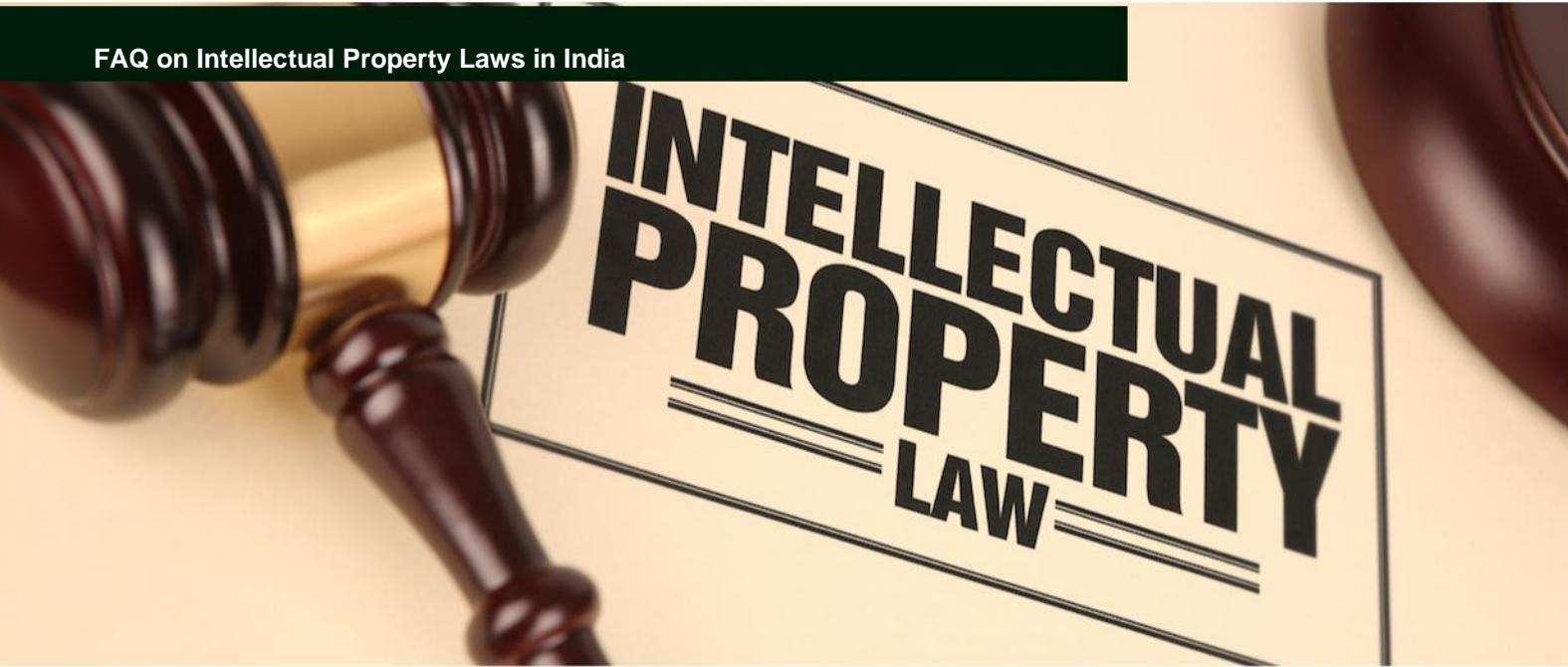


## FAQ on Intellectual Property Laws in India



This primer discusses Indian laws related to recognition, registration, and enforcement of rights in intellectual property in India. In this primer, we have provided an overview of Indian laws related to copyright, patents and trademarks.

### 1. What is copyright?

In India, copyright is governed by the Copyright Act, 1957 (**Copyright Act**). Copyright is an exclusive right acquired by the owner or author for his original work. The term work includes literature work inclusive of computer programming, tables, compilations, databases, dramatics, musical or artistic work comprising of a painting, drawing, sculpting & engraving, a cinematographic film, sound recording and work of joint ownership.

The author of copyrighted work may reproduce, re-work or distribute copies of his work publicly. Copyright on a work confers a right on its owner or author to prevent the use of such work by any other person without his consent. The author of copyrighted work may also authorise another person to use his entire work or a substantial part of his work. For example, in case of a music video, copyright may subsist in the lyrics of the song or music composition or the entire video. The authorisation may be given for substantial part of the work (translation of audio) or reproduction of the entire work (reproduction on CDs).

### 2. Who is the owner of a copyright?

An author of a copyright is the creator of the work and is usually the first owner. However, in certain instances, the author of the work is not the first owner of the copyright in the absence of an agreement to the contrary. Some of these instances are provided below:

- (a) The employer of the author is the first owner of the work created by such author during his employment under a contract of service or apprenticeship.
- (b) In the case of a photograph taken, or a painting or portrait drawn, or an engraving or a cinematograph film made, for valuable consideration at the instance of any person, then such person will be the first owner of the copyright.

- (c) In case of Government work, the Government will be the first owner and in case of work made or first published by or under the direction of any public undertaking, then such public undertaking shall be the first owner of the copyright.
- (d) If the author has made the work or first published it under the direction or control of an international organization, then such international organization will be the first owner.

### 3. Is it necessary to register a work to claim copyright?

An author is not required to register his work to claim copyright. Copyright comes into existence as soon as the original work is created, and no additional formality is required to be completed for acquiring copyright. However, to avoid multiple claims, it is advisable to register a work for copyright. A registration of copyright serves as a prima facie evidence of ownership of the copyright work in a court of law.

### 4. Is use of a copyrighted work without permission of the owner of the copyright permitted?

- 4.1. A person seeking to use copyrighted work is required to obtain the consent of the owner of such copyrighted material except in case such use qualifies as fair dealing or fair use under the Copyright Act. Use of copyrighted works by a person for research, criticism or review are some instances which constitute fair dealing or fair use and therefore do not require the prior authorisation of the owner of the copyrighted work. To elaborate, students of an educational institution performing a musical work in course of the activities of such institution or storing any work in any electronic form for private or personal use will not be an infringement under the Copyright Act. Some other instances under the Copyright Act includes use of work in library, schools or in lectures, reporting of current events, activities in connection with judicial proceedings, reading or recitation of reasonable extracts from a published literary or dramatic work, etc.
- 4.2. The purpose and the manner of unauthorised use are the determining factors of fairness of the use. The objective of permitting a fair use is to strike a balance between the interests of the copyright owner and the interests of the society at large.

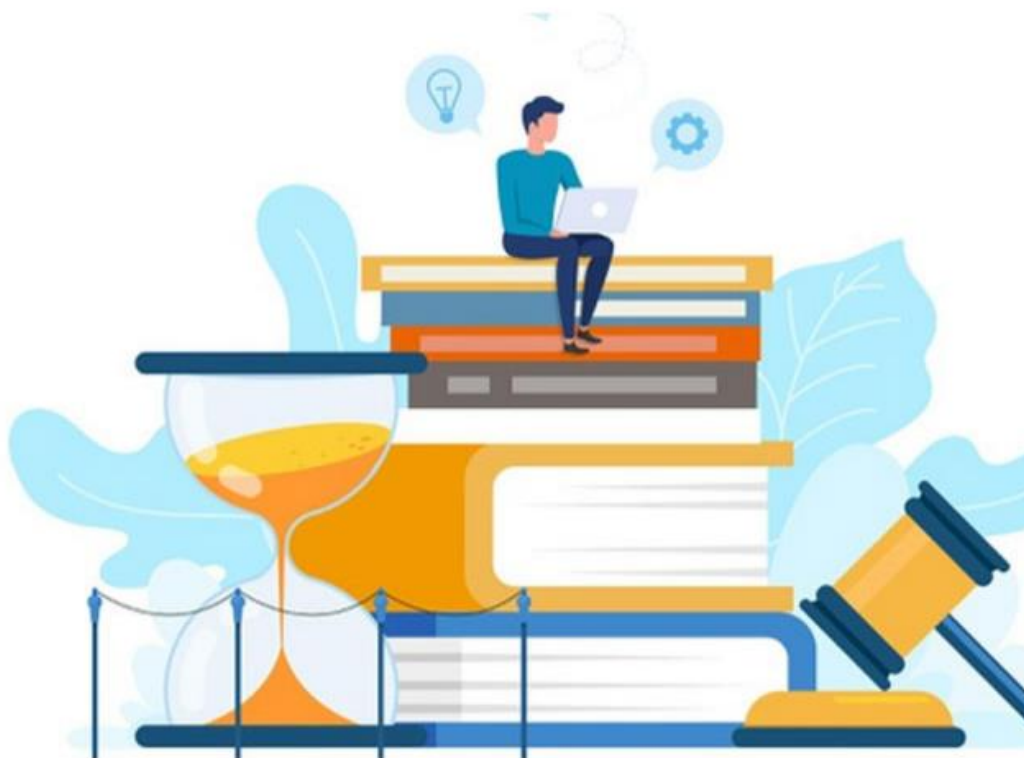
### 5. Whether an unpublished work can be registered?

The Copyright Act permits registration of both published and unpublished works (that is works which are not available to the public).

### 6. What is the procedure for registration of work under the Copyright Act?

- (a) Application: An applicant can make an application by filing Form XIV along with the applicable fees for registration of a copyright. Every such application should be in respect of one work only.
- (b) Notice: The applicant 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.
- (c) Objection: Any person can raise objection to the applicant's claim within 30 days. If any objection is received, then the Registrar may conduct further enquiry.
- (d) Entry: The Registrar of Copyrights shall make necessary entry in the Register of Copyrights if no objection is received.





**7. Is copyright assignable?**

- 7.1 The owner of the copyright in an existing work or the prospective owner of the copyright in a future work may assign the whole or any part of the copyright to any person. Such assignment can be wholly or partially or with subject to limitations and is not required to be mandatorily registered under the Copyright Act. Further, any assignment of copyright in any future work shall take effect only after the work comes into existence. However, it should be noted that mere grant of right to publish and sell does not amount to assignment of copyright.
- 7.2 Assignment of copyright is only valid if it is in writing and signed by the assignor or his agent. Further, the assignment document should also specify the royalty payable, if any to the assignor or his legal heirs. If the period of assignment is not mentioned in writing, it will be deemed to be taken for 5 (five) years.

**8. What is the validity of a copyright?**

Type of material	Validity
Literary, Dramatic, Musical and Artistic work	60 years from the beginning of the calendar year which follows the year in which the author dies
In anonymous and pseudonymous works	60 years from the beginning of the calendar year which follows the year in which the work is published
Posthumous work in the case of a literary, dramatic or musical work or an engraving, in which copyright subsists at the date of the death of the author	
Cinematography Films	

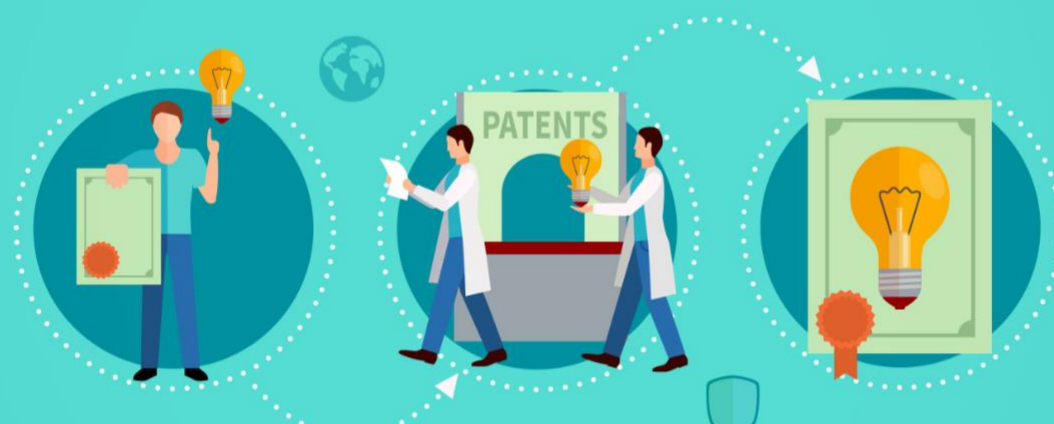
Sound Recordings	
Government Work	
Works of Public Understanding	
Works of International Organisation	

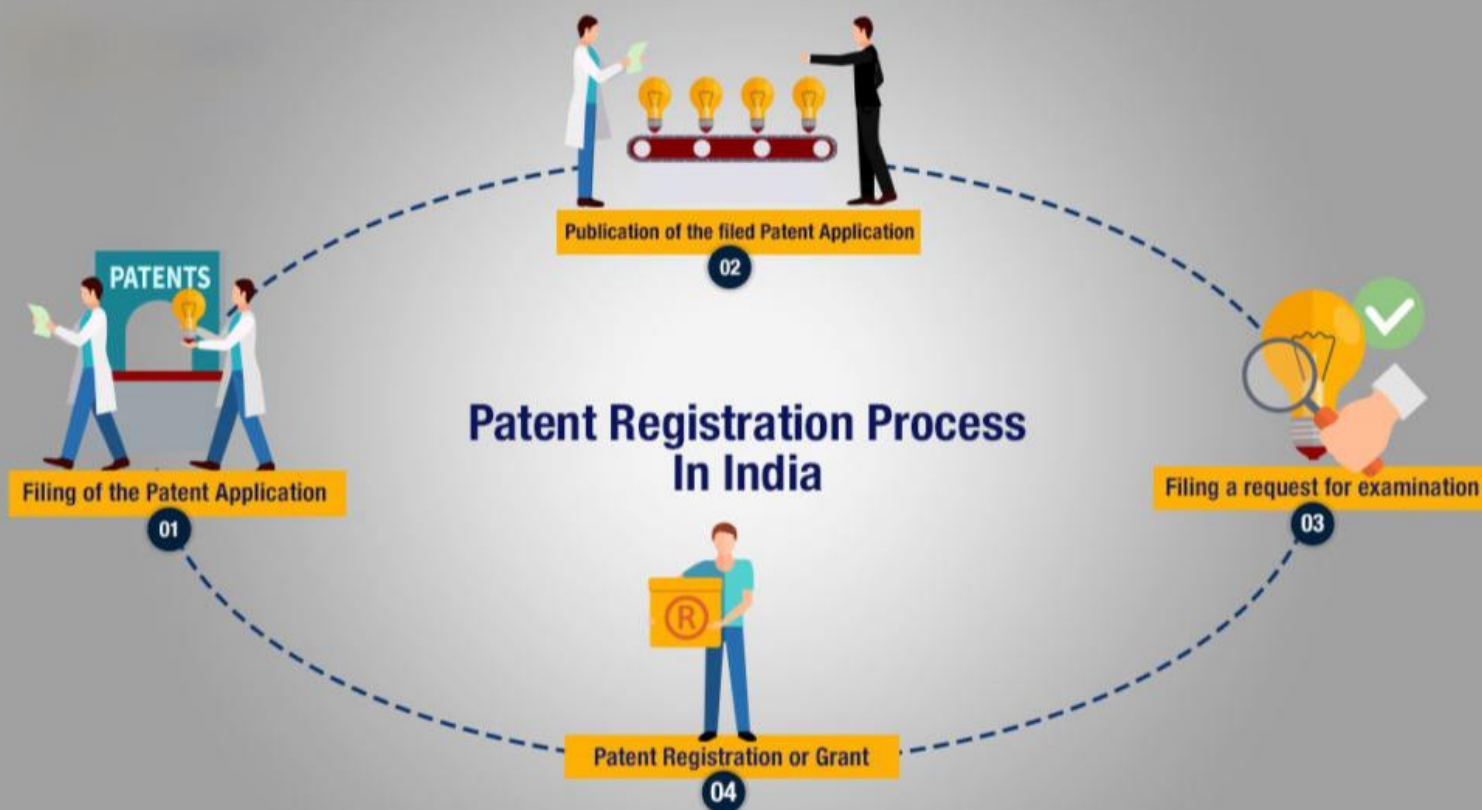
**9. What is a patent? What can be patented and what is the criteria?**

- 9.1 Patent is a monopoly right conferred on an inventor for a limited period of time to exploit his invention. A grant of patent excludes others from making, using, selling, importing the patented product or use the process for producing that product without the consent of the patent holder.
- 9.2 In India, patents are regulated by the Patent Act, 1970 (**Patent Act**). Patents are territorial rights and are only applicable in the country or region in which the patent is filed or granted. A patent granted under the Patent Act is effective only within the territory of India.
- 9.3 A patent can be granted under the Patent Act on inventions relating either to a product or process which meet the criterial provided below:
  - (a) Novelty: The invention should be new i.e. the invention should not be found in any product or process which has at any time been made available to the public anywhere in the world in any manner.
  - (b) Inventive step: The invention should involve technical advances as compared to the existing knowledge or having economic significance or both and that makes the invention not obvious to a skilled person.
  - (c) Industrial application: Invention should be capable of being made or used in an industry.
- 9.4 The Patent Act provides a list of inventions which are not patentable. The list includes inventions which are frivolous or relate to well established natural laws (such as law of gravity), mere arrangement or re-arrangement or duplication of known devices, method of agriculture or horticulture, relate to atomic energy, relate to any process for the medicinal, surgical, curative, prophylactic diagnostic or therapeutic or other treatment of human being, relate to a presentation of information, relate to topography of integrated circuits etc.

**10. What is the term of a patent in the Indian system?**

Under the Indian system, the term of a patent is 20 years from the date of filing an application. In case of applications filed under the Patent Cooperation Treaty, 1970 (**Patent Cooperation Treaty**), the term is 20 years from the international filing date.





#### 11. Can patent owner assign a patent under Patent Act?

A patent holder can assign his rights in a patent to another person. Under the Patent Act, an assignee is required to register any assignment of rights in a patent.

#### 12. What is the process of registration of a patent in India?

Following are the steps involved in registration of a patent in India:

- (a) **Application:** An applicant can file an application for grant of patent by filing Form 1 with the Indian Patent Office, with provisional or complete specification in Form 2, along with applicable fees. The applicant is required to file the complete specification within 12 months from the date of filing of the application with provisional specification. Application for filing of patents can be made through a comprehensive online filing system available through the Intellectual Property India website.
- (b) **Publication:** Every application for patent is published after the expiry of 18 months from the date of application or date of priority, whichever is earlier. The applicant can make a request for early publication in Form 9 along with the applicable fees.
- (c) **Pre-Grant Opposition:** Any person can file a pre-grant opposition in Form 7A within 6 months of publication.
- (d) **Examination of Application:** The applicant is required to file an application for examination in Form 18 within 48 months from the date of application or date of priority, whichever is earlier.
- (e) **Post Grant Opposition:** Any person can file an opposition after the grant of a patent under the Patent Act. Such post grant opposition should be filed in Form 7 within 1 year from the date of publication of such grant.

**13. What is the process for registering a patent in a foreign jurisdiction?**

13.1. An applicant may file an international application for patent for an invention after filing a patent application in India for the same invention (**Basic Application**). Post the Basic Application, the applicant may apply for patent of the invention either under the Paris Convention for Protection of Industrial Property (**Paris Convention**) or Patent Cooperation Treaty in the respective contracting states.

**13.2. Paris Convention:**

Under this route, the Applicant can file the application for patent in the contracting states within 12 months of the Basic Application. This route is preferred if patent is proposed to be applied in less than 5 countries.

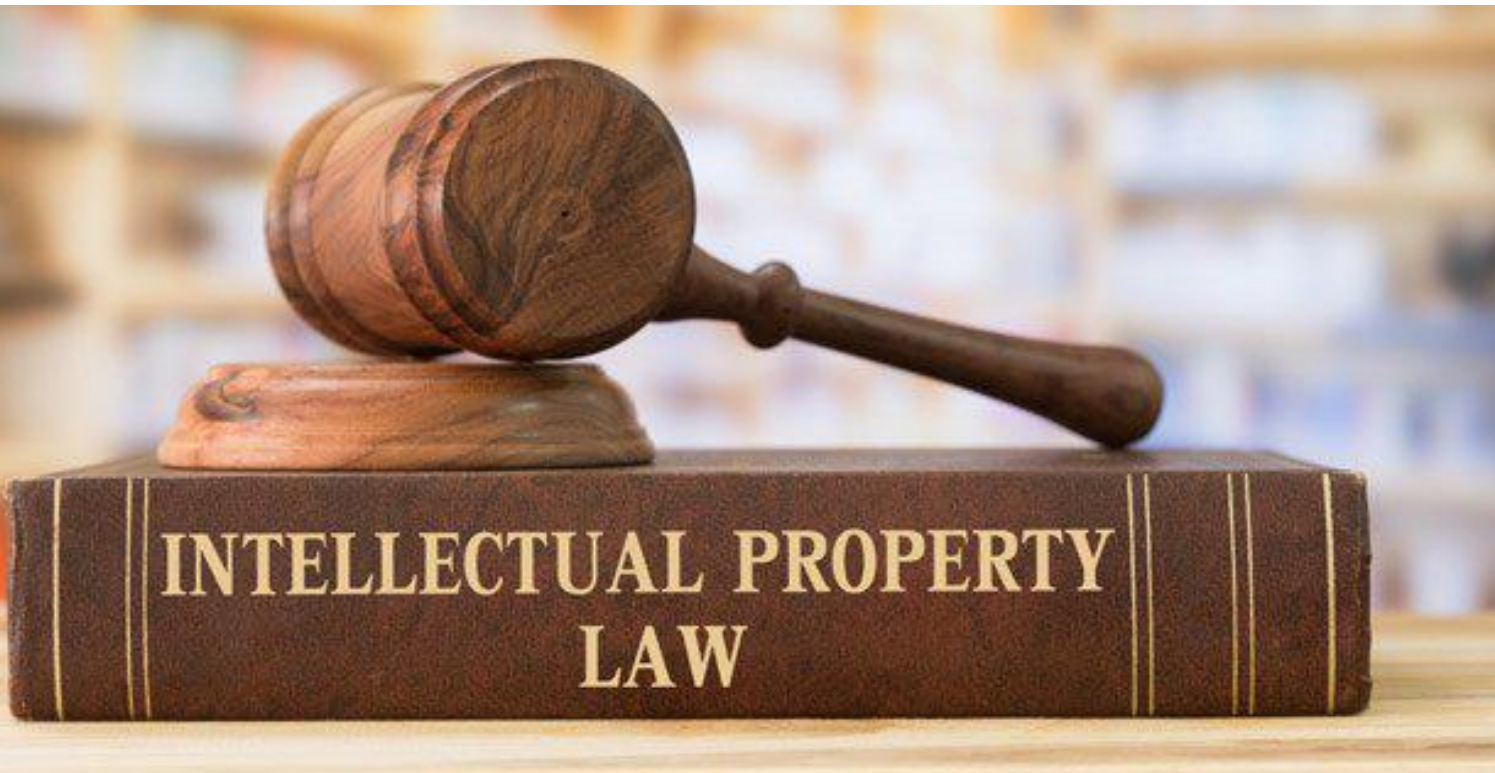
**13.3. Patent Cooperation Treaty:**

Under this route, the applicant will have to file an application under Patent Cooperation Treaty with complete specification within 12 months of the Basic Application with World Intellectual Property Organisation. The Patent Cooperation Treaty application can be filed at the Indian Patent Office. Once the Patent Cooperation Treaty application has been filed, the applicant can file applications for patent of the invention in the concerned foreign jurisdiction before the expiry of 30 to 31 months (as prescribed by most contracting states of Patent Cooperation Treaty including India) from the earlier of the date of the Basic Application or priority date. This route is preferred if patent is proposed to be applied in 5 or more countries. Further, this route provides an additional timeline for applying patents.

**14. What constitutes a trademark under India law?**

In India, the Trade Marks Act, 1999 (**Trade Marks Act**) regulates recognition and registration of marks as trademarks. There are three essentials for registration of a mark as a trademark:

- (a) the mark should include a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof;
- (b) the mark should be capable of being represented graphically i.e. in the paper form; and
- (c) the mark should be capable of distinguishing the goods or services of one person from others.





**15. Is it mandatory to register a trade mark?**

Registration of trade marks is not mandatory under the Trade Marks Act. A registration under the Trade Marks Act does not confer any new right to the mark claimed or any greater right than what already existed at equity without registration. However, a registered proprietor can sue for infringement of registered trade mark irrespective of the fact whether it is used or not used. Registration confers an exclusive right over the use of the mark on the proprietor.

**16. What is the process of registration of trade mark?**

- (a) Application: Any person claiming to be the proprietor of a trade mark, who is desirous of registering it, can apply in writing to the Registrar of Trade Marks (**Registrar**) in Form TM-A for the registration of his trade mark. The applicant should pay the applicable fees and should mention the class under which the applicant wants the goods or services to be included.
- (b) Examination of trade mark: The Registrar shall cause the application to be examined. A search is conducted amongst the earlier trademarks, registered or applied for registration, to ascertain whether mark is unique or capable of being distinguished in respect of the same or similar goods or services.
- (c) Advertisement: The Registrar shall cause the application to be advertised upon acceptance, with or without conditions or limitations.
- (d) Opposition: Upon publication of the trade mark in the Trade Marks Journal opposition from general public is sought. Any person may file opposition in Form TM-O within 4 months of the advertisement of an application for registration along with the applicable fees.
- (e) Registration and issuance of certificate: If no objection to application is raised, the trade mark is registered and certificate is issued to the applicant.

**17. What is the validity period of a trade mark?**

After registration, a trade mark is valid for 10 years and can be renewed from time to time.

**18. Can rights in a trade mark be assigned?**

An owner of a registered trade mark can assign his rights on the mark subject to the provisions of the Trade Marks Act. The assignee is required to file Form TM-P with the Registrar under the Trade Mark Act to register the assignment. An assignee is the successor to all the rights of an assignor consequent to a valid assignment of the trade mark and the goodwill associated.



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