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India

Intellectual Property

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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 laws.

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

(ii) The Designs Act, 2000;

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

(iv) The 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:

- i. 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;

- ii. Protection under The Trade Marks Act, 1999 – 10 years from the date of application and may be renewed every ten years for perpetuity.
- iii. Protection under The 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.
- iv. Protection under The 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.
- v. Protection under The Designs Act, 2000 – 10 years from date of application, and may be renewed for a further period of 5 years.
- vi. Protection under The 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.
- vii. Under Protection of The 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:

- i. 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).
- ii. In case of Trade Mark, the first and rightful owner is considered to be the first adopter and user of a trade mark.
- iii. 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?

a) 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.

b) 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 / guidelines of the Indian IP offices may be referred for a ready understanding:

i. Patents:

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

Further changes to the Rules have been made on March 15, 2024 and the same has been notified on March 15, 2024 and available at https://www.ipindia.gov.in/writereaddata/Portal/IPORule/1_83_1_Patent_Amendment_Rule_2024_Gazette_Copy.pdf

Some highlights of the Amendments are:

1. Timeline for filing request for examination has reduced to 31 months from the priority date
2. Details of foreign filing particulars to be furnished within 3 months from the issuance of the examination report
3. Divisional applications can be filed basis disclosure in the provisional /complete specification
4. A new Form is introduced for requesting grace period for filing a patent application in case of anticipation by public display, etc. In the following circumstances – <https://ipindia.gov.in/writereaddata/Portal/ev/sections/ps31.html#:~:text=Anticipation%20by%20public%20display%2C%20etc.&text=if%20the%20application%20for%20the,as%20the%20case%20may%20be>

However, the Rules do not clarify “transactions of Ld. Society”. Therefore, clarity is required if publications in international journals would be considered within the scope of such provision.

1. Maintainability of pre-grant oppositions to be decided by the Controller, before service on the applicant (if not found maintainable, Controller to pass such order within a month from hearing the Opponent); timeline to file reply statement by an Applicant reduced to 2 months from the earlier 3 months.
2. In case of post grant opposition, the Opposition Board shall submit recommendation within 2 months from the date on which the documents are forwarded to it.
3. 10% reduction if renewal fee if paid in advance for a period of 4 years at a time.
4. Working Statement to be filed once in every 3 financial years **instead of filing every financial year**. Extendible by 3 months upon payment of fees.

ii. Trade Marks

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

iii. Design

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

iv. Copyright

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

v. Geographical Indications

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

vi. Plant varieties

<https://www.plantauthority.gov.in/crop-dus-guidelines>

<https://www.plantauthority.gov.in/general-guidelines-regarding-registration-edv>

<https://www.plantauthority.gov.in/time-schedule-submission-application-and-seed-crops>

vii. Semi-conductor Integrated Circuits Layout Designs

<https://sicldr.gov.in/sicw/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 2 - 3 years
2	Trade Marks	About 12 - 14 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. Further, there are options to expedite the examination for patents and trade marks by filing a request for expedited examination. For patents, the applicant must fulfil the categories as provided under the Patents Act. This would significantly reduce the timeline for grant.

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?

Since the abolishment of the Intellectual Property Appellate Board (IPAB) in India, all appeals in case of Patents, Trade Marks, Geographical Indications, Plant Varieties, Copyright are being 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. 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 Courts 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:

(i) 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 or startup or small entity or educational institution: 1600/-

For others: 8000/-

For Requesting Examination

Under Section 11B, Rule 24(1)

For Individual or startup or small entity or educational institution: 4000/-

For others: 20000/-

Under Rule 20(4)(ii)

For Individual or startup or small entity or educational institution: 5600/-

For others: 28000/-

Under Rule 24C

For Individual or startup or small entity or educational institution: 8000/-

For others: 60000/-

- Renewal Fees:

For Online Renewal Payment

3rd year: Individual or startup or small entity or educational institution 800; Other 4000.

4th year: Individual or startup or small entity or educational institution 800; Other 4000.

5th year: Individual or startup or small entity or educational institution 800; Other 4000.

6th year: Individual or startup or small entity or educational institution 800; Other 4000.

7th year: Individual or startup or small entity or educational institution 2400; Other 12000.

8th year: Individual or startup or small entity or educational institution 2400; Other 12000.

9th year: Individual or startup or small entity or educational institution 2400; Other 12000.

10th year: Individual or startup or small entity or educational institution 2400; Other 12000.

11th year: Individual or startup or small entity or educational institution 4800; Other 24000

12th year: Individual or startup or small entity or educational institution 4800; Other 24000

13th year: Individual or startup or small entity or educational institution 4800; Other 24000

14th year: Individual or startup or small entity or educational institution 4800; Other 24000

15th year: Individual or startup or small entity or educational institution 4800; Other 24000

16th year: Individual or startup or small entity or educational institution 8000; Other 40000

17th year: Individual or startup or small entity or educational institution 8000; Other 40000

18th year: Individual or startup or small entity or educational institution 8000; Other 40000

19th year: Individual or startup or small entity or educational institution 8000; Other 40000

20th year: Individual or startup or small entity or educational institution 8000; Other 40000

For Offline Renewal Payment

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

May refer –

https://www.ipindia.gov.in/writereaddata/Portal/IPORule/1_83_1_Patent_Amendment_Rule_2024_Gazette_Copy.pdf

(ii) The 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>

(iii) The 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/writereaddata/Portal/Images/pdf/GIR_Fees-August_26_2020.pdf

(iv) The 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>

(v) The 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/-

(vi) The Semi-conductor Integrated Circuits Layout-Design Act, 2000 –

- Application Fees: 5000/-
- Renewal Fees: Not applicable

(vii) The 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 farmer's variety the annual fee is 10/-.

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.

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 must be in writing and in addition comply with the requirements laid down under the provisions of the Indian Contract Act, 1872. Additionally, the following are the common requirements:

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

Special Requirements

(a) For Trade Marks:

- Restriction on assignment or transmission where multiple exclusive rights would be created;
- Restriction on assignment or transmission where exclusive rights would be created in different parts of India;
- A certification trade mark cannot be assigned except with the consent of the Trade Marks Registrar;
- Associated trade marks are assignable and transmissible only as a whole and not

separately, subject to the provisions of the Trade Marks Act, 1999;

- v. 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.

(e) For Designs

- i. The assignment of a Design must be recorded with the Patent Office within six months from the execution of the instrument or within such further period not exceeding six months in the aggregate as the Controller on the application

made in the prescribed manner allows.

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?

(a) For Patents

Yes, a Patent assignment must be made registered with the Patent Office as per the procedure laid down to be operate as a legally enforceable contract.

(b) For Designs

Like Patents, an assignment for design rights must be recorded with the Design Office as per the procedure laid down and such registration must be done within six months of the execution of the instrument of the assignment.

(c) For Trade Marks

Recordal of Trade Marks assignment is not mandatory. However, it is advisable to have an assignment recorded with the Trade Marks Office as it assist in establishing ownership of the brand in an enforcement action before the Court or in any proceedings with the Trade Marks Office. An unregistered trade mark can also be assigned.

(d) Copyright

Like Trade Marks, it is not mandatory to record Copyright assignments. Pertinently, if the assignee fails to exercise any of the rights assigned to him within a period of one year of the assignment, the assignment is deemed to have lapsed unless a contrary provision is made in the Assignment Agreement.

(e) For Semi-Conductor Integrated Circuits Layout Design

The proprietor of a registered layout-design can assign the layout-design for any consideration. with or without good will. The assignee shall have to register his title with the Registrar as per the procedure provided in the Act.

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 requirement 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, it is mandatory to record a license within six months from the execution of the instrument or within such further period not exceeding six months in the aggregate as the Controller on application made in the prescribed manner allows;

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

Note: For Semi-Conductor Integrated Circuits Layout-Design and Trade Marks, one can enter into registered user agreements with the registered proprietor. Such agreements must be recorded with the respective IP offices as per the procedure prescribed in the Acts. Most significant difference between a licensed user and registered user is that a registered user may take action in its own name before the appropriate court against any infringement.

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 are 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 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. The High Courts at Calcutta, Mumbai, Delhi, Madras and Himachal Pradesh exercise original jurisdiction unlike other High Courts that exercise appellate jurisdiction only.

(i) Courts :

As per the respective statutes read with The Commercial Courts Act, 2015, the jurisdiction to institute a suit in connection with registered and unregistered trademarks, copyright, patent, design and geographical indications would be the commercial division at the District Court or at High Court having original jurisdiction.

In case the pecuniary value of a suit proceeding concerning registered and unregistered trademarks, copyright, patent, design and geographical indications is less than Rs. 3,00,000 then a suit can be filed only before the District Court.

In case of Trade Mark, Geographical Indications, Copyright, the registered proprietor can sue from its place of business unlike in the case of Patents and Designs where suit can be filed on the basis of the defendant's place of business or where the cause of action arose.

In case of Plant varieties, such suits do not fall within the definition of a commercial suit and the court action is to be initiated before the District Court within the local limit of whose jurisdiction the cause of action arises.

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

In India, proceedings before the Court are 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 Court on a specified date or dates. The Court may pass ad-interim reliefs based on the petition, and then summon the other side to appear before it and/or may summons 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 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 The Bharatiya Sakshya Adhiniyam (BSA), 2023 (replaced the Indian Evidence Act, 1872). The evidence is basically two kinds [which may also include witness or documents signed by experts]:

(i) Documentary Evidence;

(ii) 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 mandates pre-suit mediation. However, in case of urgency, the Court may waive such requirement upon request and/or an application being made before the Court.

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

- i. Cease & Desist Notice and undertaking;
- ii. Out of Court Settlements;
- iii. Alternative Dispute Resolution such as arbitration, mediation.

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 is required to be established in a case of infringement by the registered proprietor

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) 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?

No, there is no technical judge or judge with technical experience before the High Courts or Commercial Courts.

However, the 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.

Pertinently, Section 115 of the Patents Act, 1970 also provides that in any suit for infringement or other proceedings under the said Act, the 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) What mechanisms are available for compelling the obtaining and protecting of evidence? Is disclosure or discovery available?

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 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 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 Courts scrutinise documents in the individual

capacity of the Judge and the 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:

(i) Under Patents Act, 1970 –

In India, the Patents Act, 1970 provides several defenses to patent infringement. These defenses can be invoked by an alleged infringer to avoid liability for patent infringement. The key defenses available under Indian patent law include:

1. Non-Infringement:

The alleged infringer can argue that their actions do not constitute infringement of the patent. This can be based on the claim that the alleged infringing product or process does not fall within the scope of the patent claims as granted.

2. Invalidity of the Patent:

The alleged infringer can challenge the validity of the patent on various grounds, including:

- **Lack of Novelty:** The invention was not new at the time of filing the patent application.
- **Lack of Inventive Step:** The invention was obvious to a person skilled in the art at the time of filing the patent application.
- **Non-Patentable Subject Matter:** The invention falls within the categories of non-patentable subject matter as defined under Section 3 and Section 4 of the Patents Act.
- **Insufficient Disclosure:** The patent specification does not sufficiently and clearly describe the invention and the method by which it is to be performed.
- **Lack of Industrial Applicability:** The invention is not capable of being made or used in an industry.

3. Experimental Use:

Under Section 47(3) of the Patents Act, any act of making, using, or selling a patented invention solely for the purposes of experiment or research, including imparting

instructions to pupils, is not considered an infringement of the patent.

4. Bolar Exemption:

Under Section 107A(a) of the Patents Act, the use of a patented invention, by any person, for the purposes of development and submission of information required under any law for the time being in force, in India, or in a country other than India, that regulates the manufacture, construction, use, sale, or import of any product, is not considered an infringement of the patent. This is commonly known as the "Bolar exemption."

5. Parallel Importation:

Under Section 107A(b) of the Patents Act, the importation of patented products by any person from a person who is duly authorized under the law to produce and sell or distribute the product is not considered an infringement of the patent. This allows for parallel importation of patented products.

6. Government Use:

Under Section 47(1) of the Patents Act, the government or any person authorized by the government may use a patented invention for the purposes of the government without constituting an infringement of the patent. This includes use for the purposes of the Central Government, State Government, or any government undertaking.

7. Compulsory Licensing:

Under Sections 84 to 92 of the Patents Act, the Controller of Patents may grant a compulsory license to a third party to use a patented invention under certain conditions, such as failure to meet the reasonable requirements of the public, non-availability of the patented invention at a reasonably affordable price, or non-working of the patent in India. The use of the patented invention under a compulsory license is not considered an infringement.

8. Prior Use:

Under Section 104A(1) of the Patents Act, if the alleged infringer can prove that they were already using the patented invention in India before the priority date of the patent, they may have a defense of prior use.

9. Exhaustion of Rights:

Once a patented product is sold by the patentee or with their consent, the patentee's rights are exhausted with respect to that specific product. The purchaser of the

product can use, sell, or distribute the product without infringing the patent. This is known as the "exhaustion of rights" or "first sale doctrine."

10. Laches

11. Estoppel

(ii) Under The Trade Marks Act, 1999 –

- a. Dissimilarity of the competing marks;
- b. Dissimilarity of the competing goods or services;
- c. Prior use of the Defendant's mark;
- d. Acquiescence;
- e. Laches;
- f. Estoppel;
- g. Registered mark is common to trade;
- h. Registered mark is descriptive or laudatory or lacks distinctiveness;

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

- a. That the Geographical Indication was not registrable under this Act;
- b. Laches;
- c. Estoppel;

(iv) Under The Copyright Act, 1957 –

- a. Dissimilarity of the competing works;
- b. Lack of originality in the copyrighted work;
- c. Prior publication of the copyrighted work;
- d. Laches;
- e. Estoppel;

(v) Under The Designs Act, 2000 –

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

(vi) Under The Semi-conductor Integrated Circuits Layout-Design Act, 2000 –

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

(vii) Under The Protection of Plant Varieties and Farmers' Rights Act, 2001

- a. That the plant variety was not registrable under this Act;
- b. Laches;
- c. Estoppel;

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

Each of the intellectual property rights described in Section A other Designs can be opposed during the registration process by any person.

Once registered, only a person interested, or a person aggrieved can challenge the registration by way of a cancellation/revocation/rectification action before the appropriate forum.

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.

For a Design IP, the challenge may be made after registration by a cancellation action.

In case of registered Patents, Trade Marks, Geographical Indications, Plant Varieties, Semi-conductor Integrated Circuits Layout-Design, Copyright – cancellation/revocation/rectification action can be commenced any time and usually no limitation rule

applies.

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:

- i. Under Patents Act, 1970 – The Office of the Controller of Patents for a pre-grant opposition and post-grant opposition. Revocation action/counter claim can also be filed before the High Court.
- ii. Under The Trade Marks Act, 1999 – The Office of the Registrar of Trade Marks for opposition at pre-registration stage and also for cancellation/rectification application at post-registration stage. A cancellation/rectification application can also be preferred before the High Court.
- iii. Under The 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. A cancellation/rectification application can also be preferred before the High Court.
- iv. Under The Copyright Act, 1957 – The Office of the Registrar of Copyrights. A cancellation/rectification application can also be preferred before the High Court.
- v. Under The Designs Act, 2000 – The Office of the Controller of Designs. Cancellation of a registered design may also be claimed as a counter-claim before the High Court in a suit for infringement.
- vi. Under The Semi-conductor Integrated Circuits Layout-Design Act, 2000 – The Office of the Registrar of Semi-conductor Integrated Circuits Layout-Design. Post-grant invalidity proceedings may also include the High Court / Special tribunal
- vii. Under The 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

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. The procedure is prescribed under the respective Rules or are governed by the High Court rules, as the case may be.

Grounds are summarized as under:

(i) Patents:

- a. that the Applicant for the patent wrongfully obtained the invention or any part thereof from the Opponent;
- b. 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]
- c. 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;
- d. 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;
- e. that the invention so far as claimed in any claim of the complete specification is obvious and does not involve any inventive step;
- f. that the subject of any claim of the complete specification is not an invention under this Act, or is not patentable under this Act;
- g. that the complete specification does not sufficiently and clearly describe the invention or the method by which it is to be performed;
- h. 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;
- i. 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;
- j. that the complete specification does not disclose or wrongly mentions the source or geographical origin of biological material used for the invention;
- k. 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.

(ii) Trade Marks:

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

(iii) Copyright:

- a. that the work has been previously registered in India;
- b. that the work has been previously published in India;
- c. that the subject-matter of the work is not new or original;
- d. that the work is not registrable under this Act; etc.

(vi) Designs:

- a. that the design has been previously registered in India;
- b. that the design has been published in India or in any other country prior to the date of registration;
- c. that the design is not a new or original design;

- d. that the design is not registrable under this Act;
- e. that the applied design is not a design as defined under this Act; etc.

(vii) Geographical Indications

- a. The GI as claimed does not belong to the Applicant;
- b. The GI is deceptively similar or identical to an earlier registered GI; etc.
- c. the GI would be likely to deceive or cause confusion;
- d. the use of the GI would be contrary to any law for the time being in force;
- e. the GI comprises or contains scandalous or obscene matter;
- f. the GI comprises or contains any matter likely to hurt the religious susceptibilities of any class or section of the citizens of India;
- g. the GI is determined to be generic names or indications of goods and are, therefore, not or ceased to be protected in their country of origin, or which have fallen into disuse in that country;
- h. the GI which, although literally true as to the territory, region or locality in which the goods originate, but falsely represent to the persons that the goods originate in another territory, region or locality, as the case may be.

(viii) Plant Varieties:

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

(ix) 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:

- a. that the applied work is not original;
- b. that the applied work is not distinctive;
- c. that the applied work is not capable of being distinguished from any other registered layout-design;
- d. 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 if the Court is satisfied that a *prima facie* case is made out by the Plaintiff. 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 Court. 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:

- i. Injunction
- ii. Damages (monetary compensation)
- iii. Accounts of Profits (monetary payment based on the illegal profits of offender)
- iv. Punitive or Exemplary Damages (additional costs imposed as punishment)
- v. 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 are 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/- to 2,00,000 for Commercial Courts and High Courts.

Under The Indian Code of Civil Procedure, 1908, in case a suit proceeding settled between the parties, the Plaintiff is entitled to refund of court fees paid at the time of filing the suit. However, the refund procedure is cumbersome, especially for foreign entities and takes time to complete.

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