



A READY RECKONER

*FUNDAMENTALS OF IPR IN INDIA*

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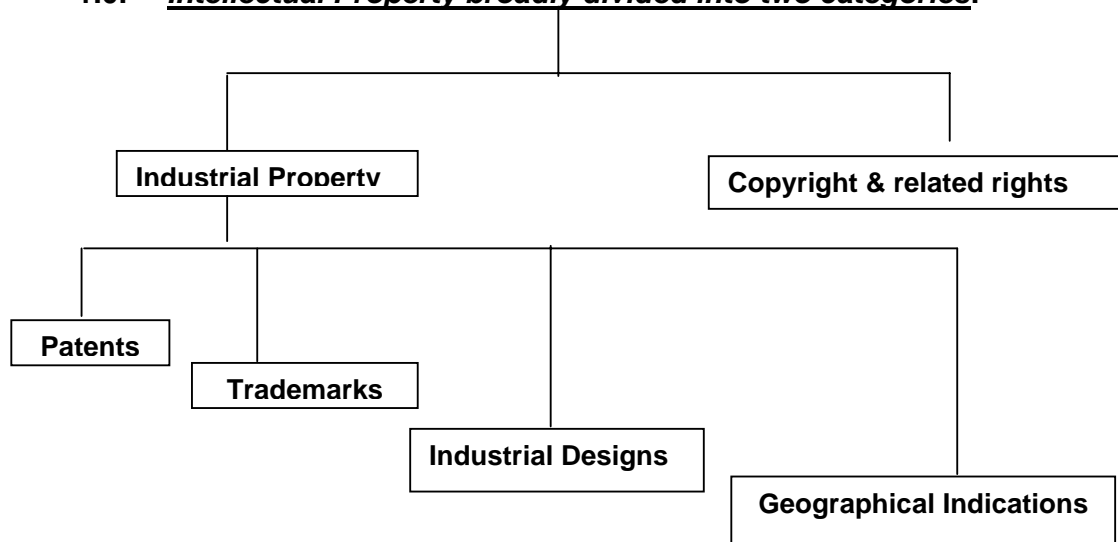
<sup>1</sup> The Contents of this Ready Reckoner is intended for dissemination of useful information on IPR which could aid as an Information tool for Industry, R&D & Academic Institutes, Lawyers, Students & IP Practitioners. The Contents of the information is not intended for Sale. Any Copying or reproduction of the contents of the ready reckoner should be undertaken with the prior permission of Andhra Pradesh Technology Development & Promotion Centre.

# Overview on IPRs

Any thing made by human intervention requires intellectual efforts and all human made things are a result of intellectual creations. However individual persons do not own most of these creations or organizations but human race as a whole is the collective owner of these creations. Some specific creations made by individuals / organizations are owned by them subject to the conditions laid down by certain laws for recognizing and rewarding the intellectual activity of the creator. Intellectual property refers to such creations. These include Inventions, Symbols, names, images; literary and artistic work.

Intellectual property rights are the rights given to persons over the creations of their minds. They usually give the creator an exclusive right over the use of his/her creation for a certain period of time.

## 1.0. Intellectual Property broadly divided into two categories:



## 1.1. Copyright & related rights:

The rights of authors of literary and artistic works (such as books and other writings, musical compositions, paintings, sculpture, computer programs and films) are protected by copyright, for a period of 60 years after the death of the author.

Also protected through copyright and related (sometimes referred to as “neighboring”) rights are the rights of performers (e.g. actors, singers and musicians), producers of phonograms (sound recordings) and broadcasting organizations. The main social purpose of protection of copyright and related rights is to encourage and reward creative work.

## **International Agreements**

### **1.2. Trade Related Aspects of Intellectual Property Rights: (TRIPs)**

India is a signatory of TRIPs in the Uruguay Round agreement of 1995. It is now bound to amend her existing laws in order to make it TRIPs-compliant. The government has initiated action to bring in the requisite changes. In the last few years, India has enacted fully TRIPs-compliant Trademarks Act, Copyright Act, Designs Registration Act, Geographical Indications Act and Protection of Layouts for Integrated Circuits Act. A novel Plant Varieties Protection and Farmers Rights Act 2001 and the Bio-diversity Act 2002 are also in Place.

### **1.3 Patent Co-operation Treaty (PCT)**

On 7<sup>th</sup> September 1998, India deposited its instrument of accession to the PCT and is bound by Patent Co-operation treaty as 98<sup>th</sup> contracting State of PCT from 7<sup>th</sup> December 1998. Furthermore, nationals and residents of India are entitled to file International applications for patents under PCT at Patent office, Kolkatta as receiving office.

With effect from 19<sup>th</sup> November 1999 Patent office branches at Mumbai, Chennai & New Delhi are also receiving the PCT applications allowing the applicants to file application at their regional Patent office.

As on date of India's accession to PCT, there were nine International Search Authorities (ISA's) & Eight International Patent Examination Authorities (IPEA's). Govt. of India opted for all of them as competent ISA's & IPE's, providing maximum options to its applicants. As on today India is the only State having maximum options.

### **1.4. Modernization of Patent Offices:**

Government has taken up comprehensive modernization of intellectual Property administration to complement legislative matters.

#### **Modernization Initiatives:**

- A completely modernized and computerized Designs Office in Kolkata has been made operational.
- Modernization of infrastructure in all the Patent offices
- Integrated IP offices have been set up in each of the four metro cities so as to house all activities under a single roof
- A logo for IP administration has been designed and put into use
- Re-designing of website (<http://www.ipindia.nic.in>) to make it more user-friendly
- Computerization of Patent database
- Human Resource Development for activities to meet International Standards
- An Intellectual Property Training Institute (IPTI) has been established at Nagpur to provide training
- Online search facilities & connectivity to international databases

- Work manuals prepared for patent offices to ensure uniformity in the operation.
- Introduction of request system for examination of all applications address to the problem of backlog of pending patent applications
- Digital database of over 1, 00,000 patent records and 48,000 design records prepared so far. A searchable database will be put on the website.

## 1.5. Patents:

### ▪ Patent Act of 1970

The Patent Act, 1970 came into force on 20.4.1972 replacing Indian Patents and Designs Act, 1911. The Patents Act, 1970 in comparison with Indian Patents and Designs Act, 1911 has far more reaching effect in some areas such as food, Drug and Medicines where all the patents granted under this category are deemed to be endorsed with the words "*Licence of Right*". Further the term of Patents related to Food, Drug & Medicines is seven years from the date of Patent or 5 years from its grant whichever is less. More elaborate definition of invention has been provided. Product Patents for Drugs & Medicines including certain class of chemicals, which are produced by chemical reactions, have been abolished. However, inventions relating to methods or processes of their manufacture are patentable. The area of search for novelty has been extended to any documents published anywhere in the world.

The provisions for appeals to the High Court from the decision of Controller have also been provided. The provision for grant of compulsory license, license of right and revocation of Patent on the ground of nonworking has also been incorporated. Many of these provisions are kept in line with the development of Patent law in developed countries, particularly Great Britain. The major departure is in the reduction of the term of patent for the invention relating to the drug, Medicine & food and abolition of Product patent per se for Drug, Medicines, Food and Chemicals.

India has become a member of the Paris Convention and PCT w.e.f. 7.12.1998. In view of these developments, the Patents Rules, 1972 have been amended facilitating filing of International applications with the head office of the Patent office at Calcutta or Branch Offices at Delhi, Chennai & Mumbai w.e.f. 17.11.99.

- **Amendment I:** In respect of obligations effective from January 01, 1995, India has amended the Patents Act, 1970 through the Patents (Amendment) Act, 1999 effective retrospectively from January 01, 1995. This Act provides for a "mail box" to receive and hold product patent applications in the fields of pharmaceuticals and agricultural chemicals and also on fulfillment of certain conditions specified in the law, for grant of exclusive marketing rights (EMRs)
- **Amendment II:** Second Amendment to the Indian Patent Act, 1970 brought about lot of changes. These changes are analyzed within the purview of TRIPS. While carrying out the Second Amendment in 2002. Patents Amendment Act 2002 came into force w.e.f. 20<sup>th</sup> May 2003.

### **Safeguards Provided In the Legislation**

- Exclusions from patentability
- Protection of traditional knowledge
- Redrafting of Compulsory Licenses provisions
- Provisions to check prices and ensure prompt availability of patented products after the expiry of the term of patent
- Protection of Biodiversity

### **Some of the changes made in the Patents Amendment Act 2002 are:**

- Inventions relating to method of treatment of plants are to be made patentable.
- The term of Patent is made 20 years
- Conditions for granting Compulsory Licenses
- Patenting micro-organisms
- An Appellate hear appeals from decisions of the controller.

➤ **Amendment III:** As on date, India is fully in compliance with its international obligations under the TRIPs Agreement..

### **The Amendment has major implications on the following:**

- Introduction of product patent protection for food, pharmaceutical and chemical inventions.
- Examination The “mail box” applications, from January 01, 2005

Ensuring that this next and the final amendment makes the domestic law completely TRIPs-compliant and also safeguards national interests, pose a considerable dilemma for the government. While there is a need to incentivise domestic industry to continue to develop and prepare themselves to face competition, protection of biodiversity and traditional knowledge, with fair benefit-sharing arrangements for communities, also needs to be ensured. The issue is one of finding a delicate balance a patent regime will offer to safeguard inventor’s interest while also check for overuse or misuse of IPR. One view is that application of a strong competition law will ensure that the latter eventuality does not happen, also addressing the affordability issue as under Section 83.

## **1.6. Trademarks**

### **▪ Legislation**

India affords full protection to trade marks under the Trade Marks and Merchandise Act. The Indian law of trademarks is protected by the Trade & Merchandise Marks Act, 1958. A new statute i.e. the Trade Mark Act, 1999 has been enacted in India to bring it in conformity with the TRIPs Agreement, to which India is a signatory. Indian Trademarks Act, 1999, came into force on September 15, 2003.

India has made a step towards fulfilling its international obligations. Consequently, the Indian trademark law has now become fully compatible with the International standards laid down in the TRIPs Agreement. The New Act primarily consolidates and amends the old Trade & Merchandise Marks Act, 1958 and provides for better protection of goods and services.

On the whole the Trademarks Act, 1999 has removed the inconvenient provisions of the old Act and has fostered the rights of the traders and other service providers significantly. It also sends a warning to infringers.

This Act not only makes Trade Marks Law TRIPs compatible but also harmonizes it with International systems and practices.

### **Convention Application and International Treaties**

India has declared certain countries as convention countries, which afford to citizens of India similar privileges as granted to its own citizens. A person from a convention country, may within six months of making an application in his home country, apply for registration of the trademark in India. If such a trademark is accepted for registration, such foreign national will be deemed to have registered his trademark in India, from the same date on which he or she made application in his home country.

#### **1.7 Industrial Design:**

In 1911 the Designs Act was passed by the then British Government in India. The Designs Act of 1911 governs industrial Designs. The registration of a design confers on the registered proprietor the right to take action against third parties who apply the registered design without license or consent. Under the TRIPS Agreement, minimum standards of protection of industrial designs have been provided for. As a developing country, India has already amended its national legislation to provide for these minimal standards.

The existing legislation on industrial designs in India is contained in the New Designs Act, 2000 India had achieved a mature status in the field of industrial designs and in view of globalization of the economy. The present legislation is aligned in view of the changed technical and commercial scenario and made to conform to international trends in design administration.

This replacement Act is also aimed to enact a more detailed classification of design to conform to the international system and to take care of the proliferation of design related activities in various fields.

#### **1.8. Geographical Indications:**

Geographical Indications of Goods are defined as that aspect of industrial property which refers to the geographical indication referring to a country or to a place situated therein as being the country or place of origin of that product. Typically, such a name conveys an assurance of quality and distinctiveness, which is essentially attributable to the fact of its origin in that, defined geographical locality, region or country. Under Articles 1 (2) and 10 of the Paris Convention for the Protection of Industrial Property, geographical indications are covered as an element of IPRs. They are also covered under Articles 22 to 24 of the Trade Related Aspects of Intellectual Property Rights (TRIPS) Agreement, which was part of the Agreements concluding the Uruguay Round of GATT negotiations.

India, as a member of the World Trade Organization, enacted the Geographical Indications of Goods (Registration & Protection) Act, 1999 has come into force with

effect from 15th September 2003. The source of Geographical origin of the biological material used in invention is required to be disclosed in the specification.

### **1.9. Copyrights:**

India has a very strong and comprehensive copyright law based on Indian Copyright Act. 1957 which was amended in 1981, 1984, 1992, 1994 and 1999 (w.e.f. January 15, 2000). The amendment in 1994 were a response to technological changes in the means of Communications like broadcasting and telecasting and the emergence of new technology like computer software.

The 1999 amendments have made the Copyright Act fully compatible with Trade-Related Aspects of Intellectual Property Rights (TRIPS) Agreement. & fully reflects Berne Convention. The amended law has made provisions for the first time, to protect performers' rights as envisaged in the Rome Convention. With these amendments the Indian Copyright law has become one of the most modern copyright laws in the world.

Moreover, India is signatory to both the International copy- right conventions i.e. the Berne Convention of 1886 and Universal Copyright Convention of 1952. India is also an active member of WIPO and UNESCO.. Indian representatives have taken part in the international copyright conferences putting forward the Indian point of view and thus helping in getting proper amendments made in the interests of developing countries. Much credit goes to India for getting the 1971 Paris Act, which recognizes the needs of developing countries and given a special treatment for that.

During the last two decades the Government of India has taken a number of measures towards the implementation and enforcement of copyright law. Under the Ministry of Human Resources Development a special Copyright Enforcement Advisory Council has been set up in which the heads of police from all the States of India participate and join forces to see to it that copyright is properly enforced. These developments have made a check on copyright infringement, by and large quite effective.

The Federation of Indian Publishers has Copyright Council, which organizes training courses in copyright for the benefit of publishers and authors all over the country from time to time with assistance from the Ministry of Education and sometimes World Intellectual Property Organization (WIPO). Recently, the Federation of Indian Publishers (FIP) in collaboration with the 'Authors Guild of India' have established 'Indian Reprographic Rights Organization' for the protection of the interests of copyright holders in India and abroad and also to act as a Collecting Society.

Being a member of the International Publishers Association (IPA) Indian publishers take an active part in the International Publishers Copyright Council (IPCC) from time to time. In the Indian law, copyright falls into 'public domain' 60 years after the death of the author.

### **Facing Digital and Electronic Publishing**

During the last couple of years the IPA, specially helped by the *Association of American Publishers (AAP)*, have developed a system called Digital Object Identifier (DOI). The technocrats in India are also developing methodology by which firstly, copyright infringement can be checked and secondly, it can detect the source form

where the infringement has originated. Such developments have deterrent effect on the pirates. The police force is also being trained to trace the pirates in all these technical and intricate electronic devices. But over all the electronic publishing, digital and Internet being in the initial stages in book publishing in India, not many problems have surfaced here in a big way as in advanced countries. But times are coming when Indian publishers will have to face these challenges and they are gearing up for that.

Special cells for copyright enforcement have been set up in 23 States and Union Territories. In addition, for collective administration of copyright, copyright societies have been set up for different classes of works.

## **2.0. Biological Diversity:**

The Biological Diversity act was passed in 2002 and had received the assent of the President on the 5th February 2003. The Act aims to provide for conservation of biological diversity, sustainable use of its components and fair and equitable sharing of the benefits arising out of the use of biological resources, knowledge and for matters connected therewith or incidental thereto.

Indian citizens, companies are allowed free access to biological resources within the country for research purposes but are barred from transferring findings to foreign entities without the National Biodiversity Act (NBA) approval.

### **2.1. Traditional knowledge:**

Traditional knowledge is in the public domain and should, therefore, not qualify for patents. This is indeed what happened with turmeric and might well have occurred with pigeon pea extracts and ngali nut oil. But for resolution of the issue, there has to be a database and computerisation of traditional knowledge. While creating a database of knowledge handed down orally is difficult, this constraint is responsible for many of India's patent-related problems.

While existing traditional knowledge is not patentable, increments to knowledge can indeed be patented, as they are in the US. The database of the National Innovation Foundation (NIF) demonstrates that India is not lacking in such incremental addition to traditional knowledge.

It is paradoxical that despite two amendments to the Indian Patent Act 1970-amendment 1999 and 2002, such inventive components of traditional knowledge cannot be patented in India. Small innovators have to file for patents in the USPTO, with higher application fees and transaction costs.

Traditional knowledge cannot be patented if documented under the TRIPS agreement of the WTO. That is why neem and haldi products when patented by the USPTO were revoked once India proved that these were the products of Indian traditional knowledge. One of the major issues needing resolution is the protection of traditional knowledge under a new "sui generis" system. The CSIR has already undertaken the documentation of traditional knowledge so that it is available for prior art search.

## **FAQs for IPR**

# FAQs for IPR

## 1.0. Patents

### I. **What is a Patent?**

A Patent is an exclusive monopoly granted by the Government to an inventor over his invention for limited period of time.

### II. **How do I find out if I need patent, trademark and/or copyright protection?**

Patents protect inventions and improvements to existing inventions. Copyrights cover literary, artistic, and musical works. Trademarks are brand names and/or designs, which are applied to products or used in connection with services.

### III. **Who can obtain a Patent?**

An inventor or any other person/company assigned by the inventor can obtain the patent over his invention.

### IV. **How a patent is obtained / filed?**

A patent is obtained by the inventor or his assignee by filing an application with the patent office in the stipulated forms as required by the Patent act of that country.

### V. **Why does the Government encourage filing of patents?**

To encourage innovation and investment in the research and development activities so that there is economic, industrial and technological development in the country.

### VI. **How does a patent document help in R&D?**

Study of a Patent document may stop re-inventing the wheel. A scientist, who has not consulted the patent literature, may start working on a problem for which the solution might have already been found by someone else and it is available in the patent literature.

### VII. **Which invention qualifies for the grant of a patent?**

A patent is granted only on that invention, which is new, non-obvious and has industrial applicability.

**VIII. Upto what extent the inventor has to disclose his invention to get a patent?**

An inventor has to disclose his invention in such a manner that any person, other than the inventor, skilled in the art should be able to work out the invention.

**IX. How does a patent expire?**

A patent can expire in the following ways:

1. the patent has lived its full term i.e. the term specified by the patent act of the country. Generally it is 20 years from the date of filing.
2. The patentee has failed to pay the renewal fee. A patent once granted by the Government has to be maintained by paying annual renewal fee.
3. The validity of the patent has been successfully challenged by an opponent by filing an opposition either with the patent office or with the courts.

**X. Is there an International/Global patent?**

No. There is no International or Global Patent. An inventor has to file an application in each country, where he seeks to protect his invention. There are regional and/or International treaties to facilitate the procedure to seek protection like Patent co-operation Treaty (PCT) or European Patent Convention (EPC)

**XI. Can a scientist get a patent on the invention, which he has already published in the form a paper in a national/International journal?**

No. A patent is not granted to an invention if it is already available with the public either in the form of published literature of common knowledge.

**XII. Why one should access the patent literature?**

Before the start of the research and development project, one should scan the patent literature to stop re-inventing the wheel or during the development phase, when stuck up with a technical problem, to find a technical solution. or once the research is complete i.e. at the time of filing the patent application, to narrow down or broaden the claims and/or to draft the application for getting a patent

**1.2. Trademarks**

**I. What is a Trademark?**

Trademarks are words, names, symbols, brands, devices, headings, labels, tickets, signatures, letters or numerals or any combination thereof, used or proposed to be used by manufacturers of goods to identify and to distinguish their goods from goods manufactured and sold by others. A person who sells his goods under a particular trademark acquires a sort of limited exclusive right to use the mark in relation to those goods

## **II. What are the benefits of trademark registration?**

Trademark registration protects the goodwill of a business and also helps to identify and distinguish the source of the goods or services of one party from those of others. Trademark registration is an evidence of ownership of the trademark and also constructive notice nationwide are issued of the trademark owner's claim. Trademark registration in India can also be used as a basis for obtaining registration in foreign countries.

## **III. Who can file an application for trademark registration?**

The application must be filed in the name of the owner of the trademark; usually an individual, corporation or partnership. Generally, the person who uses or controls the use of the mark, and controls the nature and quality of the goods to which it is affixed, or the services for which it is used, is the owner of the mark.

## **IV. What trademarks can be registered?**

A trade mark which consists of at least one of the following essential particulars: the name of a company, individual or firm represented in a particular or special manner; the signature of the applicant for registration; one or more invented words; one or more words having no direct reference to the character or quality of the goods and not being according to its ordinary signification a geographical name or a surname or a personal name or any common abbreviation thereof or the name of a sect, caste or tribe in India; any other distinctive trade mark; a trade mark which has acquired distinctiveness by use over a prolonged period of time, may be registered.

## **IV. What trademarks may not be registered?**

Trademark, which is identical to or deceptively similar to a trademark, which is already registered or has already been applied for in the name of a different proprietor in respect of the same goods or description of goods, may not be registered. Also trademark the use of which would be likely to deceive or cause confusion; the use of which would be contrary to any law in force; which comprises or contains scandalous or obscene matter or any matter likely to hurt the religions susceptibilities of any class or section of the citizens of India; may not be registered.

## **V. How do I find out whether a mark is already registered?**

In order to determine whether any person or company is using a particular trademark, a trademark search can be conducted.

## **VII. What is a trademark search?**

A trademark search is designed to identify pre-existing trademarks that have the potential to conflict with your name. Without the benefit of a trademark search, you run the risk of being sued for trademark infringement and losing the right to use your new business name, product name, domain name or slogan after you have invested in that name. Uncovering and avoiding trademark conflicts with your name can often mean the difference between the success and failure of your business venture.

**VIII. Is it advisable to conduct an official search of the govt. records before filing an application?**

Yes, it is advisable to get the official search report from the registered and pending application records before filing the application.

**IX. How long does it take for a mark to be registered?**

Due to a lot of back log and also since the applications are processed on "first come first serve" basis generally, it takes on an average about 5-6 years before the mark is registered provided no opposition is entered by any third party.

**X. Could the office refuse to register a mark?**

Yes, the Trademark office will refuse to register matter if it does not function as a trademark. Not all words, names, symbols or devices function as trademarks. For example, matter which is merely the generic name of the goods on which it is used cannot be registered.

**XI. Do I have to be an Indian citizen to obtain a trademark registration?**

No. However, an applicant's citizenship must be set forth in the record. If an applicant is not a citizen of any country, then a statement to that effect is sufficient. If an applicant has dual citizenship, then the applicant must choose which citizenship will be printed in the Official Gazette and on the certificate of registration.

**XII. Is it possible for a foreign corporation to license a trademark in India against payment of royalty in a foreign currency?**

An agreement for payment of royalty to a non-resident requires the prior approval of the government. The government's policy statement makes it clear that in case of a use of a foreign brand name a payment of royalty shall not be allowed unless the products on which the mark is used are intended for export.

**XIII. Can the ownership of a trademark be assigned or transferred from one person to another?**

Yes. A registered mark, or a mark for which an application to register has been filed is assignable.

**XIV. When is it proper to use the "TM" and the registration symbol "®" with the mark?**

Once you have filed an application for registration of trademark, the "TM" symbol may be used with the mark. Anyone who claims rights in a mark may use the TM (trademark) designation with the mark to alert the public to the claim. However, the registration symbol, ®, may only be used once the mark is actually registered in the Trademark Registrar's Office. Even though an application is pending, the registration symbol may not be used before the mark has actually become registered.

## **XV. What forms of protection are available for trademarks?**

There are two forms of legal protection that are available for trademarks. Under the Trade and Merchandise Marks Act, 1958, once the trademark is registered, infringement can be easily established. In case of unregistered marks and marks which are not registerable, the only form of protection is the common law remedy of passing off. Trademark law protects the right of the owner of a mark to use marks that distinguish his goods from others and to prevent others from using marks that are likely to cause confusion.

### **1.3. Designs:**

#### **I. What is meant by 'Design' under the Designs Act, 2000?**

"Design" means only the features of shape, configuration, pattern or ornament or composition of lines or colour or combination thereof applied to any article whether two dimensional or three dimensional or in both forms, by any industrial process or means, whether manual, mechanical or chemical, separate or combined, which in the finished article appeal to and are judged solely by the eye, but does not include any mode or principle or construction or any thing which is in substance a mere mechanical device, and does not include any trade mark, as defined in clause (v) of sub-section of Section 2 of the Trade and Merchandise Marks Act, 1958, property mark or artistic works as defined under Section 2(c) of the Copyright Act, 1957.

#### **II. What does an article under the Designs Act, 2000, mean?**

Under the Designs Act, 2000 the "article" means any article of manufacture and any substance, artificial, or partly artificial and partly natural; and includes any part of an article capable of being made and sold separately;

#### **III. What is the object of registration of Designs?**

Object of the Designs Act to protect new or original designs so created to be applied or applicable to particular article to be manufactured by Industrial Process or means. Sometimes purchase of articles for use is influenced not only by their practical efficiency but also by their appearance. The important purpose of design Registration is to see that the artisan, creator, originator of a design having aesthetic look is not deprived of his bonafide reward by others applying it to their goods.

#### **IV. What is a Register of Designs?**

The Register of Designs is a document maintained by The Patent Office, Kolkatta as a statutory requirement. It contains the design number, class number, date of filing (in this country) and reciprocity date (if any), name and address of Proprietor and such other matters as would affect the validity of proprietorship of the design and it is open for public inspection on payment of prescribed fee & extract from register may also be obtained on request with the prescribed fee.

#### **V. What is the effect of registration of design?**

The registration of a design confers upon the registered proprietor 'Copyright' in the design for the period of registration. 'Copyright' means the exclusive right to apply a design to the article belonging to the class in which it is registered.

**VI. What is the duration of the registration of a design? Can it be extended?**

The duration of the registration of a design is initially ten years from the date of registration, but in cases where claim to priority has been allowed the duration is ten years from the priority date. This initial period of registration may be extended by further period of 5 years on an application made in Form-3 accompanied by a fee of Rs. 2,000/- to the Controller before the expiry of the said initial period of Copyright. The proprietor of a design may make application for such extension even as soon as the design is registered.

**VII. What is the date of registration?**

The date of registration except in case of priority is the actual date of filing of the application. In case of registration of design with priority, the date of registration is the date of making an application in the reciprocal country.

**VIII. What is piracy of a Design?**

Piracy of a design means the application of a design or its imitation to any article belonging to class of articles in which the design has been registered for the purpose of sale or importation of such articles without the written consent of the registered proprietor. Publishing such articles or exposing terms for sale with knowledge of the unauthorized application of the design to them also involves piracy of the design.

**IX. Why is it important for filing the application for registration of design at the earliest possible?**

First-to-file rule is applicable for registrability of design. If two or more applications relating to an identical or a similar design are filed on different dates only first application will be considered for registration of design.

**X. Can the same applicant make an application for the same design again, if the prior application has been abandoned?**

Yes, the same applicant can apply again since no publication of the abandoned application is made by the Patent Office, provided the applicant does not publish the said design in the meanwhile.

**XI. How to get information on registration of design?**

Ans.: After registration of designs the most relevant view(s) of the article along with other bibliographic data will be available in the official gazette, which is being published on every Saturday. However, such provision cannot be implemented at this stage due to insufficient infrastructure.

**1.4. Geographical Indication**

**I. What is a Geographical Indication?**

- It is an indication
- It originates from a definite geographical territory.

- It is used to identify agricultural, natural or manufactured goods
- The manufactured goods should be produced or processed or prepared in that
- It should have a special quality or reputation or other characteristics

## II. **What is the benefit of registration of geographical indications?**

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

## III. **Who can apply for the registration of a geographical indication?**

- Any association of persons, producers, organization or authority established by or under the law can apply
- The applicant must represent the interest of the producers
- The application should be in writing in the prescribed form
- The application should be addressed to the Registrar of Geographical Indications along with prescribed fee.

## IV. **Who is a registered proprietor of a geographical indication?**

- Any association of persons, producers, organisation or authority established by or under the law can be a registered proprietor.
- Their name should be entered in the Register of Geographical Indication as registered proprietor for the Geographical Indication applied for.

## V. **Who is an authorized user?**

- A producer of goods can apply for registration as an authorized user
- It must be in respect of a registered geographical indication
- He should apply in writing in the prescribed form along with prescribed fee

## VI. **Who is a producer in relation to a Geographical Indication?**

- The persons dealing with three categories of goods are covered under the term producer
- Agricultural Goods includes the production, processing, trading or dealing
- Natural Goods includes exploiting, trading or dealing
- Handicrafts or Industrial goods includes making, manufacturing, trading or dealing.

## VII. **Is a registration of a geographical indication compulsory and how does it help the applicant?**

- Registration is not compulsory
- Registration affords better legal protection to facilitate an action for infringement

- The registered proprietor and authorized users can initiate infringement actions
- The authorized users can exercise the exclusive right to use the geographical indication.

#### VIII. **Who can use the registered geographical indication?**

- An authorized user has the exclusive rights to the use of geographical indication in relation to goods in respect of which it is registered.

#### IX. **How long the registration of Geographical Indication is valid?**

- The registration of a geographical indication is valid for a period of 10 years.

#### X. **Can a Geographical Indication be renewed?**

- It can be renewed from time to time for further period of 10 years each.

#### XI. **What is the effect if a Geographical Indication if it is not renewed?**

- If a registered geographical indication is not renewed it is liable to be removed from the register.

#### XII. **Who can initiate an infringement action?**

- The registered proprietor or authorized users of a registered geographical indication can initiate an infringement action.

#### XIII. **Can a registered geographical indication be assigned, transmitted, etc?**

No. A geographical indication is a public property belonging to the producers of the concerned goods.

- It shall not be the subject matter of assignment, transmission, licensing, pledge, mortgage or such other agreement
- However, when an authorized user dies, his right devolves on his successor in title.

#### XIV. **How a geographical indication is different from a trademark?**

- A trademark is a sign which is used in the course of trade and it distinguishes goods or services of one enterprise from those of other enterprises.
- Whereas a geographical indication is an indication used to identify goods having special characteristics originating from a definite geographical territory.

### 1.5. **Copyrights**

#### I. **What is a Copyright?**

Copyright is a form of intellectual property protection granted under the Indian Copyright Act 1957, to the creators of original works of authorship such as literary,

dramatic, musical, artistic, and certain other intellectual works. The copyright vests in original work in whatever form it may be and in India it is not mandatory but useful in courts where civil and/or criminal proceedings can be taken to protect it.

## **II. What does a copyright protect?**

Copyright law protects creative expression, not fact, idea system or method of process or operation. Expression may be found in product design, written expression, traditional artistic works, and other original works such as literary, dramatic, musical, and artistic works such as poetry, novels, movies, songs, computer software and architecture.

## **III. How to obtain copyright protection for a software/algorithm developed by us?**

To protect your work from piracy etc. you can file application for copyright protection of your software/algorithm and in fact, your single application in India can provide you international protection for your software/algorithm.

## **IV. Is it compulsory for me to register my work with Copyright Office to get copyright protection?**

No. Your work is protected by a copyright at the moment you create it in a tangible form (written copy, recorded music, filmed movie, digital data saved on a computer disk). It is not necessary under the Indian Copyright Act to register with the Copyright Office to get copyright protection. Registration of the work is however highly recommended because such registration is helpful in an infringement suit. As per the Copyright Act, the register of copyrights (where the details of the work are entered on registration) is prima facie evidence of the particulars entered therein. The documents purporting to be copies of any entries therein, or extracts from the register which are certified by the Registrar of copyrights and with the seal of the copyright office, are admissible as evidence in all courts without proof or production of the original. India is a member of both Berne and Universal Conventions and Indian law extends protection to all copyrighted works originating from any of the convention countries. However, in case of infringement of copyright, during court proceedings, copyright registration with the government of India serves as an advantage.

## **IV. What part of my creation does copyright law protect?**

Copyright law prevents copying of expression. Facts and ideas are not protectable under copyright law.

## **V. How long is a copyright valid?**

The duration of a copyright depends on when the author acquired the copyright. Currently, the duration for individuals is life of the author plus 70 years, or the case of a joint work, the term lasts for 70 years after the last surviving author's death, alternatively 75 years, whichever is longer. If a company is the author, the duration is 95 years from the year of first publication or 120 years from the year of creation, whichever expires first.

**VII. What is the geographic scope of protection of a copyright?**

Treaties provide for substantially worldwide protection.

**VIII. What is proper copyright notice?**

Notice has three parts. First, a word, abbreviation, or symbol designating copyrights (copyright, cppt, or ©). Next, the name of the author. Finally, the year in which the work was completed. Multiple years indicate multiple years of completion (i.e. continuing editing). Use of the words "All rights reserved" provides protection in a couple South American countries

**IX. Can a company be considered the author?**

A company can be considered the author of works done within the scope of an employee's duties. Such work by an employee by which the company is considered the author is called "work for hire". A company under certain circumstances can be considered the author of works of independent contractors. Companies can also become the owner of copyrights through assignments.

**X. Can I license or sell my copyright?**

Yes. Just like patents or trademarks (or any other property), any or all of the rights of ownership in a copyrighted work may be transferred by the owner to another party. Usually, a legal agreement outlining the transfer accompanies the license or sale.

## **Procedures for Filing IPRs in India**

## Procedures for filing IPRs in India

### 1.0. Patents

#### 1.1. Documents Required For Filing An Application:

- Application form in triplicate.
- Provisional or complete specification in triplicate. (Provisional specification must be followed by complete specification within specified period of time)
- Drawing in triplicate (if necessary).
- Abstract of the invention (in triplicate).
- Information and undertaking listing the number, filing date and current status of each foreign patent application in duplicate.
- Priority document (if priority date is claimed).
- Declaration of inventorship where provisional specification is followed by complete specification or in case of convention application.
- Power of attorney (if filed through Patent Agent).
- Fee in cash/by local cheque/by demand draft.

#### 1.2. Patent Application Forms: <http://www.ipindia.nic.in/ipr/patent/patents.htm>

## **2.0. Trademarks:**

### **2.1. Documents Required:**

- A signed power of attorney in front of 2 witnesses;
- 30 prints of the mark;
- Date of the first use in India or the date intended to be used;
- Applicant's name, address, nationality, the list of goods and/or services, and the nature of business if the applicant is a corporate.

### **2.2. Procedure to be followed before applying for registration of Trademark:**

a. It is advisable to conduct a market survey through an investigating agency etc. to ascertain whether any other person in the market uses any identical or deceptively similar mark for the same goods.

b. It is advisable not to imitate another person's trade mark or any other well known trade mark even if the goods are different.

c. Before applying for registration it is desirable to obtain preliminary advice regarding the distinctiveness of your mark from the Registrar by making a request on form TM-55 with a prescribed fee of Rs. 50/-.

d. Also a request can be made on form TM-54 with a prescribed fee of Rs. 50/- to the Trade Marks Registry to obtain an official report to ascertain whether any identical or deceptively similar trade mark exists on the Register or pending for registration for the same goods.

e. Also a personal inspection or search through the records of the Trade Marks Registry on payment of a prescribed fee of Rs. 50/- per hour may be done.

### **2.3. Procedure for Registration of Trademark Application:**

By filing an application in prescribed form with prescribed fee in one of the five patent office depending on the place where the applicant resides or his principle place of business.

#### **Application under Convention Agreement:**

If a right to priority is claimed by reason of an application for protection of a trademark duly filed in a convention country under section 154 a certificate by the registry or competent authority of that Trade Mark office shall be included in an application for registration under sub- (3), (4), (6), (7) (b), (8) (b), (11), (17) (b) or (18) (b) of rule 25, as the case may be and it shall include particulars of the mark, the country(s) and date(s) of filing of application and such other particulars as may be required by the registrar.

### **2.4. Forms: <http://www.tmrindia.com/Forms/formindex.htm>**

### **3.0. Designs**

The existing legislation on industrial designs in India is contained in the New Designs Act, 2000.

#### **3.1. Documents Required:**

- A signed power of attorney in front of 2 witnesses;
- 5 sets of figures or photographs in color or black and white, preferably of various views of the complete article;
- A certified copy of the priority document showing the filing date, number and country, if priority is to be claimed.

#### **3.2. Steps involved in Registration of Designs:**

- ❖ Finding out whether any registration already exists
- ❖ Preparing a representation of the design
- ❖ Identifying the class of design
- ❖ Providing a statement of novelty
- ❖ Including a disclaimer
- ❖ Claiming a priority date
- ❖ Determining the fee to be paid
- ❖ Ensuring all enclosures are attached

#### **3.3. Forms: <http://www.ipindia.nic.in/ipr/design/designform.htm>**

#### **4.1. Geographical Indications:**

#### **4.2. Documents required for filing Geographical Indications**

An application for registration of a geographical indication is to be made in writing using a replica of the official application Form GI-1 for the registration of a Geographical Indication in Part A of the Register by an Indian applicant; Form GI-2 for a convention application; an application for goods falling in different classes by an Indian applicant in Form GI-3 and an application for registration of goods falling in different classes from a convention country in Form GI-4 along with prescribed fee and should be addressed to the “Registrar of Geographical Indications.

#### **Additional Requirements:**

- Application in prescribed forms (submitted to
- The Registrar of Geographical Indication)
- How the indication serves to designate the goods as a Geographical Indication?
- The Class of goods;
- The territory;
- The particulars of appearance;
- Particulars of producers;
- An affidavit of how the applicant claim to represent the interest;
- The standard bench mark or other characteristics of the geographical indication;
- The particulars of special characteristics;
- Textual description of the proposed boundary;
- The growth attributes in relation to the G.I. pertinent to the application;
- Certified copies of the map of the territory
- Special human skill involved, if any;
- Number of producers; and
- Particulars of inspection structures, if any, to regulate the use of geographical indication.

## **5.0. Copyrights:**

One need not to apply or register to have a copyright; copyright protection is received when you create the work. However, registering your work expands your protections and sometimes can be done without disclosing the entire work. Depositing a copy of your work with the Copyright Office within 90 days of creation also protects your work, as it provides a legal record of the creation date, and allows others to have notice of your ownership rights.

There is no such thing as an "international copyright" that will automatically protect an author's writings throughout the entire world. Protection against unauthorized use in a particular country depends, basically, on the national laws of that country. However, most countries do offer protection to foreign works under certain conditions, and these conditions have been greatly simplified by international copyright treaties and conventions.

### **5.1. Documents Required:**

- A signed power of attorney
- If the applicant is not the author/s, a Deed of Assignment executed by the author/s, assigning his/their rights to the applicant, legalized by the Indian Consulate in the applicant's country
- The author's name or authors' names for joint works
- Three copies of the work of art

### **5.2. How do you file a copyright application?**

- Classify Work
- Determine Ownership
- Identify Appropriate Form
- Complete Registration Form
- Comply with Deposit Requirements
- Payment of fee

## **Time Taken for the grant of IPRs in India**

### **1.0. Time Taken for the grant of IPRs in India**

<b><u>IPRs</u></b>	<b><u>Time Taken for the grant</u></b>	<b><u>Validity Period</u></b>	<b><u>Renewal Period</u></b>
<b>Patent</b>	2-3 yrs	20 yrs	Annual
<b>Trademark</b>	1-2 yrs	Perpetual on renewal & the use of mark in Trade	10 yrs
<b>Geographical Indications</b>		Perpetual on renewal	10 yrs
<b>Design</b>		10 years	5 years
<b>Copyright</b>	1-12 moths	Life time of author +60 yrs after his death from its publication date	

**Nodal Agencies supporting IPR facilitation, Technology Incubation & Funding:**

S.NO	NAME OF THE COMPANY	CONTACT ADDRESS	TELEPHONE & FAX NO	WEBSITE/ EMAIL
1	CII - Andhra Pradesh Technology Development & Promotion Center	1-11-252/9, Plot #7 Regal House, Motilal Nehru Nagar Begumpet Hyderabad-500016	Tel:91-40-27765837 Fax:91-40-27765836	Website: <a href="http://www.aptdc.com">www.aptdc.com</a>
2	National Research Development Corporation	20-22, Zamroodpur Community Center, Kailash Colony Extension, New Delhi 110 048. India	Ph: +91-11-26419904, 26417821, 26480767, 26432627 Fax: 011-26460506, 26478010, 26231877	Website: <a href="http://www.nrdcindia.com">www.nrdcindia.com</a> email: <a href="mailto:write2@nrdcindia.com">write2@nrdcindia.com</a>
3	Department of Science & Technology	Technology Bhavan, New Mehrauli Road, New Delhi	T:110+91-11-2656737 F: +91-11-26864570, 268624183, 26962819016	General Info: <a href="mailto:dstinfo@alpha.nic.in">dstinfo@alpha.nic.in</a>
4	Council of Scientific and Industrial Research (CSIR)	Anusandhan Bhavan 2, Rafi Marg New Delhi - 110 001, India.	Fax: (91 11) 371 0618	E-mail: <a href="mailto:dgcsir@csirhq.ren.nic.in">dgcsir@csirhq.ren.nic.in</a>
5	Technology Information, Forecasting and Assessment Council (TIFAC)	Department of Science and Technology (DST), Technology Bhavan, New Mehrauli Road, New Delhi-110016, India.	Ph: +91-11-26515420/ 26865475 Fax: +91-11-26515420/ 26863866	E-mail: <a href="mailto:tifacinfo@tifac.org.in">tifacinfo@tifac.org.in</a>
6	Department Of Science & Technology	The Secretary, Technology Development Board, Department Of Science & Technology, Technology Bhawan, New Mehrauli Road, New Delhi-110016	Telephone No. 6516037, 6961583  Fax No. 6857643.	
7	Technology Export Development Organization (TEDO)	C/o Confederation of Indian Industry 249F, Udyog Vihar Phase IV, Sector 18, Gurgaon (Haryana)	Phone: 91-0124-8914060-67 Fax: 91-0124-8914080	<a href="http://www.ciionline.org">www.ciionline.org</a>
8	Department of Industrial Policy & Promotion	Section Officer (DBA.II), Department of Industrial Policy & Promotion, Room No.457, Udyog Bhavan, New Delhi-110011.		

# **Glossary of Terms**

# Glossary of Terms

## **Amendments**

Alterations (such as clarifications or deletions) made to a patent application or to a granted patent specification. The description, drawings and claims can all be altered by amendment, either because the applicant wishes to, or because the Office requires it. Any amendments must not add any material to the application or specification that was not present when the application was filed.

## **Anticipation**

This is when the prior art indicates that a patent application lacks novelty.

## **Applicant**

A person who makes a patent application. Often this will be the inventor, but it need not be so. Several people can apply jointly for a patent, as can organizations.

## **Application (for Patent)**

Papers comprising petition, specification, drawings (when required), one or more claims, oath or declaration and filing fee, whereby an applicant seeks a patent.

## **Arbitration**

An alternative method of resolving disputes between parties. The right of Appeal from a decision of the arbitrator is limited by the Arbitration Act

## **Assignee**

The person(s) or corporate body to whom all or limited rights under a patent are legally transferred. Assignment Transfer of all or limited rights under a patent.

## **Assignment**

The transfer of intellectual property rights from the owner of the rights to another person or organisation.

## **Assignor**

One who assigns a patent right.

## **Claims**

A precise statement of the invention that the applicant wishes to protect. It is the monopoly rights that the applicant is trying to obtain for the invention. A main claim will define the invention in its broadest form, by including its essential technical features. Further "dependant" claims can then relate to additional features of the

invention. The claims become the actual monopoly that is given when/if the patent is granted.

### **Convention country**

A state that has signed up to the Paris Convention.

### **Decisions**

The exercise in writing or orally by the Comptroller of any discretion vested in by, for example, the Patents Act 1977 and the Patents Rules 1995.

### **Description**

A full and detailed explanation of the invention and how it works, filed at the Office to initiate a patent application . The description may be accompanied by one or more drawings.

### **Design Patent**

A type of patent covering the shape characteristics of an object.

### **Drawing**

One or more specially-prepared figures filed as a part of a patent application to explain and describe the invention. Drawings (or illustrations, where appropriate) are more commonly found with inventions for mechanical or electrical devices. As a rule, chemical patents will include chemical formulae in the description of the invention and/or in the examples.

### **Examiner**

A patent office official who is appointed to determine the patentability of applications. Exclusive license. A license granted by the owner of a patent which allows other party to use the invention protected by the patent. With such a license, the owner himself cannot then use his invention, but he can collect royalties on the use of his patent.

### **Expiry Date**

The date when a patent has run its full term in a country and is no longer protected there (see also Lapse, Withdrawn).

### **Filing date**

The date on which a full description is lodged at the Office. An important date when considering if the invention in the patent application is novel and inventive.

### **Grant**

A temporary right given by a patent office for a specified period, to prevent anyone else from using the technology defined in the claims of a patent.

## **Infringement**

Carrying out an action which falls within the scope of the patent rights owned by another person, without their permission.

## **Injunction**

A court order prohibiting a person from doing something or requiring a person to do something.

## **International patent application**

Single patent application for up to 104 countries, made under the Patent Cooperation Treaty (PCT) via one of a number of receiving Offices . This can lead to the grant of a patent in each country designated by the applicant.

## **Inventive step**

If a patent for an invention is to be granted, the invention must contain an inventive step. This means that the invention must not be an obvious development of what has gone before, when considered by someone who is skilled in the area of technology to which the invention relates.

## **Lapse**

The date when a patent is no longer valid in a country or system due to failure to pay renewal (maintenance) fees. Often the patent can be reinstated within a limited period.

## **License**

The means by which the owner of a patent gives permission to another person to carry out an action which, without such permission, would infringe the patent. Thus a licence can allow another person to legitimately manufacture, use or sell an invention protected by a patent. In return, the patent owner will usually receive royalty payments.

## **License of right**

A patent owner may indicate (via the Office) that licences under his patent are available as of right to anyone who asks for one on reasonable terms. The owner is then allowed to pay half the usual renewal fees on his patent.

## **Markush**

A term used to describe the series of compounds covered by a patent claim, where the compound is defined as a basic structure with a variable list of possible substituents (e.g. where R=H, alkyl, aryl etc.).

## **Novelty**

If an application for a patent is to be granted, the invention must be novel. This means that the invention must not have been publicly disclosed, anywhere in the world, before the date of filing of the patent application (or before the priority date, if the application has one).

## **Obviousness**

The concept that the claims defining an invention in a patent application must involve an inventive step if, when compared with what is already known (i.e. prior art), it would not be obvious to someone skilled in the art.

## **Opposition**

The time period allowed for an interested party to post oppositions to the grant of a patent. For example, this may be up to nine months from the date of grant of a European patent.

## **Paris convention**

The Paris Convention for the Protection of Industrial Property. An agreement concluded in 1883 and updated several times since. It provides common rules between the member states for designs and other forms of intellectual property. A member state is often referred to as a Convention country.

## **Patentability**

The basic conditions of patentability, which an application must meet before it is granted, are that the invention must be novel, contain an inventive step, be capable of industrial application and not be in one of a number of excluded fields. In some countries certain types of inventions, e.g. computer software and plants, may be unpatentable.

## **Patent agent**

A person who acts on behalf of an applicant for the purposes of drafting a patent application and then taking that patent application through the various stages needed to grant the patent.

## **Patent Family**

All the equivalent patent applications corresponding to a single invention, covering different geographical regions Patent Law Treaty (PLT) A treaty to harmonize formal requirements for patent applications worldwide, which is currently in the process of being implemented.

## **Preliminary Examination**

The initial study of an application by an official in the patent office to check that the specification is properly arranged and for preparing search reports.

### **Preliminary hearing**

A hearing appointed to decide a point of procedure, usually in with notice (inter parties) proceedings.

### **Prior Art**

Previously used or published technology that may be referred to in a patent application or examination report.

### **Priority date**

A patent application may claim as a priority date the filing date of an earlier patent application provided that the earlier application was (i) filed in the previous 12 months, (ii) filed by the same applicant as the later application and (iii) filed in a Convention country. Thus the later application need not be made in the same country as the earlier one. In practice, this means that all patent applications filed in Convention countries in a single year by the same applicant and relating to the same subject matter can be given the same effective date of filing. This effective date of filing is important when considering if the invention in the patent application is novel and inventive.

### **Priority document**

A previously-filed patent application which provides a priority date for a later application.

### **Publication**

A patent application which is successfully granted will be published twice. The first time (A-publication) occurs around 18 months after the filing date of the application (or the priority date, if it has one). The application will generally be published "as filed". The second time (B-publication) occurs when the patent is granted, and publishes the application in its final form.

### **Renewal fees**

Once a patent is granted, annual renewal fees are payable to the Office to keep the patent in force.

### **Research Disclosure**

Defensive-type publications which are published, often anonymously, to give companies and inventors "freedom of use" rather than legal protection. Once research disclosures are published the invention described cannot be patented.

### **Restorations**

The proceedings by which a patent which has lapsed through failure to pay renewal fees may be restored.

## **Revocation**

A process by which a granted patent can be annulled. This can happen because it is demonstrated that the patent does not satisfy one of the patentability criteria - but it can also occur for other reasons.

## **Search report**

A report to the applicant by a patent examiner, bringing to the applicant's attention documents which are thought by the patent examiner to establish whether the invention is novel and inventive.

## **Specification**

The term used to cover the description, drawings and claims contained in an application.

## **Term of patent**

The maximum number of years that the monopoly rights conferred by the grant of a patent may last.

## **Trade Secret**

Businesses often rely on confidential information -- inventions, strategies and processes -- to keep their competitive edge. If such information is improperly disclosed -- for example, by a former employee -- or otherwise illegally acquired by a competitor.

Utility

Fitness for some desirable practical or commercial purpose.

## **Utility Model**

In some countries, a type of patent which is available involving a simpler inventive step than that in a traditional patent. Such patents generally have a shorter life.

## **Utility Patent**

Utility Patents, sometimes called "functional"(or, final) patents, cover a new and useful invention in the categories of processes; mechanical, electrical or chemical procedures; machines with moving parts; articles of manufacture, such as hand tools; compositions of matter, like chemical compounds, combinations, or mixtures. the life of a utility patent is currently 20 years from the date of filing.

## **WIPO**

The World Intellectual Property Organization. An intergovernmental organization with its Headquarters in Geneva, Switzerland. It is responsible for the promotion of the protection of intellectual property throughout the world through co-operation amongst states. It is also responsible for the administration of various international treaties, such as the Patent Co-operation Treaty.

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