

Intellectual Property Rights Primer for India

A Guide for UK Companies

Hunter Rodwell Consulting
in partnership with Rouse & Co. International

Fast track to the world ^{UK}

ABOUT THE AUTHORS AND SPONSORS

*Hunter Rodwell
Consulting*

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Rouse & Co. International, which has contributed legal and technical advice for the guides in this series, is a global intellectual property consultancy, providing the full range of IP services to many of the world's major IP owners. It operates from 17 offices in 11 countries worldwide and is regularly ranked among the leading IP practices in the jurisdictions in which it operates. Its wide range of IP professionals includes commercial and dispute resolution lawyers, mediators, patent and trade mark attorneys, researchers and specialist IP investigators. www.iprights.com



UK Trade & Investment is the government organisation that helps UK-based companies succeed in an increasingly global economy. Our range of expert services is tailored to the needs of individual businesses, enabling them to maximise their international success by providing them with knowledge, advice and practical support.

UK Trade & Investment also helps overseas companies bring high quality investment to the UK's vibrant economy: the UK is acknowledged as Europe's best place from which to succeed in global business. We provide support and advice to investors at all stages of their business decision-making. UK Trade & Investment offers expertise and contacts through a network of international specialists throughout the UK and in British Embassies and other diplomatic offices around the world.

For further information please visit www.uktradeinvest.gov.uk or telephone +44 (0)20 7215 8000.



The **UK Intellectual Property Office** is an Executive Agency of the Department of Innovation, Universities and Skills (DIUS). It was previously known as the Patent Office and has been in existence since 1852. UK-IPO is the official government body responsible for establishing and maintaining the national framework of intellectual property rights. These include Patents, Trade Marks, Designs and Copyright.

The UK Intellectual Property Office is also responsible for raising awareness of IP across the UK, helping businesses make the most of their IP and be better prepared to compete in national and international markets. UK-IPO offers chargeable search and advisory services to help business and publicly-funded bodies take decisions about intellectual property – because we know that IP can offer both an opportunity and a threat.

For further information please visit www.ipo.gov.uk or telephone +44 (0)1633 813930.

Also in this series
Intellectual Property Rights Primers for:

Brazil

China

Korea

Vietnam

WELCOME TO THE INTELLECTUAL PROPERTY RIGHTS PRIMER FOR INDIA

THIS IS ONE OF A SERIES OF GUIDES BEING PUBLISHED BY THE UK INTELLECTUAL PROPERTY OFFICE AND UK TRADE & INVESTMENT TO HELP BRITISH COMPANIES IN THE MAJOR MARKETS AROUND THE WORLD WHERE THEY ARE LIKELY TO MEET PROBLEMS IN OBTAINING, PROTECTING AND ENFORCING THEIR INTELLECTUAL PROPERTY RIGHTS.

Why India?

India is one of Britain's priority overseas markets. As Lord Bilimoria, Chairman of the recently-formed UK India Business Council, said in 2007:

'There is no doubt that India is going places. Its GDP has grown by an average of nine per cent over the past three years, and the future looks even brighter as India's reforms continue. Leading investment banks have projected that India's economy could grow at ten per cent per annum for the next decade, and become the world's second-largest economy – larger than the United States – by 2050.'

Effective business in India demands entrepreneurship, but it also requires a knowledge of how to use, guard and enforce the rights you have over the various forms of intellectual property owned by you or your company. There are many difficulties in achieving such protection in India. This guide provides the basic information you will need about IPR in general and how these principles may be applied overseas. In particular, it aims to make you better informed about the issues and the relevant legal framework in India.

Is this guide for you?

The content of this guide is pitched mainly at the managers of the business, rather than its lawyers, because we recognise that most smaller businesses do not have an in-house legal team, while the use of an external law firm tends to be limited by cost. However this guide is deliberately referred to as a 'primer'; we are not suggesting that it can, or should, replace the services of IP lawyers or other professionals such as patent attorneys: there will be times when it is essential to seek the advice of experts.

A company's intellectual property portfolio may be its most valuable asset. We believe it is sensible for the managers of the business to make themselves familiar with the concepts of IP and understand how the IP rights owned by their business will be affected in overseas markets. This knowledge can save the company a great deal of money through knowing what to look out for, taking timely self-help avoidance measures, appreciating when the experts should be consulted – and being able to communicate knowledgeably with them.

Not just for exporters

The guides in this series all deal with overseas markets but they are not aimed exclusively at exporters. Being involved in other types of business activity abroad also requires a good working knowledge of the local IPR environment. A company may conduct manufacturing or sourcing overseas without exporting at all; but its intellectual property rights may be just as vulnerable as a counterpart that is exporting its products or services from its UK base.

Even companies that are not involved in overseas markets can still become the victims of IPR abuse abroad. Any product may be copied or otherwise infringed by

perpetrators far away. This may not be of immediate concern to the UK-based business – until the counterfeiters start exporting their illicit goods to the UK or Europe. Such companies need to understand their position in relation to the law in the countries where the abuse originates if they are to take action successfully.

This guide should therefore be useful for managers of companies of all types, whatever their geographical span. And we hope that interested people generally, familiar or not with IPR in the UK or India, may find it a valuable addition to the existing body of information on the subject.

How this guide is organised

We start by examining the basic principles of intellectual property and rights, based on the laws that apply in the UK. We go on to deal with the European and global dimensions, discussing the ways that international treaties and arrangements affect UK rights owners. The next section deals with India: its international IPR memberships, its laws and how practices compare with those of the UK. Finally we look at the operation of IPR in India, with information and advice on preparation, protection, enforcement and the law. The appendices contain aides-mémoire covering the registration of IP in the UK, EU and worldwide, enforcement options and a comparison of the main IP rights conditions in the UK and India.

Hyperlinks are used to direct readers to more comprehensive information in the Reference section and from there to the Internet. From the Index, click on a heading to go straight to a chosen subject, while clicking on '[index]' moves you to the Index and '[return]' takes you back to your previous place in the text.

Currency: a conversion rate of £1 to INR81 (Indian Rupees) is used in this guide.

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1 Indian IPR References

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Central Board of Excise and Customs
Competition Commission of India
Confederation of Indian Industry
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Copyright Office
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Laws and Procedures (p.30)
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Local Law Firms

1. INTELLECTUAL PROPERTY RIGHTS BASICS

1.1 OVERVIEW

Q. How exactly are intellectual property and IP rights defined? [index]

Someone who is responsible for a 'creation of the intellect' such as an inventor, author or originator creates intellectual property (IP). Like tangible property, their creation has a value and, as with all property, it needs to be protected. Intellectual property rights (IPR) give them this protection, as well as helping them exploit and control their IP. Such a person is known as a 'rights owner' or 'rights holder'.

intellectual property definitions

Q. How do I know whether I have IP? [index]

The main criterion, for all forms of IP, is whether you have been responsible for creating something novel or innovative, representing progress over what went before. The definitions vary depending on whether it is a creation in the artistic or literary fields (protected by a copyright), a new technology (patent), a product's shape or appearance (design right) or a sign to distinguish your product or service from others (trade mark) – but the principle is the same: rights cannot be granted over anything mundane or generic, or which currently exists, is already in the public domain or is owned by someone else.

do you possess IP?

novelty is the crucial test...

However, if what you created was made in company time then the chances are that your employer will be entitled to own the rights to it. Whether it is owned by you or your company, intellectual property needs protection. Apart from with copyright and certain other rights that are already protected by law and do not have to be registered – 'unregistered rights' – this means you will need to apply to register the creation and, if successful, obtain 'registered rights'; otherwise there will be no protection and others will be free to exploit your ideas and efforts.

forms of intellectual property

Registered rights have to be applied for and granted by the government. In Britain the UK-IPO is responsible for granting all registrations. There is an extensive UK-IPO website to help you.

→ *the UK Intellectual Property Office*

Q. Which are the registered and unregistered IP rights? [index]

Registered IP rights consist of patents, registered trade marks and registered design rights. In the unregistered category are copyright, (unregistered) design rights, common law trade marks, database rights and protection for know-how under laws dealing with confidential information and trade secrets.

registered and unregistered rights

There are also rights covering plant varieties, geographical indications and the design of integrated circuits, as well as protection against 'passing off' under fair trade legislation.

Q. How do the main types of IPR differ? [index]

the definitions below are based on UK law

Copyright [index]

As we have seen, this is an inherent right (which means it is not applied for) protecting creative works such as books, music, plays, films and broadcasts. Copyright protection occurs automatically once the work has first been recorded in some way, such as by printing.

copyright: protects creative works such as books, music and films

Its relevance to works in the artistic, literary and media sectors is well known but copyright also covers industrial items such as a product's instruction manual as well as its technical drawings.

The period of validity of a copyright varies depending on the type of work. For dramatic, artistic or literary works the protection period in the UK is 70 years following the author's death, while for broadcasts and sound recordings protection lasts 50 years after first broadcast.

→ *UK-IPO: on copyright*

Patents [index]

Patents, a form of registered IPR, are used to protect technological inventions including processes. Although a patent doesn't automatically allow a rights owner to make or sell the item (since a product's manufacture and distribution must conform to prevailing regulations) it does protect the rights owner by preventing others from exploiting or copying the IP, so it is sometimes called a 'negative right'.

patents: protection for rights associated with technology and processes

A patent gives the inventor a monopoly right over the product and also allows him or her to license it for others to make and sell, in return for the payment of royalties. It is essential to apply for a patent early on in the process of the development of a new product or process since – in addition to the possibility of someone else copying it – a technology that is already in the public domain will not be registrable.

→ *UK-IPO: on patents*

essential to apply early

Obtaining a patent normally involves retaining a patent attorney to draft and file a patent application. To be eligible for patent protection your invention must be new and inventive and must not be of an excluded type. A search of worldwide patent databases will be made by the national Patent Office to find out if anyone has already filed a patent or disclosed a scientific article for the same technology. If not, and if the new product is deemed to be 'novel and inventive' (that is, not just a re-working of an existing idea), then the patent may be granted and the invention is protected from unauthorised use. In the UK this can take up to four and a half years; however the process can be significantly accelerated if examination work has already been conducted at another intellectual property office.

how to go about applying for a patent

As in most countries, a UK patent is valid for up to 20 years. To maintain it, fees must be paid annually after the fifth year.

→ *renewal of patents and other IP rights*

Design Rights [index]

Design rights, as we have seen, consist of both registered and unregistered forms. The distinctions between what exactly may be protected by each, and the relative levels of protection, are complex. Expert advice is needed to choose which is appropriate.

The more common type is the registered design, covering the appearance (that is, the shape or pattern) of a product or its packaging, as well as typefaces and graphics. To be registered in the UK a design must be distinctive and novel – it should not ‘remind an informed person of an existing design’ – as well as meeting other detailed criteria.

Whilst there are costs involved in obtaining registered design rights (compared with relying on unregistered design rights, which are free) this form of IPR can be treated in the same way as patents – for example, by rights owners exploiting their IP through licensing – and it provides a good level of protection. A registered design right lasts for up to 25 years in the UK and must be renewed every five years.

design rights: for the appearance of an object; rights may be registered or unregistered

designs must be novel to qualify

→ *UK-IPO: on design rights*

Trade Marks [index]

Registered trade mark rights protect the signs used to identify a company’s products or services, distinguishing them from those owned by other businesses. Brand names and logos are perhaps the most familiar form of trade marks, but elements like a product’s colour or shape, or even a piece of music or (at least, in theory) a smell associated with it, can be registered as trade marks. You can also register a slogan, logo or domain name.

Various criteria are used to decide whether a distinctive sign is registrable. The use of a generic term, for example, would not be allowed as everyone should be free to use it, while those which merely ‘designate the kind, quality, quantity, intended purpose, value, geographical origin...’ of the goods or service are disallowed as insufficiently distinctive. However if it can be shown that an otherwise mundane feature associated with a product (for example its colour) has become distinctively connected with the product, it may be allowed.

Registration, normally using the services of a trade mark attorney, consists of filing an application with UK-IPO’s Trade mark Registry, followed by a search and examination. Before a trade mark is granted it is advertised in the UK Trade Marks Journal and can be opposed. A renewal fee is payable every ten years. A registered trade mark will remain valid indefinitely if the rights owner continues to use and renew it. Goods are classified for registration purposes under the 45 class headings of the ‘International (Nice) Classification of Goods and Services for the Purposes of the Registration of Marks’.

Another type is the unregistered or common law trade mark. As with unregistered design rights, this form of protection is not frequently used as it has less force and relies on the common law offence of ‘passing off’ for protection. The ‘™’ device indicates that a trade mark is subject to this type of rights, whereas a registered trade mark can use the ‘®’ symbol.

The term ‘word mark’ is applied to a form of trade mark based solely on a typographic treatment of a piece of text that provides a recognised identity and branding.

trade marks: signs to identify products or services

→ *UK-IPO: on trade marks*

distinctiveness is an important criterion

→ *new rules for notifying trade mark owners about applications for similar marks*

→ *Nice classification system*

unregistered trade marks: free but less effective

word marks

Other Rights [index]

The IP rights set out above are the major ones that most companies require. There are also specific provisions for the following:

- **Domain Names.** Ownership rights for domain names may be defended as a reflection of the content involved, for example under trade mark, copyright and passing-off laws. → [domain names](#)
- **Geographical Indications (GI).** This form of rights, part of the UK Trade mark Act, protects the identity of goods whose characteristics are attributable to their geographical origin. → [geographical indications](#)
- **Plant Varieties.** Rights covering all plant genera and species are available under the Plant Varieties Act 1997. → [plant varieties](#)
- **Semiconductor Topographies.** Rights over the designs of the layouts of semiconductors are protected as unregistered design rights in the UK. → [semiconductors](#)
- **Software.** The patenting of computer software is a problem area, depending on interpretation of the much-discussed ruling by the European Patent Office (EPO) that 'computer programs as such' are not patentable. → [European rules for software IP](#)

Q. The term 'industrial property' is sometimes used. How does this differ from 'intellectual property'? [index]

The following quotation from the World Intellectual Property Organization (WIPO), a Geneva-based United Nations agency with 184 member nations, explains this distinction and summarises the paragraphs above:

'Intellectual property refers to creations of the mind: inventions, literary and artistic works, and symbols, names, images, and designs used in commerce.'

'Intellectual property is divided into two categories: Industrial property, which includes inventions (patents), trade marks, industrial designs, and geographic indications of source; and Copyright, which includes literary and artistic works such as novels, poems and plays, films, musical works, artistic works such as drawings, paintings, photographs and sculptures, and architectural designs.'

A summary of registration procedures in the UK is provided in Appendix A.

→ [WIPO](#)

['industrial property' defined](#)

→ [UK registration procedures](#)

1.2 INTERNATIONAL CONSIDERATIONS

Q. Do these rights apply internationally? [index]

Member nations of the World Trade Organisation (WTO) are committed to include an agreed scope of IPR protection in their national laws. These requirements, akin to 'minimum standards', are set out in the Trade-Related Aspects of Intellectual Property Rights (TRIPS) Agreement, which was negotiated in 1994. TRIPS also specifies procedures for associated matters such as IPR enforcement and dispute resolution.

→ *WTO*

→ *TRIPS*

This means that if you are doing business in countries that are members of the WTO you will find a degree of similarity between local IPR laws and those in force in the UK. In theory at least, the same can be said of the local enforcement and dispute resolution procedures and practices. (Few major trading nations are not included: there are now more than 150 WTO members. An important exception is the Russian Federation, which currently has observer status).

→ *WTO membership*

Whilst this enhances international IPR protection and makes it simpler for rights owners to understand what to expect in other countries, the existence of universal minimum standards does not mean IP rights held in one country will be valid in others. It is a common and potentially dangerous misconception amongst some rights owners that their domestic IP rights automatically extend worldwide. In fact – with certain exceptions and beneficial reciprocal arrangements arising from international treaties – many IP rights must be registered for specific, designated countries. This limitation is known as territoriality.

territoriality: essential to know which rights apply internationally

Q. What are the exceptions and reciprocal arrangements? [index]

These include copyright and other IP rights that are recognised under supranational laws, treaties and extensions. There are also international agreements making it easier for rights owners to achieve recognition for their rights abroad by allowing a single registration to apply more widely within a group of contracting states, or by streamlining search and application procedures.

Copyright [index]

Copyright regulations are governed by the Berne Convention, established in 1886, and (now less important) the Universal Copyright Convention (UCC), set up as an alternative to the Berne Convention. As we have seen, WTO members are bound by TRIPS; this, in turn, means they accept the Berne Convention, which covers most trading nations: there are 163 Berne Convention signatories. However in certain countries it is advisable – and in some cases, standard practice – to make a 'recordal' even of copyright to enhance protection by ensuring its prompt and trouble-free recognition.

→ *Berne Convention*

There are several systems to harmonise intellectual property rights in the EU, just as there are in Benelux and other trading blocks such as NAFTA. It is important to know whether a particular form of IP rights applies automatically to a number of territories – 'unitary' rights – or only in those territories for which it has been specifically registered. Unitary rights enjoy the same protection across a group of states without the need to apply for the rights individually in each.

definition of 'unitary' rights

Community Trade mark [index]

The Community Trade mark (CTM) system, which operates alongside the national trade mark systems of EU countries, is unitary – so a single registration in one of the EU member states confers trade mark protection rights throughout the EU. CTM applications are administered by the EU's Office for Harmonisation in the Internal Market (OHIM) in Alicante.

→ [the Community Trade Mark: a unitary right within the EU](#)

Madrid Protocol [index]

The Madrid System for the International Registration of Marks ('the Madrid Protocol'), operated by WIPO, is another unitary system for trade marks. An application filed in the UK means it will be recognised as an application in other countries that have also signed up to the Madrid Protocol, as designated in the application. ('The Madrid Union' currently consists of more than 70 individual nations plus the EU and the Russian Federation).

→ [the Madrid Protocol and Madrid Union membership](#)

Local trade mark authorities are allowed to challenge the filing but if they do not do so within 18 months the trade mark receives the same protection as if locally registered. In 2004 the European Community joined the Madrid Protocol, which allows a Community Trade mark to be used as the basis of an application for trade mark registrations under the Madrid Protocol.

[18 months to challenge a filing](#)

European Patent Convention [index]

There has long been pressure within the EU for a system for patents along similar lines to the Community Trade mark but so far negotiations have failed to achieve this. The European Patent Convention (EPC), with more than 30 contracting EU and other European nations, does not confer unitary protection and falls well short of being a 'community patent'; but it does provide useful assistance for European companies registering patents. Harmonised procedures allow you to make a single application, via the European Patent Office (EPO), for as many of the EPC countries as you need to cover. However the patents granted can then only be enforced individually, on a national basis.

→ [EPC explanation and text](#)

Patent Cooperation Treaty [index]

Similarly, an application under the 1970 Patent Cooperation Treaty (PCT), operated by WIPO, does not lead to an 'international patent' but is a streamlined procedure allowing an application for a patent in a single language to apply simultaneously in any of the more than 130 PCT contracting countries ('The PCT Union'). The process involves an 'international phase' application followed by a search to assess whether an invention is capable of being patented in the designated territories. Once this has been decided, applications may be made in the individual countries, in the 'national phase', according to local rules and procedures.

→ [further information on the PCT and its membership](#)

The main advantages of making a PCT application are that it buys extra time (about 18 months) and cuts costs by reducing duplication, helping you avoid territories where the chances of obtaining a patent are low. For the UK, the European Patent Office performs the international searches under the PCT system.

Registered Community Design [index]

A Registered Community Design (RCD) offers unitary protection throughout all the EU member states, based on a single application to OHIM, the administering authority. It lasts for up to 25 years, in a series of five-year periods.

Unregistered community designs are weaker and offer less protection than RCDs. However they may be useful in certain industries where it is not feasible to apply to register an RCD, for example in textiles.

→ *the RCD: unitary protection in the EU*

→ *unregistered community designs*

Hague Agreement [index]

Further protection for design rights is available to signatories of the Hague Agreement, administered by WIPO, which allows the protection of designs in multiple countries through a single filing in one language. As with the Madrid System, there is the possibility of refusal by national design rights authorities. There are 48 contracting states, including the European Community.

In 2007 the European Commission passed legislation linking the RCD and Hague Agreement systems. This enables companies in EU countries that have not individually signed up to the Geneva Act of the Hague Agreement to extend the coverage of an RCD into the 23 Hague Agreement states. The EC acceded to the Geneva Act on 1 January 2008.

→ *Hague Agreement and linking of the RCD*

Paris Convention [index]

The most important provision of this long-standing intellectual property treaty, dating from 1883 and now administered by WIPO, is the establishment of 'priority rights' for patent, design and trade mark applicants in respective signatory states.

This system allows applicants in one country to gain protection for their IP in another. The date of filing in the first country is counted as the effective date of filing in a second country, as long as the second filing occurs within a set period: six months for trade marks and designs; a year for patents and utility models.

→ *Paris Convention*

international 'priority rights' for patents, designs and trade marks

Rights Extensions [index]

In addition to the arrangements set out above, British companies can benefit from extensions of their IP rights in more than 40 current and former Commonwealth nations and territories.

A summary of international treaties and registration procedures is provided in Appendix B.

→ *extensions of IP rights for UK firms*

→ *international treaties and procedures*

2. INDIA

2.1 IPR OVERVIEW

Q. Which principal international IPR organisations and agreements does India belong to? [index]

- Berne Convention (copyright) – since 1928
- Hague Agreement/Geneva Act (designs) – non-member
- Madrid Protocol (trade marks) – accession expected 2009
- Paris Convention (priority rights) – since 1998
- Patent Cooperation Treaty (patents) – since 1998
- WTO/TRIPS (IPR in general) – since 1995

India's membership of international IPR-related organisations

Q. How does India compare with Europe in terms of the protection of IPR? [index]

India's IPR legislation covers every significant aspect of the protection of IP in accordance with the international standards required by TRIPS (see 1.2 above). The regulations relating to all forms of intellectual property have been amended or reissued in recent years, mainly in response to India's accession to the WTO in 1995 and, with it, membership of TRIPS.

IPR protection in India and the EU compared

Although the IPR law is thorough and, for the most part, stands comparison with international norms, there remain significant concerns over enforcement. Dr Kebschull, Chief Programme Coordinator of EU-India Trade and Investment Development Programme, pointed out that:

'India is not considered an efficient production location in terms of IPR. Its image has to improve with regard to intellectual property rights to enable investment from small and medium enterprises that create employment and investment... There are laws but there is hardly any enforcement and awareness about IPRs! (speech, 23 November 2007)

views of the EU...

US Under Secretary of Commerce for International Trade, Franklin L. Lavin, stated:

'Some progress has been made toward creating a more comprehensive framework for IPR protection in India. For example, in 2005 India extended patent protection to pharmaceutical and agricultural products. Still, India does not have in place a TRIPS-consistent data exclusivity regime for these products. Also, many perceive an uneven enforcement of India's existing trade mark and copyright laws! (speech, 2 May 2006)

...and the US

India is now on the USA's 'priority watch list', whereas it was previously designated a 'priority foreign country' within the more stringent 'Special301' system, which monitors the IPR protection performance of US trading partners. Meanwhile Indian law firm Anand & Anand Advocates is more positive:

'The Indian IP regime has come a long way in recent months, and the outlook for the protection and enforcement of IP rights in India has never looked more positive. With the Indian judiciary showing enthusiasm for and commitment to the protection of IP rights, IP owners have become more proactive in enforcing their rights by all means, and are exploring uncharted waters to obtain unique remedies

local lawyers more sanguine

from the courts... While much still remains to be done regarding the criminal justice system, the Indian civil system for the protection of IP rights is improving daily.

(Pravin Anand and Keshav S Dhakad, Anand & Anand Advocates India: 'Building and enforcing intellectual property value 2007').

Q. Is the Indian government in earnest in fighting IPR infringement? [index]

is the government in earnest?

The scale of IPR education programmes in India is huge – but so is the problem, especially in relation to patents and copyright. There is no clear answer to this question; some outsiders are adamant that more should be done, while certain official Indian authorities insist that the picture is much rosier.

The not-for-profit Confederation of Indian Industry (CII) provides a good example of taking a lead in promoting public awareness initiatives:

→ CII

'...the IPR Division of CII also conducts various National level awareness programs, sectoral focused IP workshops, moot courts, seminars, training programs and interactive sessions across the country. The overall objective of the IPR Division is to foster an 'IP Culture' which would enhance the Intellectual Capital, which is vital for economic development of the Country.'

– public education initiatives

There are also a number of government measures designed to improve IPR training and awareness in India. The Department of Industrial Promotion and Policy has signed co-operative agreements with patent offices and other relevant departments of countries including France, the USA and the UK. In 2006 India agreed a Joint Statement of Intent on Bilateral Cooperation on IPR with the UK. The proposals included: the training of patent and trade mark officials; further development of the profession of patent and trade mark attorneys; the sharing of experience and best practice in the investigation of the IPR infringement; greater attention to the teaching of IP law in law schools and universities; and measures to increase the awareness and understanding by industry of the use of intellectual property. These are to be furthered by means of a joint programme implemented by the UK Intellectual Property Office and the Indian Office of the Controller General of Patents, Designs and Trademarks.

government-to-government initiatives

Q. What are the main difficulties rights owners face in enforcing their rights? [index]

A major cause for concern in enforcement is bureaucratic delay, with a backlog of cases at both the civil and criminal courts. This means that cases can run for five years or more. There is a lack of transparency, particularly at a local level. Set against these problems is the balanced approach of the Indian judicial system, which comes down heavily on IPR infringers. Over the years decisions in favour of foreign companies against local infringers have demonstrated the judiciary's impartial approach. In addition the readiness of the Indian courts to grant interim injunctions usually means an infringement is halted pending the outcome of a case.

challenges for rights owners

Nonetheless there may be unhelpful factors when enforcing your rights by carrying out search and seizure through the police. Instances have been reported of social unrest and the disruption of search and seizure procedures by local trade associations following robust market-level crackdowns against infringers. This has in some cases led to a reluctance by enforcement officials to take similar action in future.

A significant feature of the IPR abuse environment in India (compared with, say, China) is the large number of small players infringing IP rights. This means that seizures tend to be small, which requires a sustained and financially draining effort in order to make an impact.

It should be noted that there are problems caused by legal deficiencies in the protection of undisclosed test data, mainly affecting pharmaceutical companies operating in India.

An advantage for UK business people operating in India is that the legal system is based on common law, as in the United Kingdom, so the fundamental processes are familiar.

2.2 INDIA'S IPR LAWS AND PROCEDURES

Q. What are India's IPR laws and procedures and how do they compare with the UK's? [index]

As discussed above, India's membership of WTO/TRIPS means it is required to establish and maintain laws whose effect is in line with certain minimum international standards. The specifics of the main forms of IPR in India are summarised below.

→ *texts of all India's IP laws*

Copyright [index]

India's Copyright Act was upgraded in 1995 to reflect the provisions of the Berne Convention and it has since been amended by the Copyright (Amendment) Act of 1999. Because of India's membership of this international treaty there is no requirement – as we have seen in Chapter 1 – for rights owners to register their copyrights as they already receive international protection. However it may be advisable to register as doing so may help to prove ownership if there are criminal proceedings against infringers; but in most cases, under the civil law, registration is not necessary to maintain a copyright infringement claim in India. Registration is made, in person or via a representative, with the Copyright Office, a subsidiary of the Ministry of Human Resource Development under the control of the Registrar of Copyrights.

copyright law

no need to register copyright, but it may be advisable to do so

→ *the Copyright Office*

The Act covers the usual scope of items subject to copyright internationally: literary, dramatic and artistic works such as films, photographs, music, books, illustrations and so on. It also protects computer programs, satellite broadcasting and digital technology. Protection for most forms of copyright in India extends to 60 years from the author's death.

Piracy over the Internet of films, music, books and software is particularly severe in India. According to the Business Software Alliance's Global Software Piracy Study for 2006 (published in May 2007) India's software piracy rate was 71 per cent, compared with the Asia Pacific average of 55 per cent. There are heavy penalties for software copyright infringement but public education lags considerably behind the law: it is believed that the vast majority of illegal copiers are ignorant of their offence or wholly apathetic to it because they are unlikely to be caught.

piracy over the internet

Patents [index]

India's Patents Act of 1970 and 2003 Patent Rules, together with their amendments of, respectively, 2005 and 2006, set out the law concerning patents but (as in the UK) there is no provision for utility model patents. The law is fully compliant with TRIPS.

patent law

The regulatory authority for patents is the Patent Registrar within the department of the Controller General of Patents, Designs and Trade Marks, which is part of India's Ministry of Commerce and Industry. Patents are valid for 20 years from the date of filing an application, subject to an annual renewal fee.

→ *Controller General*

maximum effective periods

In order to be patented, the item in question must be 'a new product or process involving an inventive step and capable of industrial application' (see Indian Patent Office's Draft Patent Manual, p.21). This definition is similar to that in most countries' patent requirements.

→ *patent manual*

India's patent law operates under the 'first to file' principle: if two or more applicants file for patents for identical items, the one whose application was filed first prevails. This is similar to UK law but different from practice in the US, where 'first to invent' is the critical test.

'first to file' criterion

In accordance with the Paris Convention (see 1.2 above), and as in other countries, the law allows for applicants for patents filing in India to 'enjoy a right of priority' if they have already applied for a patent for the same item overseas within the previous 12 months.

'rights of priority'

India is a member of the Patent Cooperation Treaty (PCT). This means that foreign owners of patents can assess the possibility of obtaining a patent before embarking on the 'national phase' of the application within India – at the end of which, if the patent is granted, they will have the same protection as any other patentee.

India is a PCT member

Designs [index]

The laws governing designs are the Designs Act of 2000 and the Designs Rules of 2001. In India designs are defined as follows:

'A design refers to the features of shape, configuration, pattern, ornamentation or composition of lines or colors applied to any article, in two or three dimensional (or both) forms.' (Design Office, Kolkata: Guidelines for Registration)

→ *registration guidelines*

Designs are valid for a maximum of ten years, renewable for a further five years. The 'right of priority' for previous filings of designs overseas requires filing in India within six months of an overseas filing.

designs: ten-year protection

Trade Marks [index]

India's trade mark laws consist of the 1999 Trade Marks Act and the Trade Marks Rules of 2002, which became effective in 2003. The new regulations have been widely welcomed by rights owners and practitioners alike.

trade marks

The regulatory authority for patents is the Trade Mark Registrar within the department of the Controller General of Patents, Designs and Trade Marks. The police now have more robust powers in enforcing trade mark law, including the ability to search premises and seize goods suspected of being counterfeit without a warrant. But these powers are tempered – or, from the perspective of rights

greater police powers ...but delays dilute their effectiveness

owners, made much less effective – by the requirement for the police to seek the Trade Mark Registrar’s opinion on the registration of the mark before taking action. This adds to the delay and may result in counterfeit goods being removed or sold.

The draft Trade Marks Work Manual provides the following useful definitions (p.7):

...‘trade mark’ means a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include shape of goods, their packaging and combination of colours... ‘mark’ is defined to include a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof... The word ‘mark’ is thus intended to be interpreted broadly and no type of sign is automatically excluded from registration. Marks which will require special consideration are colours, shape of goods, sounds and smells.’

[definitions](#)

Trade names also constitute a form of trade mark in India, with protection, irrespective of existing trade names, for those wishing to trade under their own surname. Domain names may be registered as trade marks subject to the usual criteria for registrability in India. Because of the widespread practice of ‘cybersquatting’ – the registration in bad faith of marks by third parties registering domain names for certain well known marks in order to sell them to the original rights owners – it is advisable for rights owners to register their domain names in India as trade marks as soon as they can.

[trade names](#)

[domain names](#)

Protection for ‘well-known marks’ is similar to that available in most countries, with registration of such a mark by someone other than the original trade mark owner disallowed under the terms of the Paris Convention. However in one respect protection is better than in many countries: it is illegal for a well-known mark to be applied to types of goods that are not the same as those for which the mark was originally registered. Marks other than well-known marks are protected in India under the principle that prior adoption and use of a trade mark takes precedence over the registration of a similar mark:

[well-known marks](#)

‘...the Registrar shall not refuse [provided continuous prior use is proved] to register the second... trade mark by reason only of the registration of the first... trade mark.’ (Trade Mark Act, Section 34)

Applications for trade marks are made on an ‘intent-to-use’ basis, so goods or services do not need to be on the market in India at the time of filing. However a trade mark must be used in India within five years and three months of registration or it may be deemed invalid.

[‘intent-to-use’](#)

Protection is also available for geographical indications, although this area is governed by the Geographical Indications of Goods (Registration & Protection) Act of 1999 rather than the Trade Marks Act. As in the UK, tests of registrability cover issues such as generic terms, geographical names and distinctive features.

[geographical indications](#)

Registration takes up to two years. A trade mark in India is valid for ten years and can be renewed thereafter indefinitely for further ten-year periods. If there are two or more applicants for identical or similar trade marks for the same or similar goods the one that was registered first prevails, as in the UK. Regulations about the ‘right of priority’ for those applying in India for trade marks for which applications have already been made overseas are similar to those for patents, in accordance with international practice.

[registration](#)

[‘right of priority’](#)

India is not yet a member of the Madrid Protocol but is expected to join in 2009. As described in Chapter 1, this will provide a unitary method of reciprocal trade mark registration for UK companies, with registration based on either a national UK trade mark or a Community Trade Mark.

unitary registration under the Madrid Protocol

Under the Paris Convention, as for patents, a filing in a foreign country is valid as a filing in India. In the case of trade marks this must be done within six months. Trade marks that remain unused for five or more years, or which lapse for that period, may be cancelled by another company if non-use can be proved.

Paris Convention

Unfair Competition Law [index]

The law relevant to unfair competition is the Competition Act of 2002, establishing the Competition Commission of India (CCI). This law allows actions against aspects of business not specifically covered by the dedicated IPR laws, such as 'dead copies'; it also protects businesses from abuse by powerful rights owners, for example in licensing situations.

→ *competition law*

How IP Rights Parameters in the UK and India Compare

A comparison between the main features of IP rights in the UK and India, relating to timescales and the basic costs for the official processes of registering the rights, is provided in Appendix D.

→ *UK & Indian IP rights compared*

2.3 PREPARATION

Q. What steps should a company take to avoid problems? [index]

The most important step is adequate preparation. This means taking advice from those who are knowledgeable about IPR in India, consulting publications and websites and referring to the many sources of assistance that are aimed specifically at companies doing business there. Many of these are listed in this document and referenced websites. (See also Where to Get Help in India below).

preparation is the key

It is also sensible to make a special assessment of the risks in India to the intellectual property owned by the business. This is particularly important if you feel your IP is potentially at risk from infringers, if other companies in similar areas of business have had problems, or if your products or services have previously been exposed to IP infringement in other territories. Such a risk assessment might include:

make an IP risk assessment

- Performing due diligence checks on the various organisations and individuals with which you intend to have dealings in India.
- Seeking professional advice from lawyers and other firms that are experienced in advising on IPR in India, as well as local diplomatic posts and chambers of commerce, as well as the India Britain Business Council, which is based in London.
- Talking to other companies which are already doing business of the same type in India or operating in the same location.
- Consulting your agents, distributors, suppliers and others who are knowledgeable about local conditions for the goods or services in question.

- Checking with a trade mark or patent attorney to see whether there have been previous registrations of your own marks, or other IP, in India. Any prior registrations are bound to cause difficulties and putting matters straight might be expensive or, at worst, unachievable.

While this is by no means a comprehensive list of the types of people and organisations you might consult, it offers some ideas on how to go about assessing the vulnerability of your IP. Such actions are a part of the overall risk assessment you will need to make when embarking on a new project overseas.

Above all, it is important to develop within your company an attitude of being true to normal instincts and sticking to familiar business methods. IPR infringement goes hand in hand with other corrupt practices, so it is essential that those new to the market are not beguiled by entreaties to 'do things differently' when overseas. Good local representation will be a key element in protecting your interests and avoiding problems of this kind.

stick to your instincts

Q. Who should take responsibility for a company's IPR protection? [index]

The simple answer is: everyone. Many companies depend on the integrity of their IP, often one of their most valuable assets, for their livelihood. So this subject should be given proper attention by the management and staff, as well as those with whom the company has relationships in other companies.

IP protection depends on everyone in the business...

It may be sensible for a manager to be nominated who will have particular responsibilities for aspects such as understanding what constitutes the IP owned by the business, which sources of assistance and information are available and how to set up measures to protect IP rights. In companies with legal departments a legally-trained manager would be the obvious choice; but in an SME without the benefit of an in-house legal team this role could still be adequately performed by a manager with sufficient interest, commitment and training.

...but consider appointing a manager with specific responsibility for IP

2.4 OPERATING IPR IN INDIA

Q. How does one go about registering IP rights? [index]

As we have seen, there are a number of possible situations:

- For copyright, no registration is required but registering copyrights with the authorities is advisable. Registration is made with the Copyright Office.
- For patents and industrial designs individual registrations must ultimately be made in India, but for rights other than industrial designs the search process is eased, and extra time gained, by applying under the terms of the Patent Cooperation Treaty. These types of rights are registered with the Controller General of Patents, Designs and Trade Marks.
- For trade marks, the options are registration within India or (after India joins in 2009) use of the Madrid Protocol to gain unitary rights under national or Community Trade mark registration systems; in the case of well-known brands, there is protection under the Paris Convention, even if unregistered, but this is an area of law which is still evolving.

registering your rights

- ‘Priority rights’ under the Paris Convention assist in the local registration of trade marks, designs and patents by allowing rights previously registered elsewhere to become effective in India, if filed within a time limit.

Registration is strongly advisable for foreign firms operating in India; it may also be undertaken for copyright. As in the UK, unregistered rights exist for certain types of intellectual property but this can be a complex area of the law and advice from local law firms is essential. However, as a guiding principle, if you do not register your rights you may find it difficult to enforce them.

registration is advisable

Q. What are the steps in IP rights enforcement? [index]

IP rights may be enforced by bringing actions in the civil courts or through criminal prosecution. There is also the possibility of mediation before an action is brought. India’s laws governing all the forms of IPR set out procedures for both civil and criminal proceedings, as does the Competition Act.

In civil litigation, interim injunctions are available to halt the alleged infringement pending further investigation. A rights owner may request that the court appoints a ‘Local Commissioner’ to raid premises and seize goods. In Case Study A an injunction was awarded and a court official deputed to make further investigations.

action through civil litigation

→ Case Study A

A disadvantage of civil litigation is that – although the infringing activities may be halted – a rights owner is unlikely to recover large damages; and punitive damages against an infringer are rare. Damages are routinely awarded in cases of copyright piracy and trade mark infringement; less so in patent cases. Case Study B shows how a civil case heard in New Delhi resulted in benefit for the plaintiff, even though only token damages were awarded.

→ Case Study B

As in other countries, the State brings actions in criminal cases; however in most cases actions follow complaints to magistrates or police authorities by rights owners. The extent to which the police will act in the absence of such complaints varies with the type of IPR in question. As mentioned above, the new Trade Mark Act allows more powerful police intervention than previously, whereas the regulations governing other forms of rights are for the time being out of step (although, in theory at least, the police may take action without a complaint if copyright infringement is suspected, although this seldom occurs). Nonetheless, criminal proceedings against infringers – when they do take place – carry the prospect of much harsher remedies, including fines and imprisonment.

criminal prosecution

The critical question for rights owners is which type of action to pursue: comparatively straightforward, routine civil proceedings, with the possibility of minimal damages; or criminal actions, which may be more difficult to invoke but which carry stronger penalties? When deciding, it may be helpful to distinguish between widespread or ‘market-wide’ abuse by a string of small-time infringers; and dedicated, large-scale infringement by one or two illegal businesses, methodically setting out to produce (for example) counterfeit goods.

which is more effective ?

In the former case, a series of police raids may have a powerful deterrent effect, even if there is no action in the courts; in the second, with a well-defined target, a civil action may be more suitable – with the prospect of bad publicity for the infringer.

Mediation or negotiation with an infringer can also be effective as an alternative form of dispute resolution. However these options work best where there are precedents in place that can be shown to the other party to impress on him the benefits of resolving the matter without resort to civil or criminal enforcement. The Civil Procedure Code provides for a formal mediation process.

mediation

In certain states and union territories (Delhi, for instance) the Economic Offences Wing – Crime Branch of the local police operates IPR sections tasked with tackling counterfeiting and copyright violations. It may be advantageous for a rights owner to approach these bodies (where they exist) to report infringements, in addition to involving the local police.

specialist IPR wings – in certain states

The role of Customs should also be borne in mind. Customs officers have the power to intercept, at their own initiative, goods being imported or exported that are suspected of infringing the IPR regulations. The Intellectual Property Rights (Imported Goods) Enforcement Rules of 2007 allows rights owners to request that particular shipments should be denied clearance through Customs by making a ‘customs recordal’ defining the goods in question. Customs may also destroy offending goods and bring prosecutions against infringers in the courts.

powers of Customs

→ *Central Board of Excise & Customs*

A summary of enforcement options (not specific to India) and their pros and cons is provided in Appendix C.

→ *enforcement options*

Self-Help Measures

Q. Should I be reconciled to taking formal action to protect my IP? [index]

The best method of protection is avoidance, rather than expecting to initiate cases against infringers. Avoidance means taking measures that lessen the likelihood of infringement. We have covered many of these under Preparation above: getting good advice, doing risk assessment, checking IP rights registrations, performing due diligence checks, filing your applications as soon as possible, giving your intellectual property the management attention it deserves as a key element of the business and – most important – remaining true to normal business instincts, wherever you are operating.

prevention is better than cure...

There are also some particular self-help considerations for companies operating in risky territories:

- Design: make it harder for infringers to reverse-engineer your product.
- Staff: hire honest people, have effective IPR-related clauses in employment contracts, educate employees about IPR protection and require them to safeguard the IP assets of the business and help to detect infringements.
- Documents and equipment: institute sound physical protection and destruction methods for drawings, tooling, samples, machinery and so on.
- Packaging: make sure there are no ‘leakages’ of packaging that might be used by counterfeiters to pass off fake product in real packages.
- Production over-runs: police them to ensure that genuine product is not being sold under a different name.

self-help measures that can help you avoid IPR infringement problems – and the need to take enforcement action

Top Tips for IPR Protection in India [index]

tips for success

- Stick to your normal business instincts
- Prevention is better than cure – and cheaper
- Assess the risks of the market and make preparations
- Seek advice but take self-help measures to protect your IPR
- Make sure everyone in your business values its IP
- Register your IP rights – even copyright
- Forge good relationships with organisations that can help you
- If action is necessary, be resolute but consider mediation first
- If you don't show that you value your IP, who else will?

Where to Get Help in India [index]

Many of the links in this guide give details of organisations that can assist in various situations. In addition, the following organisations can provide advice on IPR in India:

- British High Commission, New Delhi. A message from the High Commissioner:
'Almost all of the British Government's international priorities involve stepping up our engagement with India. They cover a wide range of sectors: foreign and defence policy; counter-terrorism and counter-proliferation; economic and trade policy; science, education, and innovation; environment and sustainable development. All of this, plus vibrant people-to-people contact, will make the bilateral relationship even more valuable for both our great nations.'
→ [British High Commission and Deputy High Commissions](#)
- Indo British Partnership Network. There is no British Chamber of Commerce in India per se, although many local chambers in the UK have strong affiliations with Indian counterparts. In its Third Report, in 2006, the House of Commons Trade and Industry Committee stated:
'We recommend that a decision is taken to position the IBPN as the leading player for the private sector in the UK; it should become the de facto Indo-British Chamber of Commerce and so the natural voice of commerce in relation to Indian trade and investment issues.'
→ [IBPN](#)
- UK India Business Council. From Lord Bilimoria, Chairman:
'If Britain is to engage and embrace India and realise the enormous opportunities available to businesses on both sides of the relationship, then it is essential to have access to top-flight advice, connections and networking opportunities, along with up-to-date and comprehensive information. This is what the UKIBC will provide to its members.'
→ [UK India Business Council](#)
- American Chamber of Commerce in India:
'Established in 1992, AMCHAM has over 550 members. Companies of US origin make up about 95 percent of membership, the remaining being individual or honorary members.'
→ [AmCham](#)
- See a website listing local law firms in India in the Reference section.
→ [law firms](#)

3. FEEDBACK

If you have any comments about what you have read in this guide we would welcome your feedback.

[feedback](#)

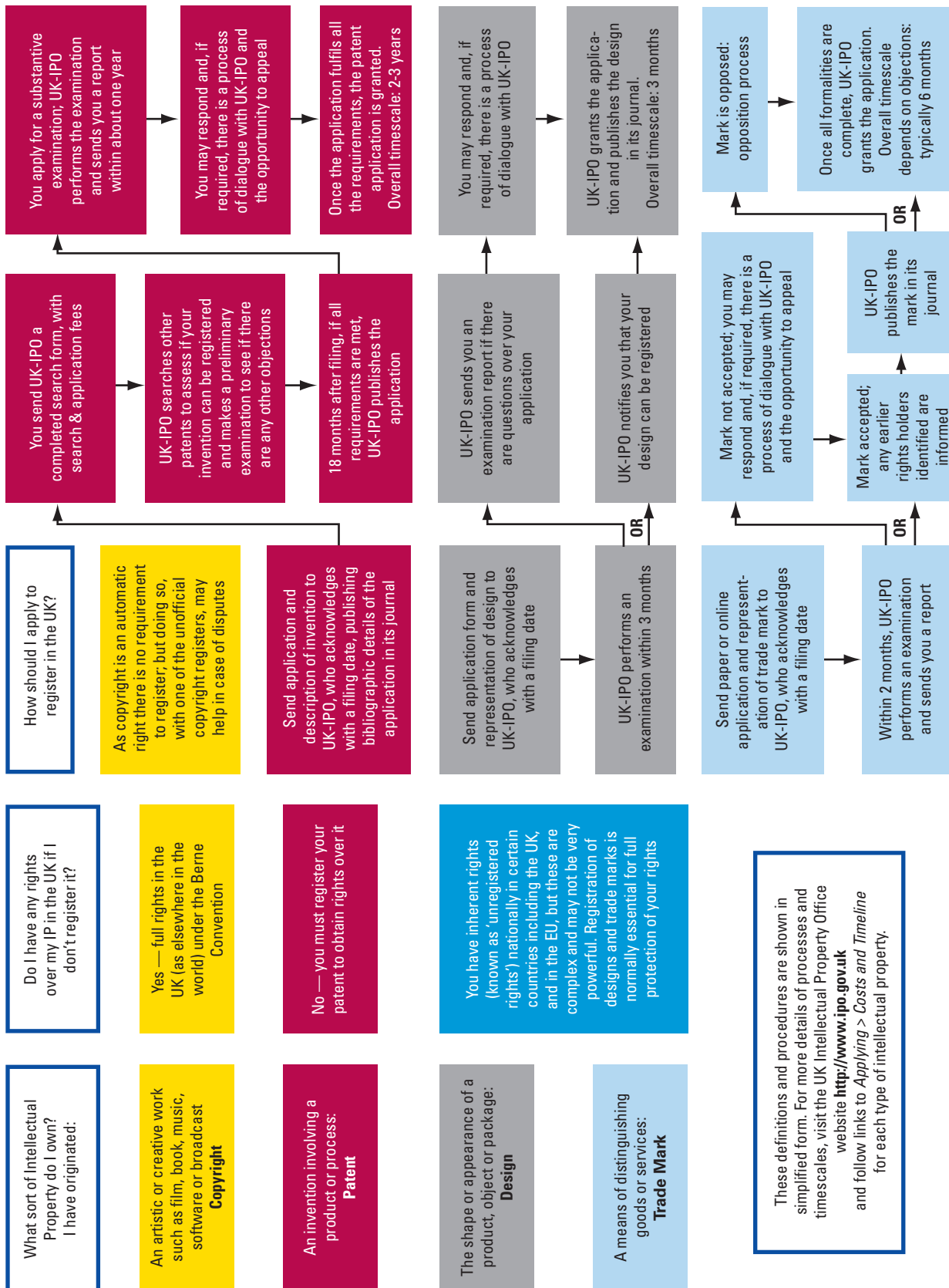
Please take a few minutes to complete our survey by clicking here. Your opinions and suggestions will help us ensure that the IPR Primers are relevant to your needs.

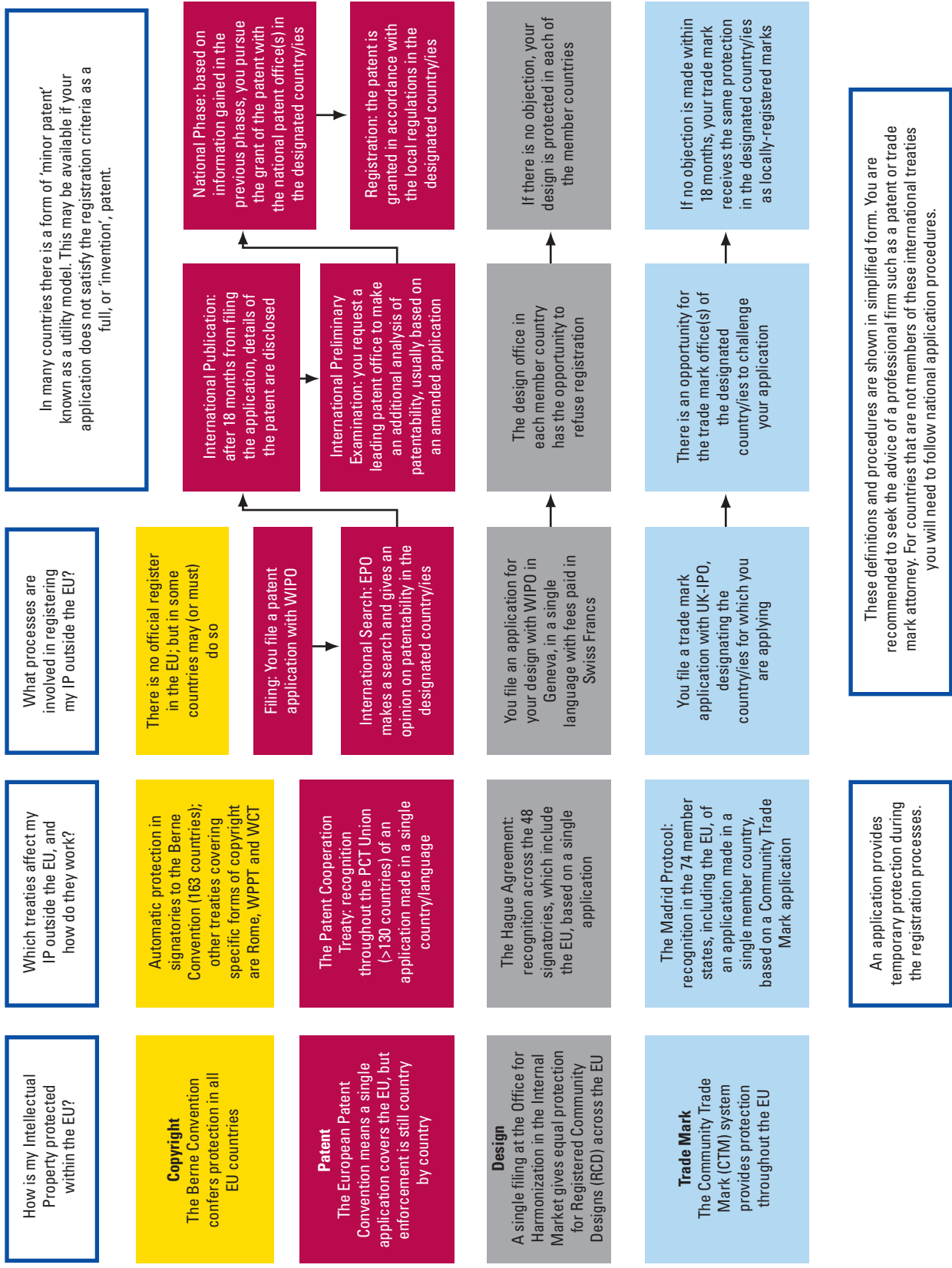
[Start survey](#)

Disclaimer

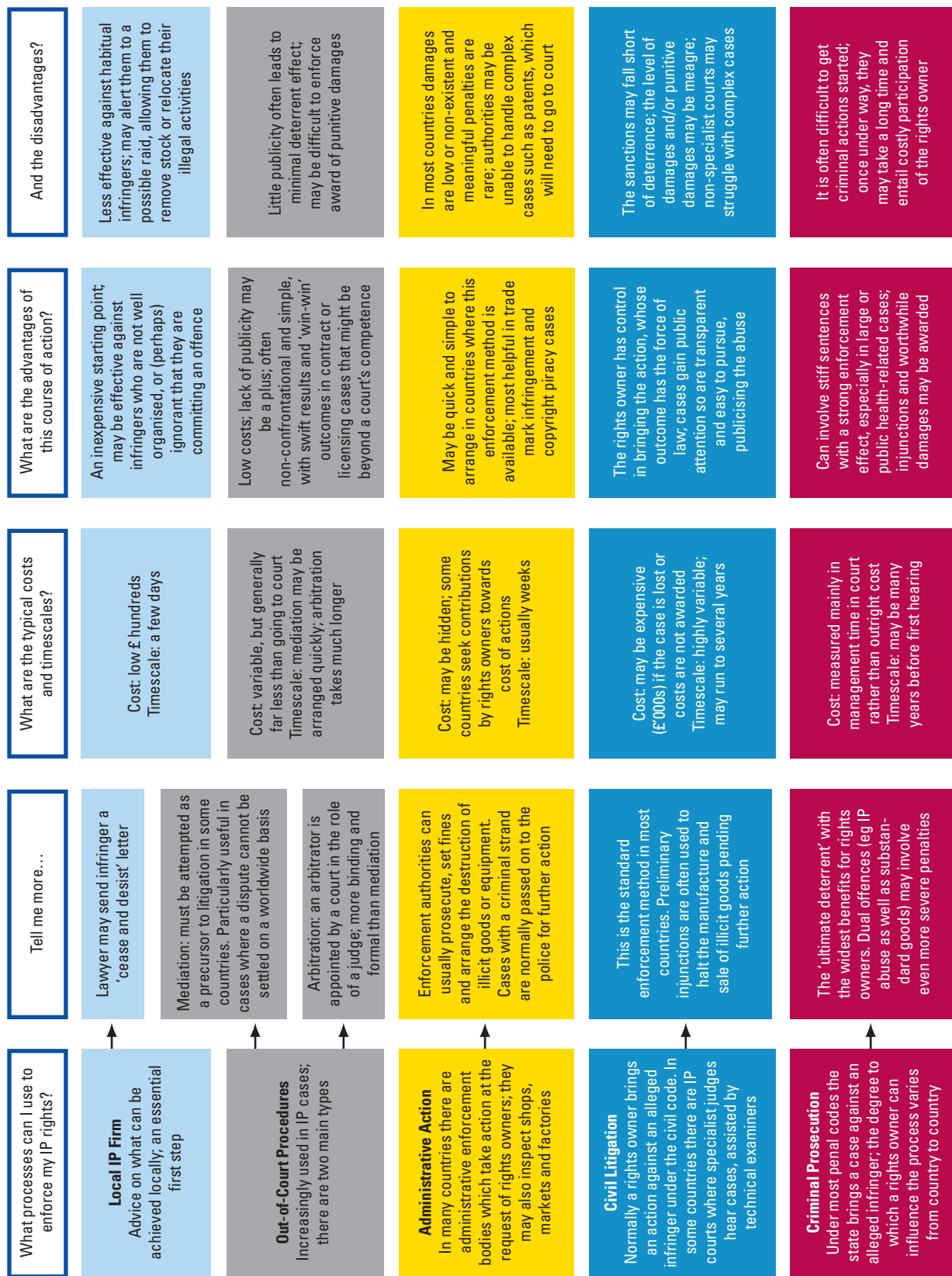
This guide contains only a summary of IPR issues. It is not intended as a substitute for the advice of professionals such as lawyers and attorneys. You should always seek expert guidance before taking decisions that may affect your IP rights, in India or elsewhere.

[the small print](#)





APPENDIX C : RIGHTS ENFORCEMENT AIDE-MEMOIRE [RETURN] [INDEX]



APPENDIX D : INDIA/UK IP RIGHTS COMPARISON [RETURN] [INDEX]

Country/Form of IP Right	Maximum Initial Term from filing date; for copyright, from author's death (eg literary work)	Cost typical official fees, excluding legal representation	Time to Register typical period, from filing date	Extension Periods total = max extension term + initial term	Notes
UK					
Copyright	70 yrs/50 yrs	–	–	none	term depends on type of work
Patent	4 yrs	£200	2 - 3 yrs	16 x 1 yr (total 20 yrs)	renewal on an escalating scale
Design	5 yrs	£60	3 mths	4 x 5 yrs (total 25 yrs)	cost for first design
Trade Mark	10 yrs	£200	6 mths	10 yrs (unlimited)	
India					
Copyright	60 yrs	£5 – £8	–	none	recordal fee; depends on type of copyright
Patent	20 yrs	£50	4 - 5 yrs	none	fee for specification of <30 pages
Design	10 yrs	£13	9 mths	1 x 5 yrs (total 15 yrs)	
Trade Mark	10 yrs	£30	2 - 3 yrs	10 yrs (unlimited)	

A: Société des Produits Nestlé, S.A. ('Nestlé') v. Gopal Bakers& Confectioners (Distributor) ('Gopal'), November 2007 (trade mark infringement – interim injunction against continuing abuse; arrangements for investigation by the court) [return] [index]

At a preliminary hearing in the High Court at New Delhi, it was alleged that Gopal had infringed Nestlé's trade marks including 'Milky Bar' (by use of the words 'Milky Ball') and the Nestlé 'Splash of Milk' device.

The court found that Nestlé had made a prima facie case. The judge stated that if an interim order were not made to prevent Gopal from manufacturing, selling or advertising their products pending the subsequent hearing there would be 'irretrievable prejudice' to Nestlé. He was also concerned that young children would buy the products, assuming them to be genuine.

In ruling that the defendants should cease their activities involving trade marks deceptively similar to those of the plaintiff, the court appointed a local commissioner, as requested by Nestlé, to visit Gopal's premises and make an inventory of the goods bearing the offending trade marks, release the products to Nestlé (on a 'superdari' basis – ie, they would remain the property of the court). The judge ordered the defendants to reveal to the commissioner where the packaging was being made, and that the police should assist the commissioner, whose fee was to be INR15,000 (approximately £185) plus expenses.

Comment: This case shows that injunction orders can be obtained swiftly in the Indian courts to halt the infringement pending further hearings. The process was aided by a person specially appointed to carry out further investigations. The matter was settled in four months – see below.

B: Société des Produits Nestlé, S.A. ('Nestlé') v. Gopal Bakers& Confectioners (Distributor) ('Gopal'), March 2008 (trade mark infringement – out-of-court settlement) [return] [index]

Following on from Case Study A above,

- the parties to the dispute had reached a 'settlement/compromise';
- Nestlé filed a suit for a permanent injunction against the infringements of its trade marks, as described above;
- Nestlé also filed a suit for 'infringement of copyright, dilution and unfair competition as well as passing off'.

It was announced in court that:

'the defendants have acknowledged the plaintiffs to be the proprietors of the aforesaid trade marks and the 'SPLASH OF MILK' device. The defendants have also acknowledged the plaintiffs to be the owners of the copyright in 'MILKYBAR' and 'POP CHOC' packaging, including their get-up, layout, colour combination and arrangement of features. The defendants have undertaken not to manufacture, sell, offer for sale, advertise, or directly or indirectly deal in any food products, including confectionery under the impugned trade marks, 'MILKYBALL, 'POPCHOC' or using the 'HEART AND MOUTH' device or any other trade mark which may be identical or deceptively similar to the aforesaid trade mark(s) of the plaintiffs.'

In addition, Gopal undertook not to pass off their goods as those of Nestlé. They agreed to pay token damages of INR55,000 (approximately £680) to Nestlé and deliver the goods and packaging seized previously by the court commissioner.

Finally, the judge recorded that he was satisfied the arrangements reached by the parties were lawful; the plaintiffs had dropped other proceedings and both parties would bear their own costs.

Comment: It may be worthwhile to pursue an infringer on more than one count. Although this case was an obvious trade mark infringement, Nestlé also cited copyright, unfair competition and passing off, giving them a stronger case and alternative grounds if the main complaint failed. Copyright concerned the packaging, whose source was revealed by court order (see Case Study A). While the amount of damages was small and Nestlé had to bear its costs in bringing the case, the outcome was – apparently – satisfactory for Nestlé: a source of counterfeits expunged, actual goods and packaging seized, damage to the genuine product's reputation reduced and potential health & safety dangers for the general public curtailed.

APPENDIX F : REFERENCES [INDEX]

1 INDIAN IPR REFERENCES [INDEX]

Organisations [return]

Central Board of Excise and Customs [return] [index]
<http://www.cbec.gov.in/>

Competition Commission of India [index]
<http://www.nipo.org.in/iplaws7.htm>

Confederation of Indian Industry (CII) [return] [index]
<http://www.ciionline.org/>

Controller General of Patents, Designs and Trade Marks [return] [index]
<http://www.patentoffice.nic.in/>

Copyright Office [return] [index]
<http://copyright.gov.in/>

Indian IPR Foundation (NIPO) [index]
<http://www.nipo.org.in/>

Laws and Procedures

Domain Name Registration [index]
<http://www.inregistry.in/>

Draft Manual of Patent Practice and Procedure [return] [index]
http://ipindia.nic.in/ipr/patent/DraftPatent_Manual_2008.pdf

Guidelines for Design Registration [return] [index]
http://www.patentoffice.nic.in/ipr/design/designs_filing.pdf

IP Environment in India [index]
<http://www.iprights.com/cms/templates/articles.aspx?articleid=324&tzoneid=2>

Texts of India's IPR Laws [return] [index]

Patents and Trade Marks:
<http://www.nipo.org.in/iplaws.htm>

Industrial Designs, Geographical Indications, Copyright and Unfair Competition:
<http://www.nipo.org.in/iplawsmn2.htm>

Biological Diversity, Plant Variety Protection, and Semiconductors & Integrated Circuits Layouts Protection:
<http://www.nipo.org.in/iplawsmn3.htm>

2 GENERAL AND INTERNATIONAL REFERENCES

Collection of Laws for Electronic Access (CLEA) [index]

This useful site, operated by the World Intellectual Property Organization (WIPO) is *'a unique electronic database providing easy access to intellectual property legislation from a wide range of countries and regions as well as to treaties on intellectual property. It is an invaluable information resource made available by WIPO free of charge to all interested parties, including researchers, legal professionals, policy-makers, students and administrators.'*
<http://www.wipo.int/clea/en/index.jsp>

Copyright

Berne Convention [return] [index]

UK Copyright Service's article '*International copyright law – The Berne Convention*':

http://www.copyrightservice.co.uk/copyright/p08_berne_convention

Copyright in the UK [return] [index]

UK-IPO:

<http://www.ipo.gov.uk/copy.htm>

Copyright Licensing Agency (CLA) [index]

Based in the UK, CLA licenses the copying of published extracts. Its website provides practical information on many aspects of copyright:

<http://www.cla.co.uk/>

Designs

Designs in the UK [return] [index]

UK-IPO:

<http://www.ipo.gov.uk/design.htm>

Unregistered Community Designs [return] [index]

Patent and trade mark attorney Hindle Lowther's explanation:

<http://www.hindlelowther.com/design11.htm>

International IPR Organisations, Systems and Treaties

Community Trade Marks (CTM) [return] [index]

CTM resource site of the Office for the Harmonization of the Internal Market (OHIM):

<http://oami.europa.eu/en/mark/default.htm>

Overview by ipr.co.uk:

http://www.ipr.co.uk/IP_conventions/community_trade_marks.html

UK-IPO:

<http://www.ipo.gov.uk/abroad/abroad-tmeurope.htm>

European Patent Convention (EPC) [return] [index]

European Patent Office site for EPC:

<http://www.epo.org/patents/law/legal-texts/epc.html>

Text of the Convention:

<http://www.european-patent-office.org/legal/epc/e/contents.html>

Hague Agreement [return] [index]

WIPO datasheet Hague System for the '*International Registration of Industrial Designs*' with link to list of parties to the agreement:

<http://www.wipo.int/hague/en/>

UK-IPO site on linking of Hague Agreement and Registered Community Design:

<http://www.ipo.gov.uk/policy/policy-issues/policy-issues-designs/policy-issues-designs-protection.htm>

and European Commission press release on the same subject:

<http://europa.eu/rapid/pressReleasesAction.do?reference=IP/05/1691&format=HTML&taged=0&language=EN&guiLanguage=en>

International Anti-Counterfeiting Coalition (IACC) [index]

<http://www.iacc.org/contact.php>

International Intellectual Property Institute (IIPI) [index]

<http://iipi.org/>

Madrid Protocol [return] [index]

WIPO's introduction '*Madrid System for the International Registration of Marks*':

<http://www.wipo.int/madrid/en/>

UK-IPO:

<http://www.ipo.gov.uk/abroad/abroad-tmworld.htm>

List of Madrid Protocol registrations on Institute of Trade Mark Attorneys site:

<http://www.itma.org.uk/trade-marks/6b-protocol.htm>

Outlaw-Com's guide to '*Registering a Trade Mark through the Madrid Protocol (international application)*':

<http://www.out-law.com/page-376>

Paris Convention [return] [index]

WIPO's '*Summary of the Paris Convention for the Protection of Industrial Property*':

http://www.wipo.int/treaties/en/ip/paris/summary_paris.html

Patent Cooperation Treaty (PCT) [return] [index]

WIPO's PCT Resources site:

<http://www.wipo.int/pct/en/>

UK-IPO:

<http://www.ipo.gov.uk/abroad/abroad-patentworld/abroad-pct.htm>

Mewburn Ellis LLP's succinct explanation and list of members:

http://www.mewburn.com/downloads/PCT_Members_States_as_at_01Jun07_-_June_2007.pdf

Registered Community Design (RCD) [return] [index] See also Hague Agreement

UK-IPO:

<http://www.ipo.gov.uk/design/d-applying/d-should/d-should-abroad/d-should-abroad-eu.htm>

Rights Extensions [return] [index]

These are listed on the UK-IPO website, with descriptions of the rules and conditions for the extension of protection for the various UK and EU IP rights:

<http://www.ipo.gov.uk/abroad/abroad-extend.htm>

TRIPS [return] [index]

Trade-Related Aspects of Intellectual Property Rights:

http://www.wto.org/english/tratop_e/trips_e/trips_e.htm

UK-IPO:

<http://www.ipo.gov.uk/policy/policy-issues/policy-issues-trips.htm>

World Intellectual Property Organization (WIPO) [return] [index]

Website gateway to a copious source of IPR information:

<http://www.wipo.int/portal/index.html.en>

World Trade Organization (WTO) [return] [index]

WTO's home page:

<http://www.wto.org/>

List of WTO members: [return]

http://www.wto.org/english/thewto_e/whatis_e/tif_e/org6_e.htm

Miscellaneous

Books [index]

The Handbook of European Intellectual Property Management

'Developing, Managing and Protecting Your Company's Intellectual Property' by Adam Jolly

ISBN 9780749449889 published July 2007

<http://www.kogan-page.co.uk/bookdetails.aspx?ISBN=9780749449889>

Knockoff: the Deadly Trade in Counterfeit Goods

'The True Story of the World's Fastest Growing Crime Wave' by Tim Phillips

ISBN: 9780749443795 published December 2005

<http://www.koganpage.com/bookdetails.aspx?ISBN=0749443790>

Enforcement of Intellectual Property Rights in the UK [index]

Kirkland & Ellis International LLP on the system in England and Wales:

http://www.buildingipvalue.com/n_eu/279_283.htm

Intellectual Property Explained ('My IP'), UK-IPO 2007 [index]

A guide covering IPR for UK companies, together with advice on protection and the steps that would-be rights owners should take:

<http://www.ipo.gov.uk/myip.pdf>

Renewal of IP Rights [return] [index]

UK-IPO:

<http://www.ipo.gov.uk/manage/manage-renew.htm>

Reports [index]

HM Treasury, 2006: *'Gowers Review of Intellectual Property'*

http://www.hm-treasury.gov.uk/media/6/E/pbr06_gowers_report_755.pdf

OECD, 2007: *'The Economic Impact of Counterfeiting and Piracy (Executive Summary)'*

<http://www.oecd.org/dataoecd/11/38/38704571.pdf>

UK-IPO website [return] [index]

Guidance on all aspects of IPR in the UK, Europe and worldwide:

<http://www.ipo.gov.uk/home.htm>

Patents [index]

Chartered Institute of Patent Attorneys (CIPA) [index]

The CIPA site offers a wide range of advice on patents, international news and articles, together with a search facility for UK-based and international patent attorneys, searchable by region:

<http://www.cipa.org.uk/pages/home>

Patents in the UK [return] [index]

UK-IPO :

<http://www.ipo.gov.uk/patent.htm>

Software Patents [return] [index]

The European Patent Office does not *'grant patents for computer programs or computer-implemented business methods that make no technical contribution. Programs for computers as such are excluded from patentability [unless they have] the potential to cause a 'further technical effect' which must go beyond the inherent technical interactions between hardware and software.'*

See EPO regulations on this subject:

<http://www.epo.org/focus/issues/computer-implemented-inventions.html>

and Ius Mentis's article *'Software Patents under the European Patent Convention'*:

<http://www.iusmentis.com/patents/software/epc/>

UK Patent Rules [index]

UK-IPO's 'unofficial consolidation' of the Patent Rules 1995:

<http://www.ipo.gov.uk/patentrules1995.pdf>

Trade Marks [index]

Changes in UK Trade Mark Registration Procedures [return] [index]

Reddy & Grose's description of how existing owners of trade marks are to be consulted when UK-IPO receives applications for similar marks:

<http://www.reddie.co.uk/content/view/119/49/>

Domain Names [return] [index]

The following links provide guidance on:

- domain names in the context of IP law:
http://www.waterfrontpartnership.com/ip/d_domain_names.htm
- choosing and registering a domain name:
<http://www.nominet.org.uk/registrants/register/choose/>
- legal rights relating to domain names:
<http://www.nominet.org.uk/disputes/drs/rights/>
- domain name disputes:
<http://www.out-law.com/page-5700>

Geographical Indications [return] [index]

UK-IPO's notes on GI and links to further information:

<http://www.ipo.gov.uk/patent/p-applying/p-should/p-should-otherprotect/p-should-otherprotect-geographic.htm>

Institute of Trade Mark Attorneys (ITMA) [index]

This site provides a compendium of information on trade marks, including definitions, costs, tips on registration, FAQs and listings of ITMA members, sorted by UK region:

<http://www.itma.org.uk/intro/index.htm>

Nice Classification System [return] [index]

'The countries party to the Nice Agreement constitute a Special Union within the framework of the Paris Union for the Protection of Industrial Property. They have adopted and apply the Nice Classification for the purposes of the registration of marks.'

Class definitions:

<http://www.wipo.int/classifications/fulltext/nice8/enmain.htm>

Plant Varieties [return] [index]

DEFRA's 'Guide to the Plant Varieties Act 1997':

<http://www.defra.gov.uk/planth/pvs/guides/pvsact-20050317.pdf>

Semiconductor Topographies [return] [index]

The Design Right (Semiconductor Topographies) Regulations 1989:

http://www.opsi.gov.uk/SI/si1989/Uksi_19891100_en_1.htm

Trade Marks in the UK [return] [index]

UK-IPO:

<http://www.ipo.gov.uk/tm.htm>

Where to get help in India

American Chamber of Commerce in India (AMCHAM-India) [return] [index]

<http://www.amchamindia.com/>

[website being updated; check in due course]

British High Commission [return] [index]

British High Commission, New Delhi

<http://www.britishhighcommission.gov.uk/servlet/Front?pagename=OpenMarket/Xcelerate/ShowPage&tc=Page&cid=1017170902251>

British Deputy High Commission, Kolkata

<http://www.britishhighcommission.gov.uk/servlet/Front?pagename=OpenMarket/Xcelerate/ShowPage&tc=Page&cid=1037199287035>

British Deputy High Commission, Mumbai

<http://www.britishhighcommission.gov.uk/servlet/Front?pagename=OpenMarket/Xcelerate/ShowPage&tc=Page&cid=1037199293480>

British Deputy High Commission, Chennai

<http://www.britishhighcommission.gov.uk/servlet/Front?pagename=OpenMarket/Xcelerate/ShowPage&c=Page&cid=1037199294136>

[Indo British Partnership Network \(IBPN\) \[return\] \[index\]](#)

<http://www.ibpn.co.uk/>

[UK India Business Council \[return\] \[index\]](#)

<http://www.ukibc.com/>

[UKTI India Website \[return\] \[index\]](#)

https://www.uktradeinvest.gov.uk/ukti/appmanager/ukti/countries?_nfls=false&_nfpb=true&_pageLabel=CountryType1&navigationPagelD=/india

[Local Law Firms \[return\] \[index\]](#)

<http://www.chambersandpartners.com/Asia/search.aspx>

UK Trade & Investment is the Government organisation that helps UK-based companies succeed in an increasingly global economy. Its range of expert services are tailored to the needs of individual businesses to maximise their international success. We provide companies with knowledge, advice and practical support.

UK Trade & Investment also helps overseas companies bring high quality investment to the UK's vibrant economy – acknowledged as Europe's best place from which to succeed in global business. We provide support and advice to investors at all stages of their business decision making.

UK Trade & Investment offers expertise and contacts through a network of international specialists throughout the UK, and in British Embassies and other diplomatic offices around the world.

For further information please visit www.uktradeinvest.gov.uk or telephone +44 (0)20 7215 8000.

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