

IPTimes.LawTM

IPR HANDBOOK



SINGHANIA & PARTNERS LLP
SOLICITORS AND ADVOCATES

Across the years, while advising and assisting the domestic and international clients, in protecting Intellectual Property Rights, we have experienced the need and demand of creating IP awareness among various clusters of the society, mainly small scale enterprises, start-ups, individual applicants, educational institutes and other such similar clusters.

This year, to celebrate the World IP Day, the theme of which is focused on IP Protection by Small Scale Businesses, we are releasing a handbook, which may answer any queries, related to the IP Protection in India, of such specific clusters or groups.

Should you have any further queries, please write to us at ipp@singhania.in or iptm@singhania.in or connect with our team:



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INTELLECTUAL PROPERTY RIGHTS

Type of IP	Protection	Requirements	Duration
Patents	A product and / or a process.	Novelty Inventive step Industrial applicability	20 years protection on payment of the renewal fee with respect to each year.
Trademark	Any name, symbol, phrase, mark, words, etc. which describe any goods or services.	Distinctiveness	10 years protection, which can be renewed for further periods of 10 years on the payment of the renewal fee.
Design	Appearance of any article, not involving functional aspects.	New Original	Initial protection for 10 years which can be extended to next 5 years on payment of the renewal fee.
Copyright	Any literary work namely artwork, poetry, films, books, music, photography, and derivative work.	Work expressed in material form	Protection for the lifetime of the creator plus 60 years.
Geographical Indications	A product originating from a specific geographical location.	Product should have the specific quality, reputation and/or characteristics due to its place of origin	Valid for 10 years and can be renewed on payment of the renewal fee.
Plant Varieties	Protection of Plant Varieties, the rights of Farmers and Breeders and to encourage the development of new varieties of plants.	Novelty Distinctiveness Uniformity Stability	Valid for 18 years for trees and vines and 15 years for extant varieties.

A. PATENTS

1. What is the meaning of Patent?

Patent is an intellectual property right, to make, use or sell an invention for a limited period of 20 years. A Patent is granted to an entity on disclosing a technical invention, which may be a product (system/apparatus/device) or process (method/manufacturing) or both, which is novel or new and demonstrate inventive step or technological advancement over the existing technologies.

2. What legal rights does a Patentee have upon grant of a Patent in India?

It is a statutory right of the Patentee for his new invention which can be categorized as a new process or product. A Patentee has the following exclusive legal rights, on the technology for which a patent is granted:

- **Product Patents:** Right to prevent third parties, from making, using, offering for sale or selling patented products in India. Also, the Patentee can thwart the third parties from importing the patented product without permission in India;
- **Process Patents:** Right to prevent third parties, from using the patented process, offering for sale or selling the product obtained by the patented process in India. Also, rights can be enforced against third parties involved in importing the product in India obtained from the patented process, for using, offering for sale or selling.

3. What are the other commercial benefits a Patent Holder can have?

The registration of a patent, grants protection to inventions and other benefits thereto, few of which are summarized below:

- **Increasing monetization opportunities:** Acts like negotiations, licensing, selling, technology transfer, licensing, and commercialization, which provide monetization opportunities in the market to the Patent Holder.
- **Marketing Strategy:** Companies can display their technologies as unique and different from existing technologies and indulge in a separate business line.
- **Reducing competition and raising company value:** Creation of a niche market for the patented products, where the consumers are solely in position to purchase the product of the Patent Holder.

4. What are the benefits to small entities or start-ups for filing the Patent applications in India?

The Indian patent system has provisions of differential official fee for Applicants belonging to different categories. The applicable official fee for the small entities and start-ups is akin to Natural Persons, after the recent Patents (2nd Amendment) Rules, 2020. The Applicant is required to provide necessary documents for claiming the official fee benefit.

5. Are the patent rights enforceable in every country?

The patent rights are territorial in nature, i.e. a patent and its related rights are valid and enforceable only in those jurisdictions where it has been registered/granted in accordance with the respective national laws. Therefore, it is always advisable that the Applicants should identify the markets and jurisdictions which are commercially significant for the technology and accordingly decide and determine the strategy for Patent Protection.

6. What is the qualifying criteria for grant of a Patent?

The invention for grant of a patent should meet the following conditions:

- **Novelty (New/Novel):** The subject matter of the invention should be novel, which means it should not be available in the public domain through prior publication in any document or claimed in an already filed complete specification or disclosed orally or known to local or indigenous community as traditional knowledge;
- **Inventive Step (Non-Obviousness):** An inventive step means a feature of an invention that involves technical advancement and/or economic significance and that makes the invention not obvious to a person skilled in the art. Inventive step is considered lacking, when an invention lies merely in verifying previous predictions, without substantially adding anything for technical advancement and/or economic significance in the art;
- **Industrial Applicability:** An invention should be capable of being made and used in the industry.

7. Which inventions are not considered patentable in India?

The subject matter of the following inventions is not patentable:

- any invention which is frivolous or contrary to natural laws;
- the use or exploitation of an invention contrary to a public order or cause injury to public, animal or plant life or health or environment;
- discovery of a scientific principal and living or non-living things occurring in nature or formulation of an abstract theory;
- discovery of a new form of known substance which does not show enhanced efficacy or new property or new use;

- admixture resulting in the aggregation of properties of its components or a process for producing such substance;
- arrangement or rearrangement or duplication of known devices each functioning independently and in a known way;
- method of agriculture or horticulture;
- any process for the medicinal, surgical, curative, prophylactic, diagnostic, therapeutic or other treatment;
- plants and animals in whole or any part thereof;
- mathematical or business method or a computer program per se or algorithms;
- anything which is included in the Copyright Act, 1957 such as literary, dramatic, musical or artistic work or any aesthetic creation;
- scheme or rule or method of performing mental act or method of playing game;
- presentation of information;
- topography of integrated circuits;
- traditional knowledge; and
- inventions relating to atomic energy.

8. How to ascertain patentability of an invention?

It is advisable to ascertain if the subject matter of an invention is patentable, before strategizing patent protection. In other words, through conducting search, the inventors can ensure that the technology invented by them has already been disclosed or not or has been made available to public or not. The prior art search can be performed using paid or unpaid databases.

The unpaid database which can be accessed freely are:

- Google Patents;

- Indian Patent Office: inPASS;
- World Intellectual Property Organization: PatentScope;
- United States Patent and Trademark Office: PatFT;
- European Patent Office: espacenet.

9. Who can apply for a Patent?

The application for patent can be filed by any of the following persons, either alone or jointly with any other person:

- True and first inventor;
- True and first inventor's assignee; or
- Legal representative of deceased true and first inventor or his/her assignee.

10. Which offices or authority accepts application for Patents in India?

The Applicant can file a request for grant of a patent along with the requisite documents at the appropriate Indian Patent Office (IPO). The IPOs are located at New Delhi, Mumbai, Chennai and Kolkata. The Applicant can determine appropriate territorial jurisdiction on the following basis:

- **Indian Applicants:** Place of residence, domicile or business of the Applicant in India;
- **Foreign Applicants:** Depends on the Indian address which is provided in the Indian patent application by the Applicant for service.

11. Are the inventions related to biological material patentable in India?

Yes, the inventions disclosing the use of biological material can be patented in India.

The complete specification should sufficiently disclose source and geographical origin of the biological material. Further, when the biological material is obtained

from India, the Applicant is required to submit a permission provided by the National Biodiversity Authority (NBA) before the grant of a patent.

In case, the disclosed biological material is not available to public, such biological material is required to be submitted with the International Depository Authority (IDA), on or before the date of filing of the application. Microbial Culture Collection (MCC), Microbial Type Culture Collection and Gene Bank (MTCC), and National Agriculturally Important Microbial Culture Collection (NAIMCC) are recognized the IDAs in India.

12. When is an application of Patent published by the Indian Patent Office?

In the official journal of the Patent Office, applications are published after the expiry of 18 months from the application filing date or the earliest priority application date, whichever is earlier.

However, the following applications are not published:

- applications imposed with secrecy directions;
- application abandoned due to non-filing of the complete specification within 12 months from the date of filing of the provisional application; or
- if a request to withdraw the patent application has been filed 3 months prior to 18 months publication period.

The official publication of the invention is significant for the Applicant, as from the publication date the Applicant shall have similar privileges as if the patent is granted. However, the Applicant cannot institute any proceedings for infringement until patent is fully granted.

13. How can the process of the official publication of the Patent application be expedited?

The Applicant can file a request for early publication along with the prescribed official fee in order to expedite the process of official publication of the patent application. In such a case, the application may be published within 1 month from the date of such request.

14. What is 'request for examination'?

It is mandatory for the Applicant to file a request for examination of the application within 48 months from the earliest priority application date or application filing date, whichever is earlier. Since, the applications are examined based on the date of filing of the request, it is advisable to file the said request as early as possible.

If the necessary request is not filed within the prescribed period, the application is treated as withdrawn by the Applicant and cannot be restored or reinstated under any provisions of the Patents Act 1970.

15. Besides the Applicant, who can file a request for examination with the Indian Patent Office?

Apart from the Applicant, any "person interested" can file a request for examination. An evidence of interest in the application is required to be provided by the "person interested" along with the request. Such person is intimated about issuance of the examination report.

A "person interested" means a person engaged in or involved in promoting research in the same field to which the invention relates.

16. Can process of examination of the patent application be expedited?

In the following categories a request to expedite the examination of the patent application can be filed or normal request can be converted into an expedited request:

- When the Applicant filing a PCT application has chosen India as the competent International Searching Authority (ISA) or elected as an International Preliminary Examining Authority (IPEA);
- Start-Up;
- Small Entity;
- at least one of the Applicants is a female, if the application is filed by joint Applicants (natural persons);
- department of the Government;
- Applicant is an institution established by a Central, Provincial or State Act, which is owned or controlled by the Government;
- Applicant is a Government company as defined under clause (45) of section 2 of the Companies Act, 2013 (18 of 2013);
- Applicant is an institution wholly or substantially financed by the Government; or
- application pertains to a sector which is notified by the Central Government on the basis of a request from the head of a department of the Central Government;
- Applicant is eligible under an arrangement for processing a patent application pursuant to an agreement between Indian Patent Office and a foreign Patent Office.

17. Is India part of the Patent Prosecution Highway or PPH?

Recently, the Patent Prosecuting Highway Pilot Program commenced between the Indian Patent Office and Japan Patent Office.

Patent Prosecution Highway is a bilateral initiative between the National Patent Offices, for providing accelerated/fast tracked patent prosecution, through use of work products, such as examination reports, written opinions, etc. of one office by the other patent office for fast grants. Notably, the number of requests is limited to 100 cases per year.

18. What is the statutory deadline for submitting response to the first examination report/ office action? Can the said deadline be extended?

The deadline for filing response to the examination report is 6 months from the date of issuance of the examination report.

However, the said deadline can be extended for maximum 3 months by filing the appropriate request, before the expiry of the actual official deadline.

19. Can a Patent application be withdrawn by the Applicant?

The Applicant can file a request to withdraw a patent application any time before the grant of a patent.

When the request to withdraw the application is filed within 15 months from the earliest priority application date, the application will not be published in the official journal of the Indian Patent Office.

Further, the Applicant may seek 90% of refunds of the official fee paid for request for examination, if the application is withdrawn by the Applicant before the issuance of the first examination report/ office action.

20. Can an Applicant for Patent file a request for adjournment of the hearing?

An Applicant for a patent can file a request for adjournment of hearing with reasonable cause. Such request shall be filed at least 3 days prior to the date of hearing. In total, the Applicant can file up to 2 requests for adjournments with applicable official fee. However, it is the discretionary power of the Controller to accept such requests.

21. What is the term of a Patent?

The term of a patent is 20 years from the application filing date or date of entering the PCT International Phase, provided that the renewal/annuity fee is paid every year before the expiry of the due date or within the extended period (maximum 6 months).

22. Does a Patent remain in force if renewal/annuity is not paid within the prescribed time limit?

The patent will lapse or cease to exist in case patent renewal/annuity is not paid within the prescribed time limit or extended period.

23. Can a patent be restored if it is ceased or lapsed due to non-payment of renewal/annuity fee?

A patent lapsed or ceased to have effect due to non-payment of renewal/annuity can be restored or reinstated by filing a request for restoration of patent within 18 months from the date on which patent is lapsed. The request for restoration is published in the official journal of the Patent Office, when the Controller is satisfied that failure to pay the renewal/annuity fee was unintentional. Any person interested,

may file a notice of opposition to restoration of patent within 2 months from the date of such publication.

24. Is it possible for the Applicant or Patentee to assign the rights or interest in the Patent application or granted Patent?

Yes, the Applicant or Patentee can assign rights or interests in the application or patent by way of executing an assignment deed or an agreement between the Assignor (Applicant or Patentee) and Assignee.

In order to enforce such agreements or assignments, it is necessary for the Assignee to file a request for change in the proprietorship of the patent application or the patented invention along with necessary documents in the prescribed manner along with the official fee.

25. When is the Patentee required to submit the working statement of the patented invention?

On the grant of a patent, it is mandatory for the Patentee to furnish information related to working of the patented invention on commercial scale in India.

The recent Patents (Amendment) Rules, 2020 resulted in the revision of the Form 27 for furnishing such statement of working. The details of the related patents can be incorporated in a single form and is required to be filed by September of every financial year.

26. What are the penalties imposed on non-submission of information related to working of the patented invention of commercial scale in India?

If the Patentee or licensee refuses or fails to provide information of working of the patented invention on commercial scale in India, he may be liable to punishment with fine which may extend up to INR 1 million.

Additionally, if the Patentee provides false information in this regard, he shall be punishable with imprisonment which may extend to 6 months, or with fine, or both.

27. What are the grounds for filing the pre-grant opposition in India?

Any person can file representation by way of Pre-Grant Opposition against the grant of a patent, after publication of the patent application in the official journal by the Indian Patent Office. The permissible grounds of opposition are as follows:

- wrongfully obtained;
- prior publication / prior claim;
- prior claim in India;
- prior public knowledge or public use in India;
- obviousness and lack of inventive step;
- not an invention or the invention not patentable;
- insufficient description of the invention;
- failure to disclose information or furnishing false information relating to foreign filings;
- convention application not filed within the prescribed time of 12 months;
- incorrect mention of source/geographical origin of biological material;
- invention anticipated with regard to traditional knowledge of any community.

28. What are the grounds for filing the post-grant opposition in India?

The Post-Grant Opposition can be filed by any “person interested”, within 1 year from the date of publication of grant of a patent. The permissible grounds of opposition are as follows:

- wrongfully obtained;
- prior publication / prior claim;
- prior claim in India;
- prior public knowledge or public use in India;
- obviousness and lack of inventive step;
- not an invention or the invention not patentable;
- insufficient description of the invention;
- failure to disclose information or furnishing false information relating to foreign filing;
- convention application not filed within the prescribed time of 12 months;
- incorrect mention of source/geographical origin of biological material;
- invention anticipated with regard to traditional knowledge of any community.

29. What is Foreign Filing License (FFL)?

Foreign Filing License is a permission, under which the Applicant or inventor has to seek permission, for filing of application outside India, from the Indian Patent Office under the following circumstances:

- When the Applicant is residing in India during the development of an invention and wishes to file the patent application for the same invention first outside India; or

- When the Applicant wishes to file a patent application for an invention outside India, before the expiry of 6 months from the date of filing of the patent application for the same invention in India.

In case the Applicant fails to comply with the aforementioned mandates, he shall be punishable with imprisonment for a term which may extend to 2 years, or with fine, or with both.

30. What is a compulsory license?

Any person interested can file a request for compulsory license after expiry of 3 years from the date of grant of Patent in India. The grounds for compulsory license are as follows:

- Reasonable requirements of public not met with respect to the invention;
- Invention not available to the public at reasonably affordable price;
- Invention not worked in the territory of India.

B. TRADEMARKS

1. What is a Trademark?

Trademark is any mark which is distinctive i.e. capable of distinguishing goods and services of one undertaking from that of other undertaking, and are capable of being represented graphically.

Trademark denotes the characterization of a product or its representation, which has to be unique, where it would appeal to the general public's perception and senses in a significant manner. Generally a brand or a logo fall under the ambit of Trademarks.

2. What can be categorized as a Trademark?

Any distinctive Word, Letter, Numeral, Slogan, Picture, Shape, Colour, Logotype, Label, Name, Signature, Shape of Goods, Packaging, Combination of Colours, which is capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others, can be registered as a Trademark. A Trademark can be any distinctive feature of a brand which helps the common public to identify the same brand.

3. Can sound or smell be registered as a Trademark in India?

Yes, sound or smell can be registered as a Trademark provided that they can be represented graphically and are distinctive in nature.

4. How is a Trademark different from Tradename?

A Tradename is the legal identity or the official name of the brand/company under which the brand/company is "doing business" whereas a Trademark identifies the

products or services provided by the brand/company and it acts as an indicator of origin. A Tradename and a Trademark may be the same for a business or different as the case may be. A company can sell all its products under its name or have separate Trademarks for different products/goods manufactured/distributed by the company.

5. What are the essential features of good Trademark?

- **Distinctive and not Descriptive:** A Trademark should not describe the goods or services that are proposed to be used or used in connection with the mark;
- **Fanciful:** Fanciful Trademarks are considered to be the one strongest type of mark which have been invented, designed or created for the sole purpose of functioning as a Trademark and have no other meaning than acting as a mark;
- **Suggestive:** Suggestive Trademarks suggest a quality or characteristic of the goods and services of a brand;
- **Unique:** The word or combination of words making a Trademark should not be generic words, but specific or unique coined words which can be described as those words which are not used in general sense in common language, like common adjectives or nouns.

6. What are the benefits of Trademark registration?



The registration of Trademark has the following benefits:

- **Exclusivity:** Exclusive rights to the brand/company by enjoying sole ownership of the Trademark throughout all the jurisdictions where the Trademark is registered, thereby stopping others from unauthorised use of that Trademark for registered products or services. The brand/company has legal rights to file an

infringement suit against third party infringers against unauthorised use of the Trademark;

- **Brand Image:** It helps to build brand/company's goodwill and reputation by establishing trust among the customers in the market;
- **Distinctiveness:** It helps to distinguish the brand/company's products or services from that of others and helps the general public or the consumers to identify the brand/company by its Trademark. A Trademark designates the characteristic of the brand/company;
- **Identity:** It helps consumers or the general public to associate quality of the products with the brand/company's name thereby helping in gaining customer base;
- **Creates IP Rights:** Registration of Trademark forms an intangible asset which is the intellectual property of the brand/company, which can be further licensed, assigned or franchised to third parties in exchange of royalties;
- **Protection from infringement:** Third party infringers can be restricted to the registered Trademark and the brand owner can get the legal protection under the Trade Marks Act, 1999.

7. What is the significance of the symbol and when used along with the Trademark?

The  symbol is used to denote that the application for registration of Trademark has been filed, however it is pending for registration. The  symbol can also be used for all Trademarks even if the application for registration has not been filed for, to claim use over the mark.

The ® symbol is used to denote that the Trademark has been registered and the brand owner has exclusive rights over the same. This symbol can be used only after the Trademark is registered.

8. Who can file a Trademark application?

Any person who claims to be a proprietor or owner of Trademark can file an application for registration of a Trademark on proposed to be used (intent to use) basis or on prior use basis.

9. How to determine the class of goods or services before filing the Trademark application?

The goods and services have been specified in accordance with the International Classification (NICE) of goods and services. The NICE Classification can be accessed [here](#).

The proprietor or owner of Trademark can search for the class of Trademark by putting in key words related to the goods or services provided under the Trademark for which the application has been filed.

10. Is registration of a Trademark mandatory in India?

No, it is not mandatory to register a Trademark. However, registration is prima facie evidence of ownership of a Trademark from the date of Trademark application and it allows the Trademark owner to institute infringement proceedings against the infringer. A Trademark owner cannot institute a suit for infringement of unregistered

Trademark but an action of passing off of goods or services can be taken against the third party indulged in unauthorised use of the said unregistered Trademarks.

11. Can a registered user restrain third party from using an identical or similar mark, when the third party is a continuous and prior user of the Trademark?

In India prior use of a Trademark is favoured over prior registration of a Trademark as the Trademark law recognises first to use and not first to file. Hence, a registered owner cannot restrain a third party from using a Trademark identical/similar to the registered Trademark, if the third party has been continuously using the mark in relation to the same goods or services for which the Trademark is registered, provided the third party is a prior user of the said Trademark when compared on the basis of the date of use or the date of application of the registered mark, whichever is earlier.

12. Can the details of the Trademark application be amended post filing of the same or post registration of the Trademark?

Yes, the details of a Trademark application can be amended post filing of the same or post registration of the Trademark. The Applicant is required to file the requisite form along with prescribed fee for recordal of amendment. Any amendment is allowed by the Trademarks Registry provided it does not amount to any substantial change in the Trademark application or the Trademark itself.

13. What is a Trademark Opposition and who can file it?

A 'Trademark Opposition' means an objection filed by third parties, against the registration of a Trademark within 4 months of the advertisement of the trademark to be opposed.

Any person, natural or legal, may file an opposition with the Registry. This includes any individual person(s), companies, partnership firm(s) and trust(s).

14. What are the grounds under which an Opposition may be filed?

Following are the grounds under which an Opposition may be filed:

- The mark which is devoid of any distinctive characteristic or includes indications which may serve in trade to designate quality, quantity, intended purpose, values, geographical origin or the time of production;
- The mark is likely to deceive the public or cause confusion. This includes any mark which may be identified with an already registered Trademark or that have become customary in the practice of trade;
- The mark contain matters which are likely to hurt the religious sentiments of any class or section of people;
- The mark is prohibited under the Emblem and Names Act, 1950.

15. What is Rectification of Trademark and who may file for it?

Any 'person aggrieved' by the registration of a Trademark, may file for removal, cancellation or rectification of the register of Trademarks. Rectification is used to remove a registered Trademark from the register which is not used within 5 years from the date of its registration. However, unlike in the Opposition proceedings, only a person who has a 'substantial interest' or a person who would be 'substantially damaged' if the mark remained on the register, can file for rectification.

Moreover, a collective mark may also be removed from the register if the manner in which the mark is used has misled the public.

16. What are the grounds under which an application for Rectification may be filed?

Following are the grounds under which an application for Rectification can be filed:

- The Trademark was registered without any *bona fide* intention that it should be used in relation to the goods and services for which it was originally registered and there has been no use of the Trademark for 3 months before the date of the application;
- The entry made in the register was made without sufficient cause or was obtained by fraud or misrepresentation of facts, or if the mark is deceptively similar to an earlier registered Trademark;
- The registered Trademark has not been used for a continuous period of 5 years from the date of registration of Trademark;
- The proprietor is no longer competent relation to the goods and services for which the mark is registered or there is no longer any public advantage for the mark to remain registered.

17. Are there any variations in the official fee depending upon the nature of the Applicant?

Yes, the reduced official fee applicable if the Applicant is:

- an Individual;
- a Start-Up;
- a Small Enterprise.

In order to claim the said reduction the Trademark application is to be accompanied with the required evidence substantiating the nature of the Applicant.

18. What is the validity of a registered Trademark? Can a Trademark registration be renewed?

The registration of a Trademark is valid for a period of 10 years and further can be renewed every 10 years. In case the registrant does not renew the Trademark, the Trademark protection is no longer valid. An application for renewal can be filed on or before 6 months, before expiry of registration, or within 6 months after expiry of registration by paying late fees along with renewal fee.

19. In case the Trademark registration expires, can it be restored?

If more than 6 months have lapsed from the renewal date, then an application for restoration can be filed within 1 year from the date of expiration of the renewal date along with an undertaking explaining the reasons for the filing of the restoration request. If the registrar is satisfied, the Trademark is restored.

20. Is the Trademark liable to be removed from the register of Trademarks on the grounds of non-use?

Any registered Trademark can be removed on the grounds of non-use if it was registered without any *bona fide* intention of use by the owner and that the same was not used till 3 months before the date of the application for removal or the same was not used for a continuous period of 5 years from the date of the Trademark application and the application was made after 3 months from the expiry of the said 5 years.

21. What are the remedies available to an owner of a Trademark when their Trademark is copied /infringed?

An infringement action occurs on the invasion of a statutory right of the registered Trademark holder. Such action may be instituted when a person uses a mark which is identical or deceptively similar to that of the registered proprietor. There are broadly two types of remedies a person has in such situations:

- **Infringement Suit:** The registered owner of the mark has the exclusive right to institute a suit before a court having civil jurisdiction;
- **Passing off:** An action for passing off is a common law remedy which allows an unregistered owner of a mark to seek civil action against misrepresentation, whether intentional or unintentional, on part of the infringer. The basis of a passing off action is that the plaintiff is likely to or has already suffered damages/ economic loss due to such misrepresentation;
- **Criminal Action:** The Trade Marks Act, 1999 provides for imprisonment for a term not less than 6 months which may extend up to 3 years and/or a fine not less than fifty thousand rupees (INR 0.05 million) which may extend up to two lakh rupees (INR 0.2 million).

22. What are the Reliefs which a court may grant against any unauthorized use of a Trademark?

The court may grant the following reliefs in a suit for infringement or passing off:

- Damages (nominal or compensatory) on accounts of profits obtained as a result of the unauthorized use;
- Permanent or temporary injunction against any further unauthorized use of such mark by the defendant.

An order for delivery up of the goods bearing infringing labels and marks for the purpose of destruction or reassurance.

C. DESIGNS

1. What does Design mean?

As per the provisions of the Designs Act, 2000, a Design means:

- feature of shape, configuration and pattern, ornamentation or composition of lines or colours applied to an article by industrial process, which in the finished form appeals to and is judged solely by the eye;
- two or three dimensional or in both forms;
- capable of being produced by industrial process.

However, a Design does not include:

- mode or principle of construction of the article on which Design is applied;
 - Trademark or property mark;
 - artistic works.

2. Which Designs are prohibited from registration?

The following Designs are not registrable in India:

- not new or original;
- not significantly distinguishable from known Designs or combination of known Designs;
- contains scandalous or obscene matter.

3. What is a new or novel Design?

A Design is considered to be new:

- when it has not been disclosed to the public anywhere in India or in any other country by publication or by use or in any other way, prior to the date of earliest priority or date of filing;
- when it is significantly distinguishable from known Designs or combination of known Designs.

4. When is a Design considered original?

An original Design means:

- originating from the author of Design;
- Designs which are old in time but are new in their application. For example, a car is for driving and commuting. A bag created in a Design of a car, which is used for carrying stuff, can be considered as original.

5. Who can apply for a Design application in India?

An application for registration of a Design can be filed by any person claiming to be a proprietor of a new or original Design applied on an article. The proprietor could be:

- an author of the Design;
- an exclusive assignee of the Design;
- original proprietor of the Design jointly with another person to whom rights have been transferred.

6. What kind of representations of Design applied on the article can be submitted for registration?

The representations of the article should be in one format which can be drawings, photographs or computer graphics. It is advisable to include a perspective view, front

view, back view, right side view, left side view, top view and bottom view of the article on which the Design is applied along with the application for Design registration.

7. Where can an application for Design be filed in India?

An application for registration of Design can be filed at any branch of the Indian Patent Office.

However, further processing and prosecution of the Design Application takes place at Kolkata Branch of the Indian Patent Office.

8. What are various types of Design applications?

There are two types of Design applications:

- **Ordinary Application:** When an application for registration of a Design is filed with the Indian Patent Office, without claiming any priority, such applications are called as Ordinary Applications;
- **Reciprocity Application:** When an application for Design registration is filed with the Indian Patent Office, claiming priority from already filed Design application(s) filed in a convention country or group of countries or inter-governmental organizations is called Reciprocity Application. The Reciprocity Application is required to be filed within 6 months from the date of earliest priority application. The said time limit is not extendable.

9. Is it mandatory to submit original certified copy of the priority application?

In case of priority applications, it is mandatory for the Applicant to furnish the original certified copy of the priority document along with the application within

extended time limit of 3 months from the date of filing of the application. A separate request is required to be filed for seeking extension of time limit.

Further, verified English translation of the priority document is required to be furnished if it is in language other than English.

10. Is it necessary to file request for examination of Design application?

The Design applications are directly taken for examination by the Patent Office. Therefore, any separate request for examination is not required to be filed.

11. Is Copyright in Design enforceable in countries outside India?

Like other IP Rights, Copyright in Design is territorial in nature i.e. enforceable in countries where Design is registered.

12. What is the term of Copyright in Design registration?

Copyright in Design subsists for 10 years from the date of registration. This period can be extended for another 5 years upon a request for extension of Copyright filed by the registered proprietor before the expiry of the original period of 10 years.

13. How long does it take to get a Design registered?

The process of Design registration normally takes around 6 to 9 months. However, it may get extended under certain circumstances. It is pertinent to note that Design registration is considered to be the quickest IP right a proprietor gets, among all other such rights.

14. Can a ceased/lapsed Design be restored?

An application for restoration of Design can be filed within 12 months from the date on which a registered Design ceased to have effect due to non-payment of fees for extension of Copyright (or renewal fee) with the Indian Patent Office.

15. Who can file request or petition for cancellation of a registered Design and on what grounds can such cancellation be filed?

Any person interested may file a petition for cancellation of a registered Design on the prescribed Form. The petition for cancellation of registered Design can be filed on the following grounds:

- Design has been previously registered in India;
- it has been published in India or in any other country prior to the date of its registration;
- Design is not new or original;
- Design is not registrable under the Designs Act 2000;
- it is not a Design as defined under the Designs Act 2000.

16. What are the grounds of rectification of the register of Designs?

Any person aggrieved on the following grounds may file a request for rectification of register of Designs:

- non-insertion or omission of any entry;
- entry made without sufficient cause;
- entry wrongly remaining on the register;
- error or defect in any entry.

17. What are the requirements to be fulfilled before delivery of the article with a registered Design?

As per the requirements of the Indian Designs Act 2000, the proprietor has to mark REGISTRED, REGD., RD or Registration No. on the article for which Design is registered before delivery on sale.

18. What are benefits to small entities or start-ups for filing Design applications in India?

The Indian IP system has provisions of differential official fee for Applicants belonging to different categories. The applicable official fee for the small entities and start-ups is akin to Natural Persons. The Applicant has to provide necessary documents for claiming the official fee benefit.

D. COPYRIGHTS

1. What is Copyright?

Copyright is a right granted by the law to creators of literary, dramatic, musical and artistic works and the makers / producers of cinematograph films and sound recordings. It is also referred to as a bundle of rights including, inter alia, rights of reproduction, communication to the public, adaptation and translation of the work.

The protection provided by Copyright to the efforts of writers, artists, designers, dramatists, musicians, architects and producers of sound recordings, cinematograph films and computer software, promotes creativity and encourages individuals to create more.

2. What is the scope of protection in the Copyright Act, 1957?

The Copyright Act, 1957 protects original literary, dramatic, musical and artistic works and cinematograph films and sound recordings from unauthorized uses. Copyright only protects the expressions and not the ideas. There is no Copyright protection for ideas, procedures and methods of operation or mathematical concepts as such.

3. What can be protected under Copyright?

The protection and rights under the Copyright laws is granted to original work. However, there is no Copyright protection for titles or names, short word combinations, slogans, phrases, plots or factual information, methods of operation, procedures or mathematical concepts.

4. What rights does Copyright grant to the rights holder?

A Copyright grants protection to the creator and his or her representatives for the works and prevents such works from being copied or reproduced without their consent.

The creator of a work can prohibit or authorise anyone to:

- reproduce the work in any form, such as print, sound, video, etc.;
- use the work for a public performance, such as a play or a musical work;
- make copies/recordings of the work, such as via compact discs, cassettes, etc.;
- broadcast it in various forms;
- translate the same to other languages.

5. Is it mandatory to register a work to claim Copyright?

No, it is not mandatory / necessary to register a work as a Copyright. The acquisition of Copyright is automatic and it does not require any formality. Copyright comes into existence as soon as a work is created.

However, certificate of registration of Copyright serve as, prima facie, evidence in a court of law with reference to dispute relating to ownership of Copyright.

6. Where can the application for registration of Copyright for a work be filed?

The Application for Copyright Protection can be filed at the Copyright Office, which is located in New Delhi.

7. What is the duration of Copyright in protected works?

The duration of protection for Copyright works varies according to the type of work and the date of creation of the work. It is divided as follows:

- **Literary, dramatic, musical or artistic works:** The Copyright expires after 60 years from the end of the calendar year in which the author dies. Where a work has a joint author/co-author, it expires 60 years from the end of the calendar year in which the last known author dies. Where the author's identity is unknown, Copyright expires 60 years from the end of the calendar year in which the work was first published.
- **Cinematograph films:** The Copyright shall subsist until 60 years from the beginning of the calendar year following the year in which the film is published.
- **Sound recordings:** The Copyright shall subsist until 60 years from the beginning of the calendar year following the year in which the sound recording is published.

8. For how long do moral rights subsist in Copyright works?

An author's moral right, which is a right against distortion, is available even after the expiry of the term of Copyright.

9. Who is the "first owner" of a Copyright work?

The "first owner" may be determined as follows:

- Literary, dramatic or artistic work (which includes a photograph, painting or a portrait) created during the course of employment or under a contract of service or apprenticeship, for the purpose of publication in a newspaper, magazine or similar periodical, the author of such a publication shall, in the absence of a contract to the contrary, be the first owner of Copyright.

However, such ownership shall vest with the proprietor of the publication only for the limited purpose of publishing the work or a reproduction of the work in a publication and, for all other purposes, the Copyright shall vest with the author of the work.

- In a photograph, painting or portrait, which has not been made for the purposes of publication in a periodical but has been made for any other purpose, then in the absence of a contract to the contrary, the Copyright in such work shall vest with the person at whose instance the work was created.
- In the case of a cinematograph film, in the absence of a contract to the contrary, the Copyright in the cinematograph film shall vest with the producer of the film (i.e. the person at whose instance the film was made for a valuable consideration).
- In the case of a work made during the course of employment or under a contract of service or apprenticeship, the employer shall, in the absence of a contract to the contrary, be the first owner of Copyright. In the case of a government work, the Copyright in the work shall vest with the Government.

10. Whether unpublished works are registered?

Yes, both published and unpublished works can be registered.

11. Whether Computer Software or Programme can be registered?

Yes, computer Software or programme can be registered as a 'literary work'. As per Section 2 (o) of the Copyright Act, 1957 "literary work" includes computer programmes, tables and compilations, including computer databases. "Source Code"

and “Object Code” have also to be supplied along with the application for registration of Copyright for software products.

12. Can Copyright in a work be jointly owned? If so, what are the rights of a co-owner?

Yes, the Copyright Act, 1957 recognises joint authorship which means a work produced by the collaboration of two or more authors in which the contribution of one author is not distinct from the contribution of the other author or authors.

The joint authors fully enjoy all of the rights granted by the Copyright Act, 1957. The term of Copyright of a work of joint authorship is calculated with respect to the author that dies last.

13. What acts fall under “fair use” of any Copyrighted works without the express permission of the owner of Copyright (i.e. what exceptions apply)?

Under the Copyright Act, 1957, there are certain exceptions which constitute fair dealing/fair use, and are not considered an infringement. Section 52 of the Copyright Act, 1957 provides for certain exceptions to infringement of Copyright and the same is reproduced below in the table identifying the various clauses of fair dealing and fair use:

S. No.	Type of Works
A.	All works except Computer Programmes
	Fair dealing of any work for private or personal use, including research
	Fair dealing of any work for criticism or review
	Fair dealing of any work for reporting of current events and current affairs

B.	Computer Programmes
	Use of work for the purpose for which it is supplied or making copies
	To obtain information essential for operating inter-operability of an independently created work by a lawful possessor
	Observation, study or testing in order to determine the ideas and principles
	Making of copies or adaptation of the work from a personally legally obtained copy for non-commercial personal use
C.	All works
	Transient or incidental storage of a work or performance purely in the technical process of electronic transmission or communication to the public
	Transient or incidental storage of a work or performance for the purpose of providing electronic links, access or integration
	Reproduction of any work for the purpose of a judicial proceeding or for the purpose of a report of a judicial proceeding
	Reproduction by Legislature
	Reproduction for obtaining certified copy
	Reproduction by teacher or pupil
	Reproduction as part of questions to be answered in examination
	Reproduction as part of answers in an examination
	Performance in an education institution like school or college
	Reproduction in a newspaper, magazine or article
	Storing of a work in any medium by electronic means by a non-commercial public library
	The reproduction or publication of any matter published in Official Gazette except an Act of a Legislature

	A recording to be heard in an enclosed room for common use of residents in any residential premises
	Any Act of a Legislature when reproduced or published together with any commentary
	Report of any committee, commission, council, board appointed by Government
	Any judgement or order by court, tribunal or other judicial authority
	Any Act of a Legislature when reproduced or published together with any commentary
	Making of not more than three copies of a book (including a pamphlet, sheet of music, map, chart or plan) by or under the direction of the person in charge for the use of the library if such book is not available for sale in India;
	Report of any committee, commission, council, board appointed by Government
	Any judgement or order by court, tribunal or other judicial authority
	The production or publication of a translation in any Indian language of an Act of a Legislature if no translation of such Act or rules or orders in that language has been previously been produced or published by the Government
	The production or publication of a translation in any Indian language of an Act of a Legislature if the translation is not available for sale to the public
D.	Artistic work
	The making or publishing of a painting, drawing, engraving or photograph of a work
	The making or publishing of a painting, drawing, engraving or photograph of a sculpture if such work is permanently situated in a public place
	The inclusion in a cinematograph film of any work permanently situated in a public place

	The inclusion in a cinematograph film of any other work by way of background or incidental to the principal matters
	The use by the creator of work, where the creator of such work made by him for the purpose of the work
	Making three dimensional object from two dimensional work
E.	Architectural drawings
	Reconstruction
F.	Cinematographic films
	Exhibition
G.	Sound recordings and Cinematographic films
	Storage
H.	Literary, musical, dramatic works or sound recordings
	Performance in religious ceremony or ceremony held by Central Government, State Government or local authority or marriages
I.	Literary, dramatic or musical works
	Reproduction for purposes of research, private study or publication
	Performance by an amateur club and performance is given to a non-paying audience, or for the benefit of a religious institution
J.	Literary or artistic works
	Importation of promotional materials
	Reading or reciting extracts in public
	Publication in collection of non- Copyright matter, bona fide intended for instructional use

14. What acts constitute primary infringement of Copyright?

Primary infringement occurs where a person performs any of the following acts without the consent of the rights holder.

- copying;
- issuing copies of the work to the public;
- renting or lending the work to the public;
- performing, showing or playing a Copyright work in public;
- communicating the work to the public;
- making an adaptation of a Copyright work or doing any of the acts listed above in relation to an adaption.

15. What acts constitute secondary infringement of Copyright?

Secondary infringement occurs where a person, with knowledge or reasonable grounds for such knowledge, carries out any of the following actions in relation to infringing copies of the work:

- makes for sale or hire, or sells or lets for hire, or byway of trade displays or offers for sale or hire;
- distributes either for the purpose of trade or to such an extent as to affect prejudicially the owner of the Copyright;
- by way of trade exhibits in public;
- imports into India.

16. What remedies are available against a Copyright infringer?

The Copyright Act, 1957, provides the following remedies for Copyright infringement:

- Civil;

- Criminal;
- Administrative.

17. Are there any specific remedies for online Copyright infringement?

The courts can direct that infringing websites be blocked by internet service providers (ISPs) either as part of a John Doe order or a website-blocking order. The Copyright Act, 1957, says that any person who circumvents an effective technological measure applied for the purpose of protecting any of the rights conferred by the Copyright Act, 1957, with the intention of infringing such rights, shall be punishable.

18. Under what circumstances is Copyright infringement a criminal act and what sanctions may apply?

The Copyright Act, 1957, prescribes that the intentional infringement or abetment of an infringement of the Copyright in a work would be considered as criminal act. Criminal remedies for Copyright infringement include:

- punishment through imprisonment which may not be less than six months but which may extend to three years;
- fines which shall not be less than Rs.50,000 and which may extend to Rs.200,000;
- search and seizure of the infringing goods including plates, which are defined as including blocks, moulds, transfers, negatives, duplicating equipment or any other device used or intended to be used for printing or reproducing copies of the work;
- delivery up of infringing copies or plates to the owner of the Copyright.

E. GEOGRAPHICAL INDICATIONS

1. What is a Geographical Indication (GI)?

GI is an indication, originating from a definite geographical territory. It is used to identify agricultural, natural or manufactured goods produced, processed or prepared in that particular territory due to which the product has special quality, reputation and/or other characteristics.

2. Is registration of a GI compulsory and how does it help the Applicant?

Registration of a GI is not compulsory. Registration of a GI has the following benefits:

- **Legal protection:** This enables to IP holder to secure protection against infringement of the registered GI;
- **Exclusive rights:** Prevents unauthorised use of a registered GI by others and assures safety of individuality;
- **Demand:** Boosts exports of the registered GI products since they receive their individual identification on every legal platform and also invite media coverage;
- **Economic Growth:** Promotes economic prosperity of producers of goods produced in a geographical territory.

3. Who and how can a person apply for the registration of a GI?

Any association of persons, producers, organisation or authority established by or under the law can apply for registration of a GI, provided:

- Applicant must represent the interest of the producers;
- application should be in writing in the prescribed form;

- application should be addressed to the Registrar of Geographical Indications along with prescribed fee.

4. Which are the registered GIs in India?

The list of the registered GIs in India is published by the Geographical Indications Registry and can be accessed [here](#).

5. When is a GI not registrable?

A GI is not registrable in the following situations:

- use of which would be likely to deceive or cause confusion;
- use of which would be contrary to any law for the time being in force;
- comprises or contains scandalous or obscene matter;
- comprises or contains any matter likely to hurt the religious susceptibilities of any class or sections of the citizens of India;
- which would otherwise be disentitled to protection in court;
- which are determined to be generic names or indication of goods;
- which, although literally true as to the territory, region or locality in which the goods originate, but falsely represent to the persons that the goods originate in another territory, region or locality, as the case may be.

6. Who is a Registered Proprietor of a GI?

Any association of persons, producers, organisation or authority established by or under the law can be a registered proprietor; and their name should be entered in the Register of GI as registered proprietor for the GI.

7. Who can use the registered GI?

An Authorised User has the exclusive rights to the use of GI in relation to goods in respect of which it is registered.

8. Who is an Authorised User of a GI?

An authorised user of GI is a producer of goods in respect of a registered GI. An authorised user should apply in writing in the prescribed form along with prescribed fee.

9. Who is a Producer in relation to a GI?

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.

10. What is the term of a registered GI?

The registration of a GI is valid for a period of 10 years. The registered GI can be renewed for every 10 years on the payment of prescribed renewal fee.

11. What is the effect if a GI is not renewed?

If a registered GI is not renewed it is liable to be removed from the register.

12. When is a registered GI infringed?

A GI is infringed in the following situations:

- **Unauthorised use:** when an unauthorised party uses a GI indicating or suggesting origination of the same other than the true place of origin of such goods, in a manner which may mislead the public;
- **Passing off:** when the use of GI results in an unfair competition including passing off in respect of registered GI;
- **False representation:** when the use of another GI results in false representation to the public that the goods originate in a territory in respect of which a registered GI relates

13. Who can initiate an infringement action?

The Registered Proprietor or an Authorised User of a registered GI can initiate an infringement action.

14. What are the penalties for GI infringement?

The Geographical Indications of Goods (Registration and Protection) Act 1999, provides for a sentence of imprisonment for a term between 6 months to 3 years and a fine varying from Rupees Fifty Thousand (INR 0.05 million) to Rupees Two Lakhs (INR 0.2 million) in case of GI infringement.

15. Can a registered GI be assigned or licensed?

No, a GI is a public property belonging to the producers of the concerned goods. Therefore, it is not a subject matter of assignment, transmission, licensing, pledge, mortgage or such other agreement. However, when an Authorised User dies, his right devolves on his successor in title.

16. Can a registered GI or a registered Authorised User be removed from the register?

Yes, the Appellate Board or the Registrar of GI has the power to remove the GI or an Authorised User from the register. Further, on application by an aggrieved person action can be taken.

17. How is a GI 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 GI is an indication used to identify goods having special characteristics originating from a definite geographical territory.

F. PROTECTION OF PLANT VARIETIES AND FARMERS' RIGHTS

1. What is the governing legislation for protection of varieties of plant and rights of Farmers' in India?

India adopted the sui generis system by enactment of The Protection of Plant Varieties and Farmers' Rights (PPV&FR) Act, 2001, to provide an effective and efficient system for the protection of Plant Varieties, the rights of Farmers & Breeders and to encourage the development of new varieties of plants.

2. What are the main objectives of PPV&FR Act 2001?

The principal objectives of the PPV&FR Act, 2001 are follows:

- To establish an effective system for the protection of Plant Varieties, the rights of Farmers & Breeders and to encourage the development of new varieties of plants;
- To recognize and protect the rights of Farmers in respect of their contributions made at any time in conserving, improving and making available plant genetic resources for the development of new Plant Varieties;
- To accelerate agricultural development in the country and to protect Breeders' rights;
- To stimulate investment for research & development both in public and private sector for the development of new Plant Varieties;
- Facilitate the growth of seed industry in the country which will ensure the availability of high quality seeds and planting material to the Farmers;
- To recognize the contribution of both Breeders & Farmers in plant breeding activity;

- To implement TRIPs in a way that supports the specific socio-economic interests of all the stakeholders including private, public sectors and research institutions, as well as resource-constrained Farmers.

3. What are the Breeders' rights under the PPV&FR Act, 2001?

Breeders' have exclusive rights to produce, sell, market, distribute, import or export the protected variety. Breeder can appoint agent/licensee and may exercise for civil remedy in case of infringement of rights.

4. What are the Researchers' rights provided under the PPV&FR Act, 2001?

The following rights vests with Researchers' under the PPV&FR Act, 2001:

- Use of any variety registered under the PPV&FR Act 2001 for conducting experiment or research.
- Use of a variety as an initial source of variety for the purpose of creating another variety.

However, in case of repeated use of such variety, the authorization of the registered Breeder is required.

5. What are the Farmers' rights provided under the PPV&FR Act 2001?

The following rights vest with Framers' under the PPV&FR Act 2001:

- A Farmer who has evolved or developed a new variety is entitled for registration and protection in like manner as a Breeder of a variety;
- Farmers variety can also be registered as an extant variety;
- Farmers engaged in the conservation of genetic resources of land races and wild relatives of economic plants are entitled for recognition and reward;

- Farmers can save, use, sow, re-sow, exchange, share or sell his farm produce including seed of a variety protected under the PPV&FR Act 2001 in the same manner as he was entitled before the coming into force the PPV&FR Act 2001;
- Farmers can claim compensation on non-performance of variety;
- Farmers would not be liable to pay any fee in any proceeding before the Authority or Registrar or the Tribunal or the High Court under the Act.

6. Which varieties can be protected under the PPV&FR Act 2001?

The New Varieties, Essentially Derived Varieties (EDV), Extant Varieties and Farmer's Varieties can be registered, provided the variety must conform to the criteria of Distinctiveness, Uniformity and Stability (DUS) and should also have a single and distinct denomination.

7. Are any varieties non-registrable under the PPV&FR Act 2001?

In accordance to the PPV&FR Act 2001, the following varieties are not registrable:

- Where prevention of commercial exploitation of such variety is necessary to protect public order or public morality or human, animal and plant life and health or to avoid serious prejudice to the environment;
- No variety of any genera or species which involves any technology which is injurious to the life or health of human beings, animals or plants shall be registered under this PPV&FR Act 2001.

8. Are there any specific guideline of test for DUS?

Guidelines for the Conduct of test for Distinctiveness, Uniformity and Stability (Crop Guidelines) has been issued by the PPV&FR Authority and can be accessed [here](#).

9. How to seek information with respect to the DUS Test Centres?

The information with respect to the DUS Test Centres, identified by the PPV&FR Authority, can be accessed at: [DUS Centres](#).

10. What is the term of protection under PPV&FR Act 2001?

The certificate of registration is valid for nine years in the case of tree and vines and six years for other crops and may be renewed for remaining period on payment of prescribed fee. The total period of validity of certificate of registration would not exceed 18 years in case of trees and vines and 15 years in case of other crops, from the date of registration of the variety.

11. What is the time limit for filing opposition?

Any person within three months from the date of the advertisement of an application for registration, can file opposition to the registration of a variety, to the Registrar.

12. What are the grounds of opposition?

The opposition to the registration under the PPV&FR Act 2001 can be filed based on any of the following grounds:

- The person opposing the application is entitled to the Breeder's right as against the Applicant; or
- The variety is not registrable under PPV&FR Act 2001; or
- The grant of certificate of registration may not be in public interest; or
- The variety may have adverse effect on the environment.

13. What are the grounds of revocation?

Any person interested may file application for revocation based on the following grounds:

- The registration certificate has been obtained based on incorrect information furnished by the Applicant;
- The registration certificate has been granted to a person, not eligible for protection under the PPV&FR Act 2001;
- The Breeder has not provided requisite and sufficient information, documents or material for registration;
- The Breeder has failed to provide an appropriate denomination of the variety;
- The Breeder has not provided the necessary seeds or propagating material to the person to whom compulsory licence has been issued;
- The Breeder has not complied with the statutory requirements stated under the PPV&FR Act 2001;
- The Breeder has failed to comply with the directions of the PPV&FR Authority issued under the PPV&FR Act 2001;
- The grant of the certificate of registration is not in the public interest.

14. Who can claim benefit sharing in the registered variety?

The content of the registration certificate are published by PPV&FR Authority and invites claim of benefit sharing to the variety. An application for benefit sharing can be made by following entities in prescribed manner along with applicable fee:

- Any person or group of persons, if such person or every person constituting such group is a citizen of India; or
- Firm or governmental or non-governmental organisation, if such firm or organisation is formed or established in India.

G. DOMAIN NAME

1. What is a Domain Name?

Domain Name is a word or a combination of words which act as an address to identify the business or brand online or on the internet. The Domain Names are used to locate the website. It is the unique reference that represents a webpage which form a part of the Uniform Resource Locator (URL).

2. How can one protect their Domain Name?

Domain Names can be registered and protected as Trademarks so long as the Domain Name meets the requirements of a Trademark under The Trade Marks Act, 1999. Domain Names as registered Trademarks are protected at a universal level primarily by the organisation, Internet Corporation for Assigned Names and Numbers. Resultantly, in case of any abusive registrations or infringing use, an individual shall have the option to file a Domain Name Dispute complaint under the Uniform Domain Name Dispute Resolution Policy (at an international level) or under the .IN Domain Name Dispute Resolution Policy (at a national level).

3. What is a Domain Name Dispute?

A Domain Name Dispute may arise when there is infringing, conflicting and/or unauthorised use of a Domain Name on part of an individual. In order to successfully establish a Domain Name dispute the complainant is required to satisfy the following aspects:

- the Registrant's Domain Name is identical and/or confusingly similar to a name, Trademark or service mark in which the Complainant has rights;

- the Registrant has no rights or legitimate interests in respect of the Domain Name; the Registrant's Domain Name has been registered or is being used in bad faith.

4. How to file a complaint regarding the Domain Name Dispute?

A complaint can be filed either under the Uniform Domain Name Dispute Resolution Policy (UDRP) or .IN Domain Name Dispute Resolution Policy (INDRP). As per the UDRP provisions, the complainant is required to submit the complaint in the prescribed format along with the evidencing documents and prescribed fee.

Under INDRP, the Complainant is required to submit all the relevant documents along with the complaint to National Internet Exchange of India (NIXI) in an electronic form along with the specified fee.

5. What to follow when cross border disputes are involved?

As the internet is not restricted by any borders or boundaries, it can very well be the case that a Domain Name infringement has occurred from a different country especially due to global presence of the companies. In such a case, the person can use the Uniform Domain Name Dispute Resolution Policy (UDRP) which is standard and uniform across the world.

6. What methods can be used to resolve Domain Name disputes?

The Domain Name Disputes can be resolved using various mechanisms. Proceedings before the Uniform Domain Name Dispute Resolution Policy (UDRP) or .IN Domain Name Dispute Resolution Policy (INDRP) which are governed by arbitral proceedings. Alternatively, the complainant can also resort to civil remedies.

H. IP INVESTIGATION

1. What does 'IP Investigations' mean?

Intellectual Property Investigations or IP Investigations are often conducted when an intellectual property holder is of the view that their intellectual property assets are being infringed or stolen. The holder, in this case, may not have any hard evidence or confession as intellectual property losses are often hidden or less visible. Consequently, IP Investigation services provide an independent oversight through effective and adequate means of gathering information in the instance an infringement action warrants a legal recourse. Notably, any intellectual property infringement impacts a company greatly as it may result in devaluation of the Tradename.

2. Are there any laws governing IP Investigations in India?

Presently, there is no legislation which governs the IP Investigation in India, however, IP Investigations are conducted based on good practice while maintaining complete confidentiality and proper recording of evidence.

3. What are the kinds of Intellectual Properties, breach of which, could result in an investigation?

Any individual who has a statutory or common law right on any kind of intellectual property can ask for an IP investigation in case of a breach. Breach may be of any kind, such as

- Trademark
- Patent

- Copyright
- Industrial Design
- Trade Secret
- Domain Name etc.

4. What is Counterfeiting Investigation?

Popular brands and products often experience counterfeiting of goods which can affect the growth and sales of the original producing entity. In such cases, one tries to find out whether the fakes are manufactured in India or manufactured abroad and distributed in India. A Counterfeiting Investigation helps investigate the individual responsible for the supply and production of such counterfeit goods.

5. What are the different kinds of IP investigation popularly conducted?

Following are a few kinds of IP investigations popularly conducted:

- **Patent Infringement Investigation:** A lot of market players from the medical, pharma, software and technology sectors experience breach against their technology. Patent infringement Investigators investigate into the abuse of the ground-breaking innovations and the violation of innovative devices and Designs;
- **Trade Secrets Breach Investigation:** Trade secrets investigation is used in cases where intellectual property rights are critical for the business growth and its breach could result to great damages. This could include breach of commercially sensitive information and business methods known by a very limited number of persons;
- **Branding, Copyright Piracy Investigation:** A lot of music composers, book authors, film producers and other creative persons from different industry sectors

usually prefer for this type of an investigation to protect their intellectual rights and Copyrights with their creation;

- **Grey Market Investigation:** This helps to deliver great results with cases involving infringed and pirated goods and their illegal sales. The Investigators trace and locate the supply chain and the stock behind their illegal distribution which helps gather concrete evidence for any product from any industry.

I. IP ADUIT

1. What is an IP Audit?

As per a normal understanding, audit means valuing and conducting inspection of a company's assets. Similarly, Intellectual Property Audit or IP Audit is the inspection of all the intellectual properties held by a company. An IP Audit consists of a systematic review of the intellectual property assets used or acquired by a business through the course of its operations. The IP audit is usually conducted to identify the intellectual property assets and also to uncover threats, if any, to a company in lieu of the use or association with that particular intellectual property asset.

2. What are the types of an IP Audit?

There are majorly 3 types of IP Audit. They are as follows:

- **General Purpose Audit:** This is done as a regular practise time and again to review the IP;
- **Event Driven Audit:** This is mostly done when a company is entering into a financial transaction;
- **Limited Purpose Audit:** This is done by a company to fulfil a specific purpose and nothing more, this is very limited and restricted to selected intellectual properties.

3. What are the kinds of IP assets which should be evaluated in an audit?

In order to conduct a comprehensive IP audit, one must analyze each aspect of a company's inputs, resources, processes, outputs and relationships. This will also help in identifying the company's intangible assets. Thereafter, the intangible assets

have to be evaluated and classified into one of the protectable intellectual property rights. These include two categories:

- **Statutory:** patents, Copyright, Designs, trademarks, Plant Varieties, geographical indications;
- **Non-statutory/common law:** know-how, technical information, confidential information, brands, tradenames, trade dress, secrets, databases, client information, business methods and processes etc.

4. What are the different kinds of agreements through which additional intellectual property rights of a company can be created?

Following are the few types of agreements through which an entity can lawfully acquire, use, or own intellectual property assets:

- Employment contracts/ NDA's and assignment contracts;
- All in-bound and out-bound IP licenses;
- Joint-ventures, M&A and other corporate transaction documents,
- Distribution agreements;
- Marketing agreements;
- Sales representative agreements;
- Original equipment manufacturer, value added reseller and other reseller agreements;
- Standard form customer agreements;
- Shrink wraps or click wraps;
- Government contracts.

5. How should an entity go about conducting an IP Audit?

Before embarking on the process of an IP Audit, it is necessary to keep in mind the purpose of the IP Audit and the resources available while making an audit plan. Research plan and checklists are an essential part of IP Audit as they help to understand and keep a track of the audit. The process of IP Audit involves some basic steps, as follows:

- Inventory check where all the IP assets are catalogued, along with a detailed description of each of the given assets.
- Checking if any of the intellectual property rights is capable of infringing the simultaneously existing intellectual property rights.
- Finally, an IP auditor is also required to identify lapses in the legal, regulatory and administrative procedures related to IP management.

6. What is the importance of an IP Audit in Mergers, Acquisitions or Assignment?

The importance of IP audits in mergers acquisitions and assignments have been growing manifold with time. Some of the key points of value are as follows:

- Some entities will have intellectual property rights as a key element and tend to invest capital heavily in the creation of their intellectual property rights.
- A portfolio of the company's intellectual property rights, if properly managed and maintained can help in the decision making process for the transacting entities.
- An IP Audit provides a basis for assessing the risk and value of the relevant intellectual property assets in a proposed transaction. This allows entities to evaluate their negotiating power and quantify the value of the proposed deal.
- The outcome of an IP Audit could lead to a significant increase or decrease in the value of the acquired company or the resulting merged entity.

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