
ECONOMIC, COMMERCIAL & INTELLECTUAL PROPERTY LAWS - PART B

CS EXECUTIVE

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LESSON 1
INTELLECTUAL PROPERTY RIGHTS

Introduction

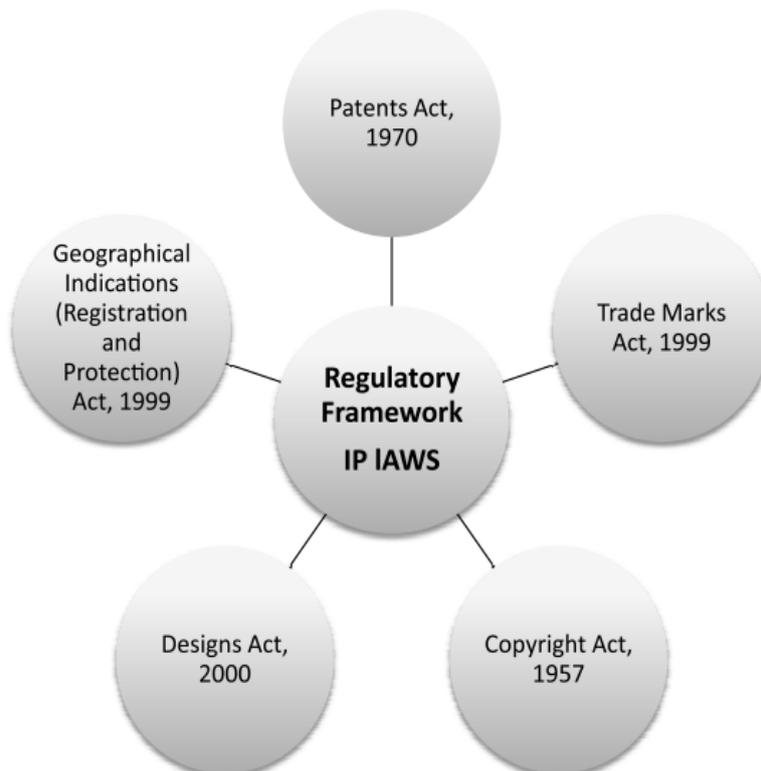
As the term intellectual property relates to the **creations of human mind and human intellect**, this property is called Intellectual property.

Intellectual Property is the Property, which has been created by exercise of **Intellectual Faculty**.

The areas of intellectual property that it covers are: **copyright** and related rights (i.e. the rights of performers, producers of sound recordings and broadcasting organizations); **trademarks** including service marks; **geographical indications** including appellations of origin; **industrial designs**; **patents** including the protection of new varieties of plants; the **layout-designs of integrated circuits**; and undisclosed information including trade secrets and test data.

Intellectual property is a vital component of economic growth and a tool for corporate competitiveness in today's highly competitive global market. Intellectual property rights serve as a catalyst for the development of innovations and inventions.

Regulatory Framework



Nature of Intellectual Property

(1) Intangible Rights over Tangible Property: IP's intangibility is the primary characteristic that sets it apart from other types of property. Although there are many significant differences between the various types of IP, one characteristic they all share is the establishment of property protection over intangible objects.

(2) Right to sue: IP is a resource that can be owned and managed, to use the language of the law. The majority of intellectual property is challenged through legal rights of action that can only be carried out by people who have legal standing. Since intellectual property (IP) is a property right, it can be inherited, purchased, gifted, sold, licenced, entrusted, or pledged. Subject to certain restrictions, the owner of an IPR owns a sort of property that can be used however they like. They also have the legal right to sue anyone who uses their innovation without their permission and to be compensated with actual property.

(3) Rights and Duties: IP results in both obligations and property rights. The owner of the IP is entitled to carry out specific tasks in connection with his creations. He has the sole authority to create, copy, sell, and otherwise exploit the work. Additionally, there is a negative right that bars others from using their statutory rights.

(4) Coexistence of different rights: In relation to a specific function, various IPR kinds may coexist. For instance, an image of an innovation might be copyrighted and the invention itself might be patented. A design may be included in a trademark and may also be protected under the Design Act.

(5) Exhaustion of rights: The doctrine of exhaustion generally applies to intellectual property rights. Exhaustion fundamentally means that after the first sale made by the right holder or by the authority designated for its exhaustion, that person's right expires and he is no longer permitted to halt the movement of the goods moving forward.

(6) Dynamism: IPR is undergoing continual improvement. The realm of IP is expanding as quickly as technology in all spheres of human activity. New things are being added to the IPR scope and the scope of its protection is being enlarged in accordance with the demands of scientific and technical advancement.

The General Agreement on Trade in Services (GATS)

(1) The General Agreement on Trade in Services of the World Trade Organization (WTO), commonly known as the GATS, established a multilateral framework of rules and principles for trade in services, a large and fast-growing segment of world trade.

(2) It also set in motion a process for the progressive removal of restrictions on international services trade.

(3) The *GATS* was a major accomplishment of the Uruguay Round of Multilateral Trade Negotiations.

(4) The *GATS* is designed to ensure that the laws and regulations that WTO member governments apply to services trade are transparent and fair.

(5) The *GATS* functions on three levels, similar to the accords on goods:

- the primary text, which contains basic principles and obligations;
- annexes, which deal with rules for particular sectors; and
- individual nations' explicit commitments to allow access to their markets.

(6) The two key pillars that support the *GATS*' contribution to global services trade are:

- (a) increasing the openness and predictability of pertinent rules and regulations and
- (b) fostering progressive liberalisation through subsequent rounds of talks.

World Intellectual Property Organization (WIPO)

(1) The United Nations organisation devoted to using intellectual property as a tool to foster innovation and creativity is known as the World Intellectual Property Organization (WIPO).

(2) WIPO was founded in 1970 with a mission from its Member States to advance the protection of intellectual property all over the globe through intergovernmental cooperation and cooperation with other international organisations.

(3) Its goal is to foster innovation and creativity through the creation of a fair and efficient international intellectual property system for the benefit of all nations' economic, social, and cultural development.

(4) In 1974, the Organization was designated as a specialised agency of the UN.

(5) The WIPO's main office is in Geneva.

(6) By signing a cooperative agreement with the World Trade Organization in 1996, WIPO enlarged its mandate and further illustrated the significance of intellectual property rights in the administration of globalised trade.

(7) In order to establish and unify laws and procedures for the protection of intellectual property rights, WIPO serves as a platform for its Member States. Additionally, WIPO provides global patent filing services as well as global registration services for trademarks, industrial designs, and appellations of origin.

Legal Frameworks under WIPO

Patent Cooperation Treaty (PCT): The Patent Cooperation Treaty (PCT) assists applicants in seeking patent protection internationally for their inventions, helps patent offices with their patent granting decisions, and facilitates public access to a wealth of technical information relating to those inventions.

Madrid Agreement: The Madrid Agreement, signed in 1891, and the Protocol pertaining to that Agreement, signed in 1989, set forth the rules for the Madrid System for the International Registration of Marks.

Vienna Agreement: For marks that are composed of or incorporate figurative features, the Vienna Agreement creates an International Classification of the Figurative Elements of Marks known as the Vienna Classification.

Nice Agreement: Regarding the International Classification of Goods and Services for the Registration of Marks, the Nice Agreement came into force.

Locarno Agreement: The Locarno Agreement creates the Locarno Classification, an international classification system for industrial designs.

WIPO Copyright Treaty (WCT): A particular agreement under the Berne Convention known as the WIPO Copyright Treaty (WCT) deals with the protection of works and the rights of their authors in the digital sphere.

Standing Committee on Copyright and Related Rights (SCCR): During the biennium of 1998-1999, the Standing Committee on Copyright and Related Rights (SCCR) was established to look into issues of substantive law or harmonisation in the area of copyright and related rights.

Hague System/Agreement: Through the submission of a single international application, the Hague System for the International Registration of Industrial Designs offers a useful commercial option for registering up to 100 designs in 74 contracting parties spanning 91 countries.

Lisbon System/Agreement: By using a single registration process and a single set of costs, the Lisbon System for the International Registration of Appellations of Origin and Geographical Indications provides a way to secure protection for an appellation of origin or a geographical indication in the contracting parties.

Trade-Related Aspects of Intellectual Property Rights (TRIPS)

(1) The TRIPS Agreement is essential for facilitating intellectual property trade, settling intellectual property trade disputes, and giving WTO members the freedom to pursue their own national goals.

(2) The Agreement formally acknowledges the importance of the connections between intellectual property and trade. That was accomplished by the Uruguay Round.

(3) WTO countries have a great deal of flexibility under the TRIPS Agreement to customise their methods to IP protection and enforcement to meet their needs and realise public policy objectives.

(4) The TRIPS Agreement addresses five main topics:

- How general rules and fundamental ideas of the global trading system apply to international intellectual property?
- What are the minimum protection criteria for intellectual property rights that members should offer?
- What mechanisms should members offer to defend those rights in their home countries?
- Specific interim framework for resolving intellectual property disputes between WTO members in order to implement TRIPS requirements.
- Special transitional arrangements for the implementation of TRIPS provisions.

The Concept of Intellectual Property

The term "intellectual property" refers to works produced by the human mind and intellect.

In other words, intellectual property refers to information that may be used to create tangible goods simultaneously in an infinite number of copies at various locations throughout the globe.

Industrial Property

✓ industrial property is a kind of intellectual property and relates to creation of human mind, e.g., inventions and industrial designs.

✓ industrial property right is a collective name for rights referring to the commercial or industrial activities of a person. These activities may include the activities of industrial or commercial interests.

✓ They may be called inventions, creations, new products, processes of manufacture, new designs or model and a distinctive mark for goods etc.

Patent

✓ A patent is a monopoly award that gives the inventor control over the output and, up to a certain point in the demand curve, the price of the patented goods.

✓ The patent system's primary economic and commercial justification is that it encourages investment in industrial innovation.

Trade Mark

✓ A trade mark tries to safeguard both the interests of the trader and the customer by differentiating the items of one manufacturer or trader from comparable goods of others.

✓ A trademark can be any combination of words, characters, numbers, symbols, or devices showing images of people, animals, or both.

Copyright

✓ The idea of Copyright protection only began to emerge with the invention of printing, which made it for literary works to be duplicated by mechanical processes instead of being copied by hand.

✓ There are well-known instances of legal intervention to punish a person for copying literary or aesthetic output of another even before the concept of copyright took shape.

Industrial Designs

✓ Industrial designs belong to the aesthetic field, but are at the same time intended to serve as pattern for the manufacture of products of industry or handicraft.

✓ An industrial design is the ornamental or aesthetic aspect of a useful article, which must appeal to the sense of sight and may consist of the shape and/or pattern and/or colour of article.

Geographical Indication (GI)

✓ Geographical Indicator is that part of industrial property that designates a nation or a location within it as the nation or place of origin of that product.

✓ Such a name typically carries a guarantee of quality and individuality, which is mostly due to the fact that it originated in the specified geographical place, region, or nation.

✓ Bordeaux wine, Darjeeling tea, Chanderi sarees, Kullu shawls, Tuscany olive oil, Kanchipuram silk sarees, Alphanso Mango, Nagpur orange, and Kolhapuri (Chappal) are well-known examples of GIs.

Trade Secret

✓ A trade secret is a method, practise, procedure, design, instrument, pattern, or collection of information that is not widely known or easily discoverable and through which a company might gain a competitive edge over rivals or clients.

✓ An enterprise may gain a competitive edge from secret business information.

Intellectual Property Rights policy

- The National Intellectual Property Rights Policy was put into place to encourage innovation, enhance the business climate, and make it easier to commercially utilise intellectual property.

- The Policy is in accordance with India's proclamation that this decade is the "Decade of Innovation".

- IPR Policy focus on:

- ✓ Improving access to healthcare, food security, and environmental protection, among other areas of critical social, economic, and technological importance.

- ✓ fostering creativity and innovation and thereby promote entrepreneurship and enhance socio-economic and cultural development.

- The Policy outlines seven goals that are further defined with actions that must be taken by the designated nodal Ministry or Department.

The goals are briefly discussed below: -

IPR Awareness: Outreach and Promotion - To create public awareness about the economic, social and cultural benefits of IPRs among all sections of society.

Generation of IPRs - To stimulate the generation of IPR.

Legal and Legislative Framework - To have strong and effective IPR laws, which balance the interests of rights owners with larger public interest.

Administration and Management - To modernize and strengthen service oriented IPR administration.

Commercialization of IPR - Get value for IPRs through commercialization.

Enforcement and Adjudication - To strengthen the enforcement and adjudicatory mechanisms for combating IPR infringements.

Human Capital Development - To strengthen and expand human resources, institutions and capacities for teaching, training, research and skill building in IPRs.

Space for Notes

LESSON 2
LAW RELATING TO PATENTS

Regulatory Framework

- Patents Act 1970
- Patents Rules 2003

The term 'Patent' acquired a statutory meaning in India under the Patents Act, 1970. The Act and the Rules framed under it, i.e. the Patent Rules, 2003 regulate the subjects like the grant, the operative period, the revocation, and infringement etc. of the Patents.

Introduction

A Patent is a statutory right for an invention granted for a limited period of time to the patentee by the Government, in exchange of full disclosure of his invention for excluding others, from making, using, selling, importing the patented product or process for producing that product for those purposes without his consent.

Patent is a monopoly grant and it enables the inventor to control the output and within the limits set by demand, the price of the patented products.

Patents

Section 2(1) (m) of the Patents Act, 1970, defines the term patent as to mean a patent for any invention granted under Patents Act.

An invention is considered as new (novel), if it is not anticipated by prior publication in patent and non-patent literature, i.e., an invention is novel if it has not been disclosed in the prior art, where the prior art means everything that has been published, presented or otherwise disclosed to the public before the date of filing/priority date of complete specification. An invention is considered as novel, if it has not been anticipated by prior use or prior public knowledge in India.

In the case of Bishwanath Prasad Radhey Shyam v. Hindustan Metal Industries, (1979) 2 SCC 511, it was held by the Hon'ble Supreme Court of India that the object of Patent law is to encourage scientific research, new technology and industrial progress. A limited-time grant of the only right to own, use, or sell a patented method or product encourages the development of new commercially useful inventions. The disclosure of the invention to the Patent Office, which becomes public domain after a predetermined duration of the monopoly, is the cost of the monopoly grant.

Patentee

The term patentee means the person for the time being entered on the register as the grantee or proprietor of the patent.

Invention

Invention means a new product or process involving an inventive step and capable of Industrial application.

In Raj Prakash v. Mangat Ram Choudhary AIR 1978 Delhi 1, it was held that inventive creation, as is notable, is to discover something or find something not found or found by anybody previously. It isn't essential that the invention ought to be anything confounded. The fundamental thing is that the creator was first to embrace it. The main issue in this manner, is that each basic creation is asserted, as in the form of novelty or new character, it will be considered as an invention and the cases & specifications must be perused in that light.

What is the Patent Cooperation Treaty (PCT)?

The PCT is an international treaty with more than 150 Contracting States which are bound with certain formal requirements set out in the Treaty and Regulations. The PCT makes it possible to seek patent protection for an invention simultaneously in a large number of countries by filing a single international patent application instead of filing several separate national or regional patent applications however, granting of patents remains under the control of the national or regional patent offices after the corresponding national phase application has been filed and the national phase application is assessed as per patent law of that jurisdiction.

Advantages of Patents

(1) Patentee have the complete rights to restrict outsider from making, operating, providing accessibility to be bought, providing or putting in the product generated by him, without his consent. He has absolute prerogative to utilize his invention and his rights that are very much ensured under the Act.

(2) The patentee has a privilege to file the suit for encroachment of his patent and can ask for remedies like, Injunction, compensation and a settlement of profit against the individual who encroached his patent.

(3) Patentee can commercially exploit or pitch his creation to any skilled individual and concede permit to him to abuse his item and in this way the patentee can likewise wins benefit along these lines.

(4) The holder of the exclusive permit can also avail the rights given to the patentee and can bring a suit if there should arise an occurrence of any encroachment of Patent.

(5) A patentee gets the privilege to make changes in or alterations of an invention depicted or uncovered in the total determination of the primary innovation and get the particular right of a patent by the substantial change or patent as a matter of addition/certain adjustment.

What are not inventions

The following are not inventions within the meaning of Section 3 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 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;
- 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 whatsoever including cinematographic works and television productions;
- l) a mere scheme or rule or method of performing mental act or method of playing game;
- m) a presentation of information;

- n) topography of integrated circuits;
- o) an invention which in effect, is traditional knowledge or which is an aggregation or duplication of known properties of traditionally known component or components;

What are the Criteria of Patentability?

An invention is patentable subject matter if it meets the following criteria -

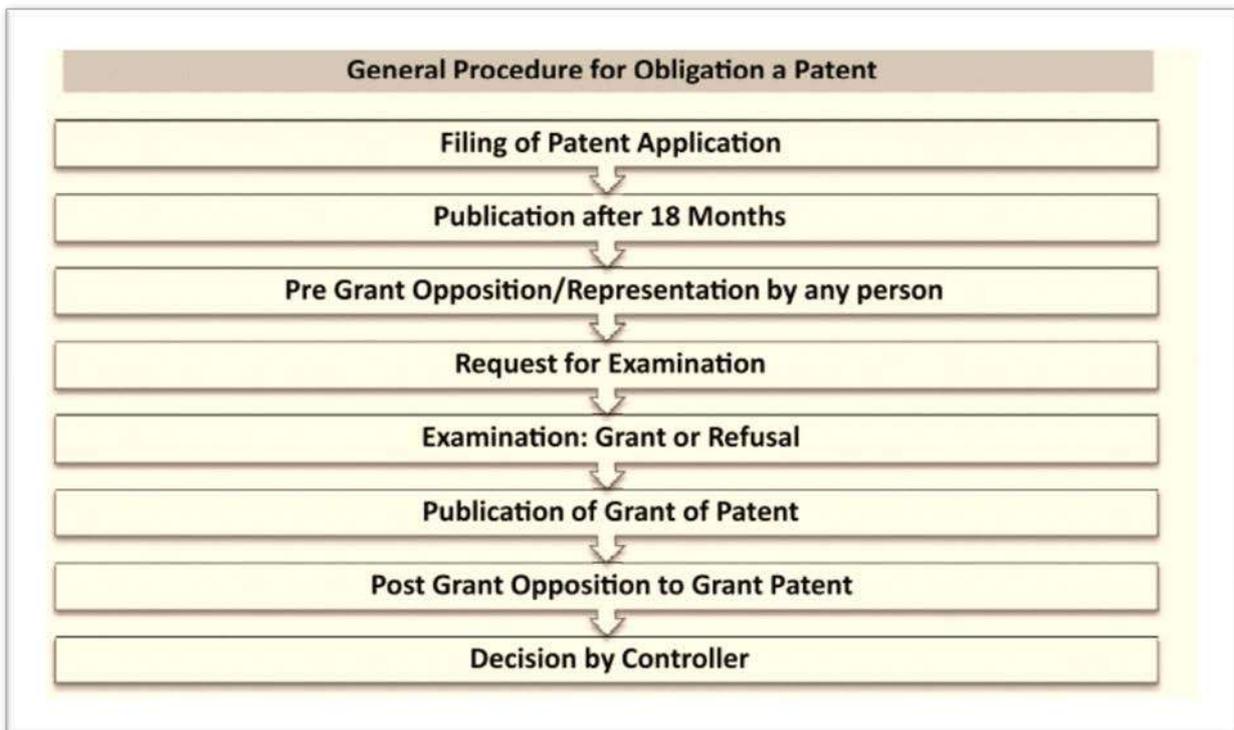
- It should be novel.
- It should have inventive step or it must be non-obvious.
- It should be capable of Industrial application.
- It should not attract the provisions of section 3 and 4 of the Patents Act, 1970.

Persons Entitled to make Application for Patent

Section 6 of the Act provides that an application for a patent for an invention may be made by any of the following persons, that is to say:

- a) by any person claiming to be the true and first inventor of the invention;
- b) by any person being the assignee of the person claiming to be the true and first inventor in respect of the right to make such an application;
- c) by the legal representative of any deceased person who immediately before his death was entitled to make such an application.

The application may be made by one of the persons either alone or jointly with any other person.



Form of Application

(1) Section 7 dealing with form of application requires every application for a patent to be made for one invention only.

(2) Where the application is made by virtue of an assignment of the right to apply for a patent for the invention, there shall be furnished with the application proof of the right to make the application.

(3) Every international application under the Patent Cooperation Treaty (PCT) for a patent, as may be filed designating India shall be deemed to be an application under the Act, if a corresponding application has also been filed before Controller in India.

(4) every such application, not being a convention application or an application filed under PCT designating India, shall be accompanied by a provisional or a complete specification.

Provisional & Complete Specification

Section 9 stipulates that where an application for a patent (not being a convention application or an application filed under PCT designating India) is accompanied by a provisional specification, a complete specification shall be filed within twelve months from the date of filing of the application, and if the complete specification is not so filed, the application shall be deemed to be abandoned.

Where two or more applications in the name of the same applicant are accompanied by provisional specifications in respect of inventions which are cognate or of which one is a modification of another and the Controller is of opinion that the whole of such inventions are such as to constitute a single invention and may properly be included in one patent, he may allow one complete specification to be filed in respect of all such provisional specifications.

However, the period of twelve months shall be reckoned from the date of filing of the earliest provisional specification.

Contents of Specifications

Section 10 dealing with contents of Specifications provides that every specification, whether provisional or complete, shall describe the invention and begin with a title sufficiently indicating the subject matter to which the invention relates.

Every complete specification is required to -

- a) fully and particularly describe the invention and its operation or use and the method by which it is to be performed;
- b) disclose the best method of performing the invention which is known to the applicant and for which he is entitled to claim protection;
- c) end with a claim or claims defining the scope of the invention for which protection is claimed; and

d) be accompanied by an abstract to provide technical information on the invention.

However, the Controller may amend the abstract for providing better information to third parties and if the applicant mentions a biological material in the specification which may not be described in such a way as to satisfy clauses (a) and (b) above and if such material is not available to the public, the application shall be completed by depositing the material to an International Depository Authority under the Budapest Treaty and by fulfilling the following conditions, namely:

- the deposit of the material shall be made not later than the date of filing the patent application in India and a reference thereof shall be made in the specification within the prescribed period;
- all the available characteristics of the material required for it to be correctly identified or indicated are included in the specification including the name, address of the depository institution and the date and number of the deposit of the material at the institution;
- access to the material is available in the depository institution only after the date of the application for patent in India or if a priority is claimed after the date of the priority;
- disclose the source and geographical origin of the biological material in the specification, when used in an invention.

How a Patent Specification is prepared? A patent specification can be prepared by the applicant himself or his registered and authorized agent. The patent specification generally comprises of the title of the invention indicating its technical field, prior art, drawbacks in the prior art, the solution provided by the inventor to obviate the drawbacks of the prior art, a concise but sufficient description of the invention and its usefulness, drawings (if any) and details of best method of its working. The complete specification must contain atleast one claim or statement of claims defining the scope of the invention for which protection is sought for.

Publication of Application

Section 11A Every application for patent is published after expiry of 18 months from the date of its filing or priority date whichever is earlier.

However, following applications are not published.

- a) Application in which secrecy direction is imposed.
- b) Application which has been abandoned u/s 9(1) and i.e., when a provisional application has been filed and the complete application has not been filed with 12 months from the filing of the provisional application.
- c) Application which has been withdrawn 3 months prior to 18 months.

The publication of every application shall include the particulars of the date of application, number of applications, name and address of the applicant identifying the application and an abstract.

On or from the date of publication of the application for patent and until the date of grant of a patent in respect of such application, the applicant shall have the like privileges and rights as if a patent for invention had been granted on the date of publication of application.

However, the applicant shall have no right to institute any proceedings for infringement until the patent has been granted.

Request for Examination [Section 11B]

No application for a patent shall be examined unless the applicant or any other interested person makes a request in the prescribed manner for such examination within the prescribed period.

In case the applicant or any other interested person does not make a request for examination of the application it shall be treated as withdrawn by the applicant.

Examination of Application [Section 12]

When the request for examination has been filed in respect of an application for a patent the application and specification and other documents related thereto shall be referred at the earliest by the Controller to an examiner for making a report to him in respect of the following matters, namely:

- a) whether the application and the specification and other documents relating thereto are in accordance with the requirements of the Act and of any rules made thereunder
- b) whether there is any lawful ground of objection to the grant of the patent in pursuance of the application;
- c) the result of investigations made under Section 13; and
- d) any other matter which may be prescribed.

The examiner to whom the application and the specification and other documents relating thereto are referred shall ordinarily make the report to the Controller within the prescribed period.

Search for Anticipation by Previous Publication and by Prior Claim [Section 13]

The examiner to whom the application for a patent is referred shall make investigation for the purpose of ascertaining whether the invention so far as claimed in any claim of the complete specification:

- a) has been anticipated by publication before the date of filing of the applicant's complete specification in any specification filed in pursuance of an application for a patent made in India
- b) is claimed in any claim of any other complete specification published on or after the date of filing of the applicant's complete specification, being a specification filed in pursuance of an application for a patent made in India and dated before or claiming the priority date earlier than that date.

Consideration of the Report of Examiner by Controller [Section 14]

In case the report of the examiner is adverse to the applicant and requires any amendment of the application, specification or other documents, the Controller shall, before proceeding to dispose of the application, communicate the gist of obligations to the applicant and afford him an opportunity of hearing.

Power of Controller to Refuse or Require Amended Application in Certain matters [Section 15]

the Controller refuse or to require the application, specification or other documents to be amended, if he is satisfied the application or any specification or any other document filed in pursuance thereof does not comply with the provisions of the Act and the rules made thereunder.

Power of Controller to make Orders Respecting Dating of Application and cases of Anticipation

Section 17 provides that at any time after the filing of an application and before the grant of the patent, the Controller may at the request of the applicant direct that the application shall be post-dated to such date as may be specified in the request and proceed with the application accordingly.

However, no application shall be post-dated to a date later than six months from the date on which it was actually made or would be deemed to have been made.

Powers of Controller in cases of anticipation

Section 18 says that where it appears to the Controller that the invention so far as claimed in any claim of the complete specification has been anticipated, he may refuse the application unless the applicant:

- a) shows to the satisfaction of the Controller that the priority date of the claim of his complete specification is not later than the date on which the relevant document was published; or
- b) amends his complete specification to the satisfaction of the Controller.

Potential Infringement [Section 19]

If, in consequence of the investigations required under this Act, it appears to the Controller that an invention in respect of which an application for a patent has been made cannot be performed without substantial risk of infringement of a claim of any other patent, he may direct that a reference to that other patent shall be inserted in the applicant's complete specification by way of notice to the public, unless within such time as may be prescribed -

- a) the applicant shows to the satisfaction of the Controller that there are reasonable grounds for contesting the validity of the said claim of the other patent; or
- b) the complete specification is amended to the satisfaction of the Controller.

Where, after a reference to another patent has been inserted in a complete specification in pursuance of a direction under sub-section (1) -

- a) that other patent is revoked or otherwise ceases to be in force; or
 - b) the specification of that other patent is amended by the deletion of the relevant claim; or
 - c) it is: found, in proceedings before the court or the Controller, that the relevant claim of that other patent is invalid or is not infringed by any working of the applicant's invention,
- the Controller may, on the application of the applicant, delete the reference to that other patent.

Substitution of Applicants [Section 20]

if the Controller is: satisfied on a claim made at any time before a patent has been granted that by virtue of any assignment or agreement or by operation of law, the claimant would, if the patent were then granted, be entitled thereto or to the interest of the applicant therein, or to an undivided share of the patent or of that interest, the Controller may direct that the application shall proceed in the name of the claimant or in the names of the claimants and the applicant or the other joint applicant or applicants.

No such direction shall however, be given by virtue of any assignment or agreement made by one of the two or more joint applicants for a patent except with the consent of the other joint applicant or applicants.

Further, no such direction shall be given unless:

- a) the invention is identified therein by reference to the number of the applications for the patent; or
- b) there is produced to the Controller an acknowledgement by the person by whom the assignment or agreement was made that the assignment or agreement relates to the invention in respect of which that application is made; or
- c) the rights of the claimant in respect of the invention have been finally established by the decision of court; or
- d) the Controller gives directions for enabling the application to proceed or for regulating the manner in which it should be proceeded

further it says that where one of two or more joint applicant for a patent dies, then with the consent of the legal representative of deceased, the controller may allow the application to proceed in the name of the survivor or survivors alone.

further it says that when there is dispute between the joint applicant for bringing a new applicant, then they can be filed for direction of controller and application proceed accordingly.

Time for Putting Application for Grant

Section 21 of the Act provides that an application for a patent shall be deemed to have been abandoned unless, the applicant has complied within the prescribed period with all the requirements imposed on him by or under the Act, whether in connection with the complete specification or otherwise in relation to the application from the date on which the first statement of objections to the application or complete specification or other documents related thereto is forwarded to the applicant by the Controller.

If at the expiration of the period as prescribed under sub section (1), -

- a) an appeal to the High Court is pending in respect of the application for the patent for the main invention; or
- b) in the case of an application for a patent of addition, an appeal to the High Court is pending in respect of either that application or the application for the main invention, the time within which the requirements of the Controller shall be complied with shall, on an

application made by the applicant before the expiration of the period as prescribed under sub-section (1), be extended until such date as the High Court may determine.

c) If the time within which the appeal mentioned in sub-section (2) may be instituted has not expired, the Controller may extend the period as prescribed under sub-section (1), to such further period as he may determine.

Provided that if an appeal has been filed during the said further period, and the High Court has granted any extension of time for complying with the requirements of the Controller, then the requirements may be complied with within the time granted by the Court.

Opposition to the Patent [Section 25]

Where an application for a patent has been published but a patent has not been granted OR at any time after the grant of patent but before the expiry of a period of one year from the date of publication of grant of a patent, may file an opposition on the following ground -

- 1. Wrongful obtainment:-** The Invention or any part thereof was wrongfully obtained from the opponent.
- 2. Prior publication:-** The invention was published before the priority date (earliest filing date which discloses the invention). This objection is subject to Section 29 of the Act, which talks about situations where the publication does not constitute an anticipation of the product or process.
- 3. Prior claim:-** The invention was previously claimed in another Indian patent application, which was published on or after the priority date of the applicant's claim but whose priority date is earlier than that of the applicant.
- 4. Prior knowledge or use:-** The invention is known or used by the public before the priority date. In the case of a process that is being patented, it is deemed to have been publicly known or used if a product made by that process was imported in India, before the first date of filing of the application.
- 5. Obviousness:-** The invention is obvious and does not involve any inventive step. This means that no advancements have been to the existing use or literature on the subject.
- 6. Non-patentable subject matter:-** The subject of the application is not considered to be an invention under the Patent Act or falls in the category of "non-patentable inventions".
- 7. Insufficient description:-** The patent specification does not properly explain the invention or the method of performing it.

8. Non-disclosure:- The applicant has failed to disclose all the details which were required under Section 8 of the Act.

9. False disclosure:- The applicant has provided materially false information.

10. Time limit:- The conventional application was not filed within the specified period of 12 months from the date of the first patent application made in conventional country.

11. Biological material:- The specification failed to disclose the origin or source of the biological material, if any, used in making the invention or has mentioned the incorrect source.

12. Traditional knowledge:- The invention was anticipated taking into consideration the knowledge possessed by indigenous communities anywhere in the world.

Constitution of Opposition board and its proceeding

Where any notice of opposition is duly given the Controller shall notify the patentee and constitute a Board by order in writing to be known as the Opposition Board and refer such notice of opposition along with the documents to that Board for examination and submission of its recommendation.

The Controller shall on receipt of the recommendation of the Opposition Board and after giving the patentee and the opponent an opportunity of being heard, order either to maintain or amend or revoke the patent.

Residents not to Apply for Patents Outside India Without Prior Permission

No person resident in India shall, except under the authority of a written permit sought in the prescribed manner and granted by or on behalf of the controller, make or cause to be made any application outside India for the grant of a patent for an invention unless an application for a patent for the same invention has been made in India, not less than six weeks before the application outside India and either no direction has been given under of section 35(1) in relation to the application in India, or all such directions have been revoked.

However, if the invention is relevant for defense purpose or atomic energy, the Controller shall not grant permit without the prior consent of the Central Government.

Grant of Patents

The grant of a patent shall be subject to the conditions that:

- any machine, apparatus or other article in respect of which the patent is granted or any article made by using a process in respect of which the patent is granted, may be imported or made by or on behalf of the Government for the purpose merely of its own use;

- any process in respect of which the patent is granted may be used by or on behalf of the Government for the purpose merely of its own use;
- any machine, apparatus or other article in respect of which the patent is granted or any article made by the use of the process in respect of which the patent is granted, may be made or used, and any process in respect of which the patent is granted may be used by any person, for the purpose merely of experiment or research including the imparting of instructions to pupils; and
- in the case of a patent in respect of any medicine or drug, the medicine or drug may be imported by the Government for the purpose merely of its own use or for distribution in any dispensary, hospital or other medical institution maintained by or on behalf of the Government or any other dispensary, hospital or other medical institution which the Central Government may, having regard to the public service that such dispensary, hospital or medical institution renders, specify in this behalf by notification in the Official Gazette.

Rights of Patentees

- where the subject matter of the patent is a product, the exclusive right to prevent third parties, who do not have his consent, from the act of making, using, offering for sale, selling or importing for those purposes that product in India;
- where the subject matter of the patent is a process, the exclusive right to prevent third parties, who do not have his consent, from the act of using that process, and from the act of using, offering for sale, selling or importing for those purposes the product obtained directly by that process in India.

Term of Patent

The term of every patent granted is 20 years from the date of filing of application.

However, for application filed under national phase under Patent Cooperation Treaty (PCT), the term of patent will be 20 years from the international filing date accorded under PCT.

Patents of Addition

- If an applicant feels that he has come upon modification or improvement of an already patented invention, another application can be made for a patent of addition in respect to such improvement or modification. Such an application may be granted by the controller as a patent of addition.
- patent of addition is granted for a term equal to that of the patent for the main invention or so much thereof as has not expired and remains in force during that term or until the previous cessor of the patent for the main invention and no longer.

- A patent of addition application cannot be rejected on the grounds that the disclosure in the primary application or patent lacked innovative step. However, the disclosure in the main application or patent may be used as evidence of innovation against the patent addition application.

Restoration of Lapsed Patents

A patent which ceased to have effect because of a failure in payment of the prescribed fees within the period.

The Patentee, or the legal representative of Patentee or where the Patent is held by two or more persons jointly, then with the permission of the Controller of Patent, one or more of the joint owners or without joining others can submit an application for Restoration of Lapsed Patent in India within 18 months from the date on which the Patent ceases to have effect.

Procedure for Disposal of applications for restoration of lapsed patents

- (1) If, after hearing the applicant in cases when the Controller should be initially convinced that the failure to pay the restoration fee was accidental and there had been no unnecessary delay, the request for restoration will be issued in the official journal.
- (2) If the Controller is satisfied that the restoration has not been made, the Controller may issue a notice to the application to that effect.
- (3) Notice of Opposition can be submitted in the prescribed manner to the application within 2 months of the date of publication in the official journal.
- (4) If no notice of opposition is given within the prescribed period aforesaid or if in the case of opposition; the decision of the Controller is in favour of the applicant, the Controller shall, upon payment of any unpaid renewal fee and such additional fee as may be prescribed, to the patent and any patent of addition specified in the application which has ceased to have effect on the cesser of that patent.

Rights of Patentees of Lapsed Patents which have been Restored

After the restoration of the lapsed patent, the patent holder's rights shall be regulated by the provision as the Controller thinks fit for the protection of benefit of persons who might have started to avail them.

Surrender and Revocation of Patents

Section 63 entitles the patentee to offer to surrender his patent, at any time by giving notice to the Controller.

Where such an offer is made, the Controller shall publish the offer in the prescribed manner and also notify every person other than the patentee whose name appears in the register as having an interest in the patent.

If the Controller is satisfied after hearing the patentee and any opponent, if desirous of being heard, that the patent may properly be surrendered, he may accept the offer and by order revoke the patent.

Grounds for Revocation of Patents

- where an invention as claimed in a valid claim of earlier priority date which is included in the complete specification of another patent granted in India;
- where the patent application was filed by a person who is not entitled under the provisions of the Act and was granted a patent on such application;
- where the patent was wrongfully obtained and the rights of the petitioner or any person under/through whom he claims, were contravened;
- when the subject of a claim of the complete specification is not an invention within the meaning of the Act;
- where the patent was wrongfully obtained and the rights of the petitioner or any person under/through whom he claims, were contravened;
- when the subject of a claim of the complete specification is not an invention within the meaning of the Act;
- where the scope of any claim is not defined properly or based on the matter which has not been disclosed in the specification;
- where a false suggestion or representation was made to obtain the patent;
- where the subject of any claim of the complete specification is not patentable under the Act;
- the invention that is being claimed was secretly used in India before the priority date of the claim;
- the complete specification does not disclose or mention the wrong source or geographical origin of biological material used for the invention;
- the invention was anticipated having regard to the knowledge which was available within any local or indigenous community within India or elsewhere.
- where any direction of secrecy passed under Section 35 has been contravened by the applicant or made an application in contravention of Section 39 for the grant of a patent outside India;
- where the permission to amend the complete specification under Section 57 or 58 was obtained by fraud;

Working of Patented Inventions - General Principles

Section 83 dealing with general principles applicable to workings of patented invention: -

- (1) that patents are granted to encourage invention and to secure that the invention are worked in India on a commercial scale and to the fullest extent that is reasonably practicable without undue delay;
- (2) that they are not granted merely to enable patentees to enjoy monopoly for the importation, of the patented article;
- (3) that the protection and enforcement of patent rights contribute to the promotion of technological innovation and to the transfer and dissemination of technology, to the mutual advantage of producers and users of technological knowledge and in a manner conducive to social and economic welfare, and to a balance of rights and obligations;
- (4) that patent granted do not impede protection of public health and nutrition and should act as instrument to promote public interest specially in sectors of vital importance for socio-economic and technological development of India;
- (5) that patent granted do not in any way prohibit Central government in taking measures to protect public health;
- (6) that the patent rights is not abused by the patentee or person deriving title or interest on patent from the patentee, and the patentee or a person deriving title or interest on patent from the patentee does not resort to practices which unreasonably restrain trade or adversely affect the international transfer of technology; and
- (7) that patents are granted to make the benefit of the patented invention available at reasonably affordable prices to the public.

Compulsory Licences

Compulsory licences are authorizations given to a third party by the Controller general to make, use or sell a particular product or use a particular process which has been patented, without the need of the permission of the patent owner.

According to Section 84, any person regardless of whether he is the holder of the patent's licence, can apply to the Controller for a compulsory licence after three years if any of the following condition are satisfied:

- the reasonable requirements of the public with respect to the patented invention have not been satisfied
- the patented invention is not available to the public at a reasonably affordable price
- the patented invention is not worked in the territory of India.

Requirement of Applications for Compulsory Licences

Every application must include a statement describing the nature of the applicant's interest, as well as any other information that may be required, such as the facts on which the application is based. If the controller is satisfied, he has the authority to order the patentee to grant a licence on the terms he sees proper.

Factors to be Taken into Account While Granting Compulsory Licences

The controller must consider the following elements when making a decision on an application for a compulsory license:

- the nature of the invention, the time which has elapsed since the sealing of the patent and the measures already taken by the patentee or any licensee to make full use of the invention;
- the ability of the applicant to work the invention to the public advantage;
- the capacity of the applicant to undertake the risk in providing capital and working the invention, if the application were granted;
- as to whether the applicant has made efforts to obtain a licence from the patentee on reasonable terms and conditions and such efforts have not been successful within a reasonable period **[not exceeding 6 months]** as the Controller may deem fit.

It may be noted that above stated point (i) to (iv) shall not be applicable in case of national emergency or other circumstances of extreme urgency or in case of public non-commercial use or on establishment of a ground of anticompetitive practices adopted by the patentee.

The reasonable requirements of the public shall be deemed not to have been satisfied if -

a) by reason of the refusal of the patentee to grant a licence or licences on reasonable terms, -

- an existing trade or industry or the development thereof or the establishment of any new trade or industry in India
- the demand for the patented article has not been met to an adequate extent or on reasonable terms; or
- a market for export of the patented article manufactured in India is not being supplied or developed; or
- the establishment or development of commercial activities in India is prejudiced; or

b) by reason of conditions imposed by the patentee upon the grant of licences under the patent or upon the purchase, hire or use of the patented article or process, the

manufacture, use or sale of materials not protected by the patent, or the establishment or development of any trade or industry in India, is prejudiced; or

c) the patentee imposes a condition upon the grant of licences under the patent to provide exclusive grant back, prevention to challenges to the validity of patent or coercive package licensing; or

d) the patented invention is not being worked in the territory of India on a commercial scale to an adequate extent or is not being so worked to the fullest extent that is reasonably practicable; or

e) the working of the patented invention in the territory of India on a commercial scale is being prevented or hindered by the importation from abroad of the patented article by -

- the patentee or person claiming under him; or
- persons directly or indirectly purchasing from him; or
- other persons against whom the patentee is not taking or has not taken proceedings for infringement.

Revocation of Patents by the Controller for Non-working [Section 85]

- Where a compulsory licence has been granted in respect of a patent, the Central Government or any person interested may apply to the Controller for an order revoking the patent after two years from the date of the order granting the first compulsory licence on the grounds that the reasonable requirements of the community with respect to the patented product have not been satisfied or that the patented invention is not worked in the territory of India or is not available at affordable price.
- The applicant bears the burden of proving that the patented product is not being used to its fullest extent possible.

Powers of Controller in Granting Compulsory Licences [Section 88]

If the Controller is satisfied on receipt of an application that conditions imposed by the patentee on the grant of licenses under the patent, or on the purchase, hire, or use of the patented article or process, are prejudicing the manufacture, use, or sale of materials not protected by the patent, he may, subject to the provisions of the Patents Act' 1970, order the grant of licenses under the patent to such customers of the applicant as he thinks fit, as well as to the applicant.

Termination of Compulsory License

Section 94 provides that on an application made by the patentee or any other person deriving title or interest in the patent, a compulsory license may be terminated by the Controller,

provided the circumstances that give rise to the grant thereof no longer exist and such circumstances are unlikely to recur. In this regard the holder of the compulsory license has been entitled to object to such termination.

International Arrangements

Who is a Convention Country?

Any country which is a signatory or party or a group of countries, union of countries or intergovernmental organizations which are signatories or parties to an international, regional or bi-lateral treaty, convention or arrangement to which India is also a signatory or party and which afford to the applicants for patents in India or to citizens of India similar privilege are granted to their own citizens or citizens to their member countries in respect of the grant of patents and protection of patent rights shall be a convention country or convention countries.

Where any country notified by the central Government as Convention country does not accord citizens of India the same right in respect of the grant of patents and protection of patent rights as it accords to its own nationals, shall be entitled solely or jointly with any other person.

- a) to apply for the grant of a patent or be registered as the proprietor of a patent;
- b) to be registered as the assignee of the proprietor of a patent; or
- c) to apply for a license or hold any license under a patent granted under the Act.

Convention Application

- where a person has made an application for a patent in respect of an invention in a convention country (basic application) and that person or legal representative or assignee of that person makes an application under the Act for a patent within twelve months after the date on which the basic application was made, the priority date of a claim of the complete specification being a claim based on matter disclosed in the basic application, is the date of making, of the basic application.
- where applications have been made for similar protection in respect of an invention in two or more convention countries, the period of twelve months shall be reckoned from the date on which the earlier or earliest of the said applications was made.

Requirement: for a Convention Application

Section 136 of the Patents Act, 1970, prescribes: special provisions with respect to convention application. Every convention application should be accompanied by:

- a complete specification;

- *an abstract;*
- *specify the date and the convention country in which the application for protection was made;*
- *state that no application for protection in respect of the invention had been made in a 'convention country' before that date by the applicant or by any person from whom he derives title.*

The complete specification filed with a convention application may include claims in respect of development or additions to the invention in respect of which the application for protection was made in a Convention country.

Section 138 require the applicant of a convention application to furnish, in addition to the complete specification, copies of the specification or corresponding document filed or deposited by the applicant in the patent office of the convention country and verified to the satisfaction of the Controller within the prescribed period from the date of communication by the Controller.

If any such specification or other document is in a foreign language, a translation into English of the specification or document verified by affidavit or otherwise to the satisfaction of the Controller are required to be furnished.

Patent Agent

The work relating to drawing of specifications, making of application for a patent, subsequent correspondence with the Patent office on the objections raised, representing the applicant's case at the hearings, filing opposition and defending application against opposition is entrusted to a qualified Patent Agent.

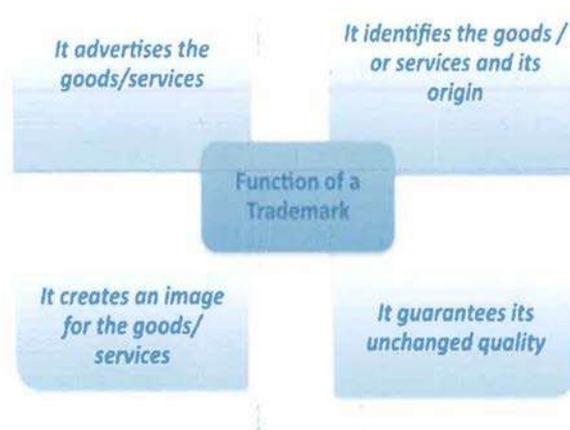
Space for Notes

LESSON 3

LAW RELATING TO TRADEMARKS

Introduction

- Trademarks Act, 1999 is an Act to amend and consolidate the law relating to trademarks, to provide for registration and better protection of trademarks for goods and services and for the prevention of the use of fraudulent marks. It extends to the whole of India.
- The current law of Trademarks contained in the Trademarks Act, 1999 is in harmony with two major international treaties on the subject, namely The Paris Convention for Protection of Industrial Property and TRIPS Agreement to both of which India is a signatory.



Trademark

A trademark (popularly known as brand name) is a visual symbol which may be a word signature, name, device, label, numerals, or combination of colours used by one undertaking on goods or services or other articles of commerce distinguish it from other similar goods or services originating from a different undertaking.

The essential requirements to register a trademark under the Act are:

- Selected mark should be capable of being presented graphically.
- It should be capable of being distinguishing the goods or services of one undertaking from those of others.
- It should be used or proposed to be used as mark in relation to goods and services so as to indicate a connection in the course of trade and some persons have right to use that mark with or without identity of that person.

Certification Trademark

Certification trademark as to mean a mark capable of distinguishing the goods or services in connection with which it is used in the course of trade which are certified by the

proprietor of the mark in respect of origin, material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics from goods or services not so certified and registerable as such.

Permitted Use of Trademark

The use of trademark is permitted -

a) by a registered user of the trademark in relation to goods or services -

- with which he is connected in the course of trade. and
- in respect of which the trademark remains registered for the time being. and
- for which he is registered as registered user. and
- which complies with any conditions or limitations to which the registration of registered user is subject. or

b) by a person other than the registered proprietor and registered user in relation to goods or services

- with which he is connected in the course of trade. and
- In respect of which the trademark remains registered for the time being. and
- by consent of such registered proprietor in a written agreement. and
- which complies with any conditions or limitations to which such user is subject and to which the registration of the trademark is subject.

Who can apply for a Trademark and How?

Any person, claiming to be the proprietor of a trademark used or proposed to be used by him, may apply in writing in prescribed manner for registration. The application should contain the trademark, the goods / services, name and address of applicant and agent (if any) with power of attorney, the period of use of the mark.

The applications can be submitted personally at the Front Office Counter of the respective office or can be sent by post. These can also be filed on line through the e - filing gateway available at the official website.

What are different types of Trademarks that may be Registered in India?

- Any name (including personal or surname of the applicant or predecessor in business or the signature of the person), which is not unusual for trade to adopt as a mark.
- An invented word or any arbitrary dictionary word or words, not being directly descriptive of the character or quality of the goods / service.
- Letters or numerals or any combination thereof.
- The right to proprietorship of a trademark may be acquired by either registration under the Act or by use in relation to particular goods or service.
- Combination of colours or even a single colour in combination with a word or device

- Monograms.
- Shape of goods or their packaging.
- Markes constituting a three - dimensional sign.
- Sound marks when represented in conventional notation or described in words by being graphically represented.

Procedure for Registration [Section 18]

- Any person claiming to be the Proprietor of a trademark used or proposed to be used by him, who is desirous of registering it, shall apply in writing to the Registrar in the prescribed manner for the registration of his trademark.
- Allows registration in several classes of goods or services by means of a single application.
- However, the fee payable is to be calculated on the basis of the number of classes in which registration is sought.

Section 23 places obligation on the Registrar to register the trademark where the procedure for registration of a trademark has been completed viz., the application has been accepted and either the application has not been opposed or the opposition has been dismissed.

Processing of TM Application in Trademark Registry

At present processing of Trademark application is done completely through TM electronic processing System and filing of application is allowed in hybrid mode, i.e., online as well as offline.

A brief description of stage wise processing ' in Trademark Registration is ac follows -

Pre - Examination Processing:

Filing of application: A Trademark Application may be filed online or offline. both online and offline applications are merged and proceed further for processing through the Trademark system.

VIENNA Codification: If applied mark consists of figurative elements, codification of the figurative elements is done as per VIENNA Agreement and then application moves for examination.

Examination of Applications:

Examination in Trademark Registration is done in two stages, first examination report is prepared by an Examiner and then the application and examination report are forwarded to Examination Controller for approval.

Examination Controller evaluates the examination report, and if found proper, approves it and thereafter the examination report is issued to applicant. However, if some deficiency is noted by the Controller, the examination report is reverted / referred back to the concerned Examiner with suggestions for resubmission / re - examination.

Show - cause hearing: In case the objection / s raised by the office are not met after consideration of reply to the examination report, the application moves for show cause hearing.

Post Advertisement Processing:

In case it is accepted, it will be published in Trademark Journal, else examination report will be issued to the applicant containing office objections which needs to be replied by the applicant within 30 days from the date of receipt of examination report.

Consideration of Reply: - After receipt of examination report, applicant needs to submit his reply to the office objections within one month time and if he fails to do so, the application is abandoned for want of reply. If reply is submitted the same is considered by the authorized officers through the Trademark system serially and may accept application and the same is to be published in the Trademark Journal.

After the acceptance of the mark, trademark is published in Trademark Journal. If no opposition is filed within 4 months from the date of publication of the trademark, the published trademark becomes eligible for registration and registration certificate is issued automatically through Trademark System.

The Trademark once registered is valid for 10 years and can be renewed after every 10 years for an indefinite period.

Opposition:

If the trademark is opposed by any third party after the publication, the same needs to be disposed of as per rules after giving proper hearing opportunity to both the parties. If the opposition is dismissed, the trademark proceeds for registration and registration certificate is issued to the applicant. In case opposition is allowed, the application gets refused as per law.

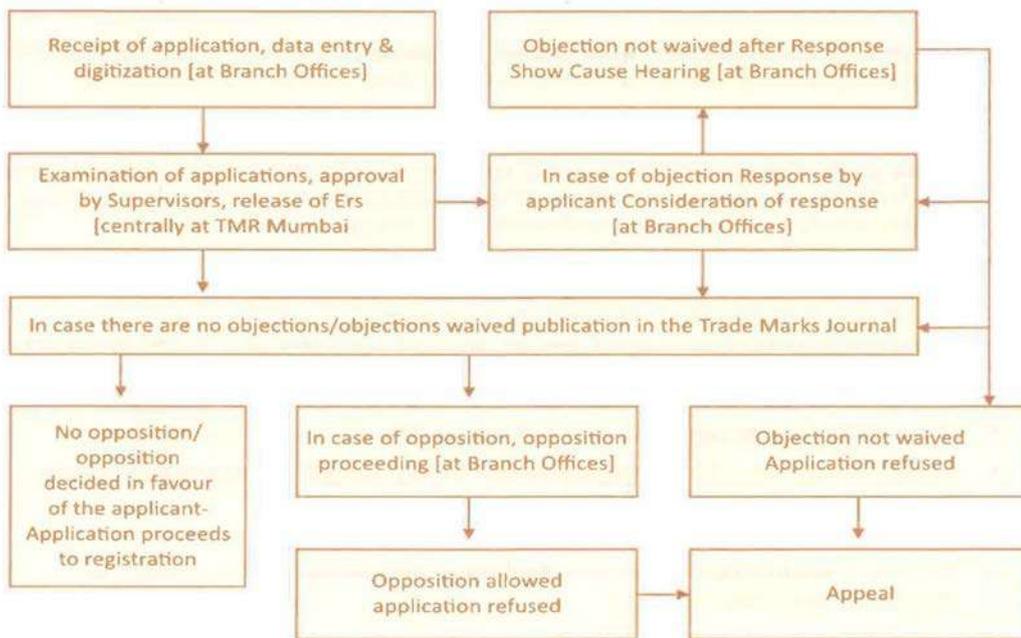
Post Registration Trademark Management

It is possible for the registered proprietor to record the post registration changes pertaining to proprietor name, address, address for service, assignment or registered user, etc. In the Register of Trademarks by filing a request on the prescribed form, with the prescribed fee.

In case the concerned officer examining the request raises some objections and requires some compliance on part of the applicant, the same should be processed ordinarily within 30 days from the date of compliance by the applicant.

It is also a practice of Registry to send one month notice to previous registered proprietor in case any change in proprietorship by way of assignment or transmission is filed by the applicant.

Trademark Registration Workflow Chart



What are the Benefits of Registering a Trademark?

- The registration of a trademark confers upon the owner the exclusive right to the use the trademark in relation to the goods or services in respect of which the mark is registered and to indicate so by using the symbol (R), and seek the relief of Infringement in appropriate courts in the country.
- The exclusive right is however subject to any conditions entered on the register such as limitation of area of use etc.
- Also, where two or more persons have registered identical or nearly similar marks due to special circumstances, such exclusive right does not operate against each other

Absolute grounds for Refusal of Registration [Section 9]

absolute grounds for refusal for registration prohibit the registration of those trademarks

- which are devoid of any distinctive character, that is to say, not capable of distinguishing the goods or services of one person from those of another person.
- which consist exclusively of marks or indications which have become customary in the current language or in the bona fide and practices of the trade, shall not be registered: established However, a trademark shall not be refused registration, if the mark has in fact acquired a distinctive character as a result of use or is a well-known trademark before the date of application.
- If the trademark tends to deceive the public or cause any confusion.
- In any instance if the trademark hurts any religious sentiment of any demographic section of Indian citizens.
- it comprises or contains scandalous or obscene matter.
- Its use is prohibited under the Emblems and Names (Prevention of Improper Use) Act, 1950.

Limitation as to Colour

Section 10 provides that a trademark may be limited wholly or in part to any combination of colours and any such limitation shall be taken into consideration by the Registrar or the High Court, as the case may be having to decide on the distinctive character of the trademark.

Relative grounds for Refusal of Registration [Section 11]

Section 11 (1) stipulates that a trademark shall not be registered if, because of

- a) Trademarks which confuse the public, as it is identical with an earlier similar trademark of goods or services.
- b) Trademarks which confuse the public, as it is similar with an earlier identical trademark of goods or services.

Section 11 (2) states the following grounds for refusal -

Trademarks which would take unfair advantage of a similar or identical earlier well - known trademark in India.

Trademarks which would be detrimental to the distinctive character or repute of a similar or identical earlier well - known trademark in India.

Section 11 (3) provides that a trademark shall not be registered if, or to the extent that, its use in India is liable to be prevented —

- a) by virtue of any law in particular the law of passing off protecting an unregistered trademark used in the course of trade. or

b) by virtue of law of copyright.

Section 11 (4) states that nothing in this section shall prevent the registration of a trademark where the proprietor of the earlier trademark or other earlier right consents to the registration, and in such case the Registrar may register the mark under special circumstances under section 12.

Recognition of well Registered Trademark

As per Section 11 (6) of the Act, the Registrar shall, while determining whether a trademark is a well - known trademark, take into account any fact which he considers relevant for determining a trademark as a well - known trademark including -

- a) the knowledge or recognition of that trademark in the relevant section of the public, including knowledge in India
- b) the duration, extent, and geographical area of any use of that trademark.
- c) the duration, extent and geographical area of any promotion of the trademark, including advertising or publicity and presentation, at fairs or exhibition of the goods or services to which the trademark applies.
- d) the duration and geographical area of any registration of or any application for registration of that trademark
- e) the record of successful enforcement of the rights in that trademark, in particular the extent to which the trademark has been recognised as a well - known trademark by any court or Registrar under that record.

Section 11 (7) provides that the Registrar shall, while determining as to whether a trademark is known or recognised in a relevant section of the public for the purposes of sub - section (6), take into account -

- a) the number of actual or potential consumers of the goods or services.
 - b) the number of persons involved in the channels of distribution of the goods or services.
 - c) the business circles dealing with the goods or services. to which that trademark applies.
- The Registrar shall not require as a condition, for determining whether a trademark is a well - known trademark, any of the following, namely:

- that the trademark has been used in India.
- that the trademark has been registered.
- that the application for registration of the trademark has been filed in India.
- that the trademark

- a) is well - known in. or
- b) has been registered in.

c) in respect of which an application for registration has been filed in, any jurisdiction other than India, or

- that the trademark is well - known to the public at large in India.

Prohibition of Registration of Names of Chemical Elements or International Non - Proprietary Names

Section 13 states that no word, shall be registered as a trademark if -

- a) which is the commonly used and accepted name of any single chemical element or any single chemical compound in respect of a chemical substance or preparation, or
- b) which is declared by the World Health Organisation and notified in the prescribed manner by the Registrar from time to time, as an international non - proprietary name or which is deceptively similar to such name.

Use of Names and Representations of Living Persons or Persons Recently Dead

Where an application is made for the registration of a Trademarks which falsely suggest a connection with any living person can be declined registration by the Registrar unless the consent of such living person is obtained.

Similarly, trademarks which falsely suggest a connection with any dead person within twenty years of submitting the application for registration can be declined by the Registrar unless the consent of legal representatives of such person is obtained.

Withdrawal of Acceptance

Section 19 provides that where, after the acceptance of an application for registration of a trademark but before its registration, the Registrar is satisfied -

- a) that the application has been accepted in error. or
- b) that in the circumstances of the case the trademark should not be registered or should be registered subject to conditions or limitations or to conditions additional to or different from the conditions or limitations subject to which the application has been accepted, the Registrar may, after hearing the applicant if he so desires, withdraw the acceptance, and proceed as if the application had not been accepted.

Advertisement of Application

once the Registrar for registration has accepted the application, he shall get the application advertised in the prescribed manner after acceptance.

The purpose of advertisement is to give information to the public at large in respect of the trademark advertised and afford an opportunity to oppose the registration of the mark on given grounds.

Registration [Section 23]

when an application for registration of a trademark has been accepted and either: -

- a) the application has not been opposed and the time for notice of opposition has expired.
- or
- b) the application has been opposed and the opposition has been decided in favour of the applicant,

The Registrar shall, unless the Central Government otherwise directs, register the said trademark within eighteen months of the filing of the application and the trademark when registered shall be registered as of the date of the making of the said application and that date shall, subject to the provisions of section 154, be deemed to be the date of registration.

On the registration of a trademark, the Registrar shall issue to the applicant a certificate in the prescribed form of the registration thereof, sealed with the seal of the Trademarks Registry.

Can a Registered Trademark be Removed from the Register?

It can be removed on application to the Registrar on prescribed form on the ground that the mark is wrongly remaining on the register.

The Registrar also can Suo moto issue Notice for removal of a registered trademark.

Infringement of Registered Trademarks [Section 29]

A registered trademark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which is identical with, or deceptively similar to, the trademark in relation to goods or services in respect of which the trademark is registered and, in such manner, as to render the use of the mark likely to be taken as being used as a trademark.

a registered trademark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which because of -

- its identity with the registered trademark and the similarity of the goods or services covered by such registered trademark. or

- its similarity to the registered trademark and the identity or similarity of the goods or services covered by such registered trademark.
- its identity with the registered trademark and the identity of the goods or services covered by such registered trademark, is likely to cause confusion on the part of the public or is likely to have an association with the registered trademark.
- is used in relation to goods or services which are not similar to those for which the trademark is registered. and
- the registered trademark has a reputation in India and the use of the mark without due cause takes unfair advantage of or is detrimental to, the distinctive character or repute of the registered trademark.

or a person uses a registered mark, if, in particular, he: -

- affixes it to goods or the packaging therefore,
- offers or exposes goods for sale, puts them on the market, or stocks them for those purposes under the registered trademark, or offers or supplies services under the registered trademark.
- is identical with or similar to the registered trademark. and
- imports or exports goods under the mark. or
- uses the registered trademark on business papers or in advertising.

a registered trademark is infringed by any advertising of that trademark such advertising: -

- takes unfair advantage of and is contrary to honest practices in industrial or commercial matters. or
- is detrimental to its distinctive character. or
- is against the reputation of the trademark.

Limits on Effect of Registered Trademark [Section 30]

This section explicitly states that nothing in section 29 shall be construed as preventing the use of a registered trademark by any person for the purposes of identifying goods or services as those of the proprietor provided the use -

a) is in accordance with honest practices in industrial or commercial matters, and

b) is not such as to take unfair advantage of or be detrimental to the distinctive character or repute of the trademark.

A registered trademark is not infringed where —

a) **the use in relation to goods or services** indicates the kind , quality , quantity , intended purpose , value , geographical origin , the time of production of goods or of rendering of services or other characteristics of goods or services.

b) **a trademark is registered subject to any conditions or limitations** , the use of the trademark in any manner in relation to goods to be sold or otherwise traded in , in any place , or in relation to goods to be exported to any market or in relation to services for use or available for acceptance in any place or country outside India or in any other circumstances , to which , having regard to those conditions or limitations , the registration does not extend.

c) **the use by a person of a trademark**

- in relation to goods connected in the course of trade with the proprietor or a registered user of the trademark if , as to those goods or a bulk of which they form part , the registered proprietor or the registered user conforming to the permitted use has applied the trademark and has not subsequently removed or obliterated it , or has at any time expressly or impliedly consented to the use of the trademark. or
- In relation to services to which the proprietor of such mark or of a registered user conforming to the permitted use has applied the mark, where the purpose and effect of the use of the mark is to indicate , in accordance with the fact , that those services have been performed by the proprietor or a registered user of the mark.

d) **the use of a trademark by a person in relation** to goods adapted to form part of , or to be accessory to , other goods or services in relation to which the trademark has been used without infringement of the right given by registration under this Act or might for the time being be so used , if the use of the trademark is reasonably necessary in order to indicate that the goods or services are so adapted , and neither the purpose nor the effect of the use of the trademark is to indicate , otherwise than in accordance with the fact , a connection in the course of trade between any person and the goods or services , as the case may be.

e) **the use of a registered trademark**, being one of two or more trademarks registered under this Act which are identical or nearly resemble each other, in exercise of the right to the use of that trademark given by registration under this Act.

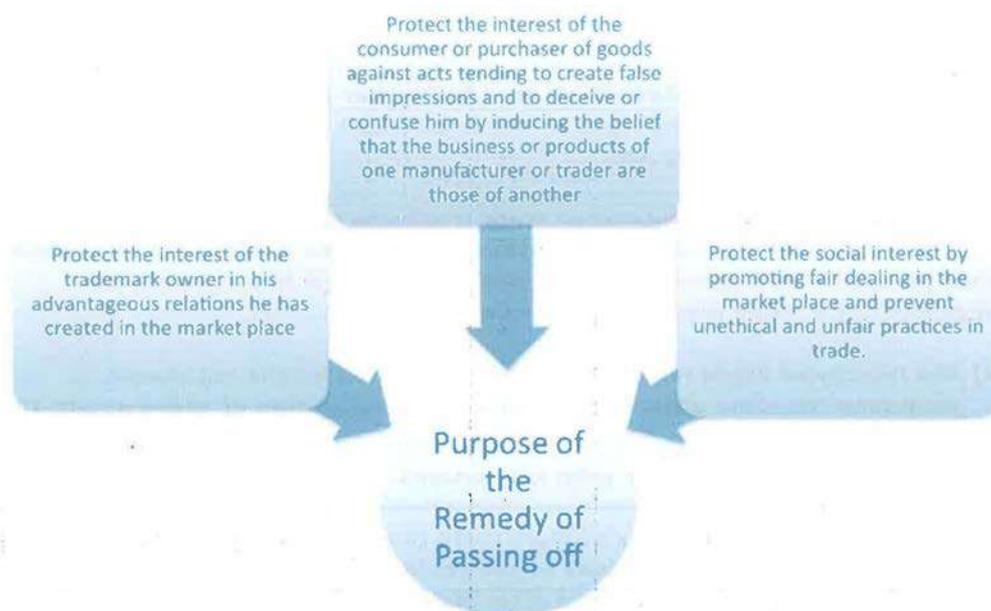
where the goods bearing a registered trademark are lawfully acquired by a person, the sale of the goods in the market or otherwise dealing in those goods by that person or by a person claiming under or through him is not infringement of a trademark by reason only of -

a) the registered trademark having been assigned by the registered proprietor to some other person, after the acquisition of those goods. or b) the goods having been put on the market under the registered trademark by the proprietor or with his consent.

It shall not apply where there exist legitimate reasons for the proprietor to oppose further dealings in the goods in particular, where the condition of the goods, has been changed or impaired after they have been put on the market.

" The act or an instance falsely representing one's own product as that of another in an attempt to deceive potential buyers. Passing off is actionable in tort under the law of unfair competition. It may be actionable as trademark infringement "

The tort of passing off is based upon the principle that " no man is entitled to represent his goods as being the goods of another man. and no man is required to use any mark, sign or symbol , device or means , whereby without making a direct representation himself to a purchaser who purchases from him , he enables such purchaser to tell a lie or to make a false representation to somebody else who is the ultimate purchaser. "



Registration to be Prima Facie Evidence of validity.

Section 31 of the Act stipulates that in all legal proceedings relating to a trademark registered under the Act, the original registration and all subsequent assignments and transmission thereof shall be prima facie evidence of its validity.

However, as per Section 34 the proprietor or a registered user of a registered trademark is not entitled to interfere with or restrain the use by any person of a trademark identical with or nearly resembling it in relation to goods or services in relation to which that person or a predecessor in title of his has continuously used that trademark from a prior date.

Therefore, in case of unregistered marks, the owner of the trademark may lodge a case against passing off action in case his trademark is used by some other person.

Assignment and Transmission

A mark may be assigned or transferred to another entity in any of the following manner:

- the registered proprietor of a trademark to assign the trademark and to give effectual receipts for any consideration for such assignment.
- the assignability and transmissibility of a registered trademark with or without goodwill of the business either in respect of all goods or services or part thereof.
- unregistered trademark may be assigned or transmitted with or without the goodwill of the business concerned.

Restriction on Assignment or Transmission:

A Trademark is not assignable or transmissible in a case in which as a result of the assignment or transmission there would subsist exclusive rights in more than one of the persons concerned, to use of trademark, nearly resembling each other or identical trademark which is likely to deceive or cause confusion, in relation to.

- Same goods or services.
- Same description of goods or services. or
- Goods or services or description of goods or services which are associated with each other.

Of trademarks nearly resembling each other or of identical trademark, if having regard to the similarity of the goods and services and to the similarity of the trademarks, the use of the trademarks in exercise of those rights would be likely to deceive or cause confusion.

However, such assignment is not deemed to be invalid, if having regard to the limitations imposed, the goods are to be sold in different markets - either within India 'or through exports.

Removal of Trademark for Non-use.

Section 47 deals with removal of a trademark from the register on the ground of non-use and provides that a trademark which is not used within five years of its registration, becomes liable for removal either completely or in respect of those goods or services for which the mark has not been used.

Register of Trademarks

The maintenance of a single Register of Trademarks at Head Office including therein particulars of registered trademarks and other prescribed particulars, except notice of trust. A copy of the Register is to be kept at each branch office.

The register of trademark currently maintained in electronic form contains inter alia the trademark the class and goods/ services in respect of which it is registered including particulars affecting the scope of registration of rights conferred. the address of the proprietors. particulars of trade or other description of the proprietor. the convention application date (if applicable). where a trademark has been registered with the consent of proprietor of an earlier mark or earlier rights, that fact.

Classification of goods and Services and Publication of Index

Classification of goods and service for the purpose of registration of trademark, the goods and services shall be classified as per current edition of "the International Classification of goods and services (NICE classification)" published by the World Intellectual Property Organization (WIPO). The Registrar shall publish a class wise and an alphabetical index of such goods and services, including goods and services of Indian origin.

Trademark Agent

Under the Trademarks Act, any act, other than the making of an affidavit, is required to be done before the Registrar by any person, the act may, be done instead of by that person himself, by a person duly authorised in the prescribed manner, who is —

- a legal practitioner, or
- a person registered in the prescribed manner as a trademark's agent, or
- a person in the sole and regular employment of the principal.

Qualification for Registration

a person shall be qualified to be registered as a trademark agent if he—

- is a citizen of India, e is not less than 21 years of age.
- is a graduate of any university in India or possesses an equivalent qualification and has passed the examination prescribed in rule 148 or is an Advocate within the meaning of the Advocates Act, 1961 or is a member of the ICSI.
- is considered by the Registrar as a fit and proper person to be registered as a trademark agent. Every person desiring to be registered as a trademarks agent shall make an application in Form TM-G. The applicant shall furnish such further information bearing on his application as may be required of him at any time by the Registrar.

Space for Notes

LESSON 4

LAW RELATING TO COPYRIGHT

Introduction

The Copyright Act provides an economic right to the author to reproduce the work, to issue copies, to perform or communicate it to the public, to make any cinematograph film or sound recording or to make any adaptation or translation of the work.

The Act also provides a right to claim authorship of the work; an integrity right- right to protect one's honour and reputation and a general right- right to not have a work falsely attributed to oneself. These moral rights remain with the author even after assignment of the copyright.

What is Copyright?

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

The © symbol stands for copyright.

Why should Copyright be Protected?

Copyright ensures certain minimum safeguards of the rights of authors over their creations, thereby protecting and rewarding creativity. Creativity being the keystone of progress, no civilized society can afford to ignore the basic requirement of encouraging the same. Economic and social development of a © society is dependent on creativity.

The protection provided by copyright to the efforts of writers, artists, designers, dramatists, musicians, architects and producers of sound recordings, cinematograph films and computer software, creates an atmosphere conducive to creativity, which induces them to create more and motivates others to create.

Works in which copyright subsists [section 13]

Section 13(1) of the Act provides that copyright shall subsist throughout India in the following classes of works, that is to say, —

- a) original literary, dramatic, musical and artistic works.
- b) cinematograph films; and
- c) sound recording.

Section 13 (2) states that copyright shall not subsist in any work specified in sub-section (1), other than a work to which the provisions of Section 40 (deals with power to extend copyright to foreign works) or section 41 (deals with provisions as to works of certain international organisations) apply, unless —

- in the case of a published work, the work is first published in India, or where the work is first published outside India, the author is at the date of such publication, or in a case where the author was dead at that date, was at the time of his death, a citizen of India.
- in the case of an unpublished work other than a work of architecture, the author is at the date of making of the work a citizen of India or domiciled in India; and
- in the case of a work of architecture the work is located in India.

According to Section 13 (3) Copyright shall not subsist —

a) in any cinematograph film if a substantial part of the film is an infringement of the copyright in any other work.

b) in any sound recording made in respect of a literary, dramatic, or musical work, if in making the sound recording, copyright in such work has been infringed.

Note — In the case of a work of architecture, copyright shall subsist only in the artistic character and design and shall not extend to processes or methods of construction.

Meaning of Copyright in Different Ways

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|---|---|---|
| Section 14 of the Act defines the term Copyright as to mean the exclusive right to do or authorise the doing of the following acts. in 1 respect of a work or any substantial part thereof, namely: | | |
| Copyright in the case of a Literary Dramatic or Musical Work, not being a means; Computer Programme | ➔ | to reproduce the work in any, material form including the storing of it in any medium by electronic. to issue copies of the work to the public not being copies already in circulation. to perform the work in public or communicate it to the public. to make any cinematograph film or sound recording in- respect of the work. to make any translation of the work to do in relation to a translation or an adaptation of the work, any of the acts specified in relation to the work in sub-clauses (i) to (vi) |

| | | |
|--|----------|---|
| <p>Copyright in the case of a computer programme</p> | <p>➔</p> | <p>to do any of the acts specified in specified in respect of a literary, dramatic, or musical work. to sell or give on commercial rental or offer for sale or for commercial rental any copy of the computer programmer: Provided that such commercial rental does not apply in respect of computer programmes where the programme itself is not the essential object of the rental.</p> |
| <p>Copyright in the case of Artistic Work</p> | <p>➔</p> | <p>To produce the work in any material form including - the storing of it in any medium by electronic or other means; or depiction in three-dimensions of a two-dimensional work; or depiction in two-dimensions of a three -dimensional work.</p> |
| <p>Copyright in the case of a Cinematograph Film</p> | <p>➔</p> | <ul style="list-style-type: none"> • to make a copy of the film, including— • a photograph of any image forming part thereof; or • 'Storing of it in any medium by electronic or other means. • to sell or give on commercial rental or offer for sale or for such rental, any copy of the film. • to communicate the film to the public. |
| <p>Copyright in the case of a Sound Recording</p> | <p>➔</p> | <ul style="list-style-type: none"> • to make any other sound recording embodying it is including storing of it in any medium by electronic or other means. • to sell or give on commercial rental or offer for sale or for such rental, any copy of the sound recording. • to communicate the sound recording to the public. • It may be noted that a copy which has been sold once shall be deemed to be copy in circulation |

Term of Copyright

| | |
|---|--|
| <p>Sections 22-29 deal with Term of Copyright in respect of Published Literary, Dramatic, Musical and Artistic Works; Anonymous and Pseudonymous; Posthumous, Photographs, Cinematograph Films, Sound Recording, Government Works, works of PSU's and Works of international organisation</p> | |
| <p>Terms of copyright</p> | <p>Number of Years</p> |
| <p>Terms of Copyright is published in Literary, Dramatic, Musical and Artistic Works.</p> | <p>the lifetime of the author until sixty years from the beginning of the calendar year next, following the year in which the author dies. in the case of a work of joint authorship, be construed as a reference to 'eh author who dies last.</p> |
| <p>Term of Copyright in Anonymous and pseudonymous works</p> | <p>in the case of literary, dramatic, musical; or artistic work (other than a photograph), which is: published anonymously or pseudonymously. Copyright shall subsist until sixty years next following the year in which the work is first published. Provided that where the identity of the author is disclosed before the expiry of the said period, copyright shall subsist until sixty years from the beginning of the calendar year next following the year in which the author dies</p> |
| <p>Term of Copyright in posthumous work</p> | <p>In the case of a literary, dramatic, or musical work or an engraving, in which copyright subsists at the date of the death of the author or, in the case of any such work of joint authorship, at or immediately before the date of the death of th author who dies last but which, or any adaptation of which, has not been published before that date. Copyright shall subsist until sixty years from the beginning of the calendar year next following the year in which the work is first published or, where an adaptation of the work is published in any earlier year, from the beginning of the calendar year next following that year.</p> |

| | |
|--|---|
| Term of Copyright in Cinematography Films | In the case of a cinematograph film, copyright shall subsist until sixty years from the beginning of the calendar year next following the year in which the film is published. |
| Term of Copyright of Sound Recording | In the case a sound recording copyright shall subsist until sixty years from the beginning of the calendar year next following the year in which the sound recording is published. |
| Term of Copyright Government Works | In the case of Government work, where Government is the first owner of the copyright therein, copyright shall subsist until sixty years from the beginning of the calendar year next following the year in which the work is first published. |
| Term of Copyrights in Works of Public Undertakings | In the case of a work, where a public undertaking is the first owner of the copyright therein, copyright shall subsist until sixty years from the beginning of the calendar year next following the year in which the work is first published. |
| Terms of Copyright in works of International Organizations | In the case of a work of an international organisation to which the provisions of section 41 apply, copyright shall subsist until sixty years from the beginning of the calendar year next following the year in which the work is first published. |

Assignment of Copyright [Section 18]

The owner of the copyright in an existing in the or the prospective owner of the copyright in a future work may assign to any person the copyright either wholly or partially and either generally or subject to limitations and either for the whole term of the copyright or any part thereof.

However, in case of the assignment of copyright in any future work, the assignment shall take effect only when the work comes into existence.

However, the author of the literary or musical work included in a cinematograph film shall not assign or waive the right to receive royalties to: be shared on an equal basis with the

assignee of copyright for the utilization of such work in any form other than for the communication to the public of the work along with the cinematograph film in a cinema hall, except to the legal heirs of the authors or to a copy right society for collection and distribution and any agreement to contrary shall be void.

Mode of Assignment [Section 19]

An assignment of the copyright in any work should be in writing signed by the assignor or by his duly authorised agent.

The assignment of copyright in any work required to identify such work, and also specify the rights assigned; the duration; territorial extent of such assignment; the amount of royalty and any other consideration payable to the author or his legal heirs during the currency of the assignment and the assignment subject to revision, extension or termination on terms mutually agreed upon by the parties.

Where the assignee does not exercise the rights assigned to him within a period of one year from the date of assignment, the assignment in respect of such rights shall be deemed to have lapsed.

Dispute with respect to Assignment of Copyright

- if an assignee fails to make sufficient of the rights assigned to him, and such failure is not attributable to any act or omission of the assignor, then, the Commercial court 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 Commercial court 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 of the recovery of any royalty payable.
- Provided that the commercial court shall not pass any order under this sub section to revoke the assignment unless it is satisfied that the terms of assignment are harsh to the assignor in case the assignor is also the author.
- Provided further that no order of revocation of assignment under this sub section shall be made within a period of five years from the date of such assignment.
- Every complaint received shall be dealt with by the Commercial Court as far as possible and efforts shall be made to pass the final order in the matter within a period of six months: from the date of receipt of the complaint and any delay in compliance of the same, the Commercial Court shall record the reasons thereof.

LICENSES

Licenses of Owners of Copyright

The owner of the copyright in any existing work or the prospective owner of the copyright in any future work to grant any interest in the right by licence in writing by him or by his duly authorised agent.

However, in the case of a licence relating to copyright in any future work, the licence shall take effect only when the work comes into existence.

where a person to whom a licence relating to copyright in any future work is granted, dies before the work comes into existence, his legal representatives shall, in the absence of any provision to the contrary in the licence, be entitled to the benefit of the licence.

Compulsory License in Works withheld from Public.

According to Section 31 of the Act, if at any time during the term of copyright in any work which has been published or performed in public, a complaint is made to the Commercial Court that the owner of copyright in the work —

- a) has refused to republish or allow the republication of the work or has refused to allow the performance in public of the work, and by reason of such refusal the work is withheld from the public; or
- b) has refused to allow communication to the public by broadcast of such work or in the case of a sound recording the work recorded in such sound recording, on terms which the complainant considers reasonable.

the Commercial Court, after giving 'to the owner of the copyright in the work a reasonable opportunity of being heard and after holding such inquiry as it may deem 'necessary, may, if it is satisfied that the grounds for such refusal are not reasonable, direct the Registrar of Copyrights to grant to the complainant 4 licence to republish the work, perform the work in public or communicate the work the public by broadcast, as the case may be, subject to payment to the owner of the copyright of such compensation and other terms and conditions as the Commercial Court may determine.

Compulsory License of Published or Unpublished Works

- Section 31A provides that where, in the case of any unpublished or any work published or communicated to the public and the work is withheld from. the public in India, the author is dead or unknown or cannot be traced, or the owner of the copyright in such work cannot be found, any person may apply to the Commercial Court for a licence to publish or communicate to the public such work or a translation thereof in any language.
- Before making an application, the applicant shall publish his proposal in one issue of a daily newspaper in the English language having circulation in a major part of the country.

- Where an application is made to the Commercial Court it may after holding inquiry, direct the Registrar of Copyrights to grant to the applicant a licence to publish the work or a translation thereof in the language mentioned in the application subject to the payment of royalty in the public account of India or in any other account specified by the Commercial Court so as to enable the owner of the copyright or, as the case may be, his heirs, executors or the legal representatives to claim such royalty at any time.
- If the original author is dead, the Central Government may, if it considers that the publication of the work is desirable in the national interest, require their heirs, executors, legal representatives of the author to publish such work within such period as may be specified by it.

Statutory License for Broadcasting of Literary and Musical Works and Sound Recording

According to Section 31D of the Act, any broadcasting organisation desirous of communicating to the public by way of a broadcast or by way of performance of a literary or musical work and sound recording which has already been published may do so by -

- giving prior notice, of its intention to broadcast the work stating the duration and territorial coverage of the broadcast and shall pay to the owner of rights in each work advance royalties in the manner and at the rate fixed by the Commercial Court.
- names of the authors of the principal performers of the work shall, except in case of the broadcasting organisation communicating such work by way of performance, be announced with the broadcast.
- No fresh alteration to any literary or musical work, which is not technically necessary for the purpose of broadcasting, other than shortening the work for convenience of broadcast, shall be made without the consent of the owners of rights.
- maintain such records and books of account, and render to the owners of rights such reports and accounts; and
- allow the owner of rights or his duly authorised agent or representative to inspect all records and books of account relating to such broadcast, in such manner as may be prescribed.

Termination of License

if at any time after the granting of a licence, the owner of the copyright in the work or any person authorised by him publishes a translation of such work in the same language and which is substantially the same in content at a price reasonably related to the price normally charged in India for the translation of works of the same standard on the same or similar subject, the licence so granted shall be terminated.

However, such termination shall take effect only after the expiry of a period of three months from the date of service of a notice.

Copyright Society

The Copyright Society is a legal body that protects or safeguards the interest of the owner in the product in which copyright subsists. Copyright societies give assurance to the creative author of the commercial management of their works.

It can also be described as a registered-collective administration society for the management and protection of copyright,

Registration of Copyright Society [Section 33]

The business of issuing or granting license in respect of literary, dramatic, musical and artistic works incorporated in a cinematograph films or sound recordings shall be carried out only through a copyright society duly registered under the Act.

Central Government registers association of persons as a copyright society after taking into account the following factors: -

in the interests of the authors and other owners of rights.

the interest and convenience of the public and in particular of the groups of persons who are most likely to seek licences in respect of the relevant rights; and

the ability and professional competence of the applicants.

Registration granted to a copyright society shall be for a period of five years and may be renewed from time to time before the end of every five years on request in the prescribed form and the Central Government may renew the registration after considering the report of Registrar of Copyrights on the working of the copyright society.

Central Government if satisfied that a copyright society is being managed in a manner detrimental to the interests of "authors and other owners of right" concerned, cancel the registration of such society after such inquiry as may be prescribed.

Administration of Rights of Owner by Copyright Society

Copyright Society empower to —

accept exclusive authorisation from an author and other owners of right to administer any right in any work by issue of licences or collection of licence fees or both.

enter into agreement with any foreign society or organization administering rights corresponding to rights under the Indian Copyright Act to entrust to such foreign society or organization the administration in any foreign country of rights administered by the said copyright society in India, or for administering in India the rights administered in a foreign country by such foreign society or organisation.

distribute such fees among author and other owners of right after making deductions for its own expenses.

perform any other functions consistent with the provisions of section 35.

Control over the Copyright Society by the Author and Other owners of Right

As per Section 35 every copyright society is subject to the collective control of the owners of rights it administers. It does not include administered by a foreign society or organisation.

Rights of Broadcasting Organization and of Performers Rights of Broadcasting Organization and Performers

Broadcast Reproduction Rights

The Broadcast reproduction right shall subsist until twenty-five years from the beginning of, the calendar year next following the year in which the broadcast is made.

During the continuance of a broadcast reproduction right in relation to the broadcast or any substantial part thereof, -

- a) re-broadcasts the broadcast; or
- b) causes the broadcast to be heard or seen by the public on payment of any charges; or
- c) makes any sound recording or visual recording of the broadcast; or
- d) makes any reproduction of such sound recording or visual recording where such initial recording was done without licence or, where it was licensed, for any purpose not envisaged by such licence; or
- e) sells or gives on commercial rental or offer for sale or for such rental, any such sound recording, or visual recording referred to in clause (c) or clause (d).

Performer's Rights

The performer's right subsist until fifty years from the beginning of the calendar year next following the year in which the performance is made.

Without prejudice to the rights conferred on authors, the performer's right which is an exclusive right subject to the provisions of the Act, to do or authorise for doing any of the following acts in respect of the performance or any substantial part thereof, namely: —

- a) to make a sound recording or visual recording of the performance, including—
reproduction of it in any material form including the storing of it in any medium by electronic or any other means.
issuance of copies of it to the public not being copies already in circulation.
communication of it to the public.
selling or giving it on commercial rental or offer for sale or for commercial rental any copy of the recording.

b) to broadcast or communicate the performance to the public except where the performance is already broadcast.

Note — Once a performer has, by written agreement, consented to the incorporation of his performance in a cinematograph film he shall not, in the absence of any contract to the contrary, object to the enjoyment by the producer of the film of the performer's right in the same film.

However, the performer shall be entitled for royalties in case of making of the performances for commercial use.

Moral Right of Performer

the performer of a performance shall, independently of his right after assignment, either wholly or partially of his right, have the right to claim to be identified as the performer of his performance.

except where omission is dictated by the manner of the use of the performance; and to restrain or claim damages in respect of any distortion, mutilation or other modification of his performance that would be prejudicial to his reputation.

What are the moral rights of an Author?

The Copyright Act applies only to works first published in India, irrespective of the nationality of the author.

However, Section 40 of the Act empowers the Government of India to extend the benefits of all or any of the provisions of the Act to works first published in any foreign country.

The benefits granted to foreign works will not extend beyond what is available to the works in the home country and that too on a reciprocal basis i.e., the foreign country must grant similar protection to works entitled to copyright under the Act.

Registration of Copyright

Registration of the work under the Copyright Act is not compulsory and is not a condition precedent for maintaining a suit for damages if somebody infringes the copyright.

An action for infringement can be brought even if the registration has not been done. The only effect of registration is that it is the prima facie evidence of the particular entered in the register.

Section 45 of the Act clearly — that the author or publisher of, or the owner of or other person interested in the Copyright in, any Work may make an application in the prescribed form accompanied by the prescribed fee to the registrar of Copyrights.

On receipt of an application in respect of any work, the Registrar of Copyrights may, after holding such inquiry as he may deem fit, enter the particulars of the work in the Register of Copyrights.

Registrar of Copyrights Possess certain Powers of Civil Courts

The Register of Copyrights is to be maintained by the Copyright Office to enter the names or titles of works and the names and addresses of authors, publishers, and owners of copyright.

The Registrar of Copyrights shall have the powers of a civil court when trying a suit under the Code of Civil Procedure, 1908, in respect of the following matters, namely, —

- a) summoning and enforcing the attendance of any person and. examining him on oath.
- b) requiring the discovery and production of any document.
- c) receiving evidence on affidavits.
- d) issuing commissions for the examination of witnesses or documents.
- e) requisitioning any public record or copy thereof from any court or office.
- f) any other matter which may be prescribed.

The Procedure for Registration

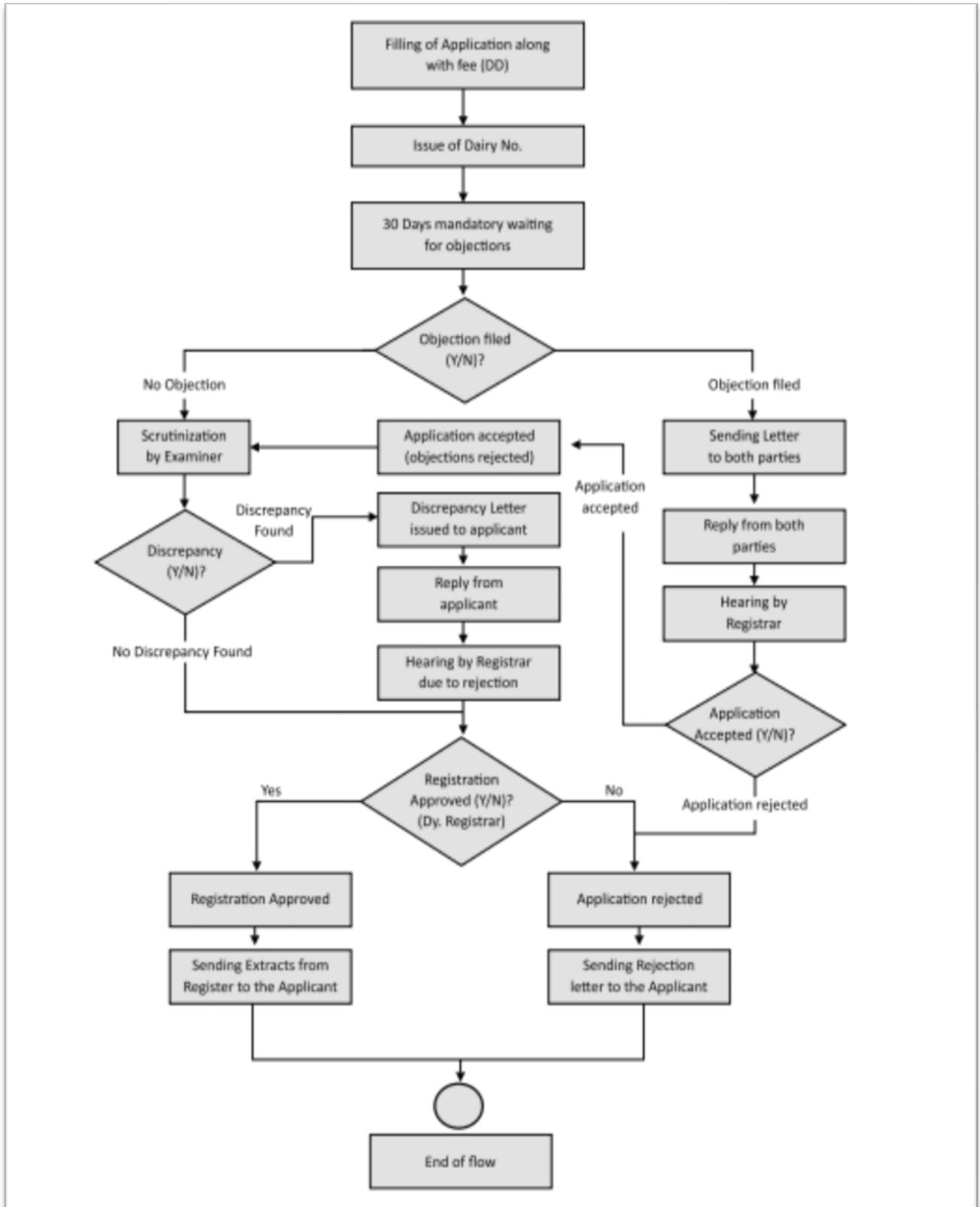
The Copyright Office has been set up to provide registration facilities to all types of works and is headed by a Registrar of Copyrights.

The applications are also accepted by post. On-line registration through "E-filing facility" has also been provided.

Procedure for Registration is as follows:

- Application for registration is to be made on specified Form (Including Statement of Particulars and Statement of Further Particulars).
- Separate applications should be made for registration of each work.
- Each application should be accompanied by the requisite fee prescribed in the second schedule to the Rules.
- The applications should be signed by the applicant. The Power of Attorney signed by the party and accepted by the advocate should also be enclosed, if applicable.
- The fee is to be paid either in the form of Demand Draft or Indian Postal Order or through E payment Each and every column of the Statement of Particulars and Statement of Further Particulars should be replied specifically.

Copyright Registration Workflow



Infringement of Copyright

Copyright infringement refers to the unauthorized use of someone's copyrighted work. Thus, it is the use of someone's copyrighted work without permission thereby infringing certain rights of the copyright holder, such as the right to reproduce, distribute, display, or perform the protected work.

According to Section 51 of the Act, Copyright is deemed to be infringed if:

- A person without obtaining the permission of the copyright holder does any act which only the copyright holder is authorised to do.
- A person permits the place to be used for communication, selling, distribution or exhibition of an infringing work unless he was not aware or has no reason to believe that such permission will result in the violation of copyright. e A person imports infringing copies of a work
- A person without obtaining: the authority from the copyright holder reproduces his work in any form.

Which are the Common Copyright Infringements?

The following are some of the commonly known acts involving infringement of copyright.

- Making infringing copies for sale or hire or selling or letting them for hire.
- Permitting any place for the performance of works in public where such performance constitutes infringement of copyright.
- Distributing infringing copies for the purpose of trade or to such an extent so as to affect prejudicially the interest of the owner of copyright.
- Public exhibition of infringing copies by way of trade; and
- Importation of infringing copies into India.

Infringing Copy Means

- In relation to a literary, dramatic, musical, or artistic work, a reproduction thereof otherwise than in the form of a cinematographic film.
- in relation to a cinematographic film, a copy of the film made on any medium by any means.
- in relation to a sound recording, any other recording embodying the same sound recording, made by any means.
- in relation to a programme or performance in which such a broadcast reproduction right or a performer's right substitutes under the provisions of this Act, the sound recording or a cinematographic film of such programme or performance, if such reproduction, copy, or sound recording is made or imported in contravention of the provisions of this Act.

Statutory Exceptions -Certain acts not to be Infringement of Copyright [Section 52]

- a) A fair dealing with any work, not being a computer programme, for the purposes of –
- private or personal use, including research.
 - criticism or review, whether of 'that work or of any other work.
 - reporting of current events and current affairs, including the reporting of a lecture delivered in public.

It may be noted that storing of any work in any electronic medium including the incidental storage of any computer programme. which is not itself an infringing copy for the said purposes, shall not constitute infringement of copyright.

b) The making of copies or adaptation of a computer programme by the lawful possessor of a copy of such computer programme, from such copy in order to utilise the computer programme for the purposes for which it was supplied; or to make back-up copies purely as a temporary protection against loss, destruction, or damage in order only to utilise the computer programme for the purpose for which it was supplied.

c) the making of copies or adaptation of the computer programme from a personally legally obtained copy for non-commercial personal use.

d) the transient or incidental storage of a work or performance purely in the technical process of electronic transmission or communication to the public.

e) the reproduction of any work for the purpose of a judicial proceeding or for the purpose of a report of a judicial proceeding.

f) the reproduction or publication of any work prepared by the Secretariat of a Legislature or, where the Legislature consists of two Houses, by the Secretariat of either House of the Legislature, exclusively for the use of the members of that Legislature.

g) the reproduction of any work in a certified copy made or supplied in accordance with any law for the time being in force.

h) the reading or recitation in public of reasonable extracts from a published literary or dramatize work

i) the performance of a literary,' dramatic or musical work by an amateur club or society, if the performance is given to a non-paying audience, or for the benefit of a religious institution.

j) the reproduction in a newspaper, magazine, or other periodical of an article on current economic, political, social or religious topics, unless the author of such article has expressly reserved to himself the right of such: reproduction.

k) the storing of a work in any medium by electronic means by a non-commercial public library, for preservation if the library already possesses a non-digital copy of the work.

l) the making or publishing of a painting, drawing, engraving or photograph of a work of architecture or the display of a work of architecture.

m) the making of a three-dimensional object from a two-dimensional artistic work, such as a technical drawing, for the purposes of industrial application of any purely functional part of a useful device.

n) the importation of copies of any literary or artistic work, such as labels, company logos or promotional or explanatory material, that is purely incidental to other goods or products being imported lawfully.

o) the reproduction of any work—

- by a teacher or a pupil in the course of instruction; or
- as part of the questions to be answered in an examination.
- in answers to such questions.

Remedies against Infringement of Copyright

The Copyright law in India provided for remedies to be made available to the author against a copyright infringer.

Civil Remedies: provide for injunctions, damages, interpretation of accounts, delivery and destruction of infringement copies and damages for conversion.

Criminal Remedies: provide for imprisonment, fines, seizures of infringing copies and delivery of infringing copies to the owner.

Border Enforcement: also provides for prohibition of import and destruction of any imported goods that infringe the copyright of a person with the assistance of the customs authorities of India.

Protection of Right of Management Information

As per section 65B any person, who knowingly removes or alters any rights management information without authority, or distributes, imports for distribution, broadcasts or communicates to the public, without authority, copies of any work, or performance knowing that electronic rights management information has been removed or altered without authority,

shall be punishable with imprisonment which may extend to two years and shall also be liable to fine.

it may be noted that "Rights Management Information" means, —
the title or other information identifying the work or performance.
the name of the author or performer.
the name and address of the owner of rights
terms and conditions regarding the use of the rights; and
any number or code that represents the information referred to in subclauses (a) to (d) but does not include any device or procedure intended to identify the user.

Offences and Penalties

Offences of Infringement of Copyright or Other Rights [Section 63]

any person who knowingly infringes or abates the infringement of the copyright in a work or any other right conferred under the Act (except for resale share right in original copies), liable to

- imprisonment for a minimum period of six months which may extend to three years and
- with minimum fine of fifty thousand rupees which may extend up to rupees two lakhs.

However, the court has been empowered to impose a sentence less than six months or a fine less than fifty thousand if the infringement had not been made for gain in the course of trade or business.

Power of Police to Seize Infringing Copies

Due to the cognizable nature of the crime, any police officer is allowed to net below the rank of sub-inspector may seize without warrant all copies of the work, and all plates used to make infringing copies of the work if he is in suspicion that an offence under Section 63 in respect of infringement of copyright in work has been, is being, or is likely to be committed, and all copies and plates seized must be produced before a Magistrate as soon as possible.

If the original owner of the work has an interest in the infringement of his work that had taken place, then within 15 days of the seizure, he can avail the remedy of restoration of the seized items.

If any person knowingly makes or has possession of plates to create infringing copies of a copyrighted work, then he will be punished for a period of not less than 2 years and will be fined along with it.

Space for Notes

LESSON 5

LAW RELATED TO GEOGRAPHICAL INDICATIONS OF GOODS

Introduction

Geographical Indications of Goods are that aspect of industrial property which refers to a country or to 4 places situated therein as being the country or place of origin of that product.

The object of the Geographical Indications of Goods (Registration and Protection) Act, 1999 is three-fold, firstly by specific law governing the geographical indications of goods in the country which could adequately protect the interest of producers of such goods, secondly, to exclude unauthorized persons from misusing geographical indications and to protect consumers from deception and thirdly, to promote goods bearing Indian geographical indications in the export market.

Examples of Indian Geographical indications are Darjeeling Tea, Kanchipuram Silk Saree, Alphonso Mango, Nagpur Orange, Kolhapuri Chappal, Bikaneri Bhujia, Agra Petha etc.

Geographical Indication

- It is an indication. it originates from a definite geographical territory.
- It is used to identify agricultural, natural, or manufactured goods.
- The manufactured goods should be produced or processed or prepared in that territory.
- It should have a special quality or reputation or other characteristics.

Indication

Indication includes any name, geographical or figurative representation or any combination of them conveying or suggesting the geographical origin of goods to which it applies.

Generic Names or Indications

In relation 'to goods, means the name of a goods which, although relates to the place or the region where the goods was originally produced or manufactured has lost its original meaning and has become the common name of such goods and serves as a designation for or indication of -_ kind, nature, type or other property or characteristic of the goods.

However, in determining whether the name has become generic, account shall be taken of all factors including the existing situation in the region or place in which the name originates and the area of consumption of the goods.

Prohibition of Registration of Certain Geographical Indication [Section 9]

They are as follows: -

- the use of which would be likely to deceive or cause confusion; or
- the use of which would be contrary to any law for the time being in force; or
- which comprises or contains scandalous or obscene matter; or e which comprises or contains any matter likely to hurt the religious susceptibilities of any class or section of the citizens of India; or
- which would otherwise be disentitled to protection in a court; or
- which are determined to be generic names or indications of goods and are, therefore, not or ceased to be protected in their country of origin, or which have fallen into disuse in that country.
- which, although literally true as to the territory, region, or locality in which the goods originate, but falsely represent to the persons that the goods originate in another territory, region, or locality, as the case may be.

Application for Registration [Section 11]

Any

association of persons or

producers or any organisation or

authority

established by or under any law for the time being in force representing the interest of the producers of the concerned goods, who are desirous of registering a geographical indication in relation to such goods shall apply in writing to the Registrar in such form and in such manner and accompanied by such fees as may be prescribed for the registration of the geographical indication.

The application shall contain —

- A single application may be 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, as the case may be.
- 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 the words or figurative elements or both.

- A statement containing such particulars of the producers of the concerned goods, if any, proposed to be initially registered with the registration of the geographical indication as may be prescribed; and
- such other prescribed particulars.

Registration [Section 16]

On the registration of a geographical indication, the Registrar shall issue each to the applicant and the authorised users, if registered with the geographical indication, a certificate sealed with the seal of the Geographical Indications Registry.

where registration of a indication is not completed within twelve months from the date of the application by reason of default on the part of the applicant, the Registrar may, after giving notice to the applicant in the prescribed manner treat the application as abandoned unless it is completed within the time specified in that behalf in the notice.

Process of Registration of Geographical Indications

Filling of Applications

The association of persons or producers or any organization or authority should represent the interest of producers of the concerned goods and. should file an affidavit how the applicant claims to represent their interest.

- Application must be made in triplicate.
- The application shall be signed by the applicant or his agent and must be accompanied by a statement of case.
- Details of the —_ characteristics and how those standards are maintained.
- Three certified copies of the map of the region to which the Gi relates.
- Details of the inspection structure if any to regulate the use of the Gi in the territory to which it relates.
- Give details of all the applicant together with address.

Preliminary Scrutiny and examination

- The Examiner will scrutinize the application for any deficiencies.
- The applicant should within one month of the communication in this 'regard, remedy the same.
- The content of statement of case is assessed by a consultative group of experts will be versed on the subject.
- They will ascertain the correctness of particulars furnished.
- Thereafter an Examination Report would be issued.

Show Cause Notice

- If the Registrar has any objection to the application, he will communicate such objection.
- The applicant must respond within two months or apply for a hearing.
- The decision will be duly communicated. If the applicant wishes to appeal, he may within one month make a request.
- The Registrar is also empowered to withdraw an application, if it is accepted in error, after giving an opportunity of being heard.

Publication in the Geographical Indications Journal

Every application, within three months of acceptance shall be published in the Geographical Indications Journal.

Opposition to Registration

- Any person can file a notice of opposition within three months (extendable by another month on request which has to be filed before three months) opposing the GI application published in the Journal.
- The registrar shall serve a copy of the notice on the applicant. e Within two months the applicant shall send a copy of the counter statement.
- If he does not do this shall be deemed to have abandoned his application. Where the counter-statement has been filed, the registrar shall serve a copy on the person giving the notice of opposition.
- Thereafter, both sides will lead their respective evidence by way of affidavit and supporting documents.
- A date for hearing of the case will be fixed thereafter.

Registration

- Where an application for a GI has been accepted, the registrar shall register the geographical indication. If registered the date of filing of the application shall be deemed to be the date of registration.
- The registrar shall issue to the applicant a certificate with the seal of the Geographical Indication's registry.

Renewal

A registered GI shall be valid for 10 years and can be renewed on payment of renewal fee.

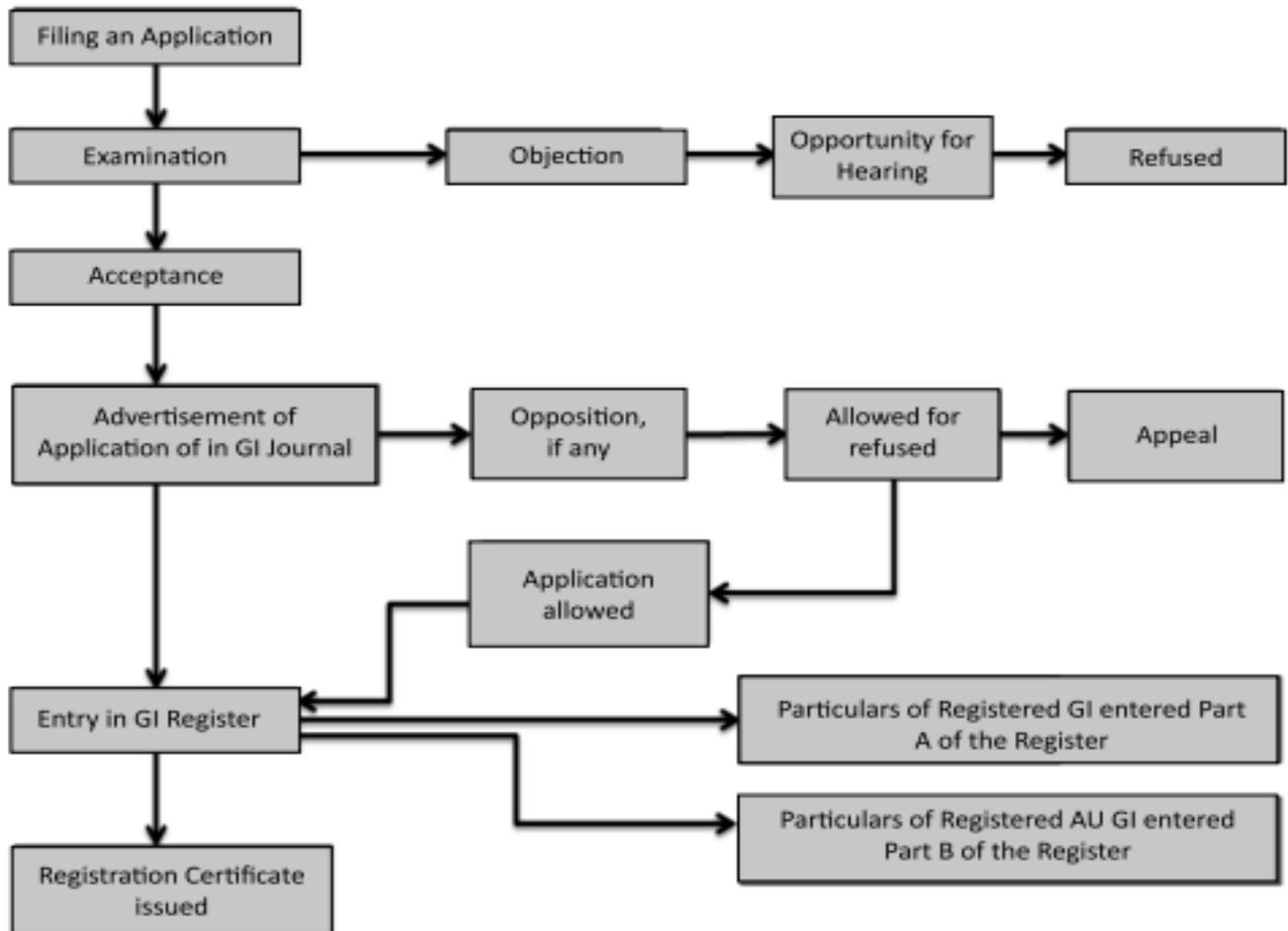
Additional Protection of Notified Goods

Additional Protection of Notified Goods is provided in the Act.

Appeal

Any person aggrieved by an order or decision may prefer an appeal.

Geographical Indications Registration Workflow



What is the benefit of registration of Geographical Indications?

- It confers legal protection to Geographical Indications in India.
- Prevents unauthorised use of a Registered Geographical Indication by others.
- It provides legal protection to Indian Geographical Indications which in turn boost exports.
- It promotes economic prosperity of producers of goods produced in a geographical territory.

Duration of Registration [Section 18]

The registration of a geographical indication shall be for a period of ten years but may be renewed from time to time in accordance with the provisions of this section.

The registration of an authorised user shall be for a period of ten years or for the period till the date on which the registration of the geographical indication in respect of which the authorised user is registered expires, whichever is earlier.

Infringement of Unregistered Geographical Indication

As per section 20 of the Act a person shall not be entitled to institute any proceeding to prevent, or to recover damages for, the infringement of an unregistered geographical indication.

Infringement of Registered Geographical Indication [Section 22]

- When an unauthorised user uses a geographical indication 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 mislead the public as to the geographical origin of such goods.
- When the use of geographical indication result in an unfair competition including passing off in respect of registered geographical indication.
- When the use of another geographical indication results in false representation to the public that goods originate in a territory in respect of which a registered geographical indication relates.

Assignment of Transmission

Section 24 of the Act prohibits assignment or transmission of geographical indication. It states that any right to a registered geographical indication shall not be the subject matter of assignment, transmission, licensing, pledge, mortgage or any such other agreement.

However, on the death of an authorised user his right in a registered geographical indication shall devolve on his successor in title under the law for the time being in force.

Prohibition of Registration of Geographical Indications as Trademarks

- A trademark is a sign which is used in the course of trade, and it distinguishes goods or services of one enterprise from those of other enterprises.
- Whereas a geographical indication is an indication used to identify goods having special characteristics originating from a definite geographical territory
- if use of such geographical indications in the trademark for such goods, is of such a nature as to confuse or mislead the persons as to the true place of origin of such goods or class or classes of goods.

Meaning of applying geographical indications

Section 37 of the Act provides that a person shall be deemed to apply a geographical indication to goods who: -

- applies it to the goods themselves; or
- applies it to any package in or with which the goods are sold, or exposed for sale, or had in possession for sale or for any purpose of trade or manufacture; or
- places, encloses, or annexes any goods which are sold, or exposed for sale, or had in possession for sale or for any purpose of trade or manufacture, in or with any package or other thing to which a geographical indication has been applied; or
- uses a geographical indication in any manner reasonably likely to lead to the belief that the goods in connection with which it is used are designated or described by that geographical indication; or
- in relation to the goods uses a geographical indication in any sign, advertisement, invoice, catalogue, business letter, business paper, price list or other commercial documents and goods are delivered to a person in pursuance of a request or order made by reference to the geographical indication as so used.

Falsifying and Falsely Applying Geographical indications

A person shall be deemed to falsely apply to goods a geographical indication who, without the assent of the authorised user of the geographical indication:

- a) applies such geographical indication or a deceptively similar geographical indication to goods or any package containing goods.
- b) uses any package bearing a geographical indication which is identical with or deceptively similar to the geographical indication of such authorised user, for the purpose of packing, filling, or wrapping therein any goods other than the genuine goods of the authorised user of the geographical indication.

Penalty for applying false geographical indications.

Imprisonment for a term which shall not be less than six months, but which may extend to three years and with fine which shall not be less than fifty thousand rupees, but which may extend to two lakh rupees.

It may be noted that the court may, for adequate and special reasons to be mentioned in the judgment, impose a sentence of imprisonment for a term of less than six months or a fine of less than fifty thousand rupees.

Space for Notes

LESSON 6 LAW RELATED TO DESIGNS

Introduction

- industrial designs refer to creative activity which result in the ornamental or formal appearance of a product and design right refers to a novel or original design that is accorded to the proprietor of a validly registered design.
- The objective of the Designs Act, 2000 is to protect new or original designs so created to be applied or applicable to particular article to be manufactured by Industrial Process or means.
- In the case of Escorts construction Equipment Ltd. vs. Action construction Equipment Pvt. Ltd

Delhi High Court observed that the primary object the Act is to protect shape and not the function or functional shape. The expression design doesn't 't includes a method or principle of construction or features of shape or configuration which is dictated solely by the function which the article to be made in that shape or configuration has to perform.

Design

Design means only the features of shape, configuration, pattern or ornament or composition of lines or colour or combination thereof applied to any article whether two dimensional or three dimensional or in both forms, by any industrial process or means, whether manual, mechanical, or chemical, separate or combined, which in the finished article appeal to and are judged solely by the eye,

but does not include any mode or principle or construction or anything which is in substance a mere mechanical device, and does not include any trademark, property mark or artistic works.

An artistic work as defined under Section 2(c) of the Copyright Act, 1957 is not a subject matter for registration which reads as follows:

"Artistic works" means: -

- *A painting, a sculpture, a drawing (including a diagram, map, chart or plan) on engraving or a photograph, whether or not such work possesses artistic quality;*
- *An work of architecture; and*
- *Any other work of artistic craftsmanship.*

Proprietor of New or Original Design

- Where the author of the design, for good consideration, executes the work for some other person, means the person for whom the design is so executed.
- Where any person acquires the design or the right to apply the design to any article, either exclusively of any other person or otherwise, means, in the respect and to the extent in and to which the design or right has been so acquired, the person by whom the design or right is so acquired; and e In any other case, means the author of the design; and
- where the property in or the right to apply, the design has devolved from the original proprietor upon any other person, includes that other person.

Prohibition of Registration of Certain Designs

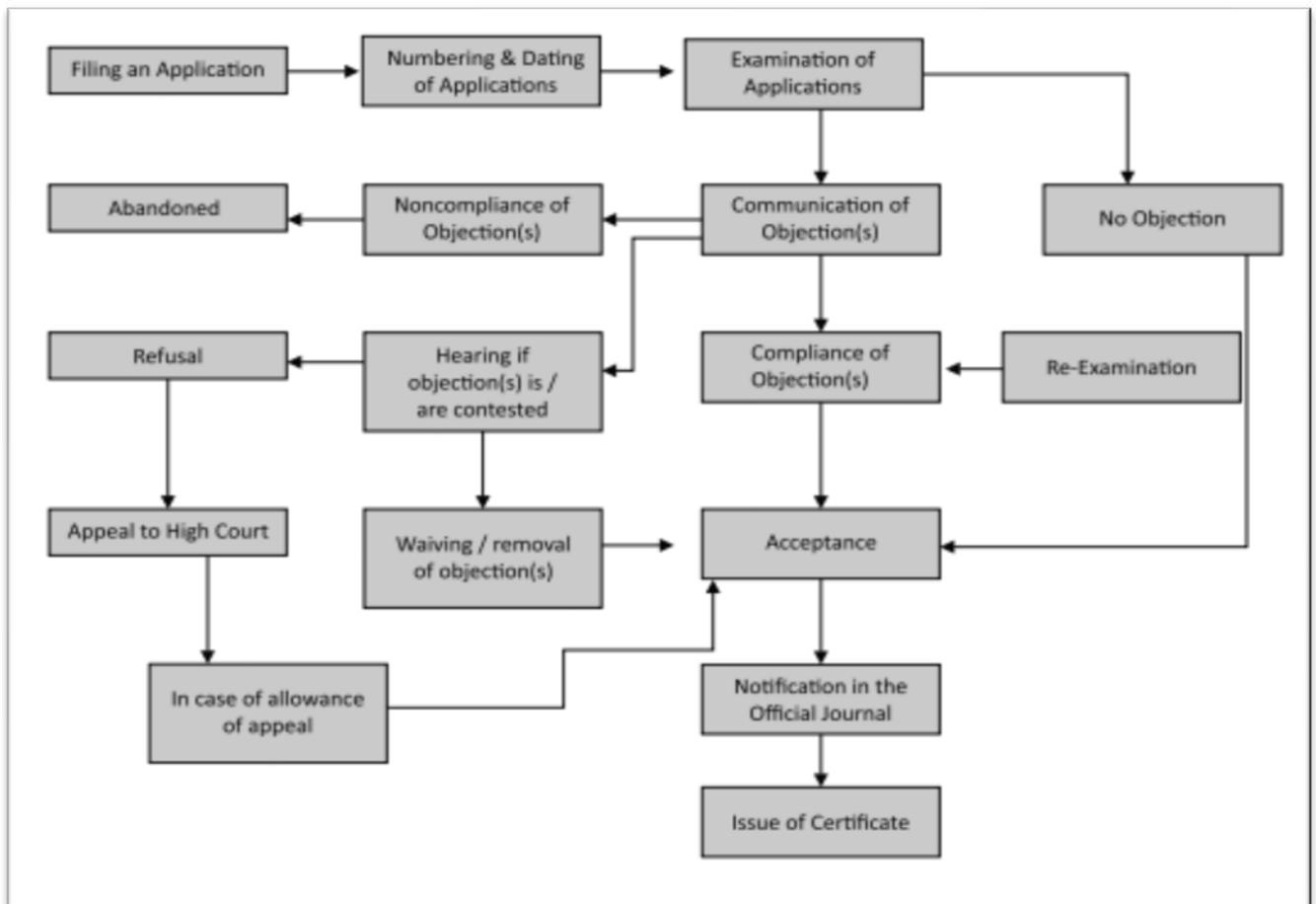
- A design which prohibited of registration under Section 4 of the Design Act, 2000 are as follows:
 - is not new or original; or
 - has been disclosed to the public anywhere in India or in any other country by publication in tangible form or by use or in any other way prior to the filing date, or where applicable, the priority date of the application for registration; or
 - is not significantly distinguishable from known designs or combination of known designs; or
 - comprises or contains scandalous or obscene matter, shall not be registered.

Application for Registration of Designs [Section 5]

- The Controller may, on the application of any person claiming to be the proprietor of any new or original design not previously published in any country and which is not contrary to public order or morality, register the design under this Act.
- Every application shall be in the prescribed form and shall be filed in the patent office in the prescribed manner and shall be accompanied by the prescribed fee.
- A design may be registered in not more than one class, and, in case of doubt as to the class in which a design ought to be registered, the Controller may decide the question.
- The Controller may, if he thinks fit, refuse to register any design presented to him for registration; but any person aggrieved by any such refusal may appeal to the High Court.
- An application which, owing to any default or neglect on the part of the applicant, has not been completed so as to enable registration to be affected within the prescribed time shall be deemed to be abandoned.

- A design when registered shall be registered as of the date of the application for registration.

Design Registration Process Workflow



Registration to be in respect of Particular Article [Section 6]

- A design may be registered in respect of any or all of the articles comprised in a prescribed class of articles.
- Any question arising as to the class within which any article falls shall be determined by the Controller whose decision in the matter shall be final.
- Where a design has been registered in respect of any article comprised in a class of article, the application of the proprietor of the design to register it in respect of some one or more other articles comprised in that class of articles shall not be refused, nor shall the registration thereof invalidated —
on the ground of the design not being a new or original design, by reason only that it was so previously registered.

on the ground of the design having been previously published in India or in any other country, by reason only that it has been applied to article in respect of which it was previously registered.

Note - subsequent registration shall not extend the period of copyright in the design beyond that arising from previous registration.

d) Where any person makes an application for the registration of a design in respect of any article and either—

- that design has been previously registered by another person in respect of some other article; or
- the design to which the application relates consists of a design previously registered by another person in respect of the same or some other article with modifications or variations not sufficient to alter the character or substantially to affect the identity thereof, then, if at any time while the application is pending the applicant becomes the registered proprietor of the design previously registered, 'the foregoing provisions of this section shall apply as if at the time of making the application, the applicant, had been the registered proprietor of that design.

Publication of particulars of Registered Designs

Section 7 of the Act provides that the Controller shall, as soon as may be after the registration of a design, cause publication of the prescribed particulars of the design to be published in such manner as may be prescribed and thereafter the design shall be open to public inspection.

Substitution of applicant or Joint Claiming [Section 8]

a) Name of an applicant can be substituted, or a joint claim can be made for an applied design, if the following requirements are met:

- The claim for substitution is made before the design has been registered; and
- Right of claimant shall be created only by:
 - An assignment
 - Agreement in writing made by the applicant or one of the applicants; or
 - Operation of law
- The design under consideration shall be identified in the assignment or agreement specifically by reference to the number of applications for registration; or
- The rights of the claimant in respect of the design have been finally established by a Court.

b) A request for substitution of applicant shall be filed in Form-2 along with the required fee. If the above said requirements are fulfilled and the Controller is satisfied that, upon registration of design, the claimant would be entitled to any interest in the design the Controller may direct that the application shall proceed:

- in the names of the claimant(s); or
- in the names of the claimant(s) and the applicant or the other joint applicant(s), as the case may be.

c) However, in ease of joint applicants, the Controller shall not pass such direction without with the consent of the other joint applicant(s);

d) In the case, joint applicant(s) die(s) at any time before the design has been registered, a request may be made for substitution by the survivor(s) and the Controller may direct that the application shall proceed in the name of the survivors alone. However, no such direction shall be issued without the consent of legal representative of the deceased.

e) If ease, there is any dispute between joint applicants as to whether or in what manner the application should be proceeded with an application may be made by any of the parties. The Controller may give such directions as he thinks fit for enabling the application to proceed in the name of one or more of the parties alone or for regulating the manner in which it should be preceded with, or for both those purposes, as the case may be. However, the Controller shall not pass any such direction without giving an opportunity to be heard to all the concerned parties.

Certificate of Registration

Under section 9 of the Design Act, the Controller grant a certificate of registration to the proprietor of the design when it registered. The Controller may, in case of loss of the original certificate, or in any other case in which he deems it expedient, furnish one or more copies of the certificates.

Register of Designs

Section 10 of the Act provides that there shall be kept at the patent office a book called the register of designs, wherein shall be entered the names and addresses of proprietors of registered designs, notifications of assignments and of transmissions of registered designs, and such other matter as may be prescribed and such register may be maintained wholly or partly on computer, floppies or diskettes, subject to such safeguards as may be prescribed.

Copyright of Registration

Section 11 provides that when a design is registered, the registered proprietor of the design shall, subject to the provisions of this Act, have copyright in the design during ten years from the date of registration.

However, before the expiration of the said ten years, application for the extension of the period of copyright is made to the Controller in the prescribed manner, the Controller shall, on payment of the prescribed fee, extend the period of copyright for a second period of five years from the expiration of the original period of ten years.

Restoration of Lapsed Designs

Section 12 of the Act provides that where a design has ceased to have effect by reason of failure to pay the fee for the extension of copyright, the proprietor of such design or his legal representative and where the design was held by two or more persons jointly, then, with the leave of the Controller one or more of them without joining the others, may, within one year from the date on which the design ceases to have the effect, make an application for the restoration of the design in the prescribed manner on payment of such fees as may be prescribed.

Can the Registration of the Design be Cancelled?

According to Section 19 of the Act, the registration of a design may be cancelled at any time after the registration of design on a petition for cancellation in prescribed form with fee to the Controller of Designs on the following grounds:

- That the design has been previously registered in India; or
- that it has been published in India or elsewhere prior to date of registration; or
- The design is not new or original; or
- Design is not registrable; or
- It is not a design under Clause (d) of Section 2.

Designs to Bind Government

As per Section 20 4 registered design shall have to all intents the like effect as against the Government as it has against any person and the provisions of Chapter XVII of the Patents Act, 1970 shall apply to registered designs as they apply to patents.

What is a Piracy of Design?

Piracy of a design means the application of a design or its imitation to any article belonging to class of articles in which the design has been registered for the purpose of sale or importation of such articles without the written consent of the registered proprietor.

Publishing such articles or exposing terms for sale with knowledge of the unauthorized application of the design to them also involves piracy of the design.

Appeal

An appeal lies to the High Court against an order passed by the Controller under the following provisions:

- an order under Section 5, refusing registration of a design.
- an order under Section 19, passed in a cancellation petition.
- an order under Section 31, passed in a rectification petition.
- an order under Section 35, refusing registration on the ground of public order or morality.

Every appeal shall be made within three months of the date of the order of the Controller.

In calculating the said period of three months, the time taken in granting a copy of the order appealed against shall be excluded.

The High Court may, if it thinks fit, obtain the assistance of an expert in deciding such appeals, and the decision of the High Court shall be final.

Space for Notes

Our Rankers



Pulak Bansal



Sidra Khan



Albiya Shaikh



Khushi Dubey



Kushal Todi



Richa Chokhani



Isha Shah



Kartiki Tulaskar



Mansi Rawat



Deep Patel



Aditya Dakh



Aditi Menon



Femi Jain



Ibrat Khan



Rahul Lakhwani



Kausha Sheth



Kimaya Sonawdekar



Suyash Kasat



Siddharth Nair



Anjali Vishwakarma



Kedar More



Raj Singh



Dhruvi Patel



Vaibhavi Palkar



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