

LLB Paper Code: 402
Subject: Intellectual Property Rights
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Unit – I: Copyright

A. Nature and Meaning:

Copyright is a well recognised form of property right which had its roots in the common law system and subsequently came to be governed by the national laws in each country. It is a form of Intellectual property, distinguished from, physical property. Copyright as the name suggests arose as an exclusive right of the author to copy the literature produced by him and stop others from doing so. Copyright is a form of intellectual property protection granted under Indian law to the creators of original works of authorship such as literary works (including computer programs, tables and compilations including computer databases which may be expressed in words, codes, schemes or in any other form, including a machine readable medium), dramatic, musical and artistic works, cinematographic films and sound recordings.

Copyright means the exclusive right to do or authorize others to do certain acts in relation to:

- (1) literary, dramatic, musical and artistic works;
- (2) Cinematograph film; and
- (3) sound recordings.

Of course the nature of the acts varies according to the subject-matter, basically, copyright is the right to copy or reproduce the work in which copyright subsists.

Copyright law protects expressions of ideas rather than the ideas themselves. Under section 13 of the Copyright Act 1957, copyright protection is conferred on literary works, dramatic works, musical works, artistic works, cinematograph films and sound recording. For example, books, computer programs are protected under the Act as literary works.

Further, Copyright refers to a bundle of exclusive rights vested in the owner of copyright by virtue of Section 14 of the Act. These rights can be exercised only by the owner of copyright or by any other person who is duly licensed in this regard by the owner of copyright. These rights include the right of adaptation, right of reproduction, right of publication, right to make translations, right to storage, communication to public etc. Copyright does not extend to any right beyond the scope of Section 14.

Copyright protection is conferred on all Original literary, artistic, musical or dramatic, cinematograph and sound recording works. Original means, that the work has not been copied from any other source. Copyright protection commences the moment a work is created, and its registration is optional.

One of the supreme advantages of copyright protection is that protection is available in

several countries across the world, although the work is first published in India by reason of India being a member of Berne Convention. Protection is given to works first published in India, in respect of all countries that are member states to treaties and conventions to which India is a member. Thus, without formally applying for protection, copyright protection is available to works first published in India, across several countries. Also, the government of India has by virtue of the International Copyright Order, 1999, extended copyright protection to works first published outside India.

In India, the law relating to copyright is governed by the Copyright Act, 1957 which has been amended in 1983, 1984, 1985, 1991, 1992, 1994, 1999 and 2012 to meet with the national and international requirements. The amendment introduced in 1984 included computer program within the definition of literary work and a new definition of computer program was inserted by the 1994 amendment. The philosophical justification for including computer programs under literary work has been that computer programs are also products of intellectual skill like any other literary work.

In 1999, the Copyright Act, 1957 was further amended to give effect to the provisions of the TRIPs agreement providing for term of protection to performers rights at least until the end of a period of fifty years computed from the end of the calendar year in which the performance took place. The Amendment Act also inserted new Section 40A empowering the Central Government to extend the provisions of the Copyright Act to broadcasts and performances made in other countries subject to the condition however that such countries extend similar protection to broadcasts and performances made in India. Another new Section 42A empowers the Central Government to restrict rights of foreign broadcasting organisations and performers.

The Act is now amended in 2012 with the object of making certain changes for clarity, to remove operational difficulties and also to address certain newer issues that have emerged in the context of digital technologies and the Internet. Moreover, the main object to amendments the Act is that in the knowledge society in which we live today, it is imperative to encourage creativity for promotion of culture of enterprise and innovation so that creative people realise their potential and it is necessary to keep pace with the challenges for a fast growing knowledge and modern society.

The importance of copyright has increased enormously in recent times due to the rapid technological development in the field of printing, music, communication, entertainment and computer industries. Copyright law is based on the principle that law does not permit one to appropriate to himself what has been produced by the labour, skill and capital of another.

Object of Copyright Law:

The object of copyright law is to protect the author of the copyright work from an unlawful reproduction or exploitation of his work by others and also to encourage authors, composers, artists and designers to create original works by rewarding them with the exclusive right for a limited period to exploit the work for monetary gain. The economic exploitation is done by licensing such exclusive right to entrepreneurs like publishers, film producers and record

manufacturers for a monetary consideration. People who economically exploit the copyright are the greater beneficiaries of the copyright law than the creators of works of copyright.

B. Scope of Protection:

Subject matter of Copyright:

Works in which copyright subsists- section 13:

Copyright subsists only in following classes of works:

- (a) Original literary, dramatic, musical and artistic works,
- (b) Cinematograph films, and
- (c) Sound recordings.

According to Section 2(o) "**literary work**" includes computer programmes, tables and compilations including computer literary data bases.

According to Section 2(h) "**dramatic work**" includes any piece for recitation, choreographic work or entertainment in dumb show, the scenic arrangement or acting form of which is fixed in writing or otherwise but does not include a cinematograph film

According to Section 2(p) "**musical work**" means a work consisting of music and includes any graphical notation of such work but does not include any words or any action intended to be sung, spoken or performed with the music

According to Section 2(c) "**artistic work**" means (i) a painting, a sculpture, a drawing (including a diagram, map, chart or plan), an engraving or a photograph, whether or not any such work possesses artistic quality; (ii) work of architecture; and (iii) any other work of artistic craftsmanship

According to Section 2(b) "**work of architecture**" means any building or structure having an artistic character or design, or any model for such building or structure

According to Section 2(i) "**engravings**" include etchings, lithographs, wood-cuts, prints and other similar works, not being photographs

According to Section 2(s) "**photograph**" includes photo-lithograph and any work produced by any process analogous to photography but does not include any part of a cinematograph film

According to Section 2(za) "**work of sculpture**" includes casts and models.

According to Section 2(f) "**cinematograph film**" means any work of visual recording and includes a sound recording accompanying such visual recording and "cinematograph" shall be construed as including any work produced by any process analogous to cinematography including video films;

According to Section 2(xx) "**sound recording**" means a recording of sounds from which such sounds may be produced regardless of the medium on which such recording is made or the method by which the sounds are produced.

According to Section 2 (xxa) **“visual recording”** means the recording in any medium, by any method including the storing of it by any electronic means, of moving images or of the representations thereof, from which they can be perceived, reproduced or communicated by any method

It is to be noted that copyright subsists only in original work.

Qualification for copyright subsistence-Section 13(2):

In order to qualify for copyright the works, apart from being original, it should satisfy following conditions, (except in the case of foreign works):

1. The work is first published in India.
2. Where the work is first published outside India the author, at the date of publication must be a citizen of India. If the publication was made after the author's death the author must have been at the time of his death a citizen of India.
3. In the case of an unpublished work the author is on the date of making of the work a citizen of India or domiciled in India.

[This does not apply to works of architecture.

These conditions do not apply to foreign works or works of international organizations.]

4. In case of work of architecture, the work must be located in India.
5. Further, Copyright shall not subsist—
 - (a) in any cinematograph film a substantial part of the film is an infringement of the copyright in any other work;
 - (b) in any sound recording made in respect of a literary, dramatic or musical work, if in making the sound recording, copyright in such work has been infringed.
6. The copyright in a cinematograph film or a sound recording shall not affect the separate copyright in any work in respect of which or a substantial part of which, the film, or as the case may be, the sound recording is made.
7. In the case of a work of architecture copyright shall subsist only in the artistic character and design and shall not extent to processes or methods of construction.

Term of Copyright- Section 22-29:

The term of copyright varies according to the nature of the work and whether the author is a natural person or a legal person e.g. a Corporation, Government Institutions, etc., or whether the work is anonymous or pseudonymous.

In the case of literary, dramatic, musical or artistic work when published during the lifetime of the author, copyright subsists during the lifetime of the author plus sixty years. Where the work is of joint authorship the sixty years period will start after the death of the author who dies last.

In case of anonymous or pseudonymous works the terms of copyright is sixty years from the year of publication. If the identity of the author is disclosed before the expiry of the sixty years period the term will extend to sixty years after the death of the author. In the case of posthumous publications the term will be sixty years from the year of publication.

For cinematograph film and sound recording also the term is sixty years from the year of publication. Where the first owner of the copyright is the Government or a public undertaking the term of copyright is sixty years from the year of publication. Copyright works of International Organisations also have a term of sixty years from the year of publication.

Thus it may be seen that in the case of literary, dramatic, musical or artistic works where the author is a natural person the term is lifetime plus sixty years. In all other cases the term is sixty years from the year of publication.

Forms of Copyright:

The Copyright Act, 1957 confers copyright protection in the following two forms:

- (A) Economic rights of the author, and
- (B) Moral Rights of the author.

A) Economic Rights:

The copyright subsists in original literary, dramatic, musical and artistic works; cinematographs films and sound recordings. The authors of copyright in the aforesaid works enjoy economic rights u/s 14 of the Act. The rights are mainly, in respect of literary, dramatic and musical, other than computer program, to reproduce the work in any material form including the storing of it in any medium by electronic means, to issue copies of the work to the public, to perform the work in public or communicating it to the public, to make any cinematograph film or sound recording in respect of the work, and to make any translation or adaptation of the work. In the case of computer program, the author enjoys in addition to the aforesaid rights, the right to sell or give on hire, or offer for sale or hire any copy of the computer program regardless whether such copy has been sold or given on hire on earlier occasions. In the case of an artistic work, the rights available to an author include the right to reproduce the work in any material form, including depiction in three dimensions of a two dimensional work or in two dimensions of a three dimensional work, to communicate or issues copies of the work to the public, to include the work in any cinematograph work, and to make any adaptation of the work. In the case of cinematograph film, the author enjoys the right to make a copy of the film including a photograph of any image forming part thereof, to sell or give on hire or offer for sale or hire, any copy of the film, and to communicate the film to the public. These rights are similarly available to the author of sound recording. In addition to the aforesaid rights, the author of a painting, sculpture, drawing or of a manuscript of a literary, dramatic or musical work, if he was the first owner of the copyright, shall be entitled to have a right to share in the resale price of such original copy provided that the resale price exceeds rupees ten thousand.

B) Moral Rights:

Section 57 of the Act defines the two basic “moral rights” of an author. These are:

- (i) Right of paternity, and
- (ii) Right of integrity.

The right of paternity refers to a right of an author to claim authorship of work and a right to prevent all others from claiming authorship of his work. Right of integrity empowers the author to prevent distortion, mutilation or other alterations of his work, or any other action in relation to said work, which would be prejudicial to his honour or reputation. The proviso to section 57(1) provides that the author shall not have any right to restrain or claim damages in respect of any adaptation of a computer program to which section 52 (1)(aa) applies (i.e. reverse engineering of the same). It must be noted that failure to display a work or to display it to the satisfaction of the author shall not be deemed to be an infringement of the rights conferred by this section. The legal representatives of the author may exercise the rights conferred upon an author of a work by section 57(1), other than the right to claim authorship of the work.

Ownership of Copyright:

First owner of Copyright: Section-17

The author of a work shall be the first owner of the copyright.

According to Section 2 (d), Author means-

- (i) in relation to a literary or dramatic work, the author of the work;
- (ii) in relation to a musical work, the composer;
- (iii) in relation to an artistic work other than a photograph, the artist;
- (iv) in relation to a photograph, the person taking the photograph;
- (v) in relation to a cinematograph film or sound recording the producer; and
- (vi) in relation to any literary, dramatic, musical or artistic work which is computer-generated, the person who causes the work to be created.

However, in the case of a literary, dramatic or artistic work made by the author in the course of his employment by the proprietor of a newspaper, magazine or a similar periodical under a contract of service or apprenticeship, for the purpose of publication in a newspaper, magazine or a similar periodical, the said proprietor shall, in the absence of any agreement to the contrary be the first owner of the copyright in the work in relation to the publication of the work in the newspaper or magazine or periodical or to its reproduction for the said purpose, but in all other respects the author shall be the first owner of the copyright in the work. The same rule applies to photographs taken, painting or portrait drawn or an engraving or a cinematograph film made by a newspaper employee in the course of employment i.e. the employer is the first owner of the copyright in the work made in the course of employment under a contract of service or appointment. However, this is subject to any agreement to the contrary.

In the case of any address or speech delivered in public, the person who has delivered such address or speech or if such person has delivered such address or speech on behalf of any other person, such other person shall be the first owner of the copyright therein notwithstanding that the person who delivers such address or speech, or, as the case may be, the person on whose behalf such address or speech is delivered, is employed by any other person who arranges such address or speech or on whose behalf or premises such address or speech is delivered.

In the case of a Government work, Government shall, in the absence of any agreement to the contrary, be the first owner of the copyright therein. According to S. 2(k)- "Government work" means a work which is made or published by or under the direction or control of— (i) the Government or any department of the Government; (ii) any Legislature in India; (iii) any court, tribunal or other judicial authority in India.

In the case of a work made or first published by or under the direction or control of any public undertaking, such public undertaking shall, in the absence of any agreement to the contrary, be the first owner of the copyright therein.

Rights of the Owner:

1. Assignment of Copyright: Section-18

An assignment is in essence a transfer of ownership even if it is partial. The owner of the copyright in an existing work or the prospective owner of the copyright in a further work may assign to any person the copyright either wholly or partially and either generally or subject to limitations and either for the whole term of the copyright or any part thereof. In the case of the assignment of copyright in any future work, the assignment shall take effect only when the work comes into existence.

It is to be noted that no such assignment shall be applied to any medium or mode of exploitation of the work which did not exist or was not in commercial use at the time when the assignment was made, unless the assignment specifically referred to such medium or mode of exploitation of the work.

The author of the literary or musical work included in a cinematograph film shall not assign or waive the right to receive royalties to be shared on an equal basis with the assignee of copyright for the utilization of such work in any form other than for the communication to the public of the work along with the cinematograph film in a cinema hall, except to the legal heirs of the authors or to a copy right society for collection and distribution and any agreement to contrary shall be void.

Also, the author of the literary or musical work included in the sound recording but not forming part of any cinematograph film shall not assign or waive the right to receive royalties to be shared on an equal basis with the assignee of copyright for any utilization of such work except to the legal heirs of the authors or to a collecting society for collection and distribution and any assignment to the contrary shall be void.

Where the assignee of a copyright becomes entitled to any right comprised in the copyright, the assignee as respects the rights so assigned, and the assignor as respects the rights not assigned, shall be treated for the purposes of this Act as the owner of copyright and the provisions of this Act shall have effect accordingly. Here, the expression "assignee" as respects the assignment of the copyright in any future work includes the legal representatives of the assignee, if the assignee dies before the work comes into existence.

Mode of Assignment: Section-19

1. Assignment of the copyright in any work shall be in writing, and it must be signed by the assignor or by his duly authorised agent.
2. The assignment of copyright in any work shall identify such work, and shall specify the rights assigned and the duration and territorial extent of such assignment.
3. The assignment of copyright in any work shall also specify the amount of royalty and any other consideration payable to the author or his legal heirs during the currency of the assignment and the assignment shall be subject to revision, extension or termination on terms mutually agreed upon by the parties.
4. Where the assignee does not exercise the rights assigned to him under any of the other sub-sections of this section within a period of one year from the date of assignment, the assignment in respect of such rights shall be deemed to have lapsed after the expiry of the said period unless otherwise specified in the assignment.
5. If the period of assignment is not stated, it shall be deemed to be five years from the date of assignment.
6. If the territorial extent of assignment of the rights is not specified, it shall be presumed to extend within India.
7. Nothing in sub-section (2) or sub-section (3) or sub-section (4) or sub-section (5) or sub-section (6) shall be applicable to assignments made before the coming into force of the Copyright (Amendment) Act, 1994.
8. The assignment of copyright in any work contrary to the terms and conditions of the rights already assigned to a copyright society in which the author of the work is a member shall be void.
9. No assignment of copyright in any work to make a cinematograph film shall affect the right of the author of the work to claim an equal share of royalties and consideration payable in case of utilization 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.
10. No assignment of the copyright in any work to make a sound recording which does not form part of any cinematograph film shall 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.

2. Relinquishment of Copyright: Section-21

The author of a work may relinquish all or any of the rights comprised in the copyright in the work by giving notice in the prescribed form to the Registrar of Copyrights or by way of public notice and thereupon such rights shall, subject to the provisions of sub-section (3), cease to exist from the date of the notice.

The Registrar of Copyrights shall publish such a notice in the Official Gazette and in such other manner as he may deem fit. Also, the Registrar of Copyrights shall, within fourteen days from the publication of the notice in the Official Gazette, post the notice on the official website of the Copyright Office so as to remain in the public domain for a period of not less than three years.

The relinquishment of all or any of the rights comprised in the copyright in a work shall not affect any rights subsisting in favour of any person on the date of the notice referred to in sub-section (1), for example- the rights of an assignee or licensee.

3. Transmission by operation of law:

Copyright is a kind of personal movable property. It can therefore be transferred, by a testamentary disposition or by the operation of law as in the case of similar properties. When the owner of the copyright dies the copyright will pass to his personal representatives if he dies intestate. If the manuscript of a literary, dramatic or musical work, or an artistic work has been bequeathed to a beneficiary without specifically bequeathing copyright the bequest will carry with it the copyright also unless a contrary intention appears from the will.

Licences:

A licence is an authorization to do certain acts which, without such authorization, would be an infringement. Licences can be exclusive or non-exclusive. 'Exclusive licence' means a licence which confers on the licensee or on the licensee and persons authorised by him, to the exclusion of all other persons (including the owner of the Copyright), any right comprised in the Copyright in a work, and 'exclusive licensee' shall be construed accordingly. (Sec. 2(j)).

In the case of a non-exclusive licence, the owner of the Copyright retains the right to grant licences to more than one person or to exercise it himself. An exclusive licence can be distinguished from a sole licence. In the case of a sole licence the licensee can exclude all others except the owner of the Copyright.

The owner of the copyright in any existing work or the prospective owner of the copyright in any future work may grant any interest in the right by licence in writing by him or by his duly authorised agent. Provided that in the case of a licence relating to copyright in any future work, the licence shall take effect only when the work comes into existence. Where a person to whom a licence relating to copyright in any future work is granted under this section dies before the work comes into existence, his legal representatives shall, in the absence of any provision to the contrary in the licence, be entitled to the benefit of the licence. (Sec. 30)

According to Section 30A, the provisions of section 19 shall, with any necessary adaptations and modifications, apply in relation to a licence under section 30 as they apply in relation to assignment of copyright in a work.

A licence is different from an assignment. In the case of a licence a licensee gets the right to exercise particular rights subject to the condition of the licence but does not become the owner of that right whereas an assignee becomes the owner of the interest assigned.

Compulsory licence in works withheld from public. According to Section 30, if at any time during the term of copyright in any work which has been published or performed in public, a complaint is made to the Copyright Board that the owner of copyright in the work— (a) has refused to republish or allow the republication of the work or has refused to allow the performance in public of the work, and by reason of such refusal the work is withheld from the public; or (b) has refused to allow communication to the public by broadcast, of such work or in the case of sound recording the work recorded in such sound recording, on terms which the complainant considers reasonable; the Copyright Board, after giving to the owner of the copyright in the work a reasonable opportunity of being heard and after holding such inquiry as it may deem necessary, may, if it is satisfied that the grounds for such refusal are not reasonable, direct the Registrar of Copyrights to grant to the complainant a licence to republish the work, perform the work in public or communicate the work to the public by broadcast, as the case may be, subject to payment to the owner of the copyright of such compensation and subject to such other terms and conditions as the Copyright Board may determine; and thereupon the Registrar of Copyrights shall grant the licence to such person or persons who, in the opinion of the Copyright Board, is or are qualified to do so in accordance with the directions of the Copyright Board, on payment of such fee as may be prescribed.

Compulsory licence in unpublished or published works. According to Section 31A-

1. Where, in the case of any unpublished work or any work published or communicated to the public and the work is withheld from the public in India, the author is dead or unknown or cannot be traced, or the owner of the copyright in such work cannot be found, any person may apply to the Copyright Board for a licence to publish or communicate to the public such work or a translation thereof in any language.
2. Before making an application under sub-section (1), the applicant shall publish his proposal in one issue of a daily newspaper in the English language having circulation in the major part of the country and where the application is for the publication of a translation in any language, also in one 16 issue of any daily newspaper in that language.
3. Every such application shall be made in such form as may be prescribed and shall be accompanied with a copy of the advertisement issued under sub-section (2) and such fee as may be prescribed.
4. Where an application is made to the Copyright Board under this section, it may, after holding such inquiry as may be prescribed, direct the Registrar of Copyrights to grant to the applicant a licence to publish the work or a translation thereof in the language mentioned in the application subject to the payment of such royalty and subject to such other terms and conditions as the Copyright Board may determine, and thereupon the Registrar of Copyrights

shall grant the licence to the applicant in accordance with the direction of the Copyright Board.

5. Where a licence is granted under this section, the Registrar of Copyrights may, by order, direct the applicant to deposit the amount of the royalty determined by the Copyright Board in the public account of India or in any other account specified by the Copyright Board so as to enable the owner of the copyright or, as the case may be, his heirs, executors or the legal representatives to claim such royalty at any time.

6. Without prejudice to the foregoing provisions of this section, in the case of a work referred to in sub-section (1), if the original author is dead, the Central Government may, if it considers that the publication of the work is desirable in the national interest, require the heirs, executors or legal representatives of the author to publish such work within such period as may be specified by it.

7. Where any work is not published within the period specified by the Central Government under sub-section (6), the Copyright Board may, on an application made by any person for permission to publish the work and after hearing the parties concerned, permit such publication on payment of such royalty as the Copyright Board may, in the circumstances of such case, determine in the prescribed manner.

Compulsory licence for benefit of disabled. According to Section 31B-

(1) Any person working for the benefit of persons with disability on a profit basis or for business may apply to the Copyright Board, in such form and manner and accompanied by such fee as may be prescribed, for a compulsory licence to publish any work in which copyright subsists for the benefit of such persons, in a case to which clause (zb) of sub-section (1) of section 52 does not apply and the Copyright Board shall dispose of such application as expeditiously as possible and endeavour shall be made to dispose of such application within a period of two months from the date of receipt of the application.

(2) The Copyright Board may, on receipt of an application under sub-section (1), inquire, or direct such inquiry as it considers necessary to establish the credentials of the applicant and satisfy itself that the application has been made in good faith.

(3) If the Copyright Board is satisfied, after giving to the owners of rights in the work a reasonable opportunity of being heard and after holding such inquiry as it may deem necessary, that a compulsory licence needs to be issued to make the work available to the disabled, it may direct the Registrar of Copyrights to grant to the applicant such a licence to publish the work.

(4) Every compulsory licence issued under this section shall specify the means and format of publication, the period during which the compulsory licence may be exercised and, in the case of issue of copies, the number of copies that may be issued including the rate or royalty: Provided that where the Copyright Board has issued such a compulsory licence it may, on a further application and after giving reasonable opportunity to the owners of rights, extend the period of such compulsory licence and allow the issue of more copies as it may deem fit.

Statutory licence for cover versions. According to Section 31C, any person desirous of making a cover version, being a sound recording in respect of any literary, dramatic or musical work, where sound recordings of that work have been made by or with the licence or consent of the owner of the right in the work, may do so subject to the provisions of this

section. Provided that such sound recordings shall be in the same medium as the last recording, unless the medium of the last recording is no longer in current commercial use. The person making the sound recordings shall give prior notice of his intention to make the sound recordings in the manner as may be prescribed, and provide in advance copies of all covers or labels with which the sound recordings are to be sold, and pay in advance, to the owner of rights in each work royalties in respect of all copies to be made by him, at the rate fixed by the Copyright Board in this behalf. Provided that such sound recordings shall not be sold or issued in any form of packaging or with any cover or label which is likely to mislead or confuse the public as to their identity, and in particular shall not contain the name or depict in any way any performer of an earlier sound recording of the same work or any cinematograph film in which such sound recording was incorporated and, further, shall state on the cover that it is a cover version made under this section. The person making such sound recordings shall not make any alteration in the literary or musical work which has not been made previously by or with the consent of the owner of rights, or which is not technically necessary for the purpose of making the sound recordings. Provided that such sound recordings shall not be made until the expiration of five calendar years after the end of the year in which the first sound recordings of the work was made. One royalty in respect of such sound recordings shall be paid for a minimum of fifty thousand copies of each work during each calendar year in which copies of it are made. Provided that the Copyright Board may, by general order, fix a lower minimum in respect of works in a particular language or dialect having regard to the potential circulation of such works. The person making such sound recordings shall maintain such registers and books of account in respect thereof, including full details of existing stock as may be prescribed and shall allow the owner of rights or his duly authorised agent or representative to inspect all records and books of account relating to such sound recording. Provided that if on a complaint brought before the Copyright Board to the effect that the owner of rights has not been paid in full for any sound recordings purporting to be made in pursuance of this section, the Copyright Board is, prima facie, satisfied that the complaint is genuine, it may pass an order ex parte directing the person making the sound recording to cease from making further copies and, after holding such inquiry as it considers necessary, make such further order as it may deem fit, including an order for payment of royalty.

Explanation.—For the purposes of this section “cover version” means a sound recording made in accordance with this section.

Statutory licence for broadcasting of literary and musical works and sound recording.

Section 31D provides that any broadcasting organisation desirous of communicating to the public by way of a broadcast or by way of performance of a literary or musical work and sound recording which has already been published may do so subject to the provisions of this section. The broadcasting organisation shall give prior notice, in such manner as may be prescribed, of its intention to broadcast the work stating the duration and territorial coverage of the broadcast, and shall pay to the owner of rights in each work royalties in the manner and at the rate fixed by the Copyright Board. The rates of royalty for radio broadcasting shall be different from television broadcasting and the copyright Board shall fix separate rates for radio broadcasting and television broadcasting. In fixing the manner and the rate of royalty under aforesaid provision, the Copyright Board may require the broadcasting organisation to

pay an advance to the owners of rights. The names of the authors and the principal performers of the work shall, except in case of the broadcasting organisation communicating such work by way of performance, be announced with the broadcast. No fresh alteration to any literary or musical work, which is not technically necessary for the purpose of broadcasting, other than shortening the work for convenience of broadcast, shall be made without the consent of the owners of rights. The broadcasting organisation shall—

- (a) maintain such records and books of account, and render to the owners of rights such reports and accounts; and
- (b) allow the owner of rights or his duly authorised agent or representative to inspect all records and books of account relating to such broadcast, in such manner as may be prescribed.

Nothing in this section shall affect the operation of any licence issued or any agreement entered into before the commencement of the Copyright (Amendment) Act, 2012.

Licence to produce and publish translations.

Section 32 provides that-

(1) Any person may apply to the Copyright Board for a licence to produce and publish a translation of a literary or dramatic work in any language after a period of seven years from the first publication of the work. (1A) Notwithstanding anything contained in sub-section (1), any person may apply to the Copyright Board for a licence to produce and publish a translation, in printed or analogous forms of reproduction, of a literary or dramatic work, other than an Indian work, in any language in general use in India after a period of three years from the publication of such work, if such translation is required for the purposes of teaching, scholarship or research: Provided that where such translation is in a language not in general use in any developed country, such application may be made after a period of one year from such publications.

(2) Every application under this section shall be made in such form as may be prescribed and shall state the proposed retail price of a copy of the translation of the work.

(3) Every applicant for a licence under this section shall, along with his application, deposit with the Registrar of Copyrights such fee as may be prescribed.

(4) Where an application is made to the Copyright Board under this section, it may, after holding such inquiry as may be prescribed, grant to the applicant a licence, not being an exclusive licence, to produce and publish a translation of the work in the language mentioned in the application—

(i) subject to the condition that the applicant shall pay to the owner of the copyright in the work royalties in respect of copies of the translation of the work sold to the public, calculated at such rate as the Copyright Board may, in the circumstances of each case, determine in the prescribed manner; and

(ii) where such licence is granted on an application under sub-section (1A), subject also to the condition that the licence shall not extend to the export of copies of the translation of the work outside India and every copy of such translation shall contain a notice in the language of such translation that the copy is available for distribution only in India.

Provided that nothing in clause (ii) shall apply to the export by Government or any authority under the Government of copies of such translation in a language other than English, French or Spanish to any country if-

- (1) such copies are sent to citizens of India residing outside India or to any association of such citizens outside India; or
 - (2) such copies are meant to be used for purposes of teaching, scholarship or research and not for any commercial purpose; and
 - (3) in either case, the permission for such export has been given by the Government of that country Provided further that no licence under this section shall be granted, unless— (a) a translation of the work in the language mentioned in the application has not been published by the owner of the copyright in the work or any person authorised by him, within seven years or three years or one year, as the case may be, of the first publication of the work, or if a translation has been so published, it has been out of print;
 - (b) the applicant has proved to the satisfaction of the Copyright Board that he had requested and had been denied authorisation by the owner of the copyright to produce and publish such translation, or that he was, after due diligence on his part, unable to find the owner of the copyright;
 - (c) where the applicant was unable to find the owner of the copyright, he had sent a copy of his request for such authorisation by registered air mail post to the publisher whose name appears from the work, and in the case of an application for a licence under sub-section (1), not less than two months before such application;
 - (cc) a period of six months in the case of an application under sub-section (1A) (not being an application under the proviso thereto), or nine months in the case of an application under the proviso to that sub-section, has elapsed from the date of making the request under clause (b) of this proviso, or where a copy of the request has been sent under clause (c) of this proviso, from the date of sending of such copy, and the translation of the work in the language mentioned in the application has not been published by the owner of the copyright in the work or any person authorised by him within the said period of six months or nine months, as the case may be;
 - (ccc) in the case of any application made under sub-section (1A),— (i) the name of the author and the title of the particular edition of the work proposed to be translated are printed on all the copies of the translation; (ii) if the work is composed mainly of illustrations, the provisions of section 32A are also complied with;
 - (d) the Copyright Board is satisfied that the applicant is competent to produce and publish a correct translation of the work and possesses the means to pay to the owner of the copyright the royalties payable to him under this section;
 - (e) the author has not withdrawn from circulation copies of the work; and
 - (f) an opportunity of being heard is given, wherever practicable, to the owner of the copyright in the work.
- (5) Any broadcasting authority may apply to the Copyright Board for a licence to produce and publish the translation of— (a) a work referred to in sub-section (1A) and published in printed or analogous forms of reproduction; or (b) any text incorporated in audio-visual fixations prepared had published solely for the purpose of systematic instructional activities, for broadcasting such translation for the purposes of teaching or for the dissemination of the results of specialised, technical or scientific research to the experts in any particular field.
- (6) The provisions of sub-sections (2) to (4) in so far as they are relatable to an application under sub-section (1A), shall, with the necessary modifications, apply to the grant of a licence under sub-section (5) and such licence shall not also be granted unless—

- (a) the translation is made from a work lawfully acquired;
- (b) the broadcast is made through the medium of sound and visual recordings; (c) such recording has been lawfully and exclusively made for the purpose of broadcasting in India by the applicant or by any other broadcasting agency; and
- (d) the translation and the broadcasting of such translation are not used for any commercial purposes.

Explanation. For the purposes of this section,— (a) "developed country" means a country which is not a developing country; (b) "developing country" means a country which is for the time being regarded as such in conformity with the practice of the General Assembly of the United Nations; (c) "purposes of research" does not include purposes of industrial research, or purposes of research by bodies corporate (not being bodies corporate owned or controlled by Government) or other associations or body of persons for commercial purposes; (d) "purposes of teaching, research or scholarship" includes— (i) purposes of instructional activity at all levels in educational institutions, including Schools, Colleges, Universities and tutorial institutions; and (ii) purposes of all other types of organised educational activity.

Licence to reproduce and publish works for certain purposes. According to Section 32 A-

(1) Where, after the expiration of the relevant period from the date of the first publication of an edition of a literary, scientific or artistic work,— (a) the copies of such edition are not made available in India; or (b) such copies have not been put on sale in India for a period of six months to the general public, or in connection with systematic instructional activities at a price reasonably related to that normally charged in India for comparable works by the owner of the right of reproduction or by any person authorised by him in this behalf, any person may apply to the Copyright Board for a licence to reproduce and publish such work in printed or analogous forms of reproduction at the price at which such edition is sold or a lower price for the purposes of systematic instructional activities.

(2) Every such application shall be made in such form as may be prescribed and shall state the proposed retail price of a copy of the work to be reproduced. (3) Every applicant for a licence under this section shall, along with his application, deposit with the Registrar of Copyrights such fee as may be prescribed.

(4) Where an application is made to the Copyright Board under this section, it may, after holding such inquiry as may be prescribed, grant to the applicant a licence, not being an exclusive licence, to produce and publish a reproduction of the work mentioned in the application subject to the conditions that,— (i) the applicant shall pay to the owner of the copyright in the work royalties in respect of copies of the reproduction of the work sold to the public, calculated at such rate as the Copyright Board may, in the circumstances of each case, determine in the prescribed manner; (ii) a licence granted under this section shall not extend to the export of copies of the reproduction of the work outside India and every copy of such reproduction shall contain a notice that the copy is available for distribution only in India. Provided that no such licence shall be granted unless— (a) the applicant has proved to the satisfaction of the Copyright Board that he had requested and had been denied authorisation by the owner of the copyright in the work to reproduce and publish such work or that he was, after due diligence on his part, unable to find such owner; (b) where the

applicant was unable to find the owner of the copyright, he had sent a copy of his request for such authorisation by registered airmail post to the publisher whose name appears from the work not less than three months before the application for the licence; (c) the Copyright Board is satisfied that the applicant is competent to reproduce and publish an accurate reproduction of the work and possesses the means to pay to the owner of the copyright the royalties payable to him under this section; (d) the applicant undertakes to reproduce and publish the work at such price as may be fixed by the Copyright Board, being a price reasonably related to the price normally charged in India for works of the same standard on the same or similar subjects; (e) a period of six months in the case of application for the reproduction and publication of any work of natural science, physical science, mathematics or technology, or a period of three months in the case of an application for the reproduction and publication of any other work, has elapsed from the date of making the request under clause (a), or where a copy of the request has been sent under clause (b), from the date of sending of a copy, and a reproduction of the work has not been published by the owner of the copyright in the work or any person authorised by him within the said period of six months or, three months, as the case may be; (f) the name of the author and the title of the particular edition of the work proposed to be reproduced are printed on all the copies of the reproduction; (g) the author has not withdrawn from circulation copies of the work; and (h) an opportunity of being heard is given, wherever practicable, to the owner of the copyright in the work.

(5) No licence to reproduce and publish the translation of a work shall be granted under this section unless such translation has been published by the owner of the right of translation or any person authorised by him and the translation is not in a language in general use in India.

(6) The provisions of this section shall also apply to the reproduction and publication, or translation into a language in general use in India, of any text incorporated in audio-visual fixations prepared and published solely for the purpose of systematic instructional activities.

Explanation. For the purposes of this section, "relevant period", in relation to any work, means a period of— (a) seven years from the date of the first publication of that work, where the application is for the reproduction and publication of any work of, or relating to, fiction, poetry, drama, music or art; (b) three years from the date of the first publication of that work, where the application is for the reproduction and publication of any work of, or relating to, natural science, physical science, mathematics or technology; and (c) five years from the date of the first publication of that work, in any other case.

Termination of licences issued under this chapter. According to Section 32B- (1) If, at any time after the granting of a licence to produce and publish the translation of a work in any language under sub-section (1A) of section 32 (hereafter in this sub-section referred to as the licensed work), the owner of the copyright in the work or any person authorised by him publishes a translation of such work in the same language and which is substantially the same in content at a price reasonably related to the price normally charged in India for the translation of works of the same standard on the same or similar subject, the licence so granted shall be terminated. Provided that no such termination shall take effect until after the expiry of a period of three months from the date of service of a notice in the prescribed manner on the person holding such licence by the owner of the right of translation intimating the publication of the translation as aforesaid: Provided further that copies of the licensed

work produced and published by the person holding such licence before the termination of the licence takes effect may continue to be sold or distributed until the copies already produced and published are exhausted.

(2) If, at any time after the granting of a licence to produce and publish the reproduction or translation of any work under section 32A, the owner of the right of reproduction or any person authorised by him sells or distributes copies of such work or a translation thereof, as the case may be, in the same language and which is substantially the same in content at a price reasonably related to the price normally charged in India for work of the same standard on the same or similar subject, the licence so granted shall be terminated: Provided that no such termination shall take effect until after the expiry of a period of three months from the date of service of a notice in the prescribed manner on the person holding the licence by the owner of the right of reproduction intimating the sale or distribution of the copies of the editions of work as aforesaid: Provided further that any copies already reproduced by the licensee before such termination takes effect may continue to be sold or distributed until the copies already produced are exhausted.

C. Procedure for Protection:

Copyright Office and Copyright Board:

Copyright Office: To administer the provisions of the Copyright Act, Section- 9 of the Act provides for establishment of Copyright Office under the control of the Registrar of Copyrights who shall act under the superintendence and direction of the Central Government. Also, there shall be a seal for the Copyright Office.

Further, Section- 10 provides that the Central Government shall appoint a Registrar of Copyrights and may appoint one or more Deputy Registrars of Copyrights. A Deputy Registrar of Copyrights shall discharge under the superintendence and direction of the Registrar of Copyrights such functions of the Registrar under this Act as the Registrar may, from time to time, assign to him; and any reference in this Act to the Registrar of Copyrights shall include a reference to a Deputy Registrar of Copyrights when so discharging any such functions.

Copyright Board: Section 11 of the Act provides that the Central Government shall constitute a Board to be called the Copyright Board which shall consist of a Chairman and two other members. The salaries and allowances payable to and the other terms and conditions of service of the Chairman and other members of the Copyright Board shall be such as may be prescribed.

Provided that neither the salary and allowances nor the other terms and conditions of service of the Chairman or any other member shall be varied to his disadvantage after appointment. Further the provision provides that the Chairman of the Copyright Board shall be a person who is, or has been, a Judge of a High Court or is qualified for appointment as a Judge of a

High Court. The Central Government may after consultation with the Chairman of the Copyrights Board, appoint a Secretary to the Copyright Board and such other officers and employees as may be considered necessary for the efficient discharge of the functions of the Copyright Board.

Powers and Procedure of Copyright Board:

Section 12 of the Act provides that the Copyright Board shall, subject to any rules that may be made under this Act, have power to regulate its own procedure, including the fixing of places and times of its sittings. Provided that the Copyright Board shall ordinarily hear any proceeding instituted before it under this Act within the zone in which, at the time of the institution of the proceeding, the person instituting the proceeding actually and voluntarily resides or carries on business or personally works for gain. In this sub-section "zone" means a zone specified in Section 15 of the States Reorganisation Act, 1956. The Copyright Board may exercise and discharge its powers and functions through Benches constituted by the Chairman of the Copyright Board from amongst its members. Provided that, if the Chairman is of opinion that any matter of importance is required to be heard by a larger bench, he may refer the matter to a special bench consisting of five members.

If there is a difference of opinion among the members of the Copyright Board or any Bench thereof in respect of any matter coming before it for decision under this Act, the opinion of the majority shall prevail. Provided that where there is no such majority, the opinion of the Chairman shall prevail.

The Chairman may authorise any of its members to exercise any of the powers conferred on it by Section 74 and any order made or act done in exercise of those powers by the member so authorised shall be deemed to be the order or act, as the case may be, of the Board.

No member of the Copyright Board shall take part in any proceedings before the Board in respect of any matter in which he has a personal interest.

No act done or proceeding taken by the Copyright Board under this Act shall be questioned on the ground merely of the existence of any vacancy in, or defect in the constitution of, the Board.

The Copyright Board shall be deemed to be a civil court for the purposes of Sections 345 and 346 of the Code of Criminal Procedure, 1973, and all proceedings before the Board shall be deemed to be judicial proceedings within the meaning of sections 193 and 228 of the Indian Penal Code.

Functions of the Copyright Board:

The following are the main functions of the Copyright Board:

- i. To decide whether a work has been published or as to the date on which work was published for the purpose of determining the term of Copyright. (Sec. 6)
- ii. To decide whether the term of Copyright for any work is shorter in any other country than under the Act. (Sec. 6)
- iii. To settle disputes arising in respect of assignment of Copyright under Section 19A.
- iv. To grant compulsory licences in respect of Indian works withheld from public. (Sec. 31)
- v. To grant compulsory licences to publish unpublished works. (Sec. 31A)
- vi. To grant compulsory licence to produce and publish translation of literary and dramatic works. (Sec. 32)
- vii. To grant compulsory licences to reproduce and publish certain categories of literary, scientific or artistic works for certain purposes. (Sec 32A)
- viii. To rectify the register on the application of the Registrar of Copyright or of any person aggrieved. (Sec. 50)

An appeal against all orders passed by the Copyright Board except under Section 6 lies to the High Court, having jurisdiction. The decision of the Copyright Board, under Section 6, shall be final if any question arises whether a work has been published or as to the date on which a work was published, or whether the term of copyright for any work is shorter in any other country than that provided in respect of that work under this Act.

Registration of Copyright:

Register of copyright- There shall be kept at the Copyright Office a register in the prescribed form to be called the Register of Copyrights in which may be entered the names or titles of works and the names and addresses of authors, publishers and owners of copyright and such other particulars as may be prescribed. (Sec. 44)

Form of Register of Copyrights. — As per Rule 15 of Copyright Rules, 1958, The Register of Copyrights shall be kept in six parts as follows :—

Part I - Literary works other than computer programmes, tables and compilations including computer data bases and dramatic works.

Part II - Musical works

Part III - Artistic works

Part IV - Cinematograph films

Part V - Sound recordings

Part VI - Computer programmes, tables and compilations including computer data bases.

The Register of Copyrights shall contain the particulars specified in Form III.

Application for Registration of Copyright - As per Rule 16 of Copyright Rules, 1958:

(1) Every application for registration of copyright shall be made in accordance with Form IV and every application for registration of changes in the particulars of copyright entered in the Register of Copyright shall be made in accordance with Form V.

(2) Every such application shall be in respect of one work only, shall be made in triplicate and shall be accompanied by the fee specified in the Second Schedule in this behalf.

(3) The person applying for registration shall give notice of his application to every person who claims or has any interest in the subject-matter of the copyright or disputes the rights of the applicant to it.

(4) If no objection to such registration is received by the Registrar of Copyrights within thirty days of the receipt of the application by him, he shall, if satisfied about the correctness of the particulars given in the application, enter such particulars in the Register of Copyrights.

(5) If the Registrar of Copyrights receives any objections for such registration within the time specified in sub-rule (4), or, if he is not satisfied about the correctness of the particulars given in the application, he may, after holding such inquiry as he deems fit, enter such particulars of the work in the Register of Copyrights as he considers proper.

(6) The Registrar of Copyrights shall, as soon as may be, send, wherever practicable, a copy of the entries made in the Register of Copyrights to the parties concerned.

Entries in register of Copyrights. -(Sec. 45) -The author or publisher of, or the owner of or other person interested in the copyright in, any work may make an application in the prescribed form accompanied by the prescribed fee to the Registrar of Copyrights for entering particulars of the work in the Register of Copyrights. Provided that in respect of an artistic work which is used or is capable of being used in relation to any goods or services the application shall include a statement to that effect and shall be accompanied by a certificate from the Registrar of Trade Marks referred to in section 3 of the Trade Marks Act, 1999, to the effect that no trade mark identical with or deceptively similar to such artistic work has been registered under that Act in the name of, or that no application has been made under that Act for such registration by, any person other than the applicant. On receipt of an application in respect of any work under sub-section (1), the Registrar of Copyrights may, after holding such inquiry as he may deem fit, enter the particulars of the work in the Register of Copyrights.

Indexes. There shall be also kept at the Copyright Office such indexes of the Register of Copyrights as may be prescribed. (Sec. 46)

According to Rule 18, Copyright Rules, 1958- (1) There shall be kept at the Copyright Office the following indexes for each part of the Register of Copyrights, namely:— (i) a general Author Index;

(ii) a general Title Index;

(iii) an Author Index of works in each language; and

(iv) a Title Index of works in each language.

Every Index shall be arranged alphabetically in the form of cards.

Forms and inspection of register. The Register of Copyrights and indexes thereof kept under this Act shall at all reasonable times be open to inspection, and any person shall be entitled to take copies of, or make extracts from, such register or indexes on payment of such fee and subject to such conditions as may be prescribed. (Sec. 47)

As per Rule 19, the Register of Copyrights and Indexes thereof shall at all reasonable time be open to inspection by any person in such manner and subject to such conditions as the Registrar of Copyrights may specify.

Register of Copyrights to be prima facie evidence of particulars entered therein. (Sec. 48)
The Register of Copyrights shall be prima facie evidence of the particulars entered therein and documents purporting to be copies of any entries therein, or extracts therefrom certified by the Registrar of Copyrights and sealed with the seal of the Copyright Office shall be admissible in evidence in all courts without further proof or production of the original.

Correction of entries in the Register of Copyrights. (Sec. 49) The Registrar of Copyrights may, in the prescribed cases and subject to the prescribed conditions, amend or alter the Register of Copyrights by— (a) correcting any error in any name, address or particulars; or (b) correcting any other error which may have arisen therein by accidental slip or omission.

As per Rule 17, The Registrar of Copyrights may, on his own motion or on application of any interested person, amend, or alter the Register of Copyrights in the manner specified in section 49 after giving, wherever practicable, to the person affected by such amendment or alteration, an opportunity to show cause against such amendment or alteration, and communicate to such person the amendment or alteration made.

Rectification of Register by Copyright Board. The Copyright Board, on application of the Registrar of Copyrights or of any person aggrieved, shall order the rectification of the Register of Copyrights by— (a) the making of any entry wrongly omitted to be made in the

register, or (b) the expunging of any entry wrongly made in, or remaining on, the register, or (c) the correction of any error or defect in the register. (Sec. 50)

Entries in the Register of Copyrights, etc., to be published. Every entry made in the Register of Copyrights or the particulars of any work entered under section 45, the correction of every entry made in such register under section 49, and every rectification ordered under section 50, shall be published by the Registrar of Copyrights in the Official Gazette or in such other manner as he may deem fit. (Sec. 50A)

Copies and extracts of the Register of Copyrights and Indexes. As per Rule 20, Any person shall be entitled to take copies of, or make extracts from, the Register of Copyrights or Indexes on payment of the fee specified in the Second Schedule subject to such supervision as the Registrar of Copyrights may arrange. The Registrar of Copyrights shall, on an application made in that behalf and on payment of the fee specified in the Second Schedule, furnish a certified copy of any entries made in the Register of Copyrights and Indexes thereof.

D. Enforcement and Remedies:

Infringement:

The owner of a copyright work has the exclusive right to do certain acts in respect of the work. If any person does any of these acts without authority he will be committing an infringement of the copyright in the work. The nature of the rights depends upon the nature of the work. Reproduction of the work in any material form, performance of the work in public and communication of the work to the public in certain forms are the usual methods by which the copyright in any work is commercially exploited for profit. If any person without authority commercially exploits the work for profit he will be infringing the copyright. There are three types of remedies available against infringement of copyright; namely, civil, criminal and administrative. The copyright work can be used for certain specified purposes without committing an infringement.

Infringement of Copyright:

According to Section 51 of the Act- Copyright in a work shall be deemed to be infringed—

(a) when any person, without a licence granted by the owner of the copyright or the Registrar of Copyrights under this Act or in contravention of the conditions of a licence so granted or of any condition imposed by a competent authority under this Act— (i) does anything, the exclusive right to do which is by this Act conferred upon the owner of the copyright, or

(ii) permits for profit any place to be used for the communication of the work to the public where such communication constitutes an infringement of the copyright in the work, unless

he was not aware and had no reasonable ground for believing that such communication to the public would be an infringement of copyright; or

(b) when any person— (i) makes for sale or hire, or sells or lets for hire, or by way of trade displays or offers for sale or hire, or

(ii) distributes either for the purpose of trade or to such an extent as to affect prejudicially the owner of the copyright, or

(iii) by way of trade exhibits in public, or

(iv) imports into India, any infringing copies of the work Provided that nothing in sub-clause (iv) shall apply to the import of one copy of any work for the private and domestic use of the importer.

Explanation: For the purposes of this section, the reproduction of a literary, dramatic, musical or artistic work in the form of a cinematograph film shall be deemed to be an "infringing copy".

According to Section 2(m) **"infringing copy"** means-

(i) in relation to a literary, dramatic, musical or artistic work, a reproduction thereof otherwise than in the form of a cinematographic film;

(ii) in relation to a cinematographic film, a copy of the film made on any medium by any means;

(iii) in relation to a sound recording, any other recording embodying the same sound recording, made by any means;

(iv) in relation to a programme or performance in which such a broadcast reproduction right or a performer's right subsists under the provisions of this Act, the sound recording or a cinematographic film of such programme or performance, if such reproduction, copy or sound recording is made or imported in contravention of the provisions of this Act.

Essentials Ingredients of Infringement:

Depending upon the kind of copyright work, infringement involves one or more of the following acts:

- 1) Reproduction of the work in a material form,
- 2) Publication of the work,
- 3) Communication of the work to the public,
- 4) Performance of the work in public,

- 5) Making of adaptations and translations of the work and doing any of the above acts in relation to a substantial part of the work.

Infringement of copyright cannot be avoided by a difference in dimensions or inexact reproductions if a substantial part of the work has been copied. In most cases there will be no direct evidence of copying. Copying can only be deduced by inference from all the surrounding circumstances. In the case of infringement of literary works the defendants' work containing the same errors as in the plaintiffs' work, similarity in language and idiosyncrasies in style may constitute some evidence of copying.

What Copyright Protects:

There is no copyright in ideas however original or brilliant or in information. What copyright protects is not the raw materials from which the work is created but the skill and labour employed by the author in the creation of the work. Any other person can produce substantially the same work using the same raw materials or even ideas without infringement if he does it originally without copying from the other work.

In the case of *R.G. Anand v M/s Deluxe Films & ors.* AIR 1978 SC 1613 Supreme Court has emerged the following propositions:

There can be no copyright in an idea, subject-matter, themes, plots or historical or legendary facts and violation of the copyright in such cases is confined to the form, manner and arrangement and expression of the idea by the author of the copyrighted work.

Where the same idea is being developed in a different manner, it is manifest that the source being common, similarities are bound to occur. In such a case the courts should determine whether or not the similarities are on fundamental or substantial aspects of the mode of expression adopted in the copyrighted work. If the defendant's work is nothing but a literal imitation of the copyrighted work with some variations here and there it would amount to violation of the copyright. In other words, in order to be actionable the copy must be a substantial and material one which at once leads to the conclusion that the defendant is guilty of an act of piracy.

One of the surest and the safest test to determine whether or not there has been a violation of copyright is to see if the reader, spectator or the viewer after having read or seen both the works is clearly of the opinion and gets an unmistakable impression that the subsequent work appears to be a copy of the original.

Where the theme is the same but is presented and treated differently so that the subsequent work becomes a completely new work, no question of violation of copy right arises.

Where however apart from the similarities appearing in the two works there are also material and broad dissimilarities which negative the intention to copy the original and the coincidences appearing in the two works are clearly incidental no infringement of the copyright comes into existence.

As a violation of copyright amounts to an act of piracy it must be proved by clear and cogent evidence after applying the various tests laid down by the case-law discussed above.

Where however the question is of the violation of the copyright of stage play by a film producer or a director the task of the plaintiff becomes more difficult to prove piracy. It is manifest that unlike a stage play a film has a much broader prospective, wider field and a bigger background where the defendants can by introducing a variety of incidents give a colour and complexion different from the manner in which the copyrighted work has expressed the idea. Even so, if the viewer after seeing the film gets a totality of impression that the film is by and large a copy of the original play, violation of the copyright may be said to be proved.

Exception to Infringement of Copyright:

According to Section 52 the following acts shall not constitute an infringement of copyright, namely:

- (a) a fair dealing with any work, not being a computer programme, for the purposes of—
 - (i) private or personal use, including research;
 - (ii) criticism or review, whether of that work or of any other work;
 - (iii) the reporting of current events and current affairs, including the reporting of a lecture delivered in public.

Explanation.—The storing of any work in any electronic medium for the purposes mentioned in this clause, including the incidental storage of any computer programme which is not itself an infringing copy for the said purposes, shall not constitute infringement of copyright.

- (aa) the making of copies or adaptation of a computer programme by the lawful possessor of a copy of such computer programme, from such copy— (i) in order to utilise the computer programme for the purposes for which it was supplied; or (ii) to make back-up copies purely as a temporary protection against loss, destruction or damage in order only to utilise the computer programme for the purpose for which it was supplied;
- (ab) the doing of any act necessary to obtain information essential for operating inter-operability of an independently created computer programme with other programmes by a

lawful possessor of a computer programme provided that such information is not otherwise readily available;

(ac) the observation, study or test of functioning of the computer programme in order to determine the ideas and principles which underline any elements of the programme while performing such acts necessary for the functions for which the computer programme was supplied;

(ad) the making of copies or adaptation of the computer programme from a personally legally obtained copy for non-commercial personal use;

(b) the transient or incidental storage of a work or performance purely in the technical process of electronic transmission or communication to the public;

(c) transient or incidental storage of a work or performance for the purpose of providing electronic links, access or integration, where such links, access or integration has not been expressly prohibited by the right holder, unless the person responsible is aware or has reasonable grounds for believing that such storage is of an infringing copy:

Provided that if the person responsible for the storage of the copy has received a written complaint from the owner of copyright in the work, complaining that such transient or incidental storage is an infringement, such person responsible for the storage shall refrain from facilitating such access for a period of twenty-one days or till he receives an order from the competent court refraining from facilitating access and in case no such order is received before the expiry of such period of twenty-one days, he may continue to provide the facility of such access;

(d) the reproduction of any work for the purpose of a judicial proceeding or for the purpose of a report of a judicial proceeding;

(e) the reproduction or publication of any work prepared by the Secretariat of a Legislature or, where the Legislature consists of two Houses, by the Secretariat of either House of the Legislature, exclusively for the use of the members of that Legislature;

(f) the reproduction of any work in a certified copy made or supplied in accordance with any law for the time being in force;

(g) the reading or recitation in public of reasonable extracts from a published literary or dramatic work;

(h) the publication in a collection, mainly composed of non-copyright matter, bona fide intended for instructional use, and so described in the title and in any advertisement issued by

or on behalf of the publisher, of short passages from published literary or dramatic works, not themselves published for such use in which copyright subsists:

Provided that not more than two such passages from works by the same author are published by the same publisher during any period of five years. Explanation.—In the case of a work of joint authorship, references in this clause to passages from works shall include references to passages from works by any one or more of the authors of those passages or by any one or more of those authors in collaboration with any other person;

(i) the reproduction of any work—

(i) by a teacher or a pupil in the course of instruction; or

(ii) as part of the questions to be answered in an examination; or

(iii) in answers to such questions;

(j) the performance, in the course of the activities of an educational institution, of a literary, dramatic or musical work by the staff and students of the institution, or of a cinematograph film or a sound recording if the audience is limited to such staff and students, the parents and guardians of the students and persons connected with the activities of the institution or the communication to such an audience of a cinematograph film or sound recording;

(k) the causing of a recording to be heard in public by utilising it,— (i) in an enclosed room or hall meant for the common use of residents in any residential premises (not being a hotel or similar commercial establishment) as part of the amenities provided exclusively or mainly for residents therein; or (ii) as part of the activities of a club or similar organisation which is not established or conducted for profit; (iii) as part of the activities of a club, society or other organisation which is not established or conducted for profit;

(l) the performance of a literary, dramatic or musical work by an amateur club or society, if the performance is given to a non-paying audience, or for the benefit of a religious institution;

(m) the reproduction in a newspaper, magazine or other periodical of an article on current 35 economic, political, social or religious topics, unless the author of such article has expressly reserved to himself the right of such reproduction; (n) the storing of a work in any medium by electronic means by a noncommercial public library, for preservation if the library already possesses a non-digital copy of the work;

(o) the making of not more than three copies of a book (including a pamphlet, sheet of music, map, chart or plan) by or under the direction of the person in charge of a non-commercial public library for the use of the library if such book is not available for sale in India;

(p) the reproduction, for the purpose of research or private study or with a view to publication, of an unpublished literary, dramatic or musical work kept in a library, museum or other institution to which the public has access: Provided that where the identity of the author of any such work or, in the case of a work of joint authorship, of any of the authors is known to the library, museum or other institution, as the case may be, the provisions of this clause shall apply only if such reproduction is made at a time more than sixty years from the date of the death of the author or, in the case of a work of joint authorship, from the death of the author whose identity is known or, if the identity of more authors than one is known from the death of such of those authors who dies last;

(q) the reproduction or publication of— (i) any matter which has been published in any Official Gazette except an Act of a Legislature; (ii) any Act of a Legislature subject to the condition that such Act is reproduced or published together with any commentary thereon or any other original matter; (iii) the report of any committee, commission, council, board or other like body appointed by the Government if such report has been laid on the Table of the Legislature, unless the reproduction or publication of such report is prohibited by the Government; (iv) any judgement or order of a court, tribunal or other judicial authority, unless the reproduction or publication of such judgment or order is prohibited by the court, the tribunal or other judicial authority, as the case may be;

(r) the production or publication of a translation in any Indian language of an Act of a Legislature and of any rules or orders made thereunder— (i) if no translation of such Act or rules or orders in that language has previously been produced or published by the Government; or (ii) where a translation of such Act or rules or orders in that language has been produced or published by the Government, if the translation is not available for sale to the public: Provided that such translation contains a statement at a prominent place to the effect that the translation has not been authorised or accepted as authentic by the Government;

(s) the making or publishing of a painting, drawing, engraving or photograph of a work of architecture or the display of a work of architecture;

(t) the making or publishing of a painting, drawing, engraving or photograph of a sculpture, or other artistic work falling under sub-clause (iii) of clause (c) of section 2, if such work is permanently situate in a public place or any premises to which the public has access;

(u) the inclusion in a cinematograph film of— (i) any artistic work permanently situate in a public place or any premises to which the public has access; or (ii) any other artistic work, if such inclusion is only by way of background or is otherwise incidental to the principal matters represented in the film;

(v) the use by the author of an artistic work, where the author of such work is not the owner of the copyright therein, of any mould, cast, sketch, plan, model or study made by him for the purpose of the work: Provided that he does not thereby repeat or imitate the main design of the work;

(w) the making of a three-dimensional object from a two-dimensional artistic work, such as a technical drawing, for the purposes of industrial application of any purely functional part of a useful device;

(x) the reconstruction of a building or structure in accordance with the architectural drawings or plans by reference to which the building or structure was originally constructed: Provided that the original construction was made with the consent or licence of the owner of the copyright in such drawings and plans;

(y) in relation to a literary, dramatic, artistic or musical work recorded or reproduced in any cinematograph film the exhibition of such film after the expiration of the term of copyright therein: Provided that the provisions of sub-clause (ii) of clause (a), sub-clause (a) of clause (b) and clauses (d), (f), (g), (m) and (p) shall not apply as respects any act unless that act is accompanied by an acknowledgment— (i) identifying the work by its title or other description; and (ii) unless the work is anonymous or the author of the work has previously agreed or required that no acknowledgement of his name should be made, also identifying the author;

(z) the making of an ephemeral recording, by a broadcasting organisation using its own facilities for its own broadcast by a broadcasting organisation of a work which it has the right to broadcast; and the retention of such recording for archival purposes on the ground of its exceptional documentary character;

(za) the performance of a literary, dramatic or musical work or the communication to the public of such work or of a sound recording in the course of any bona fide religious ceremony or an official ceremony held by the Central Government or the State Government or any local authority. Explanation. For the purpose of this clause, religious ceremony including a marriage procession and other social festivities associated with a marriage.

(zb) the adaptation, reproduction, issue of copies or communication to the public of any work in any accessible format, by—

- (i) any person to facilitate persons with disability to access to works including sharing with any person with disability of such accessible format for private or personal use, educational purpose or research; or
- (ii) (ii) any organisation working for the benefit of the persons with disabilities in case the normal format prevents the enjoyment of such works by such persons:

Provided that the copies of the works in such accessible format are made available to the persons with disabilities on a non-profit basis but to recover only the cost of production:

Provided further that the organization shall ensure that the copies of works in such accessible format are used only by persons with disabilities and takes reasonable steps to prevent its entry into ordinary channels of business.

Explanation.—For the purposes of the sub-clause, “any organization” includes and organization registered under section 12A of the Income-tax Act, 1961 and working for the benefit of persons with disability or recognized under Chapter X of the Persons with Disabilities (Equal Opportunities, Protection or Rights and full Participation) Act, 1995 or receiving grants from the government for facilitating access to persons with disabilities or an educational institution or library or archives recognized by the Government.

(zc) the importation of copies of any literary or artistic work, such as labels, company logos or promotional or explanatory material, that is purely incidental to other goods or products being imported lawfully.

The above provisions shall apply to the doing of any act in relation to the translation of a literary, dramatic or musical work or the adaptation of a literary, dramatic, musical or artistic work as they apply in relation to the work itself.

Remedies:

Protection of rights under the copyright law, which is basically a negative right is as much a problem of complying with the mandatory provisions of the procedural law as the effective exercise of investigative and adjudicatory functions by the enforcing authorities and the courts.

Section 54 to Section 62 of the Copyright Act provide for civil remedies under the Act. Section 55 provides that where copyright in any work has been infringed, the owner of the copyright can, except as otherwise provided in the Act, be entitled to all remedies like injunctions, damages and accounts as are conferred by law for the infringement of a right. However, if the defendant proves that at the date of the infringement he was not aware and had no reasonable ground to believe that copyright subsisted in the work, the plaintiff will not be entitled to any remedy other than an injunction in respect of the infringement and a decree for the whole or part of the profits made by the defendant by the sale of the infringing copies as the court may, in the circumstances, deem reasonable.

In *Zee Telefilm Limited v. Aalia Productions & Others* 2000 PTC 382 Bom. there was a dispute relating to transfer of copyright in TV serial ‘India’s Most Wanted’. It was held that in the absence of any specific rights assigned by the defendants in respect of concept/script/story/synopsis/structure and/or format of programme, the plaintiffs cannot seek injunction against the defendant. The assignment agreement executed between the plaintiff and the defendants as regards structure, format, concept, synopsis and script vague and uncertain, the plaintiffs are not entitled to any interim relief.

The case of *Hawkins Cookers Ltd. v. Magicook Appliances Co.*, 100(2002) DLT698 discussed the grant of permanent injunction to the plaintiff for restraining the defendant from using a label for pressure cookers, which was deceptively similar to the registered trade mark 'HAWKINS' of the plaintiff – On non-appearance of the plaintiff, an *ex-parte* order was passed and it was ruled that, the unjust enrichment by the infringing party, was a mischief and the plaintiff was to be protected from it as per Section 55 of the Copyright Act, 1957. Hence permanent injunction was granted.

In any civil proceedings under the Copyright Act for infringement of copyright, it is the District Court which will have jurisdiction over such matters. Section 62 (2) further provides that notwithstanding anything contained in the Civil Procedure Code, 1908 or any other law for the time being in force, the District Court within the local limits of whose jurisdiction the person instituting the suit is actually or voluntarily residing or carrying on business or personally working for gain will have jurisdiction in the matter.

Administrative remedies consist of moving the Registrar of Copyrights under Section 53 to ban the import of infringing copies into India and the delivery of infringing copies confiscated to the owner of the copyright.

Criminal remedies provide for the imprisonment of the accused or imposition of fine or both, seizure of infringing Copies and delivery of infringing copies to the owner of the copyright. Prior to the maximum punishment for infringement of copyright under Section 63 of the Copyright Act, 1957 was one year imprisonment and fine. These punishments were enhanced by the Copyright (Amendment) Act, 1984 with a view to curbing widespread piracy in video-taping and musical records. Under these provisions, a person who knowingly infringes or abets the infringement of copyright in a work or any other right conferred by the

Copyright Act, is punishable with imprisonment for a term of not less than six months but which may extend to three years and fine which shall not be less than rupees 50,000/-, but which may extend to rupees 2,00,000/-.

However, the court has the discretion to reduce the minimum term of imprisonment and the minimum fine for adequate and special reasons. For the second and subsequent convictions, the minimum term of imprisonment has been prescribed as one year and the minimum fine rupees 1,00,000/-. The amendment in 1994, has further restricted the discretion of the court to impose lesser penalties than the minimum prescribed in the Act. The imposition of lesser penalties than the minimum prescribed in the Act has been restricted to cases where the infringement has not been made for gain in the course of trade and business. In other words, courts have been given a discretion to impose a lesser penalty where the infringement is of a technical nature and not motivated by business considerations.

Section 54 defines the term owner of copyright. In *Rupendra Kashyap v. Jiwan Publishing House* 1996 PTC (16) 439 Del., it was held that CBSE is a public undertaking; examination papers are literary work made under the direction and control of CBSE and applicability of Section 17(dd) of Copyright Act is squarely attracted to the facts of the case. CBSE is the first owner of the copyright in the examination papers on which examinations are conducted by it.

In another case Allahabad high Court has held that the copyright in the question papers set for the High School and Intermediate examinations belongs to the paper-setters and since this copyright neither belonged to nor has been assigned to the Board, the notification which declares that 'copyright of the question papers set at the examinations conducted by Board

shall vest in the Board' is clearly bad. Simply by issuing a notification under the Intermediate Education Act, the State Government could not arrogate to itself or to the Board a right which neither of them possessed under the law relating to copyright, embodied in the Copyright Act of 1957 (*Agarwala Publishing House v. Board of High School and Intermediate Education & Another AIR 1996 All LJ 550*).

Section 58 entitles the owner of the copyright to initiate proceedings for the possession of infringing copies and other materials related thereto. In this context, the section clarifies that all infringing copies of any work in which copyright subsists and all plates used or intended to be used for the production of such infringing copies shall be deemed to be the property of the owner of the copyright.

Unit – II: Patents

A. Nature and Meaning:

Meaning:

A patent is a form of industrial or intellectual property. A patent is a right granted to a person who has invented a new and useful article or an improvement of an existing article or a new process of making an article. Basically, it consists of an exclusive right to manufacture the new article invented or manufacture an article according to the invented process for a limited period. After the expiry of the period for which exclusive right is granted to the inventor, the invention can be put to use by any person other than the one to whom a patent had been granted. The person to whom a patent is granted is called patentee.

It means grant of some privilege, property or authority made by the Government or the Sovereign of the country to one or more individuals. In other words, it means a government authority or licence conferring a right or title for a set period, especially the sole right to exclude others from making, using, or selling an invention.

Under the Patent Act, 1970, Section 2(m) defines Patent as- "patent" means a patent for any invention granted under this Act. The Patent Rules, 2003 provides for the application for patents. It conveys to the inventor substantive rights and secures to him the valuable monetary right which he can enforce for his own advantage either by using it himself or by conveying the privileges to others. He receives something tangible; something which has present existing value which protects him from some competition and is the source of gain and profit.

Object of Patent law:

A patent is to encourage and develop new technology and industry. An inventor has exclusive right to keep it secretly. He may disclose the new invention only if he is rewarded.

The patent is granted for a statutory period and after the expiry of monopoly period others can use the invention or improve upon it.

Patent law system is based on the theory that “the opportunity of acquiring exclusive rights in an invention stimulates technical progress in four ways:

- i. That it encourages research and invention;
- ii. That it induces an inventor to disclose his discoveries instead of keeping it as trade secrets;
- iii. That it offers a reward for the expenses for developing inventions to the stage at which they are commercially practicable;
- iv. That it provides an inducement to invest capital in new lines of production which might not appear profitable if many competing producers embarked on them simultaneously.

Manufacturers would not be prepared to develop and produce important machinery if others could get the results of their work with impunity.”

B. Scope of Protection:

Protectable Subject Matter- Patentable Invention:

The protectable subject-matter of a patent is an invention.

Section 2(1)(j) of Patents Act, 1970 provides- "invention" means a new product or process involving an inventive step and capable of industrial application.

Patentable inventions:

The question whether there is an invention is a question of fact in each case. What is protected is the result of an invention; the resultant product, so to say. An improvement on something known is a subject-matter of a patent provided it results in a new product or process or a more useful or a more economical product or process.

A patentable combination is the one in which the component elements are so combined as to produce a new result or to arrive at an old result in a better or more expeditious or more economical manner. If the result produced is a new article or a better or a cheaper article than before, the combination will be entitled to a patent.

The mere combination of two or more elements without exercising any inventive faculty and without involving an inventive step cannot be a subject matter of patent. In order to qualify for grant of patent, an invention must have elements of novelty, utility and non-obviousness.

A new product or process involving an inventive step and capable of industrial application is also a patentable invention.

Non- Patentable Inventions:

Sections 3 and 4 of Patents Act, 1970 lists the following as not being inventions within the meaning of the Act and therefore, being unpatentable-

What are not inventions: The following are not inventions within the meaning of this Act,— (a) an invention which is frivolous or which claims anything obviously contrary to well established natural laws;

(b) an invention the primary or intended use or commercial exploitation of which could be contrary public order or morality or which causes serious prejudice to human, animal or plant life or health or to the environment;

(c) the mere discovery of a scientific principle or the formulation of an abstract theory or discovery of any living thing or non-living substance occurring in nature;

(d) the mere discovery of a new form of a known substance which does not result in the enhancement of the known efficacy of that substance or the mere discovery of any new property or new use for a known substance or of the mere use of a known process, machine or apparatus unless such known process results in a new product or employs at least one new reactant.

Explanation.—For the purposes of this clause, salts, esters, ethers, polymorphs, metabolites, pure form, particle size, isomers, mixtures of isomers, complexes, combinations and other derivatives of known substance shall be considered to be the same substance, unless they differ significantly in properties with regard to efficacy;

(e) a substance obtained by a mere admixture resulting only in the aggregation of the properties of the components thereof or a process for producing such substance;

(f) the mere arrangement or re-arrangement or duplication of known devices each functioning independently of one another in a known way;

(g) Omitted by the Patents (Amendment) Act, 2002

(h) a method of agriculture or horticulture;

(i) any process for the medicinal, surgical, curative, prophylactic diagnostic, therapeutic

or other treatment of human beings or any process for a similar treatment of animals to render them free of disease or to increase their economic value or that of their products.

- (j) plants and animals in whole or any part thereof other than micro organisms but including seeds, varieties and species and essentially biological processes for production or propagation of plants and animals;
- (k) a mathematical or business method or a computer programme per se or algorithms;
- (l) a literary, dramatic, musical or artistic work or any other aesthetic creation whatsoever including cinematographic works and television productions;
- (m) a mere scheme or rule or method of performing mental act or method of playing game;
- (n) a presentation of information;
- (o) topography of integrated circuits;
- (p) an invention which in effect, is traditional knowledge or which is an aggregation or duplication of known properties of traditionally known component or components.

Inventions relating to atomic energy not patentable: No patent shall be granted in respect of an invention relating to atomic energy falling within sub section (1) of section 20 of the Atomic Energy Act, 1962 (33 of 1962).

Rights and Obligations of patentee:

The rights conferred on a patentee are purely statutory rights conferred by the Patents Act, 1970. There is no such thing as a common law right in inventions as in the case of trade marks. A patent when granted confers on the patentee following exclusive rights:

- i. Where the subject matter of a patent is a product, to prevent third parties not having the owner's consent from the acts of: making using offering for sale, selling, or importing for these purposes that product;
- ii. Where the subject matter of a patent is a process, to prevent third parties not having the owner's consent from the act of using the process, and from the acts of: using, offering for sale, selling or importing for these purposes at least the product obtained directly by that process.
- iii. Patent owners shall also have the right to assign, or transfer by succession, or right to exploit the patent and to conclude licensing contracts. A patentee has a right to surrender as well.

Besides the abovementioned rights, following obligations are imposed on a patentee:

- i. It is an obligation cast on the patentee to work the invention on a commercial scale either by himself or through licensees. If the patentee does not do this any interested person may obtain a compulsory licence to work the patent.

- ii. In respect of patents relating to drug or medicine or substances used as food, any person interested in working the patent may obtain a licence as a matter of right after a period of three years from the date of grant of patent. If in spite of compulsory licences being granted the invention is not worked on a commercial scale, the patent is liable to be revoked on the ground of non-working by following the procedure prescribed.

Right to exploit the Patent:

Section 48 confers Rights of patentees: Subject to the other provisions contained in this Act and the conditions specified in section 47, a patent granted under this Act shall confer upon the patentee:

(a) where the subject matter of the patent is a product, the exclusive right to prevent third parties, who do not have his consent, from the act of making, using, offering for sale, selling or importing for those purposes that product in India;

(b) where the subject matter of the patent is a process, the exclusive right to prevent third parties, who do not have his consent, from the act of using that process, and from the act of using, offering for sale, selling or importing for those purposes the product obtained directly by that process in India

Right to Licence:

Section 70 confers Power of registered grantee or proprietor to deal with patent: Subject to the provisions contained in this Act relating to co-ownership of patents and subject also to any rights vested in any other person of which notice is entered in the register, the person or persons registered as grantee or proprietor of a patent shall have power to assign, grant licences under, or otherwise deal with, the patent and to give effectual receipts for any consideration for any such assignment, licence or dealing. Provided that any equities in respect of the patent may be enforced in like manner as in respect of any other movable property.

Right to Assign:

As stated above, Section 70 also confers right to assignment on a patentee.

Right to Surrender the Patent:

Section 63 provides Surrender of patents: (1) A patentee may, at any time by giving notice in the prescribed manner to the Controller, offer to surrender his patent.

(2) Where such an offer is made, the Controller shall publish the offer in the prescribed manner, and also notify every person other than the patentee whose name appears in the register as having an interest in the patent.

(3) Any person interested may, within the prescribed period after such publication, give notice to the Controller of opposition to the surrender, and where any such notice is given the Controller shall notify the patentee.

(4) If the Controller is satisfied after hearing the patentee and any opponent, if desirous of being heard, that the patent may properly be surrendered, he may accept the offer and, by order, revoke the patent.

Compulsory Licensing:

Section 84 stipulates that at any time after the expiration of three years from the date of the grant of a patent, any person interested may make an application to the Controller for grant of compulsory licence on patent on any of the following grounds, namely:—

- (a) that the reasonable requirements of the public with respect to the patented invention have not been satisfied, or
- (b) that the patented invention is not available to the public at a reasonably affordable price, or
- (c) that the patented invention is not worked in the territory of India.

An application under this section may be made by any person notwithstanding that he is already the holder of a licence under the patent and no person shall be estopped from alleging that the reasonable requirements of the public with respect to the patented invention are not satisfied or that the patented invention is not worked in the territory of India or that the patented invention is not available to the public at a reasonably affordable price by reason of any admission made by him, whether in such a licence or otherwise or by reason of his having accepted such a licence.

Every application mentioned above shall contain a statement setting out the nature of the applicant's interest together with such particulars as may be prescribed and the facts upon which the application is based.

The Controller, if satisfied that the reasonable requirements of the public with respect to the patented invention have not been satisfied or that the patented invention is not worked in the territory of India or that the patented invention is not available to the public at a reasonably affordable price, may grant a licence upon such terms as he may deem fit.

Where the Controller directs the patentee to grant a licence he may, as incidental thereto, exercise the powers set out in section 88.

In considering the application filed under this section, the Controller shall take into account,—

- (i) the nature of the invention, the time which has elapsed since the sealing of the patent and the measures already taken by the patentee or any licensee to make full use of the invention;
- (ii) the ability of the applicant to work the invention to the public advantage;
- (iii) the capacity of the applicant to undertake the risk in providing capital and working the invention, if the application were granted;
- (iv) as to whether the applicant has made efforts to obtain a licence from the patentee on reasonable terms and conditions and such efforts have not been successful within a reasonable period as the Controller may deem fit;

Provided that this clause shall not be applicable in case of national emergency or other circumstances of extreme urgency or in case of public non-commercial use or on establishment of a ground of anticompetitive practices adopted by the patentee, but shall not be required to take into account matters subsequent to the making of the application.

Explanation.—For the purposes of clause (iv), "reasonable period" shall be construed as a period not ordinarily exceeding a period of six months.

For the purposes of this Chapter, the reasonable requirements of the public shall be deemed not to have been satisfied—

(a) if, by reason of the refusal of the patentee to grant a licence or licences on reasonable terms,—

- (i) an existing trade or industry or the development thereof or the establishment of any new trade or industry in India or the trade or industry of any person or class of persons trading or manufacturing in India is prejudiced; or
- (ii) the demand for the patented article has not been met to an adequate extent or on reasonable terms; or
- (iii) a market for export of the patented article manufactured in India is not being supplied or developed; or

(iv) the establishment or development of commercial activities in India is prejudiced; or

(b) if, by reason of conditions imposed by the patentee upon the grant of licences under the patent or upon the purchase, hire or use of the patented article or process, the manufacture, use or sale of materials not protected by the patent, or the establishment or development of any trade or industry in India, is prejudiced; or

(c) if the patentee imposes a condition upon the grant of licences under the patent to provide exclusive grant back, prevention to challenges to the validity of patent or coercive package licensing; or

(d) if the patented invention is not being worked in the territory of India on a commercial scale to an adequate extent or is not being so worked to the fullest extent that is reasonably practicable; or

(e) if the working of the patented invention in the territory of India on a commercial scale is being prevented or hindered by the importation from abroad of the patented article by—

- (i) the patentee or persons claiming under him or
- (ii) persons directly or indirectly purchasing from him; or

(iii) other persons against whom the patentee is not taking or has not taken proceedings for infringement.

Section 90 lays down terms and conditions of compulsory licences:

(1) In settling the terms and conditions of a licence under section 84, the Controller shall endeavour to secure—

(i) that the royalty and other remuneration, if any, reserved to the patentee or other person beneficially entitled to the patent, is reasonable, having regard to the nature of the invention, the expenditure incurred by the patentee in making the invention or in developing it and obtaining a patent and keeping it in force and other relevant factors;

(ii) that the patented invention is worked to the fullest extent by the person to whom the licence is granted and with reasonable profit to him;

(iii) that the patented articles are made available to the public at reasonably affordable prices;

(iv) that the licence granted is a non-exclusive licence;

(v) that the right of the licensee is non-assignable;

(vi) that the licence is for the balance term of the patent unless a shorter term is consistent with public interest;

(vii) that the licence is granted with a predominant purpose of supply in the Indian market and that the licensee may also export the patented product if need be in accordance with the provisions of sub-clause (iii) of clause (a) of sub-section (7) of section 84;

(viii) that in the case of semi-conductor technology, the licence granted is to work the invention for public non-commercial use;

(ix) that in case the licence is granted to remedy a practice determined after judicial or administrative process to be anti-competitive, the licensee shall be permitted to export the patented product, if need be.

(2) No licence granted by the Controller shall authorise the licensee to import the patented article or an article or substance made by a patented process from abroad where such importation would, but for such authorisation, constitute an infringement of the rights of the patentee.

(3) Notwithstanding anything contained in sub-section (2), the Central Government may, if in its opinion it is necessary so to do, in the public interest, direct the Controller at any time to authorise any licensee in respect of a patent to import the patented article or an article or substance made by a patented process from abroad (subject to such conditions as it considers necessary to impose relating among other matters to the royalty and other remuneration, if any, payable to the patentee, the quantum of import, the sale price of the imported article and the period of importation), and thereupon the Controller shall give effect to the directions.

Revocation of Patent:

Section 64 lays down the conditions where a patent may be revoked. It provides that (1) Subject to the provisions contained in this Act, a patent, whether granted before or after the commencement of this Act, may, be revoked on a petition of any person interested or of the Central Government by the Appellate Board or on a counter-claim in a suit for

infringement of the patent by the High Court on any of the following grounds, that is to say—

- (a) that the invention, so far as claimed in any claim of the complete specification, was claimed in a valid claim of earlier priority date contained in the complete specification of another patent granted in India;
- (b) that the patent was granted on the application of a person not entitled under the provisions of this Act to apply therefor;
- (c) that the patent was obtained wrongfully in contravention of the rights of the petitioner or any person under or through whom he claims;
- (d) that the subject of any claim of the complete specification is not an invention within the meaning of this Act;
- (e) that the invention so far as claimed in any claim of the complete specification is not new, having regard to what was publicly known or publicly used in India before the priority date of the claim or to what was published in India or elsewhere in any of the documents referred to in section 13.
- (f) that the invention so far as claimed in any claim of the complete specification is obvious or does not involve any inventive step, having regard to what was publicly known or publicly used in India or what was published in India or elsewhere before the priority date of the claim;
- (g) that the invention, so far as claimed in any claim of the complete specification, is not useful;
- (h) that the complete specification does not sufficiently and fairly describe the invention and the method by which it is to be performed, that is to say, that the description of the method or the instructions for the working of the invention as contained in the complete specification are not by themselves sufficient to enable a person in India possessing average skill in, and average knowledge of, the art to which the invention relates, to work the invention, or that it does not disclose the best method of performing it which was known to the applicant for the patent and for which he was entitled to claim protection;
- (i) that the scope of any claim of the complete specification is not sufficiently and clearly defined or that any claim of the complete specification is not fairly based on the matter disclosed in the specification;
- (j) that the patent was obtained on a false suggestion or representation;
- (k) that the subject of any claim of the complete specification is not patentable under this Act;
- (l) that the invention so far as claimed in any claim of the complete specification was secretly used in India, otherwise than as mentioned in sub-section (3), before the priority date of the claim;
- (m) that the applicant for the patent has failed to disclose to the Controller the information required by section 8 or has furnished information which in any material particular was false to his knowledge;
- (n) that the applicant contravened any direction for secrecy passed under section 35 or made or caused to be made an application for the grant of a patent outside India in contravention of section 39;
- (o) that leave to amend the complete specification under section 57 or section 58 was obtained by fraud.

- (p) that the complete specification does not disclose or wrongly mentions the source or geographical origin of biological material used for the invention;
- (q) that the invention so far as claimed in any claim of the complete specification was anticipated having regard to the knowledge, oral or otherwise, available within any local or indigenous community in India or elsewhere.
- (2) For the purposes of clauses (e) and (f) of sub-section (1):
- (a) no account shall be taken of personal document or secret trial or secret use; and
- (b) where the patent is for a process or for a product as made by a process described or claimed, the importation into India of the product made abroad by that process shall constitute knowledge or use in India of the invention on the date of the importation, except where such importation has been for the purpose of reasonable trial or experiment only.
- (3) For the purpose of clause (1) of sub-section (1), no account shall be taken of any use of the invention:
- (a) for the purpose of reasonable trial or experiment only; or
- (b) by the Government or by any person authorised by the Government or by a Government undertaking, in consequence of the applicant for the patent or any person from whom he derives title having communicated or disclosed the invention directly or indirectly to the Government or person authorised as aforesaid or to the Government undertaking; or
- (c) by any other person, in consequence of the applicant for the patent or any person from whom he derives title having communicated or disclosed the invention, and without the consent or acquiescence of the applicant or of any person from whom he derives title.
- (4) Without prejudice to the provisions contained in sub-section (1), a patent may be revoked by the High Court on the petition of the Central Government, if the High Court is satisfied that the patentee has without reasonable cause failed to comply with the request of the Central Government to make, use or exercise the patented invention for the purposes of Government within the meaning of section 99 upon reasonable terms.
- (5) A notice of any petition for revocation of a patent under this section shall be served on all persons appearing from the register to be proprietors of that patent or to have shares or interests therein and it shall not be necessary to serve a notice on any other person.

C. Procedure for Protection:

Procedure for obtaining a patent consists of the following steps:

- i. Submission of application.
- ii. Examination of application.
- iii. Advertisement of acceptance of complete specification.
- iv. Opposition of grant of patent to the applicant.
- v. Hearing of the parties.
- vi. Grant and sealing of patent.

Person entitled to apply for patents:

Section 6 provides that:

(1) Subject to the provisions contained in section 134, an application for a patent for an invention may be made by any of the following persons, that is to say,—

- (a) by any person claiming to be the true and first inventor of the invention;
- (b) by any person being the assignee of the person claiming to be the true and first inventor in respect of the right to make such an application;
- (c) by the legal representative of any deceased person who immediately before his death was entitled to make such an application.

(2) An application under sub-section (1) may be made by any of the persons referred to therein either alone or jointly with any other person.

Form of application:

Section 7(1) provides that: (1) Every application for a patent shall be for one invention only and shall be made in the prescribed form and filed in the patent office.

(1A) Every international application under the Patent Cooperation Treaty for a patent, as may be filed designating India shall be deemed to be an application under this Act, if a corresponding application has also been filed before the Controller in India.

(1B) The filing date of an application referred to in sub-section (1A) and its complete specification processed by the patent office as designated office or elected office shall be the international filing date accorded under the Patent Cooperation Treaty.

(2) Where the application is made by virtue of an assignment of the right to apply for a patent for the invention, there shall be furnished with the application, or within such period as may be prescribed after the filing of the application, proof of the right to make the application.

(3) Every application under this section shall state that the applicant is in possession of the invention and shall name the person claiming to be the true and first inventor; and where the person so claiming is not the applicant or one of the applicants, the application shall contain a declaration that the applicant believes the person so named to be the true and first inventor.

(4) Every such application (not being a convention application or an application filed under the Patent Cooperation Treaty designating India) shall be accompanied by a provisional or a complete specification.

Special provision for foreign applicants:

Section 8 provides that:

(1) Where an applicant for a patent under this Act is prosecuting either alone or jointly with any other person an application for a patent in any country outside India in respect of the same or substantially the same invention, or where to his knowledge such an application is being prosecuted by some person through whom he claims or by some person deriving title

from him, he shall file along with his application or subsequently within the prescribed period as the Controller may allow—

(a) a statement setting out detailed particulars of such application; and
(b) an undertaking that, up to the date of grant of patent in India, he would keep the Controller informed in writing, from time to time, of detailed particulars as required under clause (a) in respect of every other application relating to the same or substantially the same invention, if any, filed in any country outside India subsequently to the filing of the statement referred to in the aforesaid clause, within the prescribed time.

(2) At any time after an application for patent is filed in India and till the grant of a patent or refusal to grant of a patent made thereon, the Controller may also require the applicant to furnish details, as may be prescribed, relating to the processing of the application in a country outside India, and in that event the applicant shall furnish to the Controller information available to him within such period as may be prescribed.

Applicant to file provisional and complete specification:

Section 9 provides that: (1) Where an application for a patent (not being a convention application or an application filed under the Patent Cooperation Treaty designating India) is accompanied by a provisional specification, a complete specification shall be filed within twelve months from the date of filing of the application, and if the complete specification is not so filed, the application shall be deemed to be abandoned.

(2) Where two or more applications in the name of the same applicant are accompanied by provisional specifications in respect of inventions which are cognate or of which one is a modification of another and the Controller is of opinion that the whole of such inventions are such as to constitute a single invention and may properly be included in one patent, he may allow one complete specification to be filed in respect of all such provisional specifications. Provided that the period of time specified under sub-section (1) shall be reckoned from the date of filing of the earliest provisional specification.

(3) Where an application for a patent (not being a convention application or an application filed under the Patent Cooperation Treaty designating India) is accompanied by a specification purporting to be a complete specification, the Controller may, if the applicant so requests at any time within twelve months from the date of filing of the application, direct that such specification shall be treated, for the purposes of this Act, as a provisional specification and proceed with the application accordingly.

(4) Where a complete specification has been filed in pursuance of an application for a patent accompanied by a provisional specification or by a specification treated by virtue of a direction under sub-section (3) as a provisional specification, the Controller may, if the applicant so requests at any time before grant of patent, cancel the provisional specification and post-date the application to the date of filing of the complete specification.

Patent Specification:

A patent specification is a technical document describing the invention. A specification may be provisional which gives the initial description of an invention when the application is filed. A complete specification gives full and sufficient detail of an invention in such a manner that a person skilled in the art can use the invention when he reads such a description. The purpose of filing a specification is to make available the invention to the public on the expiry of the term of the patent.

Section 10 of the Act provides for a complete list of contents of a specification as follows:

(1) Every specification, whether provisional or complete, shall describe the invention and shall begin with a title sufficiently indicating the subject-matter to which the invention relates.

(2) Subject to any rules that may be made in this behalf under this Act, drawings may, and shall, if the Controller so requires, be supplied for the purposes of any specification, whether complete or provisional; and any drawings so supplied shall, unless the Controller otherwise directs be deemed to form part of the specification, and references in this Act to a specification shall be construed accordingly.

(3) If, in any particular case, the Controller considers that an application should be further supplemented by a model or sample of anything illustrating the invention or alleged to constitute an invention, such model or sample as he may require shall be furnished before the application is found in order for grant of a patent, but such model or sample shall not be deemed to form part of the specification.

(4) Every complete specification shall—

(a) fully and particularly describe the invention and its operation or use and the method by which it is to be performed;

(b) disclose the best method of performing the invention which is known to the applicant and for which he is entitled to claim protection; and

(c) end with a claim or claims defining the scope of the invention for which protection is claimed;

(d) be accompanied by an abstract to provide technical information on the invention.

Provided that—

(i) the Controller may amend the abstract for providing better information to third parties; and

(ii) if the applicant mentions a biological material in the specification which may not be described in such a way as to satisfy clauses (a) and (b), and if such material is not available to the public, the application shall be completed by depositing the material to an international depository authority under the Budapest Treaty and by fulfilling the following conditions, namely:—

(A) the deposit of the material shall be made not later than the date of filing the patent application in India and a reference thereof shall be made in the specification within the prescribed period;

(B) all the available characteristics of the material required for it to be correctly identified or indicated are included in the specification including the name, address of the depository institution and the date and number of the deposit of the material at the institution;

(C) access to the material is available in the depository institution only after the date of the application of patent in India or if a priority is claimed after the date of the priority;

(D) disclose the source and geographical origin of the biological material in the specification, when used in an invention.

(4A) In case of an international application designating India, the title, description, drawings, abstract and claims filed with the application shall be taken as the complete specification for the purposes of this Act.

(5) The claim or claims of a complete specification shall relate to a single invention, or to a group of inventions linked so as to form a single inventive concept, shall be clear and succinct and shall be fairly based on the matter disclosed in the specification.

(6) A declaration as to the inventor ship of the invention shall, in such cases as may

prescribed, be furnished in the prescribed form with the complete specification or within such period as may be prescribed after the filing of that specification.

(7) Subject to the foregoing provisions of this section, a complete specification filed after a provisional specification may include claims in respect of developments of, or additions to, the invention which was described in the provisional specification, being developments or additions in respect of which the applicant would be entitled under the provisions of section 6 to make a separate application for a patent.

Publication of Application:

Section 11 A provides (1) Save as otherwise provided, no application for patent shall ordinarily be open to the public for such period as may be prescribed.

(2) The applicant may, in the prescribed manner, request the Controller to publish his application at any time before the expiry of the period prescribed under sub-section (1) and subject to the provisions of sub-section (3), the Controller shall publish such application as soon as possible.

(3) Every application for a patent shall, on the expiry of the period specified under sub-section (1), be published, except in cases where the application—

(a) in which secrecy direction is- imposed under section 35; or

(b) has been abandoned under sub-section (1) of section 9; or

(c) has been withdrawn three months prior to the period specified under sub-section (1).

(4) In case a secrecy direction has been given in respect of an application under section 35, then it shall be published after the expiry of the period prescribed under sub-section (1) or when the secrecy direction has ceased to operate, whichever is later.

(5) The publication, of every application under this section shall include the particulars of the date of application, number of application, name and address of the applicant identifying the application and an abstract.

(6) Upon publication of an application for a patent under this section—

(a) the depository institution shall make the biological material mentioned in the specification available to the public;

(b) the patent office may, on payment of such fee as may be prescribed, make the specification and drawings, if any, of such application available to the public.

(7) On and from the date of publication of the application for patent and until the date of grant of a patent in respect of such application, the applicant shall have the like privileges and rights as if a patent for the invention had been granted on the date of publication of the application.

Provided that the applicant shall not be entitled to institute any proceedings for infringement until the patent has been granted.

Provided further that the rights of a patentee in respect of applications made under sub-section (2) of section 5 before the 1st day of January, 2005 shall accrue from the date of grant of the patent.

Provided also that after a patent is granted in respect of applications made under sub-section (2) of section 5, the patent-holder shall only be entitled to receive reasonable royalty from

such enterprises which have made significant investment and were producing and marketing the concerned product prior to the 1st day of January, 2005 and which continue to manufacture the product covered by the patent on the date of grant of the patent and no infringement proceedings shall be instituted against such enterprises.

Examination of Application:

Section 11B provides that:

- (1) No application for a patent shall be examined unless the applicant or any other interested person makes a request in the prescribed manner for such examination within the prescribed period.
- (2) Omitted by the Patents (Amendment) Act, 2005
- (3) In case of an application in respect of a claim for a patent filed under sub-section (2) of section 5 before the 1st day of January, 2005 a request for its examination shall be made in the prescribed manner and within the prescribed period by the applicant or any other interested person.
- (4) In case the applicant or any other interested person does not make a request for examination of the application for a patent within the period as specified under sub-section (1) or sub-section (3), the application shall be treated as withdrawn by the applicant.

Provided that:

- (i) the applicant may, at any time after filing the application but before the grant of a patent, withdraw the application by making a request in the prescribed manner; and
- (ii) in a case where secrecy direction has been issued under section 35, the request for examination may be made within the prescribed period from the date of revocation of the secrecy direction.

Communication to the Applicant:

If, on examination, any objections are raised by the Patent Examiner concerned, the Patent Office will communicate to the applicant the objections so raised. The objections generally relate to the drafting of the specification and claims, anticipation of any of the claims in any prior publication of any specification or claims or documents or prior publication of the invention in some book or journal. The applicant is to make the amendment sought. If such amendments are not made within fifteen months from the date on which the first statement of objections to the application or complete specification is forwarded by the controller to the applicant, the application is deemed to have been

abandoned. Such period of making amendments can be extended to a maximum of 18 months on a request for extension being made by the applicant. If the objections are not satisfactorily rectified, the Controller after giving an opportunity of hearing to the applicant may refuse the acceptance of the application.

Opposition proceedings to grant of Patent:

Section 25 provides that: (1) Where an application for a patent has been published but a patent has not been granted, any person may, in writing, represent by way of opposition to the Controller against the grant of patent on the ground—

(a) that the applicant for the patent or the person under or through whom he claims, wrongfully obtained the invention or any part thereof from him or from a person under or through whom he claims;

(b) that the invention so far as claimed in any claim of the complete specification has been published before the priority date of the claim—

(i) in any specification filed in pursuance of an application for a patent made in India on or after the 1st day of January, 1912; or

(ii) in India or elsewhere, in any other document:

Provided that the ground specified in sub-clause (ii) shall not be available where such publication does not constitute an anticipation of the invention by virtue of sub-section (2) or subsection (3) of section 29;

(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.

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

(e) that the invention so far as claimed in any claim of the complete specification is obvious and clearly does not involve any inventive step, having regard to the matter

published as mentioned in clause (b) or having regard to what was used in India before the priority date of the applicant's claim;

(f) that the subject of any claim of the complete specification is not an invention within the meaning of this Act, or is not patentable under this Act;

(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 in the case of a convention application, the application was not made within twelve months from the date of the first application for protection for the invention made in a convention country by the applicant or a person from whom he derives title;

(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,

but on no other ground, and the Controller shall, if requested by such person for being heard, hear him and dispose of such representation in such manner and within such period as may be prescribed.

(2) At any time after the grant of patent but before the expiry of a period of one year from the date of publication of grant of a patent, any person interested may give notice of opposition to the Controller in the prescribed manner on any of the following grounds, namely:—

(a) that the patentee or the person under or through whom he claims, wrongfully obtained the invention or any part thereof from him or from a person under or through whom he claims;

(b) that the invention so far as claimed in any claim of the complete specification has been published before the priority date of the claim—

(i) in any specification filed in pursuance of an application for a patent made in India on or after the 1st day of January, 1912; or

(ii) in India or elsewhere, in any other document.

Provided that the ground specified in sub-clause (ii) shall not be available where such publication does not constitute an anticipation of the invention by virtue of sub-section (2) or sub-section (3) of section 29;

(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 the priority date of the claim of the patentee 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 claim of the patentee;

(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.

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

(e) that the invention so far as claimed in any claim of the complete specification is obvious and clearly does not involve any inventive step, having regard to the matter published as mentioned in clause (b) or having regard to what was used in India before the priority date of the claim;

(f) that the subject of any claim of the complete specification is not an invention within the meaning of this Act, or is not patentable under this Act;

(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 patentee 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 in the case of a patent granted on a convention application, the application for patent was not made within twelve months from the date of the first application for protection for the invention made in a convention country or in India by the patentee or a person from whom he derives title;

(j) that the complete specification does not disclose or wrongly mentions the source and geographical origin of biological material used for the invention;

(k) that the invention so far as claimed in any claim of the complete specification was anticipated having regard to the knowledge, oral or otherwise, available within any local or indigenous community in India or elsewhere, but on no other ground.

(3) (a) Where any such notice of opposition is duly given under sub- section (2), the Controller shall notify the patentee.

(b) On receipt of such notice of opposition, the Controller shall, by order in writing, constitute a Board to be known as the Opposition Board consisting of such officers as he may determine and refer such notice of opposition along with the documents to that Board for examination and submission of its recommendations to the Controller.

(c) Every Opposition Board constituted under clause (b) shall conduct the examination in accordance with such procedure as may be prescribed.

(4) On receipt of the recommendation of the Opposition Board and after giving the patentee and the opponent an opportunity of being heard, the Controller shall order either to maintain or to amend or to revoke the patent.

(5) While passing an order under sub-section (4) in respect of the ground mentioned in clause (d) or clause (e) of sub-section (2), the Controller shall not take into account any personal document or secret trial or secret use.

(6) In case the Controller issues an order under sub-section (4) that the patent shall be maintained subject to amendment of the specification or any other document, the patent shall stand amended accordingly.

Term of Patent:

Section 53 provides that (1) Subject to the provisions of this Act, the term of every patent granted, after the commencement of the Patents (Amendment) Act, 2002, and the term of every patent which has not expired and has not ceased to have effect, on the date of such commencement, under this Act, shall be twenty years from the date of filing of the application for the patent.

Explanation.—For the purposes of this sub-section, the term of patent in case of International applications filed under the Patent Cooperation Treaty designating India, shall be twenty years from the international filing date accorded under the Patent Cooperation Treaty.

(2) A patent shall cease to have effect notwithstanding anything therein or in this Act on the expiration of the period prescribed for the payment of any renewal fee, if that fee is

not paid within the prescribed period or within such extended period as may be prescribed.

(3) [Omitted by the Patents (Amendment) Act, 2005]

(4) Notwithstanding anything contained in any other law for the time being in force, on cessation of the patent right due to non-payment of renewal fee or on expiry of the term of patent, the subject matter covered by the said patent shall not be entitled to any protection.

D. Enforcement and Remedies:

Infringement of Patents:

A patent confers exclusive right on the patentee to make, distribute or sell the invention in India. An infringement would be when any of these rights is violated. A patentee may assign or license all or some of these rights. The exercise of the rights so transferred in favour of the assignee or the licensee by the assignor or the licensor would not amount to infringement of the patent. In case of a product patent the rights of the patentee are infringed by anyone who makes or supplies that substance commercially. In case of a process patent, the use of such a method or process in India by anyone other than the patentee amounts to infringement.

Whether the act of person other than the patentee amounts to infringement or not would depend upon:

- i. the extent of the monopoly right conferred by the patent which is interpreted from the specification and claims contained in the application of the patentee. Any action which falls outside the scope of the claims would not amount to infringement.
- ii. Whether he is infringing any of the monopoly rights of the patentee to make, distribute or sell the invention.

Infringement to be decided on the facts of each case:

Since patented inventions involve complicated scientific principles and mechanisms, there can be no generalized formula as to the acts which would constitute infringement. Whether there is an infringement or not, would depend upon the claim of each patentee and the case made out against the infringer and what the infringer has to say in his defence.

Doctrine of pith and marrow:

The purpose of this doctrine is to judge the infringement of a patent. It provides that the pith and marrow of the invention is the essence of the invention which if taken and reproduced in the infringed article even by incorporating a colourable variation of it within the invention, infringement has taken place. Courts apply the doctrine of pith and marrow which means that

the court is not to detect an absolute similarity between the two but is to see whether the pith and marrow of the invention has been taken and if it has been so done, there is an infringement. The question to be answered is whether the infringing article or process is substantially the same as the patented article or process. If the answer is yes, there has been an infringement.

Relief for Infringement:

Whenever the monopoly rights of the patentee are violated, his rights are secured again by the Act through judicial intervention for which a patentee has to institute a suit for infringement. Following reliefs may be awarded in such a suit:

- i. Interlocutory/ interim injunction.
- ii. Damages or account of profits.
- iii. Permanent injunction.

Place of institution of suit:

Section 104 of the Act provides that a suit for infringement shall not be instituted in any court inferior to a District Court having jurisdiction to try the suit. In appropriate cases where the High Court has original jurisdiction to try the suit, the suit shall be instituted in the High Court. When an action for infringement has been instituted in a District Court and the defendants make a counter-claim for revocation of the patent, the suit is transferred to the High Court for decision because High Court has the jurisdiction to try cases of revocation. Section 104A provides for burden of proof in case of suits concerning infringement.

Procedure to be followed:

The procedure provided in Code of Civil procedure has to be followed in suit of infringement of patents.

When can a suit be instituted:

A suit for infringement can be instituted only after a patent has been sealed. When a specification has been accepted and published i.e., during the period when opposition has been called and is being decided, the applicant cannot institute a suit for infringement, but damages sustained due to the infringement committed during the period i.e. between the date of publication of acceptance of complete specification and the date of grant may be claimed in another suit; a separate suit for damages but not a suit for infringement.

When the term of patent has expired and infringement occurred during the term of the patent, a suit can be instituted during the term or even after the expiry of the term. In case a patent has lapsed and was subsequently restored, no suit or other proceeding can be brought for

infringement committed between the date on which the patent ceased to have effect and the date of publication of application for restoration. When a patent was obtained wrongfully by a person and later granted to the true and first inventor, no suit for infringement can be instituted for any infringement occurring for the period of such grant to the true a first inventor.

Who can sue:

The person who has a right in the patent can institute a suit for infringement, therefore, following persons are entitled to sue:

- i. The patentee.
- ii. The exclusive licensee if the licence is registered.
- iii. A compulsory licensee when the patentee refuses or neglects to institute proceedings.
- iv. A licensee other than the above two licensees can bring an action for infringement depending upon the term of the contract between the licensor and licensee.
- v. Assignee, subject to limitations.
- vi. Co-owner of a patent.

Who can be sued:

- i. Person who infringes the patent that violates the monopoly right of patentee can be sued for infringement.
- ii. When two or more persons have jointly infringed the patent, both of them have to be sued as co-defendants.
- iii. Agents and servants of a principal who is responsible for the infringement can also be sued either individually or collectively along with their employer/principal.
- iv. The consignees of an infringing article can be made a party to the proceedings in an infringement suit.

Defences which may be set up by the defendant:

One or more of the following defences can be set up by the defendant:

- i. That the plaintiff is not entitled to sue for infringement.
- ii. That there has been no infringement or any threat or intention to infringe.
- iii. That there was leave or license, express or implied, to use the invention.
- iv. Estoppels or res judicata.

Besides the abovementioned defences, Section 107 of the Act provides that in a suit for infringement of a patent, every ground on which it may be revoked under Section 64 shall be available as a ground for defence. Therefore subject to conditions provided, following grounds can also be taken as defence by the defendant:

- (a) that the invention, so far as claimed in any claim of the complete specification, was claimed in a valid claim of earlier priority date contained in the complete specification of another patent granted in India;
- (b) that the patent was granted on the application of a person not entitled under the provisions of this Act to apply therefor;
- (c) that the patent was obtained wrongfully in contravention of the rights of the petitioner or any person under or through whom he claims;
- (d) that the subject of any claim of the complete specification is not an invention within the meaning of this Act;
- (e) that the invention so far as claimed in any claim of the complete specification is not new, having regard to what was publicly known or publicly used in India before the priority date of the claim or to what was published in India or elsewhere in any of the, documents referred to in section 13;
- (f) that the invention so far as claimed in any claim of the complete specification is obvious or does not involve any inventive step, having regard to what was publicly known or publicly used in India or what was published in India or elsewhere before the priority date of the claim;
- (g) that the invention, so far as claimed in any claim of the complete specification, is not useful;
- (h) that the complete specification does not sufficiently and fairly describe the invention and the method by which it is to be performed, that is to say, that the description of the method or the instructions for the working of the invention as contained in the complete specification are not by themselves sufficient to enable a person in India possessing average skill in, and average knowledge of, the art to which the invention relates, to work the invention, or that it does not disclose the best method of performing it which was known to the applicant for the patent and for which he was entitled to claim protection;
- (i) that the scope of any claim of the complete specification is not sufficiently and clearly defined or that any claim of the complete specification is not fairly based on the matter disclosed in the specification;
- (j) that the patent was obtained on a false suggestion or representation;
- (k) that the subject of any claim of the complete specification is not patentable under this Act;

- (l) that the invention so far as claimed in any claim of the complete specification was secretly used in India, otherwise than as mentioned in sub-section (3), before the priority date of the claim;
- (m) that the applicant for the patent has failed to disclose to the Controller the information required by section 8 or has furnished information which in any material particular was false to his knowledge;
- (n) that the applicant contravened any direction for secrecy passed under section 35 or made or caused to be made an application for the grant of a patent outside India in contravention of section 39;
- (o) that leave to amend the complete specification under section 57 or section 58 was obtained by fraud;
- (p) that the complete specification does not disclose or wrongly mentions the source or geographical origin of biological material used for the invention;
- (q) that the invention so far as claimed in any claim of the complete specification was anticipated having regard to the knowledge, oral or otherwise, available within any local or indigenous community in India or elsewhere.

Unit –III: Trademarks

A. Nature and Meaning:

Meaning:

A trade mark (popularly known as brand name in layman's language) is a visual symbol which may be a word to indicate the source of the goods, a signature, name, device, label, numerals, or combination of colours used, or services, or other articles of commerce to distinguish it from other similar goods or services originating from another. It is a distinctive sign which identifies certain goods or services as those produced or provided by a specific person or enterprise. Its origin dates back to ancient times, when craftsmen reproduced their signatures, or "marks" on their artistic or utilitarian products. Over the years these marks evolved into today's system of trade mark registration and protection. The system helps consumers identify and purchase a product or service because its nature and quality, indicated by its unique trade mark, meets their needs.

A trade mark provides protection to the owner of the mark by ensuring the exclusive right to use it or to authorize another to use the same in return for payment. The period of protection

varies, but a trade mark can be renewed indefinitely beyond the time limit on payment of additional fees. Trade mark protection is enforced by the courts, which in most systems have the authority to block trade mark infringement.

In a larger sense, trademarks promote initiative and enterprise worldwide by rewarding the owners of trademarks with recognition and financial profit. Trade mark protection also hinders the efforts of unfair competitors, such as counterfeiters, to use similar distinctive signs to market inferior or different products or services. The system enables people with skill and enterprise to produce and market goods and services in the fairest possible conditions, thereby facilitating international trade.

Object of Trademark Law:

The object of trade mark law has been explained by the Supreme Court in *Dau Dayal v. State of Uttar Pradesh* AIR 1959 SC 433, in the following words:

“The object of trade mark law is to protect the rights of persons who manufacture and sell goods with distinct trade marks against invasion by other persons passing off their goods fraudulently and with counterfeit trademarks as those of the manufacturers. Normally, the remedy for such infringement will be by action in Civil Courts. But in view of the delay which is incidental to civil proceedings and the great injustice which might result if the rights of manufacturers are not promptly protected, the law gives them the right to take the matter before the Criminal Courts, and prosecute the offenders, so as to enable them to effectively and speedily vindicate their rights”.

The distinction between a trade mark and a property mark has been stated by the Supreme Court in the case of *Sumat Prasad Jain v. Sheojanam Prasad and Ors.*, AIR 1972 SC 413. The Apex Court held: “...Thus, the distinction between a trade mark and a property mark is that whereas the former denotes the manufacture or quality of the goods to which it is attached, the latter denotes the ownership in them. In other words, a trade mark concerns the goods themselves, while a property mark concerns the proprietor. A property mark attached to the movable property of a person remains even if part of such property goes out of his hands and ceases to be his.”

The trade mark law in India is a ‘first-to-file’ system that requires no evidence of prior use of the mark. A trade mark application can be filed on a ‘proposed to be used or intent-to-use’ basis or based on use of the mark. The term ‘use’ under the Trade Marks Act, 1999 has acquired a broad meaning and does not necessarily mean the physical presence of the goods in India. Presence of the trade mark on the Internet and publication in international magazines and journals having circulation in India are also considered as use in India. One of the first landmark judgments in this regard is the “Whirlpool case” [*N. R. Dongre v. Whirlpool Corporation*, 1996 (16) PTC 583] in which the Court held that a rights holder can

maintain a passing off action against an infringer on the basis of the trans-border reputation of its trademarks and that the actual presence of the goods or the actual use of the mark in India is not mandatory. It would suffice if the rights holder has attained reputation and goodwill in respect of the mark in India through advertisements or other means.

Important definitions under the Act:

1. Trade Mark:

A trade mark is a word, phrase, symbol or design, or combination of words, phrases, symbols or designs used in the course of trade which identifies and distinguishes the source of the goods or services of one enterprise from those of others.

As stated above, the definition of "trade mark" under Section 2(1)(zb) has been enlarged to mean a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from others and may include shape of goods, their packaging and combination of colours and covers both goods and services.

"Mark" includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof". [Section 2(1)(m)].

Being an inclusive definition it will thus include any mark within the definition of trade mark so long as the mark is –

- capable of being represented graphically; and
- capable of distinguishing the goods or services of one person from those of others.

2. Service:

The new definition of 'service' has been included for the benefit of service-oriented establishments such as banking, communication, education, finance, insurance, chit funds, real estates, transport, storage, material treatment, processing, supply of electrical or other energy, boarding, lodging, entertainment, amusement, construction, repair, conveying of news or information and advertising .

A service mark is the same as a trade mark except that it identifies and distinguishes the source of a service rather than a product. Normally, a mark for goods appears on the product or on its packaging, while a service mark appears in advertising for the services.

The definition of "registered trade mark" under Section 2(1)(w) has been modified to mean a trade mark which is actually on the Register and remaining in force. The renewal of registration of a trade mark should be made for every ten years instead of seven years under the present Act.

3. Certification Trade Mark:

"Certification trade mark" means a mark capable of distinguishing the goods or services in connection with which it is used in the course of trade which are certified by the proprietor of the mark in respect of origin, material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics from goods or services not so certified and registrable as such under Chapter IX in respect of those goods or services in the name, as proprietor of the certification trade mark, of that person.[Section 2(1)(e)]

4. Collective Mark:

The new definition of 'collective mark' has been provided for the benefit of members of an association of persons (but not partnership) and such inclusion of 'collective mark' will benefit the traditional Indian family trade marks.

“Collective mark” under Section 2(1)(g) of the Act means a trade mark distinguishing the goods or services of members of an association of persons (not being a partnership within the meaning of the Indian Partnership Act, 1932) which is the proprietor of the mark from those of others.

5. Trade Description:

Trade description under Section 2(1)(za) means any description, statement or other indication, direct or indirect :

- (i) as to the number, quantity, measure, gauge or weight of any goods; or
- (ii) as to the standard of quality of any goods or services according to a classification commonly used or recognized in the trade; or
- (iii) as to fitness for the purpose, strength, performance or behaviour of any goods, being “drug”, as defined in the Drugs and Cosmetics Act, 1940 or “food”, as defined in the Prevention of Food Adulteration Act, 1954; or
- (iv) as to the place or country in which or the time at which any goods or services were made, produced or provided, as the case may be; or
- (v) as to the name and address or other indication of the identity of the manufacturer or of the person providing the services or of the person for whom the goods are manufactured or services are provided; or
- (vi) as to the mode of manufacture or producing any goods or providing services; or
- (vii) as to the material of which any goods are composed; or
- (viii) as to any goods being the subject of an existing patent, privilege or copyright, and includes –
 - (a) any description as to the use of any mark which according to the custom of the trade is commonly taken to be an indication of any of the above matters;
 - (b) the description as to any imported goods contained in any bill of entry or shipping bill;
 - (c) any other description which is likely to be misunderstood or mistaken for all or any of the said matters;

6. Well Known Trade mark:

Being a signatory to the Paris Convention and TRIPS, India recognizes the concept of a well known trade marks.

Under Section 2(1)(zg) of the Trade Marks Act, 1999 “well-known trade mark”, in relation to any goods or services, means a mark which has become so to the substantial segment of the public which uses such goods or receives such services that the use of such mark in relation to other goods or services would be likely to be taken as indicating a connection in the course of trade or rendering of services between those goods or services and a person using the mark in relation to the first-mentioned goods or services.

A mark, which has been designated as a well known mark, is accorded stronger protection. The Act casts an obligation on the Registrar to protect a well known mark against an identical or similar trade mark.

7. Permitted Use:

Section 2(1) (r) defines the term “permitted use”, in relation to a registered trade mark, as to mean the use of trade mark-

- (i) by a registered user of the trade mark in relation to goods or services -
 - (a) with which he is connected in the course of trade; and
 - (b) in respect of which the trade mark remains registered for the time being; and
 - (c) for which he is registered as registered user; and
 - (d) which complies with any conditions or limitations to which the registration of registered user is subject; or
- (ii) by a person other than the registered proprietor and registered user in relation to goods or services
 - (a) with which he is connected in the course of trade; and
 - (b) in respect of which the trade mark remains registered for the time being; and
 - (c) by consent of such registered proprietor in a written agreement; and
 - (d) which complies with any conditions or limitations to which such user is subject and to which the registration of the trade mark is subject.

Functions of Trademark:

Trademark performs four functions –

- It identifies the goods / or services and its origin;
- It guarantees its unchanged quality;
- It advertises the goods/services;
- It creates an image for the goods/ services.

B. Scope of Protection:

Essentials of a Trade Mark:

A trade mark should have the essential element of distinctiveness in it. A trade mark would be considered a good trade mark when it is distinctive. In the case of Imperial Tobacco v. Registrar, Trade Marks, AIR 1977 Cal 413, the word distinctiveness was held to be some quality in the trade mark which earmarked the goods marked as distinct from those of other products or such goods.

Distinctiveness may be class dependent. What is distinctive to one class of goods may not be so in relation to another class of goods. The trade mark may be united wholly to one or more

specified colours and this colour combination may become the distinctive character of the particular mark. Distinctiveness may be inherent or acquired.

Rights conferred by registration of trade mark:

The registration of a trade mark confers on the registered proprietor of the trade mark the exclusive right to use the trade mark in relation to the goods or services in respect of which the trade mark is registered. While registration of a trade mark is not compulsory, it offers better legal protection for an action for infringement.

As per Section 17 of the Act, the registration of a trade mark confers the following rights on the registered proprietor:

- (i) It confers on the registered proprietor the exclusive right to the use of the trade mark in relation to the goods or services in respect of which the trade mark is registered.
- (ii) If the trade mark consists of several matters, there is an exclusive right to the use of the trade mark taken as a whole. If the trade mark contains matter common to trade or is not of a distinctive character, there shall be no exclusive right in such parts.
- (iii) It entitles the registered proprietor to obtain relief in respect of infringement of the trade mark in the manner provided by the Trade Marks Act, 1999 when a similar mark is used on (a) same goods or services, (b) similar goods or services, (c) in respect of dissimilar goods or services.
- (iv) Registration of a trade mark forbids every other person (except the registered or unregistered permitted user) to use or to obtain the registration of the same trade mark or a confusingly similar mark in relation to the same goods or services or the same description of goods or services in relation to which the trade mark is registered.
- (v) After registration of the trade mark for goods or services, there shall not be registered the same or confusingly similar trade mark not only for the same goods or services but also in respect of similar goods or services by virtue of Section 11(1) of Trade Marks Act, 1999.
- (vi) Moreover, after registration of the trade mark for goods or services, there shall not be registered the same or confusingly similar trade mark even in respect of dissimilar goods or services by virtue of Section 11(2) in case of well-known trade marks.
- (vii) Registered trade mark shall not be used by anyone else in business papers and in advertising. Use in comparative advertising should not take undue advantage of the trade mark. Such advertising should not be contrary to honest practices in industrial or commercial matters. The advertising should not be detrimental to the distinctive character or reputation of the trade mark.

(viii) There is a right to restrict the import of goods or services marked with a trade mark similar to one's trade mark.

(ix) There is a right to restrain use of the trade mark as trade name or part of trade name or name of business concern dealing in the same goods or services. The registered trade mark continues to enjoy all the rights which vest in an unregistered trade mark. By registration the proprietor of an unregistered trade mark is converted into proprietor of the registered trade mark. An application for registration may be based on a trade mark in use prior to such application and such a trade mark is already vested with rights at Common law from the time the use of the mark was commenced.

Assignment and Transmission:

Assignment and Transmission have been defined under Section 2(1) (b) and 2(1)(zc) of the Trade Marks Act, 1999 respectively. Section 2(1) (b) defines "assignment" as assignment in writing by act of the parties concerned. Under section 2(1)(zc) "transmission" means transmission by operation of law, devolution on the personal representative of a deceased person and any other mode of transfer, not being assignment.

Assignment of trade mark involves transfer of ownership of the trade mark to another person or entity. The provisions concerning assignment and transmission of trade mark are contained in section 37 to 45 of the Trade marks Act, 1999 read with rule 68 to 79 of the trade marks rules.

Section 37 entitles the registered proprietor of a trade mark to assign the trade mark and to give effectual receipts for any consideration for such assignment. Under the new Act, a registered trade mark is assignable and transmissible whether with or without goodwill of the business either in respect of all goods or services or part thereof. The assignment or transmission of trade mark has been prohibited under Section 40, where multiple exclusive rights would be created in more than one person in relation to same goods or services; same description of goods or services; or goods or services or description of goods or services associated with each other, the use of such trade marks would be likely to deceive or cause confusion.

Assignment of a trade mark without goodwill of business is not allowed unless the assignor obtains directions of the Registrar and advertises the assignment as per the Registrar's directions. The assignment and transmission of certification trade marks is allowed only with the consent of the Registrar. Associated trade marks are assignable and transmissible only as a whole but they will be treated as separate trade marks for all other purposes. The assignment and transmission of trade marks is absolute. The validity of the assignment can be challenged only on the basis of the provisions contained in Sections 37 to 45 of Trade Marks Act, 1999.

C. Procedure for Protection:

Who can apply for Trademark:

Any person claiming to be the proprietor of a trade mark used or proposed to be used by him may apply in writing in form prescribed for registration. The application should contain the trade mark, the goods/services, name and address of applicant and agent (if any) with power of attorney, period of use of the mark and signature. The application should be in English or Hindi. It should be filed at the appropriate office.

Jurisdiction for filing application:

A trade mark application should be filed at the appropriate office of the Registry within whose territorial limits, the principal place of business in India of the applicant is situate. In the case of joint applicants, the principal place of business in India of the applicant will be that of the person whose name is first mentioned as having a place of business. If the applicant has no principal place of business in India, he should file the application at that office within whose territorial jurisdiction, the address for service in India given by him is located. No change in the principal place of business in India or in the address for service in India shall affect the jurisdiction of the appropriate office once entered.

Particulars to be filed with application for registration:

The application should be filed in triplicate with the following particulars –

- i. Graphic representation of the trademark.
- ii. Five Additional representations are to be provided corresponding exactly with one another.
- iii. In the case of three dimensional mark, the reproduction of the mark should consist of a two dimensional or photographic reproduction.
- iv. Where the trade mark contains a word or words in scripts other than Hindi or English, a transliteration and translation of each word in English or in Hindi should be given indicating the language to which the word belongs, at the time of filing the application to facilitate completion of data entry at the initial stage itself.
- v. The application may contain a declaration claiming priority as per the Paris Convention.

Procedure for registration:

Section 15 (3) makes provision for registration of trade mark as series in respect of the same or similar goods /services where the marks, while resembling each other in the material particulars thereof and yet differ in respect of –

1. Statement of goods or services in relation to which they are respectively used or proposed to be used; or

2. Statement of number, price, quality or names of places; or
3. Other matter of a non-distinctive character which does not substantially affect the identity of the trade mark; or
4. Colour.

Application for registration of series marks is to be on form prescribed. Though it is permissible to file a single application for registration of trade mark in more than one class, it is to be noted that each series marks must be in respect of the same goods or services or description of goods/services. Where a group of marks are applied for registration as series in one registration and the Registrar does not consider them eligible for registration of series marks under section 15 the applicant will be required to delete any of the mark which is under objection. All trademarks registered as series in one registration are deemed to be registered as associated trade mark.

Registration of Collective Marks:

Special provisions have been made for registration of collective marks in section 61 to 68 of the

Act. "Collective mark" is defined to mean a trade mark distinguishing the goods or services of

members of an association of persons (not being a partnership within the meaning of Indian Partnership Act, 1932) which is the proprietor of the mark from those of others"- section 2(1)(g). To be registerable, the collective mark must be capable of being represented graphically

and meet other requirements as are applicable to registration of trade marks in general. The following points should be noted for registering collective marks -

- The collective mark is owned by an association of persons not being a partnership.
- The collective marks belong to a group and its use thereof is reserved for members of the group.
- The association may not use itself the collective mark but it ensures compliance of certain quality standards by its members who may use the collective mark.
- The primary function of a collective mark is to indicate a trade connection with the association or organization who is the proprietor of the mark.

Application for registration as collective mark should be made on form prescribed.

Administrative procedure of registration of trademarks:

An application for registration of trademarks is received at the Head office of Trademark Registry, Mumbai and its branches according to territorial jurisdiction. Applications are then examined mainly with regard to the distinctiveness, possibility of deceptiveness and conflicting

trademarks. The registrar on consideration of the application and any evidence of use or distinctiveness decides whether the application should be accepted for registration or not, and if

accepted, publishes the same in the official gazette i.e. Trade Marks Journal.

Within a prescribed period any person can file an opposition, a copy of which is served to the applicants who is required to file a counterstatement within two months failing which the application shall be treated as abandoned.

Thereafter, the opponent leads evidence in support of his case by way of affidavit followed by the applicant's evidence also by way of affidavit in support of the application. After that the opponent files evidence by way of rebuttal. On completion of evidence, the matter is set down for a hearing and the case is decided by a Hearing officer. The registrar's decision is appealable to the Intellectual Property Appellate Board.

Almost all functions of the Registry have now been decentralized and executed by respective offices except publication of journal, issuance of Registration Certificate and post registration activities including renewal which is done at TMR, Mumbai (Head Office).

Correction and amendment of registration application:

An applicant for registration of a trade mark can before the registration of the mark, apply in prescribed form for correction of any error in connection with his application. But the correction should not alter the trade mark that has been applied for or substitute a new specification of goods or services not included in the application.

Renewal of registration:

The period of registration which was 7 years until recently under 1958 Act, has been increased to 10 years under the present Act. The 10 year period of registration is reckoned from the date of making of the application which is deemed to be the date of registration.

Registrations can be renewed by payment of prescribed renewal fees in all cases (trademark / collective marks/certification marks) on form prescribed. The application is filed by the proprietor of the registered trade mark or his agent. If there is any change in the proprietorship of the mark, and it has not been brought on record, proof of title should be filed in the first instance.

E-filing of Trademark application:

E-filing is the service provided by the Trademark Registry in order to enable customers to apply

for a Trade Mark on-line allowing from the applicant's browser to:

- Complete an electronic application form;
- Provide the associated attachments;
- Complete the necessary payment details.

Procedure for e-filing:

In order to submit an electronic application form, following steps should be followed -

- 1) Acquire Class 3 Digital Signatures from (n)Code Solutions or Tata Consultancy Services (TCS) or SafeScript from Sify . The Procedure for getting the Digital Signature and the location of their Offices is available at their website.
- 2) For users (Proprietors/Agents or Attorneys), already registered with TMR (Trademark Registry) Office India can complete online registration by providing a desired User ID, their User Type (Proprietor/Agent/Attorney) and User Code.

- 3) For Users who are not registered as Proprietor / Attorney with TMR Office, they can search and fill online form to obtain User code (Party Code).
- 4) Secure Login into the system with created User Id and the Digital Signatures.
- 5) Obtain a New Reference Number for New Application. Use this option when the applicant wants to apply for a new Trademarks Application.
- 6) Update Application Details: Use this option to edit / update the application details along with relevant images and attached documents. Final Submission to TMR-India with Digital Signature is included in this option after which application cannot be edited.
- 7) The Cases which are Digitally Submitted to TMR, India are available for online payment. The applicant can pay for more than one application in a single transaction. Once the payment is realized as confirmed by the Payment Gateway, an acknowledgement receipt for the fees paid is generated by the system indicating the Receipt Number, Application Number and Date of Filing.
- 8) An applicant can also view online History and status of the applications filed by him / her by clicking Status of Filed Application.
- 9) An applicant can also view the online status of e-Payments.

D. Enforcement and Remedies:

Offences, Penalties & Procedures:

There are mainly two classes of Offences relating to Trademarks –

- (a) Falsification of Trademark; and
- (b) Falsely applying the trademark to goods or services.

The punishment for the above offences shall not be less than 6 months imprisonment which may extend to three years and a fine which shall not be less 50,000/-, but may extend to Rupees Two

Lakh. Wherever the court proposes a lower punishment than the minimum, it has to record, adequate and special reasons for the same.

However second and subsequent offences shall be more severely punished. There shall be an Imprisonment of not less than one year which may extend to three years and a fine which shall not be less Rupees One lakh, but may extend to Rupees Two Lakh. The court can propose a lower punishment than the minimum, only after recording adequate and special reasons for the same.

Sections 101 to 121 deal with the matters relating to offences, penalties and procedure. Some of the important provisions are discussed below.

1. Section 103 deals with the penalty for applying false trade mark, trade description, etc. and imposes punishment with imprisonment for a term which shall not be less than six months but which may extend to three years and with fine which shall not be less than fifty thousand rupees but which may extend to two lakh rupees.

2. Section 105 prescribes enhanced penalty on second and subsequent conviction for offences committed under sections 103 and 104 and imposes punishment with imprisonment which shall not be less than one year but which may extend to three years and with fine which shall not be less than one lakh rupees but which may extend to two lakh rupees.

3. Section 106 provides penalty for removing piece goods, etc., in violation of the provisions of Section 81 dealing with stamping of piece goods, cotton yarn and thread. This section provides for forfeiture of goods to the government and fine upto rupees 1000.

4. Section 107 makes it an offence if a person falsely represents a trade mark as registered. It has

been clarified that use of symbols like "R" in circle in relation to unregistered trade mark would constitute an offence. The punishment for such offences is imprisonment for a term which may extend to three years or with fine or with both. It is also clarified that where the mark in question is registered under the law of the country outside India, the use of the word or other expression to

denote such registration in foreign country is permissible.

5. According to section 108, the use of any words which would lead to the belief that a person's place of business is officially connected with the Trade Mark Office shall be treated as offence and be punishable with imprisonment for a term which may extend to two years or with fine or with both.

6. Section 109 contains provisions for penalty for falsification of entries in the register. This offence is punishable with imprisonment not exceeding two years or with fine or with both.

Section 114 deals with offences by companies and provides that where a person committing offence is a company, every person in charge of and responsible to the company for the conduct of its business at the time of commission of an offence will be liable. Where a person accused proves that the offence was committed without his knowledge or he has exercised all due diligence to prevent the commission of such offence, he will not be liable. However, where it is proved that an offence has been committed with the consent or connivance or is attributable to any neglect of any Director, Manager, Secretary or any other officer of the company, he shall be deemed to be guilty of the offence. Explanation to this section defines a company as to mean body corporate and includes a firm or other association of individuals. The explanation also defines director in relation to a firm, as to mean a partner in the firm.

Reliefs in suits for infringement/ Passing-off:

Civil Litigation: A suit can be initiated either under the law of passing off or for infringement under the Trade Marks Act, 1999 depending on whether the trade mark is unregistered, pending registration or registered respectively.

Jurisdiction: The suit for passing off and/or infringement can be initiated either in the District Court or in the High Court depending on the valuation of the suit. The suit can be at the place where the rights holder or one of the rights holders actually and voluntarily reside or work for gain or carries on business.

Elements of the Complaint : In the complaint, the rights holder is required to demonstrate that-(a) the alleged infringing act involves a mark that is identical or similar to a trade mark of the rights holder;

(b) the infringing representation of a trade mark is being used in connection with goods or services and might lead to confusion in public regarding the origin of the infringing goods/services;

(c) the unlawful act interfered with the trade mark holder's rights of exclusive use or caused the rights holder economic loss

Section 135 expressly stipulates that the relief which a Court may grant in any suit for infringement or for passing off referred to in Section 134 includes injunction (subject to such terms, if any, as the court thinks fit)

and at the option of the plaintiff, either damages or an account of profits, together with or without any order for the delivery up of the infringing labels and marks for destruction or erasure.

Ex-parte Interim Injunction : Most Indian Courts will grant *ex-parte* interim injunctions. *Ex-parte* interim injunction is a temporary injunction granted without any notice to the infringer restraining him from using the infringing mark during the pendency of the trial. This injunction is normally granted at the early stages of the trial and many a times on the first date of hearing itself, provided that the rights holder is able to establish its rights before the Court and prove the gravity of the offence, merits immediate consideration.

An interlocutory order for any of the following matters can also be passed, namely:—

- (a) for discovery of documents;
- (b) preserving of infringing goods, documents or other evidence which are related to the subject matter of the suit;
- (c) restraining the defendant from disposing of or dealing with his assets in a manner which may adversely affect plaintiff's ability to recover damages, costs or other pecuniary remedies which may be finally awarded to the plaintiff.

The Court shall not grant relief by way of damages (other than nominal damages) or on account of profits in any case—

- (a) where in a suit for infringement of a trade mark, the infringement complained of is in relation to a certification trade mark or collective mark; or
- (b) where in a suit for infringement the defendant satisfies the court—
 - (i) that at the time he commenced to use the trade mark complained of in the suit, he was unaware and had no reasonable ground for believing that the trade mark of the plaintiff was on the register or that the plaintiff was a registered user using by way of permitted use; and
 - (ii) that when he became aware of the existence and nature of the plaintiff's right in the trade mark, he forthwith ceased to use the trade mark in relation to goods or services in respect of which it was registered.

However, the Courts are restrained from granting relief by way of damages (other than nominal damages) or on account of profit in any case where the infringement complained of relates to certification mark or collective mark or where the defendant satisfies the Court that when he used the mark, he was unaware or had no reasonable ground of belief that the trade mark is registered one and when he came to know of existence and nature of plaintiff's right, he stopped the use of the trade mark.

The distinction between a suit based on infringement and that based on passing off was explained by the Supreme Court in *Kaviraj Pandit Durga Dutt Sharma v. Navaratna Pharmaceutical Laboratories*, AIR 1965 SC 980. It was explained that "while an action for passing off is a common law remedy being in substance an action for deceit, that is, a passing off by a person of his own goods as those of another, that is not the gist of an action for infringement. The action for infringement is a statutory remedy conferred on the registered proprietor of a registered trade mark for the vindication of the 'exclusive right to the use of the trade mark in relation to those goods. The use by the defendant of the trade mark of the plaintiff is not essential in an action for passing off, but is the sine qua non in the case of an action for infringement."

It was further noticed that "where the evidence in respect of passing off consists merely of the colourable use of a registered trade mark, the essential features of both the actions might coincide, in an action for infringement, the plaintiff must, no doubt, make out that the defendant's mark is so close either visually, phonetically or otherwise and the Court should reach the conclusion that there is an imitation" in which event it would be established that the plaintiff's rights are violated.

The grant of an injunction is a right expressly provided by the Trade Marks Act, 1999. The rules governing the grant of injunctions in trade mark cases are based on the provisions contained in Sections 36 to 42 of the Indian Specific Relief Act, 1963 and Order 39 Rules 1 and 2 read with Section 151 of the Code of Civil Procedure (*Century v. Roshanlal* AIR 1978 Del. 250).

In *Midas Hygiene Industries (P) Ltd. v. Sudhir Bhatia and Ors.*, AIR 2004 SC 186, it was held that the law on the subject is well settled. In cases of infringement either of trade mark or of copyright, normally an injunction must follow. Mere delay in bringing action is not sufficient to defeat grant of injunction in such cases. The grant of injunction also becomes necessary if it *prima facie* appears that the adoption of the mark was itself dishonest.

In an action for infringement where the defendant's trade mark is identical with the plaintiff's mark, the Court will not enquire whether the infringement is such as is likely to deceive or cause confusion. The test, therefore, as to likelihood of confusion or deception arising from similarity of marks is the same both in infringement and passing off actions [See *Ruston & Hornsby Ltd. v. The Zamindara Engineering Co.*, AIR 1969 SC 304].

In *Ramdev Food Products Pvt. Ltd. v. Arvindbhai Rambhai Patel and Ors.*, AIR 2006, it was held that a *prima facie* case of irreparable injury has been made out by the Appellant. It may not be necessary to show more than loss of goodwill and reputation to fulfill the condition of irreparable injury. If the first two pre-requisites are fulfilled, irreparable loss can be presumed to have taken place.

It was further held that the grant of an interlocutory injunction is in exercise of discretionary power and hence, the Appellate Courts will usually not interfere with it. However, Appellate Courts will substitute their discretion if they find that discretion has been exercised arbitrarily, capriciously, perversely, or where the court has ignored settled principles of law regulating the grant or refusal of interlocutory injunctions. [*Wander Ltd. v. Antox India P. Ltd.*, (1990) Supp SCC 727; *Seema Arshad Zaheer v. MC of Greater Mumbai* (2006) 5 SCALE 263]

In *Laxmikant V. Patel v. Chetanbhai Shah and Anr.*, AIR 2001 SC 763, it was stated:

A person may sell his goods or deliver his services such as in case of a profession under a trading name or style. With the lapse of time such business or services associated with a person acquire a reputation or goodwill which becomes a property which is protected by Courts. A competitor initiating sale of goods or services in the same name or by imitating that name results in injury to the business of one who has the property in that name. The law does not permit any one to carry on his business in such a way as would persuade the customers or clients in believing that the goods or services belonging to someone else are his or are associated therewith. It does not matter whether the latter person does so fraudulently or otherwise.

The reasons are two. Firstly, honesty and fair play are, and ought to be, the basic policies in the world of business. Secondly, when a person adopts or intends to adopt a name in connection with his business or services which already belongs to someone else, it results in confusion and has propensity of diverting the customers and clients of someone else to himself and thereby resulting in injury.

The Delhi High Court in *Toyota Jidosha Kabushiki Kaisha v. Deepak Mangal & Others, 2010 (43) PTC 161(Del.)*, held that plaintiff is not entitled to the discretionary relief as prayed for by him. He has not been able to make any prima facie case in his favour for injunction the defendant from using the trade mark "PRIUS" on which the defendant is admittedly the registered proprietor and owner since 2002. Principles of equity and fair play also do not find favour with the plaintiff. The balance of convenience in fact lies in favour of the defendant. If at this stage i.e. after business growth of more than seven years, the defendant is enjoined from using his trade name under which he is selling his auto accessory products, he would suffer huge business loss which would probably bring to a close not only his business reputation but all his legitimate financial expectations. On the other hand no irreparable loss or injury will be suffered by the plaintiff as admittedly the plaintiff is not in the market.

Plaintiff has given up all claims if any on the use of the mark "PRIUS" as he has knocked the doors of the Court after an unexplainable delay of more than six and half years. None of the ingredients for continuing of the interim injunction in favour of the plaintiff arise. If injunction is allowed to continue, the loss to be suffered by the defendant would become irreparable as his business would come to stand still. In these circumstances, balance of convenience is also in favour of the defendant. The application of the defendant under Order 39 Rule 4 CPC is accordingly allowed and the interim ex parte injunction granted is set aside. Recently in *Proctor & Gamble Co. & Anr v. Shipra Laboratories (November, 2011)*, the Delhi High Court held that it is not in dispute that the defendant has been using the trade mark SAFE GUARD for sale of antiseptic creams. There is practically no difference between the trade mark SAFEGUARD and SAFE GUARD since no person is likely to notice the space between the words SAFE and GUARD. The Court observed that in any case, the defendant has no legal right to use the trade mark SAFEGUARD or any other mark identical or deceptively similar to this registered trade mark of the plaintiff in respect of any of the products for which registration has been granted. The plaintiffs, therefore, are entitled to an appropriate injunction, restraining the defendant from using the trade mark SAFE GUARD in respect of the product for which registration has been granted to it by Registrar of Trade marks in India.

Criminal Litigation: The Trade Marks Act, 1999 provides for remedies for infringement under the criminal laws too. The police have the power to *suo motu* conduct raids and seizure operations. However, the use of such powers by the police is minimal.

Under the criminal law, should the rights holder not be aware of the details (name, address, dates of infringement, etc.) of the infringers, it is advisable to procure a general search and seizure warrant from the local magistrate and thereafter organize search and seizure operations in that area. In the alternative, should the rights holder be aware of the details of the infringer a complaint can be lodged with the police authorities and raids organized accordingly. In a criminal proceeding, the litigation is between the State and the infringer and therefore the rights holder has a limited role to play. The maximum imprisonment that an infringer can get under the Trade Marks Act, 1999 is up to three years with a fine of up to two lakhs.

Provisions under the Customs Laws: Besides the civil and the criminal remedies mentioned herein above, there are also certain provisions under the trade mark law and the customs law which prohibit the importation of infringing goods in India. The Customs authorities have promulgated guidelines known as the Intellectual Property Rights (Imported Goods) Enforcement Rules, 2007, under which the rights holder can record their registered trade marks with the Customs authorities. These guidelines authorize the Custom officials to seize goods infringing the trade marks of the rights holder at the border without obtaining any orders from the Court. These rules also empower the Custom officers to destroy the suspended goods under official supervision or dispose them outside the normal channels of commerce after it has been determined that the goods detained have infringed the trade marks of the rights holder and that no legal proceeding is pending in relation to such determination. These rules also prohibit the re-exportation of the goods infringing trade marks in an unaltered state.

Unit –IV: Designs

A. Nature and Meaning:

Meaning:

“Design” means only the features of shape, configuration, pattern, ornament or composition of lines or colours applied to any article whether in two dimensional or three dimensional or in both forms, by any industrial process or means, whether manual, mechanical or chemical, separate or combined, which in the finished article appeal to and are judged solely by the eye; but does not include any mode or principle of construction or anything which is in substance a mere mechanical device, and does not include any trade mark as defined in clause (v) of sub-section (1) of section 2 of the Trade and Merchandise Marks Act, 1958 or property mark as defined in section 479 of the Indian Penal Code or any artistic work as

defined in clause (c) of section 2 of the Copyright Act, 1957. [Section 2(d) of Designs Act, 2000]

Object of Design Law:

The essential purpose of design law is to promote and protect the design element of industrial production. It is also intended to promote innovative activity in the field of industries. The Designs Act, 2000 and the Designs Rules, 2001 presently govern the design law in India. The object of the Designs Act to protect new or original designs so created to be applied or applicable to particular article to be manufactured by Industrial Process or means. Sometimes purchase of articles for use is influenced not only by their practical efficiency but also by their appearance. Therefore, it becomes much more important to extend protection to such designs.

B. Scope of Protection:

Registerable Designs:

A design is capable of being registered only if it is new or original.

Novelty: A design shall be considered to be new when it has not been disclosed to the public, anywhere in India or in any other Country, by publication or by use or in any other way, prior to the filing date or priority date. A design shall be considered new if it is significantly distinguishable from known designs or combination of known designs. [Section 4]

Originality: Original in relation to a design, means (a) originating from the author of design, and (b) includes the cases, which though old in themselves yet are new in their application. [Section 2(g)]

For instance, the figure of Taj Mahal is centuries old. But if a person conceives for the first time, the idea of making a flower vase or an ash tray in the form of figure of Taj Mahal, that may be an original design and shall be registrable.

Rights granted and the term of such Rights:

The registration of a design confers upon the registered proprietor the exclusive right to apply a design to the article in the class in which the design has been registered. A registered proprietor of the design is entitled to a better protection of his intellectual property. He can sue for infringement, if his right is infringed by any person. He can license or sell his design as legal property for a consideration or royalty. Registration initially confers this right for ten years from the date of registration. It is renewable for a further period of five years. If the fee for extension is not paid for the further period of registration within the period of initial registration, this right will cease. There is provision for the restoration of a lapsed design if

the application for restoration is filed within one year from the date of cessation in the prescribed manner.

Essential requirements for registration of Design:

A design should -

- i. Be new or original
- ii. Not be disclosed to the public anywhere by publication in tangible form or by use or in any other way prior to the filling date, or where applicable, the priority date of the application for registration.
- iii. Be significantly distinguishable from known Designs or combination of known designs.
- iv. Not comprise or contain scandalous or obscene matter.
- v. Not be a mere mechanical contrivance.
- vi. Be applied to an article and should appeal to the eye.
- vii. Not be contrary to public order or morality.

Who can apply for registration:

Any person or the legal representative or the assignee can apply separately or jointly for the registration of a design. The term "person" includes firm, partnership and a body corporate. An application may also be filed through an agent in which case a power of attorney is required to be filed. An Application for registration of design may be prepared either by the applicant or with the professional help of attorneys.

C. Procedure for Protection:

Application and Registration of Design:

Section 5 provides that the Controller may, on the application of any person claiming to be the proprietor of any new or original design not previously published in any country and which is not contrary to public order or morality register the design under the Act. Every application for registration is required to be in the prescribed manner and accompanied by the prescribed fee. A design when registered shall be registered as of the date of the application for registration.

As per Section 7, the Controller shall, as soon as may be after the registration of a design, cause publication of the prescribed particulars of the design to be published in the prescribed manner and the design be open to public inspection. Under Section 9 of the Design Act, the Controller grants a certificate of registration to the proprietor of the design when it is registered. The important purpose of design Registration is to see that the artisan, creator,

originator of a design having aesthetic look is not deprived of his bonafide reward by others applying it to their goods.

Register of Design:

The Register of Designs is a document maintained by the Patent Office, Kolkata as a statutory requirement. It contains the design number, date of filing and reciprocity date (if any), name and address of proprietor and such other matters as would affect the validity of proprietorship of the design such as notifications of assignments and of transmissions of registered designs, etc. and it is open for public inspection on payment of prescribed fee and extract from register may also be obtained on request with the prescribed fee.

Procedure for submission of application of registration:

Any person who desires to register a design is required to submit the following documents to the Design Wing of the Patent Office at Kolkata or any of the Branch Offices of the Patent Office at Delhi, Mumbai and Chennai. The applications received by the Branch Offices will be transmitted to the Head Office for processing and prosecuting.

- i. Application duly filed in on the prescribed form along with the prescribed fees, stating name in full, address, nationality, name of the article, class number, address for service in India. The application should also be signed either by the applicant or by his authorized agent.
- ii. Representation (in quadruplicate of size 33 cm x 20.5 cm with a suitable margin) of the article. Drawings \ sketches should clearly show the features of the design from different views and state the view (e.g. front or Side).
- iii. A statement of novelty and disclaimer (if any) in respect of mechanical action, trademark, work, letter, numerals should be endorsed on each representation sheet which should be duly signed and dated.
- iv. Power of attorney (if necessary).
- v. Priority documents (if any) in case of convention application claimed under Section 44 of the Designs Act, 2000.

Cancellation of registration of Design:

The registration of a design may be cancelled at any time after the registration of design on a petition for cancellation in form 8 with a fee of Rs. 1,500/-to the Controller of Designs on the following grounds:

1. That the design has been previously registered in India; or

2. That it has been published in India or elsewhere prior to date of registration; or
3. The design is not new or original; or
4. Design is not registrable; or
5. It is not a design under Clause (d) of Section 2.

D. Enforcement and Remedies:

Infringement of a copyright in design is termed as “Piracy of a registered Design”.

Piracy of registered design:

During the existence of copyright over any design, other persons are prohibited from using the design except or with the permission of the proprietor, his licensee or assignee. The following activities are considered to be infringement.

- i. To apply the design or any fraudulent imitation of it to any article for sale;
- ii. To import for sale any article to which the design or fraudulent or obvious imitation of it,
has been applied;
- iii. To publish or to expose for sale knowing that the design or any fraudulent or obvious imitation of it has been applied to it. [Section 22]

Test to determine infringement:

The Court has to determine whether the alleged infringement has the same shape or pattern and must eliminate the claim of similarity due to similarity of functions, e.g. similarity of functions would result when two articles have same shape due to the inherent nature of goods, two pens will necessarily be similar in having an ink tube, a cap and a nib for writing. This element of functional similarity is to be eliminated. The Judge has to look at the two articles and check out their similarities and differences and through the eyes of person with average intelligence see whether the defendant's article is substantially different from that of the plaintiff.

Remedy:

The judicial remedy for infringement of a registered design recommended in the Act is damages alongwith an injunction. Section 22(2) stipulates remedy in form of payment of a certain sum of money by the person who pirates a registered design. A suit in the appropriate manner for seeking the relief in the form of an injunction is also recommended.

Jurisdiction:

According to Section 22 a suit is to be instituted in a District Court or a High Court depending upon the quantum of damages claimed. The provisions of this section do not exclude action for passing off and for rendition of accounts.

Defences:

In a suit for infringement, a defendant may present evidence and argue the following defences:

- i. The plaintiff has no title to sue. He may question whether the plaintiff has no title to sue. He may question whether the plaintiff, is a registered proprietor of the design or his duly authorised agent or licensee.
- ii. The design is not entitled to protection. Disentitlement to protection can be pleaded on the grounds that:
 - a) the design has been previously registered in India,
 - b) it has been published in India prior to the date of registration, or
 - c) the design is not a new or original design.
- iii. The plaintiff's own conduct is tainted- Law expects the party approaching its doors to approach with clean hands. The defendant can plead that plaintiff's own conduct is tainted.
- iv. Delay and acquiescence- The institution of the suit within a reasonable time after the discovery of the infringement is expected of the plaintiff. The unreasonable delay in institution of the proceedings would amount to acquiescence on the part of the plaintiff to such an infringement. Acquiescence of piracy is a reasonable ground to deny the plaintiff any of the reliefs prayed for.
- v. Expiry of period of registration- The copyright on a design is limited by time, the defendant on proving the expiry of period of registration is entitled to use the design and the plaintiff is not entitled to any relief.

References:

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2. The Patents Act, 1970.
3. The Copyright Act, 1957.
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