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# Overview of Intellectual Property in India

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# 1) What are Intellectual Property or Intellectual Property Rights (IP for IPRs)?

**(i) Legal or statutory rights of exclusive or monopolistic nature in respect of creative exercises of human intellect or intelligence**

**(a) legal or statutory rights**

**(b) exclusive or monopolistic rights**

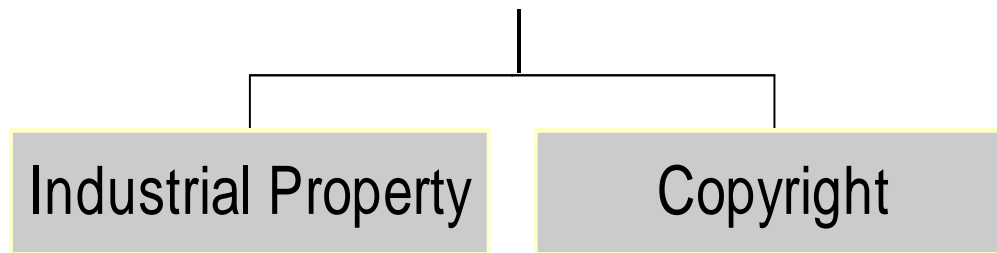
**(c) Creations i.e. products of human intellect**



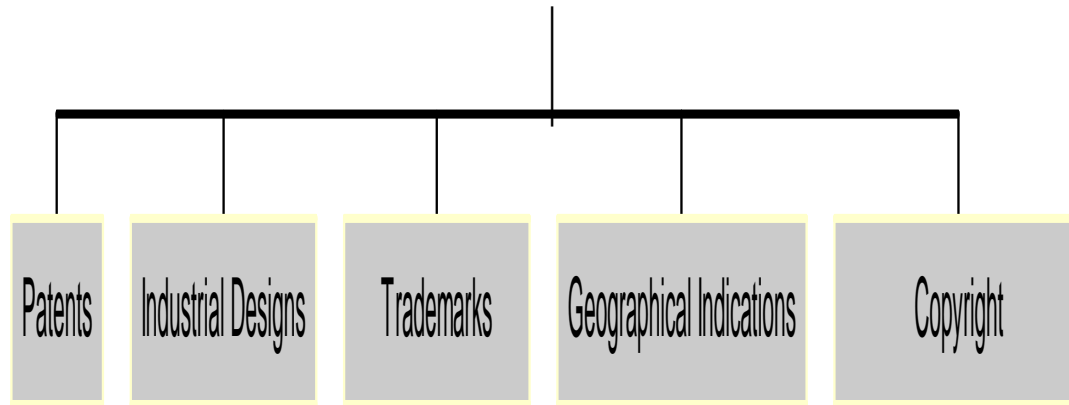
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## (ii) IPRs in general



## (iii) IPRs in the Indian Context



# 2. TRADE MARK & SERVICE MARK

## (i) Definition

- (a) **Any distinctive mark capable of distinguishing goods or services of one person from those of others. Distinctive nature or character may be in the uniqueness of the mark itself or may be acquired by extensive use of the mark.**
- (b) **Trade Mark - Goods**  
**Service Mark - Services**
- (c) **Mark includes device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof.**
- (d) **Right in a trade mark or service is acquired by registration under the Trade Marks Act 1999 and/or by user which is a common law right.**
- (e) **Black and white representation of the mark covers all the colours and colour combinations.**



# Definition Cond....

- (f) **Associated trademarks - Marks nearly resembling one another**

**Examples**

**BAJAJ**

**BAJAJ Pulsar**

**LIVOMIN**

**LIVOMIN FORTE**

- (g) **Series marks**

**Composite marks comprising any part of distinctive nature registrable independently. Both the composite mark and such part may constitute series marks.**

**Examples**

**Philips & Philips Emblem**

**Fevicol & Fevicol label**



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# Definition Cond....

## (h) Certification marks

**Marks certified by the proprietor of the mark as to origin, material, mode of manufacture or such other characteristics.**

### **Examples**

**Agmark – in relation to food / agricultural products.**

**Wool mark – in relation to woollen garments / materials**



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## **(ii) Unregistrable Trademarks**

- (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 services or other characteristics of the goods and services ;**
  
- (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.**





# Unregistrable Trademarks cond... **KOCHHAR & Co.** ADVOCATES & LEGAL CONSULTANTS

- (d) which are of such nature as to deceive the public or cause confusion;**
- (e) which contains or comprise any matter likely to hurt the religious susceptibilities of any class or section of the citizens of India;**
- (f) which comprise or contain scandalous or obscene matter**
- (g) whose use is prohibited under the Emblems and Names (Prevention of Improper Use) Act, 1950 (12 of 1950)**
- (h) consisting 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.**

## **(iii) Availability Search**

**Official search**

## **(iv) Procedure for Registration**

- a) Filing**
- b) Examination**
- c) Acceptance and publication**
- d) Opposition, if any**
- e) Registration**



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## **(v) ENFORCEABILITY**

### **(a) Infringement / Passing Off Action**

**(a1) Civil Suit**

**(a2) Reliefs**

**injunction**

**damages or account of profits**

**(a3) Anton Piller Order for search and seizure of the infringing goods**

### **(b) Criminal Complaint**

**(b1) Magisterial order for search and seizure of the infringing goods.**

**(b2) Police Officer not below the rank of DSP also may search and seize the infringing goods after obtaining the opinion of the Registrar of Trade Marks on the question of infringement.**



## **(vi) Salient Features of the Trade Marks Act 1999**

### **a) Registration of service marks**

**Service industries like information technology, software, BPO services, hotels, cinemas, hospitals, airlines, insurance, banks, investment business, chartered accountant practices, consultants, advertisement agencies, etc., can now register their marks as service marks.**

### **b) Protection of well-known trade marks against misappropriation**

### **c) Change in the civil jurisdiction of the courts pertaining to infringement / passing off actions**

**Earlier trade mark owner / proprietor had to institute infringement / passing off actions in a Court under whose jurisdiction the defendant resided or carried on business, whereas he can now institute infringement / passing off suits in a court under whose jurisdiction he resides or carries on business.**



# Trade Marks Act 1999 contd...

## **d) Provision of additional remedy against criminal offence**

**Criminal offence has been made a cognizable offence. Any police officer not below the rank of DSP, on obtaining an opinion of the Registrar of Trade Marks on infringement can search and seize, without warrant, the goods, dies, blocks, machines, plates, etc., involved in committing the criminal offence.**

## **e) Constitution of Intellectual Property Appellate Board**

**Earlier appeals from the decisions of the Registrar were entertained by the High Court, whereas appeals shall henceforth be heard by the Appellate Board.**

## **f) Provision of Single Register of Trade Marks**

**Provides a single register for all trade marks eliminating two parts of the Register, namely Part A and Part B as existed.**



## Trade Marks Act 1999 contd...

**g) Certification trade marks**

**Authority to register certification trade marks now vests with the Registrar whereas earlier it was with the Central Government.**

**h) Provision for filing multiple application**

**A single application for registration of a trade mark in different classes of goods or services may now be filed as multiple application.**

**i) Prohibition of part of corporate name or name of business as trade mark**

**Use of some one else's trade mark as part of corporate name or name of business concern is prohibited.**



# Trade Marks Act 1999 Contd...

## **j) Term of registration**

**Validity of registration of trade marks has been increased from 7 years to 10 years.**

## **k) Collective Mark**

**Concept of registration of collective mark has been introduced. Collective mark means trade mark distinguishing the goods or services of members of an association of persons (not being a partnership) as proprietors from those of others.**

# Trade Marks Act 1999 Cond...

## **l) Infringement**

**Scope of infringement of a trade mark has been widened.**

### **Example:**

**Use of a registered trade mark, as a part of a corporate name or use of a mark, which is identical or deceptively similar to a registered trade mark even in respect of dissimilar goods or services, will be regarded as infringement of trade mark.**

## **(ix) International Treaty**

**Paris Convention**

## **(x) Priority Claim**

**Significance and advantage**

## **(xi) Importance of Trade Mark/Service Mark in Commerce and Industry**

- (a) builds up enormous goodwill and reputation in respect of goods /services**
- (b) valuable asset which may be assigned or licensed –monetary compensation.**

## (xii) Term

**Perpetual or limitless upon payment of renewal fee.**

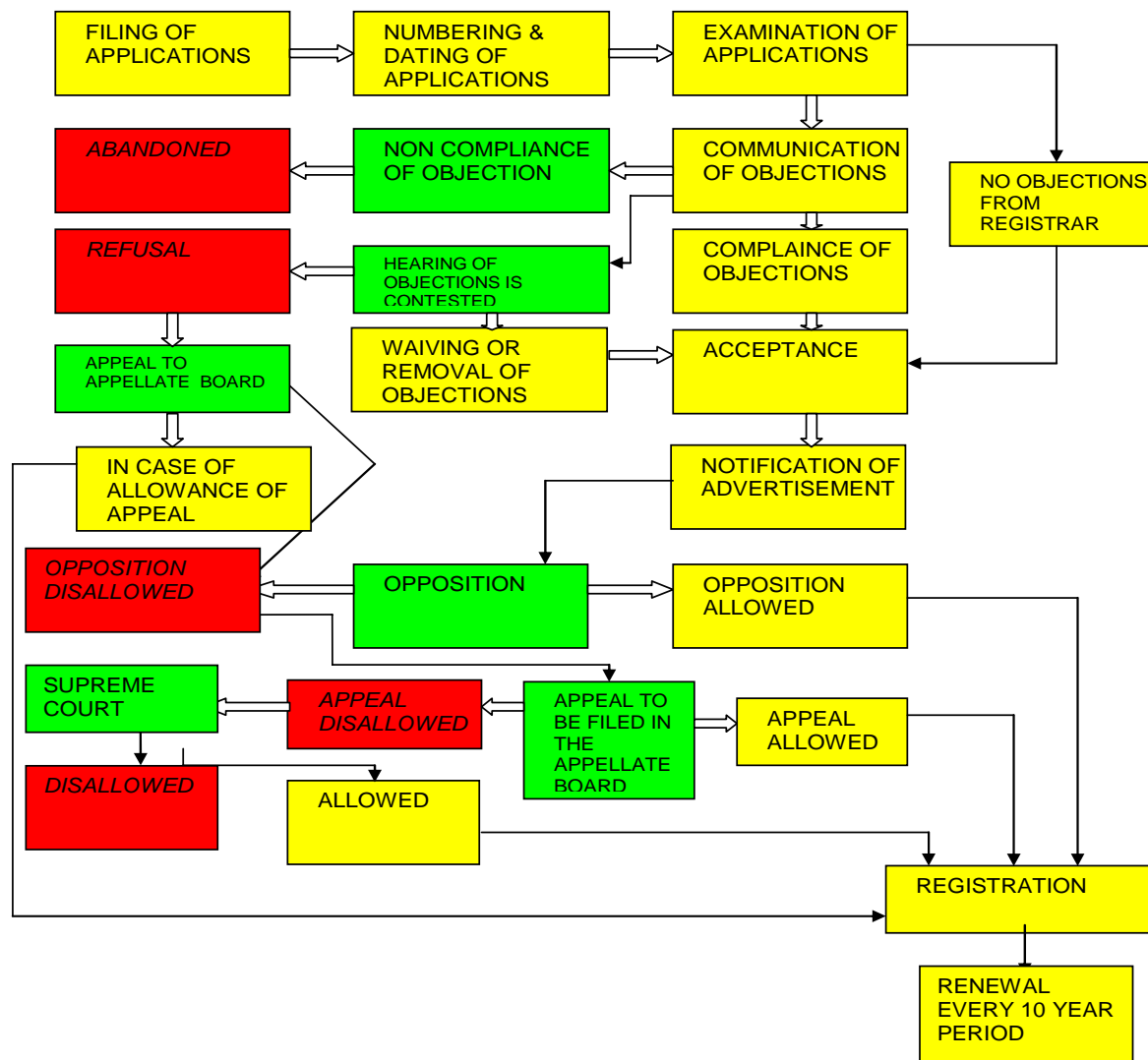
## (xiii) Marking of Goods

TM for pending trade marks

® for registered and renewed trade marks



COLOUR KEY
PROCEDURES
OPPOSITION/APEAL
NEGATIVE OUTCOMES



# **3. DESIGNS**

## **(i) Definition**

- (a) Design means features of shape, configuration, pattern, ornament or composition of lines or colours as applied to an article. The Designs Act 2000**
  
- (b) Essentially for the outer look of an article. Nothing to do with the functioning of the article.**

## **(ii) Criteria For Registrability**

- (a) Original and new**
  
- (b) Significantly distinguishable from known designs**

## **(iii) Procedure for Registration**

- (a) Filing application**
- (b) Examination**
- (c) Registration**

## **(iv) Term of Registration**

**10 + 5**

## **(v) Enforceability**

### **Infringement Action**

- (a) Civil Suit**
- (b) Reliefs -  
Injunction  
Damages**



## **(vi) Marking of Articles**

**Regd / Registered Design No \_\_\_\_\_**

## **(vii) Priority Claim**

**Significance and advantage**

## **(viii) Importance of Designs in Commerce and Industry**

- (a) Exclusivity and hence edge over competitors**
- (b) Assignment or licensing facility-monetary compensation.**
- (c) Builds up product image / goodwill**

# 4. COPYRIGHT

## (i) What is Copyright

**Copyright means right to copy or reproduce and it is always in respect of work namely**

- a) Literary, dramatic, musical or artistic work**
- b) Cinematograph film**
- c) Sound recordings**



## (ii) Scope of Works

- (a) Literary Work includes books, compilations articles, magazines, newspapers, computer programmes and databases.**
- (b) Dramatic Work includes plays, any piece for recitation, choreographic work or entertainment in dumb show, the scenic arrangement or acting form of which is fixed in writing or otherwise.**
- (c) Musical Work includes works of music and graphical notation of such work but does not include any words or any action intended to be sung, spoken or performed with the music.**
- (d) Artistic Work includes painting, sculpture, drawing, engraving or photograph.**

# Scope of Works - Contd .....

- (e) Cinematograph Film includes any work of visual recording on any medium produced through a process from which a moving image may be produced by any means and includes a sound recording accompanying a visual recording.**
  
- (f) Sound Recording means a recording of sounds from which such sounds may be produced regardless of the medium on which such recording is made or the method by which the sounds are produced.**

## iii) What is Not Copyrightable

**There is no copyright in ideas nor in works devoid of originality. Copyright subsists only in the material form in which the ideas are expressed. Work should be original and should not be a copy. Copyright in a work subsists as soon as the work comes into existence or is created.**

## iv) Registration

**(a) Registration is not mandatory:**

**Registration is not required to acquire copyright although there is a provision for registration of a copyright work. Registration is optional and provides prima facie evidence of ownership. The statute is The Copyright Act, 1957.**

**(b) Conditions for Registration:**

**In order to qualify for copyright, the works apart from being original should also satisfy the following conditions:**

- (i) The work is first published in India.**
- (ii) Where the work is first published outside India the author at the date of publication must be a citizen of India. If the publication was made after the author's death, the author must have been at the time of his death a citizen of India.**

## Registration Contd...

- (iii) In the case of unpublished work, the author is on the date of making of the work a citizen of India or domiciled in India.**
- (iv) In the case of an architectural work of art, the work is located in India.**

### **(c) Procedure For Registration:**

- (i) Filing application**
- (ii) Scrutiny by the Copyright Registrar**
- (iii) Issuance of registration details by the Registrar**

## vi) Term of Copyright

- (a) Generally life time of the author plus 60 years.**
- (b) Work published anonymously or pseudonymously 60 years from the date of first publication.**

## vii) Importance of Copyright

- (a) Work relates to the author/owner and generates enormous goodwill / reputation.**
- (b) Valuable asset which may be assigned or licensed – monetary compensation.**

# vii) Rights conferred under Copyright

## **Exclusive rights to**

- (a) Reproduce the work**
- (b) Make Copies of the work**
- (c) Communicate the work to public**
- (d) Translate the work**
- (e) Adapt the work**
- (f) In the case of computer program additional right to sell or give on hire, copies of the computer program**



## **viii) Enforceability**

### **(a) Infringement Action**

**(a1) Civil Suit**

**(a2) Reliefs-  
Injunction  
Damages or account of profits**

### **(b) Criminal Complaint**

**(b1) Magisterial order for search and seizure of the  
infringing copies**

**(b2) Cognizable offence. Any police Officer not below the  
rank of a sub-inspector may, without warrant, also  
search and seize the infringing copies**



## ix) International Treaties

- (a) **Berne Convention**
- (b) **Universal Copyright Convention**

## x) Marking of Copies of Work

©

# 5 GEOGRAPHICAL INDICATIONS

## i) Definition

- (a) Geographical indication includes any name, geographical or figurative representation or any combination of them conveying or suggesting the geographical origin of goods to which it applies.
- (b) Geographical indication is related to goods which may be agricultural, natural or manufactured or any goods of handicraft or of industry and includes foodstuff originating or manufactured in the territory of a country or region or locality in that country.
- (c) Geographical indication essentially identifies the goods in terms of certain given or inherent quality, reputation or other characteristic which is essentially attributable to their geographical origin.





## i) Definition cond.....

### (d) Examples

**Scotch Whisky**

**Darjeeling Tea**

**Assam Tea**

**Himachal apples**

**Dehradun Basmati Rice**

## ii) Unregistrable Geographical Indications

The following are not registrable as geographical indications :

- (a) the use of which would be likely to deceive or cause confusion;
- (b) the use of which would be contrary to any law for the time being in force;
- (c) which comprise or contain scandalous or obscene matter;
- (d) which comprise or contain any matter likely to hurt the religious susceptibilities of any class or section of the citizens of India;
- (e) which would otherwise be disentitled to protection in a court;
- (f) which are determined to be generic names or indications of goods and are therefore, not or ceased to be protected in their country of origin, or which have fallen into disuse in that country;

# Unregistrable Geographical Indications Cond...

- (g) which, although literally true as to the territory, region or locality in which the goods originate, but falsely represent to the persons that the goods originate in another territory, region or locality, as the case may be**

## iii) Procedure for registration

- **Application**
- **Examination**
- **Acceptance and publication**
- **Opposition, if any**
- **Registration**



## **iv) Term of registration**

**Perpetual or unlimited provided renewed every 10 years**

## **v) Enforceability**

### **(a) Infringement/passing off Action**

**a) Civil Suit**

**b) Reliefs**

**Injunction**

**damages or account of profits**

**order for the delivery - up of the infringing labels and indications  
for destruction or erasure.**

### **(b) Criminal complaint**

**(b1) magisterial order for search and seizure of the infringing  
goods**

**(b2) police officer not below the rank of DSP also may search and  
seize the infringing goods**



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## vi) Importance of Geographical Indication in commerce and Industry

**Builds up enormous goodwill and reputation in respect of the goods.**

## vii) Marking of Goods

**Registered Geographical Indication or RGI**



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# **Simplified summary for understanding of various Intellectual Property rights in India.**



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	<b>PATENT</b>	<b>DESIGN</b>	<b>COPYRIGHT</b>	<b>TRADEMARK</b>
What is protected?	Functional features of a process, structural features of a Machine or a manufactured item, composition of matter producing synergistic effects	Ornamental pattern, outer design for article of manufacture	Writings, photographs, music, labels, works of art, computer programmed, paintings, sculpture, drawing, engraving, dramatic work, scenic arrangement, or acting form which is fixed in writing or otherwise.	device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colors or any combination thereof .
Criteria for Protection?	New and 'non obvious'	New and not published	Originality	Should be capable of identifying and distinguishing the



	PATENT	DESIGN	COPYRIGHT	TRADEMARK
				goods and services Proprietor. Should not conflict with a prior Registered or pending mark.
How Rights are obtained	An application with a complete specification and claims in the prescribed manner is to be made with the appropriate fee	An application in the prescribed manner is to be made with the appropriate fee.	1. Automatic upon creation. 2. By applying Copyright notice (c) 2004 (Year of the first publication) if publicly	1. By Common Law: Adoption & Use. 2. An applic- ation in the prescribed manner is to be made with the appropriate fee to the Registrar of Trade Marks.



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	PATENT	DESIGN	COPYRIGHT	TRADEMARK
			distributed. An application in the prescribed manner is to be made with appropriate fee to the Registrar of Copyright	
Marking	Goods may be Marked Patent No. (After Grant) IND PAT No. -	Goods may be marked Design No. 0000/year (After Grant).	© 2004	Use ® for Registered Trade Mark and ™ for unregistered.



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	<b>PATENT</b>	<b>DESIGN</b>	<b>COPYRIGHT</b>	<b>TRADEMARK</b>
Life	20 years from the date of Patent (filing of complete specification),	10 years subject to renewal for 5 years only.	Valid for 60 years from date of death of author.	Common Law: As long as property used as a mark. Registration is perpetual subject to renewal every 10 years.
Test of infringement	Making, using or selling Patented article or composition (not a drug) or carrying on a process embodying the claimed invention.	Designs which look alike to the eye of an ordinary observer.	Substantial portion copied. Similarity, Public Performance without license.	Likelihood of Confusion, mistake or deception. Deliberate copying?



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		<b>PATENT</b>	<b>DESIGN</b>	<b>COPYRIGHT</b>	<b>TRADEMARK</b>
International Protection	a. b.	Patent Co-operation treaty (PCT ) Paris convention	A priority can be claimed in member WTO countries.	Indian Copyrights are valid in countries which are members of the Berne Convention and Universal copyright convention	Indian Trademarks are not valid in any other country just like Foreign Trademarks are not valid in India, unless used on applied for/granted in India. Protection of well known trademarks against misappropriation.



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- **The firm's Lawyers have attained the position of recognition as experts in the respective field of practice.**
- **The firm's intellectual property expertise includes trademark, design and copyright law and handling related litigation against infringement of all such rights, including drafting patent specifications, preparing and filing Indian and Foreign applications and all related work.**
- **The Firm also advises on licencing, transfer of intellectual property and software developing licencing agents.**
- **The Firm has offices at Chennaia, New Delhi, Mumbai and Bangalore.**

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