



Chandrawat
& Partners

INTELLECTUAL PROPERTY RIGHTS IN INDIA

A brief guide on the intellectual property rights in India

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PREFACE



Intellectual Property Rights law means the rules and regulations authorized and formulated by the Government for the protection, recognition and preservation of intangible assets, which helps in the promotion and growth of the business. These laws are primary and ensure long-term security and protection to the business enterprise in maintaining a competitive edge. Intellectual Property Rights laws in India were a result of the Agreement on Trade-Related Aspects of Intellectual Property Rights ("TRIPS") agreement, which is an international legal agreement between all the member nations of the world and trade organizations for the protection of Intellectual property rights of the manufacturers and producers of the member nations.

Intellectual Property Rights law is divided into seven broad categories i.e. Trade Marks Act, 1999, The Patents Act, 1970 (amended in 2005), The Copyright Act, 1957, The Designs Act, 2000, The Geographical Indication of Goods (Registration and Protection) Act, 1999, The Protection of Plant Varieties and Farmers Rights Act, 2001 and The Information Technology Act, 2000.

These Acts protect different types of Intellectual Property recognized by the Government. The basic purpose of these laws is to recognize different types of Intellectual Properties and get them registered to the respective inventors/ innovators/ producers in their name. Further, these laws prohibit unjust i.e. without permission interference of others with the respective owner's Intellectual Property. India's consent to the World Trade Organization ("WTO") agreement has paved the way for its compliance with TRIPS.

TYPES OF INTELLECTUAL PROPERTY RIGHTS IN INDIA

Patent

A patent is used to prevent an invention from being created, sold, or used by another party without permission. Patents are the most common type of intellectual property rights that come to people's minds when they think of intellectual property rights protection.

A patent owner has every right to commercialize his/her/its patent, including buying and selling the patent or granting a license of the invention to any third party under mutually agreed terms.

Trademark

A trademark is a distinctive sign that allows consumers to identify the particular goods or services a company provides easily. Some examples include McDonald's golden arch, the Facebook logo and so on.

A trademark can come in the form of text, a phrase, symbol, sound etc. A trademark can protect a set or class of products or services. The trademark owner can be an individual, business organization, or any legal entity.

Copyright

Copyright (or author's right) is a legal term used to describe the rights that creators have over their literary and artistic works. Copyright does not protect ideas. Instead, it only covers "tangible" forms of creations and original work for example, art, music, architectural drawings etc.

The copyright owner has the exclusive right to sell, publish, and/or reproduce any literary, musical, dramatic, artistic or architectural work created by the author.

Trade Secret

Trade secrets are the secrets of a business. They are proprietary systems, formulas, strategies, or other confidential information and are not meant for unauthorized commercial use. This is a critical form of protection.

Although intellectual property rights may seem to provide a minimum amount of protection, when utilized wisely, they can maximize the benefit and value of an invention and enable world-changing technology.



APPLICABLE LAWS AND REGULATIONS



The Copyrights Act, 1957 (“Copyright Act”)

Copyright is a type of Intellectual property, which is used to provide protection and recognition to an original art form of work particularly music, movies, films, documentaries etc.

Copyright includes rights of reproduction, communication to the public, adaptation and translation of the work.

Copyrights are generally provided to writers, artists, designers, etc. which involves the production of some intangible assets stored in tangible mode.

The Trade Marks Act, 1999 (“Trade marks Act”)

This law deals with registration and protection against unjust interference with trademarks. Trademarks can be acquired either by their use in the course of trade in relation to certain goods and/ or services or by registration under the Trade Marks Act, of 1999. According to Section 2(1) of the Trade Marks Act, 1999, a ‘trademark’ means a mark which is capable of being represented graphically and capable of distinguishing the goods or services of one person from those of others, It may include the shape of goods or their packaging and combinations of colors.

The statutory source of the trademark registration scheme is the Trade Marks Act, 1999 along with the Trade Marks Rules, 2017.

The Patents Act, 1970 (“Patents Act”)

The Patents Act, of 1970 covers protection given to Patents, an Intellectual property right given to any invention in regard to any existing or new products. The Patents Act has been repeatedly amended in 1999, 2002, 2005 and 2006 respectively. The validity of a patent given to any product is 20 years and it is subject to renewal. In basic words, the patent provides the right of exclusive sale of the patented product to the registered party for a particular period of time.

The Design Act, 2000 (“Design Act”)

The Design Act, of 2000 primarily is made for the purpose of protecting invented or innovated two-dimensional or three-dimensional lines, patterns, shapes, designs and colors. The term ‘Design’ under Design Act is defined as :

“Features of shape, any configuration, pattern, ornament or composition of lines or colors which is applied in two dimensional or three dimensional or in both the forms using any process including manual, chemical or mechanical, separate or combined which in the finished article appeals to the eye.

The main objective behind the implementation of this act is to protect the original inventor of the design from intended or unintended usage without permission.



The Geographical Indications of Goods (Registration and Protection) Act, 1999 (“GI Act”)

As per the Section 2 (e) of the G.I. Act, 1999, Geographical Indication includes goods such as agricultural goods, natural goods or manufactured goods originating, or manufactured in the territory of a country, or a region or locality, where a given quality, reputation or other characteristics of such goods is essentially attributable to its geographical origin and in a case where such goods are manufactured.

The main objective behind this is to protect local producers or manufacturers of India who are not much informed regarding IPR laws from infringement of their brand marks. GI tag is given for the product range as a whole eg. Basmati Chawal.

REGISTRATION, RENEWAL AND TRANSFER OF INTELLECTUAL PROPERTY RIGHTS

How to Register Trademark ?

Step 1:- Trademark Search- This step involves doing research around the brand name or name that one wants to register as a trademark.

Step 2: Filing an Application- This step involves applying with the Trademark Registry Office.

Step 3: Examination Process- This step involves an examination of the application by the registrar and checking whether there is a repetition of the trademark or if there is any issue with further registration.

Step 4: Post Examination Procedures- In this step, a hearing takes place for the replies filed by the applicant as per Step 3 and if the examiner is fully satisfied he/she can accept the mark and forward it for publication in the Trademark Journal.

Step 5: Publication of the Trademark Application- After acceptance of the application, the trademark will be published in the Trademark Journal which will remain there for 4 months.

Step 6: Registration- the last step involves registration after receiving clearance from all the objections of the third parties by the concerned authorities.

How to Renew Trademark ?

Trademarks can be renewed by filing an application to the Registrar. Renewal can take place in two ways i.e. renewal as it is or renewal with alterations. The application for the renewal of a trademark is the form TM-R.

After filing the application the applicant has to follow the status of the application in case if any opposition is filed to the registration of the trademark. After the application's approval, the trademark will be published in the official gazette of the Trademark Journal.

How to Transfer trademark ownership ?

Transfer of trademark ownership is called Trademark Assignment. An Application is sent by the Assignor or Assignee or by both along with filing TM-P Form to the Registrar. All the necessary required documents are to be filed within 6 months from the date of acquisition of proprietorship. After acceptance, the applicant has to make an advertisement of transfer. After considering all the submitted documents Registrar will depending upon his/her own satisfaction approve the transfer of trademark ownership.

How to Register Copyright ?

The registration of the copyright involves the following process:-

Step 1:- Filing of copyright Application:- An application for registration of copyright has to be sent to the Registrar of Copyrights Office in the format of FORM IV. Every application has to be signed by the applicant as well as an Advocate in whose favour a Vakalatnama or a POA has been executed.

Step 2:- Issue of No.- The registrar will issue a no. after the registration and then there will be a waiting period of 30 days for all the objections to be raised.

Step 3:- if there is no objection found then the application will be checked and will be sent to the registrar for entry in the Register of Copyright.

Step 4:- Registration- In this step, after the hearing as per Step 3 takes place, in case of acceptance, registration will take place.

How to Renew Copyrights ?

The validity of most types of Copyrights is for 60 years from the inception or lifetime of the owner. Generally, Copyrights are not subject to renewal as per Indian laws.

How to Transfer Copyright ownership ?

The transfer of copyright ownership is called assignment of Copyright which involves the transfer of some or all of the rights to a licensee to utilize his work for financial benefits by the copyright owner or licensor. In Assignment, ownership vests with the licensee however in licensing, the ownership rights do not vest with the licensee.

An assignment of copyright is valid only if it is in writing and signed by the assignor or his duly authorized agent. The assignment of a copyright in a work should identify the work and specify the kind of rights assigned and the duration and territorial extent of such assignment.



How to Register Industrial Design ?

Step 1:- Application- An application for registration is made to the Controller of Designs.

Step 2:-Examination- In this step examination takes place as to whether the application and the documents satisfy the formal requirements, and whether such design as applied to an article is registrable, under the provisions of the Designs Act, 2000 and Designs Rules, 2001.

Step 3:- Formality Check- In this step formalities as per the provisions of the law takes place as to the checking under Step 2 of Examination.

Step 4:- Substantive Examination- Substantive examination is carried out.

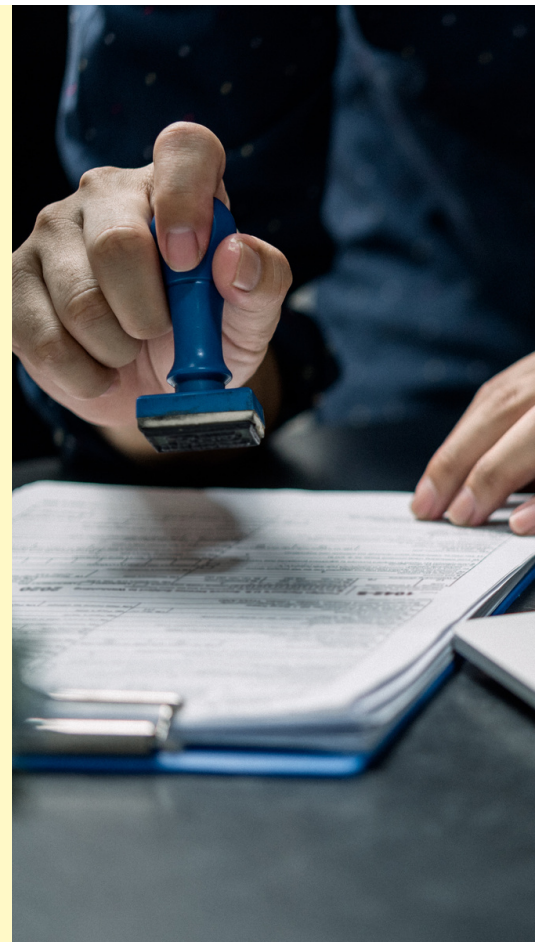
Step 5:- Consideration Of Report Of Examiner- the report of the examiner is considered for further registration of the design.

Step 6:- Registration- Once the approval is given, the registration takes place and the design is registered and published in the Patent Office Journal.

How to Renew Industrial Design ?

The validity of the Design is for 10 years from the date of Design registration. The renewal takes place for a time period of 5 years. An application should be filed before the Registrar as per Form-3 as prescribed under Rule 23 of the Design Rules, 2001. The Designs Wing is required to complete the proceedings of Renewal or extension of the Copyright of Designs, within one week from the date of receipt of Form-3.

The Design Wing, when it is satisfied that the application is filed within the time limit prescribed, will approve the application for Renewal or extension of Design. It needs to be entered in the Register of Designs regarding the renewal. Regarding renewal, it needs to be published in the Journal of Patent Office by the Design Wing.



How to Register Geographical Indications ?

Step 1:- Application for registration- The application for the registration of Geographical Indication shall be made in triplicate to one of the authorized centres for the registration of GI products.

Steps 2 and 3 – Preliminary Scrutiny and Examination- the application will be examined by the concerned authorities and in case of discrepancies; it will be informed to the applicant.

Step 4- Issue of Show Cause Notice- In case of any objection by the registrar, notice will be issued and the applicant must respond within a period of two months from the receiving of the notice.

Step 5: Opposition to Registration- the opposition can be filed within three months (extendable by another month on request, which has to be filed before three months).

Step 6- Corrections and amendments- Applicant will be supposed to make an amendment as per the decision made in the hearing and present the same to the concerned authority.

Step 7- Registration- If everything amendments are approved then registration takes place and the registrar shall then issue to the applicant a certificate

How to Renew Geographical Indications ?

The registration of a geographical indication is valid for a period of 10 years. A geographical indication can be renewed by making an application to the Registrar at the authority. During the processing of the application, the authorities will check its validity and whether to approve it or not. On successful approval, GI will get registered and get published in the gazette.

How to Transfer Geographical Indications ?

Assignment of Geographical Indication will have to be made in the name of assignees by the assignor. An application has to be made in this regard and then checking and evaluation will take place. After this the name of the assignee will be registered. Assignee's name must be entered in the Register of Geographical Indicators as there are registered owners for the Geographical Indication.

DISPUTE RESOLUTION MECHANISMS

Despite the best of efforts, intellectual property disputes unfortunately can and do arise. Such disputes can include infringements of IP rights by third parties or third parties alleging that there has been an infringement upon their IP rights. Both cases can potentially result in legal proceedings, demands to cease using the IP asset and/or compensation of payments.

Arbitration

In an arbitration procedure, all parties agree to submit the dispute to one or more arbitrators who then make a binding decision on the dispute.

The arbitration procedure is private and less formal than court proceedings. An award of damages obtained through arbitration is also more easily enforceable internationally than an award through national court proceedings.

Mediation

In a mediation procedure a neutral intermediary, the mediator, helps the parties to reach a mutually satisfactory settlement. Any settlement is recorded in an enforceable contract.

An advantage of mediation is that parties retain control of the dispute resolution process. This can help to preserve good business relations with the other parties involved.

ADR in IP Disputes in India:

The arbitrability of substantive IP laws claims in India is not well settled. When the Arbitration and Conciliation Act 1996 was enacted the use of arbitration in resolving IP dispute's was not anticipated. The Arbitration and Conciliation Act 1996 as well as various IP Acts are silent regarding the enforceability of arbitral awards involving the findings of IP validity or infringement. Section 103 of the Patents Act, which is applicable in cases where the government wishes to use a patented invention, includes a clause that permits the court to refer any issue (including questions of patent validity) to arbitration.

However, there are no recorded decisions of Indian courts concerning the objective arbitrability of substantive IP law. The Indian judiciary has effectively tried to bring mediation and settlement for intellectual property disputes in the traditional model of litigation, through the reading of Section 89 of the Civil Procedure Code, 1908. Even where the alternative dispute resolution methods fails to be the effective choice for the determination of disputes related to intellectual property rights, they can be used for narrowing down the issues for contestability in a traditional model of litigation.



Patent Law and Alternative Dispute Resolution

As the patent disputes involve an understanding of technical knowledge related to the dispute in question, the biggest hurdle, which the Indian Courts face, is with respect to streamlining the trial of the dispute in a cost effective and prompt manner. Every dispute in the domain of patent law in India has revolved around the nitty-gritty of interim injunctions and the appeals related to those injunctions.

In fact many countries have endorsed the inclusion of arbitration as a model for the resolution of patent disputes. The Patent Act, 1970 particularly under section 103 of the Act makes use of arbitration as a procedure for resolution of disputes. Closer integration of alternate dispute resolution mechanisms in patent infringement suits could be the way forward for appropriate dispensation of justice.

Trademarks and Alternative Dispute Resolution

In India, trademark litigation covers an overwhelming landscape in the intellectual property related litigation. The trademark litigation is an inter parties adjudication. That being the case, the modes of alternative dispute resolution can certainly provide an appropriate recourse to the ailing judiciary.

Moreover, in cases of cybersquatting, arbitration plays an eminent role in the streamlined procedure outlined under the Uniform Domain Name Dispute Resolution Policy, 1999 and the Indian Domain Name Dispute Resolution Policy for the adjudication of disputes. This brings to forefront the importance of arbitration and the use of other alternate dispute resolution measures for reconciliation of the interests of the trademark owner and the impugned party.

HOW CAN WE HELP?



We provide assistance in the proper identification of Intellectual property, background research required, procurements of necessary documents for proof of identity, facilitating related transactions and IP litigation.

- In case of a dispute between an applicant for registration and any third party, we provide assistance for litigation and help in collecting evidence.
- Our team has the required expertise to help startups, middle-class producers, etc., achieve a competitive edge by registering their Intellectual assets in the most economical and convenient manner.
- Our advice is sought for matters related to privacy and new registrations.
- Being active in corporate and commercial law practice, our advice is sought to ensure holistic support for business entities.
- Our team is well equipped with all the expertise and technical aspects which helps in avoiding legal troubles, which can be faced, while registration.
- It is ensured that in case of infringement of IPR of their clients, all the necessary legal support is provided on time.

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Key Contact



Surendra Singh Chandrawat

Managing Partner

✉ surendra@chandrawatpartners.com

Connect Surendra on

[LinkedIn](#)

[WhatsApp](#)

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