

Law-copyrights  
patents trademarks  
and geographical  
indication



GLOSSARY The Patents Act, 2005 Section 2. (1) of the Patents Act, specifies the following terms, c. " Convention application" means an application for a patent made by virtue of section 135; d. " convention country" means a country or a country which is member of a group of countries or a union of countries or an Inter-governmental organization referred to as a convention country in section 133; j. invention" means a new product or process involving an inventive step and capable of industrial application; j(a) " inventive step" means a feature of an invention that involves technical advance as compared to the existing knowledge or having economic significance or both and that makes the invention not obvious to a person skilled in the art; k. " new invention" means any invention or technology which has not been anticipated by publication in any document or used in the country or elsewhere in the world before the date of filing of patent application with complete specification, i. . . , the subject matter has not fallen in public domain or that it does not form part of the state of the art; m. " patent" means a patent for any invention granted under this Act; n. " patent agent" means a person for the time being registered under this Act as a patent agent; o. " patented article" and " patented process" mean respectively an article or process in respect of which a patent is in force; o(a). " Patent Cooperation Treaty" means the Patent Cooperation Treaty done at Washington on the 19th day of June, 1970 as amended and modified from time to time; p. patentee" means the person for the time being entered on the register as the grantee or proprietor of the patent; The Trademarks Act, 1999 Plaintiff: A plaintiff, also known as a claimant or complainant, is the term used in some jurisdictions for the party who initiates a lawsuit (also known as an action) before a court. A plaintiff in a trademark infringement <https://assignbuster.com/law-copyrights-patents-trademarks-and-geographical-indication/>

case generally must prove 1) it possesses a valid mark; 2) that the defendant used the mark; 3) that the defendant used the mark in commerce, “ in connection with the sale, offering for sale, distribution or advertising of goods and services; and 4) that the defendant used the mark in a manner likely to confuse consumers. Respondent: Respondent is the persons against whom a suit, case or appeal is filed in a court who in turn is required to answer , or act according to the directions issued by the court till conclusion of the legal proceedings. Appellate: A higher court that reviews the decision of a lowercourt when a losing party files for an appeal. Appellant: A litigant or party that is making an appeal in court.

Injunction: An injunction is an equitable remedy in the form of a court order that requires a party to do or refrain from doing certain acts. A party that fails to comply with an injunction faces criminal or civil penalties and may have to pay damages or accept sanctions. In some cases, breaches of injunctions are considered serious criminal offenses that merit arrest and possible prison sentences. Geographical Indication (Registration and Protection) Act, 1999 “ Registrar” Section 2(1)(o), 3 means the Registrar of Geographical Indications.

Registrar of Geographical Indications is the Controller of Patents, Designs and Trade Marks appointed under sub-section (1) of Section 3 of the Trade Marks Act, 1999. The Central Government may appoint such officers for the purpose of discharging, under the superintendence and direction of the Registrar, such functions of the Registrar under this Act, as he may from time to time authorize them to discharge. ‘ Goods’-Section 2(1)(f)- means any agricultural, natural or manufactured goods or any goods of handicraft  
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or of industry and includes foodstuff. Producer' - Section 2(1)(k)- in relation to goods, means any person who, — a) if such goods are agricultural goods, produces the goods and includes the person who processes or packages such goods; b) if such goods are natural goods, exploits the goods; if such goods are handicraft or industrial goods, makes or manufactures the goods, and includes any person who trades or deals in such production, exploitation, making or manufacturing, as the case may be, of the goods.

Registered proprietor"- Section 2(1)(n)- in relation to a geographical indication, means any association of persons or of producer or any organisation for the time being entered in the register as proprietor of the geographical indication. " Authorised user" - Section 2(1)(b)- means any person claiming to be a producer of the goods in respect of which a geographical indication has been registered may apply for registration as an authorized user " Appellate Board" - Section 2(1)(a)- means the Appellate Board established under Section 83 of the Trade Marks Act, 1999.

Intellectual Property Rights (IPR) The WTO's Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), negotiated in the 1986-94 Uruguay Round , introduced intellectual property rules into the multilateral trading system for the first time. In the last century, human kind has created an unbelievable number of things. Aeroplanes, jets, printing press, automobiles, television, computers and antibiotics are some examples. This has been possible due to human ingenuity. It is the human mind that conceives such ideas and then creates the mechanisms required to apply them.

However, there is nothing innate about human thought. We think about our problems and concerns. Such human activity must result in desirable things and outputs. If individuals cannot avail the results of their occupations, there would be no incentive for them to create new things and ideas. Towards this, let us explore how ownership and property works. Property works on the principle of exclusion. It allows the owner, its enjoyment without interference. The owner can use it, gift it, sell it or even destroy it. Some property is known as movable property.

Examples of this would be TV and computers. Immovable property refers to things which are permanently fixed to the ground, like land and buildings. On the same lines, we create intellectual property. It is intellectual because it is not a tangible thing, like movable or immovable properties. Yet, when applied to the actual world, it can create useful and valuable things. The use of certain ideas is the exclusive prerogative of the person who thinks of them, and thus, we create a property in it. IP emerges from human creativity, innovation and engagement. It takes different forms like ideas, innovations, literary works, designs, music, films, computer software and industrial processes. IPR have been classified into Patents, Copyrights, Trademarks and Designs. These forms have different scopes. However, as these are properties, they can be owned, controlled, leased, and traded. Like tangible property, their enjoyment is also subject to regulation by the state. Let us consider a case of patents to explore the organization of IPR's. A person, after years of research, experimentation and innovation, comes up with a way of getting X-rays directly into an electronic form, instead of on a photo-plate.

This would reduce the cost of taking X-rays, improve storage and would also make examination more convenient. However, once the person introduces the machine in the market, others will get to know the mechanism of the machine. They may copy the technology and introduce their own machines in the market. Some among them may have more capital and resources to advertise these machines and to reduce their price by attaining economies of scale. The person who had invented the machine would be reduced to penury. Left to itself, in such a scenario, nobody would like to take the invention, for the person who invent it.

The intervention of the state would not have been needed if the property of the person had been intangible; say, the person had brought his harvest from the field. He would have safely kept it inside his house and guarded. However, in the case of an invention, it has to be brought out in the open. It is not something that the person can keep under lock and key. Hence, the state sets up a mechanism where it asks an inventor to get his invention registered in his name. Thereafter, it prevents others from using the idea and gives an exclusive opportunity to the inventor, to use the idea.

The inventor is free to use the idea, sell it off or lease the right to use the idea. Thus, by taking note of inventions, the state has created a property in the fruits of intellectual labour of individuals. Property rights create ownership. However, ownership is subject to regulations, control and curtailment, for the larger social good. Thus, the state can authoritatively acquire land individuals for public purposes, like for making of roads, airports or industries. While individuals may be free to sell their property, the state may fix the maximum selling price.

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Similarly, intellectual property is also subject to conditions and constraints in the interest of the larger social good. Consider another situation . The person does not put the idea into use because the X-ray film making company is paying him not to put the idea into practice, or, he does not put it into use for years, hoping to rack the price. In such situations, the society as a whole is deprived of the benefit of the innovation. To restore the balance, the state in recognizing the property, provides for a compulsory deployment and other restrains. Thus, the law dealing with IP, on the one hand, creates a right in the IP.

On the other hand the law, in the larger interest of the society, regulates and curtails the ownership of this property. Development of law after independence It was clear to the leadership of our country at the time of our independence that the path towards the progress and prosperity of the country was through industrial development. India's industrialization, which had been mainly brought about by the Europeans and a few Indian businessmen, was still in a nascent stage. While it could continue on its own, after independence, its capacity to rapidly industrialize a country of India's size was limited.

To be on the path of industrial development, India needed to build its infrastructure in terms of expansion in its rail network, road network, post and telegraph network and power generation facilities, along with the development of its metal industry and the manufacturing of machines. These activities needed large capital investments and had long gestation periods.

They were not readily profitable and thus, at that time, were beyond the capacity of Indian industries. These activities had to be undertaken by the <https://assignbuster.com/law-copyrights-patents-trademarks-and-geographical-indication/>

state itself. The Indian state took the task of investing in these fields, through the public sector, upon itself.

These fields where the industrialists could profitably work were left open for them. This came to be known as the private sector. This mix of public and private initiatives in India's industrialization was described as a mixed economy, with the commanding heights in the hand of the state, through the public sector. In this arrangement, the state was the largest deployer of the capital. To protect its investment, it heavily regulated entry into production. This was secured to the industrial development and regulation act, 1951. In some industries, only the state and its undertakings could operate.

In others, private companies were allowed to operate. However, to operate in these sectors, appropriate licenses had to be obtained from the state. The state needed resources not only for its upkeep, but also for investment, as it was the largest deployer of capital. The state could raise these resources through taxation. However there was a limit to the amount that could be raised through taxes. The other option for the state was to mop up public savings as borrowings. Through its network of banks, the state mobilized deposits from the public and borrowed these funds.

To do this it was important for the state to have control and monopoly on credit, finance and banking. The state ensured this through the nationalization of banks. Through the reserve bank of India, bank interests and other policies were formulated so as to ensure that the bank mobilized resources which the state could then borrow. For example, all the banks were required to deposit a good percentage of their total deposits with the



reserve bank. The government could then access these funds of the reserve bank of India, in the form of public securities.

Having a complete control over the banking, the state could borrow funds and invest them as it is willed. Also, public financial institutions, like the LIC, banks and others, were supposed to invest in private companies, but not interfere in their management. Thus most of the capital of a company could come from the government organizations and yet, the management could be in private hands. The state, interested in protecting the local industrialists and its own investments in different sectors, had kept put foreign competition. This was achieved through different means.

Foreign firms were not allowed to work in India under the industrial and regulation act, foreign exchange regulation act, company act and other licensing regulations. The only option available to them was to export goods to India. However, even the imports into India were heavily regulated. In addition, the custom duties were so high as to make it disadvantageous to import goods. After independence, India had to create a new economic and business order. Towards this, it constituted expert commissions and committees in several fields, to frame new enactments.

These enactments, consistent with the mood and direction of the state, bolstered the thrust on creating an insulated economy and privileging Indian industries. Examples of such enactments were the trade and merchandise marks act, 1956, the patents act, 1970, and the copyrights act. At other times, the new enactments were trying to catch up with the changes that were taking place in the economy. Examples of this were the standards of

weights and measures act, the prevention of food adulteration act, and the companies act, 1956.

While India, as compared to the other developing countries, was successful in bringing about industrialization, it could not sustain its pattern of development especially in keeping the economy free from competition from abroad. While India could claim to be self-reliant, it crucially depended upon international trade. In the 1970s, the prices of oil (petroleum) went up significantly. Oil was an important ingredient for industrialization, since it was required in the movement of trains, trucks, buses and cars, in addition to its industrial uses.

Understandably, the demand for oil was on the increase. Oil was an essential import item, required to sustain the economy. India wanted to be self-sufficient in food. For increasing agricultural production, large quantities of fertilizers also needed to be imported. Edible oil was yet another important item for imports. In addition, plant and machinery for capital development, as well as several raw materials, needed to be imported. For all this, foreign exchange was needed. In the international market, foreign exchange could be earned only through exports.

But in the international market, while India's import requirements were increasing, exports were not being able to keep pace. Therefore foreign exchange was always scarce. Towards this, a draconian foreign exchange regulation act was enacted to heavily regulate the use of foreign exchange. But India's foreign exchange problem was chronic. It had to go to the international monetary fund (IMF), an international body created for meeting

such exigencies of developing countries, to borrow foreign exchange. Every time the loan came, it came with certain conditions, including that of devaluing the rupee. PATENTS

A Patent is an intellectual property right relating to inventions and is the grant of exclusive right, for limited period, provided by the Government to the patentee, in exchange of full disclosure of his invention, for excluding others, from making, using, selling, importing the patented product or process producing that product for those purposes. The purpose of this system is to encourage inventions by promoting their protection and utilization so as to contribute to the development of industries, which in turn, contributes to the promotion of technological innovation and to the transfer and dissemination of technology.

Under the system, Patents ensure property rights (legal title) for the invention for which patent has been granted, which may be extremely valuable to an individual or a Company. One should make the fullest possible use of the Patent System and the benefits it provides. Patent right is territorial in nature and a patent obtained in one country is not enforceable in other country. The inventors/their assignees are required to file separate patent applications in different countries for obtaining the patent in those countries. Legislation The Patent System in India is governed by the Patents Act, 1970 (No. 9 of 1970) as amended by the Patents (Amendment) Act, 2005 and the Patents Rules, 2003, as amended by the Patents (Amendment) Rules 2006 effective from 05-05-2006. Administration The Patent Office, under the Department of Industrial Policy & Promotion, Ministry of Commerce & Industry, performs the statutory duties in connection with the grant of <https://assignbuster.com/law-copyrights-patents-trademarks-and-geographical-indication/>

patents for new inventions and registration of industrial designs. Patent Offices are located at Kolkata , Mumbai, Chennai and Delhi to deal with the applications for patents originating within their respective territorial jurisdictions. Patent Information System (PIS) located at Nagpur maintains a comprehensive collection of patent specifications and patent related literature, on a worldwide basis and provides technological information contained in patent or patent related literature through search services and patent document supply services. \* Intellectual Property Training Institute (IPTI) located at Nagpur provides training to the officials of IP offices and other users of the system who are working in the field of Intellectual Property Rights. Types of patent applications 1. Ordinary Application 2. Convention application 3.

PCT- International Application 4. PCT -National Phase Application 5. Application for Patent of Addition 6. Divisional Application \* Ordinary Application The first application for patent filed in the Patent Office without claiming priority from any application or without any reference to any other application under process in the Patent office is called an ordinary application. \* Convention application When an applicant files a patent application, claiming a priority date based on the same or substantially similar application filed in one or more of the convention countries, it is called a convention application.

To get a convention status, an applicant should file the application before any of the patent offices within 12 months from the date of first application in the convention country. \* PCT- International Application The Patent

Cooperation Treaty or PCT is an international agreement for filing patent <https://assignbuster.com/law-copyrights-patents-trademarks-and-geographical-indication/>

applications. However, there is nothing called as a ' world patent'. The PCT application does not provide for the grant of an international patent, it simply provides a streamlined process for the patent application process in many countries at the same time.

Some of the benefits of the system are: \* It simplifies the process of filing patent applications i. e. , an applicant can file a single international patent application in one language with one receiving patent office in order to simultaneously seek protection for an invention in up to 138 countries throughout the world. \* It provides internationally recognized priority date, which has an effect in each of the countries designated. \* Delays the expenses associated with applying for patent protection in various countries.

PCT gives 30 to 31 months time to enter into various countries from the priority date or international filing date whichever is earlier unlike the convention method which gives only 12 months time to file for a patent application in the country of interest from the priority date. Hence, the PCT route allows the inventor more time to assess the commercial viability of his/her invention. \* It provides an international search report. The results of this search are very valuable to the applicant.

They allow the applicant to make more informed choices early in the patent process, and to amend the application to deal with any conflicting material, before the major expenses of the national phase of the patent process begin.

\* Provides an option of an International Preliminary Examination Report that is forwarded to the elected Offices and the applicant, the report containing an opinion as to whether the claimed invention meets certain international

criteria for patentability. \* National Phase Application under PCT The PCT-national phase must follow the international phase.

The applicant must individually 'enter into the national phase'. i. e. file a National phase application in each country he wishes to enter. The applicant can enter the national phase in up to 138 countries within 30-31 months (depends on the laws of the designated countries) from the international filing date or priority date (whichever is earlier). If the applicant does not enter the national phase within the prescribed time limit, the International Application loses its effect in the designated or elected States. \* Patent of Addition

Patent of addition is an application made for a patent in respect of any improvement or modification of an invention described or disclosed in the complete specification already applied for or has a patent. In order to be patentable an improvement, should be something more than a mere workshop improvement and must independently satisfy the test of invention. The major benefit is the exemption of renewal fee so long as the main patent is renewed. A patent of addition lapses with the cessation of the main patent. \* Divisional Application A divisional application is one which has been "divided" from an existing application.

The applicant, at any time before the grant of a patent can file a further application, if he so desires or if an objection is raised by the examiner on the ground that the claims disclosed in the complete specification relates to more than one invention. A divisional application can only contain subject matter in the application from which it is divided (its parent), but retains the

filing and priority date of that parent. A divisional application is useful if a unity of invention objection is issued, in which case the second invention can be protected as a divisional application. INVENTIONS

Invention means a new product or process involving an inventive step and capable of Industrial application. Inventive step means a feature that makes the invention not obvious to a person skilled in the art Capable of Industrial application means that the invention is capable of being made or used in an industry. However, inventions claiming substance intended for use, or capable of being used, as food or as medicine or drug or relating to substances prepared or produced by chemical processes (including alloys, optical glass, semiconductors and inter-metallic compounds) are not patentable. Only process claims are allowed in such cases.

INVENTIONS . PATENABLE NON-PATENTABLE A. ) PATENABLE INVENTIONS

The basic criteria for an invention to be patentable are the following: (1) An invention must be novel - Novelty (2) Has an inventive step and - Inventiveness (Non-obviousness) (3) Is capable of industrial application - Usefulness 1. Novelty An invention will be considered novel if it does not form a part of the global state of the art. Information appearing in magazines, technical journals, books, newspapers etc. constitute the state of the art. Oral description of the invention in a seminar/conference can also spoil novelty.

Novelty is assessed in a global context. An invention will cease to be novel if it has been disclosed in the public through any type of publications anywhere in the world before filing a patent application in respect of the invention.

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Prior use of the invention in the country of interest before the filing date can also destroy the novelty. Novelty is determined through extensive literature and patent searches. It should be realized that patent search is essential and critical for ascertaining novelty as most of the information reported in patent documents does not get published anywhere else. . Inventiveness (Non-obviousness) A patent application involves an inventive step if the proposed invention is not obvious to a person skilled in the art i. e. , skilled in the subject matter of the patent application. The prior art should not point towards the invention implying that the practitioner of the subject matter could not have thought about the invention prior to filing of the patent application. Inventiveness cannot be decided on the material contained in unpublished patents. The complexity or the simplicity of an inventive step does not have any bearing on the grant of a patent.

In other words a very simple invention can qualify for a patent. If there is an inventive step between the proposed patent and the prior art at that point of time, then an invention has taken place. A mere ' scintilla' of invention is sufficient to found a valid patent. 3. Usefulness An invention must possess utility for the grant of patent No valid patent can be granted for an invention devoid of utility. B. ) NON-PATENABLE INVENTIONS There are some products and processes, which are not patentable in India. They are classified into two categories in the patent act:- a) Those, which are not inventions ) Invention relating to atomic Energy The following are certain examples of non-patentable inventions • Discovery of any natural living thing or non-living thing. • Invention based on any new Diagnostic and Therapeutic treatment of any causative disease to human beings and animals. • Use or commercial



exploitation of any invention, which could be harmful to human, animal or plant life or to the environment. • Plants and animals, including varieties, seeds and species thereof and Biological process for the production or propagation of plants and animals. New mathematical or Business trend method, computer programs, any artistic work, art of presentation, new method of playing game, topography of integrated circuits. • Replication of any traditional knowledge. APPROPRIATE OFFICE FOR FILING AN APPLICATION & FOR OTHER PROCEEDINGS Application is required to be filed according to the territorial limits where the applicant or the first mentioned applicant in case of joint applicants, for a patent normally resides or has domicile or has a place of business or the place from where the invention actually originated.

If the applicant for the patent or party in a proceeding having no business place or domicile in India, the appropriate office will be according to the address for service in India given by the applicant or party in a proceeding . The appropriate office once decided in respect of any proceedings under the Act shall not ordinarily be changed. The four patent offices are located at Kolkatta, Mumbai, Delhi & Chennai. PROVISIONAL SPECIFICATION

Application for patent may be accompanied by the provisional specification. It should contain the description of invention with drawing, if required. It is not necessary to include Claim. However, the complete specification should be fairly based on the matter disclosed in the provisional specification and should be filed within 12 months. If the complete specification is not filed within 12 months the application is deemed to have been abandoned.

#### COMPLETE SPECIFICATION

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The complete specification is an essential document in the filing of patent application along with the drawing to be attached according to the necessity. Complete specification shall fully describe the invention with reference to drawing, if required, disclosing the best method known to the applicant and end with Claim/Claims defining the scope of protection sought.. The specification must be written in such a manner that person of ordinary skill in the relevant field, to which the invention pertains, can understand the invention.

Normally, it should contain the following matter- 1) Title of invention, 2) Field of invention, 3) Background of invention with regard to the drawback associated with known art, 4) Object of invention, 5) Statement of invention, 6) A summary of invention, 7) A brief description of the accompanying drawing, 8) Detailed description of the invention with reference to drawing/examples, 9) Claim(s), 10) Abstract. The specification must start with a short title, which describes the general nature of invention.

The title should not contain anyone's name, a fancy name and trade name or personal name or any abbreviation etc. Description: The specification must be written in good and clear English or Hindi. The specification should indicate those features which are essential for the operation of the invention as well as those features for which a choice can be made. The description must be sufficiently detailed for someone who works in the same area of technology to be able to perform the invention from the information given in the description. The best method of putting the invention into effect is required to be described.

In case of biological invention, it is required to mention the source or geographical origin of biological material used for the invention

## PUBLICATION & EXAMINATION OF PATENT APPLICATIONS

i) Publication: All the applications for patent, except the applications prejudicial to the defence of India or abandoned due to non-filing of complete specification within 12 months after filing the provisional or withdrawn within 15 months of filing the application, are published in the Patent Office Journal just after 18 months from the date of filing of the application or the date of priority whichever is earlier.

The publication includes the particulars of the date of the application, application number, name and address of the applicant along with the abstract. The applications for patent are not open for public inspection before publication. After the date of publication of the application, as stated above, the complete specification along with provisional and drawing, if any, abstract, application on any form or on plain paper and any correspondence between the office and applicant may be inspected at the appropriate office by making a written request to the Controller in the prescribed manner and on the payment of prescribed fee..

Early Request for Publication: The applicant may also file a request for early publication in Form-9 with a prescribed fee of Rs 2500/- or 4Rs 10, 000/- for natural person and other than natural person respectively. The above application is published ordinarily within one month from the date of the request on Form-9. The applicant shall have provisional Rights from the date of publication. ii) Request for examination No application for patent will be examined if no request is made by the applicant or by any other interested person in Form-18 with prescribed fee of Rs. , 500/- or Rs. 10, 000/- for

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natural person and other than natural person respectively, within a period of 48 months from the date of priority of the application or from the date of filing of the application , whichever is earlier. Where no request for examination of the application for patent has been filed within the prescribed period, the aforesaid application will be treated as withdrawn and, thereafter, application cannot be revived. EXAMINATION

Application for patent, where request has been made by the applicant or by any other interested person, will be taken up for examination, according to the serial number of the requests received on Form 18. A First Examination Report (FER) stating the objections/requirements is communicated to the applicant or his agent according to the address for service ordinarily within six (06) months from the date of request for examination or date of publication whichever is later.

Application or complete specification should be amended in order to meet the objections/requirements within a period of 12 months from the date of First Examination Report (FER). No further extension of time is available in this regard. If all the objections are not complied with within the period of 12 months, the application shall be deemed to have been abandoned. When all the requirements are met the patent is granted, after 6 months from the date of publication, the letter patent is issued, entry is made in the register of patents and it is notified in the Patent Office, Journal.

**WITHDRAWAL OF PATENT APPLICATION** The application for patent can be withdrawn at least 3(Three) months before the first publication which will be 18(Eighteen) months from the date of filing or date of priority whichever is

earlier. The application can also be withdrawn at any time before the grant of the patent. The application withdrawn after the date of publication, cannot be refiled as it is already laid open for public inspection. However, application withdrawn before the publication can be refiled provided it is not opened to public otherwise.

#### OPPOSITION PROCEEDINGS TO GRANT OF PATENTS Pregnant opposition

Where an application for a patent has been published but a patent has not been granted, any person may, in writing represent by way of opposition to the Controller against the grant of any Patent. The representation shall be filed at the appropriate office and shall include a statement and evidence, if any, in support of the representation and a request for hearing if so desired.

The above representation may be made on the following grounds (a) that the applicant for the patent or the person under or through whom he claims, wrongfully obtained the invention or any part thereof from him or from a person under or through whom he claims; (b) that the invention so far as claimed in any claim of the complete specification has been published before the priority date of the claim (c) that the invention so far as claimed in any claim of the complete specification was publicly known or publicly used in India before the priority date of that claim.

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

reasonable trial or experiment only; (d) that the invention so far as claimed in any claim of the complete specification is obvious and clearly does not involve any inventive step, having regard to the matter published as mentioned in clause (b) or having regard to what was used in India before the priority date of the applicant's claim; (e) that the subject of any claim of the complete specification is not an invention within the meaning of this Act, or is not patentable under this Act; (f) that the complete specification does not sufficiently and clearly describe the invention or the method by which it is to be performed; (g) that the applicant has failed to disclose to the Controller the information required by section 8 or has furnished the information which in any material particular was false to his knowledge; (h) that in the case of convention application, the application was not made within twelve months from the date of the first application for protection for the invention made in a convention country by the applicant or a person from whom he derives title; (i) that the complete specification does not disclose or wrongly mentions the source or geographical origin of biological material used for the invention; The Controller shall, if requested by such person for being heard, hear him and dispose of such representation. If the opposition is decided in favour of the applicant, the patent is granted and the grant of Patent is published in the Patent Office Journal thereby opening the application, specification and other related documents for public inspection on payment of prescribed fee. GRANT OF PATENT

When all the requirements of the FER are met or in case of opposition under section 25(1), if the opposition is decided in favour of the applicant, the patent is granted, after 6 months from the date of publication under section

11 A, the letter patent is issued, entry is made in the register of patents and it is notified in the Patent Office, Journal, thereafter opening the application, specification and other related documents for public inspection on payment of prescribed fee. TERM AND DATE OF PATENT Term of every patent will be 20 years from the date of filing of patent application, irrespective of whether it is filled with provisional or complete specification. Date of patent is the date on which the application for patent is filed. POST-GRANT OPPOSITION Any interested person can file notice of opposition (along with written statement and evidence, if any) anytime after the grant of Patent but before the expiry of a period of one year from the date of publication of grant of a Patent in the Patent Office Journal .

The above notice under Section 25(2) shall be filed on Form-7 along with a fee of Rs. 1500/ or Rs. 6000/- for natural person and other than natural person respectively, in duplicate at the appropriate office. The grounds of opposition under section 25 (2) are the same as given before in case of pre grant opposition. The post grant opposition is decided by an Opposition Board followed by a hearing and the reasoned decision by the Controller.

RIGHTS OF THE PATENTEE Where a patent covers a product, the grant of patent gives the patentee the exclusive right to prevent others from performing, without authorisation, the act of making, using, offering for sale, selling or importing that product for the above purpose.

Where a patent covers a process, the patentee has the exclusive right to exclude others from performing, without his authorisation, the act of using that process, using and offering for sale, selling or importing for those purposes, the product obtained directly by that process in India. These rights  
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created by statute are circumscribed by various conditions and limitations as provided in the Patents Act, 1970 as amended by The Patents (amendment) Act, 2002. **RENEWAL FEE** To keep the patent in force, Renewal fee is to be paid every year. The first renewal fee is payable for the third year and must be paid before the expiration of the second year from the date of patent.

If the patent has not been granted within two years the renewal fees may be accumulated and paid immediately after the patent is granted, or within 3 months of it's recordal in Register of Patents or within extended period of 9 months, by paying extension fees of six month on Form 4, from the date of recording. If the renewal fees are not paid within the prescribed time, the patent will cease to have effect. However, provision to restore the patent is possible provided application is made within eighteen months from the date of cessation. **RESTORATION** Application for restoration of a patent that lapses due to non-payment of renewal fees must be made within 18 months of lapse. The application is to be filed in the appropriate office according to the jurisdiction. **REQUEST FOR PERMISSION TO FILE ABROAD**

If any application is to be filed abroad , without filing in India , it should be made only after taking a written permission from the Controller . The request for permission for making patent application outside India shall be made in Form-25 along with a fee of Rs 1000/- or Rs 4000/- for natural person and other than natural person respectively. A gist of invention should also be filed along with the Form-25. **ARTICLES RELATING TO TRIPS AGREEMENT**  
**Article 27. 1:** The TRIPS Agreement requires Member countries to make patents available for any inventions, whether products or processes, in all



fields of technology without discrimination, subject to the normal tests of novelty, inventiveness and industrial applicability.

It is also required that patents be available and patent rights enjoyable without discrimination as to the place of invention and whether products are imported or locally produced

Illustration - Novelty: The invention is a new type of electrical battery involving the use of materials not previously used for this purpose.

Illustration - Inventiveness: A new form of washing machine is invented that includes a particular type of motor coupled to a particular type of pump. For the inventive step to be denied, it is necessary that not only the combination, but also the choice of the combined elements, is obvious.

Illustration - Industrial Applicability: The above invented combination to be used in new form of washing machine should be useful in terms of its application and not remain as mere invention on paper

Article 27. 2: There are three permissible exceptions to the basic rule on patentability.

One is for inventions contrary to order public or morality; this explicitly includes inventions dangerous to human, animal or plant life or health or seriously prejudicial to the environment. The use of this exception is subject to the condition that the commercial exploitation of the invention must also be prevented and this prevention must be necessary for the protection of order public or morality.

Illustration: Suppose an invention, which meets the conditions for patent grant, is a device whose explicit and only use is to ensure that radars that control speed limits on highways are de-activated. A Member may be able to justify its exclusion on the grounds that this invention is intended to disrupt ordre public.

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However, a Member cannot exclude the invention from patentability on this ground and then allow the sale or other commercial exploitation of this device. Article 27. 3(a): The second exception is that Members may exclude from patentability diagnostic, therapeutic and surgical methods for the treatment of humans or animals. Article 27. 3(b): The third is that Members may exclude plants and animals other than micro-organisms and essentially biological processes for the production of plants or animals other than non-biological and microbiological processes. However, any country excluding plant varieties from patent protection must provide an effective sui generis system of protection.

Moreover, the whole provision is subject to review four years after entry into force of the Agreement. Article 28: The exclusive rights that must be conferred by a product patent are the ones of making, using, offering for sale, selling, and importing for these purposes. Process patent protection must give rights not only over use of the process but also over products obtained directly by the process. Patent owners shall also have the right to assign, or transfer by succession, the patent and to conclude licensing contracts. Illustration: Suppose a patented process is being used outside the Member A's jurisdiction where the patent has been obtained and the resulting product is being imported into this territory.

The patent owner has the right to prevent the importation from Member B's jurisdiction and the sale of the product in Member A if it has been directly obtained by using the patented process. Article 29. 1: Members shall require that an applicant for a patent shall disclose the invention in a manner

sufficiently clear and complete for the invention to be carried out by a person  
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skilled in the art and may require the applicant to indicate the best mode for carrying out the invention known to the inventor at the filing date or, where priority is claimed, at the priority date of the application. Article 33: The term of protection available shall not end before the expiration of a period of 20 years counted from the filing date.

Illustration: If Person A has been granted a patent for his XYZ invention on 1/12/2011, he has the patent right for next 20 years considering he has been paying the renewal fees Article 34: If the subject-matter of a patent is a process for obtaining a product, the judicial authorities shall have the authority to order the defendant to prove that the process to obtain an identical product is different from the patented process, where certain conditions indicating likelihood that the protected process was used are met.

WHAT CONSTITUTES A PATENT INFRINGEMENT A patent granted to a person bestows exclusive right to the person to make, distribute, mortgage, or sell the invention. Patents are jurisdictional rights, and are therefore restricted to a country that grants the patent. Patents are analogous to Real-estate property. Both grant exclusive rights to the owner. Violation of the exclusive rights of a Real-estate property by someone who unlawfully uses an area of the real-estate property is called . encroachment.. Similarly, an encroachment upon the invention patented by the owner is called “ infringement”.

Patent infringement is the unauthorized making, using, offering for sale, selling of any patented invention within a jurisdiction, or importing into the jurisdiction of any patented invention during the term of a patent. In India,

Section 104 to section 114 of the Indian Patents Act 1970 provides <https://assignbuster.com/law-copyrights-patents-trademarks-and-geographical-indication/>

guidelines relating to patent infringement. Patent infringement occurs when a product infringes one or more patents. To determine patent infringement, firstly a product or a process is analyzed and compared with all relevant patents that may claim an invention similar to the product. Secondly, the product or the process is scrutinized to see if the product or the process reads on one or more patents and is substantially described by the claims of the one or more patents. There are three basic types of patent infringements: 1. Direct patent infringement Direct patent infringement is the most obvious and the most common form of patent infringement. In the most basic definition, direct patent infringement occurs when a product that is substantially close to a patented product or invention is marketed, sold, or used commercially without permission from the owner of the patented product or invention. 2. Indirect patent infringement and contributory patent infringement: Indirect patent infringement suggests that there was some amount of deceit or accidental patent infringement in the incident. For e. g. person A holds a patent for a device and a person B manufactures a device which is substantially similar to the person A's device. The person B is supplied with a product from a Person C to facilitate manufacturing of the person B's device. If the device so manufactured by the person B infringes on the Person A's patent, then the person C indirectly infringes the Person A's patent. Further, if such a product is knowingly sold or supplied, it may lead to contributory patent infringement.. For example, in the above example if the person C knowingly supplies the product to the Person B then the infringement is construed as . contributory patent infringement.

CASELETS FOR INFRINGEMENT Direct patent infringement

If Company A is selling their patented product X in the market and Company B is found to be selling the same product X in the market it's a case of direct patent infringement. Indirect patent infringement and contributory patent infringement: For e. g. a person A holds a patent for a device and a person B manufactures a device which is substantially similar to the person A's device. The person B is supplied with a product from a Person C to facilitate manufacturing of the person B's device. If the device so manufactured by the person B infringes on the Person A's patent, then the person C indirectly infringes the Person A's patent. Further, if such a product is knowingly sold or supplied, it may lead to . contributory patent infringement.

For example, in the above example if the person C knowingly supplies the product to the Person B then the infringement is construed as contributory patent infringement. Case Study Bajaj Auto LTD. Vs. TVS Motor Company LTD. Complaint Filed by Bajaj Auto Ltd against TVS Motor Company In 2007 Bajaj Auto Ltd. (hereafter referred to as Bajaj) filed a patent litigation suit against TVS Motor Company Ltd. (hereafter referred to as TVS) in court. Bajaj alleged that CC-VTi technology used by TVS in manufacturing, marketing, selling, offering for sale or exporting 2/3 wheelers, including the proposed 125-CC FLAME infringes on one of Bajaj's was granted Indian Patent No. 195904. Technology Bajaj was granted Indian Patent No. 95904 in respect of a patent application titled " An Improved Internal combustion engine working on four stroke principle" with a priority date of 16th July 2002. According to Bajaj, they invented a unique technology of using two spark plugs for efficient burning of lean air fuel mixture in a small bore engine in the size between 45 mm and 70 mm. The use of two spark plugs in large bore

engines or in high performance/racing bikes was known in the Automobile industry. However, the above invention of the Bajaj was not known. The Bajaj's invention which is called "DTS-i Technology" is a step of providing a second spark plug in a small bore engine running lean, was never thought of or implemented in the automobile industry.

Further, according to Bajaj, it results in better combustion in a comparatively shorter duration of time leading to reduction in emission and improved fuel consumption while maintaining the predetermined level of performance.

According to Bajaj the essential features of its invention are: \* Small displacement engine as reflected by a cylinder bore diameter between 45 mm and 70 mm; \* Combustion of lean air fuel mixtures; \* Using a pair of spark plugs to ignite the air fuel mixture at a predetermined instant. Bajaj argued that they applied for the grant of the patent on 16. 07. 2002 and the patent was granted on 07. 07. 2005, which was published in Issue No. 28/2005 dated 29. 07. 2005. According to Bajaj, there was no opposition filed by anyone including TVS either before or after the grant of patent.

However, TVS questioned the validity of Bajaj's patent just 7 days before the launch of its proposed 125-CC motorcycle by filing an application for revocation of Bajaj's patent No. 195904 before Indian Patents Appellate Board (IPAB). Bajaj argued that the TVS's 4 stroke combustion engine in small bore lean burn engine of size 54. 5mm x 53. 5mm and combusting lean air fuel mixture infringes its patent. Bajaj stated that TVS using 3 valves in the engine does not dilute the infringement as the number of valves is not an essential feature of its invention. In counter-attack, TVS argued that the use of two spark plugs in an IC engine with three valves was well known in <https://assignbuster.com/law-copyrights-patents-trademarks-and-geographical-indication/>

the art and that Bajaj cannot seek patent for the use of two spark plugs in an IC engine.

TVS further argued that in order to avoid the said situation, Bajaj misled by introducing a limitation of bore size to the US Honda patent. TVS also argued that Bajaj had full knowledge that US Honda patent did not have any such limitation. Along with US Honda Patent No. 4534322, TVS cited number of prior arts against Bajaj's " DTS-i Technology" in an attempt to revoke Bajaj's patent. TVS also added that Bajaj's claim is two spark plugs with two valves, whereas its technology is about having two spark plugs with three valves.

Verdict In this case Madras High Court denied injunction against TVS.

However, the court ordered that TVS shall not receive any further booking for TVS Flame containing the disputed engine technology patent.

The court also allowed TVS the liberty to deliver the already booked TVS Flame motor-cycles provided they maintain accounts for the motorcycles so delivered. TRADEMARK ACT 1999 (SEC 2) A trademark is a kind of intellectual property, and typically a name, word, phrase, logo, image, symbol, design, or a combination of these elements, which discriminate services or goods of one person or enterprise from those of another. A trademark is a distinctive sign or indicator used by an individual, business organization, or other legal entity to identify that the services or products to consumers with which the trademark appears originate from a unique source, and to distinguish its products or services from those of other entities.

The trademarks law of India is enshrined the new Trade Marks Act, 1999 came into vigor with effect from September 15, 2003. The old Trade and Merchandise Marks Act, 1958 was repealed at the same time. The new Trademarks Act of 1999 is in line up with the WTO recommendations and is in conventionality with the TRIPS Agreement to which India is a participant

Provisions in the new law, the Trade marks Act, 1999: \* The service marks and collective marks may be registered and defensive marks are no longer registrable. \* A single application may cover numerous classes of goods and services. \* The term of a registration will be increased from 7 to 10 years, and be renewable for additional 10-year periods. The definition of infringement has been broadened to embrace action against the unauthorized use of a confusingly similar mark, not only in respect of the goods and services covered by the registration, as is currently the case, but also in respect of goods and services not covered in the registration which are so similar that a likelihood of deception or confusion exists. \* An appellate board is to be reputable to expedite appeals and applications for rectification which are presently submitted to the high court.

PURPOSE- (Who can apply? )A trademark registration in India gives exclusive proprietary rights to the rights holder for protection of their trademark in India. However as the Indian legal system is based on the common law system, even an unregistered trademark is entitled to protection and the rights holder of the unregistered trademark can initiate action against a third party under the law of passing off.

Under The Trade Marks Act, 1999 a person who is the proprietor of the trademark can apply for the registration of its mark for goods as well



services. Any word, signature, name, logos, label, numerals or combination of colors used by one enterprise on goods or services can be registered as a trademark in India

### TYPES OF TRADEMARKS

Under the Indian trademark law the following are the types of trademarks that can be registered:

- **Product trademarks:** are those that are affixed to identify goods.
- **Service trademarks:** are used to identify the services of an entity, such as the trademark for a broadcasting service, retail outlet, etc. They are used in advertising for services.
- **Certification trademarks:** are those that are capable of distinguishing the goods or services in connection with which it is used in the course of trade and which are certified by the proprietor with regard to their origin, material, the method of manufacture, the quality or other specific features
- **Collective trademarks:** are registered in the name of groups, associations or other organizations for the use of members of the group in their commercial activities to indicate their membership of the group. Any person claiming to be the proprietor of a trademark may apply in writing for registration.

### THE TRADEMARKS THAT CANNOT BE REGISTERED

The following are the types of marks that cannot be registered in India:

- Not capable of distinguishing the goods or services of one person from those of another ;
- Consisting exclusively of marks or indications which may serve in trade to designate the kind, quality, quantity, intended purpose, values, geographical origin or the time of production of the goods or rendering of the service or other characteristics of the goods or service.
- Of such nature as to deceive the public or cause confusion. Contains or comprises of any matter likely to hurt the religious susceptibilities of any class or section of the citizens of India
- Comprises or contains scandalous or obscene matter;
- A word that is a commonly used and accepted name of any single chemical

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element or any single chemical compound in respect of a chemical substance or preparation or which is declared by the World Health Organization and notified in the prescribed manner by the Registrar from time to time, as an international non-proprietary name or which is deceptively similar to such name

TRADEMARK WITH REFERENCE TO TRIPS AGREEMENT

A trademark provides protection to the owner of the mark by ensuring the exclusive right to use it in the marketplace to identify certain goods or services, or to authorize another to use it in return for payment. The trademark system thus serves to protect producers from unfair competition from other producers seeking to free ride on the goodwill earned by the trademark owner. Thus, trademarks protect an undertaking's goodwill, as well as the consumers against confusion and deceptive practices. While the registration of service marks was optional under the Paris Convention, it has become obligatory under the TRIPS Agreement.

TRIPS PROVISIONS ON TRADEMARKS 1. SUBJECT MATTER OF TRADEMARK PROTECTION

a) DISTINCTIVE SIGNS According to Article 15. of the TRIPS Agreement any sign, or any combination of signs, capable of distinguishing the goods and services of one 'undertaking' from those of other undertakings must be eligible for trademark protection. These signs could be words including personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of signs. This means that in principle there is no limitation on the type of signs that can constitute trademarks. Rather, the emphasis is on distinctiveness - i. e. the ability of these signs to distinguish products of one enterprise from those of others. Members are free to determine whether or not to allow the registration of signs which are not visually perceptible (e. g. smells).

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Fantasy words like YAHOO, ATARI or EXXON are therefore more likely to be distinctive (with regard to any product) than descriptive words like CAR for cars or BIKE for bicycles. Where signs are not inherently (i. e. “ by the nature of the sign itself”) capable of distinguishing the relevant products, Members can allow registration as a trademark on the basis of distinctiveness that has been acquired through use. Distinctiveness is acquired if an otherwise descriptive term (e. g. “ Raisin-Bran” for bran cereal with raisins or “ Federal Express” for express mail service at the Federal level), through extensive advertising or use for a product by a particular enterprise, has ceased to be understood as a general term and has come to be associated with the product of one specific supplier.

It then serves to distinguish those products from the products of other suppliers, which makes it capable of constituting a trademark. b. TRADE NAMES The notion of a trade name is interpreted in different ways in existing legislations. It can generally, however, be defined as being the name or designation identifying the enterprise of a natural or legal person. The protection of trade names has been held by the Appellate Body to also fall within the scope of the TRIPS Agreement by virtue of the incorporation of Article 8 Paris Convention into the TRIPS Agreement c. COLLECTIVE MARKS AND CERTIFICATION MARKS According to Article 7bis Paris Convention as incorporated into the TRIPS Agreement Members must also accept the registration of signs as collective marks.

This means that signs can be registered not only with respect to products from one enterprise, but with respect to those of a group of enterprises or an association. These enterprises can then own, use and defend the trademark <https://assignbuster.com/law-copyrights-patents-trademarks-and-geographical-indication/>

collectively. Such marks are often used to distinguish the geographical origin or other common characteristics of products of different enterprises which use the collective mark under the control of its owner, or to certify that the product bearing the mark has certain characteristics such as a particular mode of production, regional or other origin, or fulfils certain standards of quality. Such marks are also sometimes referred to as certification marks or guarantee mark. ARTICLES RELATING TO TRIPS AGREEMENT Article 15:

Protectable Subject Matter Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark. Such signs, in particular words including personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs, shall be eligible for registration as trademarks. Where signs are not inherently capable of distinguishing the relevant goods or services, Members may make registrability depend on distinctiveness acquired through use. Members may require, as a condition of registration, that signs be visually perceptible.

Paragraph 1 shall not be understood to prevent a Member from denying registration of a trademark on other grounds, provided that they do not derogate from the provisions of the Paris Convention (1967). Members may make registrability depend on use. However, actual use of a trademark shall not be a condition for filing an application for registration. An application shall not be refused solely on the ground that intended use has not taken place before the expiry of a period of three years from the date of

application. The nature of the goods or services to which a trademark is to be applied shall in no case form an obstacle to registration of the trademark.

Members shall publish each trademark either before it is registered or promptly after it is registered and shall afford a reasonable opportunity for petitions to cancel the registration. In addition, Members may afford an opportunity for the registration of a trademark to be opposed. Article 16: Rights Conferred The owner of a registered trademark shall have the exclusive right to prevent all third parties not having the owner's consent from using in the course of trade identical or similar signs for goods or services which are identical or similar to those in respect of which the trademark is registered where such use would result in a likelihood of confusion.

In case of the use of an identical sign for identical goods or services, a likelihood of confusion shall be presumed. The rights described above shall not prejudice any existing prior rights, nor shall they affect the possibility of Members making rights available on the basis of use. Article 17:

Exceptions Members may provide limited exceptions to the rights conferred by a trademark, such as fair use of descriptive terms, provided that such exceptions take account of the legitimate interests of the owner of the trademark and of third parties. Article 18: Terms of Protection Initial registration, and each renewal of registration, of a trademark shall be for a term of no less than seven years. The registration of a trademark shall be renewable indefinitely.

Article 19: Requirement of Use. Use is required to maintain a registration, the registration may be cancelled only after an uninterrupted period of at least three years of non-use, unless valid reasons based on the existence of obstacles to such use are shown by the trademark owner. Circumstances arising independently of the will of the owner of the trademark which constitute an obstacle to the use of the trademark, such as import restrictions or other government requirements for goods or services protected by the trademark, shall be recognized as valid reasons for non-use. When subject to the control of its owner, use of a trademark by another person shall be recognized as use of the trademark for the purpose of maintaining the registration.

CONDITIONS FOR REGISTRATION AS A TRADEMARK As registration of a trademark is the principal way of obtaining trademark protection, a number of rules concern the conditions under which trademark registrations can be obtained, and mechanisms for facilitating t