



*Subject :*  
**Intellectual  
Property Law**

**Paper : 5.1**



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## **INTRODUCTION:**

Property designates those things that are commonly recognized as being the possessions of an individual or a group. A right of ownership is associated with property that establishes the good as being "one's own thing" in relation to other individuals or groups, assuring the owner the right to dispense with the property in a manner he or she deems fit, whether to use or not use, exclude others from using, or to transfer ownership tangible property and intangible property i.e. one that is physically present and the other which is not in any physical form. Building, land, house, cash, jewellery are few examples of tangible properties which can be seen and felt physically.

On the other hand there is a kind of valuable property that cannot be felt physically as it does not have a physical form.

Intellectual property is one of the forms of intangible property which commands a material value which can also be higher than the value of a tangible asset or property. Rights protected under Intellectual Property The different types of Intellectual Property Rights are: i. Patents ii. Copyrights, iii. Trademarks iv. Industrial designs v. Protection of Integrated Circuits layout design vi. Geographical indications of goods vii. Biological diversity viii. Plant varieties and farmers rights etc.

### **Nature And meaning of intellectual property:**

Intellectual property Right (IPR) is a term used for various legal entitlements which attach to certain types of information, ideas, or other intangibles in their expressed form. The holder of this legal entitlement is generally entitled to exercise various exclusive rights in relation to the subject matter of the Intellectual Property. The term intellectual property reflects the idea that this subject matter is the product of the mind or the intellect, and that Intellectual Property rights may be protected at law in the same way as any other form of property. Intellectual property laws vary from jurisdiction to jurisdiction, such that the acquisition, registration or enforcement of IP rights must be pursued or obtained separately in each territory of interest. Intellectual property rights (IPR) can be defined as the rights given to people over the creation of their minds. They usually give the creator an exclusive right over the use of his/her

creations for a certain period of time. What is Intellectual Property? Intellectual property is an intangible creation of the human mind, usually expressed or translated into a tangible form that is assigned certain rights of property. Examples of intellectual property include an author's copyright on a book or article, a distinctive logo design representing a soft drink company and its products, unique design elements of a web site, or a patent on the process to manufacture chewing gum.

### **What is Intellectual Property Rights?**

Intellectual property rights (IPR) can be defined as the rights given to people over the creation of their minds. They usually give the creator an exclusive right over the use of his/her creations for a certain period of time. Intellectual property (IP) refers to creations of the mind: inventions, literary and artistic works, and symbols, names, images, and designs used in commerce.

### **Categories of Intellectual Property:**

Categories of Intellectual Property One can broadly classify the various forms of IPRs into two categories:

- IP is divided into two categories for ease of understanding:
  - Industrial Property which includes inventions (patents), trademarks, industrial designs, and geographic indications of source; and
  - Copyright, which includes literary and artistic works such as novels, poems and plays, films, musical works, artistic works such as drawings, paintings, photographs and sculptures, and architectural designs. Rights related to copyright include those of performing artists in their performances, producers of phonograms in their recordings, and those of broadcasters in their radio and television programs Intellectual property shall include the right relating to: i. Literary, artistic and scientific works; ii. Performance of performing artists; iii. Inventions in all fields of human endeavour; iv. Scientific discoveries; v. Industrial designs; vi. Trademarks, service marks and etc; vii. Protection against unfair competition.

## **CHARACTERISTICS OF INTELLECTUAL PROPERTY:**

- IP does not cover the created physical object but retains the conceptual development behind the physical object . Intellectual property law does not deal with the material object in which works of the mind have represented . The main feature which distinguishes IP from other types of property in its intangibility
- Intellectual property is derived from common law, and it is covered under specific laws.
- Intellectual property gives an exclusive right to the owner of the property
- Intellectual property is a negative right.

## **Types of Intellectual property:**

Traditionally, the two main categories of intellectual property rights are copyright and rights associated with copyright and industrial property. Industrial property includes trademarks, geographical indications, industrial designs, and trade secrets. Some of the examples of intellectual property are :

### **Patent in Intellectual Property Rights**

When an invention satisfies the requirements of general novelty, non-obviousness, and industrial or commercial application, a patent is granted.

- Products as well as processes are eligible for patent protection.
- A patent gives the owner the authority to decide whether or how others may use an invention.
- In exchange for this privilege, the holder of the patent publishes technical details about the invention in the patent document for public consumption.

### **Copyrights**

The legal term "copyright" is defined as the ownership rights of authors and artists over their creative works.

- The works protected by copyright can include computer programs, databases, advertisements, maps, and technical drawings, in addition to books, music, paintings, sculptures, and films.
- Copyright protects the author's rights to literary and artistic works for at least 50 years after the owner's death.
- The rights of performers (such as actors, singers, and musicians), phonogram producers, and broadcasting organisations are all safeguarded by copyright and related rights.

### **Trademarks**

A trademark can be defined as a symbol that can be used to separate the products or services of one company from those of another company.

- Trademarks have existed since the earliest days when artisans would sign or "mark" their creations.

### **Industrial Designs**

Industrial design represents the decorative or aesthetic component of an object. The designs can include two-dimensional elements like patterns, lines, or colours and three-dimensional elements like the shape or surface of an object.

### **Geographical Indications**

Geographical indications and appellations of origin are labels applied to products that have a particular geographical origin and that have qualities, a reputation, or other characteristics that can primarily be linked to that location of origin.

- The name of the location where the goods were made is most frequently included in a geographical indication.

### **National IPR Policy 2016**

It unifies all IPRs on one platform. It establishes a formal system for implementation, oversight, and evaluation. Importantly, it also seeks to incorporate and modify best practices from around the world for the Indian context.

- In addition, it gives communities more power to advance their traditional knowledge, regulate its uses, and profit from its commercial exploitation.

## **International Bodies/Conventions on Intellectual Property Rights:**

To safeguard intellectual property rights, the international community has come up with various conventions and established bodies, as listed below.

### **World Intellectual Property Organisation (WIPO)**

The promotion of the global protection of intellectual property rights is the responsibility of the WIPO. It also supervises the following treaties and conventions.

- **Paris Convention for the Protection of Industrial Property (1883):** In its broadest sense, this convention covers all forms of industrial property, including patents, trademarks, industrial designs, utility models, service marks, trade names, geographical indications, and the stifling of unfair competition.
  - It was the first significant action taken to assist creators in making sure that their intellectual property was protected in other nations.
  - **The provision of national treatment** was established by this convention.
- **Berne Convention for the Protection of Literary and Artistic Works (1886):** It is a convention that governs copyright internationally. The Convention covers the rights of authors as well as the protection of works.
- **Budapest Treaty:** On the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure.
- **The Marrakesh Treaty**, which is overseen by WIPO, facilitates the creation and international transfer of books that have been specially adapted for those who are blind or have visual impairments.
  - It accomplishes this by defining a set of restrictions and exclusions from conventional copyright law.
- **Patent Cooperation Treaty (1970):** It offers a standardised process for submitting patent applications to safeguard inventions in all of its signatory states.

- It focuses on making the world accessible, streamlining the process of meeting various formality requirements, delaying the significant costs related to international patent protection, and providing a solid basis for patenting decisions.

### **TRIPS (Trade Related Intellectual Property Rights) Agreement, 1994**

The TRIPS Agreement is one of the most significant **agreements of the WTO**.

- At a broad level, it covers
  - Copyright and related rights (the rights of performers, record companies, and broadcasting organisations);
  - trademarks, including service marks;
  - geographical indications, such as appellations of origin;
  - industrial designs;
  - patents, which protect novel plant varieties;
  - integrated circuit layout-designs; and undisclosed information, such as trade secrets and test data.
- The agreement's three primary characteristics are:
  - **Standards:** The TRIPS Agreement specifies the minimum standards of protection that each member must offer with regard to each of the primary intellectual property domains that it covers.
    - The subject matter to be protected, the rights to be granted, the permissible changes from those rights, and the minimum length of protection are all defined as the essential components of protection.
  - **Enforcement:** Intellectual property rights enforcement on a domestic level is addressed by enforcement procedures and remedies.
    - The agreement establishes a few broad guidelines that apply to every IPR enforcement process.
    - It also includes detailed provisions on criminal procedures, special requirements related to border measures, interim measures, and civil and administrative procedures and remedies.

- **Dispute settlement:** According to the Agreement, differences amongst WTO Members regarding observance of the TRIPS obligations are resolved through the WTO's dispute resolution processes.
- Furthermore, the agreement stipulates fundamental concepts like national and most-favored-nation treatment.

## **PATENTS**

### **INTRODUCTION:**

A patent is an exclusive right granted by law to applicants / assignees to make use of and exploit their inventions for a limited period of time (generally 20 years from filing). Patent is a grant for an invention by the Government to the inventor in exchange for full disclosure of the invention. The patent holder has the legal right to exclude others from commercially exploiting his invention for the duration of this period. In return for exclusive rights, the applicant is obliged to disclose the invention to the public in a manner that enables others, skilled in the art, to replicate the invention.

### **OBJECTIVE OF PATENT LAW:**

Patent law serves the vital purpose of promoting innovation and economic growth while also helping to protect creations from unfair infringement.

The patent system is designed to balance the interests of applicants / assignees (exclusive rights) and the interests of society (disclosure of invention). ‘Invention’ under Patent Law Sec.2(1)(J) - Invention” means a new product or process involving an inventive step and capable of industrial application .

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

- **Novelty:** The matter disclosed in the specification is not published in India or elsewhere before the date of filing of the patent application in India.
- **Inventive Step:** The invention is not obvious to a person skilled in the art in the light of the prior publication/knowledge/ document.



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

### **What is not an ‘Invention’?**

According to Sec 3 of the Patent Act, 1970 :

The following are not inventions within the meaning of this Act,--

(a) an invention which is frivolous or which claims anything obviously contrary to well established natural laws;

<sup>1</sup>[(b) an invention the primary or intended use or commercial exploitation of which would 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 <sup>2</sup>[or discovery of any living thing or non-living substance occurring in nature];

<sup>3</sup>[(d) the mere discovery of a new form of a known substance which does not result in the enhancement of the known efficacy of that substance or the mere discovery of any new property or new use for a known substance or of the mere use of a known process, machine or apparatus unless such known process results in a new product or employs at least one new reactant.

**Explanation.** - For the purposes of this clause, salts, esters, ethers, polymorphs, metabolites, pure form, particle size, isomers, mixtures of isomers, complexes,

combinations and other derivatives of known substance shall be considered to be the same substance, unless they differ significantly in properties with regard to efficacy;]

(e) a substance obtained by a mere admixture resulting only in the aggregation of the properties of the components thereof or a process for producing such substance;

(f) the mere arrangement or re-arrangement or duplication of known devices each functioning independently of one another in a known way;

(h) a method of agriculture or horticulture;

(i) any process for the medicinal, surgical, curative, prophylactic <sup>5</sup>[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.

(j) 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;

(k) a mathematical or business method or a computer programme *per se* or algorithms;

(l) a literary, dramatic, musical or artistic work or any other aesthetic creation whatsoever including cinematographic works and television productions;

(m) a mere scheme or rule or method of performing mental act or method of playing game;

(n) a presentation of information;

(o) topography of integrated circuits;

(p) an invention which, in effect, is traditional knowledge or which is an aggregation or duplication of known properties of traditionally known component or components.]

### **Inventions relating to atomic energy not patentable**

No patent shall be granted in respect of an invention relating to atomic energy falling within sub-section (1) of section 20 of the Atomic Energy Act, 1962 (33 of 1962).

### **WHO MAY APPLY FOR PATENT;**

Section 6 in The Patents Act, 1970 provide for Persons entitled to apply for patents— Subject to the provisions contained in section 134, 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.

An application under sub-section (1) may be made by any of the persons referred to therein either alone or jointly with any other person.

#### **SPECIFICATION:**

Sec 9. Provisional and complete specifications.—(1) Where an application for a patent (not being a convention application or an application filed under the Patent Cooperation Treaty 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.

(2)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. Provided that the period of time specified under sub-section (1) shall be reckoned from the date of filing of the earliest provisional specification.

(3)Where an application for a patent (not being a convention application or an application filed under the Patent Cooperation Treaty designating India) in. accompanied by a specification purporting to be a complete specification, the Controller may, if the applicant be requests at any time within twelve months from the date of

filing of the application, direct that such specification shall be treated, for the purposes of this Act, as a provisional specification and proceed with the application accordingly.

(4) Where a complete specification has been filed in pursuance of an application for a patent accompanied by a provisional specification or by a specification treated by virtue of a direction under sub-section (3) as a provisional specification, the Controller may, if the applicant so requests at any time before grant of patent, cancel the provisional specification and post-date the application to the date of filing of the complete specification.

### **OPPOSITION TO GRANT PATENTS:**

Under the Indian Patents Act 1970, third parties are given an opportunity to file oppositions against the grant of any patent. There is a specific duration specified in the act for the same. Section 25 of the Act deals with Opposition. The opposition period involves two stages- pre-grant and post-grant.

**Sec 25. Opposition to the patent.--** (1) Where an application for a patent has been published but a patent has not been granted, any person may, in writing, represent by way of opposition to the Controller against the grant of patent on the ground--

(a) that the applicant for the patent or the person under or through whom he claims, wrongfully obtained the invention or any part thereof from him or from a person under or through whom he claims;

(b) that the invention so far as claimed in any claim of the complete specification has been published before the priority date of the claim--

(i) in any specification filed in pursuance of an application for a patent made in India on or after the 1st day of January, 1912; or

(ii) in India or elsewhere, in any other document:

Provided that the ground specified in sub-clause (ii) shall not be available where such publication does not constitute an anticipation of the invention by virtue of sub-section (2) or subsection (3) of section 29;

(c) that the invention so far as claimed in any claim of the complete specification is claimed in a claim of a complete specification published on or after the priority date of the applicant's claim and filed in pursuance of an application for a patent in India, being a claim of which the priority date is earlier than that of the applicants claim;

(d) that the invention so far as claimed in any claim of the complete specification was publicly known or publicly used in India before the priority date of that claim.

*Explanation.*--For the purposes of this clause, an invention relating to a process for which a patent is claimed shall be deemed to have been publicly known or publicly used in India before the priority date of the claim if a product made by that process had already been imported into India before that date except where such importation has been for the purpose of reasonable trial or experiment only;

(e) that the invention so far as claimed in any claim of the complete specification is obvious and clearly does not involve any inventive step, having regard to the matter published as mentioned in clause (b) or having regard to what was used in India before the priority date of the applicant's claim;

(f) that the subject of any claim of the complete specification is not an invention within the meaning of this Act, or is not patentable under this Act;

(g) that the complete specification does not sufficiently and clearly describe the invention or the method by which it is to be performed;

(h) that the applicant has failed to disclose to the Controller the information required by section 8 or has furnished the information which in any material particular was false to his knowledge;

(i) that in the case of a convention application, the application was not made within twelve months from the date of the first application for protection for the invention made in a convention country by the applicant or a person from whom he derives title;

(j) that the complete specification does not disclose or wrongly mentions the source or geographical origin of biological material used for the invention;

(k) that the invention so far as claimed in any claim of the complete specification is anticipated having regard to the knowledge, oral or otherwise, available within any local or indigenous community in India or elsewhere,

but on no other ground and the Controller shall, if requested by such person for being heard, hear him and dispose of such representation in such manner and within such period as may be prescribed.

(2) 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, any person interested may give notice of opposition to the Controller in the prescribed manner on any of the following grounds, namely:--

(a) that the patentee or the person under or through whom he claims, wrongfully obtained the invention or any part thereof from him or from a person under or through whom he claims;

(b) that the invention so far as claimed in any claim of the complete specification has been published before the priority date of the claim--

(i) in any specification filed in pursuance of an application for a patent made in India on or after the 1st day of January, 1912; or

(ii) in India or elsewhere, in any other document:

Provided that the ground specified in sub-clause (ii) shall not be available where such publication does not constitute an anticipation of the invention by virtue of subsection (2) or subsection (3) of section 29;

(c) that the invention so far as claimed in any claim of the complete specification is claimed in a claim of a complete specification published on or after the priority date of the claim of the patentee and filed in pursuance of an application for a patent in India, being a claim of which the priority date is earlier than that of the claim of the patentee;

(d) that the invention so far as claimed in any claim of the complete specification was publicly known or publicly used in India before the priority date of that claim.

*Explanation.*--For the purposes of this clause, an invention relating to a process for which a patent is granted shall be deemed to have been publicly known or publicly used in India before the priority date of the claim if a product made by that process had already been imported into India before that date except where such importation has been for the purpose of reasonable trial or experiment only;

(e) that the invention so far as claimed in any claim of the complete specification is obvious and clearly does not involve any inventive step, having regard to the matter published as mentioned in clause (b) or having regard to what was used in India before the priority date of the claim;

(f) that the subject of any claim of the complete specification is not an invention within the meaning of this Act, or is not patentable under this Act;

(g) that the complete specification does not sufficiently and clearly describe the invention or the method by which it is to be performed;

(h) that the patentee has failed to disclose to the Controller the information required by section 8 or has furnished the information which in any material particular was false to his knowledge;

(i) that in the case of a patent granted on convention application, the application for patent was not made within twelve months from the date of the first application for protection for the invention made in a convention country or in India by the patentee or a person from whom he derives title;

(j) that the complete specification does not disclose or wrongly mentions the source and geographical origin of biological material used for the invention;

(k) that the invention so far as claimed in any claim of the complete specification was anticipated having regard to the knowledge, oral or otherwise, available within any local or indigenous community in India or elsewhere, but on no other ground.

(3) (a) Where any such notice of opposition is duly given under sub-section (2), the Controller shall notify the patentee.

(b) On receipt of such notice of opposition, the Controller shall, by order in writing, constitute a Board to be known as the Opposition Board consisting of such officers as he may determine and refer such notice of opposition along with the documents to that Board for examination and submission of its recommendations to the Controller.



(c) Every Opposition Board constituted under clause (b) shall conduct the examination in accordance with such procedure as may be prescribed.

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

(5) While passing an order under sub-section (4) in respect of the ground mentioned in clause (d) or clause (e) of sub-section (2), the Controller shall not take into account any personal document or secret trial or secret use.

(6) In case the Controller issues an order under sub-section (4) that the patent shall be maintained subject to amendment of the specification or any other document, the patent shall stand amended accordingly.

### **Contents of specifications.**

SEC 10 : (1) Every specification, whether provisional or complete, shall describe the invention and shall begin with a title sufficiently indicating the subject-matter to which the invention relates.

(2) Subject to any rules that may be made in this behalf under this Act, drawings may, and shall, if the Controller so requires, be supplied for the purposes of any specification, whether complete or provisional; and any drawings so supplied shall, unless the Controller otherwise directs, be deemed to form part of the specification, and references in this Act to a specification shall be construed accordingly.

(3) If, in any particular case, the Controller considers that an application should be further supplemented by a model or sample of anything illustrating the invention or

alleged to constitute an invention, such model or sample as he may require shall be furnished <sup>1</sup>[before the application is found in order for grant of a patent], but such model or sample shall not be deemed to form part of the specification.

(4) Every complete specification shall--

(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; and

(c) end with a claim or claims defining the scope of the invention for which protection is claimed.

<sup>2</sup>[(d) be accompanied by an abstract to provide technical information on the invention: Provided that--

(i) the Controller may amend the abstract for providing better information to third parties; and

(ii) 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), and if such material is not available to the public, the application shall be completed by depositing <sup>3</sup>[the material to an international depository authority under the Budapest Treaty] and by fulfilling the following conditions, namely:--

<sup>4</sup>[(A) 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];

(B) 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;

(C) access to the material is available in the depository institution only after the date of the application for patent in India or if priority is claimed after the date of the priority;

(D) disclose the source and geographical origin of the biological material in the specification, when used in an invention.]

(4A) In case of an international application designating India, the title, description, drawings, abstract and claims filed with the application shall be taken as the complete specification for the purposes of this Act.]

[(5) The claim or claims of a complete specification shall relate to a single invention, or to a group of inventions linked so as to form a single inventive concept, shall be clear and succinct and shall be fairly based on the matter disclosed in the specification.]

(6) A declaration as to the inventorship of the invention shall, in such cases as may be prescribed, be furnished in the prescribed form with the complete specification or within such period as may be prescribed after the filing of that specification.

(7) Subject to the foregoing provisions of this section, a complete specification filed after a provisional specification may include claims in respect of developments of, or additions to, the invention which was described in the provisional specification, being developments or additions in respect of which the applicant would be entitled under the provisions of section 6 to make a separate application for a patent.

**Rights of the Patentee (Sec.48 of Patents Act, 1970);-** Where a patent covers a product, the grant of patent gives the patentee the exclusive right to prevent others from performing, without authorisation, the act of making, using, offering for sale, selling or

importing that product for the above purpose. Where a patent covers a process, the patentee has the exclusive right to exclude others from performing, without his authorisation, the act of using that process, using and offering for sale, selling or importing for those purposes, the product obtained directly by that process in India. Where a patent is granted to two or more persons, each of those persons will be entitled to an equal undivided share in the patent unless there is an agreement to the contrary.

The Paris Convention is an international convention for promoting trade among the member countries, devised to facilitate protection of industrial property simultaneously in the member countries without any loss in the priority date. All the member countries provide national treatment to all the applications from the other member countries for protection of industrial property rights. The convention was first signed in 1883. Since then the Convention has been revised several times; in 1900 at Brussels, in 1911 at Washington, in 1925 at the Hague, in 1934 at London, in 1958 at Lisbon and in 1967 at Stockholm. The last amendment took place in 1979. India became a member of the Paris Convention on December 7, 1998. The principal features of the Paris Convention are: • National treatment • Right of priority • Independence of patents • Parallel importation • Protection against false indications and unfair competition

The Paris convention recognized that non working of registered patents may amount to abuse of the patent system. • Article 5A (2) permits members of Paris union to “take legislative measures for the grant of compulsory licenses, to prevent the abuses which might result from the exercise of exclusive rights conferred by the patent. For example - failure to work. 57 • According, to Article 5A (3) persistent inaction on the part of the patent holder may even be remedied by forfeiture, of the patent right, but not before the expiration of two years from the grant of a first compulsory license. • According to Article 5A (4) however insufficient working shall not result in compulsory license before the expiration period of 4 years from the date of filing of patent application or 3 years from the date of grant of patent, whichever period expires last. The patent holder is allowed to justify his inactions by legitimate reasons stemming

from “the existence of legal, economic, technical obstacles to exploitation, or more intensive exploitation of the patent in the country”.

## **TRANSFER OF PATENT RIGHT:**

### Assignment

The term 'assignment' is not characterized in the Indian Patents Act. It is a demonstration by which the patentee does out entire or part of his patent rights to the appointee who secures the option to keep others from making, utilizing, practicing, or distributing the innovation.

### Mortgage:

- A mortgage is an understanding wherein the patent rights are entirely or somewhat moved to appointee as a trade-off for an amount of cash. When the assignor reimburses the total to the trustee, the patent rights are reestablished to assignor/patentee. The individual in whose favor a loan is made is not qualified to have his name entered in the register as the owner, yet he can get his name entered in the register as mortgagee.

### Licenses:

- The Patents Act permits a patentee to give a License by the method of understanding under segment 70 of the Act. A patentee by the method of conceding a permit may allow a licensee to make, use, or exercise the creation. A permit allowed is not substantial except if it is recorded as a hard copy. The permit is contract endorsed by the licensor and the licensee recorded as a hard copy and the terms settled upon by them including the installment of eminences at a rate referenced for all articles made under the patent. Licenses are of the accompanying sorts:
  - Legal License (such as obligatory License)
  - Elite/Limited License
  - Express/Implied License

## **GRANT OF PATENT:**

**Se 43. Provides for Grant of patents.--**(1) Where an application for a patent has been found to be in order for grant of the patent and either--

(a) the application has not been refused by the Controller by virtue of any power vested in him by this Act; or

(b) the application has not been found to be in contravention of any of the provisions of this Act,

the patent shall be granted as expeditiously as possible to the applicant or, in the case of a joint application, to the applicants jointly, with the seal of the patent office and the date on which the patent is granted shall be entered in the register.

(2) On the grant of patent, the Controller shall publish the fact that the patent has been granted and thereupon the application, specification and other documents related thereto shall be open for public inspection.

### **Infringement of Patents:-**

Infringement of a patent consists of the unauthorized making, importing, using, offering for sale or selling any patented invention within the India.

Remedies against infringement of a patented invention

1. Interlocutory Injunction A patent owner at the start of a trial can request for an interim injunction to restrain the defendant from committing the acts complained of until the hearing of the action or further orders. Permanent injunction is given based on the merits of the case at the end of the trial.
2. Relief of damages: An award of damages focuses on the losses sustained by the claimant. A patent owner is entitled to the relief of damages as compensation to the patentee and not punishment to the infringer.
3. Account of profits: Account of profits focuses on the profits made by the defendant, without reference to the damage suffered by the claimant at the hands of the defendant. The purpose of the account is to prevent the unjust enrichment of the defendant by the use of the claimant's invention. The patent owner may also opt for the account of profits where he has to prove use of invention and the amount of profit derived from such illegal use.
4. Penalties
  - 1) Contravention of secrecy provisions relating to certain inventions (Sec.118) - If any person fails to comply with any directions given under section 35 or makes or causes to be made an application in contravention of section 39 he shall be punishable with

imprisonment up to 2 years or with fine or with both. (Section 35 deals with secrecy directions relating to inventions relevant for defence purposes and Section 39 deals with residents not to apply for patents outside India without prior permission. 2) Falsification of entries in register etc (Sec.119) - If any person makes, or causes to be made, a false entry in any register kept under this Act, he shall be punishable with imprisonment for a term that may extend to 2 years or with fine or with both. 3) Unauthorized claim of patent rights (Sec.120) - If any person falsely represents that any article sold by him is patented in India or is the subject of an application for a patent in India, he will be punishable with fine that may extend to Rs.1,00,000. The use of words 'patent', 'Patented', 'Patent applied for', 'Patent pending', 'Patent registered' without mentioning the name of the country means they are patented in India or patent applied for in India.

### **Sec 53 provide for Term of patent:**

Every patent granted, after the commencement of the Patents (Amendment) Act, 2002, and the term of every patent which has not expired and has not ceased to have effect, on the date of such commencement, under this Act, shall be twenty years from the date of filing of the application for the patent. For the purposes of this sub-section, the term of patent in case of International applications filed under the Patent Cooperation Treaty designating India, shall be twenty years from the international filing date accorded under the Patent Cooperation Treaty. A patent shall cease to have effect notwithstanding anything therein or in this Act on the expiration of the period prescribed for the payment of any renewal fee, if that fee is not paid within the prescribed period<sup>3</sup>[or within such extended period as may be prescribed]. Notwithstanding anything contained in any other law for the time being in force, on cessation of the patent right due to non-payment of renewal fee or on the expiry of the term of patent, the subject matter covered by the said patent shall not be entitled to any protection. **Section 60 provides that** Where a patent has ceased to have effect by reason of failure to pay any renewal fee within the<sup>1</sup>[period prescribed under section 53 or within such period as may be allowed under sub-section (4) of section 142], the patentee or his legal representative,

and where the patent 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 <sup>2</sup>[eighteen months] from the date on which the patent ceased to have effect, make an application for the restoration of the patent. An application under this section shall contain a statement, verified in the prescribed manner, fully setting out the circumstances which led to the failure to pay the prescribed fee, and the Controller may require from the applicant such further evidence as he may think necessary.

### **REVOCAION AND SURRENDER OF PATENTS:**

Sec 63 provides for **surrender of patents**: A patentee may, at any time by giving notice in the prescribed manner to the Controller, offer to surrender his patent. Where such an offer is made, the Controller shall <sup>1</sup>[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. Any person interested may, within the prescribed period after <sup>2</sup>[such publication] give notice to the Controller of opposition to the surrender, and where any such notice is given the Controller shall notify the patentee. 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.

### **Revocation of Power patents:**

(1) Subject to the provisions contained in this Act, a patent whether granted before or after the commencement of this Act, may, <sup>1</sup>[be revoked on a petition of any person interested or of the Central Government by <sup>2\*\*\*</sup> on a counter-claim in a suit for infringement of the patent by the High Court] on any of the following grounds, that is to say--



- (a) that the invention, so far as claimed in any claim of the complete specification, was claimed in a valid claim of earlier priority date contained in the complete specification of another patent granted in India;
- (b) that the patent was granted on the application of a person not entitled under the provisions of this Act to apply therefor;
- (c) that the patent was obtained wrongfully in contravention of the rights of the petitioner or any person under or through whom he claims;
- (d) that the subject of any claim of the complete specification is not an invention within the meaning of this Act;
- (e) that the invention so far as claimed in any claim of the complete specification is not new, having regard to what was publicly known or publicly used in India before the priority date of the claim or to what was published in India or elsewhere in any of the documents referred to in section 13:
- (f) that the invention so far as claimed in any claim of the complete specification is obvious or does not involve any inventive step, having regard to what was publicly known or publicly used in India or what was published in India or elsewhere before the priority date of the claim:
- (g) that the invention, so far as claimed in any claim of the complete specification, is not useful;
- (h) that the complete specification does not sufficiently and fairly describe the invention and the method by which it is to be performed, that is to say, that the description of the method or the instructions for the working of the invention as contained in the complete specification are not by themselves sufficient to enable a person in India possessing average skill in, and average knowledge of, the art to which the invention relates, to work the invention, or that it does not disclose the best method of performing it which was known to the applicant for the patent and for which he was entitled to claim, protection;
- (i) that the scope of any claim of the complete specification is not sufficiently and clearly defined or that any claim of the complete specification is not fairly based on the matter disclosed in the specification;

- (j) that the patent was obtained on a false suggestion or representation;
- (k) that the subject of any claim of the complete specification is not patentable under this Act;
- (l) that the invention so far as claimed in any claim of the complete specification was secretly used in India, otherwise than as mentioned in sub-section (3), before the priority date of the claim;
- (m) that the applicant for the patent has failed to disclose to the Controller the information required by section 8 or has furnished information which in any material particular was false to his knowledge;
- (n) that the applicant contravened any direction for secrecy passed under section 35<sup>4</sup>[or made or caused to be made an application for the grant of a patent outside India in contravention of section 39];
- (o) that leave to amend the complete specification under section 57 or section 58 was obtained by fraud;
- (p) that the complete specification does not disclose or wrongly mentions the source or geographical origin of biological material used for the invention;
- (q) that the invention so far as claimed in any claim of the complete specification was anticipated having regard to the knowledge, oral or otherwise, available within any local or indigenous community in India or elsewhere.]

(2) For the purposes of clauses (e) and (f) of sub-section (1),--

(a) no account shall be taken of<sup>5</sup>[personal document or secret trial or secret use]; and

(b) where the patent is for a process or for a product as made by a process described or claimed the importation into India of the product made abroad by that process shall constitute knowledge or use in India of the invention on the date of the importation, except where such importation has been for the purpose of reasonable trial or experiment only.

(3) For the purpose of clause (l) of sub-section (1), no account shall be taken of any use of the invention--

(a) for the purpose of reasonable trial or experiment only; or

(b) by the Government or by any person authorised by the Government or by a Government undertaking, in consequence of the applicant for the patent or any person from whom he derives title having communicated or disclosed the invention directly or indirectly to the Government or person authorised as aforesaid or to the Government undertaking; or

(c) by any other person, in consequence of the applicant for the patent or any person from whom he derives title having communicated or disclosed the invention, and without the consent or acquiescence of the applicant or of any person from whom he derives title.

(4) Without prejudice to the provisions contained in sub-section (1), a patent may be revoked by the High Court on the petition of the Central Government, if the High Court is satisfied that the patentee has without reasonable cause failed to comply with the request of the Central Government to make, use or exercise the patented invention for the purposes of Government within the meaning of section 99 upon reasonable terms.

(5) A notice of any petition for revocation of a patent under this section shall be served on all persons appearing from the register to be proprietors of that patent or to have shares or interests therein and it shall not be necessary to serve a notice on any other person.

### **VARIOUS POWERS OF CONTROLLER UNDER THE Act**

The Patents Act empowers the Controller with various powers and responsibilities as follows for performing certain duties –

Section 15 – If the Controller is satisfied that the application or any specification or any other document filed in pursuance thereof does not comply with the requirements of this Act or of any rules made thereunder, the Controller may refuse the application or may require the application, specification or the other documents, as the case may be, to be amended to his satisfaction before he proceeds with the application and refuse the application on failure to do so.

Section 16 – The Controller can make orders respecting division of application if the the claims of the complete specification relate to more than one invention.

Section 17 – The Controller can make orders to post-date a patent application upon a request made by the applicant to such date (not later than six months from the date on which the application was actually made) as may be specified in the request.

Section 18 – The Controller can refuse a patent application in case of anticipation unless the applicant 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 if the applicant amends his complete specification to the satisfaction of the Controller.

Section 19 – The Controller can direct that a reference to another patent shall be inserted in the applicant's complete specification by way of notice to the public if he thinks that the patent application's invention cannot be performed without substantial risk of infringement of a claim of that other patent unless the applicant shows to the satisfaction of the Controller that there are reasonable grounds for contesting the validity of the claim of the other patent or the complete specification is amended to the satisfaction of the Controller.

Section 20 – The Controller can direct that the patent 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 in case if he thinks the claimant would be entitled or to the interest of the applicant or to an undivided share of the patent or of that interest.

Section 77 – The Controller has the powers of a civil court while trying a suit under the Code of Civil Procedure, 1908 in respect of the following matters

- 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) awarding costs;
- f) reviewing his own decision on application made within the prescribed time and in the prescribed manner;
- g) setting aside an order passed ex- parte on application made within the prescribed

time and in the prescribed manner;

h) any other matter which may be prescribed.

Section 78 – The Controller has the power to correct any clerical error in any patent or in any specification or other document filed in pursuance of such application or in any application for a patent or any clerical error in any matter which is entered in the register.

Section 79 – The Controller has the power to take oral evidence in lieu of, or in addition to, evidence by an affidavit, or may allow any party to be cross-examined on the contents of his affidavit.

Section 81 – The Controller may extend the time for doing any act, nothing in this Act shall be deemed to require him to give notice to or hear the party interested in opposing the extension, nor shall any appeal lie from any order of the Controller granting such extension.

Section 86 – The Controller may by order adjourn the further hearing of the patent application for such period not exceeding twelve months in the aggregate as appears to him to be sufficient for the invention to be so worked if he is satisfied that the time which has elapsed since the sealing of the patent has for any reason been insufficient to enable the invention to be worked on a commercial scale to an adequate extent or to enable the invention to be so worked to the fullest extent that is reasonably practicable.

Section 88 – The Controller may order the grant of licences under the patent to such customers of the applicant as he thinks fit as well as to the applicant if he is satisfied on an application made under section 84 that the manufacture, use or sale of materials not protected by the patent is prejudiced 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.

Section 131 – The Controller may refuse to recognise as agent in respect of any business under this Act –

- a) any individual whose name has been removed from, and not restored to, the register;
- b) any person who has been convicted of an offence under section 123;
- c) any person, not being registered as a patent agent, who in the opinion of the

Controller is engaged wholly or mainly; in acting as agent in applying for patents in India or elsewhere in the name or for the benefit of the person by whom he is employed;

d) any company or firm, if any person whom the Controller could refuse to recognise as agent in respect of any business under this Act, is acting as a director or manager of the company or is a partner in the firm. Moreover, the Controller shall refuse to recognise as agent in respect of any business under this Act any person who neither resides nor has a place of business in India.

Section 146 – The Controller may, at any time during the continuance of the patent, by notice in writing, require a patentee or a licensee, exclusive or otherwise, to furnish to him within two months from the date of such notice or within such further time as the Controller may allow, such information or such periodical statements as to the extent to which the patented invention has been commercially worked in India as may be specified in the notice.

Therefore Patent implies the granting of a property right by a sovereign authority to an inventor. A Patent provides the inventor an exclusive right for an invention up to a certain period in exchange for a complete disclosure of the invention. Patent Infringement is violation of the rights of a patent and different types of infringement need to be defended differently. It is very important for business to conduct proper research before filing for a patent in order to ensure that their invention is novel and non obvious. This in turn will help to minimise the risk associated with infringement. These rights prohibit others from making, selling, or using the invention without permission for a while. The **Patent Corporation Treaty (PCT)** guides applicants in seeking patent protection internationally for their inventions through a single patent application where a patent can be filed in a large number of countries.

## Copyright

### Introduction:

Modern copyright law developed in India gradually, in a span of more than 150 years. Copyright law entered India in 1847 through an enactment during the East India Company's regime. According to the 1847 enactment, the term of copyright was for the lifetime of the author plus seven years post-mortem. But in no case could the total term of copyright exceed a period of forty-two years. The government could grant a compulsory licence to publish a book if the owner of copyright, upon the death of the author, refused to allow its publication. The act of infringement comprised in a person's unauthorized printing of a copyright work for (or as a part of attempt of) "sale hire, or exportation", or "for selling, publishing or exposing to sale or hire". Suit or action for infringement was to be instituted in the "highest local court exercising original civil jurisdiction." The Act provided specifically that under a contract of service copyright in "any encyclopedia, review, magazine, periodical work or work published in a series of books or parts" shall vest in the "proprietor, projector, publisher or conductor." Infringing copies were deemed to be copies of the proprietor of copyrighted work. Importantly, unlike today, copyright in a work was not automatic. Registration of copyright with the Home Office was mandatory for the enforcement of rights under the Act. However, the Act also specifically reserved the subsistence of copyright in the author, and his right to sue for its infringement to the extent available in law other than the 1847 Act. At the time of its introduction in India, copyright law had already been under development in Britain for over a century and the provisions of the 1847 enactment reflected the learnings from deliberations during this period. In 1914, the then Indian legislature enacted a new Copyright Act which merely extended most portions of the United Kingdom Copyright Act of 1911 to India. It did, however, make a few minor modifications. First, it introduced criminal sanctions for copyright infringement (sections 7 to 12). Second, it modified the scope of the term of copyright;

under section 4 the "sole right" of the author to "produce, reproduce, perform or publish a translation of the work shall subsist only for a period of ten years from the date of the first publication of the work." The author, however, retained her "sole rights" if within the period of ten years she published or authorised publication of her work a translation in any language in respect of that language. The 1914 Act was continued with minor adaptations and modifications till the 1957 Act was brought into force on 24th January, 1958. History of Patent Law in India The first legislation in India relating to patents was the Act VI of 1856. The objective of this legislation was to encourage inventions of new and useful manufactures and to induce inventors to disclose secret of their inventions. The Act was subsequently repealed by Act IX of 1857 since it had been enacted without the approval of the sovereign. Fresh legislation for granting 'exclusive privileges' was introduced in 1859 as Act XV of 1859. This legislation contained certain modifications of the earlier legislation, namely, grant of exclusive privileges to useful inventions only and extension of priority period from 6 to 12 months. The Act excluded importers from the definition of inventor. The 1856 Act was based on the United Kingdom Act of 1852 with certain departures including allowing assignees to make application in India and also taking prior public use or publication in India or United Kingdom for the purpose of ascertaining novelty.

The benefits of copyright protection are:

- It provides a practical means of protecting original content.
- It helps give people credit for the work they do.
- It grants the only authority for reproduction, duplication, transcription, and translation to the owner of the original work.
- The original work's owner has the power to stop unauthorised use of it and to pursue legal action in the case of infringement.
- Copyright encourages society to be creative by allowing owners to benefit from and have their creative work protected.

### **Subject Matter of Copyright**



**Original Musical Work:** Original musical works involve the composition of music, potentially incorporating graphical notations. Excluded are works intended for singing, speaking, or performing with music. The 2012 Amendment introduced statutory licenses for cover versions, allowing specific adaptations of existing musical works. It's noteworthy that a song typically comprises both literary and musical elements, with distinct rights possibly owned by different individuals.

**Original Artistic Work:** Original artistic works, as defined in the Copyright Act, include diverse creative expressions such as sculptures, drawings, paintings, and photographs. Unlike other categories, artistic quality is not a prerequisite for copyright protection. Authorship of an artistic work lies with the creator, with specific considerations for works of artistic craftsmanship and architectural creations.

**Original Dramatic Work:** An original dramatic work encompasses various forms, including recitations, choreography, and non-verbal expressions of entertainment. The author of a dramatic work is responsible for crafting characters, plot, and dialogue, whether expressed in written form or other mediums. The principles applicable to literary works extend to dramatic works, highlighting the interrelationships between these categories.

**Cinematography Films:** Cinematography films encompass visual recordings capturing moving images, potentially accompanied by sound recordings. Producers in cinematography are credited with authorship, overseeing the creative and financial aspects of film production. This category extends to works created through processes akin to cinematography, such as video films.

**Original Literary Work:** Original literary works span a wide range of written expressions, including novels, poems, plays, essays, and computer programs. To qualify for copyright protection, a literary work must showcase originality and intellectual effort. The author, responsible for creating the literary work, enjoys exclusive control over both published and unpublished creations.

Sound Recordings: Sound recordings involve the recorded representation of sounds that can be reproduced, encompassing music, vocals, or other audio elements. Within copyright, the individual responsible for the recording process is typically acknowledged as the author of the sound recording, highlighting the unique creative aspects of capturing and reproducing audio elements.

The general meaning of "Originality" is something newly developed or recently discovered which didn't happen previously. The term "originality" is often applied as a compliment to the creativity of artists, writers, and thinkers. SECTION 13(1)(a) of the Copyright Act, 1957 states that copyright shall exist in all original literary, dramatic, musical & other artistic works done by people across india. The aspect of Originality in the Copyright Act, 1957 prevents the new creation, artistic work, or inventions from forgeries, reproducing similar creations, or other unoriginal works. Originality in the art form inspires artists, creators, inventors to do more and people take it as a compliment for their creative work.

The Act does not state what 'original' means. In law, more stress is laid on how an idea had been expressed. There is no definite and single, unified concept of "originality" and there have been different doctrines which have tried to define the concept. **University of London Press Ltd. V. University Tutorial Press Ltd.** In University of London Press Ltd. V. University Tutorial Press Ltd., the court held the word 'original' must be construed to mean as originality of expression. There is no requirement for revolutionary and unprecedented new ideas but the way thought is expressed must be original. In order for a work to gain copyright protection, it must originate from the author – the legal meaning given to 'original'.

### **MEANING OF COPYRIGHT:**

**Sec 14 of th Act say that** copyright means the exclusive right subject to the provisions of this Act, to do or authorise the doing of any of the following acts in respect of a work or any substantial part thereof, namely--

(a) in the case of a literary, dramatic or musical work, not being a computer programme,--

(i) to reproduce the work in any material form including the storing of it in any medium by electronic means;

(ii) to issue copies of the work to the public not being copies already in circulation;

(iii) to perform the work in public, or communicate it to the public;

(iv) to make any cinematograph film or sound recording in respect of the work;

(v) to make any translation of the work;

(vi) to make any adaptation of the work;

(vii) 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);

(b) in the case of a computer programme:

(i) to do any of the acts specified in clause (a);

(ii) to sell or give on commercial rental or offer for sale or for commercial rental any copy of the computer programme:

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.]

(c) in the case of an artistic work,--

(i) to reproduce the work in any material form including--

(A) the storing of it in any medium by electronic or other means; or

(B) depiction in three-dimensions of a two-dimensional work; or

(C) depiction in two-dimensions of a three-dimensional work;]

(d) in the case of a cinematograph film,--

(i) to make a copy of the film, including--

(A) a photograph of any image forming part thereof; or

(B) storing of it in any medium by electronic or other means;]

(ii) to sell or give on commercial rental or offer for sale or for such rental, any copy of the film.

(iii) to communicate the film to the public;

(e) in the case of a sound recording,--

(i) to make any other sound recording embodying it <sup>6</sup>[including storing of it in any medium by electronic or other means];

(ii) to sell or give on commercial rental or offer for sale or for such rental, any copy of the sound recording;]

(iii) to communicate the sound recording to the public.

*Explanation.-* For the purposes of this section, a copy which has been sold once shall be deemed to be a copy already in circulation].

**Sec 17 provides for the First owner of copyright:**

Subject to the provisions of this Act, the author of a work shall be the first owner of the copyright therein:

Provided that--

(a) in the case of a literary, dramatic or artistic work made by the author in the course of his employment by the proprietor of a newspaper, magazine or similar periodical under

a contract of service or apprenticeship, for the purpose of publication in a newspaper, magazine or similar periodical, the said proprietor shall, in the absence of any agreement to the contrary, be the first owner of the copyright in the work in so far as the copyright relates to the publication of the work in any newspaper, magazine or similar periodical, or to the reproduction of the work for the purpose of its being so published, but in all other respects the author shall be the first owner of the copyright in the work;

(b) subject to the provisions of clause (a), in the case of a photograph taken, or a painting or portrait drawn, or an engraving or a cinematograph film made, for valuable consideration at the instance of any person, such person shall, in the absence of any agreement to the contrary, be the first owner of the copyright therein;

(c) in the case of a work made in the course of the authors employment under a contract of service or apprenticeship, to which clause (a) or clause (b) does not apply, the employer shall, in the absence of any agreement to the contrary, be the first owner of the copyright therein;

(cc) in the case of any address or speech delivered in public, the person who has delivered such address or speech or if such person has delivered such address or speech on behalf of any other person, such other person shall be the first owner of the copyright therein notwithstanding that the person who delivers such address or speech, or, as the case may be, the person on whose behalf such address or speech is delivered, is employed by any other person who arranges such address or speech or on whose behalf or premises such address or speech is delivered;]

(d) in the case of a Government work, Government shall, in the absence of any agreement to the contrary, be the first owner of the copyright therein;

(dd) in the case of a work made or first published by or under the direction or control of any public undertaking, such public undertaking shall, in the absence of any agreement to the contrary, be the first owner of the copyright therein.

*Explanation.--* For the purpose of this clause and section 28A, public undertaking means--

(i) an undertaking owned or controlled by Government; or

(ii) a Government company as defined in Section 617 of the Companies Act, 1956 (1 of 1956); or

(iii) a body corporate established by or under any Central, Provincial or State Act;]

(e) in the case of a work to which the provisions of section 41 apply, the international organisation concerned shall be the first owner of the copyright therein.

<sup>2</sup>[ Provided that in case of any work incorporated in a cinematograph work, nothing contained in clauses (b) and (c) shall affect the right of the author in the work referred to in clause (a) of sub-section (1) of section 13.]

## **TERM OF COPYRIGHT:**

### **SEC 22: Term of copyright in published literary, dramatic, musical and artistic works**

Except as otherwise hereinafter provided, copyright shall subsist in any literary, dramatic, musical or artistic work published within the lifetime of the author

until [sixty years] from the beginning of the calendar year next following the year in which the author dies.

*Explanation.*--In this section the reference to the author shall, in the case of a work of joint authorship, be construed as a reference to the author who dies last.

### **SEC 23: Term of copyright in anonymous and pseudonymous works**

(1) In the case of literary, dramatic, musical or artistic work (other than a photograph), which is published anonymously or pseudonymously, copyright shall subsist until <sup>1</sup>[sixty years] from the beginning of the calendar year 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 <sup>1</sup>[sixty years] from the beginning of the calendar year next following the year in which the author dies.

(2) In sub-section (1), references to the author shall, in the case of an anonymous work of joint authorship, be construed,--

(a) where the identity of one of the authors is disclosed, as references to that author;

(b) where the identity of more authors than one is disclosed, as references to the author who dies last from amongst such authors.

(3) In sub-section (1), references to the author shall, in the case of a pseudonyms work of joint authorship, be construed,--

(a) where the names of one or more (but not all) of the authors are pseudonyms and his or their identity is not disclosed, as references to the author whose name is not a pseudonym, or, if the names of two or more of the authors are not pseudonyms, as references to such of those authors who dies last;

(b) where the names of one or more (but not all) of the authors are pseudonyms and the identity of one or more of them is disclosed, as references to the author who dies last from amongst the authors whose names are not pseudonyms and the authors whose names are pseudonyms and are disclosed; and

(c) where the names of all the authors are pseudonyms and the identity of one of them is disclosed, as references to the author whose identity is disclosed or if the identity of two or more of such authors is disclosed, as references to such of those authors who dies last.

*Explanation.*--For the purposes of this section, the identity of an author shall be deemed to have been disclosed, if either the identity of the author is disclosed publicly by both the author and the publisher or is otherwise established to the satisfaction of the <sup>2</sup>[Commercial Court] by that author.

### **ASSIGNMENT AND MODES OF ASSIGNMENT:**

Sec 18 : Assignment of copyright;

(1) The owner of the copyright in an existing work 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:

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



Provided further that no such assignment shall be applied to any medium or mode of exploitation of the work which did not exist or was not in commercial use at the time when the assignment was made, unless the assignment specifically referred to such medium or mode of exploitation of the work:

Provided also that 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 utilisation 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 copyright society for collection and distribution and any agreement to contrary shall be void:

Provided also that the author of the literary or musical work included in the sound recording but not forming part of any 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 any utilisation of such work except to the legal heirs of the authors or to a collecting society for collection and distribution and any assignment to the contrary shall be void.]

(2) Where the assignee of a copyright becomes entitled to any right comprised in the copyright, the assignee as respects the rights so assigned, and the assignor as respects the rights not assigned, shall be treated for the purposes of this Act as the owner of copyright and the provisions of this Act shall have effect accordingly.

(3) In this section, the expression "assignee" as respects the assignment of the copyright in any future work includes the legal representatives of the assignee, if the assignee dies before the work comes into existence.

Sec 19: Mode of assignment.

(1) No assignment of the copyright in any work shall be valid unless it is in writing signed by the assignor or by his duly authorised agent.

(2) The assignment of copyright in any work shall identify such work, and shall specify the rights assigned and the duration and territorial extent of such assignment.

(3) The assignment of copyright in any work shall also specify the amount of <sup>3</sup>[royalty and any other consideration payable], to the author or his legal heirs during the currency of the assignment and the assignment shall be subject to revision, extension or termination on terms mutually agreed upon by the parties.

(4) Where the assignee does not exercise the rights assigned to him under any of the other sub-sections of this section within period of one year from the date of assignment, the assignment in respect of such right shall be deemed to have lapsed after the expiry of the said period unless otherwise specified in the assignment.

(5) If the period of assignment is not stated, it shall be deemed to be five years from the date of assignment.

(6) If the territorial extent of assignment of the rights is not specified, it shall be presumed to extend within India.

(7) Nothing in sub-section (2) or sub-section (3) or sub-section (4) or sub-section (5) or sub-section (6) shall be applicable to assignments made before the coming into force of the Copyright (Amendment) Act, 1994.

(8) The assignment of copyright in any work contrary to the terms and conditions of the rights already assigned to a copyright society in which the author of the work is a member shall be void.

(9) No assignment of copyright in any work to make a cinematograph film shall affect the right of the author of the work to claim an equal share of royalties and consideration payable in case of utilisation of the work in any form other than for the communication to the public of the work, along with the cinematograph film in a cinema hall.

(10) No assignment of the copyright in any work to make a sound recording which does not form part of any cinematograph film shall affect the right of the author of the work

to claim an equal share of royalties and consideration payable for any utilisation of such work in any form.

**Sec 24 : Term of copyright in posthumous work.**

(1) 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 the author who dies last, but which, or any adaptation of which, has not been published before that date, copyright shall subsist until <sup>1</sup>[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.

(2) For the purposes of this section a literary, dramatic or musical work or an adaptation of any such work shall be deemed to have been published, if it has been performed in public or if any <sup>2</sup>[sound recordings] made in respect of the work have been sold to the public or have been offered for sale to the public.

**Sec 26 Term of copyright in cinematograph films:**

In the case of a cinematograph film, copyright shall subsists until <sup>1</sup>[sixty years] from the beginning of the calendar year next following the year in which the film is published.

**Se 27: Term of copyright in sound recording:**

In the case a <sup>1</sup>[sound recording] copyright shall subsist until <sup>2</sup>[sixty years] from the beginning of the calendar year next following the year in which the <sup>1</sup>[sound recording] is published.

**Sec 28: 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 <sup>1</sup>[sixty years] from the beginning of the calendar year next following the year in which the work is first published.

Sec 28A: **28A. Term of copyright 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 <sup>2</sup>[sixty years] from the beginning of the calendar year next following the year in which the work is first published.

**Se 29 : Term of copyright in works of international organisations**

In the case of a work of an international organisation to which the provisions of section 41 apply, copyright shall subsist until <sup>1</sup>[sixty years] from the beginning of the calendar year next following the year in which the work is first published.

**Compulsory licence**

**Compulsory licence in works withheld from public:**

(1) If at any time during the term of copyright in <sup>1</sup>[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 a licence to republish the work, perform the work in public or communicate the work to the public by [broadcast], as the case may be, subject to payment to the owner of the copyright of such compensation and subject to such other terms and conditions as the [Commercial Court] may determine; and thereupon the Registrar of Copyrights shall grant the [licence to such person or persons who, in the opinion of the [Commercial Court], is or are qualified to do so] in accordance with the directions of the [Commercial Court], on payment of such fee as may be prescribed.

### **INFRINGEMENT AND NOT INFRINGEMENT OF COPYRIGHT:**

When copyright infringed.— Copyright in a work shall be deemed to be infringed—

- (a) when any person, without a licence granted by the owner of the copyright or the Registrar of Copyrights under this Act or in contravention of the conditions of a licence so granted or of any condition imposed by a competent authority under this Act— (i) does anything, the exclusive right to do which is by this Act conferred upon the owner of the copyright, or 1 [(ii) permits for profit any place to be used for the communication of the work to the public where such communication constitutes an infringement of the copyright in the work, unless he was not aware and had no reasonable ground for believing that such communication to the public would be an infringement of copyright; or]
- (b) when any person— (i) makes for sale or hire, or sells or lets for hire, or by way of trade displays or offers for sale or hire, or (ii) distributes either for the purpose of trade or to such an extent as to affect prejudicially the owner of the copyright, or (iii) by way of trade exhibits in public, or (iv) imports into India, any infringing copies of the work: 3

[Provided that nothing in sub-clause (iv) shall apply to the import of one copy of any work for the private and domestic use of the importer.] Explanation.— For the purposes of this section, the reproduction of a literary, dramatic, musical or artistic work in the form of a cinematograph film shall be deemed to be an “infringing copy”

Certain acts do not result in copyright infringement. Such acts/uses of copyrighted works are allowed without permission from the copyright owner. The following are the acts that do not result in copyright infringement in India are:

- A fair dealing with a work for the purposes of:
  - Personal or private use, including research
  - Review or criticism of the work
  - Reporting of current affairs and events, including the lecture delivered in public
- Adaptation or making of copies of a computer programme by the possessor of a copy of such computer programme to:
  - Usage of the computer programme for which it was supplied
  - Make backup copies as a temporary protection against destruction, loss or damage
- Storage of a performance or work
- Reproduction of work in a judicial proceeding
- Reproduction or publication of a work prepared by the Secretariat of a Legislature for the exclusive use of the Legislature members
- Reproduction of work in a certified copy supplied or made as per law
- Recitation or reading in public of reasonable extracts from a published dramatic or literary work
- Publication in a collection composed of non-copyright matter intended for instructional use of short passages from published dramatic or literary works
- Reproduction of a work by a teacher in the course of instruction, as part of the questions to be answered in an examination, or as answers to such questions

- Performance of a dramatic, literary or musical work in an educational institution by the students and staff or reproduction of a sound recording and cinematograph film when the audience is limited to staff and students
- Causing a recording to be heard in public in any residential premises in an enclosed hall or room meant for the common use of residents or as part of the activities of a club or organisation not conducted/established for profit
- Performance of a dramatic, literary or musical work by an amateur society or club, if the performance is given for the benefit of a religious institution or to a non-paying audience
- Reproduction in a magazine, newspaper or other periodicals of an article on current political, economic, religious or social topics, unless the article author has expressly reserved the right of reproduction
- Reproduction of a work for private study or research or publishing an unpublished dramatic, literary or musical work kept in a museum, library or other institutions to which the public has access
- Publishing or making a drawing, engraving, painting, display or photograph of a work of architecture
- Inclusion of an artistic work situated permanently in a public place or premises to which the public has access in a cinematograph film if such inclusion is by way of incidental or background to the principal matters represented in the film
- Making a three-dimensional object from a two-dimensional artistic work for industrial application
- Reconstruction of a structure or building as per the architectural plans or drawings

### **Remedies For Copyright Infringement**

The authors/copyright owners can take legal action against a person or entity infringing their copyrighted works. The copyright owner can file a civil case in a court having jurisdiction and is entitled to remedies by way of damages, injunctions and accounts. A criminal suit can also be filed in a court of a First Class Judicial Magistrate or Metropolitan Magistrate.

In the case of copyright infringement by an artificial judicial person like a company or Limited Liability Partnership (LLP), the company/LLP and all persons in charge at the time of committing the offence or responsible for the conduct of the business would be liable for the infringement.

### **Civil Remedies**

Where a copyrighted work has been infringed, the copyright owner is entitled to remedies of injunction, damages and accounts. However, when the infringer proves that he/she was unaware and had no reasonable ground for believing that copyright existed in work at the infringement date, the copyright owner will not be entitled to any remedy except an injunction.

**Injunction:** Injunction is the effective remedy for copyright infringement. An injunction means a judicial process through which the infringer is restrained to continue the infringing acts or is ordered to restore the position which stood before the infringement.

**Damages:** Damages are compensation provided to the copyright owner. The purpose of ordering to provide the damages to the copyright holder is to restore the owner to the earlier position. There are various factors to determine the damage amount. Generally, the damages are the amount the copyright holder would have gotten from the infringing acts if the infringer had obtained the licence for such acts. Various other factors, such as loss of reputation, loss of profit to the copyright holder, decrease in the sale of the copyright holder's work, etc., determine the damages amount.

**Accounts:** The infringer can be asked to submit an account of profits made from the sale of the copied works and pay such an amount to the copyright owner.

### **Anton Pillar Orders**

Orders of this nature are extreme, and they have broad effects. These orders consist of the following components:

- An order prohibiting the defendant from disposing of or selling counterfeit products.



- An order directing the defendant to disclose the names and addresses of suppliers and customers.
- An order allowing the plaintiff's solicitors access to the defendant's premises so they can search them and remove goods that are in their safe custody. In simple words, it is an order allowing the plaintiff's solicitors to search the defendant's premises.

#### **IV. Mareva Injunction**

It is an order that temporarily seizes a defendant's assets, preventing them from violating the judgement by selling them.

#### **Criminal Prosecution for Copyright Infringement**

When a person knowingly infringes or abets the infringing act of a copyrighted work, then the offence is a criminal offence under the Copyright Act, 1957. When the copyright owner files a criminal suit for copyright infringement, the minimum punishment for the infringement is imprisonment for six months, which can extend to three years, with a minimum fine of Rs. 50,000, which can extend up to Rs.2 lakhs.

In the case of a subsequent and second conviction, the punishment is imprisonment for a minimum of one year, extending to three years and a fine of Rs.1 lakhs, extending to Rs.2 lakhs. Any police officer (not below the sub-inspector rank) can seize the infringing copies without a warrant when the police officer is satisfied that a copyright infringement offence in any work has been committed and produce them before the Magistrate.

Copyright aims to protect the author's rights and provide them with economic benefits. The scope of copyright protection extends to all original works which demand creativity, including computer software and databases.

**Rights of Broadcasting Organisation and of Performers:** - Every broadcasting organisation will have a special right to be known as 'broadcast reproduction right' in respect of its broadcasts. The broadcast reproduction right will subsist until twenty-five years from the beginning of the calendar year next following the year in which the broadcast is made. This would prevent any person other than the broadcasting organisation from: i) Re-broadcasting what has already been broadcasted ii) Causing

the broadcast to be seen or heard by the public on payment of charges iii) Making any sound/visual recording of the broadcast iv) Making 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 v) Selling or hiring or offering to sell or hire sound/visual recordings. Where any performer appears or engages in any performance, he will have a special right known as the 'performer's right' in relation to such performance. The performer's right will subsist until 24 fifty years from the beginning of the calendar year next following the year in which the performance is made. These rights are: i) No person may make a sound/visual recording of the performer's performances ii) Reproduce a sound/visual recording iii) Broadcast the performance iv) Communicate to the public otherwise than by broadcast

Copyright exists to safeguard the rights of original work creators and to reward them financially for their hard work and ingenuity. Databases and computer software are included in the scope of copyright, as are other literary or creative works that require innovation. Although it is not essential to register a work in order to qualify for copyright protection, doing so is frequently encouraged since it will serve as legal proof in the event of a legal dispute.

## **TRADEMARK**

**INTRODUCTION:** While some form of proprietary protection for marks in India dates back several millennia, India's statutory Trademarks Law dates back to 1860. Prior to 1940 there was no official trademark Law in India. Numerous problems arose on infringement, law of passing off etc and these were solved by application of section 54 of the Specific Relief Act, 1877 and the registration was obviously adjudicated by obtaining a declaration as to the ownership of a trademark under Indian Registration Act 1908. To overcome the aforesaid difficulties the Indian Trademarks Act was passed in 1940, this corresponded with the English Trademarks Act. After this there was an increasing need for more protection of Trademarks as there was a major growth in Trade and Commerce. The replacement to this act was the Trademark and Merchandise Act, 1958. This Act was to provide for registration and better protection of Trademarks and for prevention of the use of fraudulent marks on merchandise. This Law also enables the registration of trademarks so that the proprietor of the trademark gets legal right to the exclusive use of the trademark. The objective of this act was easy registration and better protection of trademarks and to prevent fraud. 15 The repeal of the Trademarks and Merchandise Act gave rise to the Trademark Act 1999; this was done by the Government of India so that the Indian Trademark Law is in compliance with the TRIPS obligation on the recommendation of the World Trade Organisation. The object of the 1999 Act is to confer the protection to the user of the trademark on his goods and prescribe conditions on acquisition, and legal remedies for enforcement of trademark rights.

**MEANING:** A trade mark (popularly known as brand name) in layman's language 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 to distinguish it from other similar goods or services originating from a different undertaking. • The selected mark should be capable of being represented graphically (that is in the paper form). • It should be capable of distinguishing the goods or services of one undertaking from those of others. • It should be used or proposed to be used mark in relation to goods or services for the purpose of indicating or so as to indicate a connection in the course of trade between the goods or services and some person have the right to use the mark with or

without identity of that person. Trade Marks are distinctive symbols, signs, logos that help consumer to

distinguish between competing goods or services. A trade name is the name of an enterprise which individualizes the enterprise in consumer's mind. It is legally not linked to quality. But, linked in consumer's mind to quality expectation.

### Key Features of Trademark

- Trademark must be Distinctive
  - Trademark must be used in Commerce
- Types of Trademark Trademark, • Servicemark, • Collectivemark, Certification Mark

### Functions of Trademark

Trademark performs four functions – • It identifies the goods / or services and its origin; • It guarantees its unchanged quality; • It advertises the goods/services; • It creates an image for the goods/ services.

Trade Marks law of India The Trade Marks Act, 1999 and the Trade Marks Rules, 2002 govern the law relating to Trade Marks in India. The Trade Marks Act, 1999 (TMA) protects the trade marks and their infringement can be challenged by a passing off or/and infringement action. The Act protects a trade mark for goods or services, on the basis of either use or registration or on basis of both elements.

## **REGISTRATION OF TRADEMARK:**

To initiate the trademark registration online or brand name registration process in India, you will need to furnish the following initial details:

- **Applicant's Name:** The name of the individual, company, or entity applying for the trademark registration.
- **Business Type:** Specify the type of business entity, such as sole proprietorship, partnership, private limited company, etc.
- **Business Objectives:** Provide a brief description of your business objectives or activities.
- **Brand/Logo/Slogan Name:** Clearly mention the name, logo, or slogan that you intend to trademark.
- **Registration Address:** Furnish the official address of the entity applying for the trademark.

## THE REGISTER AND CONDITIONS FOR REGISTRATION:

3. Appointment of Registrar and other officers. — (1) The Central Government may, by notification in the Official Gazette, appoint a person to be known as the Controller-General of Patents, Designs and Trade Marks, who shall be the Registrar of Trade Marks for the purposes of this Act. (2) The Central Government may appoint such other officers with such designations as it thinks fit for the purpose of discharging, under the superintendence and direction of the Registrar, such functions of the Registrar under this Act as he may from time to time authorise them to discharge.

Sec . 4. Power of Registrar to withdraw or transfer cases, etc.—Without prejudice to the generality of the provisions of sub-section (2) of section 3, the Registrar may, by order in writing and for reasons to be recorded therein, withdraw any matter pending before an officer appointed under the said sub-section (2) and deal with such matter himself either de novo or from the stage it was so withdrawn or transfer the same to another officer so appointed who may, subject to special directions in the order of transfer, proceed with the matter either de novo or from the stage it was so transferred.

5. Trade Marks Registry and offices thereof.—(1) For the purposes of this Act, there shall be a trade marks registry and the Trade Marks Registry established under the Trade and Merchandise Marks Act, 1958 (43 of 1958) shall be the Trade Marks Registry under this Act. (2) The head office of the Trade Marks Registry shall be at such place as the Central Government may specify, and for the purpose of facilitating the registration of trade marks, there may be established at such places as the Central Government may think fit branch offices of the Trade Marks Registry. (3) The Central Government may, by notification in the Official Gazette, define the territorial limits within which an office of the Trade Marks Registry may exercise its functions. (4) There shall be a seal of the Trade Marks Registry. 6. The Register of Trade Marks.—(1) For the purposes of this Act, a record called the Register of Trade Marks shall be kept at the head office of the Trade Marks Registry, wherein shall be entered all registered trademarks with the names, addresses and description of the proprietors, notifications of assignment and transmissions, the names, addresses and descriptions of registered users, conditions, limitations and such other matter relating to

registered trademarks as may be prescribed. (2) Notwithstanding anything contained in sub-section (1), it shall be lawful for the Registrar to keep the records wholly or partly in computer floppies diskettes or in any other electronic form subject to such safeguards as may be prescribed. (3) Where such register is maintained wholly or partly on computer under sub-section (2) any reference in this Act to entry in the Register shall be construed as the reference to any entry as maintained on computer or in any other electronic form.

The Madrid System is a convenient and cost-effective solution for registering and managing trademarks worldwide. File a single international trademark application and pay one set of fees to apply for protection in up to 131 countries. Modify, renew or expand your global trademark portfolio through one centralized system.

#### Benefits of the Madrid System

WIPO's Madrid System is the one-stop solution for you as a national or regional trademark holder to obtain and maintain protection of your brands overseas in multiple markets simultaneously. Whether you are a small start-up or a large multinational exporter, the Madrid System will help you to manage your brands efficiently and centrally.

#### **ABSOLUTE GROUNDS FOR REFUSAL OF REGISTRATION.—**

Sec 9 of the Act provides for the trade marks— (a) 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; (b) which consist exclusively of marks or indications which may serve in trade to designate the kind, quality, quantity, intended purpose, values, geographical origin or the time of production of the goods or rendering of the service or other characteristics of the goods or service; (c) which consist exclusively of marks or indications which have become customary in the current language or in the bona fide and established practices of the trade, shall not be registered: Provided that a trade mark shall not be refused registration if before the date of application for registration it has acquired a distinctive character as a result of the use made of it or is a well-known trade mark.

(2) A mark shall not be registered as a trade mark if—

(a) it is of such nature as to deceive the public or cause confusion;

(b) it contains or comprises of any matter likely to hurt the religious susceptibilities of any class or section of the citizens of India;

(c) it comprises or contains scandalous or obscene matter; (d) its use is prohibited under the Emblems and Names (Prevention of Improper Use) Act, 1950 (12 of 1950). (3) A mark shall not be registered as a trade mark if it consists exclusively of— (a) the shape of goods which results from the nature of the goods themselves; or (b) the shape of goods which is necessary to obtain a technical result; or (c) the shape which gives substantial value to the goods.

Sec 11. Relative grounds for refusal of registration.—(1) Save as provided in section 12, a trade mark shall not be registered if, because of— (a) its identity with an earlier trade mark and similarity of goods or services covered by the trade mark; or (b) its similarity to an earlier trade mark and the identity or similarity of the goods or services covered by the trade mark, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

(2) A trade mark which— (a) is identical with or similar to an earlier trade mark; and (b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is registered in the name of a different proprietor, shall not be registered if or to the extent the earlier trade mark is a well-known trade mark in India and the use of the later mark without due cause would take unfair advantage of or be detrimental to the distinctive character or repute of the earlier trade mark. (3) A trade mark 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 trade mark used in the course of trade; or (b) by virtue of law of copyright. (4) Nothing in this section shall prevent the registration of a trade mark where the proprietor of the earlier trade mark or other earlier right consents to the registration, and in such case the Registrar may register the mark under special circumstances under section 12.

SEC 16 provides for where a trade mark which is registered, or is the subject of an application for registration, in respect of any goods or services is identical with another trade mark which is registered, or is the subject of an application for registration, in the name of the same proprietor in respect of the same goods or description of goods or same services or

description of services or so nearly resembles it as to be likely to deceive or cause confusion if used by a person other than the proprietor, the Registrar may, at any time, require that the trade marks shall be entered on the register as associated trade marks.

Where there is an identity or near resemblance of marks that are registered, or are the subject of applications for registration in the name of the same proprietor, in respect of goods and services which are associated with those goods or services, or goods or services of that description, sub-section (1) shall apply as it applies as where there is an identity or near resemblance of marks that are registered, or are the subject of applications for registration, in the name of the same proprietor in respect of the same goods or description of goods or same services or description of services. Where a trade mark and any part thereof are, in accordance with the provisions of sub-section (1) of section 15, registered as separate trade marks in the name of the same proprietor, they shall be deemed to be, and shall be registered as, associated trade marks. All trade marks registered in accordance with the provisions of sub-section (3) of section 15 as a series in one registration shall be deemed to be, and shall be registered as, associated trade marks. On application made in the prescribed manner by the registered proprietor of two or more trade marks registered as associated trade marks, the Registrar may dissolve the association as respects any of them if he is satisfied that there would be no likelihood of deception or confusion being caused if that trade mark were used by any other person in relation to any of the goods or services or both in respect of which it is registered, and may amend the register accordingly.

## **EFFECT OF REGISTRATION**

27. No action for infringement of unregistered trade mark.—(1) No person shall be entitled to institute any proceeding to prevent, or to recover damages for, the infringement of an unregistered trade mark. (2) Nothing in this Act shall be deemed to affect rights of action against any person for passing off goods or services as the goods of another person or as services provided by another person, or the remedies in respect thereof.

Sec 28. Rights conferred by registration.—(1) Subject to the other provisions of this Act, the registration of a trade mark shall, if valid, give to the registered proprietor of the trade mark the exclusive right to the use of the trade mark in relation to the goods or services in respect



of which the trade mark is registered and to obtain relief in respect of infringement of the trade mark in the manner provided by this Act. (2) The exclusive right to the use of a trade mark given under sub-section (1) shall be subject to any conditions and limitations to which the registration is subject. (3) Where two or more persons are registered proprietors of trade marks, which are identical with or nearly resemble each other, the exclusive right to the use of any of those trade marks shall not (except so far as their respective rights are subject to any conditions or limitations entered on the register) be deemed to have been acquired by any one of those persons as against any other of those persons merely by registration of the trade marks but each of those persons has otherwise the same rights as against other persons (not being registered users using by way of permitted use) as he would have if he were the sole registered proprietor.

### **INFRINGEMENT OF TRADEMARK:**

**DECEPTIVE SIMILARITY:** A mark shall not be registered as a trade mark if it is of such nature as to deceive the public or cause confusion. Similarly, a trade mark shall not be registered if because of its identity with an earlier trade mark and similarity of goods or services covered by the trade creates a likelihood of confusion on the part of the public. The likelihood of similarity or deception that creates confusion depends on certain circumstances. Nature of the mark, whether they are invented words, words having descriptive significance, non descriptive words, geographical names, surnames, letters, numerals or devices. The degree of resemblances between the two marks-phonetic, visual as well as similarity in idea or expression. The nature of goods and services in respect of which they are used or likely to be used as trade marks. The similarity in the nature, character and purpose of the goods or services of the rival traders. The class of purchasers who are likely to buy the goods bearing the marks, their level of intelligence and the duty of care they are likely to exercise in purchasing the goods and other surrounding circumstances.

#### **What are the Grounds of Infringement?**

As per Section 29 of the Trade Marks Act, 1999, trademark infringement in India can be accounted for in the following scenarios:

- **Identity with a Registered Mark:** Infringement occurs if an unregistered mark is identical to a registered one for the same class of goods and services.
- **Likelihood of Confusion:** If an unregistered mark is similar to the infringed mark, causing confusion among consumers.
- **Similarity to a Mark with Reputation:** Infringement is established if the unregistered mark resembles a registered trademark with a recognised reputation in the market.
- **Unauthorized Use on Labeling or Packaging:** If the registered trademark is used on labelling or packaging without proper authorization, it is an infringement.
- **Unfair Advantage in Advertising:** If the registered trademark is used in advertising to gain an advantage detrimental to or against the trademark's reputation.

Sec 29. Infringement of registered trademarks.—(1) A registered trade mark 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 trade mark in relation to goods or services in respect of which the trade mark is registered and in such manner as to render the use of the mark likely to be taken as being used as a trade mark. (2) A registered trade mark 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— (a) its identity with the registered trade mark and the similarity of the goods or services covered by such registered trade mark; or (b) its similarity to the registered trade mark and the identity or similarity of the goods or services covered by such registered trade mark; or (c) its identity with the registered trade mark and the identity of the goods or services covered by such registered trade mark, is likely to cause confusion on the part of the public, or which is likely to have an association with the registered trade mark. (3) In any case falling under clause (c) of sub-section (2), the court shall presume that it is likely to cause confusion on the part of the public. (4) A registered trade mark 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—

(a) is identical with or similar to the registered trade mark; and

(b) is used in relation to goods or services which are not similar to those for which the trade mark is registered; and

(c) the registered trade mark 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 trade mark. 19 (5) A registered trade mark is infringed by a person if he uses such registered trade mark, as his trade name or part of his trade name, or name of his business concern or part of the name, of his business concern dealing in goods or services in respect of which the trade mark is registered.

### **What does not come under Trademark Infringement?**

Section 30 of the Trademarks Act 1999 outlines certain conditions where the registered trademark is not infringed. The alleged infringer can use it to defend themselves from the suit for infringement. A registered trademark is not considered infringed in the following situations:

- **Using Indicating Characteristics:** When the use of the trademark in relation to goods or services merely indicates their kind, quality, quantity, intended purpose, value, geographical origin, time of production, or other characteristics.
- **Limitations on Registration:** If the trademark is registered subject to certain conditions or restrictions, its use in a manner that falls outside the scope of those conditions or limitations is not considered an infringement.
- **Authorized Use by Proprietor or Registered User:** When a person uses the trademark for goods or services connected with the trademark owner or a registered user.
- **Adaptation of Goods or Services:** If a person adapts the trademark of the goods or services to be part of or accessory to other goods or services, and if the use is reasonably necessary.
- **Use of Identical or Similar Trademarks:** When a registered trademark, which is identical or closely resembles another registered trademark, is used by its rightful owner under the rights granted by registration.

## **Remedies and Penalties against trademark infringement:**

Remedies against trademark infringement are categorised into civil and criminal remedies. Choosing the appropriate path depends on the specific circumstances and desired outcome. **Civil Remedies:**

### **Injunctions:**

- **Temporary Injunction:** A court order immediately stopping the infringer from using the trademark until the lawsuit concludes.

- **Permanent Injunction:** A long-term court order prohibits the infringer from using your trademark.

- **Damages:** Compensation for financial losses or reputational damage suffered due to the infringement. This can include:

- **Actual Damages:** Reimbursement for quantifiable losses, like lost sales or profits.

- **Additional Damages:** Compensation for intangible harm, like goodwill or brand reputation damage.

- **Account of Profits:** An order requiring the infringer to disclose and surrender all profits earned through the infringing use of your trademark.

### **Criminal Remedies:**

- **Imprisonment:** The infringer can be jailed for at least 6 months, extendable to 3 years.

- **Fine:** The infringer can be fined a minimum of Rs. 50,000 and up to Rs. 2,00,000.

**PASSING-OFF-ACTION:-** In respect of an unregistered trademark the proprietor may initiate passing off action against those who try to pass off their goods or services as those of the proprietor of the unregistered trade mark. This is a common law remedy, provided under the law of torts. The basis for a passing off action is false representation. In an action for passing off, it is by no means necessary that there should be absolute identity between the articles of the plaintiff and the defendant. The main test is that misrepresentation, made by a person in the course of trade, to prospective consumers of his or ultimate consumers of

goods or services supplied by him, which is calculated to injure the business or goodwill of another trade which causes actual damage to a business or good will of the trader by whom the action is brought. The Crux of the passing off action lies in actual or possible or probable deception. The passing off action depends upon the principle that nobody has a right to represent his goods as the goods of somebody else. In other words a man is not to sell his goods or services under the pretence that they are those of another person. The common law remedy is basically an action for deceit. On the other hand, the action for infringement is a statutory remedy conferred on the registered proprietor of a registered trade mark.

To conclude we can say that a consumer's decision to purchase goods or hire services is heavily influenced by the Brand Value and reputation a Brand Name possesses. It is a valuable intellectual asset for a company because it discourages competitors from using similar names or logos. A trademark is a type of intellectual property that consists of a recognizable sign, design, or expression that distinguishes one source's products or services from those of others. Services are usually referred to as service marks or known as Brand Name. The owner of a trademark can be an individual, a business organization, or any legal entity. A trademark can be found on a package, a label, a voucher, the product itself, or on company property. To put it another way, trademarks serve to identify a specific entity as the source of goods or services. A good trademark should be easy to say and remember while maintaining its uniqueness and distinctive character.

## **GEOGRAPHICAL INDICATION**

Geographical indication identify a good as originating in the territory of a country or a region or locality in that territory where a given quality, reputation or other characteristic of the goods is essentially attributable to its geographical origin as for example paris perfume, scotch whisky of UK, Manipuri black rice, Kashmir saffron etc. The GI tag serves to designate a product originating therein, the Quality and characteristics of which are due exclusively or essentially to the geographical environment, including natural and human factors. At present there is no specific law governing geographical indications of goods in the country which could adequately protect the interest of producers of such goods. Exclusion of unauthorized persons from misusing geographical indications would serve to protect consumers from deception, add, to the economic prosperity of the producers of such goods and also promote goods bearing Indian geographical indications in the export market.