

## **“PROTECTION OF INTELLECTUAL PROPERTY RIGHTS UNDER THE INDIAN & INTERNATIONAL LAWS”**

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### **INTRODUCTION**

Intellectual Property (IP) has been traditionally categorized into Industrial property and Copyright. The term Industrial Property includes patents, trademarks, industrial designs, and geographic indications of source. Copyright protection is granted to protect literary, artistic and musical works. Rights related to copyright include those of performing artists in their performances, producers of phonograms in their recordings, and those of broadcasters in their radio and television programs<sup>2</sup>. Intellectual property rights are generally said to be a bundle of exclusive rights granted to the lawful owner.

The term intellectual property denotes the specific legal rights, and not the intellectual work itself. It is important to be aware of what these IP rights are, how they can be protected and, in due course, how to benefit from them.

### **Why Registration of Intellectual Property is important?**

Developments of new products and processes, brand names, content, etc. are resource intensive and usually require huge investments. It is therefore, the expectation of the individuals or entities creating them that they have exclusive rights over their creation to the exclusion of others. Intellectual Property system and laws essentially provides this exclusivity. For certain forms of IP like trademark and copyright, the right is born the day the work is created, registration though not mandatory provides certain benefits and advantages like prima facie proof of the ownership making it easier to enforce the IP right in court. Otherwise, the registered owner will have to prove that the IP belongs to him when the IP is used in an unauthorized manner. In case of trademark only a registered proprietor can claim and sue for infringement. For certain IP like patents and designs, the right is granted upon making application and complying with the rules prescribed for their registration. The IP so protected helps the registered owners to reap the

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<sup>2</sup> Definition of Intellectual property – <http://www.wipo.int/about-ip/en/>

returns of their investments by preventing others from using the creation without permission. IP rights in essence are said to be negative rights. IP rights and registrations help the owner to exclude third parties from using the creation in an unauthorized manner and having a free ride on the efforts of the original inventor. It provides an incentive to keep creating and benefit from them.

The various forms of IP, their protection and registration both in India and internationally are detailed below.

## 1. TRADEMARK

A trademark is the most valuable asset owned by a business. When a business is successful, others will imitate not only the ideas and market strategy, but very often they will also imitate the trademarks, product packaging, distinctive markings, etc. used by a successful company. Businesses with particularly successful products or services spend considerable amounts of time, effort and money creating, establishing and promoting their unique identities.

Owners who fail to pay sufficient attention towards the protection of their companies' trademarks face a number risks, including the inability to register or use their own marks on a future date, the dilution of the market's recognition of their products or services, and, in some cases end up spending huge resources in legal action to prevent unauthorized use or justify the use of their own property.

It is therefore pertinent that the trademarks be registered over all the goods and/or services over which the mark is used. The legislations which deal with the protection and registration of trademarks in India are *The Trademark Act, 1999 and The Trademark Rules 2002*. In India, trademark registration is valid for a period of ten years. The same may be renewed from time to time for additional periods of ten years each<sup>3</sup>.

For registration of a mark as a trademark in India, the mark has to fulfill certain criteria. These include the following requirements:

**- The mark should be non- generic** - A generic trademark is a trademark or brand name that has become the colloquial or generic description for (or synonymous with) a general class of product or service, rather than the specific meaning intended by trademark's holder. A trademark typically becomes "genericized" when the products or services with which it is associated have acquired substantial mind share.

<sup>3</sup> Section 25 (1) of the Trade Mark Act, 1999

- **The mark should be non- descriptive** - Descriptive trademarks are those which describe some aspect, characteristic or quality of the products on which they are used.
- **The mark is not identical or similar to existing marks**- A proposed mark should not be similar or identical to that for which the earlier trademark is registered in the name of a different proprietor<sup>4</sup>.
- **The mark should be non- deceptive** - A deceptive trademark is one that wrongly indicates that the goods over which it is used have certain qualities but they do not.

The term trademark or service mark includes any word, name, symbol, or device, or any combination thereof to identify and distinguish goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods.

## INTERNATIONAL PROTECTION FOR TRADEMARKS

Trademark registrations are geographical in that, application has to be filed in each and every country where one wants protection. Application also has to be made in the relevant class of goods/services over which the mark is used. If the mark falls under more than one class, applications have to be filed in each relevant class. There are three different ways to seek protection for trademarks internationally.

The first option is to file application individually in each and every country where the applicant wants protection for their trademark.

The second option is to file application for trademark protection through regional conventions which provide for registration in multiple countries by a single application process. Regional conventions are established through bilateral or multilateral treaties. Community Trade Mark (CTM) application, Benelux and African Intellectual Property Organization (OAPI) are examples of systems that facilitate '*Regional Applications*'. Community Trade Mark (CTM) provides a unique opportunity to **obtain a trade mark registration throughout the European Union by filing a single application at a much lower cost** than the cost of separate national filings (should separate applications be filed in all 27 countries).

A CTM registration will cover all countries which are member states of the European Union. At present these are Austria, Benelux (Belgium, Netherlands & Luxembourg), Bulgaria, Cyprus, the Czech Republic, Denmark, Estonia, Finland, France, Germany, Greece, Hungary, Ireland,

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<sup>4</sup> Section 11 (2) (b) of the Trade Mark Act, 1999

Italy, Latvia, Lithuania, Malta, Poland, Portugal, Romania, the Slovak Republic, Slovenia, Spain, Sweden and the United Kingdom.

These regional systems are not restricted to the member countries alone but are open to all.

### **International applications through Madrid system-**

Madrid System of International Registration of Trademarks is governed by the Madrid Agreement of 1891 and the Madrid Protocol. In that, applicants from non member countries can also seek regional protection. The Madrid System offers the possibility to obtain trademark protection in the countries of the Madrid Union by filing a single international application. The Madrid System enables applicants to submit application to one member country and designate other member countries where protection is required. The application could be submitted in a single language and is over all very cost effective, since it negates the need for multiple attorneys in each country where protection is sought.

However, unlike regional systems, the Madrid System is not open to all countries worldwide automatically. The criteria's for filing application through Madrid system are that applicants should be a national or domiciled or have a real or effective establishment in a Madrid member country.

## **2. PATENT**

Patent is a form of protection that provides a person or legal entity with exclusive rights for making, using or selling a concept or invention and excludes others from doing the same, also for claiming damages from those who infringe the invention.

Patents generally cover innovations, products or processes that include new functional or technical aspects. It is granted by the Indian Patent Office and has a term of 20 years. After expiration of this 20 year monopoly the product/ invention will fall in the public domain for any third party to use it.

The legislations which deal with the protection and registration of patents in India are *The Patent Act, 1970 and The Patent Rules 2003*. The patent Act 1970 has undergone three (3) amendments in 1999, 2002 and 2005. In the 2005 amendment introduced product patent protection for food, pharma and chemical inventions.

In India an invention/product has to satisfy various criteria to qualify for a patent are:

- New/ Novel- The invention has a feature that sets it apart from previous inventions and is unknown to the public.

- Non-obviousness- The invention's novelty must not be obvious to someone who has ordinary skill in the area of invention.
- Utility- The invention is considered useful.

Like other IP laws patent protection is territorial in nature. Registration of a patent ensures protection in all over India. If somebody wants to protect their invention in another country they have to file application in each and every country where the Applicant wants patent protection for their product/invention.

## INTERNATIONAL PROTECTION FOR PATENTS

The important agreements that should be considered when contemplating international patent protection are The Paris Convention for the protection of Industrial Property & Patent Cooperation Treaty (PCT).

### 1. The Paris Convention

The Paris Convention established in 1883 for the protection of Industrial Property is an international intellectual property treaty adhered to by more than 100 countries. The Paris Convention provides that each country guarantees to the citizens of the other countries the same rights in patent matters that it gives to its own citizens.

The treaty also provides for the right of priority in the case of patents. These rights means that, on the basis of a regular first application filed in one of the member countries, the Applicant may, within 12 months period of time, apply for protection in all the other member countries. These later applications will then be treated as if they had been filed on the same day as the first application. Moreover, these later applications, being based on the first application, will not be invalidated by any acts accomplished in the interval. Thus, these later applicants will have priority over applications for the same invention which may have been filed during the same period of time by other persons.

### 2. International applications through the Patent Co-operation Treaty (PCT)

The Patent Co-operation Treaty (PCT) facilitates the filing of applications for patents on the same invention in member countries. The PCT system does not provide for the grant of an international patent, it is a system for filing international application for patents. The PCT provides for centralized filing procedures whereby a single application filed in a PCT can constitute an application for patent in one or more (including all) member countries. After filing

local (home) application, within 12 months the Applicant claiming Paris Convention Priority or as an original applicant can file the international application under the PCT.

Once the application is filed, one of the eligible PCT governmental search offices will perform a patent search on the application. When the search is completed, PCT governmental office evaluates the patentability of the application pursuant to patentability standards set forth in the Patent Cooperation Treaty. Eventually, the Applicant will be required to have the PCT application officially entered into the national patent office of each of the countries from which the Applicant desires patent protection.

There are several advantages to the PCT process. The Applicant can file a single PCT application rather than filing a series of national applications. The single PCT application is much less expensive than the individual national filings. Although the applicant will eventually be required to incur a cost similar to the national filings when the PCT application is entered in each national patent office, the PCT procedure allows these costs to be delayed for up to thirty months from the priority date. This period of time will allow the inventor a better chance to analyze the patentability and profitability of the invention, and therefore the applicant can make a more informed decision regarding where the patent application should be filed.

### 3. COPYRIGHT

Copyright is a right given by the law to the creators of literary, dramatic, musical and artistic works and producers of cinematograph films and sound recordings. In fact, it is a bundle of rights including rights of reproduction, communication to the public, adaptation and translation of the work.

The creator of a copyrighted work has right to control/ prevent unauthorized copying or reproduction of their work by others for a certain time period, after the said work will enter in the public domain. The protection of copyright varies according to national legislations and the type of work. The Indian law extends copyright protection for the work made by an individual for life time of the author plus sixty (60) years.<sup>5</sup> The Copyright Act, 1957 and the Copyright Rules, 1958 provide for protection of copyrights in India.

There are various criteria for securing copyright protection for a work. Firstly, the work must be original and secondly, the work must be fixed or presented in tangible form such as writing,

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<sup>5</sup> Section 22 of the Copy Right Act 1957- defines copyright shall subsist in any literary, dramatic, musical or artistic work (other than photograph) published with in the lifetime of the author until sixty years from the beginning of the calendar year next following the year in which the author dies.

recording, film or photography, etc. It is to be noted that, Copyright does not protect the underlying idea but only the expression of that particular idea is protected under copyright.

Copyright is provided automatically to the author of any original work covered by the law as soon as the work is created. Registration is not mandatory, but provides for protection of ownership in case of dispute. Copyright registration is invaluable to a copyright holder who wishes to take a civil or criminal action against infringement.

One of the supreme advantages of copyright protection is that unlike other IP rights, protection is available in several countries across the world, by reason of India being a member of Berne Convention. Protection is given to works first published in India, in respect of all countries that are member states to treaties and conventions to which India is a member. Thus, without formally applying for protection, copyright protection is available to works first published in India, across several countries. The government of India vide International Copyright Order, 1999 has extended copyright protection in India to works first published outside India.

### **International protection under the Berne Convention-**

The Berne Convention for the Protection of Literary and Artistic Works was first adopted in 1886 as an agreement to honour the rights of all authors who are nationals of countries that are party to the convention. The convention is administered by the World Intellectual Property Organization, (WIPO).

The member countries formed a Union and the Act provides protection for the work of authors who are nationals of one of the countries of the Union, or where the work is first published (or simultaneously published) in a country that is a member of the Union.<sup>6</sup> For the purposes of the Berne Convention, persons who are not nationals, but which have their habitual residence in a country of the Union, will be regarded as a national of the country.<sup>7</sup>

An author from any country that is a signatory of the convention is awarded the same rights in all other countries that are signatories to the Convention as they allow to their own nationals, in addition to any rights granted under the Convention.

The terms of the Berne Convention also stipulates that where a country outside the Union does not provide adequate protection to authors, countries of the Union are entitled to not extend protection to nationals of that country, beyond that which is granted by that country.<sup>8</sup>

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<sup>6</sup> Article 3 (1) (b) of the Berne Convention For The Protection Of Literary And Artistic Works

<sup>7</sup> Article 3 (2) of the BERNE Convention For The Protection Of Literary And Artistic Works

<sup>8</sup> Article 6 of the BERNE Convention For The Protection Of Literary And Artistic Works - Where any country outside the Union fails to protect in an adequate manner the works of authors who are nationals of one of the countries of the Union, the latter

#### 4. INDUSTRIAL DESIGNS

An industrial design refers to the creation of a shape, configuration or composition or combination of pattern or color in three dimensional forms containing aesthetic value.<sup>9</sup> Designs Act protects only designs that are aesthetic in nature. An industrial design can be a two- or three-dimensional pattern. Novelty and originality are important criteria for a design registration. In addition, only those designs that are applied to an article by an industrial process will be protected.

The Indian law of designs is enshrined in the Designs Act, 2000 and the Design Rules, 2001. The industrial design registration grants the proprietor the exclusive rights of selling, importing and applying the design to any product. India has adopted the 'first to file' system, which means that the right holder should file the application on the earliest point of time to rule out the possibility of any other person claiming for the rights of the intended designs. Any person can apply for the industrial design rights as far as the design is new, not previously published in any nation, reproducible through industrial means, not against to the public order, distinct from the known designs, not consisting of any obscene material and eye catching. In India, a design registration is valid for a period of 10 years, renewable for a further period of 5 years.

The registration of a design confers the copyright in the design for the period of registration to the proprietor. Copyright means the exclusive right to apply the design in respect of the article for which it is registered.

There are some artistic works which is not possible to be registered as the design. They are painting, sculpture, drawing (including a diagram, map, chart or plan), an engraving or photograph (whether or not any such work possesses artistic quality), a work of architecture, and any other work of artistic craftsmanship.

Design rights are granted on a country-by-country basis. An Indian registration provides protection only in India and its territories. If the proprietor of a design wishes to protect a design in other countries, the owner must seek protection in each country separately under the relevant laws.

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country may restrict the protection given to the works of authors who are, at the date of the first publication thereof, nationals of the other country and are not habitually resident in one of the countries of the Union. If the country of first publication avails itself of this right, the other countries of the Union shall not be required to grant to works thus subjected to special treatment a wider protection than that granted to them in the country of first publication.

<sup>9</sup> Article 2 (d) of the Designs Act, 2000 in India defines 'A design is defined as the features of shape, configuration, pattern, ornament or composition of lines or colours applied to any article by any industrial process or means, whether manual, mechanical or chemical, separate or combined, which in the finished article appeal to and are judged solely by the eye, but does not include any mode or principle of construction or anything which is in substance a mere mechanical device and does not include any trademark or property mark or artistic work'.

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The Paris Convention also provides certain privileges to member countries for design protection. A party who files design application in a member state of the Paris Convention, such as India, can within six months of that filing date file applications in other member countries claiming the priority of the first application.<sup>10</sup> If such a design is accepted for registration it will be deemed to have registered from the same date on which the application is made in the home country.

Hague Agreement is the only international system for filing design applications. Since India is not a signatory of this agreement, Indian companies/individuals do not have access to this system.

### **International filing through Hague Agreement-**

The Hague System of international registrations of industrial designs is applicable among the countries party to the Hague Agreement. It is administered by the International Bureau of WIPO.

This system gives the owner of an industrial design the possibility to have his design protected in member countries of the Hague Agreement, by simply filing one application, in one language, with one set of fees in one currency.

## **5. GEOGRAPHICAL INDICATION (GI)**

Geographical Indication refers to ‘Indication which identifies a good as originating in the territory of a member, or a region or locality in that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin’.

In India, the geographical indications regime is regulated by the Geographical Indications of Goods (Registration & Protection) Act, 1999 and the Geographical Indication of Goods (Regulation and Protection) Rules, 2002. Registration of the geographical indication is not compulsory in India<sup>11</sup> the owner of the unregistered geographical indication can enforce his rights through the common law remedy of passing off. It is recommendable to register the geographical indication as the registration certificate acts as the prima facie evidence in the court in case of any dispute and no additional evidence is required to prove the validity / ownership.

While registration of geographical indication is not mandatory in India, Section 20 (1) of the Geographical Indication of Goods Act states that no person “shall” be entitled to institute any proceeding to prevent, or to recover damages for, the infringement of an “unregistered”

<sup>10</sup> Article 4 (A) (1) of the Paris Convention for the Protection of Industrial Property 1883

<sup>11</sup> The Geographical Indications of Goods (Registration and Protection) Act, 1999 - Section 22

geographical indication. The registration of a geographical indication gives its registered owner and its authorized users the right to obtain relief for infringement.<sup>12</sup>

To register the geographical indication, any organization or association of people or statutory authority can apply for the registration. They need to file the application which should consist of the statement of how the geographical indications are related to the quality and with other characteristic features which are the result of the geographical environment encompassing the natural qualities and human factors, unique methods of production, processing and preparation, which occur within the said geographical area.

In India, a geographical indication may initially be registered for a period of ten years, and it can be renewed from time to time for further periods of 10 years.<sup>13</sup> Indian law places certain restrictions in that a registered geographical indication is not a subject matter of assignment, transmission, licensing, pledge, mortgage or any such other agreement.

At the international level, TRIPS sets out minimum standards of protection that WTO members are bound to comply within their respective national legislations. However, as far as the scope of protection of geographical indication under TRIPS is concerned, there is a problem of hierarchy. This is because, although TRIPS contains a single, identical definition for all geographical indication<sup>14</sup>, irrespective of product categories, it mandates a two-level system of protection: (i) the basic protection applicable to all geographical indication in general (under Article 22), and (ii) additional protection applicable only to the geographical indication denominating wines and spirits (under Article 23).”

Like any other intellectual property law, the regulations which govern geographical indication also vary from one country to another. An Indian registration of geographical indication provides protection only in the territories of India.

The two agreements which relate to the international registration of geographical indication are the Lisbon Agreement for the Protection of Appellations of Origin, 1958 and the Paris Convention on industrial property, 1883 (Trademarks).

## International Protection through “Lisbon Agreement for the Protection of Appellations of Origin”-

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<sup>12</sup> The Geographical Indications of Goods (Registration and Protection) Act, 1999- Section 21 (a)

<sup>13</sup> The Geographical Indications of Goods (Registration and Protection) Act, 1999- Section 18 (1)

<sup>14</sup> The Trade Related Aspects of Intellectual Property Rights (TRIPs) Agreement has defined the 'geographical indications rights' as the exclusionary rights for the indicator which identify the goods originated within the member nations territories, or area or region of that territory, where the reputation or other attributes of the goods is essentially related to the geographic origin of the place.

Certain countries together have created a system of international registration of appellations of origin so called Lisbon Union. The basic mechanism of Lisbon is that the local producers of the product must first seek protection for their appellation of origin in their home country. As long as the appellation of origin is protected in the home country, all other Lisbon Countries are obliged to protect it<sup>15</sup>.

The appellation of origin right is a superior right to the trademark right. Therefore, if an existing trademark right conflicts with a newly registered appellation of origin, it must be phased out within two years.<sup>16</sup> Very few countries are members of the Lisbon Union. India is not a member of the Lisbon Union.

## CONCLUSION

The commercial importance necessitates that intellectual property be adequately protected. The protection of the resultant Intellectual Property thus assumes significance in order to ensure that the investments are recouped in a profitable manner. The protection prevents third parties using the protected IP in an unauthorized manner and in case of any unauthorized use provides legal remedies to prevent the same and claim damages. The given right to the creator/ inventor is an incentive for them to produce ideas that will benefit the society as a whole.

The scope and extent of protection of Intellectual Property Rights are being increasingly harmonized around the world for providing business opportunities to protect and enforce their rights globally.

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<sup>15</sup> Article 1 (2) of the Lisbon Agreement

<sup>16</sup> Article 5 (6) of the Lisbon Agreement