



# Ownership and Enforcement of Intellectual property



# Patents

## What is a patent ?

- A patent is a legal right granted by the government which gives exclusive privilege for a limited period of time to inventor to make, sell and use the invention for which a patent has been granted .

# THE INDIAN PATENT ACT

- In India the grant of patents is governed by the patent Act 1970 and Rules 1972.
- The patents granted under the act are operative in the whole of India.

## HISTORY

- ❖ The Patent and Designs Act, 1911.
- ❖ The Patents Act, 1970 and Rules 1972
- ❖ The Patent amendment act 2005

## Objectives of getting a patent.....

- To enjoy the exclusive rights over the invention.
- The patent is to ensure commercial returns to the inventor for the time and money spend in generating a new product.

# Indian Patent act 1970

- An act to amend and consolidate law relating to patents.
- Under this act various patent bills and its amendments were done by research efforts and consultation by government.....

# What can be patented?

- In order to be patentable ,
  1. The invention must be “New/Novel”
  2. The invention must be “Useful”
  3. The invention must be “Nonobvious”

## “NEW” MEANS.....

### Invention must not be

- Published in India or elsewhere
- In prior public knowledge or prior public use with in India

### “Useful” means...

- Invention is capable of being made or used in any kind of industry.
  - *subject matter has a **useful purpose** and also includes operativeness*
  - *Invention must "work" to be useful*

### “Non-obvious” means...

- Involves technical advance as compared to the existing knowledge..



# Types Of Patents

## Utility Patent

- Protects the way an invention is used and works.
  - Process (ex a method for making an alloy, method of making food products.)
  - Machine (ex. camera)
  - Article of Manufacture (ex. carpet)
  - Composition of matter (ex. adhesive)

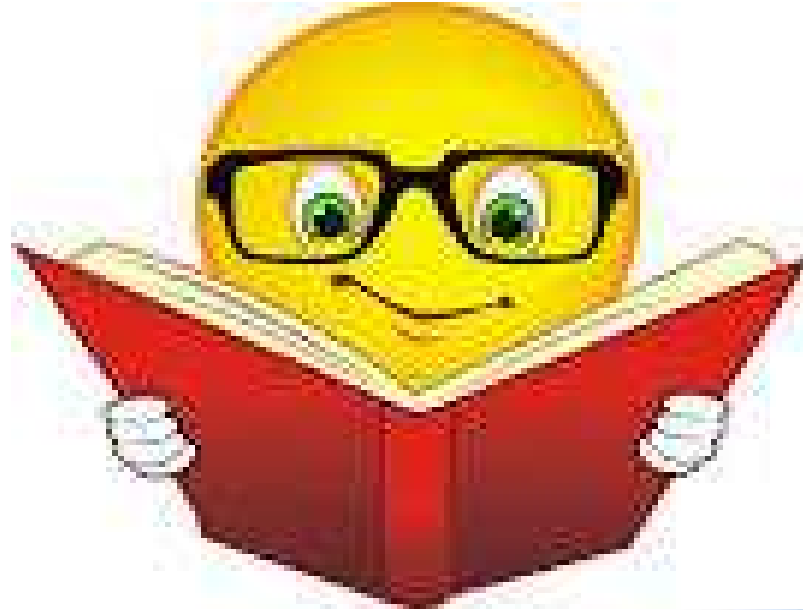
## Plant Patents

- Any newly *discovered* and *asexually reproduced*, distinct and *new variety* of plant, including cultivated mutants, hybrids, and newly found seedlings, other than a tuber-propagated plant or a plant found in an uncultivated state.

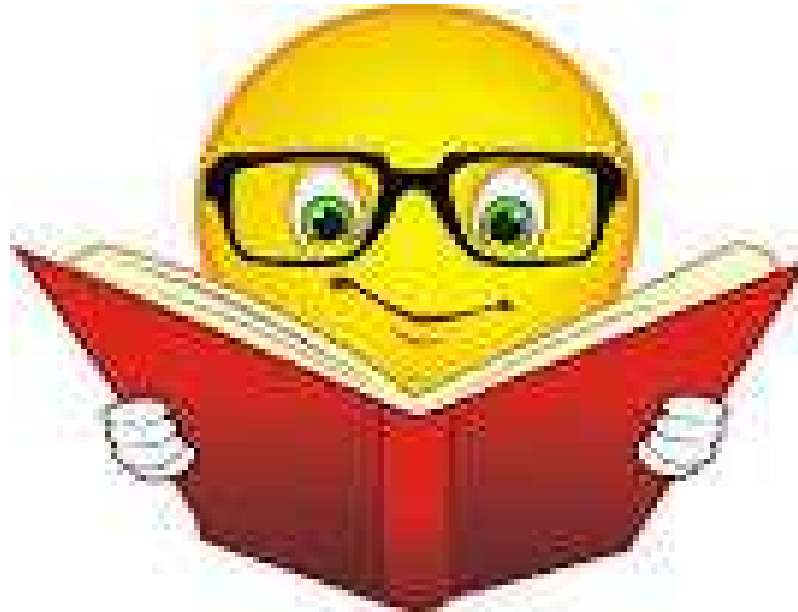
# Design Patents

- Any **new** and **non obvious** ornamental design for an article of manufacture
- Protects only the **appearance** of an article, **not** its structural or functional features
- Design patent has a term of **14 years** from grant

# Indian Patent act 1970 – Objectives



# Indian Patent act 1970 – Salient features



# Non Patentable Inventions



# Registration

## STAGES FROM FILING TO GRANT OF A PATENT

# 1.Obtaining a Patent

- File an application for patent
  - With one of the registrar of patent offices based on territorial jurisdiction of the place of office or residence of the applicant /agent
  - submit the documents and pay the required fee

## 2. Formality Check

- An Examiner checks the formal requirements before accepting the application and the fee – this is done immediately
- Issue of application number and the cash receipt – this is done the same day



## 3.Publication

- Application is kept secret for a period of 15 months from the date of filing
- Once the period of 15 months expires the application is published in the official journal – this journal is made available on the website weekly

## 4.Request for Examination

- Application is sent to an Examiner within 1 month from the date of request for examination
- Examiner undertakes examination w.r.t.
  - whether the claimed invention is not prohibited for grant of patent
  - whether the invention meets the criteria of patentability

## 5. Issue of FER

- A period of 1 to 3 months is available to Examiner to submit the report to the Controller
- 1 month's time available to Controller to vet the Examiner's report
- First Examination Report (FER) containing list of the objections is issued within 6 months from the date of filing of request

## 6. Response from the Applicant

- 12 months' time, from the date of issue of FER, is available to the applicant to meet the objections. Extension of 3 months is available.
- If objections are not met within given period, application is abandoned.
- If objections are met, grant of patent is approved by the Controller – within a period of 1 month

## 7.Pre-grant Opposition

- After publication, an opposition can be filed within a period of 6 months
- Opportunity of hearing the opponent is also available
- Opposition (documents) is sent to the applicant
- A period of 3 months is allowed for receipt of response

# Consideration of Pre-grant Opposition

- After examining the opposition and the submissions made during the hearing, Controller may
  - Either reject the opposition and grant the patent
  - Or accept the opposition and modify/reject the patent application
- This is to be done within a period of 1 month from the date of completion of opposition proceedings
- If opposition is decided in favour of applicant or is not refused, patent is granted.

## 8. Grant of a Patent

- A certificate of patent is issued within 7 days
- Grant of patent is published in the official journal

# The Term Of Patent :

- ✓ In respect of a invention claiming process of manufacture of a substance intended to be used as food or medicine ----- 5 yrs from the date of sealing or 7 yrs from the date of patent whichever is shorter.
- ✓ In case of any other invention ----- 14 yrs from the date of patent.



# Key Amendments in the Patent Law

- Opposition to the grant of patent
- Exclusive marketing rights
- Compulsory license to ensure availability of drugs at reasonable prices
- Provision to deal with public health emergency
- Secrecy Provisions
- Rights prior to the grant of patent
- Patents for computer software
- Patents for Business model

# Rights of a patentee

## 1. Right to exploit the patent.

- ✓ The patentee has a right to exploit the patent & prevent 3<sup>rd</sup> parties, from exploiting the patented invention.

## 2. Right to grant license.

- ✓ The patentee has a power to assign rights or grant license.

## 3. Right to surrender.

- ✓ The patentee is given the right to surrender the patent by giving notice in prescribed manner to the controller.

## 4. Right to sue for infringement.

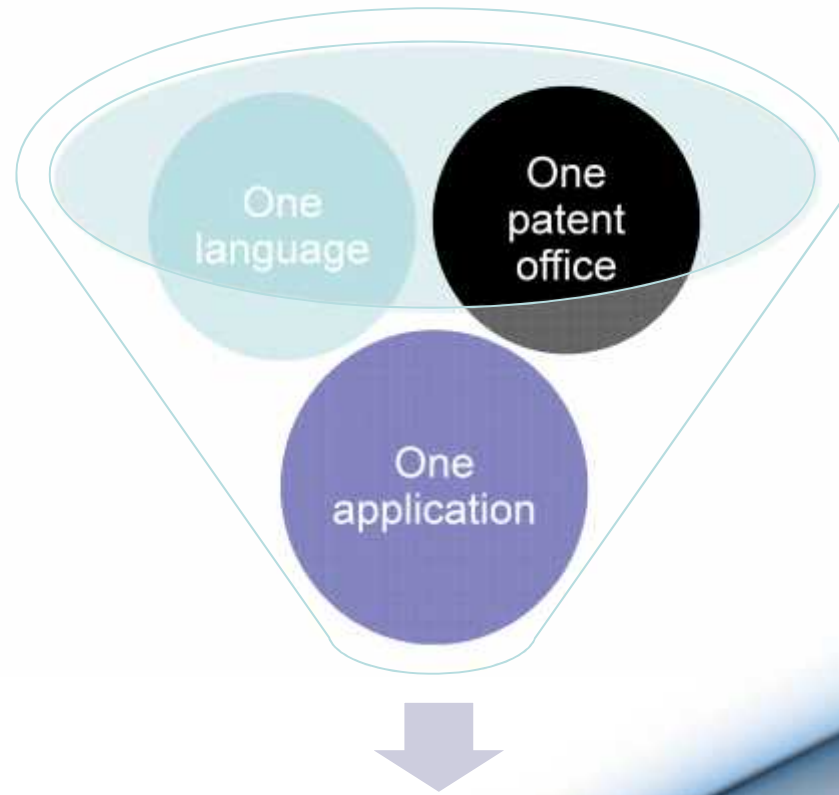
- ✓ A patentee is given the right to institute proceeding for infringement of the patent in a district court .

# Patent Infringement

- Patent infringement is a violation of civil law causing commercial harm.
- Patent infringement consists of the unauthorized making, using, offering for sale or selling any patented invention without the consent of owner(patentee).
- Whoever actively induces infringement of a patent shall also be liable as an infringer.
- In short it is the commission of a prohibited act with respect to a patented invention without permission from the patent holder.
- Patentee can sue infringer for damage and compensation.

# Patent cooperation treaty

- Patent Cooperation Treaty (PCT) is an international patent law treaty that provides a unified procedure for filing patent application to protect inventions in each of its contracting states.
- It is an special international treaty organized by WIPO that only provides access to member states of **Paris Convention for the Protection of Industrial Property**.



**International application/PCT application**

# PCT System



## PCT Timeline



# PCT System – International Phase

## 1. Filing of a PCT application

- Up to 12 months from the filing date of your local (first) application to file your PCT application with the receiving Office of your national or regional patent Office. Or file PCT application directly with the RO of WIPO if permitted by the national security provisions in your national law.

## 2. International search report & written opinion

- At around 16 months from the filing date of your local application, an international search report (ISR) and a written opinion from a national or regional patent Office will be received.

## 3. International publication

- The International Bureau of WIPO publishes the PCT application on PATENTSCOPE shortly after 18 months from the priority date of PCT application.

# PCT System – International Phase

## 4. Supplementary international search (optional)

- The request from supplementary international search may be filed anytime prior to the expiry of 19 months from the priority date. It is completely optional but may be of interest in cases where a more complete overview of the prior art is desired, particularly in respect of specific languages.

## 5. International preliminary examination (Optional)

- If you are not entirely satisfied with the contents of the written opinion, you may decide to continue the assessment of your invention under the PCT by filing a demand for international preliminary examination with a national or regional patent.

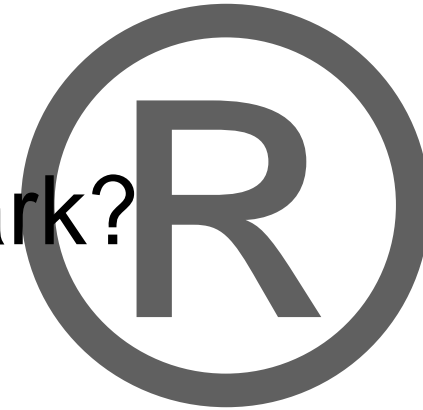


# Youngest Patent-holder on wheelchair



❖ JAIPUR: Drawing inspiration from scientist [Stephen Hawking](#), a wheelchair-bound nine-year-old boy here has invented a game of six-player circular chess. The boy, **Hridayeshwar Singh Bhati** has got the game's design patented in his name.

# What is a Trademark?



## Trademark:

- A distinctive sign which identifies the goods and services of one company from those of another
- A trademark helps consumers to identify and choose between products/services based on their reputation and quality



**Coca-Cola  
registered  
since 1887**

**Nike  
registered  
since 1971**



# Functions of a Trademark

- Indicates the source of origin of goods or services
- Helps guarantee the quality of goods bearing the mark
- It advertises the product. The trademark represents the product.
- It creates an image of the product in the minds of the public particularly the consumers or the prospective consumers of such goods.

What is a service mark?

A **service mark** is the same as a trademark, except that it identifies and distinguishes the source of a **service**, rather than a product.

### Service Mark Examples

The image shows the Walmart logo, which consists of the word "WAL\*MART" in a bold, blue, sans-serif font. A white five-pointed star is positioned between the "L" and "M".

# Types of trademarks

There are 4 types of marks

- **1. Generic names:**

Pertain to an entire group or class of things  
(generally not protected)

computer; is generic; Apple computer is not;

Cola is generic; Coca-Cola is not;

corn flakes is generic.

## 2. Descriptive names:

- Describe the intended purpose, function, use or characteristic of the goods  
(generally not protected)
- Gold Medal (flour), Blue Ribbon (beer), Tasty Bread, Yellow Pages
- But subsequent secondary meaning will be protected (where public no longer associates the words with the literal meaning).  
Holiday Inn, Whole Foods, Save-on Drugs



### 3. **Suggestive names:**

Not merely descriptive but somewhat fanciful and imaginative

(strongly protected)

Greyhound (bus), Tide (laundry soap)

### 4. **Fanciful and arbitrary names:**

(strongest protected of all marks)

- Fanciful: (made up names)

Kodak (photography equipment),

Clorox (bleach), Cutex (fingernail products), Sanka (coffee); Xerox (copier)

- Arbitrary (no connection to the product)

Camel (cigarettes), Apple (computer);

Shell (gasoline); Black & White (scotch)

## How to acquire a right of property in a trade mark?

- A person may acquire a right of property in a trade mark in the following modes:
  - a) By use of the mark in relation to particular goods ;or
  - b) By registration under the Act; or
  - c) By Purchasing of the right or obtaining a license to use mark from another person.



# Different Trademarks

- Service marks: Similar to trademarks; are used to identify the services or intangible activities of a business, rather than a business's physical products.

Examples: *Amazon.com, Orbitz, eBay, Overstock.com, Pandora*

- Collective marks: Trademarks or service marks used by the members of a cooperative, association, or other collective group.

Examples: *Rotary International, International Franchise Association*

# Different Trademarks

- Certification marks: Marks, words, names, symbols, or devices used by a person other than its owner to certify a particular quality about a good or service.

Examples: *Florida Oranges, ISO 9000, Underwriters Laboratories*

# Trademarks act 1999

- The present Trade Marks Act, 1999 has replaced the Trade and Merchandise Marks Act, 1958. And the Trade Marks Act, 1999 has been brought into force only on 15th September 2003. The Trade Mark Rules, 2002 are passed under the Trade Marks Act, 1999.
- Objective is to provide protection to the user and prescribe conditions for acquisition and legal remedies for enforcement of trademark rights.

# SALIENT FEATURES OF THE ACT



# TRADEMARK REGISTRATION

## **WHO CAN APPLY ?**

- Any person who claims to be a proprietor of a trademark and is desirous of registration of the mark can apply. The application may be made in the name of an individual, partners of a firm, a Corporation, any Government Department, a trust or joint applicants.

The registration process includes several steps.

- First, the trademark owner files an application to register the trademark. About 3 months after its filed, the application is reviewed by an examining attorney at Trademark Office.

-The examining attorney checks for compliance with the rules of the Trademark Manual of Examination Procedure.

-This review includes procedural matters such as making sure the applicant's goods or services are identified properly.

-It also includes more substantive matters such as making sure the applicant's mark is not merely descriptive or likely to cause confusion with a pre-existing applied-for or registered mark.

- Second, If the application runs afoul of any requirement, the examining attorney will issue an office action requiring the applicant to address certain issues or refusals prior to registration of the mark.

- Third, If the examining attorney approves the application, it will be "published for opposition."

During this 30-day period third-parties who may be affected by the registration of the trademark may step forward to file an Opposition Proceeding to stop the registration of the mark.

-If an Opposition proceeding is filed it institutes a case before the Trademark Trial and Appeal Board to determine both the validity of the grounds for the opposition as well as the ability of the applicant to register the mark at issue.

- Fourth, provided that no third-party opposes the registration of the mark during the opposition period or the opposition is ultimately decided in the applicant's favor the mark will be registered in due course.



- Upon submission of an application for registration of a trademark, there can be four outcomes:
- a. The application is accepted as it is.
- b. The application is accepted subject to certain amendment.
- c. The application is accepted but later it is found to have been accepted in error.
- d. The application stands rejected.

# Trademark refusal

- A trademark will not be registered if
  - Mark deceives public or causes confusion
  - Mark that hurts religious sentiments of any class
  - Marks that contains scandalous and obscene matter
  - Marks that are named after great personalities and Leaders

- **Term of registration** -The registration of a trademark shall be for a period of 10 years, but it may be renewed from time to time.
- Registration of a trade mark is not compulsory. But for better protection it is advisable to register a trade mark.

# TRADEMARK INFRINGEMENT

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

# ESSENTIALS OF INFRINGEMENT

- 1) The taking of any essential feature of the mark or taking the whole of the mark a few additions and alterations would constitute infringement.
- 2) The infringing mark must be used in the course of trade, that is, in a regular trade wherein the proprietor of the mark is engaged.
- 3) The use of the infringing mark must be printed or usual representation of the mark in advertisements, Invoices or bills. Any oral use of the trademark is not infringement.
- 4) Any or all of the above acts would constitute infringement.

# REMEDIES

- The proprietor of a trademark has a right to file a suit for infringement of his right and obtain .
- Injunction- an injunction restrains the defendant from using the offending mark pending the trial of the suit or until further orders.
- Damages in assessing the damages the important question is what is the loss sustained by the plaintiff. The loss must be the natural and direct consequence of the defendant's acts. The object of damages is to compensate for loss or injury.

- Accounts of profits. Where a plaintiff claims the profits made by the unauthorised use of his trademark, it is important to ascertain to what extent he trademark was used, in order to determine what proportion of the net profits realised by the infringer was attributable to its use.

# Passing-off Action

- Passing off action is a form of [intellectual property](#) enforcement against the unauthorised use of a mark which is considered to be similar to another party's registered or unregistered trademarks.
- In passing-off registration of trademark has no meaning. Priority is given to adoption and use of trademark rather than its registration.



# Essential elements for successful Passing off action

- Owner has to prove similarity in trade names.
- Defendant is deceptively passing off his goods in name of owners.
- Causing confusion in minds of customers.
- Nature of activity and market consumption of goods of both the parties must be same.
- Injuring business reputation of trader.
- Misrepresentation and loss or damage of goodwill.

# **COPYRIGHTS AND RELATED RIGHTS**

# Copyrights

- Copyright is a right given by the law to creators of literary, dramatic, musical and artistic works and producers of cinematograph films and sound recordings
- It is a bundle of rights including rights of reproduction, communication to the public, adaptation and translation of the work.

# What are protected by copyrights

- The Copyright Act, 1957 protects original literary, dramatic, musical and artistic works and cinematograph films and sound recordings from unauthorized uses. Unlike the case with patents, copyright protects the expressions and not the ideas. There is no copyright in an idea.

# Scope of protection

- **Literary works**

- Includes story

- writing,scripting,novels,Biographies,Newspaper articles.

- Also includes computer program ,table of compilation, databases.

- **Musical works**

- Includes lyrics

- **Dramatic works**

- Includes Dance shows,Plays.

- **Artistic work**

- Drawing,Painting,Sculpturing,Photography.

- **Cinematographic film**

- Includes Motion pictures

- Pictorial, graphic, sculptural works

- **Sound recordings**

- **Radio and television broadcasts**

# Computer software

- Software can also be protected

# COPYRIGHT ACT, 1957

- Copyright Act refers to laws that regulate the use of the work of a creator, such as an artist or author.
- This includes copying, distributing, altering and displaying creative, literary and other types of work. Unless otherwise stated in a contract, the author or creator of a work retains the copyright.
- Copyright does not ordinarily protect titles by themselves or names, short word combinations, slogans, short phrases, methods, plots or factual information.



# NEED FOR COPYRIGHT

- It gives you the exclusive right to reproduce or copy the work or change its form.
- Registration informs the world that you own the work
- If you succeed in an infringement suit, you are entitled to money damages.

# Indian perspective on Copyright Protection

The Copyright Act, 1957 provides copyright protection in India. It confers copyright protection in the following two forms:

(a) Economic rights of the author: Economic rights allow the rights owner to derive financial reward from the use of his works by others

(b) Moral Rights of the author: Moral rights allow the author to take certain actions to preserve the personal link between himself and the work.

# TERM OF COPYRIGHT

- It varies according to the nature of work - 60 years, in India.
- ✓ literary, dramatic, musical or artistic work (other than a photograph), when published during the lifetime of the author, copyright subsists during the lifetime of the author, plus 60 years.
- ✓ In the case of photographs, cinematograph films and sounds recordings; the term is 60 years from the date of publication.
- ✓ When the first owner of copyright is the government or a public undertaking, the term of copyright is 60 years from the date of publication.

# COPYRIGHT INFRINGEMENT

Copyright infringement is the use of works under copyright, infringing the copyright holder's exclusive rights without permission from the copyright holder. As per (sec 51 ) of Copyright act 1957 ,copyright in a work is said to be infringed when any person :

- ✓ Making infringing copies for sale or hire
- ✓ Distributing infringing copies for the purpose of trade
- ✓ By way of trade-exhibits in public
- ✓ Imports in to India

# Remedies



# Remedies

- Civil suits provide remedy for claiming compensation for loss of profits,damages
- Criminal remedies:***Copyright Act 1957, s.64*** empowers the Police (any officer not below the rank of sub-inspector) to seize infringing copies without warrant  
Police Raids (Power of ***search, seizure & arrest*** without a warrant)  
Fines (**min. 50,000-200,000 INR**)  
Imprisonment (**6 months to 3 years**)

## EXCEPTIONS TO COPYRIGHT INFRINGEMENT: Fair Use

- Doctrine of fair use have been invoked by legislators and judges to provide exceptions to copyright infringement.
- It can be used without consent of copyright holder to facilitate education, research and the dissemination of knowledge and for information purpose.
- Fair use doctrine is valid when transfer of use to the defendant will benefit society.

# Fair Use

- Act was done for parliamentary/ judicial proceedings
- Publication of short passages for educational purposes.
- Playing of records or performance by a club or society for the benefit of the members of religious institutions.
- Making of a drawing, engraving or photograph of an architectural work of art, or a sculpture kept in a public place.
- Public Reading or recitation of a literary work.



# Copyright act ,1957(Amendment 1999)



# ***INDUSTRIAL DESIGN***

# Industrial Design and Business Strategy

## **What is an Industrial Design?**

- The ornamental or aesthetic features of a product. In other words, it refers only to the appearance of a product and NOT the technical or functional aspects.
- Any composition of lines or colour or any three dimensional form whether or not associated with lines or colours; provided that such forms or composition gives a special appearance to a product of industry or handicraft and can serve as a pattern for a product of industry or handicraft

# Industrial designs

- Industrial designs is relevant to a wide variety of products of industry, fashion and handcrafts from technical and medical instruments to watches, jewelry, from household products, furniture and electrical appliances to cars and architectural structures, textile.
- Industrial design is also important in relation to packaging containers and get up of products.

# Industrial designs

- For businesses, designing a product generally implies developing the product's functional and aesthetic features taking into consideration issues of manufacturing or the ease of transport, storage repair and disposal

# Registration of an Industrial Design

- Essentials of a Design

It should be:

1. New or Original
2. Relate to features of shape, patterns, configuration or ornamentation
3. Applied to articles by any industrial process
4. Appeal to and solely judged by the eye
5. Should not include any trademark or property mark
6. It should not include any artistic work as defined under copyright act 1957
7. Should not be mere mechanical device.

The following designs will not qualify under the design act:

8. Has not been disclosed to public anywhere in tangible form or by use or in any other way prior to date of filing.
9. Is significantly distinguishable from known designs or combinations thereof.
10. Does not comprise or contain scandalous or obscene matter.

# Registration process

- Procedure for registration of design consists of the following steps:-
  - 1)Submission of application
  - 2)Acceptance/Objections/Refusal
  - 3)Removal of objections
  - 4)Decision of government
  - 5)Registration of the design



# Registration process

- SUBMISSION OF APPLICATION

The proprietor of the design has to file an application for registration. It should contain:

Four copies of representation of design

State the class in which the design is to be registered

Brief statement of novelty

# Registration process

- Acceptance/Objection

If controller finds that applicant meets all prescribed requirements then he will register the design or else any objections appear to the controller while examining ,then statement of these objections is given to applicant.

# Registration process

- Removal of objections

The applicant has to meet all objections within a period of 1 month failing which application will be nullified.

When controller refuses the application, applicant can directly appeal to Central Government .

# Registration process

- Decision

Decision of central Government will be final

- Registration

Once application is accepted, the controller shall direct the registration and publication of the particulars of the application and the representation of design to official gazette.

Once a design is registered it is entered into the **design register and published.**

# duration of the registration of a design? Can it be extended?

- Industrial designs protection generally lasts for a period of 10 yrs
- Initially the right is granted for a period of 10 years, which can be extended, by another 5 years by making an application and paying a fee of Rs. 2000/- to the Controller before the expiry of initial 10 years period. The proprietor of design may make application for such extension even as soon as the design is registered.

# Hague Agreement

- The Hague Agreement is an international registration system which offers the possibility of obtaining protection for industrial designs in a number of States and/or intergovernmental organizations by means of a single international application filed with the International Bureau of the World Intellectual Property Organization (WIPO).

# Hague Agreement contd....

- The Hague system cannot be used to protect an industrial design in a country which is not party to the Hague Agreement, or which is not a member State of an intergovernmental organization party to the Hague Agreement. In order to protect a design in such a country, the applicant has no choice but to file a national (or regional) application.

# Enforcement

- Infringement action for unauthorised use of registered 'Design' can be filed in the district court or High court.
- Reliefs Available are:
  - Injunction order
  - Damages
  - Accounts of profits
  - Delivery up cost



# SICLD ACT 2000

# WHAT IS SEMICONDUCTOR INTEGRATED CIRCUIT?

- A product having transistors
- Circuitry elements inseparably formed on a semiconductor material
- Insulating material inside the semiconductor material
- Designed to perform an electronic circuitry function.

# INVENTIVE STEPS

- Should be original
- Creator's own intellectual efforts
- combination of elements and interconnections provided such combination taken as a whole is the result of its creator's own intellectual efforts

# INFRINGEMENT OF LAYOUT- DESIGN

Any act of

- Reproducing
- Importing
- Selling
- Or distributing for commercial purposes amounts to Infringement

# PENALTY FOR INFRINGEMENT OF LAYOUT-DESIGN

- Imprisonment for a term which may extend to 3 years
- Fine not less than fifty-thousand and may extend to ten lakh rupees
- Or with both
- The court may also direct the forfeiture of all goods and things by means of, or in relation to, which the infringement has been committed

# WHO MAY APPLY?

- Any person claiming to be the creator of a layout-design
- who is desirous of registering it
- shall apply in writing to the Registrar
- In the prescribed manner for the registration of the layout-design

# REGISTRATION

- ▶ Application to be filed
- ▶ If Not opposed
- ▶ And time for notice of opposition expired
- ▶ Decision is taken in favour of the applicant
- ▶ The Registrar shall register the said layout-design

# REGISTRATION

- ▶ On the registration of a layout-design, Certificate is issued by the registrar.
- ▶ If registration of a layout-design is not completed within twelve months, application considered as abandoned .
- ▶ Duration of protection is 10 years .



# Thank You

