhi High Court vacated the interim order against NATCO following the revocation of the suit patent granted to Novartis with respect to Ceritinib used in treatment of lung cancer. Though Novartis filed an appeal before the IPAB, the Court held that the patent is considered to be invalid unless the decision is reversed by the IPAB.

### **COMMUNICATION COMPONENTS ... VS ACE TECHNOLOGIES CORP. AND ORS.**

Court: Delhi High Court

The Court in this case granted an interim injunction in favour of the plaintiff, which holds a patent entitled, Asymmetrical Beams for Spectrum Efficiency. The Court decided to grant an interim injunction based on the following conclusions:

- (a) Substantial change in circumstances had taken place since the first judgment of the Ld. Single Judge dated 4th November, 2011, in Ten XC v. Mobi Antenna, where an interim injunction was refused as a credible question of patent validity was raised;
- (b) The Defendants withheld vital information, by not disclosing the beam patterns of their antennae;
- (c) The Plaintiff corresponded with the Defendants since 2017, and notified the Defendants of their patent rights. The Defendants' email in response thereto was merely acknowledging receipt of the Plaintiff's notice. There has been no other response by the Defendants;
- (d) When any party is notified of patent rights, there exists an obligation on the said party to either challenge the patent or rebut the allegations made in the notice. It cannot simply choose to wait for the Plaintiff to file a suit for infringement, and in the said suit, withhold crucial and relevant information and vital data;
- (e) Patent rights are limited in nature – especially in the telecommunication industry, technologies are changing rapidly. The Defendants having not responded and having not disclosed crucial information to the Court, are liable to be put to terms; and
- (f) The fact that the Plaintiff had already licensed its patents, and the present patent not being a standard essential patent, the Plaintiff has a right to insist for an injunction once infringement is established. However, in a case where the Plaintiff was willing to license the patent and the Defendants have merely procrastinated, the Defendants can be put to terms.

The Court in the case asked the defendants to deposit 54.5 crores to continue its activities with respect to antennas. If they do not deposit the amount, the Court stated that they would be restrained from dealing with the antennas covered under the plaintiff's patent. The Court stated in the case that prosecution in foreign jurisdictions has only limited significance at a general level to understand the invention. The prosecution history in other countries cannot be used to define scope of claims in India. The Court gave a good understanding of the objective of patent law, and principles for constructing patent claims. It stated that scope of patent claims must be based on purposive interpretation.

## **NATCO PHARMA LIMITED VS BAYER HEALTHCARE LLC**

Court: Delhi High Court

In this case, Bayer sued NATCO for patent infringement of its patented drug, Regorafenib, and prayed for a permanent injunction. Bayer asked for an interim injunction during the pendency of the suit, which was granted by the single judge based on its *ex parte* order in the Sterlite Technologies case. On appeal, the Division Bench of the Delhi High Court held that a decision on interim injunction cannot be made without assessing the factors laid down by the Supreme Court: *Prima facie* case; Balance of convenience and Irreparable loss/harm. It stated that the decision on interim injunction must reflect the consideration and analysis of the said factors, and that the order cannot be vague (Paras 25 to 27). The Court also pointed out that patent cases form a genus under which pharma patent cases form a species, which require certain additional considerations such as public interest, public health, and so on, based on cases decided earlier (Para 21). The Court remanded the case to the single judge for a decision in line with the principles laid down in its judgment.



## **INDUSTRIAL DESIGN**

Industrial Design (ID) is the professional practice of designing products, devices, objects, and services used by millions of people around the world every day.

Industrial designers typically focus on the physical appearance, functionality and manufacturability of a product, though they are often involved in far more during a development cycle. All of this ultimately extends to the overall lasting value and experience a product or service provides for end-users.

Every object that you interact with on a daily basis in your home, office, school, or public setting is the result of a design process. During this process, myriad decisions are made by an industrial designer (and their team) that are aimed at improving your life through well-executed design.

## **APPLICATION PROCEDURE FOR AN INDUSTRIAL DESIGN**

- Application form
- Application fees
- Representation of the design (photo, drawing etc)
- Comparison with existing designs
- Publication (opposition period 60 days)
- Registration
- Priority 6 months

## **GEOGRAPHICAL INDICATIONS**

The Geographical Indications of Goods (Registration and Protection) Act, 1999 The Geographical Indications of Goods (Registration and Protection) Rules, 2002. International Treaties to which India is a signatory

Paris Convention for the Protection of Industrial Property Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS)

## **MEANING**

"Geographical indications are indication or signs used on goods that have a specific geographical origin and possess qualities or a reputation that is due to that place of origin. Most commonly, a geographical indication consists of the name of the place of origin of the goods. For example: "Champagne".



## **WHO CAN APPLY?**

Any association of persons or producers or any organization or authority established by or under any law for the time being in force representing the interest of the producers of the concerned goods can apply for the registration of the geographical indication in the prescribed format.

## **WHAT CANNOT BE REGISTERED AS A GEOGRAPHICAL INDICATION?**

The following are the geographical indications that cannot be registered in India:

- The use of which would be likely to deceive or cause confusion;
- The use of which would be contrary to any law for the time being in force;
- Which comprise or contain scandalous or obscene matter;\
- Which comprise or contain any matter likely to hurt the religious susceptibilities of any class or section of the citizens of India;
- Which would otherwise be disentitled to protection in a court;

## **REGISTRATION PROCEDURE**

The Register of Geographical Indications is divided into two parts, part A and Part B. Part 'A' consists of particulars relating to registered geographical indications and Part 'B' consists of particulars of the registered authorized users. The various steps that the rights holder should follow for the registration of their geographical indications in India are as follows:

- **Preparing of documents and filing of application**

The rights holder can file a single application for registration of a geographical indication in different classes of goods as per the prescribed format. The application can be filed in the Office of Geographical Indications, Chennai. The application to be filed should contain a statement as to how the geographical indication serves to designate the goods as originating from the concerned territory of the country or region or locality in the country, in respect of specific quality, reputation or other characteristics that is due to the place of origin exclusively. It should also include the class of goods to which the geographical indication shall apply, the geographical map of the territory of the country or region or locality in the country in which the goods originate or are being manufactured, the particulars regarding the appearance of the geographical indication (as to whether it is comprised of words or figurative elements or both) and any statement containing particulars of the producers of the concerned goods.

- **Examination and Publication of the Application**

After the application has been filed, the examiner reviews the application and the accompanying statement of case. For purposes of examination, the Registrar of Geographical Indications ordinarily constitutes a Consultative Group of not more than seven representatives to ascertain the correction of the particulars as mentioned in the Statement of Case. Thereafter, the Registrar issues an examination report. Depending on the merits of the application and of any evidence of use, the Registrar may accept or reject the application either absolutely or subject to certain modifications. The Applicant is required to respond to the rejection or objections within two months of the receipt of the examination report failing which the application will be dismissed. After the acceptance of the application by the Registrar, either absolutely or subject to certain conditions and with or without a hearing being conducted, the application will be published.

Any person who is aggrieved by the order of the Registrar of Geographical Indications may appeal the order before the Appellate Board.

- **Opposition and Registration**

Any person may, within three months of the publication of the application to register a geographical indication, file an opposition. After serving the opposition documents on the Applicant and after examining the evidence and hearing the parties, the Registrar of Geographical Indications may decide whether and subject to what limitations or conditions the registration is to be permitted.

Any person who is aggrieved by the order of the Registrar of Geographical Indications may appeal the order before the Appellate Board.

The Registrar of Geographical Indications may register the geographical indication after the application has been accepted and not opposed or if opposed the opposition has been decided in favour of the Applicant. Thereafter the Registrar will issue the Registration Certificate in the prescribed format and sealed with the seal of the Geographical Indications Registry to each of the Applicant and the authorized users.

- **Term of Registration**

The registration of a geographical indication is for a 10-year period, and is renewable, indefinitely.

## **INFRINGEMENT & ENFORCEMENT REMEDIES AVAILABLE UNDER THE ACT**

A person, not being an authorized user, infringes a registered geographical indication when he uses:

- Such geographical indication by any means in the designation or presentation of Goods that indicates or suggests that such goods originate in a geographical area other than the true place of origin of such goods in a manner which misleads the persons as to the geographical origin of such goods;

- Any geographical indication in such manner that constitutes an act of unfair competition including passing off in respect of registered geographical indication.

**Civil Action:** The rights holder may initiate either infringement and/or passing off proceedings against an infringer. The infringement proceedings may be initiated if the geographical indication has been registered. However in case the geographical indication is not registered, the rights holder still has the option of initiating a passing off action against the infringer. The relief that the court may grant in the case of infringement and/or of passing off includes injunction, and at the option of the rights holder either damages or accounts of profits, delivery-up of the infringing labels and indication for destruction or erasure.

One of the landmark judgments in India regarding the protection of geographical indications is **Scotch Whisky Association & Ors. v. Golden Bottling Limited {2006(32) PTC 656 (Del)}**. In this case, the Delhi High Court passed an order of permanent injunction restraining the infringer from using the word 'Scot' as a part of its brand name, as it gives an impression to the unwary consumer of whisky that the product originates in Scotland or that it is Scotch Whisky.

- Damages:** There has been a change in the Indian judicial system in recent times with the judiciary awarding some damages and costs to the rights holder because of violation of their intellectual property rights. In the case of Scotch Whisky Association & Ors. v. Golden Bottling Limited {2006(32) PTC 656 (Del)}, the Delhi High Court awarded damages to the amount of INR 5, 00, 000 (approximately \$ 12,500) for the violation of its Intellectual Property Rights and also awarded the sum of INR 3, 10, 000 (approximately \$7,750) as costs for the litigation.

**Criminal Litigation:** The Geographical Indications of Goods (Registration and Protection) Act, 1999 provides for remedies for violation of geographical indications under the criminal laws too. Under the criminal laws, if a person is convicted of an offence for applying false geographical indications or selling goods to which a false geographical indication is applied, the Court may direct the defendant to forfeit the goods to the government.

Any person who falsely applies a geographical indication, or sells goods to which false geographical indications are applied, may be punished by imprisonment for a term not less than six months but not exceeding three years with a fine, which shall not be less than fifty thousand rupees (approximately \$1,250), but which may extend to two lakh rupees (approximately \$5000). No prosecution of any offence under this Act shall be commenced after the expiry of three years next after the commission of the offence charged or two years after the discovery thereof by the prosecutor, whichever expiration happens first.

Police have the power to suo moto conduct raids and seizure operations. However, before making any search and seizure, the police officer shall obtain the opinion of the Registrar of Geographical Indications on the facts involved in the offence and shall abide by the opinion that has been obtained.



## **COPYRIGHTS**

Copyright is a form of intellectual property protection like trademark and patents. A copyright is a legal right given by the law to creators of literary, dramatic, musical and artistic works and producers of cinematograph films and sound recordings. Copyright give the owner of the work certain safeguard to ensure the intellectual work is protected and creativity is rewarded.

### **WHAT IS COPYRIGHT ALL ABOUT?**

- Right to copy, Also called Author's Rights
- Only to tangible expression of an Idea, not an Idea itself
- Only to expressions of original Idea and to Original forms of expression of an existing Idea

‘Original’ means, that the work has not been copied from any other source

### **OBJECTIVE OF COPYRIGHT LAW**

The object of copyright law is:-

- to encourage authors, composers, artists and designers to create original works by rewarding them with the exclusive right for a limited period to exploit the work for monetary gain
- It protects the writer or creator of the original work from the unauthorized reproduction or exploitation of his materials

### **WHAT IS COPYRIGHT?**

Copyright is a

- form of intellectual property protection
- granted under Indian law
- to the creators of original works of authorship

There is no copyright in ideas. Copyright subsists only in the material form in which the ideas are expressed.

Works protected by copyright are:

- Original Literary (including computer programs, tables and compilations including computer databases which may be expressed in words, codes, schemes or in any other form, including a machine readable medium), dramatic, musical and artistic works;

- Cinematographic film; and
- Sound Records

### **Literary Works**

- Literary work includes computer programmes, tables and compilations including computer databases.
- Titles of books, movies, etc.  
For eg. Movie Sholay
- Advertisements Slogan

Advertising catch phrases entitled to copyright

For eg. “Yeh dil mange more” by Pepsi and “Yeh Dil Maange No More” by coca cola



- Question Papers
- Catalogues
- Compilations
- News
- Letters
- Questionnaire
- Lectures
- Computer Programmes
- Databases

### **DRAMATIC WORKS**

“Ddramatic work” includes

- any piece for recitation
- choreographic work
- entertainment in dumb show

### **MUSICAL WORKS**

"Musical work" means a work consisting of music and includes any graphical notation of such work but does not include any work or any action intended to be sung, spoke nor performed



with the music

### **ARTISTIC WORK**

"Artistic work" means:-

- a painting, a sculpture, a drawing (including a diagram, map, chart or plan), an engraving or a photograph, whether or not any such work possesses artistic quality;
- an architectural work of art; and
- any other work of artistic craftsmanship

### **CINEMATOGRAPH FILM**

- "cinematograph film" means any work of visual recording on any medium produced through a process from which a moving image may be produced by any means and includes a sound recording accompanying such visual recording and "cinematograph" shall be construed as including any work produced by any process analogous to cinematography including video films.
- Author is the producer
- Feature film, Documentary, Video, TV film

### **SOUND RECORDING**

- "Sound recording" means a recording of sounds from which such sounds have been produced regardless of the medium on which such recording is or the method by which the sounds are produced
- Author of sound recording is the producer

### **WHAT IS NOT PROTECTED?**

- Ideas or concepts

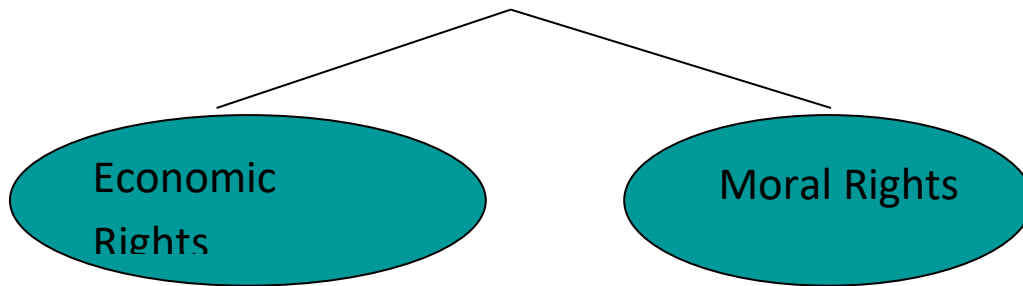
For eg- How to write a book for children regarding drawing pictures with charcoal



### **INDIAN PERSPECTIVE ON COPYRIGHT PROTECTION UNDER COPYRIGHT ACT, 1957**







### **ECONOMIC RIGHTS**

➤ In the case of a literary, dramatic or musical work, not being a computer programme:-

- to reproduce the work in any material form
- to issue copies of the work to the public
- to perform the work in public, or communicate it to the public
- to make any cinematograph film or sound recording
- to make any translation of the work
- to make any adaptation of the work



➤ In the case of a computer programme:-

- to do any of the acts specified earlier
- to sell or give on hire, or offer for sale or hire, any copy of the computer programme
- regardless of whether such copy has been sold or given on hire on earlier occasions

➤ In the case of cinematograph film:-

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

➤ In the case of an artistic work:-

- to reproduce the work in any material form, including depiction in three dimensions of a two dimensional work or in two dimensions of a three dimensional work,
- to communicate or issues copies of the work to the public
- to include the work in any cinematograph work
- to make any adaptation of the work.

➤ In the case of Sound Recording:-

To make any other sound recording embodying it;

- to sell or give on hire, or offer for sale or hire, any copy of the sound recording regardless of whether such copy has been sold or given on hire on earlier occasions;

- **MORAL RIGHTS**

➤ **RIGHT OF PATERNITY**

The right of paternity refers to a right of an author to claim authorship of work and a right to prevent all others from claiming authorship of his work.

➤ **RIGHT OF INTEGRITY**

Right of integrity empowers the author to prevent distortion, mutilation or other alterations of his work, or any other action in relation to said work, which would be prejudicial to his honour or reputation.

- Moral rights are available to the authors even after the economic rights are assigned.
- The moral rights are independent of the author's copyright and remains with him even after assignment of the copyright.

**STATUTORY RIGHT**

**Licenses**

- A license is an authorization of an act which, without such authorization becomes infringement
- A license is a grant of authority to do a particular thing, which otherwise could not have been done
- amounts to a consent or permission granted by the owner of copyright that the licensee could carry out a restricted act which but for such permission could have been an infringement
- Owner of copyright in an existing work or future work 'may grant any interest in the right by license in writing signed by him or his duly authorized agent'

**Assignment**

In essence assignment refers to a transfer of ownership

- May be for whole of the rights or for part only in the Following manner:
- ❖ For the entire world or for a specific country or territory
- ❖ For the full term of copyright or part thereof relating to

All the rights comprising the copyright or only part of  
Such rights.

- Copyright be assigned in respect of existing and future works
- Assignment for future work will take effect only after it comes into existence
- Need not be in any special form -- Written and Signed
- If the period of assignment is not stated, it shall be deemed to be five years from the date of assignment.
- If the territorial extent of assignment of the rights is not specified, it shall be presumed to extend within the whole of India.

### **DISPUTES WITH RESPECT TO ASSIGNMENT**

- If an assignee fails to make sufficient exercise of the rights assigned to him, then, the Copyright Board may, on receipt of a complaint from the assignor and after holding such inquiry as it may deem necessary, revoke such assignment.
- If any dispute arises with respect to the assignment of any copyright the Copyright Board may, on receipt of a complaint from the aggrieved party and after holding such inquiry as it considers necessary, pass such order as it may deem fit including an order for the recovery of any royalty payable

### **FORMS AND FEES FOR REGISTRATION OF COPYRIGHT**

Form IV prescribed under rule (16) of - Application for Registration of Copyrights

|                                                                                                      |                                           |
|------------------------------------------------------------------------------------------------------|-------------------------------------------|
| A- Literary, Dramatic, Musical or Artistic work                                                      | Rs. 50 per work                           |
| B- Providing that in respect of literary or artistic work<br>of being used in relation to any goods. | Rs. 400 per work which is used or capable |

### **HOW TO OBTAIN COPYRIGHT?**

In order to qualify for copyrights the works apart from being original, should satisfy the following conditions (except in the case of foreign works)

1. The work is first published in India.
2. Where the work is first published outside India the author, at the date of publication must be a citizen of India. If the publication was made after the authors' death the author must have been at the time of his death a citizen of India.
3. In case of unpublished work the author is at the date of making the work a citizen of India or domiciled in India.
4. In case of the architectural work of art, the work is located in India.

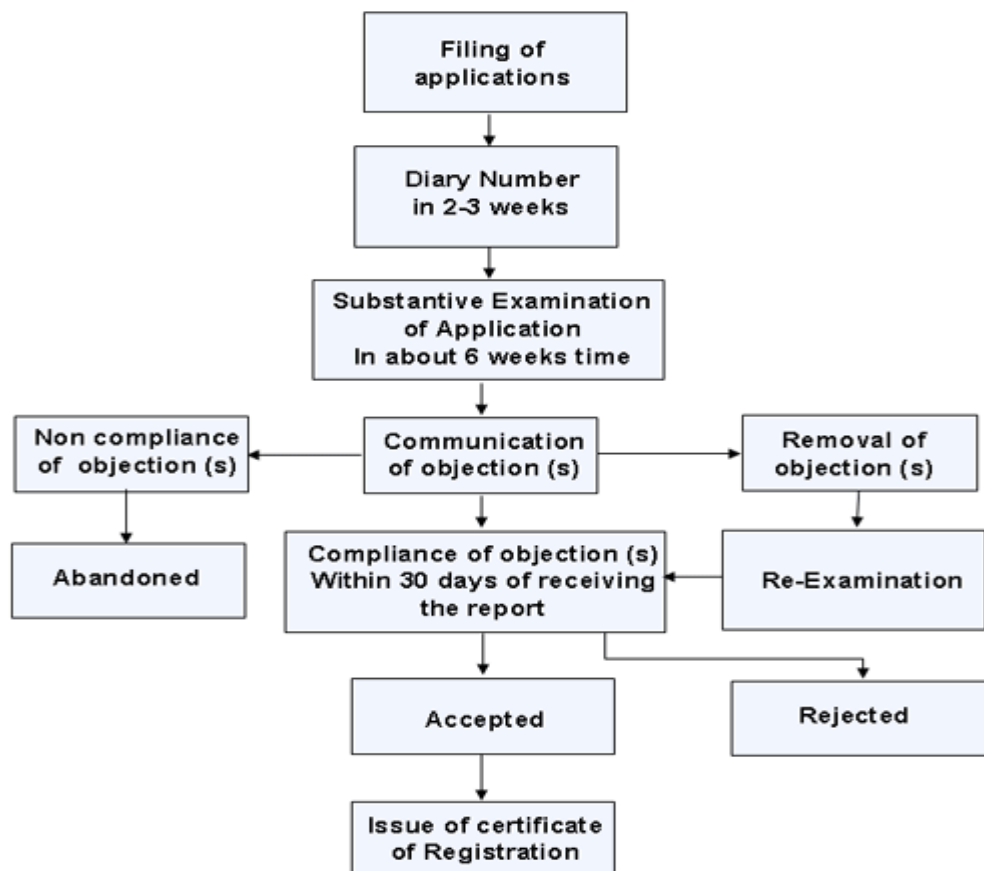
Explanation: - In the case of a work of joint authorship the conditions conferring copyright specified in this subsection shall be satisfied by all the authors of the work.

### **DO WE NEED TO REGISTER TO BE PROTECTED?**

- Copyright registration is optional. However it is always advisable to obtain a registration for a better protection.
- Copyright registration does not confer any rights and is merely a prima facie proof of an entry in respect of the work in the Copyright Register maintained by the Registrar of Copyrights.
- Copyright it does not depend on official procedures.
- A created work is considered protected by copyright as soon as it exists.



### **PROCEDURE FOR FILING COPYRIGHT APPLICATION**



### The steps for Registration:

1. Application in triplicate with prescribed fees.
2. Applicant to serve notice of his application to every person who has any interest in the subject matter.
3. If the Registrar receives any objection he may after holding such inquiry as he deems fit, enter such particulars of work in the register of copyright, which he considers proper.
4. Registrar then sends copies of the entries made in the register to the parties concerned

Registration formalities are simple and the paperwork is least. In case, the work has been created by a person other than employee, it would be necessary to file with the application, a copy of the assignment deed.

When a work has been registered as unpublished and subsequently it is published, the applicant may apply for changes in particulars entered in the Register of Copyright in Form V with prescribed fee.

### **DURATION OF REGISTRATION**

| Type of work                                                        | Term of Copyright                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                            |
|---------------------------------------------------------------------|--------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| Literary or musical works or artistic works, other than photographs | <p>For published work</p> <p>extends for the life time of the author + 60 years from the beginning of the calendar year next following the year in which the author dies</p> <p>In case of a work of joint authorship the period of Sixty Years will commence after the death of author who dies last.</p> <p>For the work has not been published, performed, or offered for sale or broadcast during the life of the author</p> <p>Continue for a period of 60 years from the end of the year in which any of these acts are done relating to the work.</p> |
| Cinematograph films, photographs and computer programs              | <p>60 years from the end of the year in which the work is made available to the public or published</p> <p>failing abovementioned event, for 60 years from the end of the year in which the work is made</p>                                                                                                                                                                                                                                                                                                                                                 |
| Sound recordings                                                    | <p>60 years from the end of the year in which the recording is first published</p>                                                                                                                                                                                                                                                                                                                                                                                                                                                                           |

### **WHEN COPYRIGHT INFRINGED?**

When any person, **without a license** granted by the owner of the copyright:

- **Does anything**, the exclusive right to do which is by this Act conferred upon the owner of the copyright, or
- **Permits for profit** any place to be used for the communication of the work to the public where such communication constitutes an infringement of the copyright in the work, **unless he was not aware** and had no reasonable ground for believing that such communication to the public would be an infringement of copyright; or

- When any person makes for **sale or hire, or sells or lets for hire, or offers for sale or hire, or exhibits** in public for trade or import (except two copies other than cinematography film or record for personal use) any infringing copies of the work covered by copyright.

In General it is the commercial exploitation of the work in any form by a person without authority that constitutes infringement.

### **REMEDIES FOR INFRINGEMENT**

#### ➤ Civil Remedies

- Injunction, damages and accounts of profit, delivery of infringing copies and damages for conversion.

#### ➤ Criminal Remedies

- Imprisonment, fine, seizure
- Administrative
- Restrain on importation

### **Period of limitation**

The period of limitation for filing the suit is 3 (three) years from the date of the infringement.

### **DECIDED LEGAL CASES**





## **ON INFRINGEMENT OF COPYRIGHT**

A copyright owner cannot enjoy his rights unless infringement of the same is stringently dealt with by the Courts. The approach of the Indian Judiciary in this regard is very satisfactory.

### **In Prakashak Puneet Prashant Prakashan v Distt.judge, Bulandshahr & Ashok Prakashan (Regd)**

- The Allahabad High Court held that if the petitioner publishes a book by adding any word before or after the book “Bal Bharati”, he infringes the copyright of the respondent.

### **In R.G. Anand v M/S Delux Films**

- The Court observed that “Where the same idea is being developed in a different manner, it is manifest that the source being common, similarities are bound to occur.
- In such a case, the Courts should determine whether or not the similarities are on fundamental or substantial aspects of the mode of expression adopted in the copyrighted work with some variations here and there.
- In other words, in order to be actionable the copy must be a substantial and material one which at once leads to the conclusion that the defendant is guilty of the act of piracy”.

## **RIGHTS**

Copyright gives the owner the exclusive right to make and distribute copies, or perform a work, or make derivative works, depending upon the type of creative work it is. BUT;

Trademark provides an individualized right to use a distinctive mark, sound, color, word, design, etc, to indicate a particular source and quality of branded goods or services.

### **➤ INFRINGEMENT OF RIGHT**

In case of Copyright, exclusive right of the owner is infringed when someone violates those rights, such as by making illegal copies. **BUT**;

In case of trademark the individualized right is infringed when someone uses the brand to falsely indicate or suggest goods or services came from the rightful brand owner, and not the knock-off producer.

### **MICKEY MOUSE CASE**

Consider the “**MICKEY MOUSE**” design: copyrighted as a cartoon character, and trademarked as an indication that it came from Disney (or a licensee).

You would infringe the copyright by using “**MICKEY**” in your own cartoons;

you would infringe the trademark by putting MICKEY's picture on the package.

**HOWEVER**, there may be occasions when both **copyright and trademark** protections are desired with respect to the same business endeavour.

For example, a marketing campaign for a new product may introduce a new slogan for use with the product, which also appears in advertisements for the product.

The Copyright and trademark Law's protection will cover different things.

The advertisement's text and graphics, as published in a particular vehicle, will be covered by **copyright** - but this will not protect the slogan as such.

The slogan may be protected by **trademark law**, but this will not cover the rest of the advertisement. If you want both forms of protection, you will have to perform both types of registration.

### **SAJEEV PILLAI V. VENUKUNNAPALLI & ANR**

Issue: Whether the author of a work even after assignment of work will have special rights to claim authorship of his work provided under Section 57(1) of the Copyright Act?

Facts: The appellant, Sajeew Pillai, a film director and a script writer claimed to have researched the history of the grand festival Mamankam and prepared a script for a movie based on the same epic. He met Venu Kunna palli and signed a MoU with Kavya Film Company which was associated with Kunna palli. Sajeew was initially appointed as the director but then his service was terminated and was replaced by someone else. The shooting of the movie was thereafter completed which Sajeew alleged was done by mutilating, distorting and modifying his script. Sajeew in light of that filed a suit seeking various reliefs. An interim injunction application was also filed to restrain the respondents from releasing, publishing, distributing and exploiting the film and issuing pre-release publicity without providing adequate authorship credits to Pillai as per film industry standards.

Judgement: In deciding the issue, the court noted that the first sub-section of Section 57(1) provides the author to restrain third parties and the second sub-section provides the author the entitlement to claim damages by such third party in respect of any distortion, mutilation or other modifications to his work or any other action, in relation thereto which would be prejudicial to his honour or reputation. This provided the appellant an unparalleled advantage in the case and that his assignment of the work would not exhaust the legal right to claim authorship over it.

### **TIPS INDUSTRIES V WYNK MUSIC**

Issue: Whether there exists a statutory licensing scheme under the Copyright Act to online streaming services?

**Background:** The dispute centers around section 31D of the Copyright Act, 1957 which provides for statutory licensing scheme, as whereby any ‘broadcasting organization’ desirous of ‘communicating to the public’ any sound recording, can obtain a statutory license to do so, provided they pay royalty rates to the copyright owners at rates fixed by the Intellectual Property Law Board.

**Facts:** Tips Industries Ltd (Plaintiff) is an Indian music label that exercises copyright over a significant music repository that, in 2016, granted Wynk Music Ltd (Defendant) license to access this music repository. At the expiry of the said license both the parties attempted to renegotiate the licensing conditions but failed to do so and hence Wynk took refuge by invoking Section 31D of the Copyright Act. Tips challenged Wynk’s invocation of Section 31D, and prosecuted Wynk pursuant to Section 14(1)(e) for breach of their exclusive rights of sound recording

**Judgement:** After hearing the contentions of both the parties the Bombay High Court came to a conclusion finding Wynk to be guilty of direct infringement on two counts – 1. To offer the copyrighted work under section 14(1) (e) (ii) which allowed the users to download and listen to the plaintiff’s work offline and 2. Under section 14(1) (e) (iii) for communicating the plaintiff’s works to the users via their streaming service.

In addition to that the Bombay High Court sought this opportunity to clear out the air regarding the ambiguity that existed with respect to online streaming services falling within the scope of Section 31D:

1. Under Section 31D of the Copyright Act, ‘ Download / Purchase ‘ of copyrighted works is not covered.

Wynk Music permitted the users to download and store copyrighted music for unlimited future use which instituted to be a ‘sale’ and not ‘communication made to public’ which constitutes as a ‘broadcast’ for the purposes of Section 31D and hence there exists no claim for statutory license for the use of such copyrighted work by Wynk Music.

2. The application of Section 31D of the Copyright Act does not include Internet broadcasting.

The case of the defendant was based primarily on the presumption that Section 31D covered Internet streaming services under ‘radio broadcasting’ as described in a 2016 DPIIT office circular, given that ‘radio broadcasting’ included ‘internet broadcasting’ under Section 31D.

The Court had an opposing view which resulted in the rejection of the interpretation put forth by the defendant.

The Court found Section 31D to be an exception to copyright which ought to only be strictly interpreted. Upon careful examination of the statutory scheme of 31D and the rules accompanying it, it becomes apparent that statutory licensing was intended to only cover radio and television broadcasting and not internet broadcasting. After examining the history associated with Section 31D, the court derived that, despite the global existence of internet streaming services when the Section was inserted through an Amendment Act of 2012, the legislation even though being aware of it omitted to include internet streaming services from the ambit of Section 31D. In addition to that, the

memorandum presented by the defendant does not contain any additional weightage of their claim as a memorandum only acts as ‘guidelines’ and lacks statutory authority and therefore has no influence to the extent of their claim.

The judgement was passed in the favour of the plaintiff and the court held that the plaintiff was entitled to interim injunction, having regard to the reality that they had made a prima facie case, would suffer irreparable harm in the way of lost revenue.

### **RAJ REWAL V UNION OF INDIA &ORS**

**Issue:** Whether an Architect, as the creator and legally the ‘author’ of a structure has a right vested in him to object to such modification or demolition of their work by the owner of the building?

**Background:** The dispute centres around section 57 of the Copyright Act, 1957 under which the plaintiff has filed for a mandatory injunction to reinstate the building according to the original plans. Section 57 of the Copyright Act, 1957 provides the author with special rights called ‘moral rights’ which subsists with the author of the work over and above economic rights of others.

**Facts:** The present case talks about one Mr. Raj Rewal who designed and Mr. Mahendra Raj who was the structural designer of the Hall of Nations building. The said building was hailed as an icon of modernist Indian architecture and was erected in the Pragati Maidan grounds in New Delhi. The ITPO in 2016, made a proposal to demolish the Hall of Nations complex in order to build an ‘Integrated Exhibition cum Convention Centre’. Despite of several attempts made by the Plaintiff to protect the building from demolition it resulted in what ITPO desired. Post demolition of the building the Plaintiff instituted a suit against the actions of ITPO by claiming that the actions of demolition had derogated the Plaintiff’s special rights under Section 57.

**Judgement:** Rejecting the plaintiff’s claims the Court framed the issue as a conflict of two different rights, namely – the architect’s rights under Section 57, and the landowner’s rights to practice acts pertaining to their property.

The court observed that the plaintiff in this case cannot be allowed to prevent the demolition of the building by the defendant as it would in turn amount to restriction of the defendant’s right to practice their control over their property and land which is provided to them under Article 300A which is a constitutional right which prevails over the statutory rights of the plaintiff which they claim to exist under Section 57 of Copyright Act, 1957.

The court further states that the author’s right under Section 57 to prohibit ‘distortion, mutilation or modification’ of his work does not permit an author to prevent complete destruction of their work since “that what cannot be viewed, seen, heard or felt, cannot be imperfect and cannot affect the honour or reputation of the author.” Therefore, the extent to which the right vested in the architect extends to is to prevent the building owner to refrain from making changes in the design made by the architect and passing it off as if the design was made by the architect. The Court in furtherance to that also relied upon Section 52(1)(x) which acts as an exception to copyright of the architect.[3] The

court reasoned that the ‘reconstruction’ envisaged under Section 52(1)(x) could only take place if the building had already been demolished. Noting that the Copyright Act must be read harmoniously, the court therefore stated that Section 57 could not reasonably contemplate the right to object to the demolition of a building.

In conclusion the court dismissed the suit due to lack of cause of action against the demolition of the Hall of Nations.

## **YRF V SRI SAI GANESH PRODUCTIONS**

**Issue:** Whether copyright can subsist in a cinematography film independent of the underlying works that it is comprised of?

2. Whether the expression under section 14 to ‘make a copy of the film’ mean making physical copy of the film only? And between the two films is there a substantial and material similarity?

**Facts:** A copyright infringement suit was filed against Sri Sai Ganesh Productions & Ors by Yash Raj Films Pvt Ltd on the grounds that it blatantly copied the movie Band Baja Baarat produced under the YRF banner and producing Jabardasth which showcased substantial and material similarities in terms of theme, concept, plot, character, sketches, story, script, form and expression amongst other things.

### **Judgement:**

The court while determining the first issue relied on the judgement handed down by the Delhi High Court in the case of MRF Limited v. Metro Tyres Ltd, in which the court held that copyright exists in the ‘cinematographic film’ independent from other underlying works that come together to constitute it and that there is a requirement of originality to exist in ‘cinematographic films’ which can be read into from Section 13(1)(b) of the Copyright Act, 1957 through Sections 13(3)(a) and 2(d) of the said Act even though it has not been explicitly mentioned.

The court while determining the second issue held that the expression ‘to make a copy of the film’ provided in Section 14(d)(i) of the said Act does not simply mean creating a physical copy of the film by process of duplication. Furthermore, as the films are protected just like original works, the court extended the test of originality set out in the case of R.G Anand v. Deluxe Films to distinguish between the two films on the basis of ‘substance, foundation and kernel’ and understand the viewpoint of an average moviegoer as to whether they would have an unmistakable impression that one work was a copy of the other. In the instant case the court found that the defendants had blatantly copied the fundamental, essential and distinctive features of the plaintiff’s film.

## **UTV SOFTWARE COMMUNICATION LTD., V.1337X.TO AND ORS**

**Issue:** How should the Court deal with the hydra headed ‘Rogue Websites’ which on being blocked, eventually multiply and resurface as redirect or mirror or alphanumeric websites?

**Facts:** UTV Software Communications Ltd (Plaintiff), is one such company which is engaged in creating content, producing and distributing cinematographic content around the world. The plaintiff has brought a suit against thirty identified websites, multiple John Doe defendants, the Ministry of Electronics and Information Technology, the Dept of Telecom and various ISPs. The contention of the plaintiff was based on the fact that the defendant websites host and provide access to their copyrighted content which infringes their rights derived from the Copyright Act, 1957. The plaintiffs provided access to a sample of such infringing content as evidence that the websites were primarily engaging in online piracy. Majority of the websites did not respond to the summons presumably since they were hosted outside of India and due to that an amicus curia was appointed in their place as the issue was pertaining to be a question of law of general public importance.

### **Judgement:**

The most notable contribution this case made was that it introduced a new procedure to extend website blocking injunctions beyond those specified in the court order but also to those websites which are ‘mirror/alphanumeric/redirect’ websites created after the injunction order was already passed by the court. This extension was termed as ‘dynamic injunction’. Singapore High Court’s decision in Disney v M1 was referred by the High Court of Delhi while deciding on the issue where their court introduced the concept of ‘dynamic injunction’ whereby a plaintiff could file an additional affidavit stating to the court why a new website fell within the purview of an existing blocking order, and forwarding the same to an ISP, which could dispute the merits of the blocking order. This process would provide to be helpful in curtailing piracy by such ‘Rogue Websites’ and reduce the burden on the copyright owners to go through the tough route of litigation over and again.

## CONCLUSION



**IPRs are valuable and they help in grooming the economic conditions of the country only if they are well protected & enforced and the World is surely moving towards it.**

The project has tackled to explain in detail the logical and practical meaning and scope of Intellectual Property. The procedure of registration of any form of IPR had been simplified and friendly explained here. These issues by developing an IPR consisting of documents Providing guidance and advice on copyright as well as links to relevant work produced by

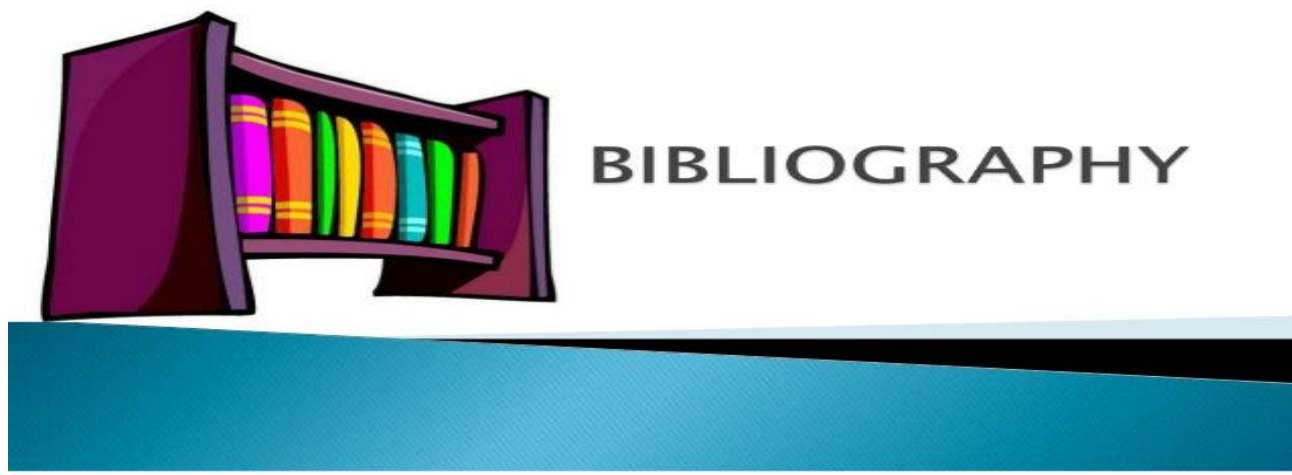
Other projects and sample documentation.

The specific issues tackled in the documents were identified from a survey of existing repository copyright advice documentation combined with substantial input from project partners.

A particularly innovative feature of the project's IPR work has been the need to tackle the variation in copyright laws across the eight European countries represented by the project partners and how to provide effective copyright advice which is both sufficiently generic to be widely applicable but which also deals with the specifics of different legal systems. This has been achieved by partners identifying a legal or copyright expert in each jurisdiction who is prepared to review and comment on the documentation provided by the Toolkit and provide advice on the details of their own copyright system to project partners.



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