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India

INTELLECTUAL PROPERTY

Contributor

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This country-specific Q&A provides an overview of intellectual property laws and regulations applicable in India.

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INDIA

INTELLECTUAL PROPERTY



1. What different types of intellectual property rights exist to protect: (a) Inventions (e.g. patents, supplementary protection certificates, rights in trade secrets, confidential information and/or know-how); (b) Brands (e.g. trade marks, cause of action in passing off, rights to prevent unfair competition, association marks, certification marks, hallmarks, designations of origin, geographical indications, traditional speciality guarantees); (c) Other creations, technology and proprietary interests (e.g. copyright, design rights, semiconductor topography rights, plant varieties, database rights, rights in trade secrets, confidential information and/or know-how).

India set forth a dynamic and progressive Intellectual Property (IP) Regime which is largely codified in different IP statutes, and is further supplemented with the application of the UK common law. The statutes mostly originate from the UK laws considering that India was a British colony, pre independence (pre 1947). Interpretation of the statutes by the courts is also indispensable for a complete understanding of the Indian Intellectual Property law.

(a) For Invention patents, the Patents Act, 1970 and the rules framed thereunder is the appropriate law. But, there is no specific IP legislations for trade secrets, confidential information and know-how. India does not have any law for granting of supplementary protection certificates.

Although, for trade secrets, confidential information and know-how, the Hon'ble High Court of Delhi, had in John Richard Brady v. Chemical Process Equipment P. Ltd., AIR 1987 Del 372 taken judicial notice of the observations of the Royal Privy Council in Saltman's case (1948-65 RPC 203) and had approved that in light of established rules making up the law of trade secrets.

These rules may, according to the circumstances in any given case, either rest on the (1) principles of equity, or by (2) the common-law action for breach of confidence which is in effect a breach of contract. The cognizance of the definition of trade-secrets as in the Black's Law Dictionary was thereafter adopted by Hon'ble High Court of Calcutta in Tata Motors Limited vs. State of West Bengal, 2010 SCC Online Cal 55. In addition to the above common law protection, the Indian Contract Act, 1872 may be utilised for taking actions for breach of contract.

(b) For Brands (trade mark, cause of action in passing off, rights to prevent unfair competition, association marks, certification marks, hallmarks, designations of origin), the Trade Marks Act, 1999 and the Rules framed thereunder is the appropriate law. In addition, the common law provisions of passing off and the Competition Act, 2002 also provide additional remedies. For Geographical indications, the Geographical Indications of Goods (Registration and Protection) Act, 1999 and the rules framed thereunder is the appropriate law. Traditional speciality guarantees do not have any separate law.

(c) For Other creations, technology and proprietary interests (e.g. copyright, design rights, semiconductor topography rights, plant varieties, database rights, rights in trade secrets, confidential information and/or know-how), the following laws are available.

(i) Copyright Act, 1957 (includes protection on database or software);

(ii) Designs Act, 2000;

(iii) Semi-conductor Integrated Circuits Layout-Design Act, 2000;

(iv) Protection of Plant Varieties and Farmers' Rights Act, 2001;

Trade secrets, confidential information and/or know-how have been dealt above.

2. What is the duration of each of these intellectual property rights? What procedures exist to extend the life of registered rights in appropriate circumstances?

The duration of protection accorded are enumerated below:

- Protection under Patents Act, 1970 – 20 years from the date of application, renewal fees however, are required to be paid in respect of every year from the 3rd year onwards until the 20th year;
- Protection under Trade Marks Act, 1999 – 10 years from the date of application and may be renewed every ten years for perpetuity.
- Protection under Geographical Indications of Goods (Registration and Protection) Act, 1999 – 10 years from the date of application and may be renewed every ten years for perpetuity.
- Protection under Copyright Act, 1957 – For literary, dramatic, musical and artistic work, protection subsists for the lifetime of the author and until 60 years from the beginning of the calendar year next following the year in which the author dies. But, for any anonymous or pseudonymous publications, and for all other works such as sound recordings, cinematograph films etc., protection subsists for 60 years from beginning of the calendar year next following the year in which the work is published.
- Protection under Designs Act, 2000 – 10 years from date of application, and may be renewed for a further period of 5 years.
- Protection under Semi-conductor Integrated Circuits Layout-Design Act, 2000 – 10 years from the date of filing an application for registration or from the date of first commercial exploitation anywhere in India or in any country, whichever is the earlier date.
- Under Protection of Plant Varieties and Farmers' Rights Act, 2001 – A certificate of registration is valid for 9 years in the case of trees and vines, and 6 years in the case of other crops, from the date of issuance. However, this may be reviewed and renewed for the remaining period on payment of prescribed fees, and validity may be extended. The total period of protection cannot exceed – 18 years from the date of registration for trees and vines, 15 years from the date of the notification by the Central

Government under section 5 of the Seeds Act, 1966 for an extant variety, 15 years from the date of registration in other cases.

Excluding the rights in a Trade Mark and Geographical Indication which are capable of protection for perpetuity subject to timely renewals, there is no procedure to extend the life of the other IP rights mentioned above.

3. Who is the first owner of each of these intellectual property rights and is this different for rights created in the course of employment or under a commission?

First Owner:

- In case of statutory rights such as Patents, Designs, Geographical Indications, Plant Varieties, Semi-conductor Integrated Circuits Layout-Design, the first owner is normally the Applicant of such works before the relevant IP office. The Applicant may for e.g. in case of a patent be the inventor(s) itself and in case the Applicant is other than the inventor then the assignee of such inventor(s).
- In case of Trade Mark, the first and rightful owner is considered to be the first adopter and user of a trade mark.
- In case of a Copyright, the author of the copyrighted work is the first owner. In case, a copyright is registered, then it shifts to the registered proprietor.

Consequence of employment or commission:

Depending on the nature of the contract, an employer may become owner of works created during the course of employment and using the resources of the employer. The determination has to be interpreted on a case to case basis.

4. Which of the intellectual property rights described above are registered rights?

Out of the aforesaid 7 IP rights, five including Patents, Designs, Geographical Indications, Plant Varieties, Semi-conductor Integrated Circuits Layout-Design, can be termed as registered rights. For Trade Marks, while registration is recommended, it is a settled position prior use of a trade mark in India accords rights in common law which is considered superior to registration. Therefore, Trade Marks may be termed as a partial registered right. The registration of a copyright is optional.

5. Who can apply for registration of these intellectual property rights and, briefly, what is the procedure for registration?

Who can apply?

For Patents, Trade Marks, Designs, Copyright, Plant Varieties, Semi-conductor Integrated Circuits Layout-Design – Any individual, legal entity or other organisation can apply for registration of the aforesaid Intellectual Property rights. However, in case of a copyright application, if such application is filed by an author, then it can be only filed by an individual since an author can only be an individual person.

For Geographical Indications – Any association of persons or producers or any organization or authority established by or under any law for the time being in force representing the interest of the producers of the concerned goods, can apply.

Procedure for Registration:

The procedure for registration involves filing an application with the concerned IP Office, followed by an examination stage and a journal advertisement stage. The following flow charts / step by step guides of the Indian IP offices may be referred for a ready understanding:

Patents:

https://ipindia.gov.in/writereaddata/Portal/News/237_1_Patent_FlowChart_09June2016.pdf

Trade Marks

<http://www.ipindia.nic.in/workflow-chart.htm>

Designs

http://www.ipindia.nic.in/writereaddata/Portal/News/238_1_Design_FlowChart_09June2016.pdf

Copyright

<https://copyright.gov.in/frmWorkFlow.aspx>

Geographical Indications

<https://ipindia.gov.in/the-registration-process-gi.htm>

Plant varieties

<http://www.plantauthority.gov.in/rp2.gif>

Semi-conductor Integrated Circuits Layout Designs

<http://sicldr.gov.in/faq>

6. How long does the registration procedure usually take?

In straightforward cases (these are estimates)

Sl. No.	Type of IP	Approximate Duration
1.	Patents	About 3 – 5 years
2.	Trade Marks	About 6 – 12 months
3.	Geographical Indications	Anywhere between 2 to 3 years
4.	Copyright	About 4 –10 months
5.	Designs	About 4 –10 months
6.	Plant Varieties	About 2 years
7.	Semi-Conductor Integrated Circuits Layout-design	The number of registrations have been few and thus difficult to provide an estimate

However, there is no specified time-frame for completion of registration procedure, and the process of registration may range from a couple of months to a couple of years or more, depending on any objections or oppositions which may arise in a particular case.

7. Do third parties have the right to take part in or comment on the registration process?

Yes, for six of the aforesaid IP rights, i.e., Patents, Trade Marks, Geographical Indications Plant Varieties, Semi-conductor Integrated Circuits Layout-Design, Copyright.

No for Designs

Sl. No.	Type of IP	Third-parties right to take part	Stage
1.	Patents	YES	Pre-grant opposition proceedings after Journal Publication
2.	Trade Marks	YES	Opposition after Journal Advertisement, and within four months from the date of advertisement
3.	Geographical Indications	YES	Opposition after Journal Advertisement, and within three months from the date of advertisement
4.	Copyright	YES	The application is listed in the monthly journal. Objection may be filed within 30 days.
5.	Designs	NO	Only cancellation action is possible after registration.
6.	Plant Varieties	YES	Opposition after Journal Advertisement, and within three months from the date of advertisement
7.	Semi-Conductor Integrated Circuits Layout-design	YES	Opposition after Journal Advertisement, and within three months from the date of advertisement

8. What (if any) steps can the applicant take if registration is refused?

In such a case, an Applicant is entitled to file an Appeal. The law for Appeals has undergone abrupt change in April 04, 2021 with promulgation of the Tribunals Reforms (Rationalisation and Conditions of Service) Ordinance, 2021, which was a temporary measure by the Government, until the The Tribunals Reforms Act, 2021, which is an Act of the Indian Parliament came into force. As it stands the Intellectual Property Appellate Board (IPAB) in India is abolished and all appeals in case of Patents, Trade Marks, Geographical Indications, Plant Varieties is required to be filed before the High Court of the concerned jurisdiction. In case of Designs, the appellate forum has always been the High Court of the concerned jurisdiction. For Copyrights, one has a choice to approach either the Commercial Court or Commercial Division of a High Court. Some High Courts have constituted a specific Intellectual Property Division (IPD) within the Commercial Division of the High Court with IPD Rules governing the procedure in addition to that under the respective IP laws. While some High Court deal with the same under the general Rules of the High Court governing the procedure of Appeals in addition to that under the respective IP laws. For Semi-conductor Integrated Circuits Layout-Design, the appeal is required to be filed before the Layout-Design Appellate Board, although the same is not yet in place and thus legal remedies under the Constitution of India may be sought until such Layout-Design Appellate Board is operational.

9. What are the current application and renewal fees for each of these intellectual property rights?

The prescribed application and renewal fees (as of June 2021) are enumerated below:

Patents Act, 1970 -

Application Fees:

For Application Stage (up to 30 pages and 10 claims. Additional fees payable for extra pages and claims)

For Individual: ₹1600/-

For Small Entity: ₹4000/-

For others: ₹8000/-

For Requesting Examination

For Individual: ₹4000/-

For Small Entity: ₹10000/-

For others: ₹20000/-

Renewal Fees:

For Online Renewal Payment

3rd year: Individual ₹800; Small Entity ₹2000; Other ₹4000.

4th year: Individual ₹800; Small Entity ₹2000; Other ₹4000.

5th year: Individual ₹800; Small Entity ₹2000; Other ₹4000.

6th year: Individual ₹800; Small Entity ₹2000; Other ₹4000.

7th year: Individual ₹2400; Small Entity ₹6000; Other ₹12000.

8th year: Individual ₹2400; Small Entity ₹6000; Other ₹12000.

9th year: Individual ₹2400; Small Entity ₹6000; Other ₹12000.

10th year: Individual ₹2400; Small Entity ₹6000; Other ₹12000.

11th year: Individual ₹4800; Small Entity ₹12000; Other ₹24000

12th year: Individual ₹4800; Small Entity ₹12000; Other ₹24000

13th year: Individual ₹4800; Small Entity ₹12000; Other ₹24000

14th year: Individual ₹4800; Small Entity ₹12000; Other ₹24000

15th year: Individual ₹4800; Small Entity ₹12000; Other ₹24000

16th year: Individual ₹8000; Small Entity ₹20000; Other ₹40000

17th year: Individual ₹8000; Small Entity ₹20000; Other ₹40000

18th year: Individual ₹8000; Small Entity ₹20000; Other ₹40000

19th year: Individual ₹8000; Small Entity ₹20000; Other ₹40000

20th year: Individual ₹8000; Small Entity ₹20000; Other ₹40000

For Offline Renewal Payment

10% of the above stated fees plus the above fees.

May refer –

http://ipindia.gov.in/writereaddata/Portal/IPOFormUpload/1_11_1/Fees.pdf

Trade Marks Act, 1999 –

Application Fees (per class and per trade mark):

For Individual / Start-up / Small Enterprise: ₹4500/- (online application) and ₹5000/- (offline application)

For others: ₹9000/- (online application) and ₹10000/- (offline application)

Renewal Fees (per class and per trade mark) : ₹9000/- (online application) and ₹10000/- (offline application)

May refer – <https://ipindia.gov.in/form-and-fees-tm.htm>

Geographical Indications of Goods (Registration and Protection) Act, 1999–

Application Fees (per class and per trade mark): ₹5000/-

Renewal Fees (per class and per trade mark): ₹3000/-

May refer – <https://ipindia.gov.in/fees-gi.htm>

Copyright Act, 1957 –

Application Fees:

₹500/- per work for literary (not capable of being used in relation to goods and services), dramatic, musical and artistic work (not capable of being used in relation to goods and services).

₹2000/- per work for literary or artistic work capable of being used in relation to goods and services.

₹5000/- per work for cinematograph film.

₹2000/- per work for sound recording.

Renewal Fees: Not applicable

May refer –

<https://copyright.gov.in/frmFeeDetailsShow.aspx>

Designs Act, 2000 –

Application Fees:

For Individual: ₹1000/-

For Small Entity: ₹2000/-

For others: ₹4000/-

Renewal Fees (after 10 years, for five year further extension):

For Individual: ₹2000/-

For Small Entity: ₹4000/-

For others: ₹8000/-

May refer – <https://ipindia.gov.in/rules-designs.htm>

Semi-conductor Integrated Circuits Layout-Design Act, 2000 –

Application Fees: ₹5000/-

Renewal Fees: Not applicable

May refer – <http://sicldr.gov.in/faq>

Protection of Plant Varieties and Farmers' Rights Act, 2001 –

Application Fees:

For Individual: ₹7000/-

For Educational: ₹10000/-

For Commercial: ₹50000/-

There is however no fee for application of a farmer's variety, and for any Extant variety notified under section 5 of Seeds Act, 1966, the application fee is ₹2000/- for all.

Renewal Fees (Per year):

Farmers- Nil

Individual – Rs. 7,000/-

Educational- Rs 10,000/-

Commercial – Rs. 80,000/-

There is also an annual fee for new variety and extant variety of ₹2000/- and for famer's variety the annual fee is ₹10/-.

May refer –

<http://www.plantauthority.gov.in/registrationfees.htm>

10. What are the consequences of a failure to pay any renewal fees and what (if any) steps can be taken to remedy a failure to pay renewal fees?

In case of the IP rights of Patents, Trade Marks, Designs, Geographical Indications, Plant Varieties, Semi-conductor Integrated Circuits Layout-Design, the failure to pay renewal fees result in an abandonment or lapse in rights. Copyright, on the other hand, requires no renewal at all.

Yes, in case of a failure to pay a renewal fees on time, there are provisions for limited extension of time and thereafter restoration on payment of surcharge fees as applicable however within the prescribed time period which period is generally about one year from the renewal expiry date. For patents, the period for making such an application for the restoration of the patent is eighteen months from the date on which the patent ceased to have effect.

11. What are the requirements to assign ownership of each of the intellectual property rights described above?

Out of the seven categories of IP rights mentioned above, Geographical Indications are expressly prohibited from assignment. All other IP rights, i.e., Patents, Designs, Trade Marks, Plant Varieties, Semi-conductor Integrated Circuits Layout-Design, Copyright may be lawfully assigned. The requirements of assignment may be classified into (1) common requirements; and (2) special requirements.

Common Requirements

An assignment in India has to be in writing and in addition comply with the requirements laid down under the provisions of the Indian Contract Act, 1872.

Therefore, the following are common requirements:

1. The Assignment needs to expressly identify the IP right being assigned;
2. The Assignment needs to specify the duration and territorial extent of such assignment;
3. The Assignment must clearly specify all terms and conditions governing the rights and obligations (as may be applicable);
4. The Assignment must specify the amount of consideration payable to the Assignor;

Special Requirements

(a) For Trade Marks:

- i. Restriction on assignment or transmission where multiple exclusive rights would be created;
- ii. Restriction on assignment or transmission where exclusive rights would be created in different parts of India;
- iii. A certification trade mark cannot be assigned except with the consent of the Trade Marks Registrar;
- iv. An associated trade mark is assignable and transmissible only as a whole and not separately, subject to the provisions of the Trade Marks Act, 1999;

An application is required to be made before the Trade Marks Registrar for recordal of such assignment on the Trade Marks Register.

(b) For Patents:

- i. An application is required to be made before the Controller of Patents for recordal of such assignment on the Patents Register.

(c) For Semi-conductor Integrated Circuits Layout-Design:

- i. An application is required to be made before the Registrar for recordal of assignment on Semi-conductor Integrated Circuits Layout-Design Register.

(d) For Copyrights:

- i. In case, the period of assignment is not stated in the assignment, the assignment is deemed to be five years from the date of assignment;
- ii. In case, the territorial extent of assignment of the rights is not specified in the assignment, the assignment is presumed to extend within India;
- iii. The assignment cannot be contrary to the terms and conditions of the rights already assigned to a copyright society in which the author is a member;
- iv. The assignment of copyright in any work to make a cinematograph film cannot affect the right of the author of the work to claim an equal share of royalties and consideration payable in case of utilisation of the work in any form other than for the communication to the public of the work, along with the cinematograph film in a cinema hall;
- v. The assignment of copyright in any work to make a sound recording which does not form part of any cinematograph film cannot affect the right of the author of the work to claim an

equal share of royalties and consideration payable for any utilization of such work in any form.

12. Is there a requirement to register an assignment of any of these intellectual property rights and, if so, what is the consequence of failing to register?

Yes, for Patents, Trade Marks, Semi-conductor Integrated Circuits Layout-Design, there is a requirement to register an assignment with the concerned IP office. A failure to comply with such provision renders the assignment ineffective. Even Courts have held that the validity of assignment agreement as evidence will be recognised only post the registration/recordal of such document with the IP office. A delay by the IP office in recordal may not be detrimental to the proprietor, however, the request for recordal must be made in a timely manner. In case of Designs, Copyrights and Plant Varieties, it is not compulsory to record an assignment with the concerned IP office.

13. What are the requirements to licence a third party to use each of the intellectual property rights described above?

Out of the seven categories of IP rights mentioned above, Geographical Indications are expressly prohibited from licensing. The other IP rights, i.e., Patents, Designs, Trade Marks, Plant Varieties, Semi-conductor Integrated Circuits Layout-Design, Copyright may be lawfully licensed. The requirements of a valid license is also required to comply with the following common requirements in accordance with the Indian Contract Act, 1872:

1. The License needs to expressly identify the IP right being licensed;
2. The License needs to specify the duration and territorial extent of such license;
3. The License must clearly specify all terms and conditions governing the rights and obligations (as may be applicable);
4. The License must specify the amount of royalty payable to the Assignor;
5. The License must specify the duration of such License;

However, a license must be in writing for effectuating benefits under IP law.

14. Is there a requirement to register a licence of any of these intellectual property rights and, if so, what is the consequence of failing to register?

In case of patents, recordal of a license is necessary. However, in the case of a licence granted under a patent, the patentee or licensee may also request the Controller to take steps for securing that the terms of the licence are not disclosed to any person except under the order of a Court. Even Courts have held that the validity of a license agreement as evidence will be recognised only post the registration/recordal of such document with the IP office.

For Trade Marks, Semi-conductor Integrated Circuits Layout-Design and Plant Varieties, while there is no mandatory requirement for recording a license, and a non-recordal does not influence effectiveness of a license contract, there are provisions for recording a licensee as a Registered User [referred as Registered Licensee for Plant Varieties], and such recordal provides certain further rights such as the right to proceed against infringement of the IP right in the own capacity as the Registered User.

For Designs, while there is a provision for recordal of a licensee, the same is optional and a non-recordal does not influence effectiveness of a license contract.

For Copyrights, there is no requirement for recordal of a license.

15. Are exclusive and non-exclusive licensees given different rights in respect of the enforcement of the licensed IP, and if so, how do those rights differ?

The aforesaid Acts generally do not expressly make any distinction between the rights of exclusive and non-exclusive licensees. Under the Patents Act however, the holder of an exclusive license shall have the like right as the patentee to institute a suit in respect of any infringement of the patent. Ordinary licensees do not have right to institute a suit for infringement of patent.

16. Are there criminal sanctions for infringement of any intellectual property rights, and if so, what are they and how are they invoked?

Criminal sanctions against infringement of intellectual property rights is only provided for Copyrights, Trade Marks and Semi-conductor Integrated Circuits Layout-

Designs.

a) Section 63 of the Copyright Act, 1957 provides for punishment of any person who knowingly and wilfully infringes a copyright with imprisonment for a term not less than six months and which may extend up to 3 years, and of fine not less than ₹50000/- which may extend up to ₹200000/-. Section 63A provides enhanced penalties on second or subsequent convictions.

b) Section 103 of the Trade Marks Act, 1999 provides for punishment of any person who knowingly and wilfully falsifies or falsely applies a trade mark with imprisonment for a term not less than six months and which may extend up to 3 years, and of fine not less than ₹50000/- which may extend up to ₹200000/-. Section 105 provides enhanced penalties on second or subsequent convictions.

c) Section 56 of the Semi-conductor Integrated Circuits Layout-Design Act, 2000 provides for punishment of any person who knowingly and wilfully infringes a layout-design with imprisonment for a term which may extend up to 3 years, and of fine not less than ₹50000/- which may extend up to ₹1000000/-, or with both.

Criminal cases are commenced in India with the filing of an FIR (First Information Report) with the police station.

17. What other enforcement options are available for each of the intellectual property rights described above? For example, civil court proceedings, intellectual property office proceedings, administrative proceedings, alternative dispute resolution.

Yes, all of these proceedings, namely, Civil court proceedings, IP office proceedings, administrative proceedings including customs seizure actions etc., alternative dispute resolution mechanisms are available. In addition, in case of a trade mark, domain dispute proceedings and passing off proceedings under common law are also available. However, customs enforcement is not available for patents.

18. What is the length and cost of such procedures?

The length and cost of such procedures depend on the complexity and the issues raised in a case and also the backlog of the relevant judicial fora. Generally, in Indian Courts while interim remedies are often achieved within a couple of months to a year, the final disposal of the

matter takes several years.

19. Where court action is available, please provide details of which court(s) have jurisdiction, how to start proceedings, the basics of the procedure, the time to trial, the format of the trial, the time to judgment and award of relief and whether any appeal is available.

The Indian judiciary is a three-tier system with hundreds of district courts hearing cases in the first instance, and with 25 High Courts, and one Supreme Court at the apex. The Supreme Court is the court of final appeal located in New Delhi, India. The High courts are the highest judicial bodies in a state and there is one High Court for each state in India (some High Courts are shared by small states) and these Courts have superintendence over all courts and tribunals within their territorial jurisdiction.

(i) Courts :

The Commercial Courts Act, 2015 at present provides the Courts of Jurisdictions in India for intellectual property rights relating to registered and unregistered trademarks, copyright, patent, design, domain names, geographical indications and semiconductor integrated circuits. Under such Act, commercial benches have been set up across the country. A court action is to be initiated before the concerned commercial court having jurisdiction over the subject matter or over the place of infringement. Sometimes, pecuniary value determines jurisdiction.

In case of Plant varieties, the court action is to be initiated before the District Court having jurisdiction over the subject matter or over the place of infringement. Sometimes, pecuniary value determines jurisdiction,

(ii) How to start proceedings and basics of procedure:

In India, proceedings before the Hon'ble Court is commenced by filing, with the necessary court fees, a plaint which contains the written case of the aggrieved party. A plaint is normally accompanied with a petition for interim reliefs.

The matter is thereafter listed before the Hon'ble Court on a specified date or dates. The Hon'ble Court may pass ad-interim reliefs based on the petition, and then summon the other side to appear before it and/or may some the other side and hear their case and then pass interim reliefs based on the petition.

Once the interim stage is complete, the matter may be either fixed for summary proceedings or for an elaborate judicial trial. All the above proceedings are conducted as per the Code of Civil Procedure, 1908.

(iii) Time to trial:

A trial commences, on conclusion of the interim proceedings, and in the absence of an application of summary proceedings or on any refusal of such application for summary proceedings by the Hon'ble Court. A trial may take few months to several years depending on the number of issues or witnesses or documents involved.

(iv) Format of Trial:

In India, trial consists of providing evidence which is governed by the provisions of the Indian Evidence Act, 1872. The evidence is basically two kinds [which may also include witness or documents signed by experts]:

- Documentary Evidence;
- Oral evidence by witness;

The evidence is required to be given on the issues framed by the court with the help of both parties, after the admission and denial of documents. The issues also indicate as to which party has the onus of proof to establish which issue.

(v) Time of Judgment or Award of Relief

A judgment is delivered in open Court and may take a few years from the date of filing of the plaint to be delivered.

(vi) Appeal

An appeal may be preferred before the Commercial Appellate Division of the High Court of the concerned State for intellectual property rights relating to registered and unregistered trademarks, copyright, patent, design, domain names, geographical indications and semiconductor integrated circuits, and normal civil appellate bench of the High Court for plant varieties. A further appeal from the order of the High Court may be preferred before the Supreme Court.

20. What customs procedures are available to stop the import and/or export of infringing goods?

The procedures for customs enforcement are under the Customs Act, 1962 and the Rules made thereunder. The same is only in respect of import of infringing goods.

The IP rights holder will have to file separate applications for its respective trademark, design, copyright and geographical indication along with the registration certificates. The IP Right holder need not have to file multiple applications for different ports as a single application covers multiple ports. Patent rights have been excluded in 2018 from customs enforcement (administrative enforcement).

The procedure of seizure of suspected infringing good and disposal of infringing goods is set-out in the Intellectual Property Rights (Imported Goods) Enforcement Rules, 2007 [as amended from time to time]

21. Are any non-court enforcement options or dispute resolution mechanisms mandatory in respect of intellectual property disputes in any circumstances? If so, please provide details.

The Commercial Courts Act, 2015 requires parties to resort to alternative dispute resolutions prior to court proceedings. However, the same is optional since there are provisions for craving leave before the Hon'ble Court for direct adjudication of the matter by the Hon'ble Court, bypassing alternate dispute resolution requirement.

22. What options are available to settle intellectual property disputes in your jurisdiction?

1. Cease & Desist Notice and undertaking;
2. Court Action;
3. Out of Court Settlements;
4. Alternative Dispute Resolution such as arbitration, mediation etc.

23. What is required to establish infringement of each of the intellectual property rights described above? What evidence is necessary in this context?

A proof of violation of the exclusive right conferred by an intellectual property is required to establish an infringement of such Intellectual Property Right.

24. How does the court acquire any necessary information (fact or technical) and in what circumstances does it do so? In

particular a) Is there a technical judge, a judge with technical experience, a court appointed expert, an expert agreed by the parties, and/or parties' expert witness evidence? b) What mechanisms are available for compelling the obtaining and protecting of evidence? Is disclosure or discovery available?

a) No, there is no technical judge or judge with technical experience before the High Courts or Commercial Courts. However, determinations of IP matters are normally entrusted with Justices/Judges who have an expertise in such field of law.

However, the Hon'ble Courts are vested with immense inherent powers and may appoint any expert or may accept any expert agreed by the parties or may accept expert witness evidence of a party as per its own discretion. For matter such as patents, it is advisable to provide expert's opinion as an opinion or witness for all.

Pertinently, Section 115 of the Patents Act, 1970 also provides that in any suit for infringement or other proceedings under the said Act, the Hon'ble Court may appoint an independent scientific adviser to assist itself and/or to inquire and report upon any such question of fact or opinion that does not involve a question of interpretation of law, as it may formulate for the purpose.

b) In India, the provisions for discovery are laid down under Order XI Rules 1 and 2 of the Code of Civil Procedure 1908, but the same is possible only after a suit has been filed and an application to that effect is made in such suit. In such discovery orders, there may be interrogatories appointed for discovery with the leave of the court, for such examination and discovery from the other side.

In addition, the Hon'ble Courts in India have often used Anton Piller orders where in case of imminent threat of destruction or removal of an infringing material, a party in a civil suit may seek detention, preservation, inspection of any property that forms the subject matter of the suit. In this situation, the Hon'ble court may authorise a person, which is generally a court commissioner appointed for the purpose, and who is allowed to visit the Defendant's premises, and cause search and seize the infringing goods or to take samples that may be necessary for the purpose of obtaining full information or evidence.

It is pertinent to mention that Indian Courts have also issued Norwich Pharmacal orders in some cases where

information or documentation is sought from a third party (such as customs and excise authorities) that may be in a position to assist the court in the Intellectual Property suit.

25. How is information and evidence submitted to the court scrutinised? For example, is cross-examination available and if so, how frequently is it employed in practice?

The Hon'ble Courts scrutinise documents in the individual capacity of the Hon'ble Judge and the Hon'ble Judge is empowered to take assistance from any expert, if necessary.

Cross-examination of a witness in a trial is extremely common and is a mandatory legal right given to the other side.

26. What defences to infringement are available?

There are several defences available for each of the IP rights:

Under Patents Act, 1970 –

- Lack of Novelty in the patented invention;
- Obviousness in the patented invention;
- Lack of inventive Step in the patented invention;
- New form of known substance in the patented invention;
- Anticipation through prior publication/prior claiming of the patented invention
- Absence of therapeutic efficacy in the patented invention;
- Incapability of industrial application of the patented invention;
- Dissimilarity of the competing inventions;
- Latches;
- Estoppel; etc.

Under Trade Marks Act, 1999 –

- Dissimilarity of the competing marks;
- Dissimilarity of the competing goods or services;
- Prior adoption of the Defendant's mark;
- Prior use of the Defendant's mark;
- Latches;
- Estoppel; etc.

Under Geographical Indications of Goods (Registration

and Protection) Act, 1999 –

- That the Geographical Indication was not registrable under this Act;
- Laches;
- Estoppel;

Under Copyright Act, 1957 –

- Dissimilarity of the competing works;
- Lack of originality in the copyrighted work;
- Prior publication of the copyrighted work
- Laches;
- Estoppel;

Under Designs Act, 2000 –

- Prior publication of the design protected;
- The design protected is not a new or original design;
- The design protected is not significantly distinguishable from known designs or combination of known designs;
- The design protected is per se registered as a trade mark, and is not a design as defined under the provisions of the Act;
- The design protected is not a design registrable under the Act;
- Laches;
- Estoppel; etc.

Under Semi-conductor Integrated Circuits Layout-Design Act, 2000 –

- The registered work is not original;
- The registered work is not distinctive;
- The registered work is not capable of being distinguished from any other registered layout-design;
- The registered work had been commercially exploited 2 years immediately prior to the date of application;
- Laches;
- Estoppel;

Under Protection of Plant Varieties and Farmers' Rights Act, 2001

- That the plant variety was not registrable under this Act;
- Laches;
- Estoppel;

27. Who can challenge each of the intellectual property rights described

above?

Any individual, company, partnership or any other legal entity may challenge the intellectual property rights described in Section A above. The person must be an interested party such as an aggrieved party in cancellation / revocation proceedings of a registered IP.

28. When may a challenge to these intellectual property rights be made (e.g. during any registration process or at any time during the subsistence of the right)?

As stated above, for six of the aforesaid IP rights, i.e., Patents, Trade Marks, Geographical Indications, Plant Varieties, Semi-conductor Integrated Circuits Layout-Design, Copyright, there is a Journal advertisement step involved where the same are published in the Official Journal to invite objections or oppositions (if any) from third parties prior to registration. Therefore, for such IP rights the challenge may be made at such time or even after registration of the right through a cancellation or rectification action. For a Design IP, the challenge may be made after registration by a cancellation action.

29. Briefly, what is the forum and the procedure for challenging each of these intellectual property rights and what are the grounds for a finding of invalidity of each of these intellectual property rights?

Forum:

Under Patents Act, 1970 – The Office of the Controller of Patents for a pre-grant opposition and post-grant opposition. .

Under Trade Marks Act, 1999 – The Office of the Registrar of Trade Marks for opposition at pre-registration stage and also for rectification application at post-registration stage..

Under Geographical Indications of Goods (Registration and Protection) Act, 1999 – The Office of the Registrar of Geographical Indications for opposition at pre-registration stage and also for rectification application at post-registration stage. .

Under Copyright Act, 1957 – The Office of the Registrar of Copyrights.

Under Designs Act, 2000 – The Office of the Controller of Designs.

Under Semi-conductor Integrated Circuits Layout-Design Act, 2000 – The Office of the Registrar of Semi-conductor Integrated Circuits Layout-Design.

Under Protection of Plant Varieties and Farmers' Rights Act, 2001 – The Office of the Registrar of Plant Varieties and Farmers' Rights.

Post-grant invalidity proceedings may also include the High Court / Special tribunal depending on the IP involved and whether there is a suit pending or not is also a relevant factor.

Procedure:

In all the above cases, a petition specifying the nature of the challenge or objection or opposition, and with the details of the rights or issues forming the basis of such challenge is required to be filed with the prescribed fees before the concerned office / forum having jurisdiction. In case a time limit is mentioned under the Act, the activity is to be performed with such deadline [such as that mentioned in Point 8].

Grounds are summarized as under:

Patents:

- that the Applicant for the patent wrongfully obtained the invention or any part thereof from the Opponent;
- that the invention so far as claimed in any claim of the complete specification has been prior published before the priority date of the claim in India or elsewhere; [Anticipation]
- that the invention so far as claimed in any claim of the complete specification is claimed in a claim of a complete specification published on or after priority date of the applicant's claim and filed in pursuance of an application for a patent in India, being a claim of which the priority date is earlier than that of the applicant's claim;
- 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;
- that the invention so far as claimed in any claim of the complete specification is obvious and does not involve any inventive step;
- that the subject of any claim of the complete specification is not an invention under this Act, or is not patentable under this Act;
- that the complete specification does not sufficiently and clearly describe the invention or the method by which it is to be performed;
- 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;

- that a convention application was not made within 12 months from date of first application for protection for the invention made in a convention country;
- that the complete specification does not disclose or wrongly mentions the source or geographical origin of biological material used for the invention;
- that the invention so far as claimed in any claim of the complete specification is anticipated having regard to the knowledge, oral or otherwise, available within any local or indigenous community in India or elsewhere.

Trade Marks:

- The applied mark is devoid of distinctive character;
- The applied mark is descriptive in nature;
- The applied mark is common to trade or generic;
- The applied mark is customary in the current language or in the established practices of business;
- The applied mark is likely to deceive the public or cause confusion;
- The applied mark is deceptively similar or identical to an earlier registered trademark;
- The applied mark is deceptively similar or identical to a prior used trademark;
- The applied mark is prohibited under the law of copyright;
- The applied mark is prohibited under the law of passing off;
- The applied mark is prohibited under any other law in force;
- The applied mark has been filed in bad faith;
- The Applicant is not the proprietor of the applied mark;
- The applied mark is a prohibited name under the Indian Emblem and Names Act, 1950;
- The applied mark contains matters that are likely to hurt religious feelings of any class or section of people;
- The applied mark is registered as a geographical indication; etc.

Copyright:

- that the applied work has been previously registered in India;
- that the applied work has been previously

published in India;

- that the subject-matter of the applied work is not new or original;
- that the applied work is not registrable under this Act; etc.

Designs:

- that the applied design has been previously registered in India;
- that the applied design has been published in India or in any other country prior to the date of registration;
- that the applied design is not a new or original design;
- that the applied design is not registrable under this Act;
- that the applied design is not a design as defined under this Act; etc.

Geographical Indications:

- The applied GI does not belong to the Applicant;
- The applied GI is deceptively similar or identical to an earlier registered GI; etc.

Plant Varieties:

- that the person opposing the application is entitled to the breeder's right as against the applicant;
- that the variety is not registrable under this Act;
- that the registration may not be in public interest;
- that the variety may have adverse effect on the environment.

Semi-conductor Integrated Circuits layout-design

An opposition may be filed on the ground that the application does not comply with the mandatory requirements of this Act, such as:

- that the applied work is not original;
- that the applied work is not distinctive;
- that the applied work is not capable of being distinguished from any other registered layout-design;
- that the applied work has been commercially exploited prior to the date of application for registration.

30. Are there any other methods to remove

or limit the effect of any of the intellectual property rights described above, for example, declaratory relief or licences of right?

While a declaratory relief may be sought from a Court of Law, licenses of right may be issued subject to negotiation between the parties. Compulsory licensing provisions are at a nascent stage in India with only one compulsory licence under the Patents Act having been issued to Natco Pharma Ltd. in respect of a patent of Bayer for the anti-cancer drug Sorafenib tosylate.

31. What remedies (both interim and final) are available for infringement of each of the intellectual property rights described above?

In the interim stage, the remedies available mainly include interim (or temporary) injunction which may be granted before or during a trial and if the Hon'ble Court is satisfied that a prima facie case is made out by the Plaintiff (or the party filing the suit). In serious cases where there is any imminent danger of destruction or removal of infringing articles, a request for appointment of a receiver or commissioner, and orders in the nature of Anton Piller orders permitting search and seizure of infringing property may be passed by the Hon'ble Courts. These orders are mostly passed ex-parte, i.e., in absence of the other side.

In the final determination, any or all of the following remedies are accorded in a successful action or case:

- Injunction
- Damages (monetary compensation)
- Accounts of Profits (monetary payment based on the illegal profits of offender)
- Punitive or Exemplary Damages (additional costs imposed as punishment)
- Endorsement of Validity of IP right of the aggrieved party, (this, if granted, assists substantially to establish validity in subsequent proceedings)

32. What are the costs of enforcement proceedings and is any kind of costs recovery available for successful parties? Is there a procedural mechanism enabling or requiring security for costs?

The court fees for a matter is fixed based upon the valuation of the Intellectual Property. However, as under-

valuing your intellectual property also has an effect on the amount of final damages which may be awarded, the general practice is to pay the highest applicable court fees which may range from ₹50000/- for Commercial Courts and High Courts.

Under the Indian Code of Civil Procedure, 1908, a successful plaintiff is entitled to refund of court fees paid at the time of final determination. However, the refund procedure is cumbersome and takes years to complete.

33. Has the COVID-19 pandemic caused any changes (temporary or permanent) to the protection or enforcement of intellectual property? For example, changes to deadlines, filing or evidence requirements or court processes.

Changes in Court Processes:

The COVID-19 pandemic while in most parts has contributed to creation of significant back-log in the Indian IP offices and the normal Courts of Law, there is also a minor positive outcome which is in the form of a thrust to digitization. The circumstances have accelerated the transition to electronic and paperless applications, documentations, fees payments etc., and also ushered in the hearings through video-conferencing. The IP presently offices primarily conduct hearings through video-conference for prosecution and contentious hearings. While some High Courts and lower courts have resumed physical hearings as the only mode of hearing, some High Courts continue to permit virtual appearance through video-conference (hybrid system) particularly for the preliminary stages of a matter where extensive submissions do not take place.

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